ESTTA Tracking number: **ESTTA125977**
Filing date: **02/20/2007**

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

Proceeding	91162370
Party	Defendant De Beers LV Ltd De Beers LV Ltd 1 Silk Street GBX London, EC2Y 8HQ
Correspondence Address	VINCENT P. RAO, II KIRKPATRICK & LOCKHART PRESTON et al 599 LEXINGTON AVENUE NEW YORK, NY 10022-6030 UNITED STATES
Submission	Reply in Support of Motion
Filer's Name	Vincent P. Rao
Filer's e-mail	vincent.rao@klgates.com
Signature	/Vincent P. Rao/
Date	02/20/2007
Attachments	NY-#509099-v1-Reply.pdf (10 pages)(453058 bytes) NY-#509098-v1-Declaration.pdf (2 pages)(67353 bytes) NY-#509084-v1-Exhibit_A.pdf (1 page)(44539 bytes) NY-#509085-v1-Exhibit_B.pdf (3 pages)(172380 bytes) NY-#509086-v1-Exhibit_C.pdf (1 page)(43099 bytes) NY-#509087-v1-Exhibit_D.pdf (3 pages)(128500 bytes) NY-#509088-v1-Exhibit_E.pdf (4 pages)(158152 bytes) NY-#509089-v1-Exhibit_F.pdf (1 page)(30110 bytes) NY-#509090-v1-Exhibit_G.pdf (2 pages)(97076 bytes) NY-#509091-v1-Exhibit_H.pdf (1 page)(41900 bytes) NY-#509092-v1-Exhibit_I.pdf (2 pages)(38003 bytes) NY-#509093-v1-Exhibit_J.pdf (3 pages)(69047 bytes) NY-#509094-v1-Exhibit_K.pdf (2 pages)(46019 bytes)

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

Atty. Ref.: 0820278.0103

De Boulle Diamond & Jewelry, Inc.	
Opposer,	Consolidated Opposition No.: 91162370
	Opposition Nos. 91162370
-against-	91162469
	91164615
De Beers LV Ltd.	91165285
	91165465
Applicant.	

REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION FOR DISCOVERY SANCTIONS

Applicant, by its undersigned attorneys, hereby submits this Reply to Opposer's Response to Applicant's Motion for Discovery Sanctions (hereinafter "Motion") for an order entering judgment against Opposer and dismissing the above-identified consolidated opposition proceeding for failure to comply with the Board's Order to Compel Discovery Responses ("Order") entered on July 26, 2006.

PRELIMINARY STATEMENT

Opposer commenced the first of these consolidated opposition proceedings on September 27, 2004. These proceedings have placed a cloud over Applicant's (hereinafter "De Beers") right to register its valuable trademarks in the United States. Accordingly, De Beers took all necessary steps to advance the proceedings as swiftly as possible with the goal of reaching a decision on the merits expeditiously.

Totally frustrating De Beers' good faith efforts, Opposer refused to comply with its obligations under the T.T.A.B. Rules:

- Opposer never produced its discovery documents despite numerous promises to do so.
- Opposer refused to respond to De Beers' numerous correspondence regarding the exchange of discovery documents.
- Opposer forced De Beers to prepare and file a Motion to Compel Production of Documents.
- Opposer allowed the discovery period to close without even attempting to meet its discovery obligations.
- Opposer failed to comply with the Board's Order by not producing its discovery documents by the August 25, 2006 deadline imposed by the Board.
- Opposer allowed the reset discovery period to close without attempting to meet its discovery obligations.
- Opposer allowed the reset testimony period to close without submitting any evidence.
- Opposer forced De Beers to file a Motion for Discovery Sanctions.

Having caused prejudice to De Beers due to Opposer's inexcusable delays, only now has Opposer awakened at the last possible moment and submitted a legally deficient excuse for its failure to comply with the Board's Order—that its prior counsel supposedly was at fault. However, as explained herein, the omissions of counsel do not, as a matter of law, constitute excusable neglect. This alone, is grounds for granting De Beers' Motion and ordering the requested sanctions, namely, that these proceedings be dismissed.

However, there is an aggravating factor, which, should there be any doubt as to the propriety of the sanctions sought, justifies the dismissal of these proceedings. Opposer neglects to inform the Board of several critical facts:

- Opposer was previously represented in these proceedings by two attorneys from separate law firms, namely, David A. Harlow, Esq. from Nelson Mullins Riley & Scarborough LLP and Pieter J. Tredoux, Esq., a solo practitioner.

- Mr. Tredoux took the lead on and was the attorney with whom De Beers dealt with on all discovery matters prior to the time Opposer ceased communicating with De Beers.

- Mr. Tredoux is still appearing as counsel in these proceedings for Opposer.

Opposer's position and last minute filing is reprehensible. Moreover, Opposer was under an obligation to fully and accurately explain all relevant circumstances to the Board. Not only did Opposer not meet this basic obligation, but it is apparent that Opposer concealed the fact that Mr. Tredoux is still appearing as counsel because this would undermine its position. Clearly, one must conclude from this obvious omission that Mr. Tredoux must have received the Board's Order and relayed it or its contents to Opposer. Accordingly, under these circumstances, the sanctions sought are appropriate—judgment in De Beers' favor and dismissal of these consolidated opposition proceedings.

ARGUMENT

A. Opposer's "Excuse" for not Complying with the Board's Order, as a Matter of Law, Does Not Constitute Excusable Neglect

Opposer contends that its failure to comply with the Board's Order was "the result of negligence and a failure in communication between De Boulle and its prior lead counsel." *See* Opposer's Response (hereinafter "Response") at 18. However, as a matter of law, the alleged omissions of counsel do not constitute excusable neglect.

Indeed, the very case cited by Opposer to support its argument is contrary to its position and fully supports De Beers' position that strong sanctions are warranted. In *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582, 1586 (T.T.A.B. 1997), the Board, following the excusable neglect standard as set forth in *Pioneer Investment Services Co. v. Brunswick Assoc. Limited*

Partnership et al., 507 U.S. 380, 396 (1993), stated that "...a party must be held accountable for the acts and omission of its chosen counsel, such that, for purposes of making the 'excusable neglect' determination, it is irrelevant that the failure to take the required action was the result of the party's counsel's neglect and not the neglect of the party itself." *Pumpkin*, 43 U.S.P.Q.2d at 1586.

This, of course, makes sense, since a party's counsel is its legal representative who acts on behalf of his or her client and who binds the client in legal proceedings such as this one. Opposer's accusation of improprieties on the part of a prior counsel has absolutely no bearing on the proper determination of De Beers' Motion. Therefore, since Opposer does not set forth any other arguments that bear on this Motion, for the above reasons alone the Motion should be granted.

However, to the extent a full analysis under the *Pioneer* Four-Part Test for excusable neglect may be necessary, it is clear that Opposer's failure to comply with the Board's Order is not excusable. The determination of whether a party's neglect is excusable includes an analysis of the following four factors: (1) The danger of prejudice to the [nonmovant]; (2) the length of the delay and 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. *Pioneer,* 507 U.S. at 396.

All four factors weigh heavily in favor of De Beers. First, De Beers has been seriously prejudiced by the overall length of this proceeding, which has been prolonged by Opposer's dilatory tactics and refusal to comply with its discovery obligations. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 U.S.P.Q.2d 1848, 1852 (T.T.A.B. 2000) (judgment warranted upon a finding that an overall pattern of delay caused extreme prejudice to

a party). Conversely, De Beers has sought in good faith to meet its discovery obligations. (see Exhibits A through H). Opposer initiated the first of these opposition proceedings on September 27, 2004, causing prejudice to De Beers by restricting its right to register its valuable trademarks in the United States. Specifically, on September 27, 2004, Opposer filed oppositions against Serial No. 78/245,219, "DB LOGO" and Serial No. 78/245,779, DB MONOGRAM. On March 14, 2005, Opposer filed an opposition against Serial No. 78/245,210, DB SIGNATURE. The Board consolidated the first three aforementioned oppositions into a consolidated proceeding on May 2, 2005. Subsequently, on May 15, 2005, Opposer filed yet another opposition, which was against Serial No. 78/245,795, DB STAR. Finally, on June 2, 2005, Opposer filed an opposition against Serial No. 79/000,478, SO DB. On July 20, 2005, the Board added the last two oppositions into the consolidated proceeding that is currently before the Board.

Contrary to Opposer's baseless assertions, these opposition proceedings and the inexcusable delay caused by Opposer's neglect and refusal to comply with its discovery obligations is harming De Beers. Currently, De Beers owns and operates a retail store in New York and conducts business throughout the U.S. De Beers has a strong interest in protecting its U.S. trademarks and receiving the benefits of registration. De Beers will continue to suffer prejudice if the Board allows Opposer to now resume these proceedings.

Second, the significant length of the delay is evident. For approximately two and a half years, De Beers has been prejudiced by the inability to register its trademarks. Now at the last minute, Opposer seeks in essence to start these proceedings from the beginning. Opposer would now have the Board overlook over two years of inexcusable delay and condone its intolerable behavior by permitting the proceedings to resume based on legally deficient arguments. If the Board entertains this request, these proceedings may very well continue for years.

Moreover, Opposer's dilatory tactics and De Beers' subsequent need to file the aforementioned motions has caused an undue burden on the Board's resources. *See Pumpkin*, 43 U.S.P.Q.2d at 1588 (holding that the Board's wasted resources for briefing and deciding a motion to reopen weighed heavily against a finding of excusable neglect). In *Pumpkin*, 43 U.S.P.Q.2d at 1588, the Board noted that it is especially interested in minimizing its resources regarding such matters as those "which come before the Board solely as a result of a sloppy practice or inattention to deadlines on the part of litigants or their counsel." *Id.* In these circumstances, the "Board's interest in deterring such sloppy practice weighs heavily against a finding of excusable neglect." *Id.*

Third, Opposer has not provided a valid excuse as to why it failed to comply with the Board's Order. An important factor in this analysis is the reason for the delay, including whether it was within the reasonable control of the movant. *See Pumpkin*, 43 U.S.P.Q.2d at 1586-87. Clearly, monitoring and adhering to a deadline imposed by the Board, as well as basic communication between counsel and client, are wholly within Opposer's control and do not constitute excusable neglect. *See Pioneer*, 507 U.S. at 396 (finding that a docketing error was an insufficient reason for Opposer's failure to provide evidence and that proper docketing and monitoring of deadlines is wholly within one's control); *Baron Philippe*, 55 U.S.P.Q.2d at 1852-53 (finding that proper interpretation of a procedural rule by Applicant's attorney is wholly within the reasonable control of Applicant). In as much as Opposer's reason for not complying with the Board's Order was well within its control and that Opposer is responsible for the actions of its counsel, this factor weighs heavily in favor of De Beers. *Pioneer*, 507 U.S. at 396.

As stated above, Mr. Tredoux was the attorney with whom De Beers corresponded with regarding all discovery matters. (see Exhibits A through I). Opposer has not provided the Board

with any explanation as to Mr. Tredoux's role in these proceedings and whether he communicated the Board's Order to Opposer. Accordingly, this omission weighs heavily in favor of De Beers. *Caterpillar Tractor Co. v. Catfish Anglers Together, Inc.*, 194 U.S.P.Q.2d 99, 100 (T.T.A.B. 1976) (entering default judgment when party failed to provide the Board with an explanation for not complying with the Trademark Rules).

Lastly, Opposer's dilatory tactics and its current attempts to mislead the Board constitute bad faith. Opposer now is attempting to deceive the Board. On January 29, 2007, Opposer's current co-counsel, Scott T. Griggs, contacted De Beers' counsel to obtain an extension of time to respond to De Beers' Motion. Declaration of Vincent P. Rao II (hereinafter "Rao Decl.") at 2. Mr. Griggs also informed De Beers' counsel that he was replacing Mr. Harlow in this proceeding. *Id.* On January 30, 2007, De Beers' counsel contacted Mr. Griggs to inform him of Mr. Tredoux's involvement in these proceedings and to inquire as to whether Mr. Griggs would be replacing Mr. Tredoux as well. Rao Decl. at 3. Mr. Griggs informed De Beers that only Mr. Harlow had been replaced. Rao Decl. at 4.

By concealing the identity of Mr. Tredoux and his involvement in these proceedings, Opposer has aggravated its failure to comply with the Board's Order. In fact, Opposer has continued to retain the very counsel (i.e., Mr. Tredoux) that was primarily responsible for Opposer's discovery and has provided the Board with no explanation as to why Mr. Tredoux may also have failed to comply with the Order. (See Exhibits A through I). Concealing essential facts because they may undermine Opposer's argument for not complying with the Order constitutes further bad faith. In addition, Opposer appears to have commenced these opposition proceedings based on ulterior motives. After all, it is inconceivable if Opposer was truly concerned about its trademarks, that it would have remained silent for approximately eight (8)

months and not so much as to inquire with one of its two lawyers about the status of these proceedings.

B. Opposer's Misleading Actions Warrant the Strongest Sanction Possible

As explained above, Opposer's papers are disingenuous and its failure to provide the Board with an accurate account of all relevant facts constitutes further bad faith. As is clear from the foregoing, Opposer affirmatively chose not to inform the Board of Mr. Tredoux's role in these proceedings and of his continued representation of Opposer. These omissions make Opposer's actions even more egregious when it refers to "prior lead counsel" as being negligent because the primary counsel in charge of discovery is still actively involved in this proceeding. It is inconceivable that two separate attorneys from different law firms were both unaware of the Board's Order or that both failed to inform their client of the Order, especially since De Beers served its discovery papers and motion on both attorneys. (see Exhibits J and K). Therefore, Opposer's entire argument regarding the failure of its prior counsel to comply with the Board's Order is disingenuous[1].

CONCLUSION

For the foregoing reasons, and for the reasons expressed in its Motion, De Beers respectfully requests that the Board enter judgment against Opposer and dismiss these consolidated opposition proceedings.

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[1] It is absurd that after all the attempts Applicant made to expedite discovery, Opposer now states that "Counsel for DeBeers 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." *See* Response at 19. It is not De Beers' obligation to remind Opposer of its deadlines, especially one that is imposed by the Board as a result of Opposer's refusal to comply with the T.T.A.B. Rules, necessitating a Motion to Compel.

Respectfully submitted,

DE BEERS LV LTD.

Dated: February 20, 2007

By: _____

Darren W. Saunders
Vincent P. Rao II
Kirkpatrick & Lockhart Preston Gates Ellis LLP
599 Lexington Avenue
New York, NY 10022-6030
Tel: (212) 536-3900
Fax: (212) 536-3901

Attorneys for Applicant

CERTIFICATE OF SERVICE BY MAIL

I hereby certify that on the 20th day of February, 2007, I served a true and correct copy of the foregoing Reply to Opposer's Response to Applicant' Motion for Discovery Sanctions on the attorneys for the Opposer at the addresses indicated below, by depositing said document in the United States mail, first-class postage prepaid:

Scott T. Griggs, Esq.
Griggs Bergen LLP
Bank of America Plaza
901 Main Street
Suite 6300
Dallas, Texas 75202

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: February 20, 2007

Vincent P. Rao II

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

Atty. Ref.: 0820278.0103

De Boulle Diamond & Jewelry, Inc. Opposer, -against- De Beers LV Ltd. Applicant.	Consolidated Opposition No.: 91162370 Opposition Nos. 91162370 91162469 91164615 91165285 91165465

DECLARATION OF VINCENT P. RAO II

Vincent P. Rao II, declares that:

1) I am associated with the firm of Kirkpatrick & Lockhart Preston Gates Ellis LLP, attorneys for De Beers LV Ltd. ("Applicant") in the above-captioned Opposition Proceeding. I make this Declaration in support of Applicant's Motion for Discovery Sanctions, pursuant to Trademark Rule 2.120(g)(1), requesting that the Trademark Trial and Appeal Board enter judgment against the Opposer and dismiss the above-identified proceeding.

2) On January 29, 2007, Mr. Scott T. Griggs contacted me and requested an extension of time to respond to my Motion for Discovery Sanctions. Mr. Griggs stated that his firm would be substituting for Mr. David A. Harlow. I provided Mr. Griggs with a two (2) day extension of time to file his response.

3) On January 30, 2007, I sent Mr. Griggs an e-mail explaining the past dilatory tactics of Opposer's attorneys, namely, Mr. Harlow and Mr. Tredoux, and stated that Mr.

Tredoux was the more actively involved of the two in this proceeding. Accordingly, I requested that he confirm that he was substituting for both attorneys.

4) On January 30, 2007, Mr. Griggs contacted me directly and stated that he was substituting only for Mr. Harlow.

I declare under the penalty of perjury that the foregoing is true and correct. Executed on February 20, 2007.

By: _____

Vincent P. Rao II
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December 29, 2005

Melanie Bradley
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Fax: 212.536.3901
mbradley@klng.com

First Class Mail

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Re: De Boulle Diamond & Jewelry, Inc. v. De Beers LV Ltd
Consolidated Opposition No. 91165285

Dear Mr. Tredoux:

As you are aware, we attempted to contact you on December 22, 2005 to determine if your client would consent to a 30-day extension of the discovery period in the above-referenced matter. As the discovery period was set to close on December 27, 2005, we required a response by that date. We were therefore somewhat disappointed that we did not receive the courtesy of a response via voicemail or email, particularly in view of our accommodation of your earlier request for additional time to serve your client's discovery responses. Since we did not hear from you, we filed an *ex parte* motion to extend the discovery period by thirty days with the Trademark Trial and Appeal Board. A copy of this motion was served on you under separate cover.

Very truly yours,

Melanie Bradley

Melanie Bradley

cc: Darren Saunders, Esq.

Kirkpatrick & Lockhart Nicholson Graham LLP

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February 7, 2006

VIA FACSIMILE 212-308-2500

Darren W. Saunders
212.536.3952
dsaunders@klng.com

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Re: DeBoulle Diamond & Jewelry, Inc. v. DeBeers LV Ltd
Consolidated Opposition No. 91165285

Dear Mr. Tredoux:

This concerns Opposer's Responses to Applicant's First Set of Interrogatories, First Set of Requests for Production of Documents and First Set of Requests for Admission.

We have had an opportunity to review Opposer's Responses and we note that they are seriously deficient and are not in compliance with DeBoulle's obligations under the Federal Rules of Civil Procedure and the applicable trademark rules. Accordingly, we are writing to address the deficiencies in an effort to avoid the need to file motions to compel.

With regard to Opposer's Responses to Applicant's First Set of Interrogatories, DeBoulle did not provide a single substantive response to any of the interrogatories. Instead, you have provided numerous objections that are baseless and that do not excuse your client's obligation to provide answers under oath to each interrogatory. We therefore insist that DeBoulle serve complete answers under oath pursuant to Rule 33, Fed. R. Civ. P. and Trademark Rule 2.120.

With regard to Opposer's Objections and Answers to Applicant's First Set of Requests for Admission, we have the following comments:

Request No. 4: We do not understand your answer. It is improper to insert a condition into an answer to a request for admission. The original request contains no such condition and no objection was interposed. Therefore, we insist that DeBoulle serve a supplemental response in which it unconditionally admits or denies the request.

Request No. 6: DeBoulle's answer is unintelligible. See comments to Request No. 4 above. Please provide a proper response.

Request No. 8: Your objections are baseless. Among other things, the request does not assume anything and your objection that it "assumes facts not in evidence" is not a basis for objecting to a discovery request. Clearly, no facts are yet in evidence in this proceeding.

With regard to Opposer's Objections and Responses to Applicant's First Set of Production of Documents and Things, it is impossible for us to determine what documents you unilaterally deem to be "non-objectionable" and what documents you intend to withhold from production notwithstanding that the documents are otherwise responsive to Applicant's requests. This is improper and unacceptable. We request that you identify for each document request, those documents or category of documents that are responsive and non-privileged, but which you assert are "objectionable."

In addition, you have objected to DeBeer's Interrogatories and Document Requests on the purported grounds of confidentiality. As you must certainly be aware, confidentiality is not a valid ground on which to base an objection to a discovery request. Therefore, we expect that you will withdraw all such objections and provide us with a proposed, stipulated protective order regarding confidential information. Please confirm that you will do so.

Finally, we note that you intend to produce Opposer's documents and things for inspection at your offices in Dallas. In our experience, we have found that it is generally less costly and less burdensome for the parties to reproduce responsive documents rather than require attorneys to travel to inspect documents and arrange for photcopying. Nevertheless, we are amenable to proceeding with document inspection if you insist. Most, if not all, of DeBeer's documents relevant to this proceeding are maintained at DeBeer's European IP counsel's office in Geneva, Switzerland. We will arrange to make the documents available for your inspection at this location on a mutually convenient date.

Unless we receive proper and complete responses to Applicant's Discovery Requests by February 24, 2006, we shall file motions to compel and seek such other relief as necessary.

Very truly yours,

Darren W. Saunders

c: Melanie Bradley, Esq.

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Start time	:	Feb-07 12:34pm
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Kirkpatrick & Lockhart Nicholson Graham LLP

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FAX

Date •	February 7, 2006
Pages •	3
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Attorney No. •	8185
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Client ID/Matter No. •	0820278/0103

COMMENTS: Please see attached.

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Bradley, Melanie

From: Bradley, Melanie
Sent: Thursday, February 23, 2006 6:35 PM
To: 'pjt@hush.com'
Subject: FW: De Boulle v. De Beers; Consolidated Opposition No. 91165285

Dear Mr. Tredoux:

Further to our request below, could you please let us know if your client would agree to the requested extension? Also, I tried to contact you in response to your message to Darren Saunders, but have not heard back as yet. Please give me a call if you have any questions or require any information in connection with this matter.

Very truly yours,
Melanie Bradley

Melanie Bradley, Esq.
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From: Bradley, Melanie
Sent: Wednesday, February 08, 2006 2:17 PM
To: 'pjt@hush.com'
Subject: RE: De Boulle v. De Beers; Consolidated Opposition No. 91165285

Dear Mr. Tredoux:

As you know, we filed an ex parte motion to extend the discovery period in the above-referenced matter to January 24, 2006. That motion has not yet been ruled on by the TTAB. As we have not exchanged documents as yet, we believe it would be beneficial to extend the discovery period by another 60 days. Would your client agree to such an extension?

Please let me know at your earliest possible convenience.

Very truly yours,
Melanie Bradley

Melanie Bradley, Esq.
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Client/Matter Name	Griffes
Client ID/Matter No. •	0820276.0103

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March 2, 2006

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Via Facsimile 1-214-712-5690

Pieter J. Tredoux, Esq.
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Dallas, Texas 75205

Re: DeBoulle Diamond & Jewelry, Inc. v. DeBeers LV Ltd.
Consolidated Opposition No. 91165285

Dear Pieter:

This is further to our conversation of Tuesday concerning an extension of the discovery and testimony periods in the above-identified matter.

As I previously indicated, we are seeking an extension of the discovery period to permit enough time to take depositions after the parties' documents have been produced. Upon reconsideration, we believe a sixty (60) day extension of the discovery period is essential to allow sufficient time to receive and review documents, and to schedule depositions, if necessary. Please advise us if your client will agree to this extension.

As previously discussed, each party will supplement their discovery responses as needed and to identify, copy and produce documents by March 15, 2006. Assuming your client agrees to the sixty-day extension referenced above, we would file the attached stipulated extension of discovery and testimony periods resetting the relevant dates as follows: discovery in the consolidated opposition to close on May 15, 2006; opposer's testimony period to close on June 23, 2006; applicant's testimony period to close on August 22, 2006; and opposer's rebuttal period to close on October 6, 2006.

Please confirm your agreement with the above so that we may file the stipulated extension of discovery and testimony periods. We would appreciate your prompt response by the close of business tomorrow as we will promptly file the motion regardless of whether it is stipulated or ex parte. Also, as we expect that the parties will be producing confidential documents, it is imperative that we file a stipulated protective order with the Trademark Trial and Appeal Board as soon as possible. Please confirm that you will provide us with a draft by the end of next week at the latest.

Should you have any questions or require additional information, please call me.

Very truly yours,

Melanie Bradley

Melanie Bradley

Enclosure

Kirkpatrick & Lockhart Nicholson Graham LLP

599 Lexington Avenue
New York, NY 10022-6030
212 536.3900
Fax 212.536.3901
www.klng.com

April 4, 2006

Melanie Bradley
212.536.4071
Fax: 212.536.3901
mbradley@klng.com

VIA FACSIMILE

Pieter J. Tredoux, Esq.
1717 Main Street, Suite 3400
Dallas, Texas 75205

Re: DeBoulle Diamond & Jewelry, Inc. v. DeBeers LV Ltd.
Consolidated Opposition No. 91165285

Dear Pieter:

This is further to our conversation of last Wednesday concerning an extension of the discovery and testimony periods in the above-identified matter.

Per our discussion each party will supplement their discovery responses as needed and to identify, copy and produce responsive documents by April 14, 2006. We will file a stipulated extension of discovery and testimony periods resetting the relevant dates as follows: discovery in the consolidated opposition to close on June 15, 2006; opposer's testimony period to close on August 14, 2006; applicant's testimony period to close on October 15, 2006; and opposer's rebuttal period to close on December 15, 2006.

As previously indicated, we intend to use the extended discovery period to take the deposition of a representative of DeBoulle Diamond & Jewelry, Inc. who is familiar with the documents produced to us, if necessary.

Please confirm your agreement with the above so that we may file the stipulated extension of discovery and testimony periods. Please also confirm that you will provide us with a draft stipulated protective order by the end of this week. We would like to file the protective order with the Trademark Trial and Appeal Board in advance of the document exchange.

Should you have any questions or require additional information, please call me.

Very truly yours,

Melanie Bradley

Melanie Bradley

Enclosure

Confirmation Report — Memory Send

Page : 001
Date & Time: Apr-04-06 12:31pm
Line 1 :
Line 2 :
Machine ID : Kirkpatrick & Lockhart LLP

Job number	:	988
Date	:	Apr-04 12:30pm
To	:	☎2#459#912123082500
Number of pages	:	003
Start time	:	Apr-04 12:30pm
End time	:	Apr-04 12:31pm
Pages sent	:	003
Status	:	OK

Job number : 988 *** SEND SUCCESSFUL ***

Kirkpatrick & Lockhart Nicholson Graham LLP

599 Lexington Avenue
New York, NY 10022
212.536.3900
Fax: 212.536.3901

FAX

Date •	April 4, 2006
Pages •	3
Time •	
Transmit To •	Pieter J. Tredoux, Esq.
Company/Firm •	
Telephone No. •	
Fax No. •	212-308-2500
From •	Melanie Bradley
Phone •	212.536.4071
Secretary •	Rebecca Powell
Phone •	212-536-4093
Attorney No. •	
Client/Matter Name	
Client ID/Matter No. •	0820278/0103

COMMENTS:

When you are sending to us, please be sure to include a cover sheet with your transmittal and a telephone number where you can be contacted in case of equipment malfunction.

Transmitted by: **Time:**

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Kirkpatrick & Lockhart Nicholson Graham LLP

J9 Lexington Avenue
New York, NY 10022
212.536.3900
Fax: 212.536.3901

FAX

Date • April 4, 2006

Pages • 3

Time •

Transmit To • Pieter J. Tredoux, Esq.

Company/Firm •

Telephone No. •

Fax No. • **212-308-2500**

From • Melanie Bradley

Phone • 212.536.4071

Secretary • Rebecca Powell

Phone • 212-536-4093

Attorney No. •

Client/Matter Name

Client ID/Matter No. • 0820278/0103

COMMENTS:

When you are sending to us, please be sure to include a cover sheet with your transmittal and a telephone number where you can be contacted in case of equipment malfunction.

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Bradley, Melanie

From: Bradley, Melanie
Sent: Friday, April 14, 2006 12:54 PM
To: 'pjt@hush.com'
Cc: Saunders, Darren W.
Subject: De Boulle Diamond & Jewelry Inc. v. De Beers LV Ltd. - Consolidated Opposition No. 91165285

Dear Pieter:

We have not received your response to our facsimile of April 4, 2006 regarding the agreed upon exchange of documents and discovery schedule in the above-identified matter. As you may recall, we had anticipated that the parties' exchange of responsive documents would occur today. We are prepared to produce documents, however, as we have not heard from you and also, since there still is no protective order in place, we will refrain from doing so. Please give me a call at your earliest convenience to reset the schedule for exchanging documents and extending discovery.

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

Kirkpatrick & Lockhart Nicholson Graham LLP

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212.536.3900
Fax 212.536.3901
www.klng.com

April 25, 2006

Melanie Bradley

212.536.4071
Fax: 212.536.3901
mbradley@klng.com

VIA FACSIMILE
Confirmation via First Class Mail

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Re: DeBoulle Diamond & Jewelry, Inc. v. DeBeers LV Ltd.
Consolidated Opposition No. 91165285

Dear Pieter:

This is further to my facsimile of April 4, 2006 and my email of April 14, 2006.

We have been trying to contact you to arrange for the exchange of documents and the entry of a protective order, but have not received any reply. According to the Trademark Trial and Appeal Board's latest order, discovery now is set to close in the Consolidated Opposition on June 1, 2006. It is therefore imperative that we immediately file a protective order and exchange documents so that we may arrange for depositions, if necessary, in advance of the close of discovery.

We require a response from you by close of business tomorrow. If we do not hear from you, we will file a motion to compel.

Very truly yours,

Melanie Bradley

Melanie Bradley

BOSTON • DALLAS • HARRISBURG • LONDON • LOS ANGELES • MIAMI • NEWARK • NEW YORK • PALO ALTO • PITTSBURGH • SAN FRANCISCO • WASHINGTON

Confirmation Report - Memory Send

Page : 001
Date & Time: Apr-25-06 04:19pm
Line 1 :
Line 2 :
Machine ID : Kirkpatrick & Lockhart LLP

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Date	:	Apr-25 04:18pm
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Start time	:	Apr-25 04:18pm
End time	:	Apr-25 04:19pm
Pages sent	:	002
Status	:	OK

Job number : 110 *** SEND SUCCESSFUL ***

Kirkpatrick & Lockhart Nicholson Graham LLP

599 Lexington Avenue
New York, NY 10022
212.536.3900
Fax: 212.536.3901

FAX

Date •	March 25, 2006
Pages •	2
Transmit To •	Pieter J. Tredoux, Esq.
Fax No. •	214-712-5690
From •	Melanie Bradley
Phone •	212.536.4071
Secretary •	Rebecca Powell
Phone •	212 - 536 - 4093
Attorney No. •	8296
Client/Matter Name	Griffes
Client ID/Matter No. •	0820278/0103

COMMENTS: Please see attached.

When you are sending to us, please be sure to include a cover sheet with your transmittal and a telephone number where you can be contacted in case of equipment malfunction.

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IMPORTANT: The materials transmitted by this facsimile are sent by an attorney or his/her agent, and are considered confidential and are intended only for the use of the individual or entity named. If the addressee is a client, these materials may also be subject to applicable privileges. If the recipient of these materials is not the addressee, or the employee or agent responsible for the delivery of these materials to the addressee, please be aware that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us at 212.536.3900 (collect) and return the transmitted materials to us at the above address via the U.S. Postal Service. We will reimburse you any costs incurred in connection with this erroneous transmission and your return of these materials. Thank you. Please report problems with reception by calling 212.536.3900.
NY-418446 v2

Kirkpatrick & Lockhart Nicholson Graham LLP

599 Lexington Avenue
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212.536.3900
Fax 212.536.3901
www.klng.com

May 10, 2006

Melanie Bradley

212.536.4071
Fax: 212.536.3901
mbradley@klng.com

VIA FEDERAL EXPRESS

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Re: DeBoulle Diamond & Jewelry, Inc. v. DeBeers LV Ltd.
Consolidated Opposition No. 91165285

Dear Pieter:

Enclosed are documents responsive to Opposer's First Request for Production of Documents and Things to DeBeers LV Ltd., bearing production numbers DB 00001 to DB 00019. We are withholding confidential documents pending the entry of an appropriate protective order. Accordingly, we ask once again that you provide us with a draft protective order at your earliest possible convenience.

We expect to promptly receive your client's supplemental responses to Applicant's First Sets of Interrogatories and Requests for Admission as well as documents responsive to Applicant's First Set of Requests for Production of Documents and Things.

Very truly yours,

M. Bradley

Melanie Bradley

PIETER J. TREDOUX
ATTORNEY AND COUNSELOR
300 Park Avenue, Suite 1700
New York, New York 10022
(212) 308-3500 • (212) 308-2500 (Telecopier)
E-mail: ptredoux@tredoux.com

December 30, 2005

JAN - 3 2006

LLP

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

Re: Consolidated Opposition No. 91165285
De Boulle Diamond & Jewelry, Inc. v. De Beers LV Ltd.

Gentlemen and Ms. Bradley:

I enclose the following in the above-referenced Proceeding:

(i) Opposer's Objections and Reponses Subject Thereto to Applicant's First Set of Admissions to Opposer;

(ii) Opposer's Objections to Applicant's First Set of Interrogatories to Opposer; and

(iii) Opposer's Objections and Reponses Subject Thereto to Applicant's First Requests for Production of Documents and Things to Opposer.

Very truly yours,

Pieter Tredoux

Pieter Tredoux

cc: David A. Harlow, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S FIRST SET OF INTERROGATORIES TO OPPOSER was served by First Class Mail, with sufficient postage prepaid, on this the 18th day of November, 2005, upon Opposer's attorneys:

David A. Harlow, Esq.
Christopher M. Kindel, Esq.
Nelson Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One/Second Floor
Raleigh, NC 27612

Peter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: New York, New York
November 18, 2005

By Rebecca Powell
Rebecca Powell

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO OPPOSER was served by First Class Mail, with sufficient postage prepaid, on this the 18th day of November, 2005, upon Opposer's attorneys:

David A. Harlow, Esq.
Christopher M. Kindel, Esq.
Nelson Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One/Second Floor
Raleigh, NC 27612

Peter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: New York, New York
November 18, 2005

By Rebecca Powell
Rebecca Powell

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO OPPOSER was served by First Class Mail, with sufficient postage prepaid, on this the 18th day of November, 2005, upon Opposer's attorneys:

David A. Harlow, Esq.
Christopher M. Kindel, Esq.
Nelson Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One/Second Floor
Raleigh, NC 27612

Peter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: New York, New York
November 18, 2005

By _____
Rebecca Powell

CERTIFICATE OF SERVICE BY MAIL

I hereby certify that on the 31st day of May, 2006, I served a true and correct copy of the foregoing Motion to Compel on the attorney for the Opposer at the address indicated below, by depositing said document in the United States mail, first-class postage prepaid:

David A. Harlow, Esq.
Christopher M. Kindel, Esq.
Nelson Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One/Second Floor
Raleigh, NC 27612

Peter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: May 31, 2006

Melanie Bradley

Melanie Bradley

CERTIFICATE OF SERVICE BY MAIL

I hereby certify that on the 9th day of January, 2007, I served a true and correct copy of the foregoing Motion for Discovery Sanctions on the attorneys for the Opposer at the addresses indicated below, by depositing said document in the United States mail, first-class postage prepaid:

David A. Harlow, Esq.
Christopher M. Kindel, Esq.
Nelson Mullins Riley & Scarborough LLP
4140 Parklake Avenue
GlenLake One/Second Floor
Raleigh, NC 27612

Peter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, N.Y. 10022

Dated: January 9, 2007

Vincent P. Rao II