

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

Desjardins/EJW

September 18, 2021

Opposition No. 91267373

*Nature's Bakery, LLC*

*v.*

*The Fynder Group, Inc.*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

By way of background, on May 5, 2021, Applicant filed a motion for summary judgment on Opposer's claims of likelihood of confusion and dilution by blurring. 6 TTABVUE. This case now comes up for consideration of Opposer's responsive motion (filed June 4, 2021) for discovery under Fed. R. Civ. P. 56(d). 8 TTABVUE. The motion is contested.

The Board has considered the parties' briefs and materials submitted therewith, but addresses the record only to the extent necessary to support the Board's analysis and findings, and does not repeat or address all of the parties' arguments or materials. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). For purposes of this order, the Board presumes the parties' familiarity with the pleadings, and the arguments and materials submitted in connection with the subject motion.

## **I. Preliminary Matter: Motion to Divide**

On February 11, 2021, Applicant submitted a motion to divide the opposed application, Serial No. 88812151, so that all goods except those in International Class 5 would be placed in a new “child” application. 4 TTABVUE 2. Said motion was granted by the Board on June 1, 2021. 7 TTABVUE.

The records of the Office show that a new application was created on August 31, 2021, i.e., application Serial No. 88982819. The child application has been routed to the USPTO Trademarks Intent-to-Use Unit for further processing.

## **II. Motion for Discovery under Fed. R. Civ. P. 56(d)**

### **A. Legal Standard**

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. As a general rule, the Board is liberal in its treatment of such requests for discovery, as the Board is mindful of its reviewing court’s concern with the “railroading” of non-movants by premature summary judgment motions or the improper entry of summary judgment when the nonmoving party has not had an opportunity to exercise pretrial discovery. *See Opryland USA Inc. v. The Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992) (citing former Rule 56(f), now Rule 56(d)); *see also Orion Group Inc. v. the Orion Ins. Co. P.L.C.*, 12 USPQ2d 1923, 1324 (TTAB 1989) (“[I]t is well settled that the granting of a motion for summary judgment is inappropriate where the responding party has been denied discovery needed to enable it to respond to the motion.”) (citing *Dunkin’*

*Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988)). Generally, if a party has demonstrated a need for discovery that is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted.

However, a party moving for Rule 56(d) discovery must show how additional discovery would preclude summary judgment and why it cannot immediately provide “specific facts” demonstrating a genuine dispute of material fact. *Opryland*, 23 USPQ2d at 1475; Rule 56(d). In particular, the moving party must “state with some precision the materials he hope[s] to obtain with further discovery, and exactly how he expect[s] those materials would help him in opposing summary judgment.” *Simmons Oil Corp. v. Tesoro Petroleum Corp.*, 86 F.3d 1138, 1144 (Fed. Cir. 1996). Thus, the party requesting Rule 56(d) discovery must identify by affidavit or declaration the specific facts that further discovery would reveal, and explain why those facts would preclude summary judgment. *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (“The Rule requires that each request for discovery be adequately supported by a showing of need.”). Failure to comply with the requirements of Rule 56(d) is a proper ground for denying discovery and proceeding to summary judgment. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (“A party may not simply assert in its brief that discovery was necessary and thereby overturn summary judgment when it failed to comply with the requirement of Rule 56[d] to set out reasons for the need for discovery in an affidavit.” (citations omitted)); *see also*

*Burlington Coat Factory Warehouse Corp. v. Esprit De Corp.*, 769 F.2d 919, 926 (2d Cir. 1985) (movant must show what facts are sought and how they are reasonably expected to create a genuine issue of material fact) (cited in *Keebler*, 9 USPQ2d at 1739 n.5).

Additionally, when a request for discovery under Rule 56(d) is granted by the Board, the discovery allowed is limited to that which the nonmoving party shows is essential in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

## **B. Board's Analysis and Order**

### **1. Applicant's Motion for Summary Judgment**

Applicant seeks summary judgment on Opposer's claims of likelihood of confusion and dilution by blurring. 6 TTABVue. In support of its motion for summary judgment, Applicant submitted USPTO TSDR<sup>1</sup> database printouts of third-party registrations for trademarks that include the term "NATURE'S" for identical goods in International Classes 5 and 30,<sup>2</sup> and additional evidence of third-party trademark

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<sup>1</sup> Trademark Status Document Retrieval.

<sup>2</sup> Third-party registrations may be used to show the conceptual weakness of a term. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) ("Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.") (quoting 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR

registrations containing the word “NATURE’S” for other food items in International Classes 29 and 30.<sup>3</sup>

With respect to the likelihood of confusion claim, Applicant’s motion focuses primarily on the first *du Pont* factor,<sup>4</sup> that is, the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression. 6 TTABVUE 14-15.

Regarding the dilution claim, Applicant likewise focuses on the alleged dissimilar appearance of the parties’ marks. However, citing to *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1298-1300 (TTAB 2016), Applicant also argues that not all dilution factors mentioned in Section 43(c)(2)(B) of the Trademark

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COMPETITION § 11:90 (4th ed. 2015)); *see also In re i.am.symbolic*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (active third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (“[E]vidence of third-party registrations is relevant to ‘show the sense in which a mark is used in ordinary parlance,’ ... that is, some segment that is common to both parties’ marks may have ‘a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.’”) (quoting *Juice Generation*, 115 USPQ2d at 1674).

<sup>3</sup> Applicant also made of record dictionary definition evidence as to the definitions of “bakery,” “baked good,” “nature,” and “find,” as well as a single news article regarding Applicant’s products. 6 TTABVUE 603-644.

<sup>4</sup> A likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (*du Pont*); *see also In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *du Pont* relevant factor for which there is evidence and argument). Two key considerations are the similarities between the marks and the similarities between the goods and services. *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

Act, 15 U.S.C. § 1125(c)(2)(B),<sup>5</sup> must be shown for the Board to determine that Applicant's use of its mark is not likely to cause dilution. 6 TTABVue at 21-22. Specifically, Applicant focuses on only four of the factors set forth in Section 43(c)(2)(B). In particular, with respect to the alleged similarity between the parties' marks, Applicant argues there is no genuine dispute that the second term in its mark, FYND, is completely different from the second term in Opposer's marks and, therefore, the marks are not "essentially the same" and evoke totally different commercial impressions. *Id.* at 22. Applicant also asserts there is no genuine dispute that Opposer does not engage in substantially exclusive use of the term NATURE'S, *id.* at 22-23; there is no evidence of record showing that Applicant intended to create an association with Opposer's pleaded marks, *id.*; and there is no evidence of actual association between the parties' marks. *Id.* at 24.

In sum, even though Applicant argues there is no evidence of record showing that it intended to create an association with Opposer's pleaded marks; and there is no evidence of actual association between the parties' marks, Applicant relies primarily on the alleged differences between the parties' marks and the commonplace presence of the term "NATURE'S" in registered marks to establish that there is no genuine

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<sup>5</sup> In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider the following non-exhaustive list of six factors: (i) The degree of similarity between the mark or trade name and the famous mark; (ii) The degree of inherent or acquired distinctiveness of the famous mark; (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (iv) The degree of recognition of the famous mark; (v) Whether the user of the mark or trade name intended to create an association with the famous mark; (vi) Any actual association between the mark or trade name and the famous mark. 15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

dispute as to any material fact and that it is entitled to judgment on both Opposer's claims.

## **2. Opposer's Requests and Declaration**

Notwithstanding the narrow focus of Applicant's motion for summary judgment, Opposer requests in its motion for discovery that the Board deny Applicant's motion for summary judgment, or defer consideration of the motion until after Opposer "has had a full and fair opportunity to obtain discovery on the schedule ordered by the Board." 8 TTABVUE 3.

Specifically, Opposer asserts that it requires a wide range of discovery in order to respond to Applicant's motion for summary judgment because "critical evidence regarding at least 9 of the 13 *Du Pont* [*sic*] factors is predominantly in the possession of Applicant." *Id.* at 5, 13. Therefore, argues Opposer, it lacks access to evidence on:

(1) the manner in which Applicant intends to use the applied-for mark on the bar products;

(2) the nature of the bar products that Applicant intends to market under the applied-for mark;

(3) trade channels;

(4) the conditions of sale, including anticipated pricing of Applicant's products sold under the applied-for mark;

(5) actual use of the trademarks submitted with Applicant's evidence;

(6) actual confusion;

(7) the extent, nature, and history of Applicant’s actual use in commerce of the applied-for mark for purposes of evaluating “concurrent use”;

(8) the variety of goods on which Applicant uses or intends to use the applied-for mark; and

(9) how Applicant conceived of the applied-for mark, including its knowledge of Opposer’s marks. 8 TTABVUE 8-9.

In support of the motion for Rule 56(d) discovery, Opposer submitted the declaration of Vilma Livas, Opposer’s Chief Marketing Officer. *Id.* at 17-21. In Ms. Livas’ declaration, she reiterates, “there is virtually no information publicly available about Nature’s Fynd’s intended use of its ‘NATURE’S FYND’ trademark” in connection with the bar products that are the subject of this opposition, *id.* at 18; and she also indicates that Opposer does not possess or maintain information or documents on the 9 *du Pont* factors mentioned in its motion (see *supra*). See Livas dec. ¶¶ 5-13, 8 TTABVUE 18-19. In addition, Ms. Livas avers that Opposer does not possess or maintain detailed information on:

(10) how Applicant will use its applied-for mark in the marketplace and what commercial impression it will create; or

(11) how and whether third parties use the trademarks identified in Applicant’s Motion for Summary Judgment. Livas dec. ¶¶ 14-15, *Id.* at 19-20.

Ms. Livas also lists specific documents Opposer believes it will find, namely, communications regarding Applicant’s creation, selection and adoption of the “NATURE’S FYND” mark, business plans, product plans, sales and marketing



documents, branding documents, communications with third parties such as design, marketing, and advertising agencies, product packaging mock-ups, specifications, and designs, communications with distributors and retailers with respect to marketing channels, consumer qualitative and quantitative research, market research and analysis, pricing strategy documents, and consumer inquiries and communications relevant to consumer confusion. *Livas dec.* ¶ 16, 8 TTABVUE 20.<sup>6</sup>

### 3. Order

Applicant seeks summary judgment on Opposer's claim of likelihood of confusion based on a single *du Pont* factor, namely, the lack of similarity of the marks. 6 TTABVUE 12-19. Similarly, regarding Opposer's dilution claim, Applicant emphasizes that summary judgment should be granted because the marks are insufficiently similar because the common term in the parties' marks is commonplace for the parties' identified goods. *Id.* at 22-23. Applicant also argues that there is no genuine dispute as to three other dilution factors. *Id.* at 22-24. Nonetheless, Opposer argues that it requires a broad range of discovery, including the eleven topics listed above, to "test Applicant's contentions regarding [the mark's] commercial impression in discovery." 8 TTABVUE 12.

The Board finds that Opposer has failed to state with requisite precision the particular evidence it needs to oppose Applicant's motion for summary judgment. *See Simmons Oil Corp.*, 86 F.3d at 1144. In particular, rather than identifying in its

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<sup>6</sup> For completeness, the Board notes that in paragraph 17 of Ms. Livas' declaration, 8 TTABVUE 20-21, she lists 10 topics regarding which Applicant states it has either witnesses or documents. The topics are virtually identical to the identified *du Pont* factors on which Ms. Livas states Opposer has no evidence.

declaration the specific facts that further discovery would reveal and why those facts are necessary “to rebut the movant’s showing of the absence of a genuine issue of fact,” *see id.* (internal citation omitted), Opposer has submitted a list of eleven general topics of discovery along with a long list of documents, without explaining why those facts or documents are essential to preclude summary judgment. *See Keebler*, 9 USPQ2d at 1739. In effect, Opposer relies entirely on its having had no discovery at all and seeks broad and unfocused discovery without demonstrating the need for particular discovery that will raise a genuine issue of material fact in relation to Applicant’s motion for summary judgment. Opposer “may not simply rely on vague assertions that additional discovery will produce needed, but unspecified, facts.” *Keebler*, 9 USPQ2d at 1739 n.5 (internal citation omitted).

In particular, Opposer does not explain how any of the 11 topics of discovery it seeks will create an issue of material fact in responding to Applicant’s motion for summary judgment, which is primarily focused on the alleged lack of similarity of the parties’ marks. *See Keebler*, 9 USPQ2d at 1739 n.5 (citing *Burlington Coat Factory Warehouse Corp.* 769 F.2d at 926 (movant must show what facts are sought and how they are reasonably expected to create a genuine issue of material fact)). Simply arguing that Applicant is “withholding entire categories of relevant documents and information that are necessary to allow [Opposer] to test these claims,” 8 TTABVue 11, does not meet Opposer’s burden under Fed. R. Civ. P. 56(d) to establish its specific need for discovery to respond to Applicant’s motion for summary judgment. Further, the Board is not required “to visualize what might have been said in the affidavits [or

declarations] required by Rule 56[d].” *Keebler*, 9 USPQ2d at 1738. Opposer simply cannot rely on vague assertions that discovery will produce needed but unspecified facts. *See Keebler*, 9 USPQ2d at 1739 n.5.<sup>7</sup>

Moreover, it is well established that discovery is not necessary in order to adequately compare the marks and determine on summary judgment that there is no genuine issue of material fact with respect to the appearance of the marks. *See Keebler*, 9 USPQ2d at 1739 (affirming denial of Rule 56(f) motion for discovery where the request was not supported with adequate specificity and affirming summary judgment against likelihood of confusion claim where the Board was found to have compared the marks in their entirety and concluded that the marks did not convey a similar commercial impression); *Kellogg Co. v. Pack’Em Enters.*, 951 F.2d 330, 21 USPQ2d 1142, 1144 (Fed. Cir. 1991) (“The Board justifiably held that the substantial and undisputed differences in ‘appearance, sound, connotation and commercial impression’ between the marks in this case warranted the grant of summary

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<sup>7</sup> Opposer cites *Dunkin’ Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988) for the proposition that the Board cannot determine that one factor in the likelihood of confusion analysis outweighs all the others without considering the evidence required to assess the additional factors. 8 TTABVue 13. Opposer’s reliance on this case is misplaced because Opposer has failed to comply with Rule 56 and relevant cases, which require the movant to explain the specific facts discovery would reveal and why those facts would preclude summary judgment on Applicant’s motion. *See Keebler*, 9 USPQ2d at 1740 (“[T]he Rule requires that each request for discovery be adequately supported by a showing of need.”). As noted in *Opryland USA Inc.*, another case relied upon by Opposer, a party seeking discovery must “state more than a mere speculative hope of finding evidence that might tend to support a claim.” *Opryland USA Inc.*, 23 USPQ2d at 1475.

judgment that there was ‘no likelihood that [the marks] contemporaneous use by different parties will result in confusion.’”).<sup>8</sup>

Accordingly, in view of the foregoing, Opposer’s motion for Rule 56(d) discovery is **DENIED**.

### **III. Response to Motion for Summary Judgment Due**

In view of the foregoing order denying Opposer’s motion for Rule 56(d) discovery, Opposer’s response to Applicant’s motion for summary judgment is due. Opposer is allowed until **THIRTY (30) DAYS** from the mailing date of this order to submit its response. Applicant may file a reply brief, should it wish to do so, in accordance with Trademark Rule 2.127(e)(1). This proceeding remains **SUSPENDED** pending the Board’s consideration of Applicant’s motion for summary judgment.



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<sup>8</sup> In addition, with respect to Opposer’s request for discovery on how and whether third parties use the trademarks identified in Applicant’s motion, not only has Opposer failed to explain why it needs such information in order to respond to the issues set forth in Applicant’s motion, Applicant is only required to provide such information to the extent that it has actual knowledge thereof. *See Sheetz of Delaware, Inc. v. Doctor’s Associates Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013) (a party need not investigate third-party use to respond to discovery requests); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011) (a party has no duty to conduct an investigation of third-party uses in response to discovery requests); *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses); *see also* TBMP § 414(9).