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

Proceeding	91181775
Party	Plaintiff Ride Snowboard Company
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Ride Snowboard Company.,)	
)	
Opposer,)	OPPOSITION No. 91181775
)	
v.)	REQUEST FOR DISCOVERY UNDER
)	RULE 56(f) AND OPPOSITION TO
Grendene S.A.,)	MOTION FOR SUMMARY
)	JUDGMENT
Applicant.)	
)	
)	
)	

**MOTION FOR DISCOVERY UNDER RULE 56(f) AND OPPOSITION TO MOTION
FOR SUMMARY JUDGMENT**

I. INTRODUCTION

Opposer Ride Snowboard Company (“Ride”) requests that the Board grant a continuance of Applicant Grendene S.A.’s motion for summary judgment pursuant to Rule 56(f) of the Federal Rules of Civil Procedure to allow Ride the opportunity to continue discovery. Ride needs the discovery to respond to Applicant’s claim that it used its RIDER mark in association with footwear in the winter sports industry before Ride used the mark RIDE in association with snowboard boots.

In the alternative, if the Board denies Ride’s request to conduct discovery pursuant to a continuance granted under Rule 56(f), Ride opposes Applicant’s Motion for Summary Judgment. Applicant’s prior registration of a stylized version of RIDER for sandals does not support the finding that Applicant is entitled to summary judgment rejecting Ride’s opposition, which is based on incontestable Registration No. 1,878,248 issued in 1995 and which confers upon Opposer a priority date of September 3, 1992. Applicant’s Application Serial No. 76/669,723, which is the subject of this opposition, seeks registration of the mark RIDER in standard

characters for the broad claim of footwear. Applicant's prior Registration No. 1,857,737 for the mark RIDER claimed a stylized mark and was limited to sandals. Applicant's prior registration does not, therefore, provide the basis for a claim to the broad registration of the mark RIDER in standard characters for the broad claim of "footwear."

II. BACKGROUND

Ride is the owner of U.S. Trademark Registration No. 1,878,248 for the mark RIDE in standard characters for snowboards and accessories for snowboards; namely, snowboard boots, snowboard bindings and parts therefor, snowboard boot bags and snowboard leashes in International Class 28. *See* Declaration of Julie VanDerZanden (VanDerZanden Decl.) and Ex. A (emphasis added). Registration No. 1,878,248, issued February 7, 1995, sets forth a date of first use of September 1992, and pursuant to 15 U.S.C. § 1051(b) represents a priority date of September 3, 1992. Registration No. 1,878,248 is currently valid, subsisting and incontestable.

On October 11, 1994, Registration No. 1,857,737 was issued to Applicant claiming the mark RIDER in a stylized format and claiming the goods "shoes; namely, molded slip-on sandals for casual wear" in International Class 25. *See* Declaration of Michael J. Bradford, Exhibit A. Registration No. 1,878,248 claims the stylized mark RIDER.

On November 30, 2006, Applicant filed Serial No. 76/669,723 seeking registration for RIDER in standard characters and broadly claiming "footwear" in International Class 25. *See* Application Serial No. 76/669,723 file history which is of record pursuant to 37 C.F.R. § 2.122(b)(1). In Application Serial No. 76/669,723 and in the Declarations submitted in support of its Motion for Summary Judgment, Applicant claims a date of first use of July 1989. *Id.*; Motion for Summary Judgment at 3.

Ride has opposed Application Serial No. 76/669,723 for RIDER in standard characters on the basis that Applicant is not entitled to the full scope of the broad claim of "footwear" sought

by that application. The Notice of Opposition filed in this Opposition specifically claims that registration of the mark RIDER for all footwear causes injury and damage to Opposer's exclusive rights in the mark RIDE in the winter sports industry. See Notice of Opposition ¶ 4 and ¶ 5. To obtain evidence relevant to Applicant's affirmative defense claiming prior use of the mark RIDER, Ride served by mail its First Set of Interrogatories and Requests for Production on Applicant on November 25, 2009. See Declaration of Cindy Caditz (Caditz Decl.) at ¶ 2 and Ex. A. Applicant's responses were due on December 30, 2009. *Id.*

On January 7, 2010 Applicant filed a Motion seeking to compel Applicant's provision of responses to discovery, which was denied without prejudice as premature pending disposition of Applicant's Motion for Summary Judgment.

To date, Applicant has not provided any answers to discovery.

III. ARGUMENT AND AUTHORITY

A. Ride needs the discovery it requested to respond to Applicant's claim that it has priority use on footwear.

Pursuant to 37 CFR § 2.127(e)(1) and Federal Rule of Civil Procedure 56(f), the Board may "order a continuance to enable affidavits to be obtained, depositions to be taken, or other discovery to be undertaken." "It 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. *Orion Group, Inc. v. The Orion Ins. Co. P.L.C.*, 2 U.S.P.Q.2D 1923 (1989) (citing *Dunkin' Donuts of Am, Inc. v. Metallurgical Exoproducts Corp.*, 6 USPQ2d 1026 (Fed. Cir. 1988)).

The discovery that Ride seeks is germane to the issues raised in Applicant's Motion for Summary Judgment. Applicant claims it has rights in the mark claimed by Application Serial No. 76/669,723 that are prior to any rights owned by Opposer because it has used the mark on

footwear with such goods as to give Applicant rights that are superior to Opposer's rights in the winter sports industry. The interrogatories and requests for production served by Ride seek information about Applicant's use of the mark RIDER on footwear other than sandals. For example, the interrogatories served by Ride specifically sought information relating to Applicant's sale of goods with the RIDER mark on "footwear or products that are not sandals." See Interrogatory No. 1, Ex. A of Caditz Declaration submitted herewith, emphasis added. Ride also requested documents relied on by Applicant in responding to Interrogatory No. 1. See Request for Product No. 1, Ex. A of Caditz Declaration submitted herewith. This information is clearly within Applicant's control and not available to Ride. Ride needs the information to properly respond to Applicant's claim of prior rights in the mark RIDER for the broad claim of footwear, including the winter sports industry. Accordingly, the Board should grant Ride's request for discovery under Rule 56(f).

B. Applicant's motion should be denied because its prior registration does not confer on Applicant the exclusive right to registration of RIDER for the broad claim of all footwear.

In the alternative, even if the Board denies Ride's request for discovery under Rule 56(f), Applicant has failed to introduce any evidence that shows it is entitled, as a matter of law, to summary judgment on the basis of prior use of RIDER with footwear in the winter sports industry.

Applicant's prior registration and use supports ownership of the a stylized mark RIDER for "shoes; namely, molded slip-on sandals for casual wear." A prior registration of the mark RIDER claiming sandals does not entitle Applicant to registration of RIDER in standard characters for the broader category of footwear. See *In re Best Software*, 63 USPQ2d 1109, 1113 (TTAB 2002) (stating that "ownership of an incontestable registration does not give the applicant a right to register the same or similar mark for different goods or services, even if they are



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