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

Proceeding	91160913
Party	Plaintiff Tiffany (NJ) Inc. ,
Correspondence Address	BARBARA A. SOLOMON FROSS ZELNICK LEHRMAN & ZISSU, P.C. 866 UNITED NATIONS PLAZA NEW YORK, NY 10017
Submission	Motion to Compel Discovery
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Date	12/01/2004
Attachments	Opposer's Motion to Compel.pdf (15 pages)

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

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TIFFANY (NJ) INC.,	:	
	:	
Opposer,	:	
	:	
-against-	:	Opp. No. 91160913
	:	
ANTHONY SIRAGUSA and	:	
MICHAEL ROMANELLI,	:	
	:	
Applicants.	:	
-----X		

**OPPOSER’S MOTION TO COMPEL
AND MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Trademark Rule of Practice § 2.120(e) and Fed. R. Civ. P. 37(a), Opposer Tiffany (NJ) Inc. (“Tiffany” or “Opposer”) hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order compelling Applicants Anthony Siragusa and Michael Romanelli (together, “Applicants”) to produce documents responsive to Opposer’s First Set of Requests for the Production of Documents and Things within five (5) days of the Board’s order. Opposer further moves for an order imposing discovery sanctions against Applicants should they fail to comply with the Board’s order.

INTRODUCTION

On August 5, 2004, Opposer served its first set of document requests on Applicants. When Applicants finally responded on October 11, 2004, Applicants either refused to produce clearly relevant documents or stated that documents would be produced but did not offer them. Three weeks later, on November 2, 2004, Applicants produced a total of nine pages of materials. Another four weeks later, on November 30, 2004, following repeated calls and letters seeking full production of the requested

documents – including documents that Applicants have admitted exist and stated would be produced – Applicants produced a total of eleven additional pages. Applicants’ refusals and lack of cooperation have necessitated this motion.

CERTIFICATION OF COUNSEL

Pursuant to 37 C.R.F. § 2.120(e)(1), this motion is made following numerous good faith attempts by counsel for Opposer to meet and confer concerning Applicants’ discovery failures. As set forth more fully in the Declaration of Laura Popp-Rosenberg (“Popp-Rosenberg Decl.”), dated December 1, 2004, submitted herewith, Opposer’s counsel has sent Applicants’ counsel several letters and has called opposing counsel in an effort to resolve the many deficiencies in Applicants’ responses to Opposer’s document requests. Despite these good faith attempts, Applicants have failed to cure their deficiencies. Opposer files this motion because, as evidenced by Applicants’ conduct to date, further attempts to resolve these discovery disputes would be fruitless.

FACTS

Opposer is the owner of the world-recognized marks TIFFANY and TIFFANY & CO. (the “TIFFANY marks”), which it has used for more than 150 years in connection with a wide variety of goods and services. The TIFFANY marks – which are the subject of over 60 United States trademark registrations owned by Opposer – repeatedly have been recognized by courts as the embodiment of a famous brand. *See, e.g., Tiffany & Co. v. Nat’l Gypsum Co.*, 59 C.C.P.A. 1063, 459 F.2d 527 (1972); *Elizabeth Kent Cosmetics, Inc. v. G.B. Kent & Sons, Ltd.*, 50 C.C.P.A. 738, 309 F.2d 775 (1962); *Tiffany & Broadway, Inc. v. Comm’r of Patents & Trademarks*, 167 F. Supp. 2d 949 (S.D. Tex.

2001); *Sykes Lab., Inc. v. Calvin*, 610 F. Supp. 849 (C.D. Cal. 1985); *see also* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 24:109.

On June 6, 2003, Applicants, two individuals, filed Application S.N. 76/520,262 in the United States Patent and Trademark Office to register the mark TIFFANY'S RESTAURANTS for food restaurant services in International Class 43, reciting a date of first use in commerce of September 1, 1980.

On June 9, 2004, Opposer filed a Notice of Opposition against Application S.N. 76/520,262, alleging both likelihood of confusion and dilution. Discovery in this proceeding opened on July 7, 2004, and is set to close April 4, 2005. (Popp-Rosenberg Decl. ¶ 2 and Exs. 1-2.)

On August 5, 2004, Opposer served, by first class mail, Opposer's First Set of Requests for the Production of Documents and Things to Applicants ("Opposer's Document Requests"). (Popp-Rosenberg Decl. ¶ 3 and Ex. 3.) Pursuant to Trademark Rules of Practice §§ 2.120(a) and 2.119(c), Applicants' written responses to Opposer's Document Requests were due by no later than September 9, 2004. One day before Applicants' responses to Opposer's Document Requests were due, on September 8, 2004, Applicants requested from Opposer a thirty-day extension of time to respond. (*Id.* at ¶ 4.) Applicants informed Opposer at that time that Applicants *had not yet even begun* the process of preparing the discovery responses or collecting the requested information. (*Id.*) Despite the late request, Opposer consented to extend Applicants' time to respond through September 24, 2004. (*Id.*)

Apparently unsatisfied with Opposer's consent to a 15-day extension, on September 9, 2004, the same day its discovery responses were due, Applicants filed with

the Board a Motion for Extension of Time to Respond to Opposer's Discovery Requests, seeking an additional thirty days – through October 11, 2004 – to serve their responses. (Popp-Rosenberg Decl. ¶ 5 and Ex. 4.) The only reason Applicants gave for the extension request was that they needed “additional time . . . to determine the information requested by the interrogatories and to locate documents requested by the requests for production.” (*Id.* at Ex. 4.)¹ Clearly, their reason was a ruse, since, as of today – almost three months after making their motion – Applicants have yet to locate or produce the vast majority of the requested documents.

Applicants finally served their written responses to Opposer's Document Requests on October 11, 2004 (“Applicants' Responses”), a full 65 days after Opposer's Document Requests were served. (Popp-Rosenberg Decl. ¶ 6 and Ex. 6.) Although Applicants have now had Opposer's Document Requests for nearly four months and advised the Board almost two months ago that they were locating responsive documents, it is apparent from the face of Applicants' Responses and their paltry, twenty-page document production provided to date that Applicants have not taken any real steps to secure the requested information.

Applicants Failure to Produce Documents

Despite the extra time afforded Applicants to respond to Opposer's Document Requests, Applicants did not produce a single responsive document with their written responses. Instead, Applicants' Responses merely stated that Applicants would produce documents at some unspecified later time in response to a number of Opposer's requests, including but not limited to, Document Requests Nos. 2-5, 7-8, 12, 17 and 19. (Popp-

¹ The Board granted as uncontested Opposer's motion for an extension of time to respond to Opposer's discovery requests on November 1, 2004. (Popp-Rosenberg Decl. ¶ 5 and Ex. 5.)

Rosenberg Decl. Ex. 6.) Applicants' Responses also indicated that, "[t]o the extent [such documents] exist," documents responsive to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29 also would be produced at some unspecified future time.² (*Id.*) To date, Applicants have yet to advise Opposer if, in fact, there are any such responsive documents.

On October 13, 2004, Opposer sent to Applicants a letter outlining the deficiencies in Applicants' Responses (the "October 13 Deficiency Letter"). (Popp-Rosenberg Decl. ¶ 7 and Ex. 7.) Among the deficiencies cited, Opposer noted that Applicant had not yet produced a single document in response to Opposer's Document Requests despite its obligation to do so, its indication that it would do so and the length of time that had already passed since the requests were first served.

On October 18, 2004, counsel for the parties held a telephone conference to discuss the deficiencies noted in Opposer's October 13 Deficiency Letter. (Popp-Rosenberg Decl. ¶ 8.) Counsel for Applicants stated that Applicants would be producing documents that same week – *i.e.*, by no later than October 22, 2004. (*Id.*) Despite this promise, no documents were produced. (*Id.* at ¶ 9.)

On October 27, 2004, counsel for Opposer wrote yet again to counsel for Applicants, requesting production of documents by no later than October 29, 2004, in anticipation of depositions of the Applicants noticed for November 17 and 18, 2004. (Popp-Rosenberg Decl. ¶ 9 and Ex. 8.) By letter dated October 28, 2004, counsel for Applicants advised that he "expected to be[gin] document production soon," but failed

² In a letter dated October 28, 2004, Applicants also agreed to produce documents responsive to Document Request No. 23 "to the extent they exist." (Popp-Rosenberg Decl. Ex. 9.)

either to specify a timeframe or to explain why no documents had yet been produced.

(*Id.* at Ex. 9.)

It was not until November 2, 2004, that Opposer received any document production, receiving on that date a total of nine pages of responsive documents.³ (Popp-Rosenberg Decl. ¶ 14 and Ex. 13.) These nine pages consist entirely of menus and related items, which clearly could have been produced weeks if not months earlier. The cover letter enclosed with the nine pages of production merely indicated that “if [Applicants] later locate additional documents that are responsive, [they] will produce them.” (*Id.* at Ex. 13.) Yet in their written document responses, Applicants unequivocally advised Opposer that documents responsive to a large number of document requests exist. (*Id.* at Ex. 6.)

On November 2, 2004, counsel for Opposer sent a letter by facsimile and mail to Applicants’ counsel objecting to the paucity of Applicants’ production and requesting full production consistent with Applicants’ Responses and their discovery obligations. (Popp-Rosenberg Decl. ¶ 15 and Ex. 14.) After receiving no response to the November 2 letter, counsel for Opposer called Applicants’ counsel on November 8, 2004, and left a voicemail message. (*Id.* at ¶ 16.) Counsel for Applicants did not return the call, and did not address the issues raised in the November 2 letter in a subsequent letter to Opposer. (*Id.* at ¶¶ 16-17 and Ex. 15.) In an attempt to avoid having to file this motion, Opposer’s counsel reminded Applicants’ counsel once again of its document production deficiencies in a letter dated November 18, 2004, and requested from Applicants by November 22, 2004, either production or notification of a date for production. (*Id.* at ¶ 18 and Ex. 16.)

³ The nine pages supposedly correspond to thirteen pages of production, but only because Applicants marked what appears to be a two-sided, tri-fold menu as six separate pages.

Applicants' counsel has not responded to the November 18 letter. However, on November 30, 2004, Opposer received an additional eleven pages of responsive documents from Applicants. (*Id.* at ¶ 18 and Ex. 17.) Again, these pages consist largely of a copy of a menu (six pages of the production) and a bag (two pages of the production), all of which clearly could have been produced much earlier.

Applicants' Deficient Document Responses

In its October 13 Deficiency Letter, Opposer pointed out numerous specific deficiencies in Applicants' Responses, including deficiencies in Applicants' responses to Document Requests Nos. 9 and 16, and deficiencies in Applicants' responses to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29.

Applicants' Deficient Response to Document Request No. 9. Document Request No. 9 asked Applicants to produce “[a]ll documents concerning attempts or plans by or on behalf of Applicants to franchise restaurants under Applicants' Mark, including all filings made with any local, state or federal governmental agency or office concerning the same.” (Popp-Rosenberg Decl. Ex. 3.) Applicants responded by objecting to the request as “overly broad, unduly burdensome, not relevant to the subject of this proceeding, and [] not likely to lead to the discovery of admissible evidence.” (*Id.* at Ex. 6.) Applicants posited that “[o]nly those franchise attempts which have been consummated are relevant to the present matter,” and therefore agreed to produce “documents, if any exist, concerning *consummated* franchising attempts” only. (*Id.* (emphasis added).)

In its October 13 Deficiency Letter, Opposer advised Applicants that “plans to franchise are relevant under the broad scope of relevancy set forth in TBMP § 402.01 and clearly relate to issues such as similarity of consumers and the nature of [Applicants']

expansion.” (Popp-Rosenberg Decl. Ex. 7.) In a written reply dated October 28, 2004, Applicants’ counsel continued to refuse to produce documents responsive to Request No. 9, despite Applicants’ clear obligation to produce such documents. (*Id.* ¶ at Ex. 10.)⁴ No documents responsive to Document Request No. 9, not even those that Applicants agreed to produce, have yet been provided.

Applicants’ Deficient Response to Document Request No. 16. Document Request No. 16 asked Applicants to produce “documents sufficient to show Applicants’ plans for expanding the nature or number of restaurants bearing the name ‘Tiffany’s Restaurants.’” (Popp-Rosenberg Decl. Ex. 3.) Applicants responded by objecting that the request “calls for the production of documents which are irrelevant to the issues presented in this matter,” claiming that, as “[t]he application for Applicants’ Mark is based on its [sic] prior and current use of the mark[,] Applicants’ prospective plans for expansion are irrelevant to the subject of this proceeding and are not likely to lead to the discovery of admissible evidence.” (*Id.* at Ex. 6.)

In its October 13 Deficiency Letter, Opposer advised Applicants that their argument that plans for expansion are irrelevant to the proceeding “is incorrect under the TBMP,” and that “plans for expansion relate specifically to such likelihood of confusion factors as bridging the gap.” (Popp-Rosenberg Decl. Ex. 7.) Applicants have continued

⁴ Opposer anticipates that Applicants will argue that documents concerning their franchising attempts are confidential and cannot be produced until entry of a protective order. Any delay in the consummation of a protective order is wholly Applicants’ fault. Applicants’ counsel did not present Opposer’s counsel with a draft protective order until October 29, 2004. (Popp-Rosenberg Decl. ¶ 11 and Ex. 10.) Opposer’s counsel responded immediately, outlining its specific objections to the draft order in a letter dated and faxed November 1, 2004. (*Id.* at ¶ 12 and Ex. 11.) Applicants’ counsel waited until November 16, 2004 before responding to Opposer’s objections. (*Id.* at ¶ 17 and Ex. 15.) Again, counsel for Opposer immediately sent a letter on November 18, 2004, detailing continued concerns. (*Id.* at ¶ 18 and Ex. 16.) Applicants’ counsel has not yet responded to the November 18 letter. (*Id.*) To move matters along, Opposer proposed that, until a protective order was agreed between the parties, documents be produced on an outside-attorneys-eyes’-only basis. (*Id.* at Exs. 11 and 12.) Applicants’ counsel refused this compromise. (*Id.* at Ex. 15.)

their refusal to produce documents responsive to Request No. 16, despite their clear obligation to produce such documents.

Applicants' Deficient Response to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29. In response to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29, Applicants responded that they would produce non-privileged, responsive documents “[t]o the extent they exist.” (Popp-Rosenberg Decl. Ex. 6.) In its October 13 Deficiency Letter, Opposer requested Applicants to advise whether responsive documents do in fact exist, and to produce such responsive documents. (*Id.* at Ex. 7.) Applicants have neither furnished this information nor produced documents responsive to any of these requests.

ARGUMENT

It is axiomatic that Opposer is entitled to documents responsive to all proper discovery requests. Since Applicants have failed to make a good faith document production in this proceeding despite having had ample opportunity to do so, and since Applicants refuse to produce documents responsive to certain proper document requests, the proper remedy is an order compelling production under TBMP § 523.01.

I. APPLICANTS HAVE FAILED TO MAKE A GOOD FAITH DOCUMENT PRODUCTION

Applicants have failed almost entirely to produce documents in response to Opposer’s properly propounded First Set of Requests for the Production of Documents and Things, even though it has had ample time in which to do so. Although Applicants affirmed that they would produce documents responsive to Document Requests Nos. 2-5, 7-8, 12, 17 and 19, they have produced a total of twenty pages consisting almost entirely of menus and related items. These twenty pages are responsive only to a portion of

Document Requests Nos. 2 and 5 (requesting, *inter alia*, “[s]amples of menus . . . and other promotional items on which Applicants use Applicants’ Mark”), a portion of Document Request No. 17 (requesting, *inter alia*, “[d]ocuments sufficient to show the location of all restaurants currently doing business under the name ‘Tiffany’s Restaurants’”), and a portion of Document Request No. 3 (requesting, *inter alia*, “documents concerning or referring to Opposer . . .”). (Popp-Rosenberg Decl. Ex. 3.) No documents have been produced in response to the other document requests for which Applicants indicated that they possessed responsive document. Those requests seek:

- “Samples of . . . napkins, matchbook covers, and any other promotional items on which Applicants use Applicants’ Mark” (Document Request No. 2);
- “[D]ocuments . . . concerning or referring to Opposer or Opposer’s Marks” (Document Request No. 3);
- “Documents, including photographs, sufficient to show signage bearing or displaying Applicants’ Mark” (Document Request No. 4);
- “Samples or photographs of each of the items identified in response to Interrogatory No. 4 [which requested identification of all materials on which Applicants use their mark]” (Document Request No. 5);
- “Documents . . . sufficient to establish the monies spent in advertising, marketing and promoting services provided under Applicants’ Mark for the last five years” (Document Request No. 7);
- “Documents concerning any licenses, franchise agreements, assignments, authorizations, consents, permissions, transfer of rights or other agreements entered into by or on behalf of Applicants concerning Applicants’ Mark” (Document Request No. 8);
- “Documents sufficient to identify all persons or entities who own, operate, control, or have an interest in restaurants that provide services under Applicants’ Mark” (Document Request No. 12);
- “Documents sufficient to show . . . the location of all planned Tiffany’s Restaurants” (Document Request No. 17); and

- “Representative samples of advertisements (regardless of media), brochures, promotional materials, point-of-sale displays, table tents, or marketing materials showing the manner in which Applicants have used or currently use Applicants’ Mark” (Document Request No. 19).

(Popp-Rosenberg Decl. Ex. 3.) Applicants also have failed to produce documents responsive to that portion of Document Request No. 9 concerning consummated franchise agreements, which they agreed to provide. (*Id.* at Ex. 6.)

By producing only twenty pages, it is clear that Applicants have either failed to undertake a search for responsive documents or are improperly withholding relevant documents. Whatever the explanation, Applicants have wholly failed to meet their obligations under Rule 34 of the Federal Rules of Civil Procedure, made applicable to Board proceedings by Section 2.120(a) of the Trademark Rules of Practice. They have also failed to fulfill their obligations “to cooperate with [Opposer] in the discovery process . . . and . . . to make a good faith effort to satisfy the discovery needs of [Opposer].” TBMP § 412.01.

The Board therefore should issue an Order compelling Applicants to produce within five (5) days of the Board’s Order all documents responsive to Document Requests Nos. 2-5, 7-8, 12, 17 and 19, as well as to that portion of Document Request No. 9 for which Applicants agreed to produce documents.

II. APPLICANTS’ BLANKET OBJECTION TO DOCUMENT REQUESTS NOS. 9 AND 16 ARE NOT WELL MADE

As explained in detail above, Applicants have refused to produce documents responsive to Document Requests No. 9 and No. 16, both of which requests seek documents related to Applicants’ plans for and attempts to expand their use of the mark

at issue.⁵ Applicants' refusal to produce documents responsive to these request is impermissible, as Applicants plans for expanding the number, location or nature of their restaurants, or their attempts to do so, is relevant to such factors as similarity of goods and consumers. The Board's Selected Discovery Procedures specifically state that "[a] party's plans for expansion may be discoverable." *See* TBMP § 414(8).

The Board therefore should issue an Order compelling Applicants to produce documents responsive to Document Requests Nos. 9 and 16 within five (5) days of its Order.

III. APPLICANTS' FAILURE TO STATE WHETHER DOCUMENTS RESPONSIVE TO REQUESTS NOS. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29 IS IMPROPER

As explained above, Applicants' responses to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29 stated that documents would be produced "[t]o the extent they exist." Applicants' refusal to state whether responsive documents exist or not, and its failure to produce responsive documents to the extent that they do exist, is impermissible. "[A] proper response requires *either* stating that there are responsive documents and they will be produced or withheld on a claim of privilege *or* stating that [Applicants have] no responsive documents." *No Fear, Inc. v. Rule*, 54 U.S.P.Q.2d 1551, 1555 (T.T.A.B. 2000). The Board therefore should issue an Order compelling Applicants within five (5) days of the Board's Order to provide in response to Document Requests Nos. 1, 6, 10-11, 13-15, 18, 20-22 and 25-29 both (1) appropriate responses stating whether or not responsive documents exist; *and* (2) any existing responsive documents.

⁵ Opposer also has concerns about Applicants' refusal to produce documents based on claims of attorney-client privilege and/or the work product doctrine. Opposer is not in a position to evaluate these claims – or object thereto – at this time because Applicants have not produced a privilege log. Therefore, Opposer

IV. APPLICANTS SHOULD RECEIVE DISCOVERY SANCTIONS FOR FURTHER MISCONDUCT

Where a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery, the Board may enter appropriate sanctions, as defined in Trademark Rule 2.120(g)(1). TBMP § 527. Such sanctions include, *inter alia*, drawing adverse inferences or entering judgment against the non-complying party. *Id.*

Here, in the event that Applicants again ignore their discovery obligations despite an Order from the Board, discovery sanctions would be appropriate. Applicants have utterly failed to meet their discovery obligations, making it increasingly difficult – if not impossible – for Opposer to prove its case. Applicants cannot be permitted to benefit from such conduct. Since Applicants have subverted the entire opposition process by their gross failure to comply with discovery, entry of judgment against them is an appropriate sanction.

CONCLUSION

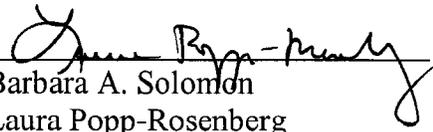
For the reasons stated above, Opposer respectfully requests the Board to grant Opposer's Motion to Compel in its entirety.

reserves its right to bring a further motion to compel based on any improper privilege claims asserted by Applicants after they produce a privilege log.

Dated: New York, New York
December 1, 2004

Respectfully submitted,

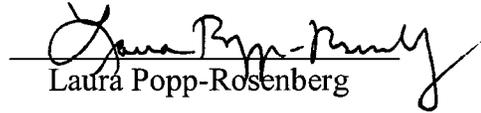
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CERTIFICATE OF SERVICE

The undersigned, counsel for Opposer Tiffany (NJ) Inc., hereby certifies that a true and correct copy of the attached Motion to Compel and Memorandum in Support Thereof was filed with the Trademark Trial and Appeal Board on December 1, 2004 via the Electronic System for Trademark Trials and Appeals ("ESTTA") and was served by pre-paid first-class U.S. Mail on December 1, 2004, on Scott E. Charney, Esq., Lerner, David, Littenberg, Krumholz & Mentlik, LLP, 600 South Avenue West, Westfield, New Jersey 07090, counsel for Applicants Anthony Siragusa and Michael Romanelli.


Laura Popp-Rosenberg

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