

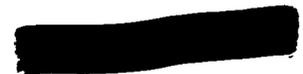
October 30, 2007

Darren W. Saunders  
D 212.536.3952  
F 212.536.3901  
darren.saunders@klgates.com

**Via FedEx**

**TTAB**

Cheryl A. Butler, Esq.  
Interlocutory Attorney  
Office G/TTAB  
Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
Madison East, Concourse Level Room C 55  
600 Dulany Street  
Alexandria, VA 22314



10-31-2007

U.S. Patent & TMO/TM Mail Rcpt Dt. #

Re: De Boule Diamond & Jewelry, Inc. v. De Beers LV Ltd.  
Consolidated Opposition No. 91162370

Dear Ms. Butler:

We are writing in regard to Opposer's pending motion for summary judgment and Applicant De Beers' pending request for leave to conduct discovery under Fed. R. Civ. P. 56(f). De Beers is compelled to submit this brief letter in reply to Opposer's Opposition to De Beer's request under Rule 56(f), as the Opposition omits several critical facts and grossly distorts the events concerning discovery in this proceeding.

Under Rule 56(f) and the applicable case law, the Board should permit Applicant to take the deposition of the affiant Dennis Boule, or in the alternative, should deny the motion for summary judgment.

Opposer argues that De Beers was not diligent in discovery supposedly because it did not take the deposition of Mr. Boule during the discovery period, and for this reason, De Beers should not be entitled to cross-examine Mr. Boule on his summary judgment affidavit. [Opposer's Opposition (hereinafter "Opp.") ¶¶13, 14.] This argument should be rejected for two reasons. First, De Beers was diligent in pursuing discovery.<sup>1</sup> But, Opposer did not comply with its obligations to produce the documents requested by De Beers during discovery, foreclosing De Beers from taking a meaningful deposition of Mr. Boule.

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<sup>1</sup> De Beers served 40 interrogatories, 42 document requests and 19 requests for admission early in the proceeding, on November 8, 2005.

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Significantly, Opposer states that it “produced more than 1300 pages of documents” (Opp. ¶15), but **Opposer neglects to mention that it did not produce its documents until February 9, 2007, well after the discovery period closed.** De Beers made several attempts through written correspondence with Opposer’s counsel, Peter J. Tredoux, to obtain the documents during discovery. Indeed, **DeBeers expressly informed Opposer that it was awaiting production of the requested documents to depose De Boule:**

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

(See letter dated April 4, 2006, Exhibit A). However, Opposer never produced the documents during the discovery period and De Beers was ultimately forced to file a Motion to Compel, which it timely did on May 31, 2006. On July 26, 2006, the Board issued its Order compelling Opposer’s production of documents within 30 days. Even after the Board granted De Beer’s Motion to Compel, Opposer did not produce the documents. Accordingly, De Beers filed a Motion for Discovery Sanctions. Opposer finally produced its documents fifteen (15) months after the document requests were served and approximately nine (9) months after the discovery period closed.<sup>2</sup>

Having not complied with its discovery obligations, and forcing De Beers to file a Motion to Compel and a Motion for Discovery Sanctions, Opposer cannot now be heard to complain that De Beers was at fault for not previously taking Mr. Boule’s deposition. In sum, the fact that De Beers did not take Mr. Boule’s deposition is irrelevant to the pending Rule 56(f) request, and the cases cited by Opposer are inapposite, because De Beers was diligent in discovery.

The second reason that Opposer’s request should be rejected is De Beers has a fundamental right to cross-examine Mr. Boule on the substance of his affidavit testimony in defending against the motion for summary judgment.

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<sup>2</sup> The Board determined that there was excusable neglect due to the actions of Opposer’s prior counsel of record, Nelson, Riley, & Scarborough LLP. See Board’s Order on Motion for Discovery Sanctions, dated July 9, 2007. Mr. Tredoux, a solo practitioner, was co-counsel to Opposer. Notably, Opposer never claimed dilatory conduct on the part of Mr. Tredoux, and therefore it can be presumed that Opposer was made aware of De Beers’ request that the documents be provided during the discovery period for the deposition of Mr. Boule. In any event, the fact that there was excusable neglect by De Boule during discovery should not now operate to prohibit De Beers from cross-examining Mr. Boule.

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The Federal Circuit has made clear:

...when the discovery is reasonably directed to “facts essential to justify the party’s opposition”, in the words of Rule 56(f), such discovery must be permitted or summary judgment refused.

*Opryland USA Inc., v. The Great American Music Show, Inc.*, 970 F.2d 847, 852 (Fed. Cir. 1992), citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 n.5 (1986). Indeed, the Board routinely permits additional discovery if such discovery is necessary to enable a party to respond to a summary judgment motion. *See e.g., Orion Group Inc. v. The Orion Ins. Co.*, 12 USPQ2d 1923 (TTAB 1989) (granting additional discovery so that the non-moving party could depose a single affiant regarding testimony central to the dispute).

Here, as set forth in the Declaration of Darren W. Saunders, dated September 17, 2007, the discovery sought by De Beers is essential to justify De Beers’ Opposition to the motion for summary judgment, as it goes to the heart of both De Boulle’s claimed trademark rights in “DB” and alleged likelihood of confusion. Under the present circumstances, it would be fundamentally unfair and highly prejudicial for the Board to accept the testimony of Mr. Boulle on the motion without permitting cross-examination by De Beers.

Accordingly, the Board should either: (1) permit the requested discovery so that De Beers may properly respond to the motion for summary judgment; or (2) deny the motion for summary judgment so that the parties may move forward with the testimony periods. *See* Fed. R. Civ. P. 56(f).<sup>3</sup>

Respectfully submitted,



Darren W. Saunders

c: Scott T. Griggs, Esq.  
(Attorney for Opposer)

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<sup>3</sup> De Beers is also compelled to address Opposer’s unfounded accusation that De Beers allegedly made an improper *ex parte* communication with the Board. (Opp. ¶8). No such communication was ever made. The Board’s August 16, 2007 order was issued *sua sponte*.

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing *Letter to Cheryl A. Butler, Esq.*, was served on counsel for Opposer, Scott T. Griggs, Esq., Griggs Bergen LLP, Bank of America Plaza, 901 Main Street, Suite 6300, Dallas, Texas 75202, by Federal Express, this 30th day of October, 2007.

Dated: October 30, 2007

  
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Vincent P. Rao II

# **EXHIBIT A**



Kirkpatrick & Lockhart Nicholson Graham LLP

599 Lexington Avenue  
New York, NY 10022-6030  
212.536.3900  
Fax 212.536.3901  
www.klmg.com

April 4, 2006

Melanie Bradley

212.536.4071  
Fax: 212.536.3901  
mbradley@klmg.com

**VIA FACSIMILE**

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

Re: DeBouille 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 DeBouille 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.



Kirkpatrick & Lockhart Nicholson Graham LLP

Pieter J. Tredoux, Esq.

April 4, 2006

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

Very truly yours,

A handwritten signature in cursive script that reads "Melanie Bradley". The signature is written in black ink and is positioned above the printed name.

Melanie Bradley

Enclosure