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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91183799
Party	Defendant Butter Licensing LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 77/071,279  
Filed December 26, 2006 For the Mark BUTTER LOUNGE  
Published in the Official Gazette on January 1, 2008  
and Trademark Registration No. 3380349 for the Mark  
BUTTER RESTAURANT Registration Date February 12, 2008

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PURE ENTERTAINMENT, LLC,	:	
	:	
	:	Opposition No.: 91183799
Opposer,	:	Cancellation No. 3380349
v.	:	
	:	
BUTTER LICENSING, LLC,	:	
	:	
Applicant	:	

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**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO**  
**APPLICANT'S REQUEST FOR A RULE 56(f) CONTINUANCE**

1. Opposer presents no credible opposition to applicant's motion for a continuance to allow applicant to complete discovery. Opposer cancelled scheduled and confirmed depositions due to the illness of a family member of its counsel and then moved for summary judgment based on affidavits of the same individuals whose depositions were sought. Submission by Opposer of such affidavits is contrary to all notions of due process and equity. In the event this motion is denied and Applicant is precluded from conducting depositions of the affiants, such affidavits must be stricken and Opposer's motion for summary judgment denied.

2. Opposer ignores the plain fact that Applicant's request for continuance is necessary to complete the very basic initial discovery to which Applicant is entitled and which was agreed upon by the parties and which Applicant has diligently pursued. No depositions have yet to be conducted.

3. Most telling of Opposer's bad faith, is its argument that it cancelled the depositions scheduled for April 2009 (the "April Depositions") which had been set since February, because "Opposer had by then determined that all of the essential facts to support a summary judgment motion were already in the record." *See Brown Decl.* ¶5, *Spieler June 3 Aff.* ¶¶ 12-13. Regardless of whether Opposer decided to forego its scheduled depositions, it had no right to cancel Applicant's depositions, which Applicant believes are essential to defend this action and support Applicant's motion for summary judgment.

4. Any allegation that Applicant has not acted in a diligent manner in pursuing discoverable information is frivolous. Until the abrupt cancellation of the April Depositions, Applicant and Opposer agreed that that depositions of parties and non-parties would be conducted and endeavored to schedule the same in a manner that was mutually convenient and cost effective for all parties, especially in light of the fact that Opposer is based in San Francisco, California, while its attorneys are located in Jackson, Mississippi.

5. Opposer seeks to punish Applicant's good faith by preventing Applicant from conducting basic discovery and then suggesting that the Board to consider only a limited number of *Du Pont* factors and issues that it deems relevant. Applicant has stated with specificity the information which is sought to be discovered and how that information serves the purpose of summary judgment. Applicant is not seeking a fishing expedition or information which is in its sole possession, but rather is seeking to complete the basic discovery to which it is not only entitled, but which it has diligently pursued.

## **ARGUMENT AND AUTHORITIES**

### **I. OPPOSER HAS A LEGITIMATE BASIS FOR ITS RULE 56(f) REQUEST**

6. It is well settled that motions under Rule 56(f) are to be liberally treated and granted where a party against whom a motion for summary judgment has been brought seeks discovery of

information which is necessary to enable him to respond to the motion. The granting of summary judgment without such discovery is inappropriate. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ 1026 (Fed. Cir. 1988); *McCormick Delaware Inc. and McCormick & Company, Incorporated v. Williams Food.*, 2001 WL 253633 at \* 7 (TTAB 2001); and *Orion Group, Inc. v. The Orion Insurance Company, PLC*, 12 U.S.P.Q.2d 1923, 1989 WL 274396 (TTAB 1989).

**A. Applicant has pled its Rule 56(f) Request with sufficient specificity**

7. Opposer's allegations that Applicant's requests are bare assertions and mere speculation could not be further from the truth. The discoverable information which is sought was stated in Applicant's motion with the same specificity in terms of information sought and relation to the summary judgment motion as has been consistently deemed sufficient by the Board. The Spierer Affidavit, specified specific topics to which Applicant required discovery, which were further narrowed by listing specific contradictory facts which give rise to such need. *See Spierer June 3 Aff.* ¶ 19-23.

8. Applicant's requests are not new or speculative, which are disfavored by the courts for being nothing more than fishing exhibitions to try to avoid summary judgment. Applicant's seeks the basic discovery to which all parties are entitled. Such requests are also certainly related to defenses initially pled by Applicant. Moreover, such depositions were agreed upon by the both parties months before the abrupt cancellation by Opposer only 2 business days prior to first scheduled deposition.

9. Opposer's reliance on cases such as *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987) and *In re Temporomandibular Joint (TMP) Implants Prod. Liab. Litig.*, 113 F.3d 1484 (8<sup>th</sup> Cir. 1997) is misplaced. A Rule 56(f) request was not made in either

case. The Court in *Sweats* found that “there is nothing which indicates Fashion was cut off in discovery. It simply chose not to invoke the protection of Rule 56(f) if it had grounds for doing so.” *Sweats at 1798*. Likewise, the court in *Temporomandibular* noted that “plaintiff’s made a conscious gamble that their case as presented was sufficient to avoid summary judgment and cannot now complain on inadequate discovery.” *See Temporomandibular at 1491*. Applicant has made no such gamble and has consistently sought to conduct depositions in the instant action.

10. Applicant was precluded from conducting scheduled depositions and actually made a timely request supported by an affidavit for a continuance under Rule 56(f). Applicant’s requests are related to the discovery which has clearly been outstanding; namely depositions of the principals of Opposer and related parties, the necessity of which were acknowledged by both parties and the subject of good faith back and forth negotiations for months until Opposer’s unexpected and unilateral cancellation of depositions. *See Spierer June 3 Aff. ¶ 12-13*.

11. Opposer purports to rely on the self-serving statements contained in the declarations of Solle and Paine, but seeks to unjustly preclude Applicant from questioning Solle and Paine on the very facts and topics to which they give testimony in their declarations.

12. The proposition by Opposer that Applicant should be denied relevant discovery because it did not adequately list the areas of requested discovery with particular defenses is not only insulting to the competency of the Board, but is contrary to the spirit of the rule, which recognizes that such motion is to be granted liberally.

**B. Applicant’s requests are within the scope of the pleadings and relevant to the issues presented by Summary Judgment**

13. It is well settled that in determining an allegation of likelihood of confusion, the Board is to look at the situation as a whole, and review each of the thirteen *DuPont* factors to which credible evidence is made a part of the record. While the obligation to consider the *DuPont* factors

does not arise in a vacuum, and it is within the Board's purview to grant more weight to some of the factors, the Board is nonetheless required to consider all of the factors of record. *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973); *Tom Cunningham v. Laser Golf Corp.*, 222 F.3d 943; 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000); *Bongrain Int'l Corp. v. Delice de France, Inc.* 811 F.2d 1479, 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987); *Giant Foods, Inc. v. Nation's Foodservice*, 710 F.2d 1565, 218 U.S.P.Q. 390 (Fed. Cir. 1983).

14. Opposer made its motion for summary judgment prior to conducting depositions to prevent Applicant from presenting evidence to the Board on all relevant *DuPont* factors, and instead limit the defense which Applicant can present. Opposer's acknowledges that "Opposer's summary judgment motion with respect to likelihood of confusion is expressly based on only four of the *DuPont* factors – similarity of marks, similarity of services, similarity of trade channels, and similarity of the class of purchasers and users....None off the factors at issue require the discovery sought by Applicant for adjudication." *Opposer Opposition* ¶6. Not only does Opposer admit that it seeks to preclude Applicant from obtaining evidence on other *DuPont* factors which Applicant believes is relevant to its defense, but Opposer further claims evidence that Applicant seeks on the four factors to be irrelevant and not warranting further discovery. For example, Applicant's motion specifically listed the need to obtain information related to distinctions between the party's clientele, menu, décor and employee skills among other items related to the parties' trade channels and similarity of the class of purchasers and users. In a blatant attempt to avoid its discovery obligations, Opposer proffers that "such information is irrelevant where no restrictions on the trade channels and customers or the goods and services offered, by either party were made in the applications and registration at issue." *See Opposer Opp.* ¶ 9. Such argument is not only disingenuous, but is contrary to applicable case law as explained in *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215; 2 U.S.P.Q.2d 1204 (9<sup>th</sup> Cir. 1987)(the court held that the fact that two shopping centers were

several miles apart and served different clientele is a factor in determining likelihood of confusion). In the instant case the two parties are on different coasts of the United States. The nature of the clientele is certainly a factor in determining the likelihood of confusion.

15. To preclude Applicant from obtaining necessary discovery related to specific requests in connection with Applicant's affirmative and other defenses Opposer takes wholly inconsistent positions with respect to the applications and registrations at issue. Much of Opposer's support for its motion including its grounds alleging fraud by Applicant are based on Opposer's prior registered, but now abandoned trademark registration.

"The only mark of Opposer that is relevant to the claims made by Opposer in these consolidated proceedings is the mark formerly registered by the Opposer."

*See Opposer Opp.* ¶17,

16. Conversely, in the face of Applicant's request for additional discovery on Opposer's failure to file a Section 8 Affidavit of Continued Use and information related to the information provided to Applicant when as the Declaration of Paine states "Solle and his partners sold all of their rights, title and interest in and to Opposer to Mark Ligman and [me] which included .....the mark BUTTER and Design" (*See Paine* ¶5), Opposer states that such information has no bearing on the summary judgment motion. *See Opposer Opp.* ¶ 16. Opposer again, seeks to dictate the defense that Applicant is permitted to put on to an action in which Opposer brought.

17. To support its absurd position that Applicant does not have the right to conduct any depositions, Opposer relies on case law which inapplicable to the case bar, such as *Build-A Bear Workshop v. Silver Dollar City, Inc.* , 2003 WL 22866815 (TTAB 2003)(in which the respondent had conceded several of the *DuPont* factors in favor of the petitioner).

**C. The discoverable information sought is not within Applicant's possession**

18. Opposer's illogical attempt to dictate the defense to which Applicant is entitled to present and obtain discoverable information is evidenced by Opposer's argument that the discoverable information sought is solely within Applicant's possession. Opposer offers no argument that can justify canceling confirmed depositions and then offering affidavits of the same witnesses as the sole support of its motion for summary judgment.

19. There is no basis for Opposer's assertion that Applicant is solely in possession of information related to likelihood of confusion including the relevant *Du Pont* factors related to Opposer including but not limited to the similarity or dissimilarity of services, trade channels, clientele, the fame of Opposer's Mark, and the nature and extent of any actual confusion. the marks, the conditions trade channels, the continuous use and/or abandonment of such mark as well as the nature of which mark(s) Opposer actually uses. Opposer is a small local business about which very little information is publicly available.

20. Such information is solely in the possession of the prior and present owners of Opposer, whose depositions were cancelled, including Oliver Paine who states that he "manages the day-to-day activities and operations of Opposer's San Francisco establishment" (*Paine Dec.* ¶15)

**D. Applicant was at all times diligent in obtaining information during the proceeding.**

21. As the Board noted in *McCormick Delaware Inc. and McCormick & Company, Incorporated v. Williams Food.*, 2001 WL 253633 at \* 9 (TTAB 2001), "The parties are reminded that they are expected to cooperate with one another in the discovery process and to treat one another cordially and reasonably, to avoid the need for Board intervention and 'micro-management' of the case." At all times during the proceeding of this case, Applicant exercised due diligence in obtaining information and conducting discovery in a manner which was reasonable and cooperative with Opposer in good faith pursuant to the expectations of the Board. Due to the locational constraints of



Opposer who was located in California but had counsel located in Mississippi, Applicant attempted to show courtesy to Opposer in the timing of scheduling depositions. Opposer now seeks to punish Applicant for such courtesy.

22. From nearly the inception of this proceeding until the unilateral cancellation of the April Depositions, it was acknowledged by the parties that depositions of multiple parties would be needed, including principals of both parties and other related parties. Moreover, it was Opposer who specifically and explicitly requested the depositions of both principals of Applicant. Further, it is undisputed that the parties engaged in substantive discussions for months to schedule depositions in a convenient and cost-effective manner for both parties due to the inapposite locations of the parties and Opposer's counsel. *See Spierer June 3 Aff.* ¶12-13.

23. The parties engaged in multiple email communications and conference calls to find acceptable dates to commence depositions of initially the principals of the parties, Richie Akiva, Scott Sartiano, Oliver Paine and Mark Ligman to be followed by other depositions if necessary. Opposer misstates the facts and attempts to mislead the Board into believing that Applicant was somehow not diligent. It is indisputable that in February 2009, it was agreed that the first set of depositions would take place from Monday, April 6, 2009 through Thursday, April 9, 2009 in New York and would include the two principals of Applicant and one of the principals of Opposer. Late Thursday evening April 2, 2009, Opposer abruptly cancelled depositions (the "April 2 Cancellation").

24. Most disingenuous is Opposer's assertion that during these months, Applicant should have made further requests for discovery and/or made a motion to compel. Such allegation is laughable, as the parties were seemingly acting in good faith to schedule depositions, and as such no such motion to compel was not necessary and would have forced the Board to micromanage a dispute where there did not appear to be one. Applicant had no indication that it would be precluded

from conducting the depositions it requested or that Opposer planned to cut off discovery by making a motion for summary judgment until it received Opposer's April 2 Cancellation email.

25. The same evening as Applicant received the April 2 Cancellation, Applicant notified Opposer that it believed such dispositions were necessary. Opposer did not even have the courtesy to respond, and in an effort to resolve this matter without unnecessary motion practice and burdening the Board, on April 21, 2009, Applicant reiterated its request to schedule depositions of the parties. The only response received by Applicant was the filing of the instant summary judgment motion a week later. The fact that such motion stayed discovery and precluded the making of a motion to compel by Applicant is ignored by Opposer.

26. In support of its disingenuous claim that Applicant was not diligent, Opposer cites cases which are simply not applicable to the case at bar, where the applicable discovery deadlines had already lapsed without any effort by the party moving under 56(f) to obtain such information as in *Davis and Davis v. G.N. Mortgage Corp.*, 369 F.3d 869 (7<sup>th</sup> Cir. 2004)(where respondent had the majority of supporting affidavits in its possession for five months before the applicant filed its motion for summary judgment and failed to seek the depositions of non-parties and such information was in the possession of third parties) and *Reyes v. Wilson Memorial Hospital*, 102 F.Supp.2d 798 (U.S.D.C. S.D. Ohio 1998)(where the court held that the plaintiff was not entitled to requested continuance, because plaintiff had waited several years in which to attempt to obtain the requested discovery). In the instant case, the discovery deadline had not lapsed and had been extended multiple times by mutual consent of the parties who recognized the need for continued discovery.

27. Any failure to subpoena and depose Solle was due to Applicant's intent to cooperate with the scheduling of the party depositions prior to scheduling third party depositions to which both parties had agreed.

II. Applicant Should not be required to extend any accommodations to Opposer and its counsel in the method, time and place of any depositions.

28. After seeking to penalize Applicant for its good faith and courtesy in conducting discovery, Opposer now requests that the Board grant additional accommodations to Opposer to which it is not entitled pursuant to the FRCP. Despite the fact that the failure to proceed with depositions was the unilateral decision of Opposer on the eve of their commencement, and that at that time the discovery deadline was not closed, Opposer now seeks to constrain the time frame in which Applicant can complete discovery. Opposer seeks to have it both ways by demanding that due to its requested abbreviated time frame, Applicant should accommodate Opposer in method, time and place of depositions.

**CONCLUSION**

Based on the foregoing and Applicant's initial moving papers, Applicant respectfully requests a continuance pursuant to FRCP §56(f) and requests that Applicant not be subject to the constraints requested by Opposer.

Dated: New York, New York  
July 8, 2009

Respectfully submitted,

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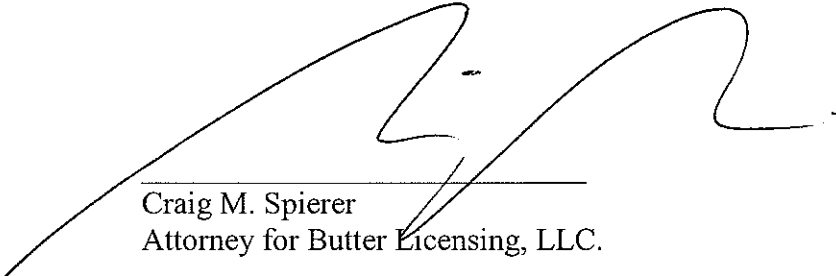
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**CERTIFICATE OF SERVICE**

I hereby certify and declare under penalty of perjury that I served a true and correct copy of Applicant Butter Licensing, LLC's Reply to Opposer's Opposition to Applicant's Request For a Rule 56(f) Continuance upon Debra Brown, attorney for Opposer Pure Entertainment, LLC by depositing the same with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Debra Brown, Phelps Dunbar, LLP, 111 E. Capitol Street, Suite 600, Jackson, MS 39201, on this 8<sup>th</sup> day of June, 2009.



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