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

Proceeding	91160913
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TIFFANY (NJ) INC.,	:	
Opposer,	:	
-against-	:	Opp. No. 91160913
UNITED WOO ENTERPRISES, INC.,	:	
Applicant.	:	

OPPOSER'S MOTION TO COMPEL AND DETERMINE SUFFICIENCY AND MEMORANDUM IN SUPPORT THEREOF

Pursuant to Rules 36 and 37 of the Federal Rules of Civil Procedure, 37 C.F.R. §§ 2.120(e) and (h), and TBMP §§ 523 and 524, and upon this memorandum and the declaration and exhibits submitted herewith, Opposer Tiffany (NJ) Inc. ("Opposer") hereby moves the Trademark Trial and Appeal Board (the "Board") for an order: (1) compelling United Wu Enterprises, Inc. ("Applicant") to respond properly and fully to Opposer's First Set of Interrogatories and First Request for Production of Documents and Things to Applicant (the "Requests") within fourteen (14) days of the Board's Order; (2) precluding Applicant from offering at trial any evidence responsive to the Requests that it does not produce forthwith, as the withholding of such evidence would severely prejudice Opposer's case; and (3) compelling Applicant to respond properly and fully to Opposer's First Set of Requests for Admission within fourteen (14) days of the Board's Order, failing which the Requests at issue will be deemed admitted. Opposer also requests that, as required by 37 C.F.R. §§ 2.120(e)(2) and (h)(2), the Board suspend this case with respect to all matters not germane to this motion during the pendency of the motion.

I. INTRODUCTION

Applicant's repeated failure to engage in good faith discovery in this matter has necessitated this motion. As is set forth more fully in the accompanying Declaration of Evan Gourvitz in Support of Opposer's Motion to Compel, dated April 18, 2007 ("Gourvitz Declaration"), Opposer first served Applicant with requests for admission on September 26, 2006, and first served Applicant with document requests and interrogatories in this matter on October 3, 2006. Although Applicant's responses to these requests contained many deficiencies, and although Opposer's counsel in good faith wrote emails and letters to Applicant noting its concerns, and setting forth Applicant's deficiencies in detail, Applicant has failed to address most of these concerns, or even to provide a substantive response to Opposer's deficiency letter.

Given Applicant's repeated refusal to remedy the deficiencies noted by Opposer, Opposer seeks an order that Applicant either fully and properly respond to Opposer's interrogatories, document requests, and requests for admission, or be precluded from relying on responsive documents and evidence that Applicant has failed to produce, and be deemed to admit the requests for admission at issue. Opposer should not be required to litigate from the position of evidentiary uncertainty that Applicant has created.

II. CERTIFICATION OF COUNSEL

As set forth in detail in the Gourvitz Declaration, Opposer's counsel has in good faith attempted to resolve the issues presented in this motion with Applicant's counsel, and has been unable to reach agreement with Applicant on these issues. Indeed, Opposer has tried to address Applicant's discovery deficiencies, and to resolve Opposer's discovery disputes with Applicant, for many months. Despite Opposer's good faith efforts, Applicant has refused to cure the vast majority of these deficiencies, or even to provide a substantive response to Opposer's detailed deficiency letter. Accordingly, Opposer now files this motion because it believes that further attempts to resolve these discovery disputes will be entirely unproductive.

III. FACTS

A. Background

Opposer is the owner of the world-famous TIFFANY and TIFFANY & CO. marks. It has opposed Applicant's attempt to register the mark TIFFANY DESIGNS.

On August 29, 2003, Wen Jong Wu filed an application, U.S. Serial No. 76/541,932, to register a design version of the TIFFANY DESIGNS mark for "dresses and gowns for proms and social occasions" in International Class 25, claiming a first use date of December 1, 1994. This application was rejected by the U.S. Patent & Trademark Office ("PTO") because of a likelihood

of confusion with certain of Opposer's TIFFANY & CO. marks, and the applicant subsequently abandoned this application.

Without disclosing this rejection to the PTO, on August 25, 2005, Applicant United Wu Enterprises, Inc., a corporate entity located as the same address as Wen Jong Wu, filed a new application, U.S. Serial. No. 78/700,677, to register the word mark TIFFANY DESIGNS for "women's formal dresses and gowns, prom dresses and gowns, dresses and gowns for formal social occasions" in International Class 25, claiming a first use date of January 1995. A March 30, 2006 response to an office action for this application (the "Application") was signed by "Wen J. Wu." Inexplicably, the PTO did not cite Opposer's registrations against this new application as it had the year before, and the Application was published for opposition.

On July 27, 2006, Opposer, which owns a wide variety of trademarks for its famous TIFFANY and TIFFANY & CO. marks for a variety of goods and services, filed a Notice of Opposition to the Application. In the Notice, Opposer alleged that, based on its extensive rights in its famous TIFFANY and TIFFANY & CO. marks and its many federal registrations for those marks that Applicant's registration of the TIFFANY DESIGN mark is likely to cause confusion with, and is likely to dilute, Opposer's famous TIFFANY and TIFFANY & CO. marks.

On September 11, 2006, Applicant filed its Answer to the Notice of Opposition. Discovery originally was set to close on February 16, 2006. However, because of Tiffany's difficulties in obtaining discovery, it proposed extending, and Applicant agreed to extend, the close of discovery until May 17, 2007. The Board ordered this extension on January 23, 2007.

B. <u>Applicant's Failure to Respond Fully to Opposer's Discovery Requests</u>

As noted above, on September 26, 2006 Opposer served its requests for admission on counsel for Applicant (Gourvitz Decl. ¶ 2; Ex. 1), and on October 3, 2006 Opposer served its

document requests and interrogatories on counsel for Applicant. (Gourvitz Decl. ¶ 3; Exs. 2-3.) Applicant served its written responses and objections to the requests for admission on October 31, 2006 (Gourvitz Decl. ¶ 4; Ex. 4) and its written responses and objections to the document requests and interrogatories on November 7, 2006 (Gourvitz Decl. ¶ 5; Exs. 5-6). As discussed in detail below, Applicant's responses were substantially deficient.

C. Subsequent Discussions Between the Parties Concerning Applicant's Deficiencies

On November 7, 2006, Opposer's counsel sent an email to Applicant's counsel noting the deficiencies in Applicant's responses to Opposer's document requests, and asking that Applicant immediately provide to Opposer: (a) the date it would make documents available; (b) a privilege log; and (c) the analysis it applied in asserting that Opposer served more than 75 interrogatories, including subparts. (Gourvitz Decl. ¶ 6; Ex. 7.) This email also noted that confidentiality was not a proper basis for withholding documents, since the parties could enter an appropriate protective order. On November 8, 2006, Applicant's counsel provided an email response that (a) demanded that Opposer provide a draft protective order, (b) ignored the issue of a privilege log, and (c) refused to provide a count of its interrogatories, but insisted that Opposer provide such a count. (Gourvitz Decl. ¶ 7; Ex. 8.) This email also raised purported deficiencies in Opposer's own production, and demanded that Opposer provide a date when it would produce its own documents.

That same day, Opposer's counsel responded, stating that it would make its document production available for inspection at some date from November 22 forward, requesting information on when Applicant's production would be available, and providing a draft protective order for Applicant's review. (Gourvitz Decl. ¶ 8; Ex. 9.) It also noted that Opposer felt that a phone conference on the parties' deficiencies would not be productive until the parties first

expressed their concerns in writing. After receiving no response, Opposer sent a follow-up email on November 20. (Gourvitz Decl. ¶ 9; Ex. 10.) After still receiving no response, Opposer called and left messages for Applicant's counsel on November 21 and 22. (Gourvitz Decl. ¶ 10.) On November 27, 2006, counsel for the parties briefly spoke on the phone and agreed to provide their thoughts on each other's purported deficiencies in writing. (*Id.*)

On November 30, 2006, Opposer noticed a 30(b)(6) deposition of Applicant, along with a deposition of Wen Jong Wu, for January 9, 2007. (Gourvitz Decl. ¶ 11; Ex. 11.) Thereafter, on December 6, 2006, Opposer's counsel sent an email to Applicant's counsel requesting the date of Applicant's document production. (Gourvitz Decl. ¶ 12; Ex. 12.) In response, Applicant's counsel stated that she was "puzzled" by this request, given their November 27 agreement to provide their comments on each other's deficiencies in writing. (Gourvitz Decl. ¶ 13; Ex. 13.) Applicant's counsel also raised purported concerns with Opposer's proposed protective order, stating that it "significantly deviates from the standard two-tiered TTAB confidentiality agreement which seems more fitting," said that the date Opposer noticed for the depositions would not work, and noted that she would be out of the office "beginning December 18 until the end of the month." (Ex. 13.) After calls to Applicant's counsel went unanswered on January 5 and 9, 2007 (Gourvitz Decl. ¶ 14), Opposer's counsel sent a letter to Applicant's counsel on January 9, rescheduling the depositions previously scheduled for that day for January 26. (*Id.* ¶ 15; Ex. 14.) This letter also stated that Opposer's proposed protective order should work for this action, since it limited disclosure to the parties to their in-house attorneys, and said that Opposer's counsel would like to review Applicant's production the day before the deposition, on January 25. (Ex. 14.)

The parties exchanged phone messages on January 9 and 10 (Gourvitz Decl. ¶ 16), and in an email January 10 Applicant's counsel proposed that the deposition be rescheduled for January 30. (*Id.* at ¶ 16; Ex. 15.) On January 11 Opposer's counsel sent an email saying that this date would work, "provided we have the chance to review your client's document production beforehand on a convenient date." (Gourvitz Decl. ¶ 17; Ex. 16.) Opposer's email also asked for a date to review Applicant's documents, and asked when Applicant would like to review Opposer's documents. (*Id.*) After several days silence, Opposer's counsel followed up with a reminder email on January 16 (Gourvitz Decl. ¶ 18; Ex. 17), and received a response (i) "confirm[ing] that you have rescheduled your earlier-noticed deposition . . . from 1/26 to 1/30, (ii) stating that "[d]ocuments will be made available for your review on January 23, 2007," and (iii) asking about the scope of Opposer's document production. (Gourvitz Decl. ¶ 19; Ex. 18.) Opposer's counsel responded that same day, (i) saying that it would not be convenient to travel to Florida to review Applicant's production a full week before the deposition, (ii) asking about the volume of Applicant's production, and (iii) noting that its own production would be voluminous. (Gourvitz Decl. ¶ 20; Ex. 19.) On January 17 Opposer's counsel provided a rough page count of its documents (Gourvitz Decl. ¶ 21; Ex. 20), asked whether Applicant's counsel would like to pay for their copying or would prefer to view them in New York, and followed up on the deposition and protective order. (Ex. 20.)

As per the parties' November 27 agreement, on January 18 Opposer's counsel sent Applicant a letter detailing in writing the many deficiencies in Applicant's written discovery responses. (Gourvitz Decl. ¶ 22; Ex. 21.) This letter asked that by January 22 Applicant inform Opposer whether it would remedy these deficiencies by January 26. (Ex. 21.) On January 19 Applicant's counsel sent an email to Opposer's counsel, which, after complaining about

Opposer's own purported discovery deficiencies, addressed only one substantive issue from Opposer's deficiency letter – the use of the word "famous." (Gourvitz Decl. ¶ 23; Ex. 22.) This letter also said that Applicant was reviewing its documents to provide a page count, and would produce "Wen Wu" both individually and as its 30(b)(6) witness on November 30. (*Id.*) Finally, the letter claimed that TTAB rules required the parties to "*discuss* the disputed issues, preferably over the telephone in a professional manner," and said that Applicant's counsel would like to schedule a telephone call to discuss the matter. (*Id.*) That same day Opposer's counsel responded, stating that (i) it was not proper for one party to raise the other's purported deficiencies as a defense to its own deficiencies, (ii) Opposer's documents had been available for Applicant's review for some time, (iii) Opposer still had not yet received any comments on its proposed protective order; (iv) Opposer set a short deadline for the response to its deficiency letter because of the rapidly approaching deposition and close of discovery, (v) Opposer would not conduct the deposition unless it could first get Applicant's proper production and proper discovery responses, and (vi) the parties' email correspondence constituted a good faith and proper effort to confer in accordance with the relevant rules, and also created a helpful record to the Board. (Gourvitz Decl. ¶ 24; Ex. 23.) The email nevertheless said that Opposer remained "willing to further discuss the matters addressed in our deficiency letter . . at any time, and we look forward to your detailed response." (Ex. 23.) However, while the parties later agreed to extend the close of discovery and delay the deposition of Applicant's witness (Gourvitz Decl. ¶ 25), Opposer received no further answer from Applicant in response to Opposer's detailed deficiency letter, as requested. Accordingly, after one more attempt at getting substantive responses from Applicant in response to Opposer's January 18 deficiency letter (*see* Gourvitz Decl. ¶¶ 26-27; Ex. 24), Opposer has brought the present motion.

IV. ARGUMENT

A. THE BOARD SHOULD COMPEL APPLICANT TO RESPOND PROPERLY TO OPPOSER'S INTERROGATORIES AND DOCUMENT REQUESTS OR PRECLUDE IT FROM RELYING ON DOCUMENTS OR OTHER EVIDENCE THAT WOULD BE RESPONSIVE TO THE INTERROGATORIES AND REQUESTS

Federal Rule of Civil Procedure 37(a)(2)(B) states that if a party fails to answer a propounded interrogatory or document request, "the discovering party may move for an order compelling an answer . . . or an order compelling inspection in accordance with the request." Similarly, 37 C.F.R. § 2.120(e)(1) states that "if a party . . . fails to answer . . . any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion . . . for an order to compel . . . an answer, or production and an opportunity to inspect and copy . . ." *See also* TMBP § 523 (requirements and procedure for motion to compel discovery). "[A]n evasive or incomplete disclosure, answer or response is to be treated as a failure to disclose, answer or respond." Fed. R. Civ. P. 37(a)(3).

Here, Applicant has failed to respond in good faith to Opposer's document requests and interrogatories. As set forth below, Applicant has wrongfully objected to and refused to produce documents responsive to a number of Opposer's document requests. Similarly, Applicant has wrongfully objected to and refused to answer *any* of Opposer's interrogatories. Under these circumstances, the Board should issue an Order (i) compelling Applicant to properly respond to Opposer's document requests, and produce all responsive documents in its possession, custody or control, within fourteen days of the Order, (ii) compelling Applicant to confirm for each request to which it has no responsive documents that such is the case, and (iii) precluding Applicant from relying at trial on any responsive documents not produced. *See* Fed. R. Civ. P. 37(a)(2)(B); 37 C.F.R. § 2.120(e)(1); TMBP §§ 412.02, 523. Additionally, the Order should (iv) compel Applicant to serve amended answers to Opposer's interrogatories within fourteen days of

the Order, and (v) preclude Applicant from introducing evidence on any of the issues covered by such interrogatories at trial if Applicant fails to provide the requested information. *See id.*

Set forth below are the deficiencies complained of for Applicant's responses to both Opposer's interrogatories and document requests.

1. Interrogatories

Applicant objected to and did not produce answers to any of Opposer's interrogatories, claiming that Opposer "exceeded the seventy-five (75) interrogatory limit, including subparts, as provided by TBMP Section 405.03(a)." (Ex. 6 at 3.) However, despite Opposer's November 7, 2006 request that Applicant provide its count of the number of interrogatories, including subparts, that it believed Opposer had propounded (Ex. 7), Applicant refused to do so (Ex. 8). While Opposer provided its own count of its interrogatories, including subparts, in its January 18, 2007 deficiency letter (Ex. 21 at 2 & Ex. 1), and while Opposer requested in that letter that Applicant provide its own count by January 22, 2007 (*id.* at 2), Applicant did not do so. Indeed, to date Applicant still has neither responded to Opposer's latest request for a count nor provided *any* answers to *any* of Opposer's interrogatories.

Trademark Rule § 2.120(d)(1) states that "[t]he total number of written interrogatories which a party can serve on another party" normally "shall not exceed seventy-five, counting subparts." In determining whether the number of interrogatories served by a party exceeds the limit, the Board counts each subpart separately. *See* TBMP § 405.03(d). However, instructions are not counted as additional interrogatories, and "[i]f an interrogatory requests 'all relevant facts and circumstances' concerning a single issue, event, or matter; or asks that a particular piece of information . . . be given for multiple years . . . it will be counted as a single interrogatory." *Id.* Here, Opposer has served only 34 interrogatories (Ex. 3), and, as shown by the attached count (Ex. 21 at Ex. 1), Opposer believes that its interrogatories, even counting subparts, total no more than 48 – well within the limit provided by the Trademark Rules of Practice. Opposer cannot comment on Applicant's own count of these interrogatories and subparts, since Applicant never provided it.

Accordingly, Opposer requests that the Board order Applicant to submit proper and full responses – without objections – to each of Opposer's interrogatories without further delay, or be precluded from introducing any evidence responsive to the interrogatories at any later point in this proceeding.

2. Document Requests

As detailed below, in its written responses Applicant has raised spurious objections and either stonewalled or refused to provide documents in response to many of Opposer's reasonable document requests. It should be required to respond properly and fully to these requests within fourteen days, or be precluded from introducing any evidence responsive to the requests that it does not produce forthwith.

a. Requests 4-6, 40-41

4. All documents concerning your creation and adoption of Applicant's Mark.

5. All documents concerning your reasons for adopting Applicant's Mark.

6. All documents reviewed or considered by Applicant in creating or developing Applicant's Mark.

40. All documents concerning how and when Applicant first became aware of Opposer.

41. All documents concerning how and when Applicant first became aware of Opposer's Mark.

In response to Opposer's Requests 4-6, Applicant stated "None known to Applicant at this time." In response to Opposer's Requests 40-41, Applicant simply stated "None known." (Ex. 5 at 7-8, 17.) While Opposer requested in its January 18 letter that Applicant supplement these responses as necessary (Ex. 21 at 10), Applicant did not agree to do so, nor has it done so to date.

All of these Requests clearly are for documents highly relevant to this opposition, since they could provide or are likely to lead to admissible evidence about, *e.g.*, Applicant's (i) intent in adopting its mark, (ii) knowledge of Opposer and Opposer's mark at the time it adopted its own mark, and (iii) knowledge of the prior rejection of its principal's application for its mark on the basis of a likelihood of confusion with Opposer's TIFFANY & CO. marks. *See, e.g.*, TBMP § 414(4)-(5), (19) (information on selection, adoption, and first use of defendant's mark, and details of defendant's knowledge of plaintiff's use of its own mark, are discoverable). Moreover, despite Applicant's claims in November 2006, it seems beyond belief that Applicant has to date found no documents on any of these subjects.

b. Requests 7-10

7. Documents sufficient to identify all persons who created or developed Applicant's Mark.

8. Documents sufficient to identify all persons who decided that Applicant would adopt Applicant's Mark.

9. Documents sufficient to identify all persons who determined where and in connection with what goods or services Applicant's Mark is and has been used.

10. Documents sufficient to identify any owner, employee, shareholder, or principal of Applicant who personally uses or is known by the name Tiffany.

In response to Requests 7-10, Applicant said that each request was "ambiguous," and that if the request sought documents identifying the given person at issue it was a "disguised interrogatory" and was objectionable as such. (Ex. 5 at 8-9.) It did not agree to produce documents responsive to any of these requests, even after Opposer's letter. (Ex. 21 at 10-11.)

Opposer does not believe that any of these requests is ambiguous – each merely requests documents sufficient to identify certain people closely related to the creation, adoption, and use

of Applicant's Mark, or to identify persons associated with Applicant who use the name Tiffany. These Requests are for documents highly relevant to the issues in this opposition, *see* Fed. R. Civ. P. 26(b)(1), since they would identify witnesses with knowledge of the subjects in question, or for whom the company was named, who then could be deposed, and since they would provide documentary evidence closely related to the identities of these witnesses. As for the claim that these are "disguised interrogatories," Applicant does not explain this claim or provide any precedent to support it. The Requests do not ask Applicant to create any documents, merely to search for and produce any existing documents that are responsive. For example, "[d]ocuments sufficient to identify all persons who created or developed Applicant's Mark."

c. Request 12

12. Documents sufficient to show the commercial impression made by Applicant's Mark.

Applicant objected to this Request as burdensome and overbroad, and as ambiguous since "commercial impression generally occurs in the minds of others encountering a mark." It did not agree to produce documents responsive to this request. (Ex. 5 at 10.)

Despite Applicant's claim, the commercial impression of a given mark is something a party reasonably should be expected to know about its own mark, and is highly relevant to the question of likelihood of confusion. *E.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005). Moreover, this request is neither burdensome or overbroad, since it seeks only documents *sufficient* to show the commercial impression of Applicant's Mark.

d. Requests 13, 16, 31, 32, 37

13. Documents sufficient to show any other words, marks, symbols, house marks, or designs Applicant uses, has used, or intends to use together with the word TIFFANY.

16. Documents sufficient to show the wholesale and retail prices of each product or service sold or provided by or on behalf of Applicant in connection with the Applicant's Mark.

31. Documents sufficient to describe the individuals or classes of consumers (*e.g.*, demographic data) to whom goods offered under Applicant's Mark are or have been marketed and sold, or to whom Applicant plan to market and sell goods offered under Applicant's Mark.

32. For each product and service in connection with which Applicant's Mark has been used, documents sufficient to show Applicant's total actual sales on an annual basis (in terms of both dollars and units sold) since Applicant's date of first use of the mark.

37. Documents sufficient to show the amount of money spent by Applicant (and any other party Applicant authorized to use the mark) for advertising and promotion of goods or services bearing Applicant's Mark on an annual basis for each month and year since the date of first use.

38. Documents sufficient to identify all officers, directors, employees, and shareholders of Applicant.

Applicant objected to all of these requests by objecting on the basis of confidentiality. In response to Request 13 Applicant objected "to the extent it seeks information about [Applicant's] intentions," and said that it otherwise had no documents "known to be responsive." (Ex. 5 at 10.) In response to Requests 31 and 38 Applicant objected but said it would make available "representative and non-privileged documents which are reasonably responsive thereto." (*Id.* at 14-16.) In response to Requests 16, 32, and 37 Applicant objected solely on the ground of confidentiality, and did not agree to produce any documents. (*Id.* at 11, 15-16.)

While Opposer noted in its deficiency letter that confidentiality is not a proper ground for refusing to produce documents, since they may be produced in accordance with a proper protective order (Ex. 21 at 12), *see also* 37 C.F.R. § 2.120(f) (protective order); TBMP § 412 (same), to date Applicant has not supplemented its responses to any of these requests.

e. Request 33

33. Documents sufficient to show all advertisements and promotional materials for goods and services sold or provided by or on behalf of Applicant in connection with Applicant's Mark (e.g., brochures, catalogs, television commercials, newspaper articles or magazine advertisements), and how the mark is or was used in each (*e.g.*, as part of a logo, as part of a slogan, in conjunction with a house mark, etc.).

Applicant objected to this request on the grounds of burdensomeness and overbreadth, and did not agree to produce responsive documents. (Ex. 5 at 15.) In its deficiency letter Opposer observed that these objections are unfounded, as its request was limited to documents *sufficient* to show the requested information, and noted that Applicant's advertising, promotion, and use of its purported mark are highly relevant to the opposition. (Ex. 21 at 13.) Applicant nevertheless still has not agreed to produce any responsive documents.

f. Request 39

39. Documents sufficient to show the relationship between (i) United Woo Enterprises, Inc., the applicant in this action, and its owners or shareholders, on the one hand, and (ii) Wen Jong Wu, the applicant for U.S. Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design, on the other hand.

In response to this Request Applicant said that it was "vague, ambiguous, and capable of more than one interpretation," and did not agree to produce responsive documents. (Ex. 5 at 16-17.) Opposer clarified in its deficiency letter that "this request seeks documents about whether Wen Jong Wu" – who previously applied for a near-identical mark for near-identical goods and had his application rejected because of likelihood of confusion with Opposer's marks (*see* 2-3 *supra*) – "is or was an owner, shareholder, officer, director, employee, or agent of Applicant, and the details of his business relationship with Applicant." (Ex. 21 at 13-14.) Despite this clarification, Applicant has not yet agreed to produce any documents in response.

g. Request 45

45. All documents or communications, including all emails, concerning Opposer.

Applicant objected to this request as "vague, ambiguous, overly broad and unduly burdensome," and did not agree to produce responsive documents. (Ex. 5 at 18.) In its deficiency letter Opposer noted that Applicant had not detailed "what, if anything, about the Request is vague or ambiguous" and that "given the obvious relevance of any responsive documents your client may have . . . and the presumably limited universe of such documents, a request for these documents is neither overbroad nor unduly burdensome." (Ex. 21 at 14.) *See, e.g.*, TBMP § 414(19) (knowledge of plaintiff's use of plaintiff's own mark discoverable). However, Applicant provided no further response.

h. Request 46

46. All documents relied on or referred to in connection with your denial of paragraph 10 of the Complaint.

Paragraph 10 of Opposer's Notice of Opposition stated "Upon information and belief, Wen Jong Wu is the owner or is otherwise a principal of Applicant." Applicant objected to this request as burdensome and overbroad, and as seeking confidential and privileged documents, and did not agree to produce responsive documents (Ex. 5 at 18), even after Opposer's deficiency letter (Ex. 21 at 14). Opposer sees no basis for Applicant's objection to this request – subject to a protective order if necessary – other than Applicant's need to deny that it applied to register the mark at issue in this opposition in bad faith.

i. Request 47-49

47. All documents that support or contravene your denial of paragraph 10 of the Complaint.

48. All documents relied on or referred to in connection with your denial of paragraph 14 of the Complaint.

49. All documents that support or contravene your denial of paragraph 14 of the Complaint.

Applicant objected to the form of these Requests as referring to a "Complaint" (rather than a Notice of Opposition), and to Request 47 and 49 as seeking "all" such documents when it had not yet completed discovery. In response to Request 48, Applicant also stated that no responsive documents "are known." (Ex. 5 at 18.) While Opposer observed in its January 18 deficiency letter that "each of these Requests referred to the Notice of Opposition, which, along with Petitions to Cancel, sometimes are referred to as 'Complaints,'" *e.g.*, TBMP § 309.02-03 (Ex. 21 at 14-15), Applicant still has not yet supplemented its response.

Given the still-unremedied deficiencies noted above, Applicant should be required to respond properly and fully to and produce documents responsive to each of these requests within fourteen days, or be precluded from introducing any evidence responsive to the requests that it does not produce forthwith.

B. THE BOARD SHOULD COMPEL APPLICANT TO RESPOND PROPERLY TO OPPOSER'S REQUESTS FOR ADMISSION OR DEEM THE REQUESTS ADMITTED

Fed. R. Civ. P. 36(a) requires that an answer to a request for admission shall "specifically deny the matter or set forth in detail the reasons why the answering party cannot truthfully admit or deny the matter." "A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder." *Id.* "If objection is made, the reasons therefor shall be stated." *Id.*

"The party who has requested the admissions may move to determine the sufficiency of the answers or objections. Unless the court determines that an objection is justified, it shall order that an answer be served. If the court determines that an answer does not comply with the

requirements of the rule, it may order either that the matter is admitted or that an amended answer be served." *Id.*; *see also* 37 C.F.R. § 2.120(h) (requests for admission shall be governed by Fed. R. Civ. P. 36); TMBP § 524.

Here, Applicant has not properly answered many of Opposer's requests for admission as required by Fed. R. Civ. P. 36(a). (*See* Ex. 4.) Moreover, while Opposer sent a detailed letter to Applicant explaining its deficiencies request-by-request (Ex. 21 at 2-9), Applicant did not respond to this letter. Accordingly, the Board should either order Applicant to serve proper amended answers to these requests for admission within fourteen (14) days of its Order, or simply deem the requests admitted. Fed. R. Civ. P. 36(a); 37 C.F.R. § 2.120(h); TMBP § 524.

a. Requests 1-3

1. Admit that Tiffany and Company is a famous retailer of jewelry.
2. Admit that Tiffany and Company is a famous retailer of bridal and engagement gifts.
3. Admit that Tiffany and Company is a famous retailer of engagement rings.

In response to each of these Requests, Applicant stated: "Subject to applicant's response to Opposer's Request for Admission 4, Applicant denies this request." (Ex. 4 at 7.) However, as Opposer noted in its deficiency letter, this qualification does not clearly articulate the objections or qualifications Applicant intended to assert. (Ex. 21 at 2-3.) When asked to "clarify whether your client admits or denies these requests, and if [Applicant has] any legitimate, good-faith qualifications please include them in your responses" (*id.*), Applicant made no reply.

b. Requests 4-6

4. Admit that Opposer's TIFFANY mark is famous for jewelry.
5. Admit that Opposer's TIFFANY mark is famous for bridal and engagement gifts.
6. Admit that Opposer's TIFFANY mark is famous for engagement rings.

In response to Request 4, Applicant objected to the form, objected to the request as "vague and ambiguous" to the extent it used the term "famous," and objected to the request as "incapable of admission" because it "fails to identify a singular mark or registration as the target of the request." However, Applicant said that if Opposer were to identify a "singular mark" rather than "an entire trademark portfolio," and to confirm whether "fame" was meant to refer to "current trademark law standards pertaining to famous marks," Applicant "would be happy to respond to such a request." In response to Request 5 and 6, Applicant simply said "[s]ee Applicant's response to Opposer's Request for Admission 4." (Ex. 4 at 7-8.)

In its deficiency letter, Opposer noted that these responses were inappropriate. While Applicant objected to "form," it failed to detail what about the form was objectionable. While Applicant objected to the use of the word "famous" as "vague and ambiguous," Opposer noted that the words "fame" and "famous" have well-established meanings in both the Lanham Act and trademark case law (for example, in the context of the strength and acquired distinctiveness of a mark, and whether a mark qualifies for protection against dilution). *E.g.*, 15 U.S.C. § 1125(c). (Ex. 21 at 3.) Finally, while Applicant claimed that the Request is "incapable of admission" because it fails to identify a single mark or registration, Opposer noted that "the Request is clear as phrased: the single mark is Opposer's mark TIFFANY." (*Id.*) Nevertheless, Applicant did not supplement its response.

c. Request 9

9. Admit that the individual Wen Jong Wu is associated with Applicant.

Applicant objected to this Request as using the vague and undefined term "'associated with' when speaking of an individual and a corporation." (Ex. 4 at 8.) While Opposer believed that the meaning of this phrase was self-evident, to clarify it asked that Applicant replace the

phrase "associated with" with the phrase "an owner, shareholder, officer, director, employee, or agent of." (Ex. 21 at 3-4.) However, Applicant still has not responded to this Request.

d. Requests 13-15, 19, 37, 39, 40

13. Admit that Applicant applied for Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design before filing the application at issue in this Opposition, Application Serial No. 78/700,677 (the "Application").

14. Admit that an entity associated or affiliated with Applicant applied for Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design before filing the Application.

15. Admit that Exhibit A hereto, the specimen for Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design, depicted the term TIFFANY DESIGNS in the same font and with one of the same flower designs as the specimen Applicant provided for the Application, a copy of which is attached hereto as Exhibit B.

19. Admit that Applicant swore in the Application that "to the best of [its] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

37. Admit that Applicant does not claim exclusive rights to the word "Designs" as used in Applicant's Mark.

39. Admit that the goods and services identified in your application for Applicant's Mark could include wedding dresses.

40. Admit that the goods and services identified in your application for Applicant's Mark could include formal wear worn at weddings.

Applicant essentially dodged each of these Requests, claiming that the documents at issue – the Application and a prior application by Wen Jung Wu – "speak for themselves." (Ex. 4 at 8-10, 12-13.) Opposer responded that the answer to a request for admission should not refer to other documents, but should simply admit or deny the request or "state in detail the reasons why the responding party cannot truthfully admit or deny the matter." (Ex. 21 at 4-5, 7.) TBMP § 407.03(b); *see also* Fed. R. Civ. P. 36. However, Applicant provided no further response.

e. Requests 17-18

17. Admit that Applicant was aware of the U.S. Patent & Trademark Office's rejection of Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design before filing the Application.

18. Admit that Applicant was aware of the U.S. Patent & Trademark Office's basis for the rejection of Application Serial No. 76/541,932 for TIFFANY DESIGNS and Design before filing the Application.

In response to these Requests Applicant objected to form, including use of the term "rejection," said that the application was not rejected but "abandoned," and did not properly respond. (Ex. 4 at 9.) While Opposer clarified in its letter that for purposes of these requests the application was "rejected" in a February 28, 2004 Office Action when the PTO refused registration of the applied-for mark (Ex. 21 at 5), Applicant did not supplement its answer.

f. Requests 21-22

21. Admit that Applicant acquired rights in Applicant's Mark from a third party.

22. Admit that Applicant acquired rights in Applicant's Mark from Wen Jong Wu.

In response to these requests Applicant stated that it was reviewing information in an effort to respond to this request" but was "presently without knowledge sufficient to enable Applicant to admit or deny this request." (Ex. 4 at 10.) While these responses were extremely suspect, Opposer asked in its deficiency letter that, once Applicant "had sufficient time to investigate the issue," it either "admit or deny both of these Requests." (Ex. 21 at 5-6.) It did not do so, and still has not done so to date.

g. Request 23

23. Admit that Applicant did not itself use Applicant's Mark as early as 1995.

In response to this request Applicant objected to form (without specifying the problem with the form of the request), and stated that "the request is further capable of several opposing

interpretations and is therefore further objectionable." (Ex. 4 at 10.) In its deficiency letter Opposer clarified that the Request "simply asked your client to admit or deny that the Applicant in this action, the corporate entity United Wu Enterprises, Inc. did not use Applicant's Mark in 1995, or at any time earlier than 1995." (Ex. 21 at 6.) Applicant did not respond.

h. Requests 31-32

31. Admit that Applicant is not named "Tiffany."

32. Admit that no owner of Applicant is known by the name "Tiffany."

In response to these Requests Applicant objected to form, objected to "the use of the term 'named,'" admitted that Applicant's "corporate name is correctly set forth in the caption of this proceeding," but then "denie[d] the remainder of [each] request." (Ex. 4 at 11.) In its deficiency letter Opposer responded that:

> First, you do not give any reason for your client's objections to form and the use of the term "named." Second, after admitting that your client's corporate name is United Wu Enterprises, Inc., you deny "the remainder of" each Request, although it is not clear what, if anything, you are denying. Third, your response to Request 32, which asked your client to admit that none of its owners are known by the name Tiffany, is nonsensical. Accordingly, please give proper answers to each of these requests.

(Ex. 21 at 6.) Applicant provided no response.

i. Request 33

33. Admit that Applicant's Mark incorporates in its entirety without any difference in spelling Opposer's mark TIFFANY.

In response to this Request Applicant objected to form, asserted that the request was not a complete sentence and "does not make sense," and raised a general objection to the definition of "Opposer's Mark." (Ex. 4 at 12.) Opposer responded that Applicant did not specify its objection to form, and that Applicant's objection based on the definition of "Opposer's Mark" was misplaced, since the request asked about "Opposer's [word] mark TIFFANY," rather than the

defined term "Opposer's Mark." (Ex. 21 at 6-7.) However, even after this clarification, Applicant did not supplement its response.

j. Requests 44-45

44. Admit that your stores sell jewelry.

45. Admit that your stores could sell jewelry in the future.

In response to these Requests Applicant objected to form, and requested "that Opposer identify which 'stores' it is referencing." (Ex. 4 at 13-14.) Opposer explained that these were "retailers that sell your client's products, as set forth at, *e.g.*, the Internet address <tiffanydesigns.com/locatornew.asp>." (Ex. 21 at 7-8.) Applicant still has not supplemented its responses.

k. Request 46

46. Admit that the website at tiffanydesigns.com depicts models wearing both the goods set forth in your Application and jewelry.

In response to this Request Applicant objected to form and to the lack of a time frame, then claimed that because its website at issue changes from time to time, it could not answer the request without being provided with photographs from the tiffanydesigns.com website to use for reference. (Ex. 4 at 14.) In its deficiency letter, Opposer responded that if Applicant's website "depicts or has depicted images of models wearing both the goods set forth in your Application and jewelry Applicant," it should "admit this fact," and if "Applicant feel a need to qualify [its] response as to time, do so as appropriate." (Ex. 21 at 8.) Again, Applicant did not respond.

l. Request 47

47. Admit that your marketing materials show people in dresses and gowns wearing jewelry.

In response to this Request Applicant admitted that "probably" there are "people in dresses and gowns," "some of whom wear jewelry and some of whom do not" in its marketing

materials, but asked to be directed to the marketing materials in question "before answering this request further." (Ex. 4 at 14.) Opposer noted that this response was "disingenuous and non-responsive," and again asked that Applicant "[e]ither admit or deny that whatever marketing materials your client may have show people in dresses and gowns wearing jewelry." (Ex. 21 at 8.) Again, Applicant provided no response, and did not supplement its answer.

m. Request 48

48. Admit that Applicant sell goods intended for weddings in connection with Applicant's Mark.

In response to this Request Applicant stated that it "does not consider that it sells goods with reference to an 'intention' and therefore objects to the form of this request." (Ex. 4 at 14.) It then admitted that its goods "may be purchased by consumers who intend to wear the goods to many different kinds of occasions, including to a wedding." Opposer noted that this response was "disingenuous and non-responsive, especially since the concept of goods 'intended' for a particular use is not unique or unusual, and especially since there appear to be several "Flower Girls" lines of clothing on [Applicant's] website." (Ex. 21 at 8-9.) Applicant again made no reply.

n. Request 49

49. Admit that Applicant's and Opposer's respective goods are sold through retail stores.

Here Applicant objected to form on the basis that "Opposer has not identified what it means by 'Opposer's respective goods," but admitted that Applicant's goods "may be" sold in retail stores. (Ex. 4 at 14-15.) Opposer explained that "when we asked about 'Applicant's and Opposer's respective goods' we were referring to (i) Applicant's goods, on the one hand, and (ii) Opposer's goods, on the other hand," and asked that Applicant "admit or deny that both parties'

goods *are* sold in retail stores – not that they 'may be' sold in such stores." (Ex. 21 at 9.) Applicant did not respond.

o. Request 51

51. Admit that Applicant has no evidence that its consumers do not overlap with consumers of Opposer's products sold in connection with the TIFFANY mark.

In response to this Request Applicant objected on the basis of form, but offered no more detailed objection. (Ex. 4 at 15.) After Opposer explained in its deficiency letter that this request "deals with whether Applicant have evidence that the parties' customers for the goods they sell in connection with the TIFFANY mark overlap" (Ex. 21 at 9), and despite the relevance of this request, Applicant still did not supplement its response.

p. Request 52

52. Admit that Applicant are aware of companies that sell both clothing and jewelry under the same mark.

In response, rather than admitting or denying the request, Applicant stated that "Applicant cannot at the moment bring to mind an example," but that "if Applicant continued to consider the request or conduct research into the matter, [it] may well be able to either recall or locate examples." (Ex. 4 at 15.) In its letter, Opposer noted that "[s]ince this was a written request that your client had more than a month to answer, we do not understand the comment that it 'cannot at the moment bring to mind an example'" and asked that "[n]ow that [Applicant] has had ample time to consider the matter, however, and given your client's obligation to investigate, please either admit or deny the request." (Ex. 21 at 9.) Applicant did not do so.

Given the deficient responses above, the Board should either order Applicant to serve proper amended answers to these requests for admission within fourteen (14) days of its Order, or simply deem the requests admitted. Fed. R. Civ. P. 36(a); 37 C.F.R. § 2.120(h); TMBP § 524.

C. THE BOARD ALSO SHOULD SUSPEND THIS CASE WITH RESPECT TO ALL MATTERS NOT GERMANE TO THIS MOTION

Opposer also requests that, as required by 37 C.F.R. §§ 2.120(e)(2) and (h)(2), the Board suspend this case with respect to all matters not germane to this motion during the pendency of the motion.

V. CONCLUSION

Given the information and argument above, Opposer respectfully requests that its motion be granted in its entirety.

Dated: New York, NY
April 18, 2007

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of April, 2007, a true and correct copy of the foregoing Opposer's Motion to Compel and Determine Sufficiency and Memorandum in Support Thereof was served by first class mail on counsel for Applicant:

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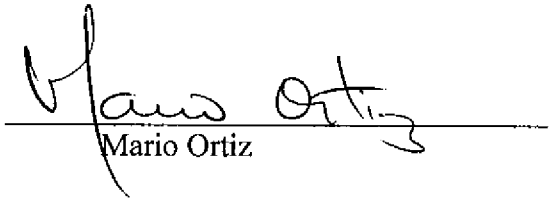

Mario Ortiz