UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

RSC

January 31, 2022

Cancellation No. 92076531 (parent)
Cancellation No. 92076334

Fashion One Television LLC

v.

FASHIONTV.COM GmbH

Rebecca Stempien Coyle, Interlocutory Attorney:

On October 4, 2021 Respondent filed its combined motion for judgment on the pleading and, alternatively, for summary judgment.[1] On October 25, 2021, Petitioner filed a "Preliminary Response for Respondent's Motion for Judgment on the Pleadings and Alternatively for Summary Judgment".[2] In this submission Petitioner "requests opportunity and additional time" to respond to Respondent's motion. Respondent then filed a response opposing Petitioner's requested relief.[3] On January 17, 2022, Petitioner filed its "Response on Motion for Summary Judgment".[4]

Inasmuch as Petitioner's October 25, 2021 motion asserts it needs additional discovery and further requests an extension of time to file a response to Respondent's

[1] 16 TTABVUE.
[2] 18 TTABVUE.
[3] 19 TTABVUE.
[4] 20 TTABVUE.

motion, the Board construes Petitioner's submission as a combined motion for discovery pursuant to Fed. R. Civ. P. 56(d) and, in the alternative, to extend time to file its responsive brief.

Pursuant to Fed. R. Civ. P. 56(d), a party that believes it cannot effectively oppose a motion for summary judgment without first taking discovery may file a motion with the Board for time to take the needed discovery. *See also Celotex v. Catrett*, 477 U.S.317, 326 (1987). In order to establish that it is entitled to discovery under Fed. R. Civ. P. 56(d), Petitioner must show through affidavit or declaration "reasons why discovery is needed in order to support its opposition" to Respondent's motion for summary judgment. *Opryland USA Inc. v. The Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed Cir. 1992) (citing *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 1389, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989)). As the movant in the Rule 56(d) motion, Petitioner bears the burden of persuasion in establishing why the Board should grant it the opportunity to seek specifically identified information in order to respond to Respondent's motion for summary judgment. Rule 56(d) is not a substitute for full-blown pre-trial discovery. Under Rule 56(d), Petitioner is limited to discovery it must have in order to respond to Respondent's motion for summary judgment. *See* T. Jeffrey Quinn, *TIPS FROM THE TTAB; Discovery Safeguards in Motions for Summary Judgment; No Fishing Allowed*, 80 Trademark Rep. 413 (1990). *Cf. Fleming Cos. v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), aff'd, 36 USPQ2d 1551 (S.D. Ohio 1992).

It is not sufficient that the party seeking discovery under Rule 56(d) simply state that it needs discovery in order to respond to the motion for summary judgment; rather the party seeking discovery under Rule 56(d) must state why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial. *See* Fed. R. Civ. P. 56(d); TBMP § 528.06 and cases cited therein. The motion 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. *See* Fed. R. Civ. P. 56(d); TBMP § 528.06; *Murray Bakery Products*, 9 USPQ2d at 1739.

In support of its motion, Petitioner argues it served discovery requests on Respondent, but Respondent filed its pending motion instead of responding to those requests.[5] Petitioner then "speculate[s]" that Respondent did so because it "has nothing to substantiate actual use".[6]

This is insufficient to support a motion for Rule 56(d) discovery. While Petitioner asks that Respondent's motion be denied "as untimely and [in] violation of the prescribed process" and Respondent be ordered to "comply with the discovery schedule", Petitioner has not stated or established, either through its motion or any declaration, that it is unable to present sufficient facts to show the existence of a genuine dispute of material fact for trial without the requested discovery. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987). Moreover, to the extent Petitioner seeks an order compelling Respondent's

[5] 18 TTABVUE 5.
[6] *Id.*

responses to all of the outstanding discovery, Petitioner has failed to provide any information from which the Board could discern whether the outstanding requests are limited to the issues raised in Respondent's motion.[7]

In view thereof, Petitioner has not made the requisite showing of a need for further discovery to prepare a substantive response to Respondent's pending motion. Petitioner's construed Rule 56(d) motion is therefore **denied**.

The Board next addresses Petitioner's request for an extension of time to respond to Respondent's motion. The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. *See* Fed. R. Civ. P. 6(b); TBMP § 509.01. The Board is generally liberal in granting extensions before the period to act has lapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1177 (TTAB 2018) (citing *Am. Vitamin Prod., Inc. v. DowBrands Inc.*, 22 USPQ2d 1313 (TTAB 1992)). "The moving party, however, retains the burden of persuading the Board that it was diligent in meeting its responsibilities and should therefore be awarded additional time." *Id.* (citing *Nat'l Football League v. DNH Mgmt., LLC*, 85 USPQ2d 1852, 1854 (TTAB 2008))

Petitioner states it requires additional time to respond to Respondent's motion because while it "intends to introduce" extensive material in support of its response, the "key associate of Petitioner in charge of Intellectual Property matters" passed

[7] Petitioner did not provide the Board with a copy of the outstanding requests.

away in April 2021.[8] After reviewing the parties' arguments and keeping in mind the Board's liberal application of the Rule 6(b) standard, the Board finds that there is no evidence of negligence or bad faith on the part of Petitioner in seeking the extension, Respondent has indicated no specific prejudice, and the Board finds none, which would result from the extension, and Petitioner has not abused the privilege of extensions. In view thereof, Petitioner has demonstrated good cause for the requested extension of time to respond to Respondent's motion. The Board further notes that consideration of a Rule 56(d) motion tolls the time for filing a response to the motion for summary judgment.

Accordingly, the Board **grants** Petitioner's request for an extension of time to respond to Respondent's motion. Moreover, inasmuch as Petitioner its "Response on Motion for Summary Judgment" on January 17, 2022, the Board **accepts** this submission as Petitioner's response brief in opposition to Respondent's motion.

However, the time to file a reply brief may not be extended. Trademark Rule 2.127(e)(1). Accordingly, Respondent's reply brief, if any, must be filed within **TWENTY DAYS of Petitioner's January 17, 2022 response**. Trademark Rule 2.127(e)(1).

Proceedings otherwise **remain suspended** pending disposition of Respondent's motion for judgment on the pleading and, alternatively, for summary judgment.

[8] 18 TTABVUE 6-7. Petitioner also states "many records [are] not in the direct possession of Respondent's representative." *Id*. In view of the preceding statement concerning the passing of Petitioner's associate, it is unclear if the reference to "Respondent's representative" is a typographical error.