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Filing date: **05/15/2009**

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

Proceeding	91162370
Party	Defendant De Beers LV Ltd
Correspondence Address	Darren W. Saunders Hiscock & Barclay, LLP Seven Times Square New York, NY 10036 UNITED STATES DSaunders@hblaw.com
Submission	Opposition/Response to Motion
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Signature	/darren.saunders/
Date	05/15/2009
Attachments	De Beers Reponse to Extend Testimony Period.pdf (9 pages)(147755 bytes)

**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 Nos.: 91162370
91164615

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO EXTEND APPLICANT'S
TESTIMONY PERIOD**

Applicant, De Beers Diamond Jewellers Limited, formerly De Beers LV Ltd., hereby responds to Opposer's Motion to Extend Applicant's Testimony Period.

Opposer, De Boule Diamond and Jewelry, Inc. ("De Boule") has filed a motion seeking a thirty-day extension of the remaining testimony periods in this proceeding. In the motion, at Paragraph 5, Opposer misinforms the Board of De Beers' position by stating that "Applicant opposes the extension sought by this Motion." This statement does not accurately reflect the communications between counsel referenced in Paragraph 5.

During the telephone conference between counsel on May 11, 2009, Applicant's counsel inquired as to whether De Boule would be retaining a new law firm to act as counsel of record or whether Pieter J. Tredoux, Esq. would be representing De Boule going forward. Mr. Tredoux has been intimately involved in this proceeding from the outset. He has personally participated in the discovery and testimony phases, including the testimony deposition of Denis Boule on July 9, 2008 during which he questioned the witness for several hours. More recently, on March 31, 2009, Mr. Boule appeared in the United States District Court in Dallas to argue on De

Boulle's behalf in opposing De Beers' Miscellaneous Action for an order authorizing substitute service of a subpoena on Mr. Boulle for his testimony deposition during Applicant's testimony period in this proceeding.

For these reasons, Applicant advised counsel in an email dated May 12, 2009 (attached as Exhibit A hereto), that if Mr. Tredoux were to take over as lead counsel in the proceeding, De Beers does not see any need for an extension, particularly since the first testimony deposition noticed by De Beers is not set until June 1, 2009. (See Exhibit B). Counsel further stated that if De Boulle will be retaining new counsel, De Beers would certainly consider consenting to an appropriate extension of time to allow new counsel to become familiar with the proceeding. *De Beers never stated on the telephone or in its email that it opposes an extension of the testimony periods.*

Instead of responding to De Beers' inquiry regarding counsel, Opposer, without further communication with Applicant, filed the instant motion. In view of the factual background as described above, and De Boulle having filed its motion without further conferring with Applicant's counsel, if Mr. Tredoux will be counsel of record or will otherwise assume the lead role in representing De Boulle, Applicant opposes the motion because it will cause further undue delay. If De Boulle will be retaining new counsel, Applicant does not oppose the motion.¹ If the Board is inclined to grant Opposer's Motion, De Beers respectfully requests that Applicant's testimony period be set to close not before August 3, 2009, in order to avoid the need for the filing of yet another Motion to Extend because of the unavailability of De Beers' witness.

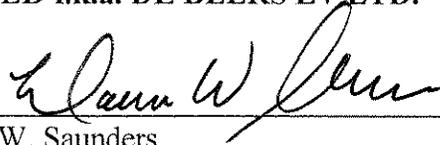
¹ Indeed, on the telephone, De Beers specifically stated that if an extension were necessary, De Beers would need 40 days instead of 30, to accommodate its witnesses' schedule because the witness, Hamida Belkadi, will be traveling out of the country from June 8, 2009 through the end of June.

Respectfully submitted,

**DE BEERS DIAMOND & JEWELLERS
LIMITED f.k.a. DE BEERS LV LTD.**

DATED: May 15, 2009

By: _____



Darren W. Saunders
Hiscock & Barclay, LLP
Seven Times Square
New York, NY 10036
P: 212.784.5800
F: 212.784.5777

Attorneys for Applicant

Certificate of Service

I hereby certify that on this 15th day of May 2009 I served the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO EXTEND APPLICANT'S TESTIMONY PERIOD by first class mail and electronic mail to:

Scott Griggs, Esq.
Griggs Bergen LLP
17950 Preston Road, Suite 1000
Dallas, Texas 75252
scott@griggslaw.com

Pieter J. Tredoux, Esq.
300 Park Avenue, Suite 1700
New York, New York 10022
ptredoux@tredoux.com


Rebecca Powell

EXHIBIT A

Saunders, Darren W.

From: Saunders, Darren W.
Sent: Tuesday, May 12, 2009 12:16 PM
To: 'Scott T. Griggs'
Cc: 'Pieter Tredoux'
Subject: De Boulle v De Beers

Dear Scott,

Once again, please accept my condolences.

With regard to the opposition proceeding, you stated on the telephone yesterday that the client has not yet determined whether Mr. Tredoux will take over or whether a new law firm will be retained. Clearly, if Mr. Tredoux will be representing De Boulle going forward, we see no reason for an extension, as Mr. Tredoux is fully familiar with the matter. Further, the only testimony deposition noticed thus far is set for June 1, 2009, which leaves more than ample time for Mr. Tredoux to prepare. If your client will be retaining new counsel, we will certainly be happy to revisit the issue of an extension of the testimony periods.

I would ask that you please inform us soon as to who will take over as lead counsel so that we will know upon whom to serve papers related to this proceeding.

Best regards,
Darren

EXHIBIT B

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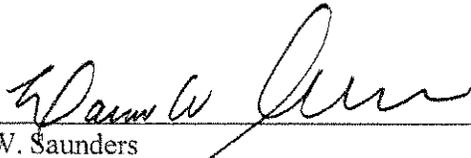
APPLICANT'S NOTICE OF TESTIMONY DEPOSITION

Please take notice that, pursuant to Trademark Rule 2.123, Applicant, De Beers Diamond Jewellers Ltd f/k/a/ De Beers LV Ltd., by its attorney, will take the testimony deposition upon oral examination of its Chief Operating Officer, Hamida Belkadi, on June 1, 2009 at 9:30 a.m. at the office of Hiscock & Barclay, LLP, Seven Times Square New York, New York 10036.

The deposition shall take place before a certified court reporter and shall continue until completed.

You are invited to attend and cross-examine.

DATED: May 7, 2009

By: 

Darren W. Saunders
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Seven Times Square
New York, NY 10036
P: 212.784.5800
F: 212.784.5777

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of May 2009 I served the foregoing Applicant's Notice of Testimony Deposition by first class and electronic mail to:

Dennis T. Griggs, Esq.
Griggs Bergen LLP
17950 Preston Road
Suite 1000
Dallas, Texas 75252
dennis@griggslaw.com