

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: December 5, 2007

Opposition No. 91162370
Opposition No. 91162469
Opposition No. 91164615
Opposition No. 91165285
Opposition No. 91165465

DE BOULLE DIAMOND & JEWELRY, INC.

v.

DE BEERS LV LTD.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In an order dated August 16, 2007, the Board observed that opposer's motion for summary judgment, filed August 9, 2007, was untimely because it was filed after the first testimony period technically opened once in this case. However, because the Board previously noted that opposer was unaware of the schedule set in an earlier order (July 26, 2006), the Board informed the parties that it would consider opposer's motion for summary judgment and reset the time for applicant to respond thereto based on the mailing date of the August 16, 2007 order.¹ Thus, applicant's response was due by September 15, 2007.²

¹ The circumstances upon which the Board based the decision to consider opposer's motion were more complicated than referenced herein.

² Applicant's response, then, was due September 15, 2007. Insofar as this date fell on a Saturday, in accordance with Trademark Rule 2.196, a timely response was due by Monday, September 17, 2007.

This case now comes up on opposer's fully-briefed motion, filed September 17, 2007, for discovery pursuant to Fed. R. Civ. P. 56(f).

Applicant seeks to depose opposer's affiant on specific topics as follows: 1) opposer's claim that it began use of DB as a trademark in December 2000; 2) opposer's claim that, since December 2000, it has used DB as a trademark in connection with jewelry; 3) opposer's claim that customers have come to identify DB with De Boulle's jewelry; 4) the basis for the statement that "potential customers of fine jewelry marketed by De Boulle are likely to assume that De Boulle has expanded diamond and fine jewelry offerings to include products offered by De Beers"; and 5) opposer's claim of "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 of De Beers." In support of its motion, applicant argues that there is no evidence that opposer actually used DB as a mark since December 2000 and that applicant must have an opportunity to obtain information regarding the claimed DB mark and to cross examine opposer's affiant.

In response, opposer argues that applicant served, and opposer responded thereto, written discovery requests yet never before sought a discovery deposition of opposer even though the discovery period had been extend several time over approximately two years. Opposer argues that, in response to written discovery

requests, it identified its witness as an expert and a person with knowledge of the relevant facts of this case. Opposer notes that discovery opened on October 24, 2004 (in the "parent" case)³ and finally closed on September 25, 2006. Opposer argues that applicant has not shown sufficient cause for requesting a deposition for the first time long after discovery closed.

Affidavits (or declarations) are permitted in support of or in response to a summary judgment motion even though they are self-serving in nature and there is no opportunity for cross examination. See TBMP §528.05(b) (2d ed. rev. 2004). Thus, the fact that applicant does not have an opportunity to cross examine opposer's affiant is not persuasive, particularly in the view of the extend time for which the discovery period was open in this consolidated case.

In this case, the discovery period close on September 26, 2006, almost one year prior to opposer filing its motion for summary judgment. In its notices of opposition, opposer pleads prior use for the "DB" and "deB" marks on jewelry (including diamonds) and in connection with retail jewelry store services, averring a priority date of "at least as early as June 30, 2001" for the "deB" mark. Opposer pleads that "... members of the general public have come to identify Opposer's "deB" mark with Opposer's Goods." Opposer sets forth averments of likelihood of confusion and dilution. Opposer alleges the nature of its damage

³ The parent case is the earliest filed opposition, No. 91162370.

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and injury. Applicant, then, was aware upon receiving the notices of opposition to take discovery (if it so desired) on the topics it presents as a basis for its 56(f) discovery motion.

Accordingly, applicant's motion for 56(f) discovery is denied. Applicant is allowed until **THIRTY DAYS** from the mailing date of this order in which to file its substantive response to opposer's summary judgment motion.

Proceedings otherwise remain suspended pending disposition of the summary judgment motion.

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