

ESTTA Tracking number: **ESTTA788309**

Filing date: **12/09/2016**

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

Proceeding	92063649
Party	Defendant Lincoln Global, Inc.
Correspondence Address	THOMAS M WILLIAMS ULMER & BERNE LLP 500 WEST MADISON STREET, SUITE 3600 CHICAGO, IL 60661 UNITED STATES twilliams@ulmer.com, mrink@ulmer.com, msaunders@ulmer.com
Submission	Motion to Compel Discovery
Filer's Name	Thomas M. Williams
Filer's e-mail	twilliams@ulmer.com, mrink@ulmer.com, msaunders@ulmer.com, amehta@ulmer.com
Signature	/Thomas M. Williams/
Date	12/09/2016
Attachments	FINAL Respondent Motion to Request Discovery Pursuant to FRCP 56d.pdf(163166 bytes )

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

The ESAB Group, Inc.,	)	
	)	
Petitioner,	)	Cancellation No. 92/063,649
	)	
v.	)	
	)	Mark: FLASHBACK FRIDAY
	)	
Lincoln Global, Inc.	)	
	)	
Respondent.	)	Registration No. 4,562,560

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**RESPONDENT’S MOTION TO REQUEST DISCOVERY  
PURSUANT TO FED. R. CIV. P. 56(d)**

Pursuant to Fed. R. Civ. P. 56(d) and TBMP § 528.06, Respondent Lincoln Global, Inc. (“Respondent” or “Lincoln”) hereby submits its Motion to Request Discovery under Fed. R. Civ. P. 56(d). Respondent files this Motion to allow sufficient time for discovery relating to the fact-intensive grounds asserted in Petitioner The ESAB Group, Inc.’s (“Petitioner” or “ESAB”) summary judgment motion.

Respondent submits this Motion concurrently with Respondent’s Opposition to Petitioner’s Motion for Summary Judgment. As explained in Respondent’s opposing brief, Petitioner’s summary judgment motion must be denied because the asserted ground, mere descriptiveness, involves an inherently fact-intensive analysis. As a result, summary judgment is inappropriate, particularly at this pre-discovery stage. However, if the Board wishes to consider Petitioner’s summary judgment motion at this stage, Respondent requests the Board to grant this

Rule 56(d) Motion permitting Respondent to conduct discovery relating to Petitioner's descriptiveness claim.

**I. FACTS ARE UNAVAILABLE TO RESPONDENT, PRECLUDING SUMMARY JUDGMENT**

As Respondent has outlined in its Opposition to Petitioner's Motion for Summary Judgment, a finding of mere descriptiveness is a highly fact-intensive analysis, in which Petitioner has not met its burden of proof. Moreover, even if Petitioner had met its initial burden, there are facts unavailable to Respondent to further support its opposition to Petitioner's summary judgment motion. As a result, Respondent is entitled to discovery.

The Board has repeatedly held that a "determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used or is intended to be used, and the impact that it is likely to make on the average purchaser of such goods or services." *In re Jose Remacle*, 66 U.S.P.Q.2d 1222, 1224 (T.T.A.B. 2002). As described below, the factual inquiries in Respondent's discovery requests fit squarely within the Board's test for descriptiveness.

Moreover, the Board acknowledges that a request for discovery pursuant to Fed. R. Civ. P. 56(d)<sup>1</sup> is often necessary for responding to a motion for summary judgment. *See* T.B.M.P. § 528.06; *see Opryland USA Inc. v. The Great Am. Music Show, Inc.*, 23 U.S.P.Q.2d 1471, 1474 (Fed. Cir. 1992) ("Rule 56(e) states that a party opposing summary judgment 'must set forth specific facts showing that there is a genuine issue for trial.' However, '[t]his requirement

---

<sup>1</sup> The TBMP notes: "Former subdivision (f) of Fed. R. Civ. P. 56 has been carried forward by the 2010 amendments to the Federal Rules of Civil Procedure as subdivision (d). Consequently, the reference to Fed. R. Civ. P. 56(f) ... is to be read as a reference to present Fed. R. Civ. P. 56(d). The textual differences between current Rule 56(d) and former Rule 56(f) are purely stylistic. Case law developed under the earlier version remains authoritative." TBMP §528.06.

in turn is qualified by Rule 56(f)'s provision that summary judgment be refused where the nonmoving party has not had the opportunity to discover information that is essential to his opposition.”); *see also Jaguar Land Rover Limited v. Toys Tekk*, Opposition No. 91213584, 2015 BL 393668, at\*6 (November 9, 2015) (“[I]f Applicant needed responses to those discovery requests to respond to Opposer’s motion for summary judgment, it should have filed a request for discovery pursuant to Fed. R. Civ. P. 56(d)”) (not precedential). Here, such a request is appropriate as outlined by Rule 56(d):

WHEN FACTS ARE UNAVAILABLE TO THE NONMOVANT. If a nonmovant shows by affidavit or declaration that, for specified reasons, it cannot present facts essential to justify its opposition, the court may: (1) defer considering the motion or deny it; (2) allow time to obtain affidavits or declarations or to take discovery; or (3) issue any other appropriate order.

Fed. R. Civ. P 56(d).

Respondent served its First Set of Interrogatories, First Set of Requests for Admission and First Set of Requests for Production to Petitioner on October 10, 2016. *See* Declaration of A. Mehta (“Mehta Decl.”), submitted herewith (attaching Respondent’s discovery requests as Exhibits A, B, and C). However, Petitioner has not provided any responses to Respondent’s discovery requests because it, instead, filed a motion for summary judgment. As described below, Respondent’s discovery requests sought—among other relevant information—any facts or evidence regarding the alleged descriptiveness of FLASHBACK FRIDAY *with respect to the welding services* for which the mark is registered. *See* Mehta Decl. at Exhibit A, at #1. Petitioner’s reliance solely on inapplicable Internet materials in its summary judgment motion is misplaced. Its evidence and arguments present an incorrect analysis made in the abstract or on the basis of guesswork. *See* Dkt. #7, Petitioner’s Motion for Summary Judgment.

For example, Petitioner has not provided information or documents regarding its awareness of any third-party uses (or lack thereof) of FLASHBACK FRIDAY in connection with goods or services in the welding industry, as requested by Respondent. *See* Mehta Decl. at Exhibit B, at #1; *see* Mehta Decl. at Exhibit A, at #3; Mehta Decl. at Exhibit C, at ##7-8. Similarly, Petitioner has not provided information regarding its awareness of Respondent’s prior use of FLASHBACK FRIDAY in connection with goods or services in the welding industry, as requested by Respondent. *See* Mehta Decl. at Exhibit B, at #2. This is relevant because intentional copying can give rise to a presumption of acquired distinctiveness. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corporation*, 94 U.S.P.Q.2d 1549, 1575 (T.T.A.B. 2008) (holding that “[c]opying is . . . evidence of secondary meaning if the defendant’s intent in copying is to confuse consumers and pass off his product as the plaintiff’s”); *see also In re Steelbuilding.com*, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005) (“In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies.”) Moreover, Petitioner has not provided information regarding its awareness of any market research or consumer surveys (or lack thereof) concerning the mark or consumer perception of the mark, as requested by Respondent. *See id.* at ##3-4; *see also* Mehta Decl. at Exhibit A, at #7. These factual inquiries, among other requests by Respondent, are directly relevant to proving “the context in which the mark is used” in relation to welding services as well as “the impact that it is likely to make on the average purchaser of such goods or services.” *In re Remacle*, 66 U.S.P.Q.2d at 1224. “[W]hen the discovery is reasonably directed to ‘facts essential to justify the party’s opposition’, in the words of Rule 56(f), ***such discovery must be permitted or summary judgment refused.***” *Opryland*, 23 U.S.P.Q.2d at 1475 (emphasis added).

Furthermore, Respondent has requested that Petitioner produce documents relating to Petitioner's use of FLASHBACK FRIDAY, including use on social media; Petitioner's selection or adoption of FLASHBACK FRIDAY, including use on social media and trademark searches; when Petitioner first became aware of Respondent's Mark and the circumstances relating to Petitioner's first knowledge of Respondent's Mark; when Petitioner first used its mark; and Petitioner's support for and contradictions to the argument that Respondent's Mark is merely descriptive, among other requests. *See* Mehta Decl. at Exhibit C, at ##1-4, 6, 13-14. Petitioner's responses to these inquiries would also aid in the fact-intensive analyses embedded in Respondent's laches and unclean hands affirmative defenses. *See* Dkt. # 6 at pp. 10-11 (Respondent's affirmative defenses). Finally, discovery obtained from Petitioner will also aid in the fact-intensive analysis of Respondent's acquired distinctiveness affirmative defense.

While Respondent will present its own independent evidence, particularly in connection with its affirmative defenses, the information sought through the discovery process "is largely within the control of the party moving for summary judgment." TBMP §528.06.

## II. CONCLUSION

For the aforementioned reasons, Respondent respectfully requests the Board to either deny Petitioner's Motion for Summary Judgment, grant Respondent's Motion under Rule 56(d) allowing discovery, and/or any such other relief as the Board may deem appropriate.

Respectfully Submitted,

Dated: December 9, 2016

By: /s/ Thomas M. Williams  
Thomas M. Williams  
Ulmer & Berne LLP  
500 West Madison St., Suite 3600  
Chicago, IL 60661  
Telephone (312) 658-6556  
Facsimile (312) 658-6557  
twilliams@ulmer.com  
*Attorney for Respondent Lincoln Global, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that I served a true and correct copy of the following **RESPONDENT'S MOTION TO REQUEST DISCOVERY PURSUANT TO FED. R. CIV. P. 56(D)** upon Petitioner's counsel via electronic mail, per the agreement of the parties, on December 9, 2016, addressed as follows:

Michael E. Hall  
Kacvinsky Daisak Bluni PLLC  
3120 Princeton Pike, Suite 303  
Lawrenceville, New Jersey 08648  
mhall@kdbfirm.com

/s/ Thomas M. Williams  
Thomas M. Williams