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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
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Submission	Motion to Reopen
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Date	02/09/2007
Attachments	Opposer's Motion to Reopen Discovery and Testimony Period.pdf (14 pages)(2685260 bytes)

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

DE BOULLE DIAMOND & JEWELRY, INC.,	
Opposer,	Consolidated Opposition No.: 91162370
v.	Opposition No.'s: 91162370 91162469 91164615 91165285 91165465
DE BEERS LV LTD.,	
Applicant.	

OPPOSER'S MOTION TO REOPEN
DISCOVERY AND TESTIMONY PERIOD

Opposer, De Boulle Diamond & Jewelry, Inc. ("Opposer" and/or "De Boulle"), hereby files this Motion to Reopen Discovery and Testimony Period (the "Motion"), and in support of same will respectfully show:

I.

Procedural History and Relevant Facts

1. Applicant, De Beers LV Ltd. ("Applicant" and/or "De Beers"), filed Applications for federal registration of the marks in issue in this Proceeding on the following dates: (i) DB LOGO (Serial No. 78/245,219), applied May 2, 2003; (ii) DB STAR (Serial No. 78/245,795), applied May 5, 2003; (iii) DB SIGNATURE (Serial No. 78/245,210), applied May 2, 2003; (iv) DB MONOGRAM (Serial No. 78/245,779),

applied November 15, 2002; and (v) SO DB Mark (Serial No. 79/000,478) applied November 25, 2003 (hereinafter collectively referred to as the "De Beers Marks").

2. De Boulle timely filed separate oppositions against federal registration of the De Beers Marks; namely, Opposition No. 91162370 (DB LOGO), Opposition No. 91162469 (DB MONOGRAM), Opposition No. 91164615 (DB SIGNATURE), Opposition No. 91165285 (DB STAR), and Opposition No. 91165465 (SO DB).

3. On May 2, 2005, by Order entered on that date, the Board consolidated Opposition Nos. 91162370, 91162469, and 91164615, under Opposition No. 91162370. On July 20, 2005, the Board further consolidated Opposition No.'s 91165285, and 91165465 with the earlier Consolidated Opposition No. 91162370, as Consolidated Opposition No. 91162370 (the "Proceeding").

4. On or about July 27, 2005, De Boulle served it First Set of Requests for Production of Documents and Things, First Set of Interrogatories, and First Requests for Admissions on De Beers in this Proceeding (the "De Boulle Discovery").

5. On or about October 3, 2005, De Beers served its answers and objections to the De Boulle Discovery in this Proceeding, a true and correct copy of which is attached to the De Boulle Motion to Compel as Exhibits "A", "B", and "C". The material and substantial deficiencies in the responses made by De Beers to the De Boulle Discovery is more particularly described in De Boulle's Motion to Compel Responses to Discovery filed in this Proceeding, which will be filed on the next business day, (the "De Boulle Motion to Compel"). All of the arguments, authorities, facts, exhibits, and other evidence

contained in the De Boulle Motion to Compel, are hereby incorporated herein by reference as if set forth at length for all purposes.

6. On or about November 18, 2005, De Beers served its First Set of Requests for Production of Documents and Things, First Set of Interrogatories, and First Requests for Admissions on De Boulle in this Proceeding (the "De Beers Discovery").

7. On December 31, 2005, De Boulle served responses to the De Beers Discovery, true and correct copies of which are attached to De Boulle's Response to Applicant's Motion for Discovery Sanctions filed in this Proceeding (the "Response to Motion for Discovery Sanctions"), as Exhibits "B", "C" and "D". All of the arguments, authorities, facts, exhibits, and other evidence contained in the Response to Motion for Discovery Sanctions, are hereby incorporated herein by reference as if set forth at length for all purposes.

8. Pursuant to the initial Scheduling Order in this Proceeding, the Discovery Deadline was set Expire on December 25, 2005. On December 27, 2005, De Beers filed a Motion to Extend Discovery and Testimony Periods (the "De Beers Extension Request").

9. On March 2, 2006, by Stipulation Regarding Motion to Extend Discovery and Testimony Periods, Opposer fully cooperated with De Beers and consented to the extensions requested by the De Beers Extension Request. Accordingly, on April 11, 2006, the Board entered a revised Scheduling Order in this Proceeding.

10. Subsequently, De Boulle and De Beers entered into discussions to reach an agreement regarding their respective responses to the opposing party's discovery, and the

De Beers Extension Request. In this regard, by May 9, 2006, De Boulle and De Beers both agreed that they would (a) supplement their initial responses to discovery; and (b) enter into an Agreed Protective Order to protect their respective trade secrets and other confidential and privileged information. Accordingly, on or about May 11, 2006, De Boulle supplemented its responses to Applicant's First Set of Interrogatories, a true and correct copy of which is attached to the Response to Motion for Discovery Sanctions, as Exhibit "F", and tendered the production of documents responsive to De Beers' Requests for Production upon the entry of a mutually acceptable Protective Order. As more particularly described in the De Boulle Motion to Compel, De Beers, however, failed and refused to supplement its responses to the De Boulle Discovery in any respect, and produced only the nineteen (19) pages of documents attached to the De Boulle Motion to Compel as Exhibit "M".

11. On May 31, 2006, De Beers summarily filed a Motion to Compel Discovery in this Proceeding (the "De Beers Motion to Compel"). On June 6, 2006, the Board suspended all proceedings pending the outcome of its ruling on the De Beers Motion to Compel Discovery. By Order dated July 26, 2006 the Board Granted the Motion, and further revised the Scheduling Order in this Proceeding (the "Discovery Order").

12. As more particularly described in the Response to Motion for Discovery Sanctions, De Boulle did not receive a copy of the Discovery Order, and had no notice of the Board's ruling until it received a copy of Applicant's Motion for Discovery Sanctions filed in this Proceeding from its previous lead counsel, David A. Harlow, of the firm of

Nelson Mullins Riley & Scarborough, L.L.P. *See* Affidavit of Denis J. Boulle, attached to the Response to Motion for Discovery Sanctions, as Exhibit "G" Prior to that time, De Boulle understood that all proceedings in this matter were still suspended, pending the outcome of the Board's ruling on the Motion to Compel Discovery, according to the Board's June 6, 2006, Order.

13. De Boulle immediately engaged the firm of Griggs Bergen LLP, to substitute as lead counsel for Mr. Harlow and his firm. *Id.* Griggs Bergen LLP, as part of De Boulle's continuing efforts to remedy the oversight by its prior counsel, has already produced over 1,300 pages of documents responsive to the De Beers Discovery[1], and attempted to enter into a dialog with counsel for De Beers, to determine to what extent, if any, its remaining responses to the De Beers Discovery can reasonably deemed to be insufficient. As more particularly described in the Certificate of Conference below, counsel for De Beers, however, completely rebuffed his efforts and has refused to cooperate with Griggs Bergen LLP in its good faith attempts to resolve the outstanding discovery disputes between the parties in this Proceeding.

14. Indeed, from the date of the filing of the De Beers Motion to Compel, until filing Applicant's Motion for Discovery Sanctions, counsel for De Beers has made no attempt whatsoever, for a period of more than seven (7) months, to contact or communicate with counsel for De Boulle in this Proceeding; whether to inquire about the possible reason for the oversight in not immediately responding to the Discovery Order, or otherwise.

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[1] The categories of documents produced to date are cataloged on Appendix I attached.

Counsel for De Beers completely failed to confer with counsel for De Boulle prior to filing Applicant's Motion for Discovery Sanctions, on or about January 9, 2007.

15. It appears that De Beers and its counsel has been waiting in the shadows, perceiving some type of tactical advantage to be gained, by allowing the time for Applicant's testimony period to expire, before filing its Motion for Discovery Sanctions, thereby attempting to obtain by such Motion relief from the Board that it could not otherwise obtain though a trail on the merits in this Proceeding.

II.

De Boulle's Oversight Was Not Intentional, But Rather
the Result of Excusable Neglect, and De Beers Will Not Be
Prejudiced By Reopening Discovery and the Testimony Period

16. De Boulle respectfully requests that the Board reopen discovery in this proceeding for a period of ninety (90) days, for the limited purpose of allowing it to more fully comply with the Discovery Order, to the extent its previous responses are deemed insufficient, and to resolve the outstanding discovery disputes between the parties in this Proceeding, presented by the De Boulle Motion to Compel.

17. De Boulle will respectfully show the Board that its failure to complete discovery and obtain testimony within the time previously set out was due to excusable neglect, and that the requested extension will not prejudice De Beers.

18. The provisions of the Federal Rules of Civil Procedure are applicable to *inter partes* proceedings before the Board. *See* 37 CFR § 2.1116(a). Rule 6(b)(2) provides for the enlargement of time of a specified period, "where the failure to act was the result of

excusable neglect". Excusable neglect "is a somewhat 'elastic concept' and is not limited strictly to omissions caused by circumstances beyond the control of the movant." In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al.*, 507 U.S. 380, 392 (1993) (discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997) the determination as to whether a party's neglect is excusable is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include . . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

19. The Board defines excusable neglect as:

> [a] failure to take the proper steps at the proper time, not in consequence of the party's own carelessness, inattention, or willful disregard of the process of the court, but in consequence of some unexpected or unavoidable hindrance or accident, **or reliance on the care and vigilance of his counsel** or on promises made by the adverse party.

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 1552-53 (Fed.Cir. 1991) (citations omitted) (emphasis provided)

20. In this regard De Boulle would respectfully show the Board that any failure to complete discovery and obtain testimony within the time previously set out, was not through manifest neglect or intentional disregard of the Board's Order, but the result of its reliance on the care and vigilance of prior lead counsel. There is no evidence that De Boulle's delay was willful or the result of bad faith.

21. The "prejudice to the nonmovant" contemplated under the first Pioneer factor must be more than the mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. *See Pumpkin Ltd.* 43 USPQ2d at 1587 (citations omitted)

22. In this regard, De Boulle would respectfully show the Board that De Beers will not be prejudiced by the requested extension:

(a) Counsel for De Beers did not communicate with De Boulle's counsel at all during the more than five (5) months that have transpired since the entry of the Discovery Order, to ascertain Opposer's intent to comply with the Discovery Order; had they done so, De Boulle would have discovered its mistake in assuming that this Proceeding was still suspended, and the parties would have resolved the outstanding discovery disputes pertaining to the Discovery Order.

(b) De Beers has made no showing of lost evidence or unavailable witnesses, as a result of any delay by De Boulle, if any, in complying with the Discovery Order, and the same would be true in the event the Board were to grant De Boulle's request to reopen discovery.

(c) De Beers will bear no greater cost in defending this matter in the event the Board were to grant De Boulle's request to reopen discovery than it would have otherwise.

(d) There is no evidence of De Beers having taken any action in this Proceeding in reliance upon De Boulle's inaction since the filing of the De Beers Motion to Compel.

(e) De Boulle's responses to the De Beers Discovery in compliance with the Discovery Order, can be affected in short order, and De Beers will have adequate further opportunity to obtain answers to the De Beers Discovery by deposition or other testimony in a timely fashion to allow it to prepare its defense in this Proceeding.

23. For the reasons more particularly set forth in the De Boulle Motion to Compel, De Boulle would further respectfully show the Board that it requires full and complete responses to the De Boulle Discovery, to which it is entitled under the Rules, which have purposely been delayed by De Beers, to allow it to prepare its prosecution of this Proceeding. De Boulle needs the additional discovery period, to obtain the Board's ruling on the De Boulle Motion to Compel, and ensure the compliance by De Beers with such ruling, in time to allow it to prepare for the Applicant's testimony period.

III.

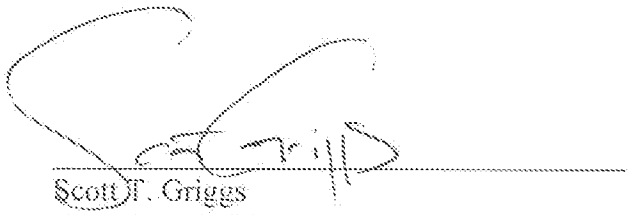
Prayer

24. Opposer, De Boulle Diamond & Jewelry, Inc., therefore respectfully prays that the Board enter an Order reopening discovery in this Proceeding for a period of ninety

(90) days, for the limited purpose of allowing it to more fully comply with the Discovery Order, to the extent its previous responses are deemed insufficient, and to resolve the outstanding discovery disputes between the parties in this Proceeding, presented by the De Boulle Motion to Compel, resetting the respective Testimony Periods of the Parties accordingly, and that the Board grant it such other and further relief, legal and equitable, general and special, to which De Boulle may show itself justly entitled.

This the 9TH 1 day of February, 2007.

Respectfully submitted,



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COUNSEL FOR OPPOSER

CERTIFICATE OF CONFERENCE

I hereby certify that on the 30th day of January, 2007, the undersigned counsel for Opposer sent an email to Vincent P. Rao, II, Esq., counsel for Applicant, and requested an opportunity to discuss this Consolidated Opposition including any outstanding discovery disputes. Mr. Rao indicated in a reply email that he would coordinate a day and time to discuss this Consolidated Opposition by no later than January 31, 2007. As of the filing of this Motion, Mr. Rao has not provided a day and time to discuss this Consolidated Opposition.

On the 1st day of February, 2007, the undersigned counsel for Opposer emailed a letter to Darren W. Saunders, Esq., also counsel for Applicant, and Mr. Rao that requested an opportunity to discuss matters of discovery and included a proposed form of a Protective Order. As of the filing of this Motion, neither Mr. Saunders nor Mr. Rao has responded to the requests in Opposer's letter dated February 1, 2007.

On the 7th day of February, 2007, the undersigned counsel for Plaintiff twice attempted to contact Vincent P. Rao, II, Esq., counsel for Applicant, to discuss the merits of this Motion. On the first call, the undersigned counsel left a voice mail for Mr. Rao and on the second call, the undersigned counsel spoke to Mr. Rao and informed Mr. Rao that Opposer intended on filing this Motion by February 9, 2007 and a Motion to Compel Responses to Discovery in due course. During the telephone conversation, the undersigned counsel attempted to confer with Mr. Rao regarding the merits of this Motion as well as any outstanding discovery disputes. Mr. Rao informed the undersigned counsel

that Mr. Rao would discuss the merits of this Motion and Applicant's position on February 8, 2007. As of the filing of this Motion, Mr. Rao has not provided Opposer with Applicant's position on this Motion.

Counsel for Applicant know of this Motion and have completely rebuffed the undersigned counsel's efforts and good faith attempts to resolve the outstanding discovery disputes between the parties in this Proceeding. Further, counsel for Applicant have refused to comment on the merits of this Motion. Accordingly, this Motion is presented to the Board for consideration.

Scott T. Griggs

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record by mailing a true copy thereof, through the United States Mail, first class, postage prepaid, on this the 7th day of February, 2007, and addressed as follows:

Darrell Saunders, Esq.
Vincent P. Rao, II, Esq.
Kirkpatrick & Lockhart Preston Gates Ellis LLP
599 Lexington Avenue
New York, NY 10022-6030

Scott T. Griggs

APPENDIX I

SUMMARY OF OPPOSER'S RESPONSES TO APPLICANT'S REQUESTS FOR PRODUCTION

Category	Bate Range
De Boulle Advertising Tear Sheets	00001-00202
De Boulle Marketing Scrap Book	00203-00288 and 00461-00463
Sample De Boulle Packaging Materials and Catalogs	00289-00460 and 692-705
De Boulle Packing Photographs	00468-00520
Copies of De Boulle Web Catalog	00680-00723
File: Federal Trademark, Registration No. 3,078,625 (Serial No. 78/444,880), Mark: "De Boulle"	00521-00594
File: Federal Trademark, Registration No. 3,078,627 (Serial No. 78/440,907), Mark: "DE B"	00595-00633
File: Application for Federal Trademark Registration, Serial No. 78/440,907, Mark: "DB"	00634-00679
Abstract of De Boulle Invoices: Interstate Sales for the period 2001 through 2006	00680-00691
Pleadings: *De Boulle Diamond & Jewelry, Inc. v. Colibri Corporation*, Case No. 3-06-CV0794-M, U.S. District Court, Northern District of Texas	05269-05330
De Beers Annual Reviews, Reports, Media Articles, Treatises on De Beers; Excerpts from the Record in *U.S. v. De Beers Centenary AG*, Case No. 2-94-019 U.S. District Court, Southern District of Ohio	05331-05878