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

Proceeding	92063649
Party	Plaintiff The ESAB Group, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The ESAB Group, Inc., Petitioner,)	
)	
v.)	Cancellation No. 92063649
)	Mark: FLASHBACK FRIDAY
Lincoln Global, Inc.)	Registration No. 4562560
Respondent.)	
)	

Attorney Ref.: 1800TCE3540

**PETITIONER’S BRIEF IN OPPOSITION TO RESPONDENT’S
RULE 56(d) MOTION TO REQUEST DISCOVERY**

Petitioner respectfully submits this brief in opposition to Respondent’s motion to request discovery under Rule 56(d) of the Federal Rules of Civil Procedure. Specifically, in response to Petitioner’s motion for summary judgment, Respondent filed both (i) a brief on the merits in opposition to Petitioner’s motion, and (ii) a Rule 56(d) motion. For the reasons stated below, Petitioner respectfully submits that Respondent’s Rule 56(d) motion should be denied.

I. Respondent’s Rule 56(d) Motion Is Moot

Respondent’s Rule 56(d) motion should be denied as moot because Respondent filed it concurrently with its brief on the merits in opposition to Petitioner’s motion for summary judgment:

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.

T.B.M.P. § 528.06 (2016). *See, e.g., Bad Boys Bail Bonds, Inc. v. Yowell*, 115

U.S.P.Q.2d 1925, 1930 (T.T.A.B. 2015) (“the [Rule 56(d)] motion is denied as moot

inasmuch as Bad Boys has responded to the motion for summary judgment on its merits.”); *Ava Ruha Corp. v. Mother’s Nutritional Ctr., Inc.*, 113 U.S.P.Q.2d 1575, 1578 (T.T.A.B. 2015) (“Inasmuch as Petitioner has filed a substantive response to Respondent’s motion for summary judgment, the motion for Rule 56(d) discovery is denied as moot.”).

Accordingly, Petitioner respectfully requests that Respondent’s Rule 56(d) motion be denied as moot.

II. Respondent’s Rule 56(d) Motion Does Not Identify “Essential” Facts

Rule 56(d) permits a non-movant, in response to a motion for summary judgment, to take discovery if the non-movant “shows by affidavit or declaration that, for specified reasons, it cannot present facts *essential* to justify its opposition...” Fed. R. Civ. P. 56(d) (emphasis added). As explained below, Respondent has not done this.

Respondent specifically points to the following topics on which it would like to take discovery:

- 1. “any facts or evidence regarding the alleged descriptiveness of FLASHBACK FRIDAY with respect to the welding services for which the mark is registered.”¹**

First, the registration at issue does not cover “welding services”; rather, it covers “online journal, namely, text and graphic works featuring information in the field of welding” in Class 41. The services are “online journal, namely, text and graphic works” and welding is merely the subject matter of those services.² As pointed out in Petitioner’s reply brief in support of its motion for summary judgment (filed concurrently herewith), Respondent’s registered mark FLASHBACK FRIDAY merely describes the manner in

¹ Respondent’s motion at 3 (emphasis in original).

² Providing online journals is a Class 41 service while “welding services” would be in Class 40.

which Respondent provides its online text and graphic works – i.e., via Flashback Friday posts – and need not also describe the subject matter (welding) in order to be merely descriptive. Thus, the existence or non-existence of others providing Flashback Friday posts *featuring information in the field of welding* is not particularly relevant and by no means a fact “essential” to Respondent’s opposition to Petitioner’s motion. And in any event, there was nothing to stop Respondent from introducing its own evidence on this point if it wished to do so.

2. “information regarding [Petitioner’s] awareness of Respondent’s prior use of FLASHBACK FRIDAY in connection with goods or services in the welding industry”³

Respondent argues this information “is relevant because intentional copying can give rise to a presumption of acquired distinctiveness.” Respondent’s argument appears to be that although Respondent has come forth with no evidence of its own to support its affirmative defense of acquired distinctiveness, if discovery were taken it might show that Petitioner knew of Respondent’s mark, which might show that Petitioner intended to copy Respondent’s mark, which in turn might support Respondent’s claim of acquired distinctiveness. This is sheer speculation and an insufficient basis on which to take discovery and avoid summary judgment:

[Opposer] argues that it is entitled to discovery to learn if [Applicant] . . . knows of instances of actual confusion. We do not agree. Summary judgment need not be denied merely to satisfy a litigant’s speculative hope of finding some evidence that might tend to support [its position].

Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 222 U.S.P.Q. 741, 744 (Fed. Cir. 1984)

(affirming Board’s granting of summary judgment). *See also J. I. Case Co. v. F.L.*

Indus., Inc., 229 U.S.P.Q. 697, 701 (T.T.A.B. 1986) (“[W]hile applicant states that it

³ Respondent’s motion at 4.

needs to take discovery on the issue of the validity of the assignment of the . . . registered trademark, it is settled that a party cannot avoid summary judgment based on an unsupported speculative hope that it might find some evidence to help its case.”); 2323 *N. Milwaukee LLC v. Winery Exchange, Inc.*, Opposition No. 91221974 (T.T.A.B. February 12, 2016) (non-precedential) (“Applicant’s speculation that Opposer may have made admissions against interest [were additional discovery taken] does not raise a factual question sufficient to preclude summary judgment.”).

3. “information regarding [Petitioner’s] awareness of any market research or consumer surveys (or lack thereof) concerning the mark or consumer perception of the mark”⁴

Here too Respondent is engaged in wild speculation. Respondent appears to be hoping against hope that Petitioner spent tens of thousands of dollars to conduct a survey, but Respondent cites no evidence or even a reason to believe this to be the case.

4. Respondent’s Additional Miscellaneous Requests

Respondent also requests discovery on a number of additional topics and offers the justifications below:

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. . . . Petitioner’s responses to these inquiries would also *aid* in the fact-intensive analyses embedded in Respondent’s laches and unclean hands 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

⁴ Respondent’s motion at 4.

the discovery process “is largely within the control of the party moving for summary judgment.”⁵

There are many problems with Respondent’s position embodied in the passage above.

First, Petitioner must point out that Respondent’s references to Petitioner’s “selection and adoption of FLASHBACK FRIDAY” and “when Petitioner first used its mark” are incoherent in the context of this proceeding because Petitioner has never claimed trademark rights in FLASHBACK FRIDAY. Indeed, Petitioner alleged in its petition that FLASHBACK FRIDAY is a generic term. Second, Respondent’s affirmative defenses of laches and unclean hands are unavailable, as explained in Petitioner’s reply brief in support of its motion for summary judgment. Third, Respondent wants to know Petitioner’s “support” for its argument that Respondent’s mark is merely descriptive, but of course Respondent received Petitioner’s motion for summary judgment so it already knows this.

More fundamental, however, is Respondent’s failure to explain why any of the information it seeks is *essential* to its opposition to Petitioner’s motion for summary judgment; indeed, Respondent did file a brief on the merits in response to Petitioner’s motion. While Respondent states that the information sought will “aid” in certain determinations, Rule 56 requires Respondent to show that without discovery it “cannot present facts essential to justify its opposition.” Respondent does not, and cannot, coherently make that argument because it submitted a brief on the merits, and moreover there was nothing to stop Respondent from introducing its own evidence to show that trial is necessary to resolve factual issues.

⁵ Respondent’s motion at 5 (citations omitted; emphasis added).

The most revealing statement in Respondent’s combined motion/declaration is found in paragraph 7 of the declaration, which states that Respondent’s affirmative defense of acquired distinctiveness “require[s] factual information from Petitioner.”⁶ That is a remarkable admission: Respondent has no evidence at all that *its own purported mark* has acquired distinctiveness and needs information from another party (Petitioner) to prove its allegation. According to Professor McCarthy, Rule 56(d) “does not permit a response on the order of ‘we have no factual basis for opposing summary judgment, but, if you stay proceedings, we *might* find something.’” 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:132 (4th ed. 2016). Yet that is precisely Respondent’s position here.

For the reasons stated above, Petitioner respectfully requests that Respondent’s Rule 56(d) motion be denied.

Respectfully submitted,

Date: December 23, 2016

/Michael E. Hall/

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Certificate of Service

I hereby certify that on December 23, 2016, a copy of the foregoing Petitioner’s Brief in Opposition to Respondent’s Rule 56(d) Motion to Request Discovery was served via email (by agreement) on Respondent’s counsel, Thomas M. Williams, at twilliams@ulmer.com.

/Michael E. Hall/

⁶ Declaration of Anisha A. Mehta at ¶ 7.