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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

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May 5, 2005

TTAB

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 Reply Memorandum In Support of Applicants' 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



05-09-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #72

The Board's Order expressly does **not** toll the time to respond to outstanding discovery requests. Each party admitted that it was withholding, or planned to withhold, confidential and trade secret documents. Entry of a Protective Order is needed to enable both parties to respond to outstanding discovery requests.

Moreover, the undersigned confirmed the propriety of this motion with Interlocutory Attorney Thomas W. Wellington in a brief telephonic discussion held on February 24, 2005.

II. OPPOSER HAS NOT JUSTIFIED AN EXCEPTION TO WARRANT NON-DISCLOSURE OF EXPERTS

The Board's standard order requires the disclosure of experts' identities prior to a party providing the expert with confidential or trade secret materials of the other party. One benefit of this procedure is to help ensure that a party's confidential or trade secret information is not disclosed to a competitor where it will cause irreparable harm. Opposer would have the Board believe that this concept is completely foreign and beyond the realm of practicality, yet this very procedure is in the Board's standard Order. For this reason, it is Opposer's burden to justify an exception.

Opposer has not justified an exception and no such exception is warranted in this case. The provisions of the Order protect the parties equally. Before an expert retained by a party can receive confidential or trade secret information, that expert's qualifications should be disclosed. Only in this way can a party ensure that the expert is not in a position to misuse the confidential information and cause irreparable harm. Allowing only a subsequent challenge to the expert would not allow a party to stop the violation before irreparable injury has occurred. The Board has recognized this inequity and has incorporated prophylactic protections within its standard Order. Opposer states no reason to justify an alteration of the Board's standard order regarding this provision.

Opposer argues that the Protective Order does not require preapproval of "any other individual not otherwise specifically covered by the terms of this order" before seeing confidential and trade secret documents. (See ¶ 4.) Actually this provision refers only to such persons as court reporters or paralegals who create no risk of misuse of trade secret information. The Board recognized that disclosure of confidential and trade secret information to experts presented a greater risk. The Board addressed that risk by requiring that experts comply with paragraph 5 (preapproval) in addition to paragraph 4, the only paragraph with which specified "other individuals" need comply.

Opposer is also concerned that Applicants are unreasonably interfering with work product. Yet, Opposer gives no indication why a nontestifying expert must be given confidential or trade secret information.

For at least these reasons, the Board's standard provision should remain, and disclosure of confidential or trade secret information to an expert should not be permitted until the expert is identified to the party whose confidential information will be disclosed.

III. DISCOVERY MATERIALS SHOULD BE LIMITED TO USE IN THE PRESENT CASE

In another effort to deviate from the Board's standard Order, without justification to do so, Opposer requests that disclosure of information protected by the anticipated Protective Order be used to facilitate prosecution and defense of this case **and** any direct appeals authorized by 15 U.S.C. § 1071(a)-(b). Again, it should be Opposer's burden to justify any deviation from the Board's standard Order. Notwithstanding the lack of justification, in order to move this matter forward, Applicants agreed to use of protected information in direct appeals which do not constitute *de novo* actions. Opposer is not satisfied with this attempted compromise. If its

position remains unchanged, Applicants are willing to go with the Board's standard provision without any change.

IV. CONCLUSION

As stated in Applicants' moving papers, both parties agree that a Protective Order is required in this case. However, the Parties have been unable to agree on the specifics of the Order. Applicants have been willing from the start to enter the Board's standard Protective Order without change, and renew this offer here.

However, Opposer has insisted on many modifications, some of which Applicants agreed to enter. Opposer's requested modifications have quite simply gone too far, and Applicants request that the Board either enter the proposed Protective Order attached to Applicants' moving papers which incorporates many of Opposer's requested modifications, or the Board's standard order so this proceeding may move forward.

Respectfully submitted,

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*Attorneys for Applicants Anthony Siragusa
and Michael Romagnelli*

Dated: May 5, 2005

By: 

Scott E. Charney

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the within APPLICANTS' REPLY MEMORANDUM IN SUPPORT OF APPLICANTS' MOTION TO ENTER A PROTECTIVE ORDER PURSUANT TO 37 C.F.R. § 2.120(f), was served upon the following counsel of record this 5th day of May, 2005, as follows:

VIA FIRST-CLASS MAIL:

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Scott E. Charney

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