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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

Scott E. Charney
908.518.6336
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April 1, 2005

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: GOOSSES 10.2A-001
Tiffany (NJ) Inc. v. Anthony Siragusa and Michael Romanelli
Opposition No.: 91160913, Serial No.: 76/520,262
Mark: **TIFFANY'S RESTAURANT**

Dear Sir:

In connection with the above-referenced Opposition proceeding, enclosed please find an original of the following:

1. Applicant's Motion To Enter A Protective Order Pursuant To 37 C.F.R. § 2.120(f) and,
2. Certificate of Service.

Respectfully yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg
Enclosures



04-04-2005

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #32

non-confidential documents while Opposer has withheld all document production pending entry of a Protective Order.

I. INTRODUCTION

Both Parties have served various discovery requests, including requests for the production of documents and things. Many of the individual requests call for the production of materials and things which are considered by one of the Parties to be confidential or trade secret information. In order to adequately protect such information, the Parties agree that a suitable Protective Order is needed. However, the Parties have been unable, despite good faith efforts, to agree on the specifics of such an order. Applicants now request that the Board enter the proposed Protective Order attached herein as Exhibit A, which is believed to be a fair and reasonable Order for both Parties based on the negotiations to date and the recommended Order of the Board.

II. FACTS / ARGUMENT

As early as October 2004, the Parties began discussing the entry of a Protective Order to adequately protect the confidential and trade secret information sought in the Parties various discovery requests. Applicants initially requested that the Board's standard order be utilized. However, Opposer stated that it would not accept the Board's Order. (*See* Exh. C.)

After Opposer identified those aspects of the Board's standard Order that it rejected, even though Applicants did not agree on many, Applicants altered the Order to accommodate the vast majority of these objections. (*See* Exh. D.) Applicants believed that several of the parts where Opposer had raised objections were in fact sufficiently tailored to adequately protect the parties' interests. With Applicants accommodating Opposer in almost every instance, the issues were

reduced to two. Applicants should not have to bend further in response to more of Opposer's demands.

The remaining portions of the Board's standard Order that Opposer requests be changed are Parts 5 and 11. It is Applicants' belief that these Parts are sufficient as drafted to protect the interests of both parties, and should be entered as provided in the Board's standard order. Opposer has requested extensive modifications to each, which Applicants' cannot agree to.

With respect to Part 5, Opposer insists that it will not enter into a Protective Order which requires pre-disclosure of experts to the party whose confidential material is being divulged. (*See* Exh. E.) The provision is in the Board's standard order for a good reason — to safeguard confidential information. Opposer proposes that the party whose confidential information is being disclosed be left only with the remedy of attacking the credibility of the expert or the accuracy of his methods after the disclosure. Unfortunately, this would be after the harm has been done and cannot be effectively corrected.

Applicants prefer the prophylactic nature of the Board's standard provision over Opposer's suggestion. It is abundantly clear that in Opposer's suggested scenario, the damage of disclosure will have already taken place prior to any protective measures being implemented. In fact, such a provision allows no protective measures — whether against the particular "expert" to which disclosure is made or to the number of experts utilized. Under the Board's standard Protective Order, adopted by Applicants, Applicants (or Opposer for that matter) have the ability to pre-screen the expert as to independence and qualifications as an expert and also can limit the sheer number of experts to which the confidential information will be disclosed. This is not a veto power as suggested by Opposer, but an attempt to insure that Applicant's confidential and

trade secret information is not disclosed to an "expert" who would be in a position to misuse the information.

With respect to Part 11, Opposer requests that Applicants stipulate that discovery from this case may freely be used in any subsequent case between the parties. For one, this request is premature as no other case is currently pending. In any event, Applicants have agreed that the discovery from this case may be used in appeals which do not constitute *de novo* actions — *i.e.*, discovery may be used for appeals to the Federal Circuit. Applicants have also agreed to revisit the request should an appropriate matter, such as one at the district court level, be filed.

III. CONCLUSION

Both Parties agree that a Protective Order is required in this case. However, the Parties have been unable to agree on two aspects of a suitable Protective Order. Applicants therefore request that the Board enter the proposed Protective Order which is based on the Board's suggested Protective order.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

600 South Avenue West
Westfield, NJ 07090-1497

Tel: 908.654.5000

Fax: 908.654.7866

*Attorneys for Applicants Anthony Siragusa
and Michael Romanelli*

Dated: April 1, 2005

By: Scott E. Charney
Scott E. Charney

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the within APPLICANT'S MOTION TO COMPEL DISCOVERY PURSUANT TO 37 C.F.R. § 2.120(e), was served upon the following counsel of record this 1st day of April, 2005, as follows:

VIA FIRST-CLASS MAIL:

Barbara A. Solomon, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

Attorneys for Opposer Tiffany (NJ) Inc.



Scott E. Charney

GOOSES 10.2A-001
Opposition No. 91160913

Exhibit A

TERMS OF ORDER

1. Classes of Protected Information

The Rules of Practice in Trademark Cases provide that all *inter partes* proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing the designation **Confidential**.

2. Information Not to Be Designated as Protected

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3. Access to Protected Information

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order.

- ◆ **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- ◆ **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- ◆ **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- ◆ **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Outside counsel, but not **in-house counsel**, shall have access to information designated as **Confidential**, subject to any agreed exceptions.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to **Confidential** information in accordance with the terms that follow in paragraphs 4 and 5.

4. **Disclosure to Any Individual**

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed

certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5. Disclosure to Independent Experts or Consultants

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6. Responses to Written Discovery

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the

error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7. Production of Documents

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8. Depositions

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9. Filing Notices of Reliance

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10. Briefs

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11. Handling of Protected Information

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case, including any direct appeals which do not constitute *de novo* actions. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12. **Redaction; Filing Material With the Board**

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13. Acceptance of Information; Inadvertent Disclosure

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error. A receiving party is entitled to rely on a producing party's original designation of information as not protected until such time as the producing party notifies the receiving party of the error. A receiving party is not required to recall any information that has been designated as protected subsequent to its production, or to take any other action except to recognize the protected status of the information after receipt of such notification.

14. Challenges to Designations of Information as Protected

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15. Board's Jurisdiction; Handling of Materials After Termination

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16. Other Rights of the Parties and Attorneys

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

CONSENTED TO BY:

FROSS ZELNICK LEHRMAN & ZISSU, P.C.
Attorney for Opposer Tiffany (NJ) Inc.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
*Attorneys for Applicants Anthony Siragusa
and Michael Romanelli*
600 South Avenue West
Westfield, NJ 07090

By: _____

By: _____

Date: _____

Date: _____

By Order of the Board, effective _____.

By:

Exhibit B

terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. ~~If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.~~

TERMS OF ORDER

1. Classes of Protected Information

The Rules of Practice in Trademark Cases provide that all *inter partes* proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations Confidential.

~~**Confidential** — Material to be shielded by the Board from public access.~~

~~**Highly Confidential** — Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.~~

~~**Trade Secret/Commercially Sensitive** — Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.~~

2. Information Not to Be Designated as Protected

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party

witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3. Access to Protected Information

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. ~~Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of~~ paragraph 4.

- ◆ **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- ◆ **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- ◆ **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- ◆ **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

~~Parties and their attorneys~~ Outside counsel, but not in-house counsel, shall have access to information designated as eConfidential ~~or highly confidential~~, subject to any agreed exceptions.

~~Outside counsel~~, but not ~~in-house counsel~~, shall have access to information designated as ~~trade secret/commercially sensitive~~.

Independent experts or consultants, non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to eConfidential ~~or highly confidential~~ information in accordance with the terms that follow in paragraphs 4 and 5. Further, ~~independent experts or consultants~~ may have access to ~~trade secret/commercially sensitive~~ information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4. Disclosure to Any Individual

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5. Disclosure to Independent Experts or Consultants

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party

which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6. Responses to Written Discovery

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7. Production of Documents

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party

makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8. Depositions

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9. Filing Notices of Reliance

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

10. Briefs

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

11. Handling of Protected Information

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case, including any direct appeals which do not constitute *de novo* actions. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

12. Redaction; Filing Material With the Board

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire

page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare.**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

13. Acceptance of Information; Inadvertent Disclosure

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error. A receiving party is entitled to rely on a producing party's original

designation of information as not protected until such time as the producing party notifies the receiving party of the error. A receiving party is not required to recall any information that has been designated as protected subsequent to its production, or to take any other action except to recognize the protected status of the information after receipt of such notification.

14. Challenges to Designations of Information as Protected

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

15. Board's Jurisdiction; Handling of Materials After Termination

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of

this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

16. Other Rights of the Parties and Attorneys

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

CONSENTED TO BY:

FROSS ZELNICK LEHRMAN & ZISSU, P.C.
Attorney for Opposer Tiffany (NJ) Inc.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
*Attorneys for Applicants Anthony Siragusa
and Michael Romanelli.*
600 South Avenue West
Westfield, New Jersey 07090

By: _____

By: _____

Date: _____

Date: _____

By Order of the Board, effective _____.

By:

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

TIFFANY (NJ) INC.,	:	
	:	Mark: TIFFANY'S RESTAURANTS
Opposer,	:	
v.	:	Serial No.: 76/520,262
	:	
ANTHONY SIRAGUSA and MICHAEL	:	Opposition No. 91160913
ROMANELLI,	:	
	:	
Applicants.	:	
_____	:	X

UNDERTAKING

I, _____, represent that I have been provided and have read and understand the Protective Order entered in the above-captioned opposition; that I will abide by its terms and conditions in handling any designated "confidential" or "protected" information; that I will not disclose, except in accordance with the terms of the Protective Order, any information, materials or knowledge received in the course of my work in this matter which is subject to the terms of the Protective Order; and that I subject myself to the jurisdiction of the above-identified Board in connection with any proceeding or hearing relating to "confidential" or "protected" information or any proceeding relating to the enforcement of the Stipulated Protective Order.

I declare under the penalty of perjury that the foregoing is true and correct.

Dated: _____, 2004.

Name:

Address:

Exhibit C

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

RONALD J. LEHRMAN
DAVID WEILD III
STEPHEN BIGGER
MICHAEL I. DAVIS
ROGER L. ZISSU
MARIE V. DRISCOLL
RICHARD Z. LEHV
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JANET L. HOFFMAN
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LAWRENCE ELI APOLZON
BARBARA A. SOLOMON
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NANCY SABARRA
LAURA POPP-ROSENBERG
IRENE SEGAL AYERS
CARA BOYLE
JOHN M. GALLACHER

*ADMITTED IN OH. ONLY

November 1, 2004

BY FACSIMILE & MAIL

Scott E. Charney, Esq.
Lerner, David, Littenberg, Krumholz &
Mentlik, LLP
600 South Avenue West
Westfield, New Jersey 07090

Re: Objection to application to register TIFFANY'S RESTAURANT
(Our Ref.: TFFJ USA TC-04/13531; Your Ref: GOOSES 10.2A-001)

Dear Mr. Charney:

I am in receipt of the draft Protective Order. In truth, I was quite surprised that you sent to me the form Protective Order from the TTAB when I told you quite clearly that this is unacceptable to us. We will not agree to any Protective Order that allows any of our client's confidential material to be provided to Messrs. Siragusa and Romanelli. Further, we will not agree to any Protective Order that requires us to disclose the name of independent experts or consultants to you before we show those consultants or experts your clients' confidential information. Indeed, you were well aware of our position on this before you sent me the Order. The fact that you have made no attempt to revise this Agreement to address our concerns suggests that you have no intention of trying to work out something mutually acceptable. I note, for example, that the first page of the Protective Order, second paragraph, has language that the Board directs to the parties and has nothing to do with a final order as entered. Yet you have included it anyway. In addition to the objections that I have already noted, other concerns about the Protective Order include:

1. Paragraph 3, the sentence beginning with "Court reporters, stenographers . . ." must be deleted.

Scott E. Charney, Esq.
November 1, 2004
Page 2

2. There needs to be a statement that a signature of a member of the outside counsel's firm is sufficient to bind the entire firm.

3. It is unclear whether you intend for in-house counsel to have to sign the Agreement.

4. The Agreement needs to be made clear that disclosed information may be used for purposes of this case, including any appeals regardless of whether those appeals are to the federal circuit or in connection with the *de novo* action in federal district court.

5. We object to the reference to "substantially contemporaneous" in Paragraph 14 on the grounds that it is overly burdensome.

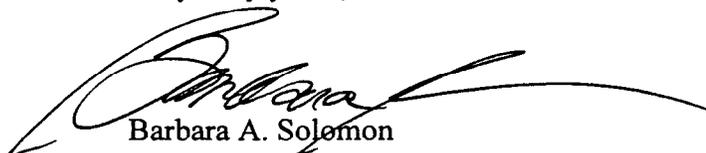
6. There needs to be provision concerning the ramifications of inadvertent disclosure of confidential information. It needs to be made clear that a party who receives material that has not been properly designated as confidential may make free use of the materials. If, at a later point, the producing party designates the material as confidential, this does not create a burden on the receiving party to recall any documents that have been re-designated as confidential or to take any other action. The confidentiality designation would work on a going forward basis only.

If you are indeed acting in good faith, we would ask that you produce all documents to us, regardless of whether they are confidential, while the terms of the agreement are worked out and that you forward to us a revised Confidentiality Agreement incorporating these comments.

Turning to the discovery requests you served on our client, please advise us by no later than Wednesday, November 3, as to whether you will agree to extend our client's time to respond to discovery by 30 days (as you took). I previously advised you that we would seek such an extension. If we do not hear from you by that date, we will make a motion to the Board.

Finally, on your request for dates of availability for deponents from our client, we cannot provide that to you until we receive the topics on which you seek deposition testimony.

Very truly yours,

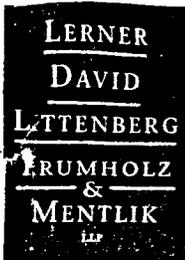


Barbara A. Solomon

BAS/fok,gc

cc: Laura Popp-Rosenberg, Esq.

Exhibit D



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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

Scott E. Charney
908.518.6336
scharney@ldlkm.com

November 16, 2004

VIA FACSIMILE (212 813 5901)
CONFIRMATION BY MAIL

Barbara A. Solomon, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

Re: GOOSSES 10.2A-001
Tiffany (NJ) Inc. v. Anthony Siragusa and Michael Romanelli
Opposition No.: 91160913, Serial No.: 76/520,262
Mark: TIFFANY'S RESTAURANT

Dear Ms. Solomon:

We are in receipt your and Ms. Popp-Rosenberg's latest letters raising various issues in this case.

As to the protective order, you are correct that the draft forwarded is that suggested by the TTAB. I stated such in my correspondence. You will note, however, that I also requested your specific, limited objections, so we may move forward with negotiating its various terms. In our previous conversations on this issue you did not identify specific sections of the Protective Order with sufficient detail to permit my addressing of them. Now that we have your fully articulated objections, we state the following:

1. We agree to delete the sentence in Paragraph 3 beginning with "Court reporters, stenographers"
2. This is acceptable to us.
3. We agree to include a signature line for in-house counsel provided that you permit our client to designate one representative who may view documents classified as Confidential or Highly Confidential, as our client does not presently employ in-house counsel. If this is acceptable, please provide us with the firm's information that acts as in-house counsel for Tiffany (NJ).
4. We agree that the disclosed materials may be used for appeals before the Federal Circuit. However, any contemplated use in connection with a *de novo* proceeding before a Federal District Court is clearly premature. Should an action be commenced in a Federal District Court, the issue may be readdressed.



Barbara A. Solomon, Esq.
November 16, 2004
Page 2

5. We agree to remove the text stating "substantially contemporaneous with the designation, or" from paragraph 14.

6. We believe that your point is adequately covered in paragraph 13 of the Protective Order. If you have a specific provision that you would like us to add, please provide it. We can assure you that we generally agree with your position.

If these terms are acceptable to you, we will proceed to draft a revised Protective Order. In the meantime, we do not agree to produce documents on an "Attorney's Eyes Only" basis. We will produce confidential documents, to the extent that responsive confidential documents exist, once the Protective Order is signed

In regard to your request for a 30-day extension to respond to our discovery requests, we agree to consent to the 30-day extension if the parties agree to extend all dates in the proceeding by 3 months.

We object to your deposition notices for Mr. Romanelli and Mr. Siragusa. Mr. Romanelli resides in New Jersey. You may take his deposition at our office, in Westfield, New Jersey. We will inform you of available dates when we have them. We object to the taking of Mr. Siragusa's deposition. Mr. Siragusa's knowledge of the matters in this case are extremely limited. His schedule makes it such that any deposition is an extraordinary burden which outweighs its usefulness.

Please be assured that amended responses to your discovery requests, verified by our client, will be prepared and forwarded to your office. With specific respect to Interrogatory No. 5, and other related requests, the opening of future restaurants is not relevant to this proceeding, notwithstanding your reference to TBMP § 414(8). Clearly, § 414(8) speaks solely to expansion of a business in the sense of its scope, not number of facilities, as articulated in footnote 233 thereto.

Finally, we request that you adopt a more civil tone in all future correspondence.

Very truly yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC:dlb/def/clg



Barbara A. Solomon, Esq.

November 16, 2004

Page 3

bcc: Thomas Bernard (*via email, tpetras@tiffanysrestaurant.com*)
Michael Romanelli (*via email, mromanelli52@hotmail.com*)

*** TX REPORT ***

TRANSMISSION OK

TX/RX NO 0985
CONNECTION TEL 12128135901
CONNECTION ID
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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West • Westfield, NJ 07090
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To:	Fax Number	Voice Number
Barbara A. Solomon, Esq.	(212) 813-5901	
Fross Zelnick Lehrman & Zissu, P.C.		

From: Scott Charney, Esq.
Date: November 16, 2004
Client/Matter No: GOOSES-1

No. Pages: 3 Original Mailed: Yes

● MESSAGE:

Exhibit E

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

RONALD J. LEHRMAN
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STEPHEN BIGGER
MICHAEL I. DAVIS
ROGER L. ZISSU
MARIE V. DRISCOLL
RICHARD Z. LEHV
DAVID W. EHRLICH
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IRENE SEGAL AYERS
CARA BOYLE
JOHN M. GALLACHER
*ADMITTED IN OH. ONLY

CONFIRMATION COPY

November 18, 2004

BY FACSIMILE AND MAIL

Scott E. Charney, Esq.
Lerner, David, Littenberg, Krumbolz & Mentlik, LLP
600 South Avenue West
Westfield, New Jersey 07090

Re: Objection to application to register TIFFANY'S RESTURANTS
(Our Ref.: TFFJ USA TC-04/13531; Your Ref.: GOOSES 10.2A-001)

Dear Mr. Charney:

We have received your letter of November 16, 2004 responding to various issues we had raised in prior correspondence.

In regard to the issue of extensions, we will agree to condition the extension of time for Tiffany to respond to your clients' discovery requests on a three-month extension of all dates in this proceeding. Towards that end, we have filed with the Board today the necessary Motion to Extend Trial Dates With Consent, a service copy of which is enclosed. Our client's discovery responses will now be due December 29, 2004.

Turning to the protective order, while you have agreed to revise the draft agreement to respond to some of our objections, you have not remedied all of the objectionable provisions.

First, we cannot agree to any protective order that would allow our client's confidential material to be provided to Mr. Siragusa and/or Mr. Romanelli, or to any Tiffany's Restaurant employee. As you are undoubtedly aware, it is typical for in-house counsel, but not business personnel, to be able to review confidential documents, and we therefore do not see why your clients' lack of "in-house" counsel should impede Tiffany's in-house counsel from exercising its normal rights and privileges as an attorney representing its client. However, in the interest of moving this proceeding forward, we will agree that neither party may have access to confidential

documents – *i.e.*, that access to all confidential documents will be limited to outside counsel's eyes only. Thus, the protective order will be a single-tiered. We reserve the right, however, to readdress this issue in the future and, if necessary, take it up with the Board.

Second, we see no need to limit the use of discovery materials to this proceeding and any appeals therefrom. Case law strongly favors allowing the use of discovery materials in other litigations: “[a]llowing the fruits of one litigation to facilitate preparation in other cases advances the interests of judicial economy by avoiding the wasteful duplication of discovery.” *Foltz v. State Farm Mut. Auto. Ins. Co.*, 331 F.3d 1122, 1131 (9th Cir. 2003). Thus, it would be improper to restrict in advance either party's ability to use discovery materials from this proceeding in subsequent litigation. Moreover, the protective order, which acts as a contract between the parties, still would be in effect, so that the use of confidential materials in subsequent actions would not jeopardize the confidential nature of those materials.

Third, we do not believe Paragraph 13, as currently drafted, adequately addresses the concerns raised in Ms. Solomon's November 1, 2004 letter. We believe the following language should be added to the end of the paragraph:

A receiving party is entitled to rely on a producing party's original designation of information as not protected until such time as the producing party notifies the receiving party of the error. A receiving party is not required to recall any information that has been designated as protected subsequent to its production, or to take any other action except to recognize the protected status of the information after receipt of such notification.

Finally, you did not address a point raise in the opening paragraph of Ms. Solomon's November 1, 2004 letter concerning the provision requiring us to disclose the names of independent experts or consultants to you before we show those consultants or experts your clients' confidential information. Paragraph 5 of your draft protective order must be deleted, and disclosure to independent experts or consultants should be covered exclusively by Paragraph 4.

With these comments in mind, please forward a revised draft protective order that remedies all of the objections we have raised. Since you continue to refuse to produce confidential documents until the protective order is signed, we ask that you send us the revisions by Monday, November 22, 2004.

In regard to the issue of the depositions, your objection to our taking the deposition of Mr. Siragusa is inappropriate. Mr. Siragusa is an applicant, and is equally a part of this proceeding as Mr. Romanelli. We are therefore entitled to take his deposition. *See* TBMP § 404.05 (“In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party . . . may be taken on notice alone.”); *see also* TBMP § 404.02 (“A discovery deposition may generally be taken of any person . . .”). Once we are in possession of

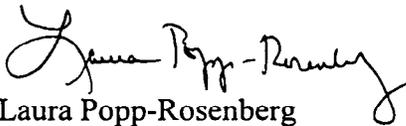
Scott E. Charney, Esq.
November 18, 2004
Page 3

Applicants' full document production, we will set new dates for the depositions already noticed, including the deposition of Mr. Siragusa, at your offices.

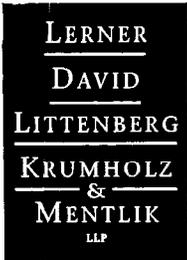
In regard to Applicants' discovery responses, you have yet to respond to the numerous deficiencies pointed out in my letter of November 1, 2004, or in Ms. Solomon's letter of November 2, 2004 regarding Applicants' bad faith production. Concerning your continued refusal to produce documents related to Applicants' plans or attempts to expand its business, we maintain our position that these documents are relevant and must be produced. We repeat yet again our request that Applicants produce *all* responsive documents. We are prepared to file on Monday, November 22, 2004, a motion to compel production unless we receive either immediate production or immediate notification of a date when such production will take place.

Finally, we request that, in the future, you extend to us the professional courtesy of returning our various telephone calls and responding our letters in a timely manner.

Very truly yours,


Laura Popp-Rosenberg

cc: Barbara A. Solomon, Esq.



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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

Scott E. Charney
908.518.6336
scharney@ldlkm.com

April 1, 2005

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: GOOSSES 10.2A-001
Tiffany (NJ) Inc. v. Anthony Siragusa and Michael Romanelli
Opposition No.: 91160913, Serial No.: 76/520,262
Mark: **TIFFANY'S RESTAURANT**

Dear Sir:

In connection with the above-referenced Opposition proceeding, enclosed please find an original of the following:

1. Applicant's Motion To Compel Discovery Pursuant To 37 C.F.R. § 2.120(e) and,
2. Certificate of Service.

Respectfully yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg
Enclosures



04-04-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #32

I. INTRODUCTION

The Trademark Trial and Appeal Board rules stipulate that a party may serve 75 interrogatories, inclusive of subparts. In counting the total number of interrogatories present in a request, the Board states that it will look to the substance of the interrogatory, and will count each question as a single interrogatory. T.B.M.P. § 405.03(d). Applicants' interrogatory requests, numbered 1-35, do not exceed the 75 interrogatory limit, and answers to each should be compelled. In the alternative, Applicants request leave to serve interrogatories in excess of the numerical limit.

II. FACTS

Applicants served Interrogatory Requests Nos. 1-35 on Opposer on October 24, 2004. On December 29, 2004, Opposer responded with only a general objection claiming that the number of interrogatories exceeded the numerical limit, per T.M.E.P. § 405.03(e). Applicants believe that the objection is without merit and request that the Board compel responsive answers.

Applicant has made a good faith attempt to remedy this dispute. Such attempts include various correspondence between the parties, including Applicants' correspondence of January 4, 2005 wherein Applicants requested that Opposer at least explain how it counted the interrogatories to exceed. (*See* Exh. A.) Opposer responded with a refusal to provide the basis, and a suggestion that Applicants file a Motion to Compel. (*See* Exh. B.) On January 26, 2005, Applicants made a second request for Opposer to provide a basis for its objection. (*See* Exh. C.) That request was summarily rejected. (*See* Exh. D.)

In each of its denials, Opposer hides behind the Trademark Rules of Practice, rather than making a legitimate attempt to remedy the dispute. Accordingly, Applicants have been left with no recourse other than to involve the Board by this motion.

III. ARGUMENT

Discovery conducted in Opposition proceedings under 37 C.F.R. § 2.120 is generally to proceed in a similar manner as discovery before the Federal district courts under the Federal Rules of Civil Procedure. See T.B.M.P. § 401. What differences do exist, are generally due to the administrative nature of Board proceedings. See *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 1988).

Pursuant to 37 C.F.R. § 2.120(d)(1), a party to an opposition proceeding may serve a total of 75 interrogatories, counting subparts. The numerical limit is in place to position the fine line between burdening the opposing party with excessive interrogatories and seeking legitimate discovery through their use. Clearly, an excessive number of interrogatories serves no legitimate purpose. However, subparts should be available to shape the scope of the request, and to provide examples of the type of discovery sought, without being counted as separate questions toward the overall total. As stated by one court in the context of a local rule directed at counting interrogatories: "Legitimate efforts [to propound discovery] should not have to depend upon linguistic acrobatics, nor should they sap the court's limited resources in order to resolve hypertechnical disputes." *Ginn v. Gemin, Inc.*, 137 F.R.D. 320, 322 (D. Nev. 1991).

The line between too burdensome discovery and the need for discovery therefore becomes an equitable consideration. Before the Board, that consideration has been manifested in the allowance of 75 total interrogatories. It is then up to the propounding party to respect that limit. Again in the context of a local rule, the *Ginn* Court summed up this balance:

In the interests of conserving the number of interrogatories used, a party may tend to propound questions that are objectionably vague or compound. If, on the other hand, the propounding party includes logically or factually related and subsumed subparts in order to give the interrogatory the desired degree of specificity, a literal reading of [the local rule] would require that each subpart, no matter how narrowly drawn, be counted as a separate interrogatory. The latter option could too quickly exhaust the propounding

party's supply of interrogatories, and unnecessarily cramp the party's fact-gathering ability.

Id. at 321-22 (footnotes omitted).

Litigants in the Federal courts are guided by the advisory committee's notes to Fed. R. Civ. P. 33(a), which state:

Parties cannot evade [the] presumptive limitation [on the number of interrogatories permitted] through the device of joining as "subparts" questions that seek information about discrete separate subjects. However, a question asking about communications of a particular type should be treated as a single interrogatory even though it requests that the time, place, persons present, and contents be stated separately for each such communication.

Fed. R. Civ. P. 33(a) advisory committee note's.

One court has suggested that the "best test of whether subsequent questions, within a single interrogatory, are subsumed and related, is to examine whether the first question is primary and subsequent questions are secondary to the primary question." *Kendall v. GES Exposition Servs., Inc.*, 174 F.R.D. 684, 685 (D. Nev. 1997). While this test is certainly short of a "bright-line test," it does lend guidance. *See Safeco Ins. Co. of Am. v. Rawstron*, 181 F.R.D. 441, 446 (C.D. Cal. 1998). If subsequent questions cannot stand alone, or are not independent of the initial question, then the entirety may be counted as a single question. *See Kendall*, 174 F.R.D. at 685. Nevertheless, questions that are not "logically or factually subsumed within and necessary related to the primary question should be counted as separate interrogatories, even if they are joined by a conjunctive word and may be related." *See id.* at 685-86.

The present motion concerns Applicants' set of 35 interrogatories tailored to the issues in this proceeding and not including extensive subparts. The interrogatories are not oppressive. They were not drafted to evade the limit. Applicants submit that the total number of questions requested to be answered, conservatively including those questions that are logically or factually

subsumed within and necessarily related to the primary question as a single interrogatory, do not approach the 75 interrogatory limit.

True and accurate renditions of the interrogatories are set forth below. Following each interrogatory, Applicants have presented various statements regarding the preceding interrogatory. For the Board's convenience, Applicants have not repeatedly presented the same arguments where unnecessary. Rather, Applicants note that the arguments made with respect to specific interrogatories are generally to be considered with equal effect as to the remainder of the interrogatories of the same type, or having the same interrogatory number counting considerations.

Interrogatory No. 1

Describe in detail the full extent of Opposer's business, including all goods sold and services offered, in connection with use of the marks TIFFANY and TIFFANY & CO.

Total Interrogatories After Interrogatory No. 1

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question. The nature of the question is a request to describe the extent of Opposer's business. The interrogatory could have requested simply that. The remaining portions of the interrogatory — those portions referencing goods, services and specific marks — are not separate and discrete subparts, but merely instructional and exemplary of the types of issues and information that are responsive to the request. In fact, by adding the qualifying statements that Applicants are seeking information as to the goods sold and services offered with respect to the marks TIFFANY and TIFFANY & CO., Applicants are actually *limiting* the scope and extent of the interrogatory by directing Opposer toward the area of particular interest, rather than creating additional interrogatories. An interrogatory asking Opposer to "describe in detail the full extent

of Opposer's business" would be much broader than the present interrogatory. Applicants should not be penalized for making this and other interrogatories specific and pointed requests, rather than generalized questions.

The sum total interrogatories thus far is therefore one (1).

Interrogatory No. 2

Identify all documents by or on behalf of Opposer which contain any statements describing or characterizing Opposer's business utilizing the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S.

Total Interrogatories After Interrogatory No. 2

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore two (2).

Interrogatory No. 3

Identify and describe all advertising and promotional activities conducted by or on behalf of Opposer with respect to Opposer's goods and service using the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, and provide all documents which refer or relate to such advertising and promotional activities.

Total Interrogatories After Interrogatory No. 3

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question. In this regard, the request to provide documents responsive to this interrogatory is not in actuality a separate interrogatory and Opposer need not answer it as an interrogatory. Applicants' Document Request No. 1, for which no specific objection was raised by Opposer, requested that Opposer provide "[a]ll documents identified, or the identification of which is requested, or which refer or relate to Interrogatories Nos. 1-35 to Opposer." In addition, Opposer

has offered to provide representative samples of advertising and promotional materials in response to various other document requests.

The sum total interrogatories thus far is therefore three (3).

Interrogatory No. 4

Identify and describe representative specimens of Opposer's advertisements and promotional literature using the marks TIFFANY or TIFFANY'S, or containing the words TIFFANY or TIFFANY'S.

Total Interrogatories After Interrogatory No. 4

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore four (4).

Interrogatory No. 5

State for each calendar year since 1975, the dollar amount expended by Opposer in connection with advertising the marks TIFFANY or TIFFANY'S, or any marks containing the words TIFFANY or TIFFANY'S, and identify all documents which substantiate such advertising expenditures.

Total Interrogatories After Interrogatory No. 5

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question. As Opposer has been unwilling to set forth its method of counting the interrogatories, Applicants are left with no option but to make assumptions as to the counting method. Here, Applicants note that by requesting advertising information for "each calendar year since 1975," Applicants are not asking the equivalent of 30 questions. It is preposterous to suggest as much. Rather, Applicants are simply requesting the total dollar amount expended by Opposer for advertising related to the TIFFANY mark, broken out by year. A yearly breakout of advertising expenditures is in no way burdensome to Opposer. In fact, the information is probably kept in

that manner in the ordinary course of business. Asking for a sum total over the past 30 years would probably be more burdensome, as that would require calculations on Opposer's part.

The sum total interrogatories thus far is therefore five (5).

Interrogatory No. 6

Identify each product since 1975 on which Opposer has used the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, and identify a label, package, sign, brochure or advertisement which substantiates the form of each such use.

Total Interrogatories After Interrogatory No. 6

Applicants have reviewed this interrogatory and count the request as two requests.

The sum total interrogatories thus far is therefore seven (7).

Interrogatory No. 7

For each product sold since 1975 using the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, state the sales of each such product on an annual basis from 1975 forward, and identify all documents which support, refer or relate to such sales.

Total Interrogatories After Interrogatory No. 7

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore eight (8).

Interrogatory No. 8

Identify the persons employed by Opposer who are most knowledgeable regarding the use of the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, by Opposer; and enforcement of trademark rights by Opposer.

Total Interrogatories After Interrogatory No. 8

Applicants have reviewed this interrogatory and count the request as two requests.

The sum total interrogatories thus far is therefore ten (10).

Interrogatory No. 9

Describe in detail the manner in which customers may purchase goods from Opposer bearing the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S.

Total Interrogatories After Interrogatory No. 9

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore eleven (11).

Interrogatory No. 10

Describe in detail all retail store locations of Opposer which have used the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, including for each such store location the annual sales of the store since 1975 and representative samples of each version of signage used in relation to the store.

Total Interrogatories After Interrogatory No. 10

Applicants have reviewed this interrogatory and count the request as three requests.

The sum total interrogatories thus far is therefore fourteen (14).

Interrogatory No. 11

Describe in detail the facts and circumstances under which the Opposer first became aware of Applicants' use of the mark TIFFANY'S RESTAURANTS.

Total Interrogatories After Interrogatory No. 11

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore fifteen (15).

Interrogatory No. 12

Identify and describe in detail any opposition or cancellation proceeding, or trademark litigation or unfair competition action, relating in any manner to the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S, in the United States or any foreign country, that Opposer has been involved in.

Total Interrogatories After Interrogatory No. 12

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore sixteen (16).

Interrogatory No. 13

Identify and describe in detail all filed Civil Actions involving trademarks that have involved Opposer and its TIFFANY or TIFFANY & CO. marks.

Total Interrogatories After Interrogatory No. 13

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore seventeen (17).

Interrogatory No. 14

Describe in detail all instances in which Opposer has charged, orally or in writing, formally or informally, any corporation, company, organization, association or individual with infringement of the marks TIFFANY or TIFFANY & CO., in the United States.

Total Interrogatories After Interrogatory No. 14

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore eighteen (18).

Interrogatory No. 15

Identify any third parties that Opposer has licensed, franchised, or otherwise authorized to use the marks TIFFANY or TIFFANY'S, or any mark containing the words TIFFANY or TIFFANY'S.

Total Interrogatories After Interrogatory No. 15

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore nineteen (19).

Interrogatory No. 16

Identify and describe in detail all third party uses of marks which contain the words TIFFANY or TIFFANY'S, or any similar word of which Opposer is aware.

Total Interrogatories After Interrogatory No. 16

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore twenty (20).

Interrogatory No. 17

Describe in detail Opposer's procedures and policies in regard to policing its TIFFANY and TIFFANY & CO. marks.

Total Interrogatories After Interrogatory No. 17

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore twenty-one (21).

Interrogatory No. 18

Identify and describe in detail any instances or incidents of actual confusion or mistake or deception arising from the contemporaneous use of Opposer's marks TIFFANY or TIFFANY & CO., and Applicant's mark TIFFANY'S RESTAURANTS, or any other name of Applicant using the word TIFFANY, of which Opposer is aware.

Total Interrogatories After Interrogatory No. 18

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore twenty-two (22).

Interrogatory No. 19

Identify and describe each poll, survey, consumer study, or other market research project commenced or completed by or on behalf of Opposer with respect to the marks TIFFANY or TIFFANY'S & CO., or any labeling, advertising, or promotion used or to be used by Opposer.

Total Interrogatories After Interrogatory No. 19

Applicants have reviewed this interrogatory and count the request as two requests.

The sum total interrogatories thus far is therefore twenty-four (24).

Interrogatory No. 20

Identify all surveys conducted by or on behalf of Opposer that have included reference to the word TIFFANY in any form.

Total Interrogatories After Interrogatory No. 20

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore twenty-five (25).

Interrogatory No. 21

Provide a copy of each trademark search commissioned by or on behalf of Opposer for any mark containing the word TIFFANY or any similar word.

Total Interrogatories After Interrogatory No. 21

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore twenty-six (26).

Interrogatory No. 22

Identify all studies, plans, marketing analyses, or other documents that refer or relate to any efforts by Opposer to expand use of its TIFFANY mark into restaurant services, and identify all documents which support, refer or relate to any such efforts.

Total Interrogatories After Interrogatory No. 22

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore twenty-seven (27).

Interrogatory No. 23

Identify all persons aware of any plan or consideration by Opposer to use the marks TIFFANY or TIFFANY'S, or any marks containing the words TIFFANY or TIFFANY'S, for restaurant services.

Total Interrogatories After Interrogatory No. 23

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore twenty-eight (28).

Interrogatory No. 24

Identify all documents that support, refer, or relate to any plan or consideration by Opposer to use the marks TIFFANY or TIFFANY'S, or any mark using the words TIFFANY or TIFFANY'S, for restaurant services, café services, and food services in Opposer's retail stores.

Total Interrogatories After Interrogatory No. 24

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore twenty-nine (29).

Interrogatory No. 25

Identify all documents that support, refer, or relate to any plan or consideration by Opposer to use the marks TIFFANY or TIFFANY'S, or any mark using the words TIFFANY or TIFFANY'S, for food services or restaurant services within its existing retail stores.

Total Interrogatories After Interrogatory No. 25

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore thirty (30).

Interrogatory No. 26

Describe fully the origin of the term Tiffany as used in Opposer's marks and identify all documents that refer or relate to the origin.

Total Interrogatories After Interrogatory No. 26

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore thirty-one (31).

Interrogatory No. 27

State the basis for your contention in paragraph 22 of the Notice of Opposition that "Courts and legislatures have deemed the TIFFANY mark to be a famous and distinctive mark entitled to protection from dilution," and identify all documents which support, refer or relate to such contention.

Total Interrogatories After Interrogatory No. 27

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore thirty-two (32).

Interrogatory No. 28

Identify all studies, reports, marketing research or the like referring or relating to competitors of Opposer.

Total Interrogatories After Interrogatory No. 28

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore thirty-three (33).

Interrogatory No. 29

Identify the entities that Opposer considers to be its 10 most direct competitors and all documents that support such an allegation.

Total Interrogatories After Interrogatory No. 29

Applicants have reviewed this interrogatory and count the request as a single request as any subparts are logically or factually subsumed within and necessarily related to the primary question.

The sum total interrogatories thus far is therefore thirty-four (34).

Interrogatory No. 30

Identify all documents that refer or relate to the use of the name, word, or mark TIFFANY to refer to lamps.

Total Interrogatories After Interrogatory No. 30

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore thirty-five (35).

Interrogatory No. 31

Identify all documents that refer or relate to any communication, contact, or correspondence between Opposer and the originator or owner of the TIFFANY mark for lamps.

Total Interrogatories After Interrogatory No. 31

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore thirty-six (36).

Interrogatory No. 32

Identify all documents which refer or relate to Louis Comfort Tiffany and lamps.

Total Interrogatories After Interrogatory No. 32

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore thirty-seven (37).

Interrogatory No. 33

Provide a detailed description and organizational charts of Opposer's corporate structure.

Total Interrogatories After Interrogatory No. 33

Applicants have reviewed this interrogatory and count the request as a single request.

The sum total interrogatories thus far is therefore thirty-eight (38).

Interrogatory No. 34

Identify each person whom Opposer expects to call as a witness, including experts, during its testimony and, for each such person, state the substance of the facts and opinions to which such witness is expected to testify, and identify all documents in which such witness intends to rely on for its testimony, or refers or relates to expected testimony.

Total Interrogatories After Interrogatory No. 34

Applicants have reviewed this interrogatory and count the request as two requests.

The sum total interrogatories thus far is therefore forty (40).

Interrogatory No. 35

For each interrogatory, identify each person who was consulted to obtain information to answer such Interrogatory, who contributed information from which the answer to such Interrogatory was derived, and who prepared the answer to the Interrogatory.

Total Interrogatories After Interrogatory No. 35

Applicants have reviewed this interrogatory and count the request as three requests.

The sum total interrogatories is therefore forty-three (43).

As demonstrated above, the total number of interrogatory requests propounded on Opposer by Applicants is 43 interrogatories. This number is far below the 75 interrogatory limit instituted by the Board. Applicants request that Opposer be compelled to respond to these 43 interrogatories within two weeks of the Board's Order compelling same. In the alternative, Applicants request leave to file interrogatories in excess of the numerical limit. Applicants also request that the time to take discovery be reset to allow a period of at least three (3) months after the date on which Opposer is required to respond to the attached interrogatories.

IV. CONCLUSION

As demonstrated by the substance of each interrogatory, Applicants' interrogatory requests, numbered 1-35, do not exceed the 75 interrogatory limit, and answers to each should be compelled. In the alternative, Applicants request leave to file interrogatory requests exceeding the numerical limit.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

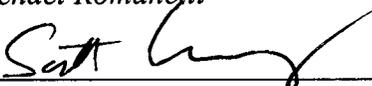
600 South Avenue West
Westfield, NJ 07090-1497

Tel: 908.654.5000

Fax: 908.654.7866

*Attorneys for Applicants Anthony Siragusa
and Michael Romanelli*

Dated: April 1, 2005

By: 
Scott E. Charney

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the within APPLICANT'S MOTION TO COMPEL DISCOVERY PURSUANT TO 37 C.F.R. § 2.120(e), was served upon the following counsel of record this 1st day of April, 2005, as follows:

VIA FIRST-CLASS MAIL:

Barbara A. Solomon, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

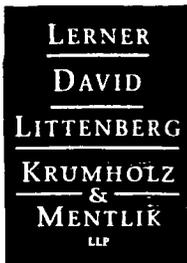
Attorneys for Opposer Tiffany (NJ) Inc.



Scott E. Charney

GOOSES 10.2A-001
Opposition No. 91160913

Exhibit A



600 SOUTH AVENUE WEST • WESTFIELD, NEW JERSEY 07090
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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

Scott E. Charney
908.518.6336
scharney@ldlkm.com

January 4, 2005

VIA FACSIMILE (212 813 5901)
CONFIRMATION BY MAIL

Barbara A. Solomon, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

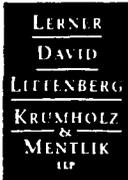
Re: GOOSSES 10.2A-001
Tiffany (NJ) Inc. v. Anthony Siragusa and Michael Romanelli
Opposition No.: 91160913, Serial No.: 76/520,262
Mark: TIFFANY'S RESTAURANT

Dear Ms. Solomon:

We have now received opposer's responses and principally objections to applicant's interrogatories and requests for production of documents. We intend to file a motion to compel if we cannot resolve these matters. Please address promptly the following issues.

Applicant's Interrogatories Nos. 1-35.

Opposer has objected to these interrogatories as exceeding the limit for written interrogatories of 75. We have reviewed the interrogatories and see no potential merit to your position. To advance this matter, please set forth the basis upon which you computed these interrogatories to be greater than 75. Specifically, please inform us as to exactly what portions of each interrogatory you counted as separate interrogatories. We may use your list to revise and limit the interrogatories, if we deem it appropriate.



Barbara A. Solomon, Esq.

January 4, 2005

Page 2

Request for Production of Documents.

We have the following comments:

Request No. 2. We request the production of the correspondence to and from the United States Patent and Trademark Office for any registration of opposer which includes the word TIFFANY. Those documents merely "evidencing" the U.S. registrations and applications are entirely insufficient.

Request No. 3. Searches are relevant for the references disclosed. The searches may disclose third party marks which are relevant.

Request No. 4. You have committed to providing "representative samples" of the requested items. Although duplicate labels, signs, etc. are not needed, we do request the production of a sample of each label, sign, etc. which uses the mark TIFFANY alone, not TIFFANY & CO. or some other variation. Do you agree with this condition?

Request No. 5. For what you identify as documents concerning applicant's mark that are related to this proceeding, we request production. Regarding U.S. surveys, we request inspection of all surveys, not just what you determine to be "representative." To lessen the burden on the opposer, we would agree initially to inspecting the survey reports, with the option to request data for surveys that we determine are relevant.

Request No. 13. These documents are undoubtedly relevant. Third party uses of marks containing the word TIFFANY are relevant to a factor for both dilution and any assertion of likelihood of confusion. Please reconsider your objection.

Request No. 14. The same relevance is established as for Request No. 13. Please reconsider.

Request No. 17. For the assertion that there are responsive privileged documents, we request that you provide a privilege log.

Request No. 19. These documents are relevant to opposer's asserted ownership as well as to any naked licensing of the mark. As a result, we see no reason why the response can be limited to relevant documents within the last five years. We request reconsideration and production of all of the requested documents as far back as they have been maintained by opposer.



Barbara A. Solomon, Esq.

January 4, 2005

Page 3

Request No. 21. We agree to take the limited documents that you have agreed to provide for proceedings involving opposer, but cannot agree to limit it to the past five years. We see no reason why information on earlier oppositions would be irrelevant.

Request No. 22. This request is different than Request No. 21 in that it seeks documents relating to charges of infringement by or to opposer, and is not limited to proceedings or litigation. This information is relevant because it may uncover third party rights regarding the mark TIFFANY which would be relevant to the claims in this case. We ask that you reconsider this matter. We note that a number of subsequent requests are similarly affected, including Request Nos. 38 and 39.

Request No. 29. You are correct that sub-part (a) is covered by Request No. 2. For sub-parts (b) and (c), we submit that the objections do not address the requests made. We request all documents which refer or relate to any alleged infringement or dilution by applicants and the decision to institute the present opposition. If the documents are privileged, you should identify them on a privilege log. If not, we request their production.

Request Nos. 31 and 32. These differ from earlier requests in that they are confined to uses of the mark TIFFANY alone or TIFFANY'S alone. We request that you provide any of the requested material which substantiates such use.

Request No. 35. Please consider Request Nos. 34 and 35 to be corrected by changing "TIFFANY'S & CO." to "TIFFANY & CO." We are not able to accept your offer of providing documents relating to the history of opposer including the opening of opposer's first store, unless you are able to represent that these are the only documents which opposer has which refer or relate to the selection and adoption of the marks TIFFANY and TIFFANY & CO. Can you make such a representation?

Request No. 37. These documents are highly relevant. You have not provided any basis for withholding these documents from production. With respect to objection (b), please advise whether there are documents which are covered by protective orders or whether this is simply a theoretical objection. In any event, we request that you reconsider this matter and produce the requested documents.

Request No. 41. The requested documents are relevant to third party use of the word TIFFANY (not by opposer) and the public's awareness of the word TIFFANY to refer to lamps. We request that you reconsider your objection.



Barbara A. Solomon, Esq.
January 4, 2005
Page 4

Request No. 42. The opposer's competitors are relevant to customers and determining the practices as to whether such competitive stores have restaurants associated with them. We ask that you reconsider the objection.

Attachment A

We note that you have identified a number of categories of documents which you are prepared to produce. We would like to move forward with this production promptly. Please advise us of the volume of documents coming within each of the 11 categories. For those documents which are not voluminous, we will request that you send copies.

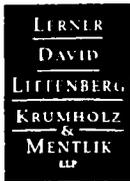
We look forward to your prompt response so that we can advance discovery in this matter. If you have any questions regarding our comments in this letter, please call.

Very truly yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC:dlb



Barbara A. Solomon, Esq.
January 4, 2005
Page 5

bcc: Thomas Bernard
Mike Romanelli

Exhibit B

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JANET L. HOFFMAN
PETER J. SILVERMAN
LAWRENCE ELI APOLZON
BARBARA A. SOLOMON
LISA PEARSON
MARK D. ENGELMANN
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January 12, 2005

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CARA A. BOYLE
IRENE SEGAL AYERS*
JOHN M. GALLACHER

*ADMITTED IN OH. ONLY

BY FAX AND MAIL

Scott E. Charney, Esq.
Lerner David Littenberg Krumholz & Mentlik LLP
600 South Avenue West
Westfield, NJ 07090

Re: *Tiffany (NJ) Inc. v. Siragusa*, Opp. No. 91/160,913
(Your Ref: GOOSES 10.2A-001; Our Ref: TFFJ 04/13531)

Dear Mr. Charney:

I write in response to your letter of January 4, 2005 to Barbara Solomon regarding our client's responses to your clients' discovery requests. Briefly put, we do not see your comments as well-founded. We will address the issues you raised in greater detail below.

Interrogatories 1-35:

Our objection stands. Our client's response complies with the requirements of Trademark Rule of Practice 2.120(d)(1). We would suggest you count the interrogatories, including subparts, following the requirements of TBMP § 405.03(d) (Application of Limit: Counting Interrogatories). If you disagree with our objection you are free to move to compel once this matter no longer is suspended. See 37 C.F.R. § 2.120(e)(2); TBMP § 523.01.

Document Requests:

As a general matter, many if not most of the document requests our client objected to are absurdly overbroad and unduly burdensome, particularly since our client has been using its TIFFANY marks in connection with its business for over 150 years. Your letter wholly ignores these objections and many others. Many of your document requests also are irrelevant and not reasonably calculated to lead to the discovery of admissible evidence, especially since your client has not objected to or contested the validity of our client's registrations or its rights in and to its TIFFANY marks. (Of course, it could not do so given the incontestable status of many of these

Scott E. Charney, Esq.
January 12, 2005
Page 2

registrations.) We also question your motives in threatening to move to compel. Unlike your client who, five months after receiving our client's discovery requests, has produced a mere twenty-four pages of documents, our client is ready to make available to you several file drawers of documents. We would suggest you take the time to review this production before determining that it does not meet your needs for this action.

Request 2:

Your comments do not address *any* of our objections or dispute their validity or applicability to the request. Our client's communications with the PTO are publicly available. As noted above, they also are irrelevant to this opposition, since you have not challenged, and legally cannot challenge, the validity of or our client's rights in and to its TIFFANY marks.

Request 3:

Again, you have not addressed any of our objections other than relevance. On that issue, you have not said how or why you believe "third party marks" are relevant to the opposition and have limited your comment to the mere possibility that the requested documents "may" disclose marks "which are relevant." Moreover, as a matter of law, the mere existence of third party registrations does not serve as evidence on any issue, including that the registered marks actually are in use or that the public is familiar with them.

Request 4:

The request and your "condition" as set forth in your January 4 letter are both overbroad and unduly burdensome, objections you wholly ignore. Moreover, you cannot point to any genuine need or basis for "each" label, sign, etc. We believe our client's production on this issue will be sufficient, and propose you review it before objecting.

Request 5:

Our objections, which once again you have not addressed, stand. Your comments do not persuade us that our response is deficient.

Request 13-14:

While your letter attempts to overcome one of the bases for our objections, namely, relevance, you have not addressed any of the other objections, thereby obviously recognizing their validity. Without contesting the issue of relevance, the objections you ignored are fatal to your request.

Scott E. Charney, Esq.
January 12, 2005
Page 3

Request 17:

Once our production has been fully gathered we will produce a privilege log. As you know, we requested that your clients produce their own log some time ago, but we still are waiting to receive it. Please advise us when it will be provided.

Request 19:

Our objections stand. Again, you have not addressed any objections other than relevance. We continue to believe that the last five years is an appropriate scope for this request, since even if there were naked licensing more than five years ago – which there wasn't – there clearly has been no abandonment of our client's rights.

Request 21:

Once again, you have not addressed objections other than relevance. We believe that the information our client has agreed to provide should be sufficient for purposes of this action. Since you have said that you agree to take the limited documents we agreed to provide, if you want information from more than five years ago, you can retrieve it as easily as our client from databases such as Westlaw, LEXIS, or the TTAB's own website.

Request 22:

Again, you have not addressed our objections other than relevance, and your argument that this request "may uncover third party rights regarding the mark TIFFANY which would be relevant to the claims in this case" is admittedly purely speculative. Even without contesting the issue of relevance, the objections you ignored are fatal to your request.

Request 29:

Our objections stand, and we believe that they are appropriate to the requests. As noted above, we will produce a privilege log.

Request 31-32:

Our objections stand. As noted, these requests duplicate requests asking for materials for "any of Opposer's marks consisting in whole or in part of TIFFANY . . ." (emphasis added). We will make available representative items, including labels and advertisements, that use the TIFFANY mark.

Request 35:

Our objections stand. (Again, you have not addressed any of these objections.) We also will not consider Requests 34 or 35 to be "corrected." Further, we will not make the

Scott E. Charney, Esq.
January 12, 2005
Page 4

requested representation that the documents to be provided "are the only documents . . . opposer has which refer or relate to the selection and adoption of the marks TIFFANY and TIFFANY & CO.," nor are we required to do so. Your request is absurdly overbroad and unduly burdensome. We are obligated to produce representative documents only and will do so. *E.g., Yves St. Laurent Fashion, B.V. v. Y&S Handbags*, Opp. No. 119,265, 2002 WL 1359367, *3 (T.T.A.B. 2002) (it is standard Board practice to allow reasonable representative samples of documents if responding to request otherwise would be so voluminous as to be burdensome).

Request 37:

Your comment that we have not provided a basis for withholding documents ignores the eight enumerated objections, none of which you bother to address. Your questions about "objection (b)" is nonsensical as there is no such objection.

Request 41:

Once again, you have not addressed any of our client's objections other than relevance, and the flaws noted in these other objections, in themselves, are fatal to your request. Moreover, your client is not seeking to use or register TIFFANY in connection with lamps. Thus, public association of TIFFANY with lamps has no relevance to this action.

Request 42:

Our objections stand. Nevertheless, we expect to provide representative studies that refer to Opposer's competition in connection with our client's response to Request 5.

Attachment A:

We are still in the process of gathering the voluminous documents you requested, and will let you know when they are available. We have not quantified the documents by category, but can advise that they will be substantial, and will fill several shelves or cabinets.

As noted in our responses, we will produce these documents where they are usually kept, namely, our offices or our client's corporate offices. Please advise as to dates when you wish to review them so we can accommodate your schedule.

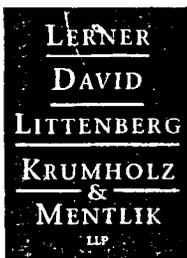
Yours sincerely,



Evan Gourvitz

cc: Barbara A. Solomon, Esq.

Exhibit C



600 SOUTH AVENUE WEST • LITTLEFIELD, NEW JERSEY 07090
908.654.5000 • FAX 908.654.7866 • WWW.LDLKM.COM

PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

Scott E. Charney
908.518.6336
scharney@ldlkm.com

January 26, 2005

VIA FACSIMILE (212) 813-5901
CONFIRMATION BY REGULAR MAIL

Evan Gourvitz, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

Re: GOOSSES 10.2A-001
Tiffany (NJ) Inc. v. Anthony Siragusa and Michael Romanelli
Opposition No.: 91160913, Serial No.: 76/520,262
Mark: TIFFANY'S RESTAURANT

Dear Evan:

This letter is in response to your correspondence of January 12, 2005 regarding your outstanding discovery obligations.

Document Requests:

In regard to the Document Requests, we repeat our request that you advise us as to the volume of documents compiled within each of the eleven categories identified as Attachment A to your responses to our Request for Production of Documents and Things Nos. 1-45. If any such categories are not voluminous, we will request that you send copies in lieu of inspection. If, however, the documents are voluminous, we wish to review the documents at the place where the documents and things are usually kept, namely, your client's principal place of business at 15 Sylvan Way, Parsippany, New Jersey. We would expect to review such documents as soon as you inform us that they are available for inspection, and no later than February 4, 2005.

Your specific objections are addressed below under the appropriate heading for each request. As a general matter, we note that we have not responded to each of your pervasive "stock" objections. Most, if not all, of these objections are superfluous and completely unrelated to the issues at hand. Note, however, to the extent that you maintain such objections, we stand by our assertion that the requests are not unduly burdensome, are reasonably calculated to lead to the discovery of admissible evidence, are not overbroad, and are relevant. Please reconsider your objections.



Evan Gourvitz, Esq.

Page 2

January 26, 2005

Request No. 2:

We repeat our comments of January 4, 2005. As you are certainly well aware, comments made in the prosecution of opposer's marks constitute admissions against the Applicant and may alter the scope of coverage associated with the entire family of marks. This request is highly relevant as the basis of opposer's repeated assertion that the TIFFANY mark is irrefutable is based on those prosecutions. We also note that opposer has requested the same application-related documents from Applicants.

You have alleged that the request calls for the production of privileged documents. Certainly you may list those documents on a privileged log and provide us with same. If the request calls for privileged documents, which is entirely in doubt since the bulk of the request is for documents submitted to the Patent and Trademark Office, it does not excuse you from responding with respect to the non-privileged documents.

Request No. 3:

We repeat the comments stated in our January 4, 2005 correspondence. Moreover, the existence of Tiffany-formative third party marks are entirely relevant to your claims of dilution and likelihood of confusion.

Request No. 4:

Although we believe our request is wholly appropriate, we will reserve further comment until we review your production on this issue.

Request No. 5:

We repeat our comments as set forth in the January 4, 2005 correspondence. We again request production of documents concerning Applicant's mark. Clearly, this portion of the request is not overly broad, not unduly burdensome, and is reasonably calculated to lead to this discovery of admissible evidence.

Regarding the U.S. surveys, we again offer initially to inspect the survey reports, with the option to request data for surveys that we determine are relevant. Please advise whether this is acceptable.

Requests Nos. 13 and 14:

We again repeat our comments of January 4, 2005. We have not addressed your "stock" objections because we view them as wholly inappropriate. Clearly, the documents are relevant and the request is not overly broad or unduly burdensome. Furthermore, the documents are reasonably calculated to lead to the discovery of admissible evidence as they



Evan Gourvitz, Esq.

Page 3

January 26, 2005

are relevant to a factor for both dilution and any assertion of likelihood of confusion. Finally, should any such documents be privileged, you may place them on a privilege log. You may not however, simply ignore the requests. Please provide documents responsive to this request.

Request No. 17:

We have no additional comments beyond those expressed in our January 4, 2005 correspondence pending receipt of your privilege log.

Request No. 19:

Our comments of January 4, 2005 stand. We again request production of all requested documents as far back as they have been maintained by opposer. Clearly these documents are relevant to opposer's asserted ownership as well as any naked licensing of the mark.

Request No. 21:

We agree to review the limited discovery you offer, but our comments of January 4, 2005 stand. We see no reason why this request should be limited to the last five years. We again request full production of the requested documents as far back as opposer maintains records.

Request No. 22:

Our comments of January 4, 2005 stand. We request production of all documents relating to charges of infringement by or to opposer.

Request No. 29:

We have no additional comments beyond those of our January 4, 2005 correspondence. We await your privilege log.

Request Nos. 31-32:

Your offer to make available representative samples of items is insufficient. However, we will withhold from renewing our request for all responsive documents pending our review of your representative sample set.

Request No. 35:

We renew our request that you consider "TIFFANY'S & CO." to be "TIFFANY & CO." Your failure to extend this courtesy is unfortunate. Of course, as soon as the stay in this matter is lifted, we may serve a corrected request. However, your courtesies in answering the intended question are expected and would be appreciated. Surely, your failure



Evan Gourvitz, Esq.
Page 4
January 26, 2005

to provide this courtesy will only be seen by the Board as a delay tactic to avoid the inevitable request.

Further, the selection and adoption of the TIFFANY and TIFFANY & CO. marks is directly relevant to the issues in this case, and are reasonably likely to lead to the discovery of admissible evidence.

Request No. 37:

Our previous positions stand. This material is highly relevant, and we request production. Further, our reference to objection (b) was intended to be in reference to objection (v). This should have been self-evident from the remainder of the response. In any event, in regard to objection (v), please advise whether there are documents which are covered by protective orders or whether this is simply a theoretical objection.

Request No. 41:

We again repeat our comments of January 4, 2005. Third party use of the mark TIFFANY and the public's awareness of the word TIFFANY to refer to lamps is highly relevant for dilution and likelihood of confusion. Please reconsider your objections. To the extent that any such documents are privileged, please provide a privilege log.

Request No. 42:

We repeat our comments of January 4, 2005. Please provide the requested discovery.

With respect to the representative studies in response to Request No. 5, please refer to our response to Request No. 5, above.

We request that you make a genuine attempt to reconsider your objections to each document request objected to rather than respond with more "stock" objections. Should you maintain the objections, we will have no recourse other than to seek action by the Board.

Interrogatories:

We have reviewed our interrogatory requests in their entirety and do not believe that the 75 request threshold has been breached. Please reconsider your position not to answer our interrogatories.



Evan Gourvitz, Esq.

Page 5

January 26, 2005

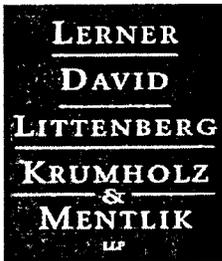
If you can identify specific requests that you believe actually encompass a substantial number of requests, please bring any such requests to our attention. Without knowing the manner in which you calculated our total number of requests, there is simply no way for us to respond. If you fail to provide this information, we will file a motion to compel in due course. We look forward to your forthcoming interrogatory responses.

Very truly yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg



LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West • Westfield, NJ 07090
Tel: 908 654 5000 • Fax: 908 654 7866

FACSIMILE TRANSMITTAL

To:	Fax Number	Voice Number
Evan Gourvitz, Esq.	(212) 813-5901	
Fross Zelnick Lehrman & Zissu, P.C.		

From: Scott E. Charney, Esq.

Date: January 26, 2005

No. Pages: 6

Original Mailed: Yes

Client/Matter No: GOOSES-1

● **MESSAGE:**

Please see attached.

*** TX REPORT ***

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To:	Fax Number	Voice Number
Evan Gourvitz, Esq.	(212) 813-5901	
Fross Zelnick Lehrman & Zissu, P.C.		

From: Scott E. Charney, Esq.

Date: January 26, 2005

No. Pages: 6

Original Mailed: Yes

Client/Matter No: GOOSSES-1

● MESSAGE:

Please see attached.

Exhibit D

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

RONALD J. LEHRMAN
DAVID WEILD III
STEPHEN BIGGER
MICHAEL I. DAVIS
ROGER L. ZISSU
MARIE V. DRISCOLL
RICHARD Z. LEHV
DAVID W. EHRLICH
SUSAN UPTON DOUGLASS
JANET L. HOFFMAN
PETER J. SILVERMAN
LAWRENCE ELI APOLZON
BARBARA A. SOLOMON
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NANCY C. DICONZA
ZOE HILDEN
LAUREN J. MANDELL
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JASON M. VOGEL
VEJAY G. LALLA
DAVID I. GREENBAUM
DAVID DONAHUE
CHARLOTTA MEDER
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NANCY E. SABARRA
LAURA POPP-ROSENBERG
CARA A. BOYLE
IRENE SEGAL AYERS*
JOHN M. GALLACHER

* ADMITTED IN OH. ONLY

January 28, 2005

BY FAX AND MAIL

Scott E. Charney, Esq.
Lerner David Littenberg Krumholz & Mentlik LLP
600 South Avenue West
Westfield, NJ 07090

Re: *Tiffany (NJ) Inc. v. Siragusa*, Opp. No. 91/160,913
(Your Ref: GOOSES 10.2A-001; Our Ref: TFFJ 04/13531)

Dear Mr. Charney:

I write to respond to your January 26, 2005 letter regarding our client's responses to your clients' discovery requests.

As previously noted, our client's response to your clients' interrogatories complies with the Trademark Rules of Practice. We do not think there is any need to elaborate on our response. If you disagree with our objection you may to move to compel once permitted to do so.

As discussed in my recent letter, we still are in the process of gathering and organizing our client's responsive documents, which will be voluminous. We will not count the documents to be produced for each of the categories in Attachment A, nor will we photocopy them and send copies to you. Instead, we will produce them for inspection at the place where they are usually kept, the office of our firm in New York. Since some of these documents are confidential, we will not produce them for inspection until we have finalized the parties' protective order.

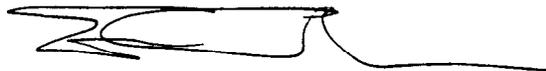
As for your comments on the individual document requests, you have offered no new information or arguments that lead us to reconsider our previous objections. (Indeed, as you repeatedly note, you essentially repeat the comments in your January 4, 2005 letter.) Naturally, if you wish to move to compel you may do so as permitted by the rules at the appropriate time.

You still have not told us when we should expect your privilege log, which we first requested from you quite some time ago. As requested in our January 12, 2005 letter, please let

Scott E. Charney, Esq.
January 28, 2005
Page 2

us know when we should receive it. We will provide you with our client's own log after its production has been completely gathered and organized.

Yours sincerely,

A handwritten signature in black ink, appearing to read "Evan Gourvitz", with a long horizontal line extending to the right.

Evan Gourvitz

cc: Barbara A. Solomon, Esq.