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

Proceeding	91160913
Party	Plaintiff Tiffany (NJ) Inc. ,
Correspondence Address	BARBARA A. SOLOMON FROSS ZELNICK LEHRMAN & ZISSU, P.C. 866 UNITED NATIONS PLAZA NEW YORK, NY 10017
Submission	OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANTS' MOTION TO ENTER A PROTECTIVE ORDER
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Date	04/20/2005
Attachments	Opposer's Mem.pdf (10 pages) Opposer's Mem Exhibits.pdf (46 pages)

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

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

**OPPOSER’S MEMORANDUM IN OPPOSITION TO
APPLICANTS’ MOTION TO ENTER A PROTECTIVE ORDER**

Opposer Tiffany (NJ) Inc. (“Tiffany” or “Opposer”) submits this memorandum in opposition to Applicants’ Motion to Enter a Protective Order Pursuant to 37 C.F.R. § 2.120(f).

INTRODUCTION

On December 28, 2004, Tiffany moved to compel discovery responses from Applicants. The Trademark Trial and Appeal Board, pursuant to its regular practice, issued an order on January 6, 2005 stating that the parties “should not file any paper which is not germane to the motion to compel.” Notwithstanding this clear order, and without benefit of legal or other authorities to show that its motion is properly before the Board, Applicants demand that the Board consider their motion and enter their proposed version of a protective order. Applicants’ motion is unjustified and must be denied.

Leaving aside the Board’s order prohibiting the filing of this motion, the substance of Applicants’ motion is not justified and is not required to protect Applicants’ confidential materials, assuming they even exist. Moreover, Applicants have not justified the two provisions to which Tiffany objects. Applicants seek a provision that would require Tiffany to pre-disclose the names

of experts to whom it wishes to provide confidential information, and to give Applicants the opportunity to object to these experts before they receive such information, regardless of whether the experts will be called as witnesses or relied on in the proceeding. The identities of such experts, however, is protected attorney work product. While Applicants claim this provision is necessary to protect confidential information from disclosure, other provisions in the order already require experts to sign non-disclosure agreements before receiving such information. Applicants' other reasons for needing to screen and approve experts are unjustified pretexts. Applicants simply want to be able to interfere with Tiffany's trial preparation. Applicants also seek a provision that would permit confidential material produced in this matter to be used in direct Federal Circuit appeals of this action, but not in direct district court appeals, even though such appeals are specifically authorized by statute. They offer no legitimate reason for this limitation.

Accordingly, to the extent that the Board believes it proper to consider Applicants' motion while this matter remains suspended, a protective order should be entered that omits Applicants' paragraph 5 in its entirety and includes a version of paragraph 11 that allows materials from this matter to be used in all appeals authorized by statute. A copy of this proposed order is attached hereto as Exhibit 1, and a redline of this version against Applicants' proposed order is attached hereto as Exhibit 2.

FACTS

Oddly, Applicants have offered only a *portion* of the correspondence between the parties regarding the protective order, through November 18, 2004. In fact, as evidenced by the documents provided herewith as Exhibit 3, Applicants did not respond to Tiffany's November 18, 2004 letter until January 26, 2005, and the parties continued to correspond on the protective order through February (and continued to discuss the matter by telephone through March).

Tiffany's counsel addressed the paragraphs at issue in this motion in a February 1, 2005 letter to Applicants' counsel. On Applicants' paragraph 5, which requires disclosure of experts' names and an opportunity for the other party to object before the expert can receive confidential information, Tiffany noted that this could require disclosure of protected work product. It also noted that Applicants' confidentiality concerns were addressed by the requirement that experts sign a nondisclosure agreement, and that any concerns Applicants might have about an expert's qualifications could be raised during the course of the proceeding. On Applicants' paragraph 11, which addresses the use of confidential information in appeals, Tiffany agreed for the sake of moving the proceeding forward that such information only could be used in direct appeals, but proposed that these include appeals to a U.S. district court as well as to the Federal Circuit (Ex. 3, 2/1/05 letter at 2), as both mechanisms are set forth in 15 U.S.C. § 1071.

Applicants never substantively responded to the issues raised in this letter. In a March 2, 2005 telephone conversation with Applicant's counsel, however, they did offer to agree to Tiffany's version of paragraph 11 if Tiffany would consent to Applicants' proposed language for paragraph 5. In a March 11, 2005 telephone conversation, they also agreed to drop their proposed language for paragraph 5 if they instead were granted the right to extend the trial schedule for four months – at their option – upon receiving an expert report from Tiffany. (According to Applicants' counsel, this provision would keep them from being “ambushed” if Tiffany served expert reports towards the close of discovery.) Tiffany's counsel rejected this proposal in a telephone conference with Applicants' counsel on March 24, 2005. While Tiffany's counsel told Applicants' counsel that Tiffany remained open to further discussing the order, Applicants instead filed this motion. It is clear that Applicants have no good faith basis for insisting on veto power over any proposed expert but instead are using it to extract concessions from Tiffany on other matters.

On the question of whether the motion is timely in light of the Board's suspension order, by letter dated April 5, 2005 Tiffany suggested that "to avoid burdening the Board and the parties with impermissible and inappropriate motions, you voluntarily withdraw your motions until our client's pending motion to compel has been resolved by the Board and the matter no longer is suspended." (Ex. 4.) Applicants' counsel refused to do so. (Ex. 5.)

ARGUMENT

I. APPLICANTS' MOTION IS PROHIBITED WHILE THIS MATTER REMAINS SUSPENDED

Applicants' present motion for entry of a protective order is prohibited by the Board's suspension order, which remains in effect.

On January 6, 2005, this action was suspended by the Board pending resolution of Tiffany's December 28, 2004 motion to compel responses to its document requests. In its order the Board stated that:

[p]roceedings herein are suspended pending disposition of the motion to compel, except as discussed below. *The parties should not file any paper which is not germane to the motion to compel. . . .* This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a discovery deposition which had been duly noticed prior to the filing of the motion to compel."

1/6/05 Order (emphasis added); see Trademark Rule 2.120(e)(2).

Nevertheless, Applicants claim, without benefit of any authority, that their motion is "proper and timely" because "discussions surrounding entry of a suitable Protective Order were being held long before the suspension, and were thus pending at the time of the suspension." Applicants also "note" that while "responses to the [parties'] various discovery requests . . . were due prior to entry of the suspension," "Opposer has withheld all document production pending entry of a Protective Order." (App. Mot. at 1-2.)

Applicants have not claimed that this motion is germane to Tiffany's pending motion to compel. Clearly, it is not.¹ While the Board stated in its order that the suspension "does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel," Tiffany timely served its responses to Applicants' interrogatories and document requests on December 29, 2004, before the Board suspended this matter. Applicants do not (and cannot) claim otherwise. Applicants have offered no authorities suggesting that a motion for entry of a protective order is appropriate during suspension where a party properly and timely responded to the other side's document requests, but refrained from producing documents until the parties could agree on a suitable protective order. While discussions regarding the protective order may have been "pending" at the time of the suspension, Applicants also have offered no authority suggesting that this justifies a motion during suspension.

Accordingly, Applicants' motion should be denied as prohibited by the Board's January 6, 2005 order without even considering the merits.

II. APPLICANTS HAVE NOT JUSTIFIED THEIR NEED FOR A PROVISION REQUIRING PRE-DISCLOSURE AND APPROVAL OF EXPERTS

Applicants seek a provision in the protective order that would require each party to pre-disclose to the other the names, addresses, occupations, and professional backgrounds of experts (both consulting experts and testifying experts) to whom they wish to disclose confidential information. (App. Mot., Ex. A, ¶ 5.) The notified party would have ten business days to object to disclosure to the expert. (*Id.*) If it objected, the parties would be obligated to negotiate the matter and, if unable to come to an agreement, the party proposing disclosure would be obligated to bring

¹ Although Tiffany's motion to compel addressed both non-confidential and confidential documents, on the issue of confidential documents it asked only that Applicants either acknowledge they have no such documents or produce them on an "outside attorneys' eyes only" basis pending entry of the protective order. (*E.g.*, Opp. Reply Mem. at 8-9.)

the matter before the Board. (*Id.*) This scheme is designed to let a party interfere with the other's trial preparation and to cause unnecessary costs and delays.

Applicants offer three reasons why they believe they need this provision: (1) "to safeguard confidential information," (2) "to pre-screen the expert as to independence and qualifications as an expert," and (3) to "limit the sheer number of experts to which the confidential information will be disclosed." (App. Mot. at 3.) None of these reasons support the entry of the provision.

Applicants ignore the fact that the provision violates the attorney work product doctrine. As many courts have observed, the identity of experts not intended to be called as a witness at trial is work product generally not discoverable absent exceptional circumstances. *E.g.*, *Ager v. Jane C. Stormont Hosp. & Training Sch. for Nurses*, 622 F.2d 496, 503 (10th Cir. 1980); *In re Pizza Time Theatre Securities Lit.*, 113 F.R.D. 94, 97-98 (N.D. Cal. 1986); *see also* Wright, Miller & Marcus, *Fed. Practice & Procedure, Civil 2d* § 2032 at 448-50 (this view "has become predominant among courts"). Similarly, the Board has stated that a "party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses *intended to be called* are discoverable." TBMP § 414(7) (emphasis added); *see also Genesco Inc. v. Martz*, Opp. No. 121,296, 2003 WL 1154482, *5 (T.T.A.B. 2003) (work product discoverable only upon showing of "substantial need"). Because the proposed provision essentially would compel Tiffany to disclose work product to Applicants, and because there are no exceptional circumstances requiring such disclosure, the provision must be rejected.

Applicants claim that pre-disclosure and pre-approval of experts is necessary "to safeguard confidential information." (App. Mot. at 3.) However, paragraph 4 of Applicants' proposed order *already* requires all experts and consultants to sign a nondisclosure agreement before gaining access to confidential information. (*Id.*, Ex. A ¶ 4 & Undertaking.) Indeed, Applicants' proposed order

allows disclosure of confidential information *without* pre-disclosure or pre-approval to “non-party witnesses” and “any other individual not otherwise specifically covered by the terms of this order,” provided they sign the nondisclosure agreement. (*See id.*, Ex. A ¶¶ 3-4, Undertaking.) Clearly, since Applicants only seek pre-disclosure and the opportunity to object to experts and consultants, but not to witnesses or other third parties (*see id.* ¶¶ 4-5), their confidentiality concerns are merely a pretext for a provision that would allow them to learn the identities of Tiffany’s consulting experts beforehand, and to delay Tiffany’s designation of experts by raising unfounded objections.

Applicants also claim it is necessary to “pre-screen” experts to ensure their “independence and qualifications as an expert.” (App. Mot. at 3.) But they offer no reason why one party should be permitted to use a protective order – a device intended to protect confidential information from disclosure – as a means for second-guessing the other party’s experts. These are issues more properly determined by the Board in the course of the opposition in accordance with the Federal Rules of Evidence, Fed. R. Evid. 702 (Testimony by Experts); *see* 37 C.F.R. § 2.122(a) (rules of evidence for proceedings before the Board are the Federal Rules of Evidence); TBMP § 702 (same), not decisions to be made unilaterally by Applicants. Applicants further claim their proposed provision is necessary to “limit the sheer number of experts to which the confidential information will be disclosed.” (App. Mot. at 3.) However, Applicants have offered no reason why they expect or believe Tiffany will disclose their confidential information to a significant number of experts, or why a confidentiality provision is the proper mechanism for limiting the number of these experts. (In any case, any and all Tiffany experts would be prevented from disclosing Applicants’ confidential information by the nondisclosure agreement noted above.)

Applicants have yet to advise Tiffany if they even *have* confidential information, let alone the nature of such information that could possibly be jeopardized by disclosure to Tiffany’s experts,

or how such information would be jeopardized when the experts already would be bound by a nondisclosure agreement. Nor can Applicants provide any cogent argument for why experts should be treated differently from other third parties to whom confidential information is disclosed. Indeed, Applicants' proposed paragraph 5 offers no real additional protection for Applicants' confidential material, but would give Applicants a procedural hammer that would require Tiffany to disclose its protected work product and would allow Applicants, at their option, to delay the course of this action merely by challenging Tiffany's experts, then requiring Tiffany to negotiate the issue with them and appeal to the Board.

Accordingly, Tiffany proposes that paragraph 5 be deleted in its entirety, and that disclosure to independent experts or consultants, like disclosure to all other third parties, be governed entirely by paragraph 4, as provided in Tiffany's attached version of the order. (Ex. 1.)

III. APPLICANTS HAVE NOT JUSTIFIED THEIR NEED FOR A PROVISION PROHIBITING THE USE OF CONFIDENTIAL MATERIAL IN APPEALS

Applicants also seek a provision that would permit the parties to use confidential material from this proceeding in appeals to the Federal Circuit under 15 U.S.C. § 1071(a), but not in direct appeals that constitute *de novo* actions as authorized by 15 U.S.C. § 1071(b). (See App. Mot., Ex. A, ¶ 11.) While they claim that "Opposer requests that Applicants stipulate that discovery from this case may be freely used in any subsequent case between the parties" (App. Mot. at 4), Tiffany actually said that it was willing to agree to limit the use of confidential materials from this action to direct appeals, whether to the Federal Circuit or to a U.S. district court. (Ex. 3 (2/1/05 letter at 2).) Applicants' only basis for refusing Tiffany's proposal is that "this request is premature as no other case is pending." (*Id.* at 4.) However, they offer to "revisit the request should an appropriate matter, such as one at the district court level, be filed." (*Id.*)

Applicants offer no legitimate justification for their arbitrary distinction between types of statutory appeals. Accordingly, Tiffany requests that paragraph 11 be modified as provided in the attached version of the order (Ex. 1), so the first sentence reads “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 authorized by 15 U.S.C. § 1071(a)-(b).”

IV. THE PARTIES SHOULD BE DENIED ACCESS TO CONFIDENTIAL MATERIAL

The parties agree that Paragraph 3 of the protective order should be changed to clarify that the parties themselves shall not have access to Confidential information. Tiffany raised this issue in its February 1, 2005 letter (Ex. 3, 2/1/05 letter at 1), and in a telephone conference with Applicants’ counsel on April 19, 2005 confirmed that Applicants will agree to such a change. Accordingly, the sentence of paragraph 3 following the bullet points should be revised to read: “Outside counsel, but not in-house counsel or the Parties themselves, shall have access to information designated as Confidential, subject to any agreed exceptions.”

CONCLUSION

For the reasons stated above, Tiffany respectfully requests that the Board refuse to hear Applicants’ motion during the pending suspension, or that it deny Applicants’ motion in its entirety and instead enter Tiffany’s version of the protective order, attached as Exhibit 1.

Dated: New York, New York
April 20, 2005

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

Barbara A. Solomon
Evan Gourvitz

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

Attorneys for Opposer Tiffany (NJ) Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Memorandum in Opposition to Applicants' Motion to Enter a Protective Order was served by prepaid first-class U.S. Mail on April 20, 2005, on Scott E. Charney, Esq., Lerner, David, Littenberg, Krumholz & Mentlik, LLP, 600 South Avenue West, Westfield, New Jersey 07090, counsel for Applicants Anthony Siragusa and Michael Romanelli.


Frances O'Keeffe

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EXHIBIT 1

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

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

**PROVISIONS FOR PROTECTING CONFIDENTIALITY OF
INFORMATION REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, the parties have agreed to be bound by the terms of this order. As used in this order, the term "information" covers both oral testimony and documentary material.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. The signature of a single member of a parties' outside counsel shall be sufficient to bind the entire outside counsel firm. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. The terms are binding from the date the parties or their attorneys sign the order.

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** or the **Parties** themselves, 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. 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.

6. 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.

7. 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.

8. 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.

9. 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.

10. 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 authorized by 15 U.S.C. § 1071(a)-(b). 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.

11. 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.

12. 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.

13. 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.

14. 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.

15. 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.
Attorneys 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 2

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

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

**PROVISIONS FOR PROTECTING CONFIDENTIALITY OF
INFORMATION REVEALED DURING BOARD PROCEEDING**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, the parties have agreed to be bound by the terms of this order. As used in this order, the term "information" covers both oral testimony and documentary material.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. The signature of a single member of a parties' outside counsel shall be sufficient to bind the entire outside counsel firm. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. The terms are binding from the date the parties or their attorneys sign the order.

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** or the **Parties themselves**, 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.~~

6.5. 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.

7.6. 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.

8.7. 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.

9.8. 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.

10.9. 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.

11.10. 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 authorized by 15 U.S.C. § 1071(a)-(b) ~~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.

12.11. 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.

13.12. 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.

14.13. 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.

15.14. 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.

16.15. 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.
Attorneys 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 3

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
LISA PEARSON
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NADINE H. JACOBSON
ANDREW N. FREDBECK
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January 26, 2005

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NANCY E. SABARRA
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IRENE SEGAL AYERS*
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*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 to follow up on our previous discussions with you regarding the parties' protective order in the above matter. Despite my call to you on December 20, 2004, we still have not heard back from you in response to our November 18, 2004 letter.

We still are in the process of gathering and preparing our client's production for your review. However, we will need to finalize the protective order before we can make the production, which will contain confidential materials, available to you.

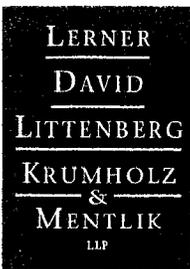
We look forward to hearing from you.

Yours sincerely,



Evan Gourvitz

cc: Barbara A. Solomon, Esq.



RECEIVED
JAN 27 11:16
JAN 27

Scott E. Charney
908.518.6336
scharney@ldlkm.com

January 26, 2005

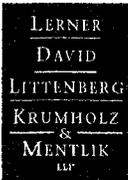
Evan Gourvitz, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
At First Avenue & 48th Street
New York, NY 10017

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:

We enclose herewith a revised Protective Order for your consideration. You will note that the Protective Order has been redlined to show changes from the Board's standard Protective Order. The changes represent those previously agreed to, as well as several additional changes based on your November 18, 2004 correspondence. In this regard, we note that we have accepted your offer to draft the Protective Order as a single tier document, whereby access to confidential documents will be limited to outside counsel's eyes only. In addition, we have included the language suggested in your November 18 correspondence as a modification to paragraph 13.

Notwithstanding, it appears that we may still be at odds with respect to the second and fourth points set forth in your November 18 correspondence. With respect to point two, we appreciate your citation suggesting that use of the fruits of one litigation in another advances the interests of judicial economy. However, we see no reason to expressly provide that discovery materials exchanged in this case may be used in future cases. The simple fact that paragraph 11 of the Protective Order only addresses this case does not absolutely preclude use of the documents at a later time for a subsequent case. Should such a case arise, we would of course entertain requests to reuse the discovery materials. Accordingly, at this time, we believe that a stipulation that all materials may be used for a later proceeding is simply premature. We do, however, agree that the materials may be used for any direct appeal resulting from this matter, and have revised the Protective Order to that effect.



Evan Gourvitz, Esq.

Page 2

January 26, 2005

Finally, we do not agree that paragraph 5 of the draft Protective Order "must" be deleted, and that disclosure to independent experts or consultants should be covered exclusively by paragraph 4. Other than your blanket statement that this change "must" be made, you have provided no justification to warrant this amendment. On the other hand, this is a standard provision in the Board's suggested Protective Order, and a provision which we feel treats both sides equally with respect to disclosure of confidential information.

Coincidentally, we find your statement that paragraph 5 "must" be deleted to be offensive. This Protective Order is intended to be a mutually agreed upon document, not one resulting from the demands of one party. In the future, we request that your proposed amendments be made as that, proposals, not demands. We will endeavor to do the same.

Should you find this draft Protective Order acceptable, please advise us of same and we will forward a signed copy to you for execution.

Very truly yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg
Enclosure

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 — 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 **confidential** 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 **confidential** or **highly confidential** information in accordance with the terms that follow in paragraph 4. 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.

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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.

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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.

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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.

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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.

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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.

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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.

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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.

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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: _____

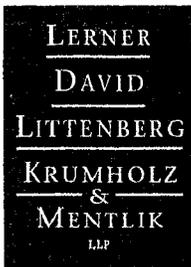
By: _____

Date: _____

Date: _____

By Order of the Board, effective _____.

By:



RECEIVED
05 FEB -7 11:00 AM
FZL & Z

Scott E. Charney
908.518.6336
scharney@ldlkm.com

February 1, 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: GOOSES 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:

Further to today's discussion, we understand that you will be forwarding a revised draft of the Protective Order for our consideration. We look forward to receiving same and agreeing on a mutually acceptable Protective Order.

With regard to the document production, we reiterate that we would like to inspect your client's documents as soon as possible. Ideally, this should be within a few days from execution of the Protective Order by all parties. If the Protective Order is not completed shortly, we will request that your client produce for inspection all non-confidential documents pending resolution of the Protective Order.

Sincerely yours,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg

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February 1, 2005

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* 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 Scott:

I write to respond to your January 26 and February 1, 2005 letters, and to follow up on our conversation today regarding our client's production and the parties' protective order.

First, to respond to a comment in today's letter, we will not provide a revised draft of the protective order. However, as discussed, we think that the order should be changed as follows:

In paragraph 1 (and throughout the remainder of the agreement), since the parties agree to a single tier of confidentiality, and agree that access to confidential documents will be limited to outside counsel (and designated experts, consultants, etc.), we believe that the three tiers in the agreement – "confidential," "highly confidential," and "trade secret/commercially sensitive" – can be condensed into a single category, "confidential."

In paragraph 3, as discussed, the sentence reading "[p]arties and their outside counsel, but not in-house counsel shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions" should be corrected to read "~~[p]arties and their~~ Outside counsel, but not in-house counsel or the Parties themselves, shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions." As noted above, however, given the restriction of confidential materials to outside counsel we think it is unnecessary to separate "confidential," "highly confidential," and "trade secret/commercially sensitive" information in this paragraph or elsewhere.

Scott E. Charney, Esq.

February 1, 2005

Page 2

We still believe that paragraph 5, which requires the parties to disclose the names of experts with whom they intend to share confidential material to the other side for approval, is unnecessary and inappropriate. Among other things, the names of such experts may be protected work product. In our conversation today, you said that this provision was necessary because a proposed expert might not be properly qualified, or might do some work for the other party's competitors. But there already are mechanisms in place in the T.T.A.B. for challenging an expert's qualifications, and we believe it is unlikely that any expert Tiffany might choose to retain would work for one of your client's competitors. Even in that unlikely situation, the expert would be bound by the nondisclosure certification required by paragraph 4. Accordingly, our client will not agree to an order that includes this paragraph.

In paragraph 11, in the interest of moving this proceeding forward, we will agree that the information disclosed pursuant to this protective order may be used only in direct appeals. However, we must insist that this include direct appeals to a U.S. district court (including by filing a *de novo* action) as well as appeals to the Federal Circuit. Accordingly, we think that the phrase "including any direct appeals which do not constitute *de novo* actions" should be replaced with the phrase "including any direct appeals."

The remainder of your proposed changes should be fine. Please let us know your response to the above issues as soon as possible so the parties can finalize the protective order.

Finally, we understand that you want to inspect our client's documents as soon as possible. As discussed, we will make them available for inspection shortly after we have finalized the protective order. However, we will *not* require our client to spend additional time and money separating, preparing and producing non-confidential documents for your review before the order is finalized, and then preparing and producing confidential documents after the order is finalized. Instead, we will make one production of all of our client's documents.

We look forward to hearing from you.

Yours sincerely,



Evan Gourvitz

cc: Barbara A. Solomon, Esq.

EXHIBIT 4

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April 5, 2005

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*ADMITTED IN OH. ONLY

BY 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 Scott:

Today we received Applicant's Motion to Enter a Protective Order. We also received what your cover letter described as Applicant's Motion to Compel Discovery, but this did not include a motion or certificate of service, but only documents described as Exhibits A-D.

As you know, this matter was suspended by the Board on January 6, 2005. In its order, the Board stated that "[t]he parties should not file any paper which is not germane to the motion to compel," citing Trademark Rule 2.120(e)(2). (While this did not toll the time for either party to respond to discovery requests served prior to our client's motion to compel, as you know, we properly served our client's responses to your requests on December 29, 2004.) Clearly, neither of your motions presently are permitted under the Board's order, and you have cited no authority to the contrary. Moreover, while we have not yet received your Motion to Compel Discovery, from our correspondence to date we find it unlikely that your client has satisfied its obligation to make a good faith effort to "meet and confer" with our client, as required by Rule 2.120(e)(1).

We therefore suggest that, to avoid burdening the Board and the parties with impermissible and inappropriate motions, you voluntarily withdraw your motions until our client's pending motion to compel has been resolved by the Board and the matter no longer is suspended. If you insist on moving forward with your motions, however, we must insist that you properly serve us with your Motion to Compel Discovery, as required by the rules of the Board.

Scott E. Charney, Esq.
April 5, 2005
Page 2

We look forward to hearing from you.

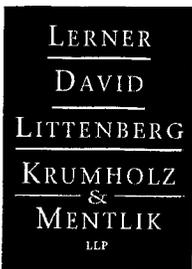
Yours sincerely,

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

Evan Gourvitz

cc: Barbara A. Solomon, Esq.

EXHIBIT 5



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April 8, 2005

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

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At First Avenue & 48th Street
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Re: GOOSES 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 responds to your April 5, 2005 correspondence which we received today. In response to your statement that you did not receive Applicant's Motion to Compel Discovery, we enclose a courtesy copy. We have not included the Exhibits which you have received.

We are aware that this matter was suspended by the Board. Our motions are proper under the Board's rules. In fact, we confirmed that with the Board prior to filing.

With respect to your allegation that the parties have not "met and conferred" prior to our filing of the Motion to Compel Discovery, we must strongly disagree. We asked you repeatedly to explain the basis for your counting of our interrogatories. You categorically refused and left us no choice but to file the Motion to Compel. If you are now willing to reconsider your lack of cooperation, please advise as to which you will answer and when.

Sincerely,

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/clg
Enclosure