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

Proceeding	91267373
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF APPLICATION SERIAL NO.: 88/812,151

MARK: NATURE'S FYND

PUBLISHED IN THE OFFICIAL GAZETTE ON: December 8, 2020

Nature's Bakery, LLC
Opposer,

v.

The Fynder Group, Inc.
Applicant.

OPPOSITION NO. 91267373

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR FED. R. CIV. P. 56(d)
DISCOVERY TO RESPOND TO SUMMARY JUDGMENT MOTION**

Applicant The Fynder Group, Inc. ("Applicant") hereby submits its Response to Opposer Nature's Bakery, LLC's ("Opposer") Motion for Discovery to Respond to Summary Judgment Motion Pursuant to Fed. R. Civ. P. 56(d) (TTABVUE 8, the "Rule 56(d) Motion"). Applicant requests the U.S. Patent and Trademark Office Trademark Trial and Appeal Board ("TTAB" or "Board") deny Opposer's Rule 56(d) Motion on the basis that Opposer's request does not demonstrate a need for discovery to oppose Applicant's Motion for Summary Judgment.

I. BACKGROUND

Applicant filed Application Serial No. 88/812,151 for "Nature's Fynd" (the "Application") on February 26, 2020. (TTABVUE 1 ("Notice of Opposition"), ¶ 11.) On January 31, 2021, Opposer filed the Notice of Opposition. In the Notice of Opposition, Opposer identified two bases for its opposition: (1) Likelihood of Confusion (Notice of Opposition, ¶¶ 13-18) and (2) Likelihood of Dilution (*Id.*, ¶¶ 19-23). For both bases, Opposer relied on U.S. Reg. No. 3917078 for NATURE'S BAKERY & Design; U.S. Reg. No. 3917217 for NATURE'S BAKERY, and U.S.

Reg. No. 5874205 for NATURE’S BAKERY & Design, which Opposer collectively refers to as the “NATURE’S BAKERY Marks.” (*Id.*, ¶ 1.)

In the Notice of Opposition, Opposer argued that “[t]he NATURE’S FYND mark is likely to be confused with the Opposer’s NATURE’S BAKERY Marks because it is confusingly similar in appearance, sound, and meaning to Opposer’s NATURE’S BAKERY Marks, and conveys a confusingly similar commercial impression.” (*Id.*, ¶ 16.) Opposer also argued that “[c]ertain goods identified in the Application, namely, ‘Protein supplements formed and packaged as bars; protein supplements; protein dietary supplements formed and packaged as bars (in International Class 5)’, are closely related to, and travel through the same channels of trade as the goods sold under Opposer’s NATURE’S BAKERY Marks.” (*Id.*, ¶ 17.) The Notice of Opposition did not address any other goods or services identified in the Application.¹

On May 5, 2021, Applicant filed a Motion for Summary Judgment (TTABVUE 6, hereinafter the “MSJ”). In addition to the Application and the NATURE’S BAKERY Marks, the MSJ relies on three sets of undisputed facts. First, the MSJ identifies fifteen registrations containing the word “NATURE’S” covering protein supplements and/or protein supplements in the form of bars. (MSJ, pp. 3-5.) Second, the MSJ identifies nineteen registrations containing the word “NATURE’S” covering baked goods, cereal based foods and/or cookies in Classes 29 and 30. (*Id.*, pp. 6-9.) Third, the MSJ identifies one hundred and three registrations containing the word “NATURE’S” covering other food products in Classes 29 and 30. (*Id.*, pp. 9-10.)

¹ An opposition must identify the specific goods and/or services in the application that are being opposed. (*See* TBMP § 309.02(a).) Because Opposer is not opposing the remaining goods and services, Applicant filed a Motion to Divide on February 11, 2021. (TTABVUE 4). Opposer did not file a response to the Motion to Divide. The Motion to Divide is currently pending before the Board.

Based on these undisputed facts, the MSJ argues that there is no genuine issue of material fact that the word “NATURE’S” is entitled to only a very narrow scope of protection such that differences in the remainder of the marks may be sufficient to avoid confusion. (*Id.*, p. 15.) The MSJ further argues that the differences between Applicant’s NATURE’S FYND mark and the NATURE’S BAKERY Marks as to appearance, sound, connotation, and commercial impression are dispositive and warrant a finding of summary judgment in favor of Applicant. (*Id.*, p. 16.) Similar arguments were presented in connection with Opposer’s dilution claim. (*See generally id.*, pp. 19-24.)

On June 4, 2021, Opposer filed the Rule 56(d) Motion. In the Rule 56(d) Motion, Opposer argued that it needs discovery to respond to the MSJ because “[t]he vast majority of relevant evidence regarding Applicant’s planned use of the NATURE’S FYND mark and the resulting likelihood of confusion is in the possession of Applicant.” (Rule 56(d) Motion, p. 6.)

II. STANDARD OF DISCOVERY UNDER RULE 56(d)

A party served with a motion for summary judgment that believes it cannot effectively oppose that motion without first taking discovery may file a request with the Board for the time needed to take discovery pursuant to Fed. R. Civ. P. 56(d). (TBMP § 528.06.) The nonmoving party must support such a request by an affidavit or declaration showing that it cannot, for the reasons specified therein, present facts essential to support its opposition to the motion for summary judgment. (*Id.*)

“[T]he burden is on the party seeking additional discovery to proffer sufficient facts to show that the evidence sought exists, and that it would prevent summary judgment.” *Webzero, LLC v. ClicVU, Inc.*, 392 F. App’x 863, 868 (Fed. Cir. 2020) (affirming rejection of request under Rule 56(d) where nonmoving party failed to describe the “particular evidence that WebZero

expected to obtain from further discovery or how that evidence would preclude summary judgment”). Accordingly, a motion pursuant to Rule 56(d) must state with specificity the reasons why discovery is needed, without which Opposer would be unable to present essential facts to oppose the motion for summary judgment. *Anand K. Chavakula v. Praise Broadcasting AKA Praise FM*, Cancellation No. 92071482, 2020 TTAB LEXIS 264, at *4 (TTAB July 28, 2020). “The request for discovery should set forth with specificity the areas of inquiry needed to obtain the information necessary to enable the party to respond to the motion for summary judgment.” *Id.* (citing *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) and TBMP § 528.06).

The party seeking discovery also bears the burden of setting forth sufficient facts to show that necessary evidence to oppose the motion for summary judgment exists. *Volk v. D.A. Davidson & Co.*, 816 F.2d 1406, 1416 (9th Cir. 1987). The party seeking discovery may not base its request on mere speculation but must set forth sufficient facts to establish that such necessary evidence could be offered at trial. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 23 USPQ2d 1471, 1475 (Fed. Cir. 1992); *see also Sweats Fashions*, 4 USPQ2d at 1795-96.

II. ARGUMENT

In the MSJ, Applicant contends that the differences between the marks in these proceedings are dispositive and requests summary judgment based on that single *du Pont* factor. In response, Opposer identifies expansive discovery it alleges is needed to respond to the MSJ based on the belief that all *du Pont* factors must be considered before summary judgment can be granted. But this argument has been squarely rejected by controlling authority from the Federal Circuit.

Even in the few instances in which Opposer attempts to connect its requested discovery to the issues raised in the MSJ, Opposer’s arguments are unavailing. Opposer fails to identify any

specific facts that it is seeking in discovery, fails to explain a plausible basis for believing those facts exist, and fails to explain *how* any specific facts would preclude summary judgment. Opposer essentially requests permission to conduct a fishing expedition, which is not the purpose of Rule 56(d). Even ignoring those issues, the broad categories of evidence for which Opposer seeks discovery are otherwise problematic. In some cases, for example, the requested evidence is irrelevant not only to the MSJ but also to these proceedings as a whole. In other cases, the requested evidence is publicly available such that no discovery is needed. And even if Opposer could overcome these issues, the submitted affidavit is insufficient to support Opposer's request.

Opposer has failed to meet its burden and the Rule 56(d) Motion should therefore be denied.

A. Opposer Does Not Even Attempt to Tie Most of Its Discovery Requests to the Issues Raised in the MSJ

Opposer acknowledges that the MSJ “asserts that the[sic] summary judgment is warranted based solely on the supposed differences between the marks and the alleged third-party trademark registrations.” (Rule 56(d) Motion, pp. 9-10.) But Opposer contends that “[t]he Board cannot determine that one factor outweighs all the others without considering the evidence required to assess them.” (Rule 56(d) Motion, p. 11.) Because Opposer is mistaken about this contention, most of the discovery it allegedly needs is irrelevant.

Rule 56(d) requires the nonmovant to show that “it cannot present facts *essential* to justify its opposition.” (emphasis added). “A nonmoving party’s Rule 56(d) request for additional discovery is properly denied ‘where the additional evidence sought for discovery would not have by itself created a genuine issue of material fact sufficient to defeat summary judgment.’” *Kiddie Acad. Domestic Franchising, LLC v. Wonder World Learning, LLC*, No. ELH-17-3420, 2020 U.S. Dist. LEXIS 132931, at *49 (D. Md. July 27, 2020) (quoting *Strag v. Bd. Of Trs., Craven Cmty.*

Coll., 55 F.3d 943, 954 (4th Cir. 1995)).

Applicant's MSJ asserts that the issue of likelihood of confusion between Applicant's "NATURE'S FYND" mark and Opposer's NATURE'S BAKERY Marks can be decided on the basis of a single *du Pont* factor: the marks at issue are different in appearance, sound, connotation and commercial impression. "In certain cases, the Board may find that a single *du Pont* factor is dispositive of likelihood of confusion." *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Opposer disagrees and argues that "[t]he Board cannot determine that one factor outweighs all the others without considering the evidence required to assess them." (Rule 56(d) Motion, p. 11.) Unfortunately for Opposer, the Federal Circuit has directly rejected this argument on several occasions. In a particularly relevant example, the Board granted summary judgment to an applicant because "the applied-for mark was so dissimilar to [opposer's] pleaded marks that no likelihood of confusion could exist as a matter of law." *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1345 (Fed. Cir. 2010). The opposer in that case argued on appeal that the Board "erred in basing its decision on the dissimilarity of the marks alone and not giving appropriate consideration to the other factors constituting the test of likelihood of confusion." *Id.* at 1346. The Federal Circuit disagreed:

[A] single *du Pont* factor "may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998). Therefore, even if all other relevant *du Pont* factors were considered in Odom's favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely.

Odom's Tenn. Pride Sausage, 600 F.3d at 1346-47.² Opposer's argument is therefore precluded by settled and controlling law.

Opposer admits that its discovery requests pertain to "at least 9 of the 13 *du Pont* factors."³ (Rule 56(d) Motion, p. 7.) Opposer does not even try to argue that most of the requested discovery relates to the single *du Pont* factor at issue in the MSJ, because its discovery requests do not relate to the single *du Pont* factor of differences in the marks. Opposer has therefore failed to meet its burden to show that such discovery would raise genuine issues of material fact sufficient to defeat the MSJ filed here.

B. Opposer's Attempts to Explain Why Certain Information is Essential to the MSJ Are Unavailing

In the few instances in which Opposer attempts to explain why its requested discovery is essential to its opposition to the MSJ, Opposer's arguments are legally incorrect, factually unsupported, or both.

1. Opposer Fails to Identify Specific Facts That Would Raise a Genuine Issue of Material Fact

As a preliminary matter, Opposer's arguments all suffer from the same flaw: they fail to identify the *specific* facts that Opposer *expects to be able to establish* which would raise a genuine issue of material fact. Opposer has identified certain categories of information on which it would

²To support its arguments, Opposer cites the *Dunkin Donuts* and *Opryland* decisions. (Rule 56(d) Motion, p. 11.) While the *Odom's Tenn. Pride Sausage* case addresses the exact same question presented here, the two cases cited by Opposer appear to address very different factual scenarios. Even if they did not, the later decision in *Odom's Tenn. Pride Sausage* that addresses the exact question at issue here would control over the earlier decision cited by Opposer.

³Applicant acknowledges that if the MSJ is denied *on its merits*, other factors may come into play. But these factors are irrelevant to whether the MSJ based on a single factor claimed to be dispositive should be granted or denied, and thus discovery related to these other factors is not essential to Opposer's opposition to the MSJ.

like to conduct discovery. This is not enough:

[The party requesting additional discovery] may not simply rely on vague assertions that additional discovery will produce needed, but unspecified, facts. The rule does not require clairvoyance on the part of the moving party, but the movant is required to state with some precision the materials he hopes to obtain with further discovery, and exactly how he expects those materials would help him in opposing summary judgment. It is not enough simply to assert, a la Wilkins Micawber, that “something will turn up.”

Simmons Oil Corp. v. Tesoro Petroleum Corp., 86 F.3d 1138, 1144 (Fed. Cir. 1996) (internal quotations and citations omitted). In addition to identifying specific facts, the moving party must also “set forth a plausible basis for believing that specified facts . . . probably exist.” *Accent Packaging, Inc. v. Leggett & Platt, Inc.*, 707 F.3d 1318, 1328 (Fed. Cir. 2013).

Here, however, Opposer has neither identified specific facts nor set forth a plausible basis for believing that such facts exist. Instead, Opposer has only vaguely identified areas of discovery it would like to pursue.

For example, Opposer claims that it needs discovery related to third-party uses of similar marks. (Rule 56(d) Motion, p. 10.) However, Opposer fails to identify (1) the specific facts related to such third-party usage that would support its opposition or (2) any plausible basis for believing such specific facts exist. As another example, Opposer claims that it needs discovery related to Applicant’s creation, selection, and adoption of the NATURE’S FYND mark. (Rule 56(d) Motion, p. 11.) Again, Opposer fails to (1) identify the specific facts related to this area that would support its opposition or (2) identify any plausible basis for believing such specific facts exist. At best, Opposer’s contention is that discovery on these broad topics “*could* elicit facts that *could* create an issue of material fact.” *Burke v. Prof’l Transp., Inc.*, No. C18-0081JLR, 2018 U.S. Dist. LEXIS 198748, at *10 (W.D. Wash. Nov. 21, 2018). Such pure speculation is not enough for Opposer to

meet its burden.⁴

2. Third-Party Registrations

Turning to the substance of the argument, Opposer first appears to contend that it is entitled to seek discovery of evidence of actual third-party uses of similar marks because the mere existence of third-party registrations is not probative of the strength of a mark. (Rule 56(d) Motion, p. 10.) This argument has several flaws.

First, Opposer is incorrect about the relevance of the third-party registrations. “[A]ctive 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.” TMEP § 1207.01(d)(iii); *see also 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.”); *Promark Brands Inc. & H.J. Heinz Co. v. Gfa Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015) (“[T]hird-party registrations and uses are

⁴ Opposer continually complains that it has not yet had the chance to seek discovery. But these proceedings are not intended to allow an opposer to seek discovery on whether it actually has a case *in the first instance*. Opposer was required to have a Rule 11 basis for alleging a likelihood of confusion in its Notice of Opposition. Fed. R. Civ. P. 11; *see also* TBMP § 527.02. This would require Opposer to have a factual basis for contending that the marks are sufficiently similar to believe there was a likelihood of confusion. Therefore, even if Opposer has not conducted discovery on those facts, it should be well aware of the facts it relied upon - on information and belief or otherwise - that would justify its filing of the Notice of Opposition. All that Opposer needed to do in its Rule 56(d) Motion was identify with specificity (1) the facts on which it relied in filing the Notice of Opposition and (2) the discovery it needs to confirm those specific facts. It did neither. Either Opposer already has the facts on which it relied and no longer believes those facts are sufficient to show a likelihood of confusion in view of the arguments in the MSJ or Opposer never had a reasonable basis for filing the Notice of Opposition in the first place. In either case, summary judgment is appropriate.

competent to show that the common term has an accepted meaning in a given field and that marks containing the term have been registered and used for related goods because the remaining portions of the marks may be sufficient to distinguish the marks as a whole.”). Applicant relies on the third-party registrations precisely for this purpose, *i.e.*, to show that the term “NATURE’S” is so commonly used that the public will look to other elements to distinguish the source of the goods or services. (MSJ, p. 15 (“The third party registration information attached hereto establishes that the word ‘NATURE’S’ is commonly registered and used not only in the food industry in general, but also the more narrow industries of baked goods, cereal based goods, cookies, bars and protein supplements.”).)⁵ Opposer fails to explain how any evidence related to actual third-party use would raise a genuine issue of material fact that would support its opposition to the MSJ.

But even if Opposer were correct, this argument would still fail because Opposer does not explain why it cannot present facts essential to its opposition without its requested discovery. The relevant evidence is “actual third-party uses of similar marks.” (Rule 56(d) Motion, p. 10.) That is, Opposer claims its needs discovery to obtain information about use of third-party marks *in the marketplace*. Rule 56(d) motions are routinely denied where the requested discovery is publicly available and therefore additional discovery would not reveal additional material facts. *See, e.g., King v. Burlington N. & Santa Fe Ry.*, 538 F.3d 814, 819 (7th Cir. 2008); *Sage Realty Corp. v. Insurance Co. of N. Am.*, 34 F.3d 124, 128 (2d Cir. 1994).

Accordingly, Opposer has failed to establish that it needs additional discovery regarding

⁵ Moreover, to the extent Opposer believes evidence of use is required, the identified registrations include such evidence. (*See* MSJ, p. 14 (noting that many of the registrations were not registered based on Sections 44(e) or 66(a) and, even if they were, a Declaration of Use has been filed to maintain the registration).) Opposer again fails to provide any plausible basis for believing that further discovery would contradict this evidence.

third-party use of similar marks to obtain information sufficient to raise a genuine issue of material fact that would preclude summary judgment.

3. Opposer Fails to Identify Specific, Relevant Facts That Would Support Its Presumed Argument That the Marks are Similar in “Appearance, Sound, Connotation, and Commercial Impression”

Opposer next contends that it needs additional discovery to respond to Applicant’s arguments regarding the differences in “appearance, sound, connotation, and commercial impression.” (Rule 56(d) Motion, p. 10.) But Opposer’s contentions are unavailing here as well.

First, Opposer claims that it has “no way of knowing how Applicant plans to use its trademark.” (*Id.*) Opposer fails to describe *why* this would be essential to its opposition to the MSJ. This is likely because any argument based on Applicant’s intent would be futile. For example, Opposer has suggested it needs discovery on “[t]he nature of the bar products that Applicant intends to market under the ‘NATURE’S FYND’ trademark.” (*Id.*, p. 7.) But the Federal Circuit has specifically rejected the argument that the Board should focus on the goods sold in the marketplace because “the Board must look to the registrations themselves to determine the scope of goods covered by the contested mark.” *See, e.g., Cunningham v. Laser Golf*, 222 F.3d 943, 950 (Fed. Cir. 2000). Similarly, although Opposer contends it requires discovery on “[t]he manner in which Applicant intends to use the ‘NATURE’S FYND’ trademark on its bar products” (Rule 56(d) Motion, p. 7), the Federal Circuit has again found that such evidence is irrelevant because “such [trade] dress might well be changed at any time; only the word mark itself is to be registered.” *Kimberly-Clark Corp. v. H. Douglas Enters.*, 774 F.2d 1144, 1147 (Fed. Cir. 1985). The question here is registrability, not Applicant’s intended use.

Opposer also contends it has “no way of knowing . . . the way in which Applicant intends the name to be pronounced.” (Rule 56(d) Motion, pp. 10-11.) But again, Opposer never explains

why the pronunciation is relevant to the issues in the MSJ. Why would it matter whether “FYND” is pronounced as “find” or, for example, “finned”?⁶ Presumably Opposer is not taking the position that it needs discovery to determine whether “FYND” is pronounced as “bakery.”⁷

Finally, Opposer contends that it “has no way of knowing . . . the connotation that Applicant seeks to invoke through such use.” (Rule 56(d) Motion, p. 11.) Although this argument is somewhat undercut by its subsequent statement that Applicant did identify the connotation and commercial impression it intended to create through such use (*id.*), it is in any case irrelevant to Opposer’s request for discovery for at least two reasons.

First, Opposer does not identify the facts it could find that are *essential* to its opposition.⁸ At best, Opposer contends that it would like to search for some unknown facts that it could use to create an undisclosed (and perhaps unknown) argument⁹ about the similarities in connotations between NATURE’S BAKERY and NATURE’S FYND, notwithstanding the significant number of third-party registrations that contain the word “NATURE’S” for similar goods and services. Essentially, Opposer seeks permission to go on a fishing expedition.

Second, the only specific discovery sought by Opposer on this issue relates to “Applicant’s creation, selection and adoption of the NATURE’S FYND mark.” (Rule 56(d) Motion, p. 11.) But again, Opposer fails to connect this evidence to the issues in the MSJ. Notably, these issues

⁶ In any case, Opposer has not alleged a plausible basis for believing that “FYND” is not pronounced as “find.” *See* MSJ, p. 17 (noting that “FYND” is a play on the word “find”).

⁷ Notably, Opposer did not require any discovery before alleging in the Notice of Opposition that the marks were confusingly similar in sound. (Notice of Opposition, ¶ 17.)

⁸ This failure is particularly notable because Opposer contended in the Notice of Opposition – without the benefit of any discovery – that the marks “convey[] a confusingly similar commercial impression.” (Notice of Opposition, ¶ 17.)

⁹ It is Opposer’s burden to show that there is a likelihood of confusion, so it is Opposer’s obligation to set forth an argument that the marks have similar connotations if that is Opposer’s contention.

“must be viewed through the eyes of a consumer.” *Hana Fin., Inc v. Hana Bank*, 574 U.S. 418, 422 (2015). Even if discovery would reveal unknown information about Applicant’s intended connotation or commercial impression of the mark,¹⁰ those intentions would be irrelevant if the connotation or commercial impression would not be recognized by the consumer. *See, e.g., Combe, Inc. v. August Wolff GmbH & Co. KG Arzneimittel*, 382 F. Supp. 3d 429, 457 (E.D. Va. 2019) (rejecting the argument that use of -san suffix, meaning health in Latin, would connote “health” to distinguish Vagisan over Vagisil because “it is doubtful whether the additional intended connotation of VAGISAN, *i.e.*, health, would be recognized by consumers given the average consumer’s lack of Latin fluency and in light of what is clearly the dominant connotation of both marks: the vaginal area of a woman’s body”). If Opposer is unable to identify a connotation that would give rise to a genuine issue of material fact *without* Applicant’s internal documents, any intended connotation or commercial impression contained therein would not be relevant to Opposer’s opposition because that information would not be available to consumers either.

For these reasons, Opposer has also failed to meet its burden to show it requires discovery related to the dissimilarity in the “appearance, sound, connotation, and commercial impression” between the marks at issue.

4. **Opposer’s Request for Discovery on the Dilution Claims Also Fail**

Just as one factor may be dispositive in the determination of likelihood of confusion, not all six enumerated factors in 15 U.S.C. § 1125(c)(B)(i)-(vi) must weigh in Applicant’s favor in the determination of dilution. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118

¹⁰ Applicant noted its intended connotation and commercial impression in the MSJ. (*See* MSJ, pp. 17-18.) Opposer has again failed to set forth a plausible basis for believing it would uncover any unknown information through discovery.

USPQ2d 1289, 1298-1300 (TTAB 2016), in which the Board determined that factors (i), (v) and (vi) outweigh the remaining three dilution factors and the applicant's marks are not likely to dilute the opposer's OMEGA marks. In this case, Applicant contends that factors (i), (iii), (v), and (vi) weigh in favor of a finding of no dilution and outweigh factors (ii) and (iv) based on the undisputed facts. Opposer fails to meet its burden to show that it needs discovery to present facts essential to its opposition as required under Rule 56(d).

With respect to factor (i), the degree of similarity between the marks, Opposer contends that "Applicant is uniquely in possession of information regarding the intended appearance of its NATURE'S FYND mark as it is used in commerce in connection with bar products." (Rule 56(d) Motion, p. 12.) However, the intended appearance is irrelevant to whether *registration* of a word mark will result in dilution. *Accord. Combe*, 382 F. Supp. 3d at 456 ("[W]hen registrability is the only issue in a case, the actual use or appearance of the marks in the marketplace is irrelevant, and it is the marks as shown in the registration applications which must be considered."). Indeed, as discussed above, Opposer has identified no facts essential to its opposition on this issue on which it needs discovery.

With respect to factor (iii), the exclusivity of the senior user's use, Opposer contends that "Applicant has declined to produce any of the supposed information of actual third-party uses to which it alludes, as detailed above." (Rule 56(d) Motion, pp. 12-13.) But Applicant has identified evidence (from the registrations) that support its argument (*supra*, n.5), and Opposer has again failed to identify any plausible basis to believe that any specific facts that may support its opposition are likely to exist. Moreover, Opposer also fails to explain why it cannot obtain this publicly available evidence without discovery.

With respect to factor (vi), actual confusion, Opposer contends that "Applicant has sought

to frustrate discovery regarding information uniquely in its possession with respect to consumer confusion engendered by its use of the mark.” (Rule 56(d) Motion, p. 13.) Importantly, Opposer fails to identify any basis for believing Applicant has any such evidence, suggesting that this is a pure fishing expedition. Indeed, Opposer elsewhere claims that “there is virtually no information publicly available about Nature’s Fynd’s intended use of its ‘NATURE’S FYND’ trademark, especially in connection with the bar products it intends to launch and that are the subject of Nature’s Bakery’s opposition.” (*Id.* p. 18.) Given these facts as alleged by Opposer, it is unclear how Opposer contends that any consumer confusion could have occurred.

Finally, with respect to factor (v), whether Applicant intended to create an association with Nature’s Bakery’s mark, Opposer faults Applicant for filing the MSJ at the beginning of discovery. (*Id.*, p. 13.) But Opposer fails to point to any plausible basis for believing that there might be evidence that Applicant intended to create an association with Opposer’s marks. Opposer admits it has no direct evidence on this issue, and this is not a case where any intent may be inferred. Compare *Miss Universe, L.P., LLLP v. Villegas*, 672 F. Supp. 2d 575, 595 (S.D.N.Y. 2009) (finding the marks “Miss USA” and Miss Asia USA” not so similar as to warrant the inference that association is likely) with *George Nelson Found. v. Modernica, Inc.*, 12 F. Supp. 3d 635, 651 (S.D.N.Y. 2014) (finding statement on website stating defendant was the official site of plaintiff’s products supports an inference that defendant intentionally created an association with plaintiff’s mark). To the contrary, the word “NATURE’S” is used in many similar third-party registrations, which contradicts Opposer’s suggestion that there might be evidence showing an intent to create an association with Opposer’s mark. Again, Opposer’s argument is nothing more than a request that it be allowed to conduct a fishing expedition so it can try to find some unknown facts that could provide a basis for opposing the MSJ. This is not the purpose of Rule 56(d). See *Keebler*

Co. v. Murray Baker Products, 866 F.2d 1386, 1389 (Fed. Cir. 1989) (“If all one had to do to obtain a grant of a Rule 56(f) motion were to allege possession by movant of ‘certain information’ and ‘other evidence’, every summary judgment decision would have to be delayed while the non-movant goes fishing in the movant’s files.”) (wherein Rule 56(f) is now Rule 56(d)).

5. Opposer’s Affidavit Cannot Support a Rule 56(d) Request

Even if Opposer had otherwise met its burden, the Rule 56(d) Motion should still be denied because the affidavit submitted by Opposer fails to provide sufficient information to support the request. To support a motion under Rule 56(d), a party must file an affidavit describing, among other things, “(1) what facts are sought¹¹ and how they are to be obtained; [and] (2) *how these facts are reasonably expected to raise a genuine issue of material fact.*” *Gualandi v. Adams*, 385 F.3d 236, 244 (2d. Cir. 2004) (emphasis added); *see also* TBMP § 528.06 (“It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(d) 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 facts sufficient to show the existence of a genuine dispute of material fact for trial.”).

Here, the affidavit submitted by Opposer does not meet these requirements. Instead, Opposer’s affidavit merely states that Opposer “does not possess or maintain detailed information or documents” about certain topics and that Applicant has information about each such topic in its possession. (Rule 56(d) Motion, pp. 17-21 (the “Affidavit”).) The Affidavit does not explain why Opposer is unable to present relevant facts without discovery. For example, Opposer contends that it does not have information showing how and whether third parties use the marks containing

¹¹ The Affidavit – and the Rule 56(d) Motion as a whole – fails to identify the specific facts that are sought.

the word “NATURE’S” for food products that are identified and relied on in Nature Fynd’s Motion for summary judgment” (Affidavit, ¶ 15), but fails to explain why further discovery is necessary to allow Opposer to gather these publicly-available facts.¹² The Affidavit also fails to even attempt to explain why the information Opposer claims not to have is reasonably expected to raise a genuine issue of material fact.

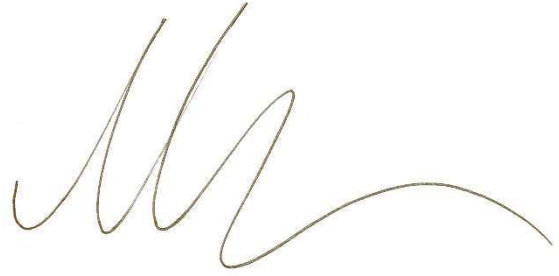
III. CONCLUSION

For the reasons set forth herein, Opposer has failed to meet its burden under Fed. R. Civ. P. 56(d) to (1) identify the discovery needed to obtain the specific facts necessary to enable the Opposer to respond to Applicant’s MSJ and (2) explain the reasons why discovery is needed to enable the Opposer to respond to Applicant’s MSJ. Accordingly, Applicant respectfully requests that the Rule 56(d) Motion be denied.¹³

¹² The Affidavit also fails to support Opposer’s need for information related to the connotation or commercial impression created by the applied-for mark, because it only states that Opposer lacks information about “how Nature’s Fynd’s mark *will be used in the marketplace* and what commercial impression it will create, how it will sound or appear, and what connotation it will imply *as used by Nature’s Fynd.*” (Affidavit, ¶ 14 (emphasis added).) As noted herein, Applicant’s intended use is irrelevant to these proceedings.

¹³ To the extent that the Board believes that Opposer has identified some narrow basis justifying further discovery, the Board should permit the Opposer to seek specific discovery on a specific schedule rather than broadly granting Opposer the ability to conduct any discovery it deems appropriate. *See First Nat’l Bank v. Cities Serv. Co.*, 391 U.S. 253, 265 (1968) (noting that former Rule 56(f) – which is now Rule 56(d) – “provides for comparatively limited discovery for the purpose of showing facts sufficient to withstand a summary judgment motion.”); *see also Phillips v. Pepsi Bottling Grp.*, No. 05-cv-01322-EWN-PAC, 2007 U.S. Dist. LEXIS 10201, at *10-11 (D. Colo. Feb. 13, 2007) (refusing to grant plaintiff *carte blanche* to conduct discovery and instead identifying particular depositions that could be conducted and particular documents that could be requested within thirty days).

Respectfully submitted,



Date: June 23, 2021

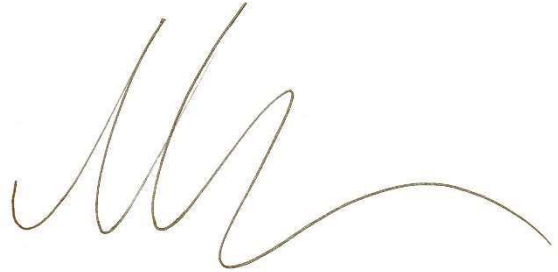
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing APPLICANT’S RESPONSE TO OPPOSER’S MOTION FOR FED. R. CIV. P. 56(d) DISCOVERY TO RESPOND TO SUMMARY JUDGMENT MOTION was served by e-mail, as prescribed in 37 C.F.R. § 2.119, on this June 23, 2021, upon Opposer’s current attorney of record:

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