

ESTTA Tracking number: **ESTTA22604**

Filing date: **01/05/2005**

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	Opposer's Reply Memorandum in Support of Motion to Compel
Filer's Name	Evan Gourvitz
Filer's e-mail	egourvitz@frosszelnick.com
Signature	/Evan Gourvitz/
Date	01/05/2005
Attachments	91160913.pdf (11 pages)

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

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

**OPPOSER’S REPLY MEMORANDUM
IN SUPPORT OF MOTION TO COMPEL**

Pursuant to Trademark Rule of Practice § 2.120(e) and Fed. R. Civ. P. 37(a), Opposer Tiffany (NJ) Inc. (“Opposer”) hereby submits this memorandum in further support of its motion 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, and imposing discovery sanctions against Applicants should they fail to comply with the Board’s order.

INTRODUCTION

In their Application Serial No. 76/520,262 to register TIFFANY’S RESTAURANTS for restaurant services in International Class 43, Applicants have alleged use of that mark for more than twenty years. However, almost five months after being served with Opposer’s detailed requests for the production of documents, and despite Opposer’s repeated reminders, follow-up letters, and phone calls, to date Applicants have produced all of *twenty-four* pages of documents in response to Opposer’s requests. As discussed in Opposer’s original memorandum and as set forth below, this production does not begin to satisfy Applicants’ discovery obligations, and

Applicants have provided no reasonable excuse for their deficient production. Accordingly, Applicants should be compelled to produce any existing non-privileged responsive documents within five days, failing which they should be sanctioned for their misconduct.

ARGUMENT

Applicants claim in their memorandum in opposition to this motion that they “have produced copies [of] all nonprivileged responsive documents and things within [their] possession, custody, or control.” (Applicants’ Brief in Opposition to Opposer’s Motion to Compel (“App. Br.”) at 1.) However, the remainder of their brief concedes that this is false, and that they are withholding responsive documents without justification.

Clearly if documents do not exist they cannot be provided. Yet it is hard to fathom that a supposedly thriving business in existence for more than twenty years with three existing restaurants has all of twenty-four pages of responsive documents.

To date Applicants have chosen to play games instead of playing by the rules. They have made repeated assertions of privilege without producing any privilege log. (Section I.) They have admitted the existence of responsive documents but have produced only a token selection. (Section II.) They have refused to produce certain responsive documents without any good faith basis for doing so. (Sections IV, VII.) They have refused in some instances to say whether responsive documents do or do not exist. (Section V.) And they have refused to provide allegedly confidential documents until a protective order is entered, delayed negotiations on that order by months, and refused to produce those documents for review by outside counsel only while the order is being negotiated. (Section VI.)

This gamesmanship must end now. Applicants must produce a proper privilege log. They must confirm whether or not documents responsive to Opposer’s requests exist, and produce all

responsive documents, including documents they wrongly claim are irrelevant because they refer to Applicants' expansion plans. And they must produce confidential documents for review by outside counsel pending entry of a protective order.

I. Applicants Must Produce a Privilege Log

Throughout their original responses, and throughout their brief in opposition to Opposer's motion to compel, Applicants repeatedly have expressed objections to the Requests on the grounds of attorney-client privilege and work-product immunity. (*E.g.*, App. Br. at 9-11, 13-15 (Responses 13-14, 18, 24-27).) None of these objections ever has been supported by a privilege log, despite Opposer's request that Applicants provide their log. Opposer therefore requests that if Applicants continue to rely on a claim of privilege to justify their failure to produce documents, the Board issue an Order compelling Applicants to substantiate these claims by producing their privilege log for all documents they claim are subject to these privileges within five (5) days of the Board's Order. *See, e.g., Wiscon Corp. v. ACH Food Cos.*, Opp. No. 91159038, 2004 WL 2921817, *10 n.20 (T.T.A.B. 2004) ("where a claim of privilege is invoked, a party must make the claim expressly and provide a description or privilege log, unless the parties otherwise agree").

II. Applicants Must Produce *All* Documents Properly Responsive to Opposer's Requests

In their original responses to certain of Opposer's Requests (*e.g.*, Requests 1, 2, 3, 4, 5, 17, 18, 19, and 27), Applicants stated that they would produce responsive documents or a representative sample of responsive documents. As discussed in detail in Opposer's initial brief, however, Applicant's production to date has been strikingly deficient. Applicants now claim that their production of as little as *one page* in response to a given request discharges their obligation to respond. (*E.g.*, App. Br. at 4-6.) It is evident on its face that Applicants' extremely limited

production is not a good faith production as required by the relevant rules. TBMP § 408.01 (each party has a duty to make a good faith effort to satisfy the discovery needs of its adversary); *see also* Fed. R. Civ. P. 26(g)(1) (signature on disclosure certifies that to signer's knowledge after a reasonable inquiry the disclosure is complete and correct).

Tellingly, Applicants do not state in their brief that *all* documents responsive to the above requests have been provided, or even that *a representative sample* of such responsive documents have been provided, but only that “[d]ocuments and things responsive to this request have been provided,” or that “Applicants have provided documents responsive to this request.” (*E.g.*, App. Br. at 4-6.) Indeed, it seems almost impossible that Applicants do not have, or in a good faith search could not discover, for example, additional examples of “menus, napkins, matchbook covers, [or] other promotional items” bearing Applicant’s Mark (Request 2) that Applicants have used over the course of more than twenty years in business.¹

If there are additional responsive documents they must be produced. If Applicant knows that there are *not* any additional responsive documents it must say so. *E.g.*, *No Fear, Inc. v. Rule*, 54 U.S.P.Q.2d 1551, 1555 (T.T.A.B. 2000) (“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”) (emphasis added). Opposer thus reiterates its request that the Board issue an Order compelling Applicants within five (5) days of the Board’s Order to either (i) produce all remaining documents responsive to these Requests, or

¹ In their brief, Applicants appear to be using the definition of “Applicants’ Mark” in Opposer’s Requests as an excuse to withhold additional responsive documents. (*See* App. Br. at 4, 5 n.1.) Applicants seem to believe since Opposer defined Applicant’s Mark as “the mark TIFFANY’S RESTAURANTS as applied for in [Applicants’ application], and which is the subject of this Opposition,” this excuses them from producing documents concerning their use of TIFFANY’S alone or other TIFFANY-formative marks. This limitation is improper, particularly since in their application Applicants have disclaimed any right to use RESTAURANTS apart from the mark as shown. *See also* Fed. R. Civ. P. 37(a)(3) (“an evasive or incomplete disclosure, answer, or response is to be treated as a failure to disclose, answer or respond”).

(ii) expressly state that no such documents exist. Given Applicants' repeated statements that they have been diligent and comprehensive in their search for documents (*E.g.*, App. Br. at 1-3), the Order also should preclude Applicants from relying later in this proceeding on any documents responsive to these Requests that were not produced. *See* TBMP § 408.02.

III. Where Applicants Have Said They Have *No* Documents Responsive to Opposer's Requests, They Should be Barred From Introducing Such Documents Later in the Proceedings

In response to certain of Opposer's Requests, including Requests 3, 10, 12, 15, 20, 21, 22, 23, and 29, despite claiming in their initial responses that they would produce responsive non-privileged documents, Applicants now say that "[n]o such documents exist," "[n]o such documents have been found," "[n]o such documents have been found or are known to exist," or even that "to date no documents within the possession, custody, or control . . . have been uncovered from Applicants files." (*E.g.*, App. Br. at 5, 8, 12, 13.) Applicants should be held to their word and barred from introducing any evidence responsive to these requests later in the proceeding. TBMP § 408.02.²

IV. Applicants Cannot Hide Behind the Claim that Certain Documents Are Not Within Their "Possession, Custody or Control"

In certain responses, Applicants now seek to avoid their obligation to produce documents by claiming without justification that the requested information is not in their "possession, custody or control." Their excuse is without merit.

In response to Request 6, which asked for "[d]ocuments sufficient to show where and to whom Applicants advertise their services under Applicant's Mark," Applicants first said they would "produce a representative sample of documents and things responsive to this request," but

² To the extent that Applicants have *no* documents responsive to certain of Opposer's requests, this highlights the importance of deposing both of Applicants' principals. Opposer intends to schedule these depositions as soon as this motion is resolved.

now claim that “[a]fter conducting a diligent search for sample advertisements, it is evident that none are currently within Applicant’s possession, custody, or control.” (App. Br. at 6.) This is deliberately evasive. *See* Fed. R. Civ. P. 37(a)(3) (evasive or incomplete response treated as failure to disclose). Opposer’s Request did not merely ask for sample advertisements, but for any documents they have (*e.g.*, receipts, invoices, bills, etc.) evidencing where and to whom they have advertised their services.³ While they claim that they “have advertised in the past with *Clipper Magazine*” in Pennsylvania (App. Br. at 6), they do not detail what (if anything) they have done to try to get a copy of the advertisement, or whether they have additional documents evidencing or relating to this advertisement.

In response to Request 11, which asked for representative sample articles concerning restaurant services provided under Applicant’s Mark, Applicants initially said they would “produce nonprivileged documents responsive to this request which are in the possession, custody or control of Applicants,” but now say that, although that they “maintain a publicly displayed collection of press clippings” at one of their restaurants, “[n]o copies of the clippings are within the possession, custody, or control of Applicants.” (App. Br. at 9.) Again, this is disingenuous and deliberately evasive. The clippings themselves clearly are within Applicants’ control, and can be produced by photocopy or otherwise.

³ Moreover, Applicants’ current statement that they “commissioned only a very limited volume of advertising for their services” (App. Br. at 6) seems at odds with their response to Opposer’s Interrogatory 9, where they said they would “provide a representative sample of local and national publications in which Applicants have advertised or promoted its services under Applicant’s Mark . . .” and that advertisements for their restaurants currently are being promoted on the WPLJ and WFAN radio stations. Assuming this current statement is true, Applicants have yet to produce a single document to show what advertising they have commissioned. Also, while Applicants noted in their interrogatory response that they maintain a website, have hung various banners, digital reader boards, manual boards and other signage at their restaurants, that they maintain a database of customers’ birthdays, and that they forward letters or emails to customers on their birthdays, they have produced no documents evidencing these uses.

In addition, in response to Request 25, which asked for documents concerning Applicants' application for the mark at issue, Applicants initially said they would produce "non-privileged documents responsive to this request, including written communications with the [PTO]," but now state that responsive documents are "believed to exist" at "the law firm of Wolf, Block, Schorr and Solis-Cohen" in Roseland, New Jersey, but that "despite numerous attempts to obtain such documents," they "have been unsuccessful," so the files presently are not in their possession, custody or control. (App. Br. at 13-14.) Whatever dispute Applicants may be having with this firm, documents held by Applicants' attorneys clearly are in their possession, custody or control, *see, e.g., 7 Moore's Federal Practice* § 34.14[2][c] at 34-69 (3d Ed. 2004), and Applicants are obligated to produce them.

V. Applicants Should Be Required to Immediately Produce the Documents They Now Have Agreed to Produce, and to Specify Whether Documents Exist Where They Have Not Done So

In response to Opposer's Requests 13 and 14, Applicants initially said they would "produce non-privileged documents responsive to" Request 13 "[t]o the extent they exist," and to Request 14 "[t]o the extent any such documents are found, although none have been located." Applicants now have reversed these qualifications, saying that they will "produce non-privileged documents responsive to" Request 13 "[t]o the extent any such documents are found, although none have been located," and to Request 14 "[t]o the extent they exist." (App. Br. at 9-10.) They have not, however, stated whether any such responsive documents exist, or when or where they will be produced. While Applicants initially said in response to Opposer's Request 26 that they would "produce non-privileged documents" "[t]o the extent they exist," they now state only that they "maintain their objections" to the Request (App. Br. at 14), and again have not specified whether any such responsive documents exist, or when or where they will be produced. Similarly, while

Applicants initially said in response to Request 28 that they “will produce” non-privileged responsive documents “[t]o the extent they exist,” they now say that they “have produced documents, if any,” responsive to this Request (*id.* at 15), but have not stated which documents do so, or whether further documents are forthcoming.

As noted above, “a proper response [to a request] 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*, 54 U.S.P.Q.2d at 1555 (emphasis added). Accordingly, and since Applicants have had five months to investigate, Opposer repeats its request that the Board issue an Order compelling Applicants within five (5) days of the Board’s Order to either produce documents responsive to these requests or to expressly state that so such documents exist, and to be barred from introducing any additional evidence responsive to these requests later in the proceeding.

VI. Applicants Should Be Required to Immediately Produce the Documents They Claim They Are Withholding Pending Entry of a Protective Order

Applicants state in their memorandum that they will produce documents responsive to Opposer’s Requests 7, 8, and 9 “upon entry of a suitable protective order.” (App. Br. at 7-8.) However, Applicants have repeatedly delayed the negotiation of this order.

Applicant provided an initial draft order on October 29, 2004. (Popp-Rosenberg Decl., Ex. 13.) Three days later, on November 1, Opposer requested that Applicant produce “all responsive documents, regardless of confidentiality” by November 10, and proposed that it “review these documents on an ‘outside attorneys’ eyes only’ basis until the protective order is in place.” (*Id.*, Ex. 12.) On November 16, Applicant refused to agree to this, stating that they would produce confidential documents only “once the protective order is signed.” (*Id.*, Ex. 15 at 2.) On November 18, Opposer’s counsel responded, attempting to resolve the issues

remaining in dispute and finalize the order. (*Id.*, Ex. 16.) However, despite Opposer's November 18 request that Applicant send a revised version of the protective order by November 22 (*id.* at 2) and a follow-up call by Opposer's counsel on December 20, 2004, Applicant has yet to respond to Opposer's last proposed revisions.

Applicants should not be permitted to benefit from their own delay. Accordingly, Opposer requests that the Board issue an Order compelling Applicants within five (5) days of the Board's Order to either produce non-privileged documents responsive to these requests as "outside attorneys' eyes only" documents pending execution of the protective order, or, if no such documents exist, to expressly state that this is the case.

VII. Applicants Must Produce Documents Relating to All Attempts to License or Franchise Their Business, Whether or Not They Have Been Consummated

Opposer's Requests 8, 9, 16, and 17 all request information from Applicants that includes information about their efforts to license, franchise or otherwise expand the business they conduct under Applicant's Mark. In response, Applicants have flatly stated "[o]nly efforts which are consummated are relevant in this Opposition." (App. Br. at 8.) In an attempt to evade the clear language of TBMP § 414(8), which states "[a] party's plans for expansion may be discoverable under protective order," Applicant claims that because the case cited to in the footnote to TBMP § 414(8) merely addresses expansion to include similar products, Applicants' plans to expand its use of the mark through licensing or franchising are not relevant and should not be discoverable.⁴ (App. Br. at 16-17.) This is simply mistaken. Such information is relevant under Fed. R. Civ. P. 26(b)(1) and TBMP § 402.01 as "reasonably calculated to lead to the

⁴ Applicants also state that because Opposer is not presently moving to compel an answer to its Interrogatory 5, they assume that Opposer has acquiesced to Applicants' position with respect to that Interrogatory. (App. Br. at 16 n.3.) This is incorrect. Opposer reserves its right to move to compel a more complete answer to this Interrogatory if a clear response is not provided during depositions.

discovery of admissible evidence,” including on issues such as whether Applicants made representations to potential licensees or franchisees about their right to use or license the TIFFANY’S RESTAURANT mark or other TIFFANY-formative marks.⁵

VIII. Applicants Should Be Sanctioned For Discovery Misconduct If They Fail to Produce the Above Documents in Response to an Order from the Board

As noted in Opposer’s original brief, when 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, including drawing adverse inferences or entering judgment against the non-complying party. 37 C.F.R. § 2.120(g)(1); TBMP § 527. Given Applicants’ gross failure to comply with discovery to date, if Applicants fail to abide by any Order of the Board resulting from this motion, entry of judgment against them would be an appropriate sanction.

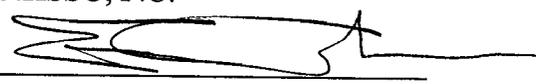
CONCLUSION

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

Dated: New York, New York
January 5, 2005

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

Barbara A. Solomon
Laura Popp-Rosenberg
Evan Gourvitz

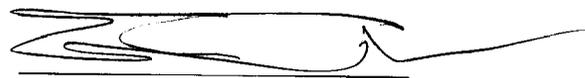
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

Attorneys for Opposer Tiffany (NJ) Inc.

⁵ Also, Applicants’ claim that “Opposer’s request is an attempt to obtain information as to Applicants’ expansion plans, so Opposer may use that information for a future licensing proposal” (App. Br. at 17) is simply absurd. For obvious reasons, Opposer has no interest in licensing its mark to Applicant.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Reply Memorandum in Support of Motion to Compel was filed with the Trademark Trial and Appeal Board on January 5, 2005 via the Electronic System for Trademark Trials and Appeals (“ESTTA”) and was served by pre-paid first-class U.S. Mail on January 5, 2005, 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.



Evan Gourvitz

I:\egourvitz\TFFJ\041230-0413531-reply-motion-compel.doc