


ESTTA Tracking number: **ESTTA897231**

Filing date: **05/16/2018**

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

Proceeding	91238574
Party	Plaintiff Grinnell Mutual Reinsurance Company
Correspondence Address	SARAH J GAYER NYEMASTER GOODE PC 625 FIRST STREET SE, SUITE 400 CEDAR RAPIDS, IA 52401 UNITED STATES Email: rwhoke@nyemaster.com
Submission	Opposition/Response to Motion
Filer's Name	Sarah Gayer
Filer's email	sjgayer@nyemaster.com
Signature	/Sarah Gayer/
Date	05/16/2018
Attachments	20180516 Grinnell Mutual opposition to motion for discovery.pdf(121703 bytes )

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

<p>GRINNELL MUTUAL REINSURANCE COMPANY</p> <p>Opposer,</p> <p>vs.</p> <p>PROTECTIVE INSURANCE COMPANY</p> <p>Applicant.</p>	<p>Opposition No. 91238574</p> <p>Serial No.: 87440152</p> <p></p> <p>Mark:</p> <p>Published: September 19, 2017</p>
---	---

**OPPOSER’S OPPOSITION TO APPLICANT’S MOTION FOR DISCOVERY**

Pursuant to Federal Rule of Civil Procedure 56 and 37 CFR Section 2.127, Opposer Grinnell Mutual Reinsurance Company (“Grinnell Mutual”) provides the following opposition to the Rule 56(d) motion of Protective Insurance Company (“Protective Insurance”).

**Introduction**

Motions for summary judgment are “an integral part of the Federal Rules as a whole, which are designed ‘to secure the just, speedy and inexpensive determination of every action.’” *Celotex Corp v. Catrett*, 477 U.S. 317, 327 (1986) (quoting Fed. R. Civ. P. 1). When a party claims to be “‘railroaded’ by a premature motion for summary judgment”, it must comply with Federal Rule of Civil Procedure 56(d) in requesting relief. *Id.* Protective Insurance has not complied with this Rule. Protective Insurance has responded on the merits to Grinnell Mutual’s summary-judgment motion, which means that its 56(d) request for discovery is moot and should be summarily denied. Alternatively, Protective Insurance’s 56(d) request should be denied for failing to prove that Protective Insurance needs any discovery to (further) oppose Grinnell Mutual’s motion.

## **I. Protective Insurance’s Request for Discovery Is Moot.**

Along with its Rule 56(d) motion, Protective Insurance has “out of an abundance of caution” filed an opposition to Grinnell Mutual’s summary-judgment motion. (Opposition p. 1). Protective Insurance acknowledges that its opposition constitutes a “response on the merits” (based on what it characterizes as “the limited information that is currently available”). *Id.* This approach is improper. *See* TBMP § 528.06 (“A request for Fed. R. Civ. P. 56 discovery ... should not be filed as a ‘throw away’ alternative accompanying a response to the motion for summary judgment on the merits”).

Because Protective Insurance has responded on the merits to Grinnell Mutual’s summary-judgment motion, its 56(d) request to conduct discovery is moot and should be summarily denied. *See Geoffrey, LLC v. Hair Are Us, Inc.*, 2017 WL 2391863 at \* 1 (TTAB 2017) (non-precedential) (“Because Applicant filed a substantive response to Opposer’s summary judgment motion, its request for Fed. R. Civ. P. 56(d) discovery is DENIED as moot”); *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 U.S.P.Q.2d 1925 at \* 5 (TTAB 2015) (precedential) (“To the extent that Bad Boys’ brief in opposition includes an embedded motion seeking Rule 56(d) discovery, the motion is denied as moot inasmuch as Bad Boys has responded to the motion for summary judgment on its merits”); *Melaleuca, Inc. v. Susser*, 2013 WL 11247294 n. 10 (TTAB 2013) (“When a party files a combined request for Fed. R. Civ. P. 56(d) discovery and response on the merits of the motion, the Board will deem the discovery request moot, and decide the summary judgment motion on the merits thereof”); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 U.S.P.Q.2d 2009 n. 8 (TTAB 2002) (“Inasmuch as opposer has submitted a substantive response to applicant’s motion for summary judgment, opposer’s request for discovery pursuant to Fed. R. Civ. P. 56(f) is denied”); TBMP § 528.06 (“When a party faced with a summary

judgment motion files a combined request for Fed. R. Civ. P. 56(d) discovery and response on the merits of the motion, the Board ordinarily will deem the Fed. R. Civ. P. 56(d) discovery request moot, and decide the summary judgment motion on the merits thereof”).

## **II. Alternatively, Protective Insurance Has Not Established any Need for Discovery.**

In addition to being moot, Protective Insurance’s 56(d) motion fails on its merits. Protective Insurance has not proven that it needs to conduct discovery in order to (further) oppose Grinnell Mutual’s summary-judgment motion. *See Bad Boys Bail Bonds*, 115 U.S.P.Q.2d 1925 at \* 5 (“[E]ven if the motion seeking Rule 56(d) discovery were not deemed moot, it would be denied because Bad Boys failed to specify any reason why it cannot present facts essential to justify its opposition to the motion for summary judgment”).

### **A. Rule 56(d) Requires Specific Proof of A Need for Discovery.**

Relief under Federal Rule of Civil Procedure 56(d) is available only when a party against whom a summary-judgment motion has been filed “shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition” to the summary-judgment motion. Fed. R. Civ. P. 56(d). A Rule 56(d) affidavit or declaration must prove “with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment.” *CBB Group, Inc. v. Trademark Tools Inc.*, 2017 WL 3718331 at \* 1 (TTAB 2017). Protective Insurance has not satisfied this stringent standard.

### **B. The Affidavit Offered By Protective Insurance Does Not Prove Any Need for Discovery.**

The affidavit by Protective Insurance’s counsel summarily states that the documents and information sought in its first sets of discovery requests “are essential to contest some of the statements in the Motion for Summary Judgment” and that Protective Insurance “is unable to

present these facts” without receiving the requested discovery. (Protective Insurance Ex. A ¶¶ 6-7, 18). These vague statements do not prove entitlement to relief under Rule 56(d). The Board has explained: “It is not sufficient that a nonmovant simply state in an affidavit that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present by affidavit facts sufficient to show the existence of a genuine dispute of material fact for trial.” *CBB Group, Inc.*, 2017 WL 3718331 at \* 1.

The affidavit goes on to attempt to link some of Protective Insurance’s discovery requests with *duPont* factors. However, even through this exercise, Protective Insurance does not identify any essential facts it needs to develop through discovery in order to (further) respond to Grinnell Mutual’s summary judgment motion. *Cf.* Fed. R. Civ. P. 56(d).

Paragraphs 8 and 9 of the Affidavit reference similarity of the parties’ marks. (Protective Insurance Ex. A). This factor must be determined by comparing Grinnell Mutual’s registered mark, as set forth in the registration, with Protective Insurance’s applied-for mark, as set forth in the application. *See e.g.*, TMEP § 1207.01(b) (similarity of marks “is based on the marks as depicted in the respective application and registration, without regard to whether the marks will appear with other marks, such as house marks, or other elements when used”). Nothing listed in Paragraphs 8 and 9 is needed to respond to Grinnell Mutual’s arguments regarding the parties’ marks. For example, Interrogatory 7 (listed in Paragraph 9 of the Affidavit) states: “Identify any means of communication in which Grinnell advertises and promotes its services to customers and/or potential customers, including each/all publications and all web sites and online advertising in which Grinnell advertises and/or promotes its services.” (Protective Insurance Ex. C). This Interrogatory relates to Grinnell Mutual’s real-world usage of its mark, which is

irrelevant. *See e.g., In Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014) (“It was proper ... for the Board to focus on the application and registrations rather than on real-world conditions...”); *In Re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, 1198 (TTAB 2003) (precedential) (“[I]t is well-settled that use of a house mark in conjunction with a product mark will not serve to prevent a finding of likelihood of confusion when the house mark is not included in the mark for which registration is sought”).

Paragraphs 10 and 11 of the Affidavit mention trade channels, classes of customers, and conditions of purchase. (Protective Insurance Ex. A). Grinnell Mutual’s registered services (“writing property and casualty insurance” and “reinsurance underwriting”) and Protective Insurance’s applied-for services (including “writing property and casualty insurance” “in the field of trucking and transportation” and “reinsurance underwriting” “in the field of trucking and transportation”) are legally identical in part. (Reg. No. 5214984); (Serial No. 87440152). Thus, “we must presume that the channels of trade and classes of purchasers are the same.” *In re SL&E Training Stable*, 2008 WL 4107225 at \* 3 (TTAB 2008); *In re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 \* 10 (TTAB 2016) (precedential). Particularly in light of these legal presumptions, Protective Insurance has not proven any need to conduct discovery regarding the *duPont* factors mentioned in Paragraphs 10 and 11.

Paragraphs 12 and 13 of the Affidavit reference “ownership and validity of the mark.” (Protective Insurance Ex. A). No discovery is needed regarding this issue. Grinnell Mutual owns a valid and subsisting registration, which Grinnell Mutual properly made of record in its summary judgment evidence. Grinnell Mutual is entitled to the presumptions of Section 7(b). *See* 15 U.S.C § 1057(b) (“A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and

of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate”). Protective Insurance did not plead lack of ownership and cannot avoid summary judgment by alleging some fact issue regarding ownership. *See* TBMP § 528.07(b) (“A party may not defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an unpleaded claim or defense”); *CSL Silicones Inc. v. Midsun Group, Inc.*, 2014 WL 11032981 at \* 5 (TTAB 2014) (“unpleaded affirmative defense .... cannot be relied upon in defense of opposer’s motion for summary judgment”); *McCormick Delaware, Inc. v. Williams Foods, Inc.*, 2001 WL 253633 at \* 7 (TTAB 2001) (denying motion for 56(f) discovery as related to abandonment because abandonment was not plead).

Paragraphs 14 and 15 of the Affidavit reference actual confusion. (Protective Insurance Ex. A). Paragraphs 12 and 13 reference “the extent of Opposer’s use” and “the conditions of concurrent use with Protective Insurance’s mark,” which are also understood to relate to the issue of actual confusion. *Id.* There is no reason to postpone the summary-judgment proceedings to allow Protective Insurance to conduct discovery relating to actual confusion. Grinnell Mutual’s motion for summary judgment does not argue actual confusion. *See Weiss Associates, Inc. v. HRL Assoc., Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990) (“It is unnecessary to show actual confusion is establishing likelihood of confusion”). Protective Insurance need not argue lack of actual confusion. Moreover, “the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same marketplace as those served by Opposer under its marks.” *McDonald’s Corp. v. McSweet, LLC*, 112 U.S.P.Q.2d 1268 at \* 17 (TTAB 2014)

(precedential). By contrast, Protective Insurance claims to have adopted its shield design just last year.

Paragraphs 16 and 17 of the Affidavit reference “various other third-party registrations for insurance services” that “include a shield-like design.” (Protective Insurance Ex. A). Grinnell Mutual does not have control over these documents. *Cf.* TBMP § 528.06. There is no reason Protective Insurance could not have already gathered from public records whatever third-party registrations it wishes to rely upon. And, this vague reference to unspecified third-party documents lacks the specificity required under Rule 56(d). *See Bad Boys Bail Bonds*, 115 U.S.P.Q.2d 1925 at \* 5 (holding the 56(d) declaration was inadequate because “to the extent Bad Boys seeks third-party declarations or affidavits Bad Boys failed to name any person from whom it would obtain one of the additional declarations or affidavits, or provide any reason why that person was previously unavailable”).

In summary, while the Affidavit offered by Protective Insurance mentions some *duPont* factors, it does not identify with specificity any facts essential to discover before (further) responding to Grinnell Mutual’s summary-judgment arguments. *See Armida Winery, Inc. v. Graveyard Vineyards*, 2015 WL 9913831 at \* 2 (TTAB 2015) (denying portion of 56(d) motion related to discovery requests because the party seeking discovery “has not cited to any specific interrogatory or document request, nor identified the specific facts that any specific request would reveal, nor explained why those facts would preclude summary judgment”); *Komar Layering, LLC v. Heat Co. Inc.*, 2017 WL 3718267 (TTAB 2007) (in denying motion under Rule 56(d), explaining that the party seeking relief under Rule 56(d) must “demonstrate why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial.”).



**C. The Legal Arguments Contained in Protective Insurance’s Motion Do Not Prove any Need for Discovery.**

Protective Insurance’s legal arguments do not establish a need for discovery. Legal arguments cannot establish entitlement to relief under Rule 56(d). *See* Fed. R. Civ. P. 56(d); *Cerveney v. Aventis, Inc.*, 855 F.3d 1091, 1110 (10<sup>th</sup> Cir. 2017) (“we may not look beyond the affidavit in considering a Rule 56(d) request”); *Radich v. Goode*, 886 F.2d 1391, 1394 (3rd Cir. 1989)(“Appellants contend that their attorney's unverified memorandum opposing the motion for summary judgment complies with the Rule 56(f) affidavit requirement. It does not”). Furthermore, the legal arguments of Protective Insurance are contrary to fundamental principles of trademark law.

1. The Parties’ Real-World Usage of Their Marks is Irrelevant.

Protective Insurance argues it is entitled to conduct discovery regarding the way the parties actually use their marks, such as “advertising and promotional examples.” (Motion p. 4).<sup>1</sup> This argument is contrary to law (for the same reason that Paragraphs 8 and 9 of the Affidavit do not prove any entitlement to discovery). Similarity of the marks must be analyzed by comparing the parties’ marks as set forth in Grinnell Mutual’s registration and Protective Insurance’s application, not based on real-world usage of the marks. *See e.g.*, TMEP § 1207.01(b); *In Re Microsoft Corp.*, 68 U.S.P.Q.2d 1195, 1198 (TTAB 2003) (precedential) (“[I]t is well-settled that use of a house mark in conjunction with a product mark will not serve to prevent a finding of likelihood of confusion when the house mark is not included in the mark for which registration is sought”).

---

<sup>1</sup> Protective Insurance’s motion even illustrates what it describes as “usages where the parties’ marks are used with and somewhat overshadowed by additional wording of the companies’ respective names,” showing a) Protective Insurance’s shield design (in color) with the term PROTECTIVE INSURANCE and b) Grinnell Mutual’s shield design with the term GRINNELL MUTUAL (both in color). (Motion pp. 4-5).

The *Homeland Vinyl* decision cited by Protective Insurance references a need to consider the marks “in their proper context” only because of the unique nature of marks at issue in that proceeding. The applied-for mark (for non-metal fence rails) consisted of “the configuration of a fence rail” and the registered mark (also for non-metal fence rails) consisted of “a configuration of the bottom portion of a fence rail bearing the exterior rounded shoulders and the recessed edges.” 81 U.S.P.Q.2d 1378 at \* 1 (TTAB 2006). Thus, the Board needed to consider “as the product shapes would be encountered by purchasers in the actual marketing environment, including their proper visual scale.” *Id.* at \* 5. Such analysis has no application to the present proceeding, which involves design marks for insurance services.

Protective Insurance quotes the 1961 *Finn* case regarding “the visual impact of the marks on the minds of the prospective purchasers.” That quote comes from a discussion of unregistered, common-law “symbols” being capable of serving as source identifiers. *Finn v. Cooper’s Inc.*, 292 F.2d 555, 558 (C.C. P.A. 1961). Whether Grinnell Mutual’s design mark serves as a source identifier is not a matter of debate because it is a registered mark. (Reg. No. 5214984). Thus, *Finn* does not support Protective Insurance’s request to conduct discovery regarding real-world usage of the parties’ marks.

2. Grinnell Mutual’s Actual Channels of Trade and Customers are Irrelevant.

Protective Insurance argues it is entitled to conduct discovery regarding Grinnell Mutual’s “actual channels of trade and potential consumers...” (Motion p. 4). These facts are not “essential” to oppose Grinnell Mutual’s summary-judgment motion. Fed. R. Civ. P. 56(d). These facts are not even relevant. Protective Insurance “may not restrict the scope” of the services “covered in the cited registration by argument or extrinsic evidence.” *In re La Peregrina Ltd.*, 86 U.S.P.Q.2d 1645 at \* 2 (TTAB 2008). *See also In Re Hearthmark, LLC*, 2014 WL

1649324 at \* 4 (TTAB 2014) (non-precedential) (“We simply cannot curtail the rights defined by the identification of goods in the registrations to limit the goods, channels of trade or classes of customers thereof to what applicant’s evidence may show them to be”).

3. Channels of Trade and Potential Purchasers Are Not Limited in Protective Insurance’s Application.

Protective Insurance argues that its “channels of trade and potential purchasers are specifically limited” in its application. (Motion p. 4). This is not accurate. Protective Insurance’s identification of services states in full: “insurance agency and brokerage; insurance services, namely, writing property and casualty insurance; reinsurance underwriting; design and development of insurance policies for others; insurance consultancy services; insurance risk management; insurance claims administration, all of the foregoing in the field of trucking and transportation.” (Serial No. 87440152). This field limitation does not constitute a limitation as to channels of trade or potential purchasers. *See In Re Tapco Intl. Corp.*, 122 U.S.P.Q.2d 1369 at \* 6 (TTAB 2017) (precedential) (“Even the ‘building construction industry’ language in Class 1 does not limit the trade channels through which the goods might be sold., e.g., in a home improvement store where they would be available both to contractors and homeowners”). *Cf. In Re Myopain Seminars, LLC*, 2017 WL 5197914 at \* 7 (TTAB 2017) (non-precedential) (“directed to medical professional and clinicians” is a limitation as to classes of customers). Moreover, the parties’ services are legally identical in part, resulting in legal presumptions, as discussed above. (Reg. No. 5214984); (Serial No. 87440152).

**Conclusion**

Grinnell Mutual respectfully requests that Protective Insurance’s 56(d) motion be denied in its entirety. Protective Insurance’s motion is moot, given its response on the merits to Grinnell

Mutual's summary-judgment motion. Thus, Protective Insurance's motion should be summarily denied. In addition, Protective Insurance has not proven any need for discovery.

Respectfully submitted,

GRINNELL MUTUAL REINSURANCE  
COMPANY

By /Sarah J. Gayer/  
Sarah J. Gayer  
Robert W. Hoke  
Attorneys for Opposer  
Nyemaster Goode, P.C.  
625 First Street SE, Suite 400  
Cedar Rapids, IA 52401  
Phone: (319) 286-7000  
Fax: (319) 286-7050  
Email: [sjgayer@nyemaster.com](mailto:sjgayer@nyemaster.com)  
[rwhoke@nyemaster.com](mailto:rwhoke@nyemaster.com)

AND

Jeff Harty  
NYEMASTER GOODE, P.C.  
700 Walnut Street, Ste. 1600  
Des Moines, IA 50309-3899  
Phone: (515) 283-8038  
Fax: (515) 283-3108  
Email: [jharty@nyemaster.com](mailto:jharty@nyemaster.com)  
**ATTORNEYS FOR OPPOSER**

**ELECTRONIC MAILING CERTIFICATE**

I hereby certify that this OPPOSITION TO APPLICANT’S MOTION FOR DISCOVERY is being submitted electronically through the Electronic System for the Trademark Trial and Appeal Board (ESTTA) on this 16<sup>th</sup> day of May, 2018.

/Sarah J. Gayer/  
Sarah J. Gayer

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing OPPOSITION TO APPLICANT’S MOTION FOR DISCOVERY will be served on the following attorney for Applicant by forwarding said copy on May 16, 2018 via email to:

Charles Meyer and Thomas Henry  
Woodard, Emhardt, Moriarty, McNett & Henry LLP  
111 Monument Circle, Suite 3700  
Indianapolis, INDIANA 46204  
Email: cmeyer@uspatent.com, thenry@uspatent.com, docketdept@uspatent.com,  
cjmeyer@uspatent.com, danielle@uspatent.com

/Sarah J. Gayer/  
Sarah J. Gayer