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Bukrinsky/Winter

May 19, 2020

Opposition No. 91239589

Maker's Mark Distillery, Inc.

v.

Bowmaker's Whiskey Company

Before Kuhlke, Heasley, and Johnson,
Administrative Trademark Judges.

By the Board:

This proceeding now comes up for consideration of Opposer's motion (filed November 27, 2018) to extend the discovery deadline by 90 days, 8 TTABVUE, and Applicant's motion (filed December 21, 2018[1]) for summary judgment on Opposer's claim of likelihood of confusion, 10 TTABVUE.[2] Both motions are fully briefed.

We have considered the parties' briefs and materials submitted in connection with both motions, but address the record only to the extent necessary to set forth our analysis and findings, and do not repeat or address all of the parties' arguments or

[1] We note that the Board partially granted Opposer's motion for additional discovery under Fed. R. Civ. P. 56(d) on July 2, 2019. 18 TTABVUE.

[2] Opposer's motion for an extension of time (filed September 23, 2019) to file its response to Applicant's motion for summary judgment is also pending and fully briefed. *See* 19, 20, and 21 TTABVUE. However, as Opposer ultimately submitted its response to Applicant's motion on the deadline as originally set, i.e., September 30, 2019, *see* 22 TTABVUE, Opposer's request for an extension is moot and will be given no further consideration.

evidence. *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, we presume the parties' familiarity with the pleadings, and the arguments and materials submitted in connection with the subject motions.

Because our decision on Applicant's summary judgment motion will determine whether we need to consider Opposer's motion to extend discovery, we first consider Applicant's motion for summary judgment.

I. Applicant's Motion for Summary Judgment

A. Legal Standard

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record must be viewed in the light most favorable to the non-moving party, and all justifiable inferences must be drawn from the

undisputed facts in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA,* 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the proceeding. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542; *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) ("If there is a real dispute about a material fact or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial.").

B. Analysis and Order

To prevail on summary judgment on the plaintiff's claim of likelihood of confusion, the defendant moving for summary judgment must establish that there is no genuine dispute that the contemporaneous use of the parties' marks in connection with their respective goods or services would not be likely to cause confusion, mistake or to deceive consumers.[3] *See* 15 U.S.C. § 1052(d); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Applicant argues that it is entitled to summary judgment because the parties' marks – BOWMAKER'S WHISKEY on the one hand and MAKER'S and MAKER'S MARK on the other – are so dissimilar in their entireties as to appearance, sound,

[3] Applicant accepts for purposes of its motion Opposer's priority of use. 10 TTABVUE 8.

connotation and commercial impression as to make the first *DuPont*[4] factor dispositive. 10 TTABVUE 11-12.

Based on our review of the parties' arguments and the evidence of record,[5] and drawing all inferences in favor of Opposer, the non-movant, we find that Applicant has not demonstrated the absence of genuine disputes of material fact and that it is entitled to judgment as a matter of law on Opposer's claim of likelihood of confusion. At a minimum, there exist genuine disputes of material fact as to the overall commercial impressions evoked by the parties' marks, the strength of Opposer's pleaded marks, and the scope of protection that should be afforded to Opposer's marks.[6]

Accordingly, Applicant's motion for summary judgment on Opposer's claim of likelihood of confusion is **DENIED**.[7]

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[4] *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

[5] We note Applicant's objections to certain of Opposer's evidence submitted with its response to Applicant's motion. 23 TTABVUE 5. Insofar as Applicant did not file a separate motion to strike or exclude any of Opposer's evidence (or otherwise indicate that its reply brief included a motion to strike), we will not deliberate on the merits of its objections. Nonetheless, we hasten to point out that evidence introduced with respect to a summary judgment motion is less formal than that introduced at trial. Further, in this particular instance, we find that the evidence should be considered on the question of whether there are issues that must be tried. Thus, we have considered the objected-to evidence, keeping in mind the objections, and have accorded it whatever probative value it merits. In particular, we find it appropriate to consider the evidence submitted by Opposer regarding its sales and advertising figures insofar as Opposer did not unequivocally refuse to provide responsive information during discovery. *See* Opposer's Responses to Applicant's Requests for Production, Nos. 18 & 19, 23 TTABVUE 30-31. *See Vignette v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005).

[6] The fact that we identify certain material facts that are genuinely in dispute should not be construed as a finding that these are the only issues that remain for trial.

[7] The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. To be considered at

II. Opposer's Motion for Extension of Deadlines

As reset in the Board's suspension order mailed February 22, 2018, 5 TTABVUE, the discovery period was set to close on December 27, 2018. 4 TTABVUE. On November 27, 2018, Opposer filed its motion in which it seeks a 90-day extension of the discovery period and testimony periods "on the grounds that the parties are engaged in advanced settlement negotiations to resolve this matter." 8 TTABVUE 2. Opposer also states that "the requested extension would enable the parties to finalize a settlement or, if Applicant is no longer inclined to pursue a settlement, to complete discovery in the case." *Id.* at 3-4.

Applicant opposes Opposer's extension request, arguing that it had already agreed to "numerous extensions" for settlement, 9 TTABVUE 2, but that Opposer "has not been expeditious in pursuing the settlement process" and that the parties had reached an "impasse in settlement." *Id.* at 2-8. Applicant also states that Opposer first served discovery on Applicant on November 26, 2018, i.e., the day before filing its request for an extension. *Id.* at 8.

Opposer filed its motion requesting an extension of the discovery period prior to the close of that period. The appropriate standard for allowing an extension of a prescribed period prior to the expiration of the term is "good cause." *See* Fed. R. Civ. P. 6(b); TBMP § 509 and cases cited therein. Generally, the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving

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final hearing, any such evidence must be properly introduced during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 528.05(a) (2019).

party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See, e.g., Am. Vitamin Prods., Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1315 (TTAB 1992). Nonetheless, the moving party retains the burden of persuading the Board that it was diligent in meeting its responsibilities and should therefore be awarded additional time. *See Nat'l Football League v. DNH Mgmt. LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008).

The record shows that from two days after the institution of this proceeding through October 3, 2018, the parties were engaged to some extent in settlement negotiations. However, the proceeding was suspended for settlement for only sixty days. Specifically:

i) On February 22, 2018, the parties agreed to a 60-day extension of the trial schedule to discuss settlement, 4 TTABVUE;

ii) On April 14, 2018, Applicant's counsel inquired as to Opposer's response to Applicant's February 26, 2018 correspondence related to Opposer's initial settlement demands, 9 TTABVUE 4-5;

iii) On April 16, 2018, Opposer advised Applicant that it had changed counsel, *id.* at 5;

iv) On May 9, 2018, Opposer's new counsel informed Applicant that Opposer was moving forward with the opposition, *id.*;

v) The parties' counsel discussed settlement during the discovery conference held on June 27, 2018. 9 TTABVUE 5.

The record further shows that Applicant substantially agreed to Opposer's proposal by email on July 6, 2018. 9 TTABVUE 6. Thereafter, Applicant served its discovery requests on July 30, 2018, and Applicant later allowed Opposer a three-week extension of time to serve its responses thereto. *Id.* at 6-7. Opposer provided a second written proposal to Applicant on September 5, 2018, and a third proposal on October 16, 2018, neither of which were accepted by Applicant. *Id.* at 6-8. Settlement discussions concluded on October 3, 2018, after Opposer had objected to "substantially all" of Applicant's discovery requests, when Applicant advised Opposer that it intended to move the opposition forward. *Id.* at 7. Opposer served its discovery requests on Applicant six weeks after its last settlement proposal, eight weeks after Applicant informed Opposer that it would be moving forward, approximately one month before the close of discovery, and one day before filing its request for a 90-day extension of deadlines. *See* 12 TTABVUE 28, 40.

We are troubled by Opposer's failure to move discovery forward during the scheduled discovery period. Opposer argues that the parties were engaged in settlement negotiations, 8 TTABVUE 3, but these proceedings were suspended for 60 days for settlement negotiations **before** Applicant filed its Answer, *see* 5 TTABVUE, and there were no further suspensions thereafter. If the parties do not agree to suspend the trial schedule, the Board expects the parties to continue with discovery and trial preparation while they negotiate to settle this matter. *See Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (the belief in settlement and/or the existence of settlement negotiations do not justify a party's

inaction or delay or excuse it from complying with the deadlines set by the Board or imposed by the rules). The parties' sporadic negotiations, without more, do not justify Opposer's delay in moving forward in this proceeding. *See Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000). "Opposer brought this case and, in so doing, took responsibility for moving forward on the established schedule." *Atlanta-Fulton County Zoo Inc.,* 45 USPQ2d at 1860.

Nonetheless, we find that a shorter extension of the discovery period is appropriate in this case for the following reasons. While Opposer obtained some discovery, including a limited deposition of Applicant's manager, pursuant to its motion under Rule 56(d), *see* 18 TTABVUE, the Board's order expressly limited the discovery to countering points raised in Applicant's motion for summary judgment. *Id.* at 5-6. Opposer was not authorized to conduct additional discovery, including discovery relevant to the other *DuPont* factors during the suspension of this case, and indeed, Applicant's evidentiary objections indicate that Applicant too may not have received documents responsive to some of its outstanding discovery requests.[8] *See* 23 TTABVUE 5-7. In view of the foregoing, we conclude that a limited extension of the discovery period in this case would promote the presentation of the merits by presenting to the Board a full record upon which to adjudicate Opposer's claim. Accordingly, Opposer's motion for an extension of discovery deadlines is **GRANTED in part**. The expert disclosure deadline and all following deadlines shall be extended by **FORTY-FIVE (45) DAYS** as set forth below.

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[8] Our reference to Applicant's objections should not be construed as a finding that documents were not produced.

IV. Proceedings Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Expert Disclosures Due	**7/2/2020**
Discovery Closes	**8/1/2020**
Plaintiff's Pretrial Disclosures Due	**9/15/2020**
Plaintiff's 30-day Trial Period Ends	**10/30/2020**
Defendant's Pretrial Disclosures Due	**11/14/2020**
Defendant's 30-day Trial Period Ends	**12/29/2020**
Plaintiff's Rebuttal Disclosures Due	**1/13/2021**
Plaintiff's 15-day Rebuttal Period Ends	**2/12/2021**
Plaintiff's Opening Brief Due	**4/13/2021**
Defendant's Brief Due	**5/13/2021**
Plaintiff's Reply Brief Due	**5/28/2021**
Request for Oral Hearing (optional) Due	**6/7/2021**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).

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