

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

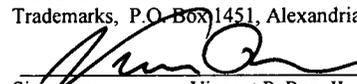
Atty. Ref.: 0820278.0103

De Boule Diamond & Jewelry, Inc. : Consolidated Opposition No.: 91162370  
Opposer, : Opposition Nos. 91162370  
: 91162469  
: 91164615  
-against- TTAB : 91165285  
: 91165465

De Beers LV Ltd.

Applicant.

"EXPRESS MAIL" Label No EM 156170241 US  
I hereby certify that this paper or fee is being deposited with  
the United Postal Service "Express Mail Post Office to  
Addressee" service under 37 C.F.R. § 2.198 on the date  
indicated below and is addressed to the Commissioner for  
Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

  
Signature Vincent P. Rao, II

Date: September 17, 2007

**MOTION TO REQUEST DISCOVERY PURSUANT  
TO FED. R. CIV. P. 56(f)**

Pursuant to Rule 56(f) of the Federal Rules of Civil Procedure and based on the accompanying declaration of Darren W. Saunders, Applicant, De Beers LV Ltd. ("De Beers"), hereby submits this Motion to Request Discovery, because it cannot respond to Opposer's ("De Boule") Motion for Summary Judgment to demonstrate the existence of disputed material facts without cross-examining De Boule's affiant Denis J. Boule. The specific topics of discovery needed are set forth in the Declaration of Darren W. Saunders.

On August 9, 2007, De Boule filed a Motion for Summary Judgment in the above-captioned Consolidated Opposition Proceeding. On August 16, 2007, the Board *sua sponte* issued an Order deeming De Boule's Motion for Summary Judgment timely and suspended this Consolidated Opposition Proceeding pending the disposition of De Boule's pending Motion. In



its August 16, 2007 Order, the Board provided De Beers thirty (30) days in which to respond to De Boule's Motion (i.e., September 15, 2007).

On September 12, 2007, De Beers filed a Stipulated Motion for Extension of Time to Respond to Opposer's Motion for Summary Judgment. The new deadline for De Beers to respond to the De Boule's Motion is September 30, 2007.

By way of background, De Beers filed for four (4) federal trademark registrations on the basis of Section 44(e) of the Trademark Act, 15 USC Section 1126(e) on the following dates: 1) May 2, 2003 - DB SIGNATURE (U.S. Application Serial No. 78/245,210); 2) May 2, 2003 - DB LOGO (U.S. Application Serial No. 78/245,219); 3) May 5, 2003 - DB STAR (U.S. Application Serial No. 78/245,795); and 4) June 1, 2003 - DB MONOGRAM (U.S. Application Serial No. 78/245,779). On November 25, 2003, De Beers filed for a fifth federal trademark registration for SO DB (U.S. Application Serial No. 79/000,478) based on Section 66(A) of the Trademark Act, 15 USC Section 1141(f).

On April 7, 2005, De Boule filed for a federal trademark registration for DB (U.S. Application Serial No. 78/604,056) based on Section 1(A) of the U.S Trademark Act, 15 USC Section 1051(a). This application is currently suspended pending the disposition of this consolidated opposition proceeding.

In support of its Motion for Summary Judgment, De Boule filed the Affidavit of Denis J. Boule. ("Boule Affidavit") *See* Exhibit A. De Boule claims that it has used DB as a trademark since December, 2000. There is no evidence that DB was actually used as a mark or functioned as a trademark since December of 2000, as claimed by De Boule. Since De Boule is relying on the claimed DB mark in its Motion for Summary Judgment, De Beers must have the opportunity to obtain information pertaining to the claimed DB mark and must have the

opportunity to cross-examine Mr. Boule on the testimony in his affidavit for the specific reasons set forth in the accompanying declaration of Darren W. Saunders.

De Beers cannot respond to the Motion for Summary Judgment without the opportunity to cross-examine the witness, Denis J. Boule, on facts which are uniquely within the knowledge and control of Mr. Boule.

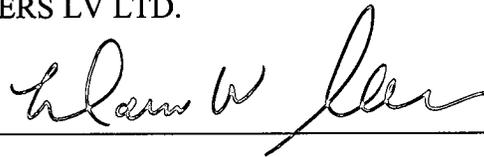
WHEREFORE, Applicant De Beers LV Ltd. prays that the Board grant this Motion and permit De Beers to take the deposition of Denis J. Boule.

Respectfully submitted,

DE BEERS LV LTD.

Dated: September 17, 2007

By: \_\_\_\_\_



Darren 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 17th day of September, 2007, I served a true and correct copy of the foregoing Motion to Request Discovery and accompanying Declaration of Darren W. Saunders on the attorney for the Opposer, Scott T. Griggs, Esq., Griggs Bergen LLP, Bank of America Plaza, 901 Main Street, Suite 6300, Dallas, Texas 75202, by depositing a true copy of the same with the United States Postal Service as first-class mail, postage prepaid, this 17th day of September, 2007.

Dated: September 17, 2007

  
\_\_\_\_\_  
Vincent P. Rao II



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

DE BOULLE DIAMOND & JEWELRY, INC.,

Opposer,

v.

DE BEERS LV LTD.,

Applicant.

Consolidated Opposition No.: 91162370

Opposition No.'s: 91162370

91162469

91164615

91165285

91165465

**AFFIDAVIT OF DENIS J. BOULLE IN SUPPORT OF  
OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

STATE OF TEXAS                    §  
   §  
COUNTY OF DALLAS               §

BEFORE ME, the undersigned authority, on this day personally appeared Denis J. Boulle, who is personally known to me, and first being duly sworn according to the law upon his oath deposed and said:

1. My name is Denis J. Boulle. I am over eighteen years of age, have never been convicted of a crime and am fully competent to make this affidavit. I have personal knowledge of the facts stated herein, all of which are true and correct.

2. I am making this Affidavit in support of the Motion for Summary Judgment filed by De Boulle Diamond & Jewelry, Inc. the Opposer in this Proceeding ("De Boulle").

3. I am the Chief Executive Officer and Chairman of the Board of De Boulle. I previously held the Office of president of De Boulle, having functioned in that capacity since its incorporation. I have been in the business of marketing and selling diamonds, fine jewelry and timepieces to the general public in the United States since 1982. I am a Member of Jewelers of America, and the Retail Jewelers Advisory Board of the American Watch Guild (I am also a founding Board Member of the American Watch Guild).

4. De Boulle was incorporated by the Secretary of State of Texas on September 26, 1983, as Quadrant Diamond Counsel, Inc. On June 29, 1984, De Boulle changed its name to De Boulle Diamond & Jewelry Counsel, Inc. On June 13, 1988, De Boulle changed its name to De Boulle Diamond & Jewelry, Inc.

5. De Boulle owns and operates a jewelry store in Dallas, Texas under the service mark "De Boulle", and has done so since 1984. As such, De Boulle has marketed and sold diamonds, fine jewelry and timepieces to the general public in Dallas, Texas, and elsewhere in the United States in association with the brand De Boulle for almost twenty five (25) years. Over the past three (3) years alone, at least thirty-five percent (35%) of De Boulle's sales were made to consumers with residences outside the State of Texas. De Boulle markets its brand and products to purchasers of engagement and wedding rings, gifts for special occasions, such as birthdays, anniversaries, and the Holidays, and connoisseurs and consumers of luxury products in general. Trust and brand identification are an important part of the buying decision to these customers. Over the years De Boulle has grown to become one of the premier independently owned jewelers in the United States.

6. Through the years, the De Boulle brand has developed a reputation in

Dallas, Texas, and elsewhere in the United States, for the fine quality of the exclusive jewelry that the De Boule craftsmen custom design and manufacture, as well as the fine quality of its diamonds and other gems. De Boule's marketing activities include advertising and promoting its brand and products in local and national luxury goods and lifestyle media, such as Vanity Fair, the Wall Street Journal, GQ Magazine, Millionaire Magazine, Robb Report, and Town & Country. True and correct copies of examples of national advertising placements by De Boule in this regard, are attached hereto as Exhibit K. De Boule, by way of further example, also markets its brand to the target market of connoisseurs of luxury and lifestyle products nationally, by advertisements on a race car that competes in events on the Formula Ford Zetec Cooper Tire Championship Series on the East Coast. De Boule further promotes its brand and offers its De Boule Collection and other products for sale to general public throughout the United States on its Web site, [www.deboule.com](http://www.deboule.com).

7. The De Boule brand is also contained on in-store displays, local and national advertising, as well as packaging delivered and shipped with De Boule's products to clients in Dallas, Texas, and elsewhere in the United States. True and correct copies of examples of the display of the De Boule brand in association with De Boule's products are contained in the de Boule's Application for federal registration of the Mark "DE BOULLE", U.S. Trademark Application Serial No. 78/444,880 (the "DE BOULLE Mark").

8. In or about December 2000, as part of the design of its Web site, De Boule designed the mark "DB", made the subject of its U.S. Trademark Application Serial No. 78/604,056 (the "DB Mark"). Since that time, De Boule has used the DB Mark in

association with the fine jewelry, diamonds, and timepieces sold to the general public throughout the United States on the Web site. The DB Mark is also contained on packaging delivered and shipped with De Boule's products to clients in Dallas, Texas, and elsewhere in the United States. True and correct copies of examples of the display of the DB mark in association with De Boule's products are contained in de Boule's U.S. Trademark Application Serial No. 78/604,056 for federal registration of the DB Mark.

9. In or about June 2001, as part of the redesign of its corporate identity to coincide with the opening of its new store, De Boule designed the mark "DE B", made the subject of its U.S. Trademark Application Serial No. 78/440,907 (the "DE B Mark"). Since that time, De Boule has also used the DE B Mark on in-store displays, local and national advertising, as well as packaging delivered and shipped with De Boule's products to clients in Dallas, Texas, and elsewhere in the United States. True and correct copies of examples of the display of the DE B brand in association with De Boule's products are contained in de Boule's U.S. Trademark Application Serial No. 78/440,907 for federal registration of the DE B Mark.

10. Customers have come to identify the DB, DE BOULLE and DE B Marks (hereinafter collectively the "De Boule Marks") with fine jewelry, diamonds, and timepieces, which are of the highest quality. Customers have come to identify the De Boule Marks with fine jewelry, including diamonds, and timepieces which originate from De Boule. The De Boule Marks are valuable assets of De Boule. The De Boule Marks carry considerable goodwill and customer acceptance of the fine jewelry, diamonds, and timepieces offered under the De Boule Marks. De Boule's customers and potential customers have come to recognize the De Boule Marks as representing the quality of De

Boulle's fine jewelry, diamonds, and timepieces. Indeed, in 2005, I met with Alyce Alston, the then Chief Executive Officer of De Beers Diamond Jewellers US Inc. ("De Beers"), at the De Boulle store in Dallas, Texas, at her request. At the meeting, De Beers requested that De Boulle consider carrying the De Beers line of products, as a result of the considerable goodwill and customer acceptance nationally of the fine jewelry, diamonds, and timepieces offered under the De Boulle brand.

11. I have reviewed and am familiar with the advertising and marketing campaign conducted by De Beers in the United States. I am also familiar with the products being offered by De Beers, at their new store in New York, New York, in Beverly Hills, California, and Las Vegas, Nevada.

12. Just like De Boulle, De Beers markets its products to purchasers of engagement and wedding rings, gifts for special occasions, such as birthdays, anniversaries, and the Holidays, and connoisseurs and consumers of luxury products in general. Based on my twenty five (25) years' experience marketing and selling diamonds and fine jewelry in to consumers located throughout the United States, I am of the opinion that diamonds and fine jewelry bearing the De Beers' brand and diamonds, and fine jewelry bearing the De Boulle Marks may be sought out and bought by the same consumer. Furthermore, because of the semantic similarity in the two brand names and their abbreviations, DB or De B, potential consumers of diamonds and fine jewelry marketed by De Boulle are likely to assume that De Boulle has expanded diamond and fine jewelry offerings to include the products offered by De Beers.

13. Just like De Boulle, De Beers markets its products under the De Beers brand through public advertising in national luxury goods and lifestyle media, and the

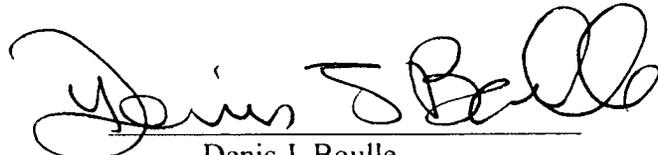
internet. The De Beers and De Boule marketing and advertising campaigns are likely to reach the same consumer. Based on my twenty five (25) years' experience marketing and selling diamonds and fine jewelry in to consumers located throughout the United States, I am of the opinion that, because of the semantic similarity in the two brand names and their abbreviations, whether DB or De B, potential consumers of diamonds and fine jewelry marketed by De Boule are likely to assume that De Boule has expanded diamond and fine jewelry offerings to include the products offered by De Beers.

14. The De Beers marketing strategy involves selling its products to the general public through its company-owned stores in New York, Beverly Hills, Las Vegas, and elsewhere, and to offer De Beers branded diamonds and fine jewelry through a select network of reputable jewelry stores (such as de Boule) in parts of the United States, where there are no company-owned stores, such as Texas. Based on my twenty five (25) years' experience marketing and selling diamonds and fine jewelry in to consumers located throughout the United States, I am of the opinion that, because of the semantic similarity in the two brand names and their abbreviations, whether DB or De B, potential consumers of diamonds and fine jewelry marketed by De Boule are likely to assume that the De Beers products offered for sale under the De Beers brand are actually the diamonds and fine jewelry offered by De Boule.

15. Additionally, any confusion between the De Boule brand and the De Beers brand may cause De Boule irreparable harm. In the market for diamonds and fine jewelry, the De Beers name has long been associated with the apartheid-era regimes in South Africa and its monopolistic practices to control diamond prices and the diamond market. De

Boulle has devoted almost twenty five (25) years in building its brand in the United States. The De Boulle brand and the De Boulle Marks are valuable assets of De Boulle. De Boulle would suffer irreparable harm if potential consumers of diamonds and fine jewelry assume that the diamonds and fine jewelry marketed by De Boulle in association with the De Boulle Marks are actually products offered by De Beers.

FURTHER AFFIANT SAYETH NAUGHT.

  
Denis J. Boulle

SUBSCRIBED AND SWORN TO BEFORE ME this 9<sup>th</sup> day of August, 2007, to certify which witness my hand and official seal.



  
Notary Public, State of Texas

[NOTARY SEAL]

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has served a copy of the foregoing document upon counsel of record by electronic mail on this the 9<sup>th</sup> day of August, 2007, and by mailing a true copy thereof with the Exhibits referenced herein, through the United States Mail, first class, postage prepaid, on the 10<sup>th</sup> day of August, 2007, and addressed as follows:

"Saunders, Darren W." [darren.saunders@klgates.com](mailto:darren.saunders@klgates.com)

"Rao, Vincent P. II" [vincent.rao@klgates.com](mailto:vincent.rao@klgates.com)

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

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

Atty. Ref.: 0820278.00103

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

**DECLARATION OF DARREN W. SAUNDERS**

1. I am a partner in the firm of Kirkpatrick & Lockhart Preston Gates Ellis LLP, attorneys for Applicant, De Beers LV Ltd. ("De Beers") in the above-captioned Consolidated Opposition Proceeding. I make this Declaration in support of De Beers' Motion to Request Discovery, pursuant to Fed. R. Civ. P. 56(f). De Beers cannot effectively respond to De Boule's Motion for Summary Judgment without cross-examining Denis J. Boule on the specific subjects set forth herein.

2. Opposer ("De Boule") submitted the Affidavit of Denis J. Boule in support of its Motion for Summary Judgment. De Beers needs to obtain the following information and cross-examine Mr. Boule on the following topics in order to demonstrate the existence of material facts in dispute:

i.) De Boule's claim that it began use of "DB" as a trademark in December, 2000. (De Boule Affidavit ¶ 8);

ii.) De Boule's claim that since December, 2000, De Boule has used DB as a trademark in connection with jewelry. (Id);

iii.) De Boule's claim that customers have come to identify "DB" with De Boule's jewelry. (De Boule Affidavit ¶ 10);

iv.) The basis for the statement that "potential consumers of fine jewelry marketed by De Boule are likely to assume that De Boule has expanded diamond and fine jewelry offerings to include products offered by De Beers." (De Boule Affidavit ¶ 12); and

v.) De Boule's claim of "irreparable harm if potential consumers of diamonds and fine jewelry assume that the diamonds and fine jewelry marketed by De Boule in association with the De Boule marks are actually products offered by De Beers." (De Boule Affidavit ¶ 15).

3. All of these facts are uniquely in the hands of Opposer/Movant. Because De Boule is relying on alleged use of the DB as a trademark in the Motion for Summary Judgment, De Beers cannot effectively oppose the Motion without first taking discovery of Mr. Boule.

4. Accordingly, De Beers requests that the Board order that Mr. Boule appear for a deposition at the time and place to be agreed to by the parties prior to the filing of De Beers' opposition to the Motion for Summary Judgment.

I declare under the penalty of perjury that the foregoing is true and correct. Executed on September 17, 2007.

New York, New York

  
\_\_\_\_\_  
Darren W. Saunders