

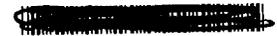
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PATENTS, TRADEMARKS, COPYRIGHTS & UNFAIR COMPETITION

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August 10, 2005

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



08-15-2005

U.S. Patent & TMOtc/TM Mail RcptDt. #01

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 And Memorandum Of Law For Leave To file An Amended Answer, and
2. Certificate of Service.

Respectfully yours,

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP

SCOTT E. CHARNEY

SEC/def

Enclosures

cc: Barbara A. Solomon, Esq. (w/encl.)(via first-class mail)



If the underlying facts or circumstances relied upon by a [moveant] may be a proper subject of relief, he ought to be afforded an opportunity to test his claim on the merits. In the absence of any apparent or declared reason — such as undue delay, bad faith or dilatory motive on the part of the movement, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. — relief sought should, as the Rules require, be "freely given."

*Id.* at 182.

Under *Foman*, district courts have held that a motion to amend may be denied only upon "a showing of prejudice, bad faith, futility, or dilatoriness associated with the motion." *Sandcrest Outpatient Serv., PA v. Cumberland County Hosp. Sys., Inc.*, 853 F.2d, 1139, 1148 (4th Cir. 1988) (quoting *Work Elec. Serv. v. First Commercial Bank*, 819 F.2d, 496, 497 (4th Cir. 1987)). None of these exceptions apply to Applicants' proposed amended answer, inasmuch as the proposed amendments are not made in bad faith, and are not futile or dilatory in nature. In addition, no prejudice against Opposer will occur.

As an initial matter, Applicants have not unreasonably delayed in requesting to file the proposed amended answer. Only recently has Applicants' counsel learned of several facts upon which the amended answer is based. These facts were learned just prior to the deposition of Michael Romanelli, one of the Applicants herein.

Nor can Opposer contend that Applicants delayed in requesting leave to file an amended answer once it had knowledge of the underlying facts. In fact, at the deposition of Michael Romanelli, Applicants requested Opposer's consent to adding the additional defense, but were denied. Nonetheless, Opposer took the opportunity to depose Mr. Romanelli on the equitable estoppel issues which were disclosed as being the basis for the requested leave. Applicants had produced documents supporting this affirmative defense before the deposition. Accordingly, Opposer has not been prejudiced by this request, as discovery on this issue has already begun.

In view of the foregoing, Applicants respectfully submit that the Board grant their motion for leave to file an amended answer, attached hereto as Exhibit A. In addition, Applicants request that the amended answer be deemed filed and served as of the date the Board rules on this motion.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP

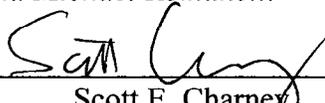
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*Attorneys for Applicants Anthony Siragusa  
and Michael Romanelli*

Dated: August 10, 2005

By:   
Scott E. Charney

# Exhibit A



6. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 and therefore deny them.

7. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 7 and therefore deny them.

8. Applicants admit the allegations of paragraph 8.

9. Applicants admit the allegations of the first sentence of paragraph 9, but deny the allegations of the second sentence of paragraph 9.

10. Applicants admit the allegations of the first sentence of paragraph 10; Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations of the second and third sentences of paragraph 10 and therefore deny them.

11. Applicants admit that they believed that the Opposer used the TIFFANY mark for jewelry and retail store services for the sale of jewelry; Applicants deny having any actual knowledge of Opposer having rights in the TIFFANY mark beyond its use for jewelry, retail store services for jewelry, and closely related goods and services; Applicants deny that they have any constructive notice of Opposer's rights in the TIFFANY mark beyond the particular goods and services set forth in the registrations, in particular jewelry and retail store services for jewelry and closely related products; Applicants deny all other allegations of paragraph 11 which are not specifically admitted by Applicants' averments in this paragraph.

12. Applicants admit that they disclaimed exclusive rights to the word RESTAURANTS apart from the entire mark as shown for Application Serial No. 76/520,262, but deny that it is proper to remove the disclaimed portion from the full mark TIFFANY'S

RESTAURANTS to determine similarity to another mark in sound, meaning, appearance, and commercial impression, and deny all other allegations of paragraph 12.

13. Applicants are without knowledge or information to form a belief as to the truth of the allegations of the first sentence of paragraph 13 and therefore deny them; Applicants deny the allegations of the second sentence of paragraph 13.

14. Applicants aver that their application covers "food restaurant services," but are without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 14 and therefore deny them.

15. Applicants deny the allegations of paragraph 15.

16. Applicants repeat and reallege each and every allegation in response to paragraphs 1-15, as if fully set forth herein.

17. Applicants deny the allegations of paragraph 17.

18. Applicants deny that a likelihood of confusion may be considered by comparing only that portion of Applicants' mark that has not been disclaimed to Opposer's mark, and deny all other allegations of paragraph 18.

19. Applicants deny the allegations of paragraph 19; Applicants note that the citation of a decision from the Federal Supplement requires no response.

20. Applicants deny the allegations of paragraph 20.

21. Applicants repeat and reallege each and every allegation in response to paragraphs 1-20, as if fully set forth herein.

22. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 22 and therefore deny them.

23. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 23 and therefore deny them.

24. Applicants deny the allegations of paragraph 24.

25. Applicants specifically deny the allegation that Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) and 15 U.S.C. § 1125(c), provides a basis for refusing registration of a mark on the ground that it is "likely to dilute" a registered famous mark, and deny all other allegations of paragraph 25.

26. Applicants deny the allegations of paragraph 26.

**FIRST AFFIRMATIVE DEFENSE**

27. The Notice of Opposition fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

28. Applicants have made substantial use of their mark TIFFANY'S RESTAURANTS for nearly 24 years for food restaurant services, contemporaneous with Opposer's alleged use of the mark TIFFANY for jewelry and closely related products and for retail store services for jewelry and related products. The absence of confusion between Applicants' mark and Opposer's mark over this time demonstrates that Applicants' mark is not likely to cause confusion, or to cause mistake or to deceive.

**THIRD AFFIRMATIVE DEFENSE**

29. Upon information and belief, Opposer's mark TIFFANY has become well-known only in association with jewelry, perfumes, watches, clocks, bowls, vases, candlesticks, and other closely related, extremely expensive jewelry items.

30. Applicants' mark TIFFANY'S RESTAURANTS has been used for food restaurant services and is associated with such services. The RESTAURANTS portion of Applicants' mark serves to emphasize the services with which the mark has become associated.

31. Upon information and belief, for the many years that Opposer has used the mark TIFFANY for retail jewelry store services, Opposer has never opened a restaurant in its retail stores, because having restaurant services in the same retail location as the display and sales of jewelry would be inconsistent with the high fashion jewelry store services provided by and associated with Opposer's TIFFANY mark.

32. Due to the significant dissimilarity between the marks, TIFFANY'S RESTAURANTS and TIFFANY, particularly with regard to the RESTAURANT portion which identifies Applicants' services; the great differences between Applicants' services and Opposer's goods and services; the low likelihood of Opposer bridging the gap; the lack of overlap between consumers of Applicants' services and Opposer's goods and services; the sophistication and knowledge of Applicants' and Opposer's customers; and the absence of actual confusion, registration of Applicants' mark TIFFANY'S RESTAURANT will not cause dilution of any distinctive quality of Opposer's TIFFANY mark.

#### **FOURTH AFFIRMATIVE DEFENSE**

33. Upon information and belief, Opposer had knowledge of Applicants' extensive use of its TIFFANY'S RESTAURANTS mark, yet Opposer inexcusably delayed in taking any action with respect to such use.

34. Applicants would now be prejudiced if Opposer is permitted inequitably to assert rights now to bar registration of Applicants' mark, so that Opposer's assertion of its rights at this time is barred by laches.

WHEREFORE, Applicants request that Notice of Opposition be dismissed and that Applicants' Serial No. 76/520,262 be allowed.

**FIFTH AFFIRMATIVE DEFENSE**

35. Upon information and belief, representatives of Opposer have reserved and used Applicants' restaurant using the mark TIFFANY'S RESTAURANTS for official parties for Opposer's officers and employees.

36. Upon information and belief, in the course of their use of Applicants' restaurant, representatives of Opposer have commented on Applicants' restaurants and its use of a name including the word TIFFANY in a favorable way, and have explicitly or implicitly represented that the Opposer did not disapprove of such use.

37. With notice of Applicants' use of the mark TIFFANY'S RESTAURANTS, representatives of Opposer have continued to reserve and use Applicants' restaurants for parties and apparently consented to Applicants' use of their mark containing the word TIFFANY.

38. After comments by Opposer's representatives about the use of a mark containing the word TIFFANY by Applicants, Opposer has not objected to Applicants' use of the mark TIFFANY'S RESTAURANTS, creating a further representation that Opposer did not object to such use or to registration of such mark.

39. Applicants have relied in part on Opposer's representations and failure to object to use of the mark TIFFANY'S RESTAURANTS in their decision to expand use of the mark TIFFANY'S RESTAURANTS and to apply to register the mark TIFFANY'S RESTAURANTS.

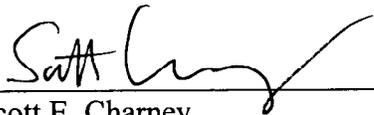
40. Opposer's assertion at this time of any objection to Applicants' registration of the mark TIFFANY'S RESTAURANTS is barred by equitable estoppel.

WHEREFORE, Applicants request that Notice of Opposition be dismissed and that Applicants' Serial No. 76/520,262 be allowed.

Respectfully submitted,

LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP

Dated: 8-16-05

By: 

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*Attorneys for Applicants Anthony Siragusa  
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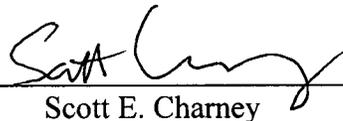
**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the within APPLICANTS' MOTION AND MEMORANDUM OF LAW FOR LEAVE TO FILE AN AMENDED ANSWER, was served upon the following counsel of record this 10th day of August, 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

GOUSES 10.2A-001  
Opposition No. 91160913