

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 18, 2007

Opposition Nos. 91172661
91172662

Jackie Wadell

v.

Jay Wagnon

Linda Skoro, Interlocutory Attorney

On March 20, 2007, opposer filed a motion for summary judgment on the grounds of priority and a likelihood of confusion. Applicant has responded with a request for discovery under Fed. R. Civ. P. 56(f); opposer has objected.

The grounds for applicant's motion is to discover the basis of opposer's allegations of first use and a claim of a likelihood of confusion. In particular, applicant seeks responses to virtually all of its discovery requests.¹ The alleged need for discovery on these issues is to analyze the factual basis of the motion for summary judgment.

¹ It is noted that discovery was scheduled to close on March 20, 2007 and applicant served its initial discovery requests on February 16, 2007. On March 19, 2007 applicant filed a motion for an extension of time of the discovery period. Its motion for an extension of the discovery period will be considered after the motion for summary judgment is decided.

In support of its motion applicant submitted copies of discovery requests and responses thereto.²

We note that as a general rule, a motion for discovery under Fed. R. Civ. P. 56(f), will be liberally treated. If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992). This is especially true if the information sought is largely within the control of the party moving for summary judgment. See *Orion Group Inc. v. Orion Insurance Co. P.L.C.*, 12 USPQ2d 1923 (TTAB 1989).

In the present case, opposer's motion for summary judgment is supported by to declarations and other evidence providing information in the areas that applicant claims it needs discovery on; namely, use of its mark on its website, articles of incorporation, and the subject applications. To respond to this motion requires applicant to establish why the evidence provided by opposer raises a genuine issue of material fact to be decided by the Board in light of the

² It is noted that applicant has not fully complied with the requirements of Fed. R. Civ. P. 56(f) that requires a supporting affidavit setting forth facts essential to justify the opposition to opposer's motion for summary judgment. See *Nature's Way roducts Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989) (mere unsupported assertion of desire to take deposition inadequate). Further, applicant has not set forth the specific areas of discovery it needs to respond to the motion for summary judgment. Rather, applicant's motion is akin to a motion to

issues of priority and a likelihood of confusion. In its motion for discovery applicant challenges the evidence opposer has provided, almost as a response to the motion for summary judgment, but has not established why it needs additional discovery to more fully respond to the motion. Applicant can set forth information on its own use of its mark and provide evidence to support its position as to why there is no likelihood of confusion, and thus the presence of genuine issues of material fact. Such information is within the control of applicant, not the moving party, and therefore not a valid basis for an extension of time to conduct unlimited and unfocused discovery to enable it to respond to the motion for summary judgment. *See also Keebler Co. v. Murray Baker Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989).

Accordingly, applicant's motion for discovery under Rule 56(f) is denied and applicant is allowed until **thirty days** from the date hereof to respond to opposer's motion for summary judgment on the issue of priority and a likelihood of confusion. Proceedings otherwise remain suspended pending disposition of the motion for summary judgment.

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compel rather than a motion for 56(f) discovery. *See* TBMP § 528.06 (2d ed., rev. 1 March 2004).