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

Proceeding	91162370
Party	Plaintiff De Boulle Diamond & Jewelry, Inc. De Boulle Diamond & Jewelry, Inc. De Boulle Diamond & Jewelry, Inc. 6821 Preston Road Dallax, TX 75205 UNITED STATES
Correspondence Address	David A. Harlow Nelson Mullins Riley & Scarborough LLP 4140 Parklake Avenue GlenLake One, Suite 200 Raleigh, NC 27612 UNITED STATES david.harlow@nelsonmullins.com
Submission	Other Motions/Papers
Filer's Name	Scott T. Griggs
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Signature	/Scott Griggs/
Date	02/01/2007
Attachments	Opposer's Response to Applicant's Motion for Discovery Sanctions & Exhibits D-E.pdf (13 pages)(2079426 bytes)

Exhibit D

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

DEBOULLE DIAMOND & JEWELRY, INC.,	§	
Opposer,	§	Consolidated Opposition No. 91165285
v.	§	
DE BEERS LV LTD.,	§	
Applicant.	§	

OPPOSER'S OBJECTIONS AND ANSWERS TO APPLICANT'S FIRST REQUEST FOR ADMISSIONS

TO: Applicant, De Beers LV Ltd., by and through its attorneys: Mark I. Peroff, Esq., Darren W. Saunders, Esq., and Melanie Bradley, Esq., Kirkpatrick & Lockhart Nicholson Graham, LLP, 599 Lexington Avenue, New York, NY 10022-6030

Opposer, De Boulle Diamond & Jewelry, Inc. ("Opposer" and/or "De Boulle"), hereby submits its Objections and Answers to Applicant, De Beers LV Ltd.'s ("Applicant" and/or "De Beers") First Requests for Admissions pursuant to Rules 26, and 36 of the Federal Rules of Civil Procedure, 37 CFR §§2.116 and 2.120, and Trademark Trial and Appeal Board Manual of Procedure, Chapter 400 (collectively the "TBMP").

This the 30 day of December, 2005.

Respectfully submitted,

Pieter J. Tredoux
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- and -

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CO-COUNSEL FOR OPPOSER

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record via hand delivery, on this the 20 day of December, 2005, and addressed as follows:

Mark I. Peroff, Esq.
Darren W. Saunders, Esq.
Melanie Bradley, Esq.
Kirkpatrick & Lockhart Nicholson Graham, LLP
599 Lexington Avenue
New York, NY 10022-6030

Pieter J. Tredoux

I.

RECURRING OBJECTIONS

1. The objections set forth in paragraphs 2 through 6 below apply to and are incorporated into Opposer's response to each Request as if set forth at length, unless the context specifically states otherwise.

2. Applicant has set forth in its Requests extremely broad Definitions of various terms purportedly to aid Opposer's responses to the Requests. Such Definitions, however, have unduly complicated Opposer's ability to provide a response to the Requests, inasmuch as the Definitions render the Requests ambiguous, overly broad, unduly burdensome, and repetitive. The Definitions cause each of the Requests to which they apply to seek information which is not relevant, material, or reasonably calculated to lead to the discovery of admissible evidence; in that each such Request seeks information which is not even remotely connected to the facts and circumstances of this Proceeding. The Definitions thus cause the scope of Applicant's Requests to be expanded to such an extent that they exceed the scope of discovery permitted under the TBMP; in that the relevant provisions of the TBMP provide all instructions and definitions recognized with respect to responding to discovery requests.

3. Opposer objects to the definition of "Opposer and "Applicant", contained in Definitions A and B, in that such definitions, require Opposer to make a determination whether a person or entity qualifies or acted within one of many enumerated capacities, and/or bears an enumerated relationship to or affiliation with another person or entity, which renders the Definitions and each Request to which they apply, unduly burdensome, vague, ambiguous, oppressive and harassing.

4. Opposer objects to the definitions of the terms "and" as well as "or" contained in Definition F, in that the Definition by its own wording, attempts to require Opposer to respond to Requests which are "otherwise outside [the] scope" of permissible discovery, and/or the matters inquired about in a particular Request, which renders the Definition, and the Requests to which it they applies, overly broad, unduly burdensome, vague, ambiguous, oppressive and harassing.

5. Opposer objects to the definition of "commerce", contained in Definition G, in that such definition is vague and ambiguous, and requires Opposer to make a legal determination and solve a plethora complex constitutional, regulatory and other legal arguments, as to whether Congress is entitled to regulate a particular activity, which renders the Definition and each Request to which it applies unduly burdensome, vague, ambiguous, oppressive and harassing.

6. Opposer objects to the Definition of "concerning", "relating to" and "pertaining to" contained in Definition H, in that such Definition, and the Requests to which it applies, are overly broad, unduly burdensome, vague, ambiguous, oppressive and harassing. Opposer further objects to the Definition in that each Request in which it is contained, as worded, seeks material which is exempt or immune from discovery, including, but not limited to, the notes and correspondence of counsel, the work-product of Opposer, its attorneys and representatives, and are therefore protected from discovery under the attorney/client, attorney work-product, party communication, and other applicable privilege, exemption or immunity.

II.

OBJECTIONS AND ANSWERS
TO REQUEST FOR ADMISSIONS

1. Opposer operates a single-location retail jewelry establishment in Dallas, Texas.

ANSWER:

Admit

2. Opposer operates a web site at the web address under the domain name www.deboulle.com.

ANSWER:

Admit

3. Customers cannot purchase jewelry from Opposer via Opposer's website.

ANSWER:

Deny

4. The name DE BOULLE is derived from the name of Opposer's company founder Dennis Boulle.

ANSWER:

Admitted to the extent that Opposer's corporate name is an arbitrary and fanciful device derived from components of Mr. Boulle's name. Otherwise the Request is denied.

5. Opposer's "DE B and Design" and "DB" marks are derived form the name "DE BOULLE."

ANSWER:

Admit

6. Opposer uses a stylized form of the mark DE BOULLE as follows:

de Boulle

ANSWER:

Admitted to the extent that Opposer uses a stylized form of the mark DE BOULLE displaying the two components of the mark, "De" and "Boulle", in different cases, to equally but separately the respective components by their individual varied stylized form. To the extent that the request seeks to imply that the inserted image is a true, accurate, and correct rendition of Opposer's mark in all respects, the request is denied.

7. The domination portion of the stylized mark in Request for Admission No. 7 is "Boulle"

ANSWER:

Opposer objects to this Request, in that it cannot determine which mark is referred to in the Request. To the extent that the request refers to the mark referenced in Request for Admission No. 6, the request is denied.

8. Other jewelry retailers in the United States use the initials "D" and "B" for their business.

ANSWER:

Opposer objects to this Request, in that it is vague, ambiguous, and overly broad, and assumes facts not in evidence, in that it seeks an admission (i) that multiple "other [unspecified] jewelry retailers in the United States use the initials "D" and "B" for their business", and (ii) that such other multiple [unspecified] jewelry retailers in the United States have rights to the mark "D" and "B" that are senior to Opposer, which Opposer cannot truthfully admit or deny without further specificity.

9. Opposer was aware of the trade name De Beers before it commenced use of any of Opposer's marks.

ANSWER:

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that the trade name DeBeers was used in trade and commerce in the United States, prior to launching Applicant's first store in New York. The request as worded is therefore denied.

10. Opposer was aware of Applicant and Applicant's marks before it filed trademark applications for Opposer's mark.

ANSWER:

Admit

11. Opposer sells third-party branded jewelry, timepieces and accessories including the brands "BULGARI," "FRED LEIGHTON," "BAUME et MERCIER," and "PATEK PHILLIPE".

ANSWER:

Admit

12. Opposer does not distribute "DEBOULLE" "DE B and Design" or "DB" branded goods to third party retailers.

ANSWER:

Admit

13. Opposer does not distribute "DEBOULLE" "DE B and Design" and/or DB" branded goods via third party web sites.

ANSWER:

Admit

14. The products sold by Applicant and Opposer are high-end luxury goods.

ANSWER:

Admit.

15. Consumers of high end "luxury" goods tend to be sophisticated.

ANSWER:

Opposer objects to this Request, in that it is overly broad, ambiguous, and misleading, in that it seeks to imply that the purchasing decisions of consumers are identical for all luxury goods, and fails to distinguish that consumers of diamonds and fine jewelry have far less product knowledge and information than when buying other luxury goods, and are therefore not necessarily sophisticated when making purchasing decisions. The Request as worded is therefore denied.

16. Consumers generally exercise great care in purchasing diamonds.

ANSWER:

Admitted to the extent that consumers generally exercise great care to ensure that they know and trust the merchant from which the diamonds are bought, as consumers of diamonds generally have very little product knowledge and information. Otherwise the Request is denied.

17. "De Beers" is a world-famous trade name and trademark.

ANSWER:

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that the trade name DeBeers was used in trade and commerce in the United States, prior to launching Applicant's first store in New York, and that the DeBeers brand has been distinguished world wide only for its mining and wholesale trade of diamonds, and not for the notoriety associated with its monopolistic business practices, violation of American law, involvement in the trade in blood diamonds, and its long-time association with the South African Apartheid regime. The request as worded is therefore denied.

18. The "De Beers" name is well-known in the United States.

ANSWER:

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that the trade name DeBeers was used in trade and commerce in the United States, prior to launching Applicant's first store in New York, and that the DeBeers brand has been distinguished world wide only for its mining and wholesale trade of diamonds, and not for the notoriety associated with its monopolistic business practices, violation of American law, involvement in the trade in blood diamonds, and its long-time association with the South African Apartheid regime. The request as worded is therefore denied.

19. De Beers has conducted advertising and promotional campaigns in the United States.

ANSWER:

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that DeBeers conducted advertising and promotional campaigns in the United States, prior to launching Applicant's first store in New York. Upon information and belief De Beers was prevented from doing business, in the United States by its extensive legal problems until 2004, and that all activities including adverting was conducted not by De Beers but through third parties such as the Diamond Promotion Service, and Ogilvy & Mather. The request as worded is therefore denied.

20. Consumers in the United States associate the name "De Beers" with diamonds.

ANSWER:

Opposer objects to this request in that it is vague, ambiguous, overly broad, and misleading, in that, as worded, it implies that the trade name DeBeers was used in trade and commerce in the United States, prior to launching Applicant's first store in New York, and that the DeBeers brand has been distinguished world wide only for its mining and wholesale trade of diamonds, and not for the notoriety associated with its monopolistic business practices, violation of American law, involvement in the trade in blood diamonds, and its long-time association with the South African Apartheid regime. The request as worded is therefore denied.

21. Each of Applicant's marks contains an additional element other than the initials "D" and "B".

ANSWER:

Deny

22. Opposer is not aware of any instances of actual confusion between products sold under Opposer's marks and Applicant's marks.

ANSWER:

Admit

Exhibit E

Pieter Tredoux

From: "Bradley, Melanie" <mbradley@klng.com>
To: <pjt@hush.com>
Cc: "Saunders, Darren W." <dsaunders@klng.com>
Sent: Tuesday, May 09, 2006 4:19 PM
Subject: DeBoulle v. DeBeers

Dear Pieter:

We have not received from you a draft protective order in the above-identified matter. We do need to have this order filed with the Trademark Trial and Appeal Board before we are able to provide you with access to DeBeers' confidential materials. It is unlikely that we will be able to negotiate, execute and file the protective order by tomorrow, May 10, which was the date we had agreed to effect the exchange of documents. Therefore, please give me a call so that we can coordinate the filing of this order and reset a time for the exchange of documents.

Sincerely,
Melanie Bradley, Esq.
Kirkpatrick & Lockhart Nicholson Graham
599 Lexington Avenue
New York, N.Y. 10022
212-536-4071 (phone)
212-536-3901 (fax)
mbradley@klng.com

No virus found in this incoming message.
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