

~~EXHIBIT~~

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

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Application Serial No. 75/245,902 :
Mark: SAVITAR :

SAVATAR, INC., :

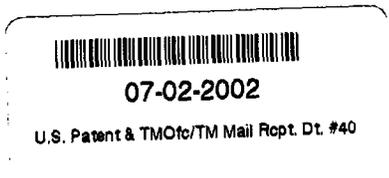
Opposer, :

v. :

SAVITAR CORPORATION, :

Applicant. :
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Opposition No. 124,976



**OPPOSITION TO APPLICANT'S MOTION TO COMPEL AND IN SUPPORT OF
OPPOSER'S CROSS-MOTION FOR A PROTECTIVE ORDER**

Opposer, Savatar, Inc. ("Savatar"), submits this memorandum in opposition to Applicant's Motion to Compel Documents ("Mot. to Compel") and in support of its motion for a protective order.

A. Background

On April 26, 2001, Savitar Corporation ("Applicant" or "Savitar") filed an intent-to-use application with the Trademark Office to register the mark SAVITAR. Opposer, Savatar, filed the subject opposition to the application based on the following:

(i) Savatar has used SAVATAR as a service mark and trade name since September 1997 in connection with its software-based services, and marketing and technology consulting services.

(ii) By virtue of extensive use and promotion of the mark SAVATAR, Savatar has developed common law trademark rights and valuable goodwill in the mark SAVATAR.

(iii) The goods and services set forth in the application herein opposed, namely, "computer software development tools and database management, software for general use," in Class 9; and "database development services, computer programming and computer software design for others," in Class 42, are related or similar to the services of Savatar under the SAVATAR company name and mark. Moreover, the channels of trade through which the respective services are sold are likely to be the same.

(iv) The mark SAVITAR set forth in the application herein opposed is substantially identical in both sight and sound to Opposer's mark SAVATAR.

On March 8, 2002, Applicant served a Request for Production of Documents and Interrogatories on Savatar. Savatar served its responses and objections on April 12, 2002. A copy of Opposer's Response to Applicant's First set of Interrogatories and Response to Request

for Production of Documents, served April 12, 2002, are attached as Exhibit A. Opposer believes that its answers were proper and complete.

B. Applicant's Motion

Applicant filed a motion to compel concerning the following answers and responses by Savatar.

1. Interrogatory Nos. 7 & 8

Applicant's Interrogatory No. 7 asked Savatar for customer lists (including names and locations). Opposer's response was that such a list was confidential. Such information is generally considered confidential. *See, e.g., Sunkist Growers, Inc. v. The Benjamin Ansehl Company*, 229 U.S.P.Q. 147, (TTAB 1985) (identities of customers and documents related to customer lists need not be disclosed). Nonetheless, without waiving its objections, Savatar provided a list of seven major clients that had been publicly disclosed and stated as to the others that their identities were confidential. Opposer has added an eighth (IBM) by way of supplemental response. See attached Declaration of Joyce Levesque, Exhibit B, No. 4.

Applicant stated that "opposer should be required to produce a list of clients for the last five years so that Savitar can explore the allegations that Opposer has continuously used its mark and that its mark has valuable goodwill." (See Mot. to Compel, page 3.) This list does,

in fact, cover Savatar clients over the last five years. However, it is not a comprehensive list of clients since 1997 because the rest of the clients are confidential.

To date, Applicant has served at least one of these companies with a subpoena. Neither Opposer nor its counsel ever received a copy of the subpoena. Upon receiving a copy of Applicant's Motion to Compel (by first class mail on June 13th), Opposer, like the Board, received a copy of Unilever's letter responding to Applicant's subpoena. See Exhibit E. Evidently, the Applicant subpoenaed Lipton Foodservice (one of the customers mentioned in the interrogatories response), a part of Unilever. Unilever, through its trademark holding company, Conopco, replied stating that a good faith effort had been made, but that no documents responsive to the subpoena were located. See Unilever letter dated May 29th attached hereto as Exhibit C. Applicant in its motion twists this reply by Unilever into the assertion that the listed companies were therefore not clients of Opposer. (See Mot. to Compel, page 3.) This is plainly illogical and without any basis. See the Levesque Declaration, paragraph 4. (Exhibit B, paragraph 4).

Applicant states that "if Opposer continues to refuse to provide such information it should be prohibited from offering any evidence/claims regarding the alleged use of its mark with any such customers" (see Mot. to Compel, page 3). This assertion is unsupported by the facts or the law. Savatar made specific and general objections in its answer to Interrogatory No. 7, which objections it did not waive, and further stated that "other customer relationships are confidential" (see Exhibit A, page 6).

2. Interrogatory Nos. 9 & 10

Interrogatory 9 asked for the number of customers who presently use Opposer's software product and the date when such software was purchased. Interrogatory 10 asked for the same information with respect to Opposer's consulting services. Opposer provided the names of current customers, FedEx and AT&T. Applicant insists on the total number of customers and the years those entities became customers. Opposer refers to the Levesque Declaration, which provides a non-exclusive list of customers, including four that currently use Savatar's software-based services and consulting services, along with the applicable dates. See Exhibit B, paragraph 4.

3. Interrogatory No. 14

Applicant's Interrogatory Number 14 seeks information relating to funds spent associated with the goodwill of the Savatar name and mark. Opposer responded by stating that Savatar, Inc. is a wholly owned subsidiary of the WPP Group, plc, a UK public company, and that "precise details of financial information concerning the company are confidential." However, an approximate dollar amount spent promoting the name and good will associated with the mark from 1997 to present is estimated to be in excess of \$300,000. See Exhibit A, page 9.

Applicant stated that this was an "unsubstantiated/undocumented guess." See Mot. to Compel, page 4. In rebutting this accusation, Opposer refers to the Levesque Declaration. See Exhibit B, paragraph 3. Funds spent to develop the SAVATAR name and

mark are directed to trade shows for Customer Relationship Management/Partner Relationship Management services, the company website, lead generation programs, client mailings, letterhead, and white papers. Thus Opposer does not believe that its answer was unsubstantiated. However, financial documents of the nature sought by Applicant in this interrogatory are confidential.

4. Request for Production No. 1

Applicant's Request for Production No. 1 seeks copies of any and all of Savatar's advertising displaying the mark SAVATAR. Savatar produced copies of its website, as well a company brochure. SAVATAR prominently appears on each and every page of the materials. See Exhibit D hereto, Opposer's Response to Applicant's First set of Documents, Bates Nos. SAV000003 – SAV000021. Savatar does not have other brochures or advertising pieces because its presentations are largely face-to-face or one-to-one. Applicant states that Savatar has produced only two items (see Mot. to Compel, page 4). But that is all that exists. For a further explanation of Savatar's advertising methodology, Opposer refers to the Levesque Declaration. Exhibit B, paragraph 3.

5. Request for Production No. 2

Applicant's Request for Production No. 2 seeks sample product packaging. Savatar does not have product packaging. It builds software-based solutions to marketing problems using custom code, off the shelf products and integrating legacy systems to either off

the shelf products or to custom code. Savatar does not deliver its code in a shrink wrap package.

See Exhibit B, paragraph 2.

C. Protective Order

Opposer has provided Applicant with a partial list of customers, and has only withheld an historical list pending the execution of a protective order. Opposer has also provided details relating to financial information as to money spent developing the goodwill of the mark and company name SAVATAR. Further financial details will also be revealed once a protective order is in place.

Savatar respectfully requests that the Board enter a protective order limiting the disclosure of any further information with respect to customer lists or financial information to Applicant's counsel only. Such an order will promote fairness by preventing Savatar and its clients from being harmed as a result of these TTAB proceedings.

Pursuant to 37 CFR 2.120(f), the Trademark Trial and Appeal Board may, upon motion of a party and a showing of good cause, issue an order requiring confidential information to be disclosed only in a designated way. A motion for a protective order should be granted where the information sought is confidential and where the disclosure of such information would harm the resisting party. See *American Standard, Inc. v. Pfizer, Inc.*, 828 F.2d 734, 740 (Fed. Cir. 1987).

1. Customer Lists

In this case, Applicant seeks the disclosure of "a list of its clients for the last five years." (See Mot. to Compel, page 3.) Such information is confidential and would not normally be disclosed without restriction. By virtue of this production, Applicant would be privy to the identity of all of Savatar's customers. Such information is analogous to requests seeking the identity of a trademark owner's suppliers because such requests seek the identities of persons and entities that work and cooperate with a trademark owner. The Board has routinely treated such information as confidential, subject to disclosure, if at all, only under a protective order. See, e.g., *Anheuser-Busch, Inc. v. Bynum*, 1996 TTAB Lexis 518 (1996) (disclosure of license agreements limited to Applicant's counsel only); *Sunkist Growers, Inc. v. The Benjamin Ansehl Company*, 229 U.S.P.Q. 147, 1985 TTAB LEXIS 20 (1985) (identities of customers and documents related to customer lists need not be disclosed); *Fissons Ltd. v. Capability Brown Ltd.*, 209 U.S.P.Q. 67 (TTAB 1980) (identification of customers required to be produced only under protective order); *Magnavox Co. v. Mattel, Inc.*, 1981 U.S. Dist. Lexis 11208 (N.D.Ill. March 24, 1981) (limiting disclosure of agreements between patentee and licensee, patent sub-license agreements, and royalty reports to "attorneys' eyes only"). Opposer's proposed protective order is attached as Exhibit E.

In addition, the disclosure of this information to Applicant directly would harm Savatar because Savatar appears to compete with Savatar based on the description of services it provided in its application. Savatar develops software-based solutions for its clients. It deals with developers, database architects, database developers as well as marketers at all levels within

the client's organization. Savatar builds solutions to marketing problems using custom code, off the shelf products and integrating legacy systems to either off the shelf products or to custom code. Applicant's "computer software development tools and database management, software for general use, in Class 9; and database development services, computer programming and computer software design for others, in Class 42," appear substantially related or similar to the type of activities Savatar provides. This illustrates the similarity of services both groups provide. If the identities of all of Savatar's clients were disclosed, Savatar would be harmed because it might interfere with Savatar's business operations, cause it economic harm, jeopardize the goodwill it has created with its customers and expose Savatar's clients to potential harassment.

Courts have recognized that there is an interest in protecting the identities of customers because of fears of harassing practices. *See Liberty Folder v. Curtiss Anthony Corp.*, 90 F.R.D. 80 (S.D. Ohio 1981) (in trademark infringement action between competitors, identification of defendant's distributors, dealers, vendors and customers was limited to plaintiff's counsel only); *Davis v. General Motors Corp.*, 184 U.S.P.Q. 288, 64 F.R.D. 420 (N.D.Ill. 1974) (limiting disclosure of information to plaintiff's attorneys and experts where the "disclosure of the requested material may effect other parties in addition to the defendant, *i.e.*, manufacturers and suppliers"); *Russ Stonier, Inc. v. Droz Wood Co.*, 52 F.R.D. 232 (E.D. Pa. 1971) (protective order granted limiting disclosure of defendants' customers and suppliers to counsel to protect against possible harassment and intimidation of customers and suppliers). Because this theory applies equally to the identities of Savatar's customers and persons who have cooperated with Savatar in the enforcement of its trademark rights, the disclosure of the identities of these persons and entities should be limited as well.

2. Financial Information

Similarly, in *Neville Chemical Company v. The Lubrizol Corporation*, 104 U.S.P.Q. 689 (TTAB 1975), the Applicant sought Opposer's sales and advertising figures. The Board required that this information be disclosed but to Opposer's counsel only, finding that since the Board does not see that applicant itself, as opposed to applicant's attorneys, has any need for such information, which would outweigh the possible harm to Opposer from the revelation thereof to applicant, the protective order should provide that the information furnished by Opposer will be confined to applicant's attorneys. *Id.* at 690.

Moreover, Applicant has made no showing as to why it, as opposed to its counsel, should have access to Savatar's confidential information, including financial documents. Applicant has not shown why its counsel would be unable to review the responsive documents to determine the validity of Opposer's claims without the help of its employees.

In sum, because of the clear risk to Savatar that would be created by the disclosure of Savatar's confidential information to Applicant, Savatar respectfully requests that the Board grant Savatar's motion for a protective order limiting the disclosure of Savatar's customer and financial related information to its counsel only.

CONCLUSION

For the foregoing reasons, Savatar respectfully requests that the Board deny Applicant's motion to compel and grant its motion for a protective order.

Respectfully submitted

DAVIS & GILBERT LLP

Dated: July 2, 2002

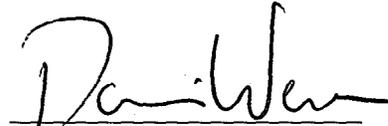
By: 
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New York, NY 10019
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that on July 2 2002, service of a true and complete copy of the foregoing pleading or paper was made upon Applicant's counsel:

Elizabeth B. Searle, Esq.
Stuart & Branigin
300 Main Street, Suite 800
P.O. Box 1010
Lafayette, Indiana 47902-1010

by depositing same in the United States mail in an envelope properly addressed and with sufficient first-class postage affixed.



David A. Weems

List of Exhibits

- Exhibit A Opposer's Response to Applicant's First set of Interrogatories and Opposer's Response to Request for Production of Documents
- Exhibit B Declaration of Joyce Levesque
- Exhibit C Unilever letter dated May 29, 2002
- Exhibit D Opposer's Response to Applicant's First Set of Documents, Bates Nos. SAV000003 – SAV000021
- Exhibit E Opposer's proposed Protective Order

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07-02-2002

U.S. Patent & TMOs/TM Mail Rcpt. Dt. #40

July 2, 2002

VIA EXPRESS MAIL

Commissioner for Trademarks
Box TTAB - NO FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Savatar, Inc. v.
Savitar Corporation
Opposition No. 124,976

TRADEMARK TRIAL AND
APPEAL BOARD
Dear Sir,
02 JUL 2002 AM 12:14

Enclosed please find an original and three (3) copies of Savatar's Opposition To Applicant's Motion To Compel and In Support of Opposer's Cross-Motion for a Protective Order.

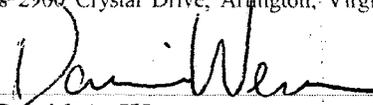
Thank you.

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I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1. 10 on the date indicated above and is addressed to the Commissioner for Trademarks-2900 Crystal Drive, Arlington, Virginia 22202-3513.

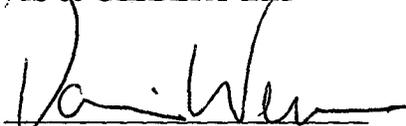
Signature


David A. Weems

DAW/ljj
Enclosure

Very truly yours,

DAVIS & GILBERT LLP

By: 

David A. Weems

Attorneys for Opposer

cc: Elizabeth B. Searle, Esq., Stuart & Branigan (w/ encl.)