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

Proceeding	92065883
Party	Plaintiff Joseph Valenti, NERO International Holding Co., Inc., and NERO Live Adventure Games, LLC
Correspondence Address	PHILLIP THOMAS HORTON HORTON LAW PLLC 736 WEST STATE STREET , #F301 FARMINGTON, UT 84025 UNITED STATES NEROLitigation@gmail.com 801-664-2863
Submission	Opposition/Response to Motion
Filer's Name	Phillip Thomas Horton
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Date	07/08/2019
Attachments	NERO response to 56d.pdf(171089 bytes )

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

In the matter of trademark Registration Nos. 4697406 and 4657988

For the marks:                NERO NEW ENGLAND ROLEPLAYING ORGANIZATION & NERO,  
respectively

Registered on March 3, 2015 and December 16, 2014, respectively

Joseph Valenti, NERO International Holding Co., Inc., and NERO Live Adventure Games LLC,  
Petitioner’s,  
v.  
William J. Bearden dba NERO Central and NERO World, LLC,  
Defendant’s.

Cancellation No.        92065883 – Parent  
    92065911 - Child

**PETITIONER’S RESPONSE TO DEFENDANT’S MOTION FOR DENIAL OF SUMMARY JUDGMENT OR, IN THE ALTERNATIVE, DISCOVERY UNDER FED. R. CIV. P. 56(d)**

Petitioners Joseph Valenti (“Valenti”), NERO International Holding Co., Inc. (“NIHC”), and NERO Live Adventure Games LLC (“NLAG”) (collectively, “Petitioners”), by its counsel, hereby oppose Defendants William J. Bearden dba NERO Central (“Bearden”) and NERO World, LLC (“World”) (collectively, “Defendants”), Motion For Denial of Summary Judgment Or, In The Alternative, Discovery Under Fed. R. Civ. P. 56(d). Defendants request for additional discovery should not only be denied for being inadequate, lacking any resemblance of specificity, but also should be denied for lack of need.

**I.        Legal Analysis**

Under Fed. R. Civ. P. 56(d), Defendants must show that “for specified reasons, it cannot present facts essential to justify its opposition” to Petitioner’s Motion For Summary Judgment. Rule 56(d) provides, in pertinent part, that a party that believes 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

1 discovery. The request must be supported by an affidavit or declaration showing that the nonmoving  
2 party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion.  
3 See Fed. R. Civ. P. 56(d); *Opryland U.S.A. Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471  
4 (Fed. Cir. 1992); *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

5 As the movant in the Rule 56(d) motion, Defendants bear the burden of persuasion in establishing  
6 why the Board should grant it the opportunity to seek specifically identified information in order to  
7 respond to Petitioners summary judgment motion. As the party seeking to conduct additional discovery,  
8 Defendant must put forth sufficient facts to show that such evidence exists and is not pure speculation.  
9 See, e.g., *Vold v. D.A. Davison & Co.*, 816 F.2d 1406, 1416 (9th Cir. 1987). Defendants, under Rule 56(d), are  
10 limited to discovery it must have in order to respond to Petitioners motion for summary judgment. See T.  
11 Jeffrey Quinn, TIPS FROM THE TTAB; Discovery Safeguards in Motions for Summary Judgment; No  
12 Fishing Allowed, 80 Trademark Rep. 413 (1990). Cf. *Fleming Cos. v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB  
13 1991), *aff'd*, 36 USPQ2d 1551 (S.D. Ohio 1992).

14 It is not enough that the party seeking discovery under Rule 56(d) merely state that it needs  
15 discovery in order to respond to the summary judgment motion, but rather must state the reasons why it  
16 is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of  
17 material fact for trial. TBMP § 528.06 (June 2017) and cases cited therein.

18 Rule 56(d) discovery is not intended as a substitute for full-blown pre-trial discovery. Cf. *First*  
19 *Nat'l Bank of Ariz. v. Cities Service Co.*, 391 U.S. 253, 265 (1968) (Rule 56(d) “provides for comparatively  
20 limited discovery for the purpose of showing facts sufficient to withstand a summary judgment motion,  
21 rather than Rule 26, which provides for broad pretrial discovery.”). Defendants have identified certain  
22 information as “relevant,” but have failed to demonstrate a need for discovery under Rule 56(d).

## 23 II. Argument

### 24 A. Defendants Have Failed To Meet The Requirements Of Fed. R. Civ. P. 56(d)

25 Defendant’s fail to state with specificity the discovery questions it seeks to ask and have  
26 answered. Defendant’s also fail to state with any specificity why such information is essential to its  
27 response to Petitioners motion for summary judgment or how such discovery would preclude entry of

1 summary judgment. Defendant's submitted a single declaration in support of its motion with the only  
2 explanation provided by Defendant's was the need for more discovery to show standing or lack of  
3 standing. The Declaration plainly fails to meet the requirements of Rule 56(d). Defendants have not  
4 identified with any specificity the discovery it needs to respond to Petitioner's summary judgment  
5 motion. Indeed, Defendants own explanation of its need amounts to little more than a request to take  
6 discovery for discovery's sake with no mention as why the more discovery would lead to an issue of  
7 material fact. It is precisely the kind of "fishing expedition" that Rule 56(d) is designed to protect  
8 against. *See, e.g., Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995) (56(f)  
9 discovery denied where applicant failed to show need for discovery as to *specific issues*) (emphasis  
10 added); *Keebler Co.*, 9 USPQ2d at 1736.

11 Defendants failure to identify what information it intends to seek and the relevance this  
12 information would have at the summary judgment stage has rendered the Declaration deficient and  
13 Defendants motion fatally flawed. As Chief Judge Markey stated in *Keebler Co.*, "[i]f all one had to do to  
14 obtain a grant of a Rule 56(f) motion were to allege possession by movant of 'certain information' and  
15 'other evidence,' every summary judgment decision would have to be delayed while the non-movant  
16 goes fishing in the movant's files." 9 USPQ2d at 1736. Indeed, the averments in *Keebler Co.* of "certain  
17 information" and "other evidence" – which were found to be an insufficient basis for a Rule 56(f) motion  
18 – are actually *more* particular than Defendants claim that more discovery is need. Accordingly,  
19 Registrant's motion must be denied.

20 **B. Defendants Already Have Information They Need To Oppose Petitioners**  
21 **Motion For Summary Judgement**

22 Defendants claim have filed the 56(b) motion solely for the purposes of acquiring documents in  
23 attempts to show Petitioners lack of standing and privity. However, under each broad request,  
24 Defendants admit that "[s]ome information has been provided in support of summary judgment" and  
25 claim the "...information is incomplete." In every *inter partes* case, standing is a threshold issue that must  
26 be plead and proven by the plaintiff. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111  
27 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 171 F.3d. 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir.

1 1999); see also *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007). In Petitioners summary  
2 judgment motion, ample evidence was provided to show Petitioners have met the threshold for standing  
3 and privity. Petitioners also wish to point out that this issue has already been argued by Defendants and  
4 the Board found that Petitioners had adequately alleged standing and, based on evidence submitted by  
5 the Petitioners, that privity was adequate. (32 TTABVUE). As such, Defendants motion must be denied  
6 since the Board has already determined Petitioners have standing and are in privity.

7 Additionally, even if standing and privity had not already been decided upon, Defendants  
8 motion must fail based on their own admission that information has already been provided. Although  
9 Defendants argue there should be more evidence, Petitioners contend the exhibits supporting the  
10 summary judgment motion should be enough. You either have standing and privity or you don't. You  
11 cannot have some standing but not enough. As such, Petitioners exhibits to the summary judgment  
12 motion provide enough, if not ample, evidence to show standing and privity. For example, Petitioners  
13 have provided unredacted tax returns and contracts showing standing is proven. Petitioners have even  
14 provided a contract between the parties in this proceeding! As such, Petitioners believe Defendants have  
15 enough evidence to respond to Petitioners summary judgment motion.

16 Petitioners also believe Defendants motion should fail due to the unduly burdensome,  
17 ambiguous, vague, overly broad, and/or seek to privileged information. For example, Under 9(a),  
18 Defendants claim they need information showing the functioning of NIHC and list a plethora of  
19 documents they presume to need in order to show Petitioners lack standing. From the NY Secretary of  
20 State website, it clearly says "current entity status: active." Exhibit A. Petitioners also attached tax  
21 returns and contracts to Petitioners summary judgment showing standing and prior use. Petitioners  
22 should not have to show each and every document Defendants want to show standing when, in fact, the  
23 Petitioners have already provided documents to show standing.

24 Defendants requests are also vague and ambiguous as they do not claim to know everything they  
25 want to discover from the 56(d) motion. Under 9(d), Defendants claim "additional inquiries and  
26 discovery may be necessary..." This clearly goes against the purpose of a Fed. R. Civ. P. 56(d) motion.  
27 As stated above, 56(d) motions are limited in nature. Defendants are proposing to have open-ended

1 discovery, even though they claim “some information has been provided.” Accordingly, Defendants  
2 motion must be denied.

3 **Conclusion**

4 Defendants motion does not conform with the requirements of Fed. R. Civ. P. 56(d), since it does  
5 not state how the information sought would be reasonably expected to raise an issue of material fact.  
6 Even if Defendants motion and accompanying Declaration were not fatally flawed, there is simply no  
7 discoverable information which Defendants could seek which would create a genuine issue of material  
8 fact. As such, Defendants Motion For Denial Of Summary Judgment Or, In The Alternative, Discovery  
9 Under Fed. R. Civ. Pro. 56(d) should be denied and the Board should proceed with briefing on  
10 Petitioner’s Motion For Summary Judgment.

11  
12  
13  
14 Date: 07/08/2019

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1 **CERTIFICATE OF SERVICE**

2  
3 I, Phillip Thomas Horton, hereby certify that a true and correct copy of the foregoing document,  
4 entitled

5 PETITIONER'S RESPONSE TO DEFENDANT'S MOTION FOR DENIAL  
6 OF SUMMARY JUDGMENT OR, IN THE ALTERNATIVE, DISCOVERY  
7 UNDER FED. R. CIV. P. 56(d)

8 was served upon Defendant's attorney by electronic mail, on this , at the following address:

9 email@bearden.law

10  
11  
12  
13  
14 Date: 07/08/2019

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# EXHIBIT A



# NYS Department of State

## Division of Corporations

### Entity Information

The information contained in this database is current through July 1, 2019.

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Selected Entity Name: NERO INTERNATIONAL HOLDING CO., INC.

Selected Entity Status Information

**Current Entity Name:** NERO INTERNATIONAL HOLDING CO., INC.

**DOS ID #:** 2282267

**Initial DOS Filing Date:** JULY 24, 1998

**County:** WESTCHESTER

**Jurisdiction:** NEW YORK

**Entity Type:** DOMESTIC BUSINESS CORPORATION

**Current Entity Status:** ACTIVE

Selected Entity Address Information

**DOS Process (Address to which DOS will mail process if accepted on behalf of the entity)**

JOESPH ALAN VALENTI

2763 NC HIGHWAY 731 WEST

MOUNT GILEAD, NORTH CAROLINA, 27306

**Chief Executive Officer**

JOSEPH ALAN VALENTI

2763 NC HIGHWAY 731 WEST

MOUNT GILEAD, NORTH CAROLINA, 27306

**Principal Executive Office**

NERO INTERNATIONAL HOLDING CO., INC.

2763 NC HIGHWAY 731 WEST

MOUNT GILEAD, NORTH CAROLINA, 27306

**Registered Agent**

NONE

This office does not record information regarding the names and addresses of officers, shareholders or

directors of nonprofessional corporations except the chief executive officer, if provided, which would be listed above. Professional corporations must include the name(s) and address(es) of the initial officers, directors, and shareholders in the initial certificate of incorporation, however this information is not recorded and only available by [viewing the certificate](#).

### \*Stock Information

# of Shares	Type of Stock	\$ Value per Share
200	No Par Value	

\*Stock information is applicable to domestic business corporations.

### Name History

Filing Date	Name Type	Entity Name
JUL 24, 1998	Actual	NERO INTERNATIONAL HOLDING CO., INC.

A **Fictitious** name must be used when the **Actual** name of a foreign entity is unavailable for use in New York State. The entity must use the fictitious name when conducting its activities or business in New York State.

NOTE: New York State does not issue organizational identification numbers.

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