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

Proceeding	91181035
Party	Plaintiff Tiffany (NJ) LLC
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Date	08/01/2008
Attachments	Motion to compel (F0326982).PDF ( 19 pages )(593012 bytes )



severely prejudice Opposer's case; and (5) ordering that if Applicant fails to comply with (1)-(4) above, judgment will be entered against her.

Opposer also requests that, as required by 37 C.F.R. § 2.120(e)(2), the Board suspend this case with respect to all matters not germane to this motion during the pendency of the motion, and that, once this motion has been resolved, the Board reset and extend the discovery period in this action to allow Opposer the time necessary to conduct any follow-up discovery, including depositions, it deems necessary.

### **I. INTRODUCTION**

This is a simple proceeding where Applicant has possession of all relevant documents. The sole issue in the action concerns when and whether, in fact, Applicant actually commenced use of the applied-for mark on each item specified in her application. It is a simple issue, yet one that Applicant has refused to answer for more than three months. The logical inference to be drawn from Applicant's refusal to provide clear answers is that she committed fraud on the Patent & Trademark Office by alleging use when there was none. Applicant's repeated, egregious failure to engage in good faith discovery in this matter has necessitated this motion.

As is set forth more fully in the accompanying Declaration of Evan Gourvitz in Support of Opposer's Motion to Compel, dated August 1, 2008 ("Gourvitz Decl."), Opposer first served Applicant with discovery requests on March 19, 2008, and served follow-up requests on April 25, 2008. Applicant's written responses to these requests were grossly deficient, and her document production of about fifty pages did not address the majority of Opposer's requests. Although Opposer's counsel in good faith repeatedly corresponded with Applicant, noting its concerns and setting forth Applicant's deficiencies in detail, Applicant nevertheless steadfastly has failed to remedy most of the deficiencies.

Given this failure, Opposer seeks an order that Applicant either fully and properly respond to Opposer's interrogatories and document requests or be precluded from relying on responsive documents and evidence that Applicant has failed to produce. Opposer should not be required to litigate from the position of evidentiary uncertainty that Applicant has created.

## **II. CERTIFICATION OF COUNSEL**

As set forth in detail in the Gourvitz Declaration, Opposer's counsel has in good faith attempted to resolve the issues presented in this motion with Applicant's counsel for months, but has been unable to reach agreement with Applicant. Despite Opposer's good faith efforts, Applicant has refused to cure the deficiencies, or even to respond to Opposer's attempts to resolve these issues in a timely manner. Accordingly, with the close of discovery rapidly approaching, Opposer now files this motion because it believes that further attempts to resolve these discovery disputes will be entirely unproductive.

## **III. FACTS**

### **A. Background**

On June 20, 2006, Tiffany Koury filed U.S. Application Serial No. 78/912,427 to register TIFFANY KOURY for "[c]lothing, namely, dresses, ponchos, bathing suits, bikinis, swimwear, lingerie, underwear, and belts" in International Class 25, claiming a first use date of June 15, 2005 and a first use in commerce date of October 1, 2005. On December 4, 2007, Opposer, owner of numerous trademarks for its famous TIFFANY and TIFFANY & CO. marks for a variety of goods and services, opposed the application based on fraud, and more specifically on the basis that Applicant was not using the mark on all of the goods set forth in her application as of the dates alleged.

On January 12, 2008, Applicant filed her Answer to the Notice of Opposition, and on February 14, 2008 moved for leave to file an amended answer, which was granted on May 9, 2008. Discovery also moved forward, and is set to close on August 10, 2008.

**B. Applicant's Failure to Properly and Fully Respond to Opposer's Discovery Requests**

On March 19, 2008 Opposer served its first set of interrogatories, requests for admission, and document requests on Applicant. (Gourvitz Decl. ¶ 2.) Applicant served her written responses and objections to each of these on April 21, 2008 (Exs. 1-2),<sup>1</sup> together with her initial document production: about fifty pages apparently consisting of two 2006 fliers, Applicant's driver's license and passport, an unidentified page from a 2006 catalog (or an advertisement), a 2007 catalog, and printouts of her application (including an undated photo) and third-party registrations from the PTO website. (Gourvitz Decl. ¶¶ 3-4.) Applicant objected to and did not substantively respond to Opposer's Interrogatories 26-27 on the basis that they "exceed[ed] the numbers [sic] permissible under the FRCP." (Ex. 1 at 14.)

On April 24, 2008 Opposer sent a letter to Applicant's counsel setting out the deficiencies in Applicant's responses and asking for a response by April 30, 2008. (Gourvitz Decl. ¶ 5; Ex. 3.) The next day Opposer served Applicant with a second set of interrogatories, requests for admission, and document requests. (Gourvitz Decl. ¶ 6; *see* Ex. 4.)

Applicant ignored the April 30 response date. (Gourvitz Decl. ¶ 7.) Opposer's counsel repeatedly followed up with Applicant's counsel in an attempt to resolve the dispute or at least get Applicant to further articulate the basis for her objections to Opposer's requests. (*Id.*) In an email exchange on May 14, 2008, Applicant's counsel asked "what items would satisfy your

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<sup>1</sup> Because Applicant inexplicably failed to reproduce each of Opposer's document requests before her responses, Opposer's requests are included with Applicant's responses in Exhibit 2.

client that the name [TIFFANY KOURY] was used on the class of goods as indicated in the application?” (*Id.* at ¶ 8; Ex. 5.) In response, Opposer’s counsel noted that it sought “proof that your client used her mark for each and every product set forth in her application as of the date claimed in her application. . . . the best way to demonstrate such use is through documentary evidence, such as a dated newspaper or magazine advertisement showing your client’s product bearing the TIFFANY KOURY mark.” (Ex. 5.)

Applicant promised to supplement her responses to Opposer’s first set of discovery requests, “at the same time, or before, [she] respond[ed] to [Opposer’s] Second Set of Requests.” (Gourvitz Decl. ¶ 9; Ex. 5.) She did not do so, but did provide written responses to Opposer’s second set of interrogatories and requests for admission on June 2, 2008. (Gourvitz Decl. ¶ 10.)<sup>2</sup> Because Applicant claimed that Opposer had exceeded its limit, she did not provide substantive responses to any of Opposer’s second set of interrogatories. (Gourvitz Decl. ¶ 11; Ex. 6.) She also did not produce written responses (or, for that matter, objections) to Opposer’s second set of document requests. (Gourvitz Decl. ¶ 10.) The same day, Applicant purported to supplement her initial document production by producing two pages of what appeared to be a 2006 brochure mentioning Applicant and offering small pictures of two dresses. (Gourvitz Decl. ¶ 14.)

Opposer’s counsel immediately sought to meet and confer with Applicant’s counsel about the interrogatory responses, asking her to provide her count of Opposer’s interrogatories, and noting that Applicant had not provided any response to Opposer’s deficiency letter, and had not supplemented responses to Opposer’s first set of discovery requests, as promised. (Gourvitz Decl. ¶ 15; Ex. 7.) In response, Applicant provided another thirteen pages of documents –

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<sup>2</sup> Notably, Applicant admitted in her answers to the requests for admission that she had not used TIFFANY KOURY in connection with many of the goods set forth in her application as of the first use and first use in commerce dates set forth in that application. (Gourvitz Decl. ¶ 12.)

purchase orders and invoices from 2005. (Gourvitz Decl. ¶ 16.) Applicant did not provide and still has not provided a privilege log. (*Id.* at ¶ 13.)

On June 3, 2008, Opposer's counsel again sent an email to Applicant's counsel, asking when Applicant would provide a written response to Opposer's deficiency letter, its full document production, the previously-promised supplemental responses to Opposer's first set of discovery requests, and her count of Opposer's interrogatories. (Gourvitz Decl. ¶ 17; Ex. 8.) Follow-up emails were sent on June 19, June 30, and July 14, 2008. (Gourvitz Decl. ¶ 17; Ex. 9.) Finally, on July 16, 2008 – almost three months after Opposer sent its first deficiency letter and more than a month after Applicant had promised to respond – in what appears to be nothing more than a half-hearted attempt to fend off the current motion to compel as discovery draws to a close, Applicant's counsel responded. (Gourvitz Decl. ¶ 18; Ex. 10.)

Unfortunately, all that was offered was a Supplemental Response to Opposer's first set of document requests (Gourvitz Decl. ¶ 18; Ex. 11), which failed to address any of the deficiencies in Applicant's responses to Opposer's interrogatories noted in Opposer's April 24, 2008 letter (*See* Ex. 3.) The Supplemental Response also failed to remedy the deficiencies in Applicant's responses to Opposer's document requests. (*See* Ex. 11.) As to the specific issues raised, Applicant's letter advised that it was sufficient to refer Opposer to Applicant's website rather than actually producing documents responsive to Opposer's requests. (Ex. 10 at 1.) As for Opposer's interrogatories, she stated that while Applicant "will not be bound by our count," she considered them to total, "at the most conservative," "in excess of ninety (90)." (*Id.*) She provided no substantiation of this count.

Given the impending close of discovery, Applicant's repeated failure to honor her agreements to respond to Opposer's deficiency concerns by a given date, Applicant's repeated

failure to provide a substantive response to most of Opposer’s stated deficiency concerns, and Applicant’s repeated mischaracterizations of the documents she has produced to date, Opposer reluctantly determined that any further attempts to meet and confer would be useless.

### ARGUMENT

**I. THE BOARD SHOULD COMPEL APPLICANT TO PROPERLY RESPOND TO OPPOSER’S REQUESTS OR PRECLUDE IT FROM RELYING ON DOCUMENTS OR OTHER EVIDENCE THAT WOULD BE RESPONSIVE TO THE INTERROGATORIES AND REQUESTS**

Federal Rule of Civil Procedure 37(a)(3)(B) states that if a party fails to answer a propounded interrogatory or document request, “the party seeking discovery may move for an order compelling an answer . . . [or] production.” Similarly, 37 C.F.R. § 2.120(e)(1) states that “if a party . . . fails to answer . . . any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion . . . for an order to compel . . . an answer, or production and an opportunity to inspect and copy . . .” *See also* TBMP § 523 (requirements and procedure for motion to compel discovery). “[A]n evasive or incomplete disclosure, answer, or response must be treated as a failure to disclose, answer, or respond.” Fed. R. Civ. P. 37(a)(4). Where a party fails to provide discovery, the Board may impose sanctions including prohibiting the disobedient party from introducing matters into evidence, drawing adverse inferences against the disobedient party, and even entering judgment against that party. TBMP § 411.04; *see also* 37 C.F.R. § 2.120(g); Fed. R. Civ. P. 37(b)(2)(A).

Here, Applicant has failed to respond in good faith to Opposer’s interrogatories and document requests. Applicant should be obligated to do so or be sanctioned accordingly.

## A. Interrogatories

### 1. *Applicant Must Verify Her Interrogatories*

The Federal Rules of Civil Procedure require the person “who makes the answers” to interrogatories to sign them. Fed. R. Civ. P. 33(b)(5); *see also* TBMP 405.04(c) (“[a]nswers to interrogatories must be signed by the person making them”). Here, while Opposer has requested that Applicant provide such a verification for her responses to its first set of interrogatories (Ex. 3 at 1), and while Applicant has promised to do so (Ex. 10), she has not.

### 2. *Applicant Must Identify Any Documents Produced or that it Intends to Produce in Response to Opposer’s Interrogatories*

Fed. R. Civ. P. 33(d) permits a party to produce documents in response to an interrogatory when its answer “may be determined by examining . . . a party’s business records . . . and . . . the burden of deriving or ascertaining the answer will be substantially the same for either party,” provided that the producing party “specif[ies] the records . . . in sufficient detail to enable the interrogating party to locate and identify them as readily as the responding party could.” *See also* TBMP § 405.04(b) (same). As the Board has noted,

a party may not rely on the option to produce business records unless it can establish that providing written responses would impose a significant burden on the party. Further, even if the responding party can meet this test and can identify particular documents in which the inquiring party will find its answers, the inquiring party must not be left with any greater burden than the responding party when searching through and inspecting the records. Often, this requirement will not be met, because the responding party will have greater familiarity with its own records and will generally have a lesser burden than the inquiring party when searching through the relevant records.

*No Fear Inc. v. Ruede D. Rule*, 54 U.S.P.Q.2d 1551, 1555 (T.T.A.B. 2000).

Here, Applicant stated that she would produce documents in response to Interrogatories 1, 2, and 23 (Ex. 1 at 1, 2, 12), but, despite Opposer’s request that Applicant identify the

documents responsive to each of these interrogatories (Ex. 3 at 1), she has not yet done so.<sup>3</sup> Accordingly, Opposer requests that the Board order Applicant to identify all such documents, and to produce them where they have not yet been produced.

3. *Applicant Must Respond to All of Opposer's Interrogatories*

Trademark Rule § 2.120(d)(1) states that “[t]he total number of written interrogatories which a party can serve on another party” normally “shall not exceed seventy-five, counting subparts.” In determining whether the number of interrogatories served by a party exceeds the limit, the Board counts each subpart separately. *See* TBMP § 405.03(d). However, “[i]f an interrogatory requests ‘all relevant facts and circumstances’ concerning a single issue, event, or matter; or asks that a particular piece of information . . . be given for multiple years, and/or for each of the responding party’s involved marks, it will be counted as a single interrogatory.” *Id.* Here, Applicant started objecting to the interrogatories on the basis that they had “exceed[ed] the number[] permissible under the FRCP” at Interrogatory 19. (Ex. 1 at 11.) Despite Opposer’s clarification in its April 24, 2008 letter that the Trademark Rules permitted seventy-five interrogatories rather than the twenty-five permitted by the Federal Rules of Civil Procedure (Ex. 3 at 1), Applicant subsequently refused to answer any of the interrogatories in Opposer’s second set of interrogatories on this basis. (Ex. 6.) In response to Opposer’s requests for Applicant’s count, Applicant said that, while she “will not . . . be bound by [her] count,” “at the most conservative” Opposer’s interrogatories “total in excess of ninety (90).” (Ex. 10.)

By Opposer’s count (treating each numbered or lettered subpart of an interrogatory as a separate interrogatory, each part of a compound interrogatory as a separate interrogatory, and each issue on which information was sought as a separate interrogatory, but treating each requests for all facts and circumstances concerning a single issue, event, or matter as a single interrogatory, TBMP

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<sup>3</sup> Indeed, leaving aside the question of whether Opposer can derive the requested information from Applicant’s documents substantially as easily as Applicant, *e.g.*, *No Fear*, 54 U.S.P.Q.2d at 1555, Applicant does not yet appear to have produced documents sufficient to show, *e.g.*, each product it has sold under Applicant’s mark to date, the date of first sale for each product, the dates any such products were discontinued, and why they were discontinued.

§ 405.03(d)), Opposer believes that its interrogatories number fifty-six at most (Gourvitz Decl. ¶ 19; Ex. 12) – well within the limit provided by the Trademark Rules of Practice. 37 C.F.R. § 2.120(d)(1); TBMP § 405.03(d). While Applicant states that “were our client to answer certain interrogatories with regard to each product offered for sale . . . this number would increase dramatically and easily climb into the hundreds” (Ex. 10), she fails to identify the interrogatories purportedly at issue, or any authority holding that an interrogatory asking about, *e.g.*, “each” of the products set forth in an applicant’s application should be counted as a separate interrogatory for each such product. In fact, this is not the case. *See* TBMP § 405.03(d) (“[i]f an interrogatory . . . asks that a particular piece of information . . . be given for multiple years, and/or for each of the responding party’s involved marks, it will be counted as a single interrogatory”).<sup>4</sup>

Accordingly, Opposer requests that the Board order Applicant to submit proper and full responses to each of Opposer’s interrogatories without further delay. In the alternative, if the Board determines that Opposer has exceeded its seventy-five interrogatory limit with its interrogatories to date, Opposer requests that the Board permit it to exceed that limit. *See* 37 C.F.R. § 2.120(d).

4. *Applicant Must Remedy its Deficient Interrogatory Responses*

*Interrogatory 2*

Opposer’s Interrogatory 2 asked Applicant to identify each product it had sold under its mark to date, state the date of first sale for each such product, and, for any discontinued product, state the date of and reason for its discontinuance. In response, Applicant offered no objections, but merely referred Opposer to its document production. (Ex. 1 at 2.) Not only has Applicant not yet identified documents responsive to this request (*see* section (2) *supra*), it has not produced documents responsive to the request. Moreover, it seems unlikely that Opposer could obtain this information from Applicant’s records as easily as Applicant. Fed. R. Civ. P. 33(d);

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<sup>4</sup> Similarly, Opposer’s Request 30 seeks “all relevant facts and circumstances” concerning a “single issue, event, or matter,” TBMP § 405.03(d), namely, why Applicant choose to delete certain products from its application. (*See* Ex. 6 at 2-3.)

TBMP § 405.04(b); *No Fear*, 54 U.S.P.Q.2d at 1555. Under the circumstances, Applicant should be ordered to provide a substantive written response to this interrogatory.

*Interrogatories 4-6*

Opposer's Interrogatory 4 asked Applicant to identify all venues where each of the products sold under its mark are, had been, or will be offered for sale, Interrogatory 5 asked it to set forth the wholesale and retail prices of each product sold or to be sold under its mark, and Interrogatory 6 asked it to describe the advertisements for the goods it sells or intends to sell under its mark, and how the mark is or is intended to be used in connection with each such ad. Applicant objected to each of these requests as irrelevant to an opposition based on fraud, and refused to provide an answer (Ex. 1 at 3-4), even after Opposer explained that each was relevant to whether Applicant had made *bona fide* use of the mark. (Ex. 3 at 2.)

Because these interrogatories request that Applicant substantiate how it purportedly made and makes *bona fide* use of its mark in connection with each product in its application (e.g., where each product set forth in the application was sold, the price at which each product was offered, and how the product was advertised), and also could lead Opposer to people or entities (e.g., stores or advertisers) with knowledge of this information, the requests are relevant to Opposer's fraud claim, and Applicant should be ordered to provide substantive written responses to each interrogatory.

*Interrogatories 15-18*

Opposer's Interrogatory 15 asked Applicant to describe the basis for the denial in her answer that she "had not used the TIFFANY KOURY mark in commerce in connection with each of the goods identified in the Application as of the dates alleged in the application," Interrogatory 16 asked her to describe the basis for her denial that the statement of use in her application "was . . . false and known to be so when made," Interrogatory 17 asked her to describe the basis for her denial that she "knowingly, willfully and in bad faith made false and fraudulent statements in connection with [her application] in an attempt to deceive the PTO and in order to obtain a registration," and Interrogatory 18 asked her to describe the basis for her

denial that her “allegation of use in connection with all of the items identified in [the] [a]pplication was falsely made . . . for the purpose of inducing the Patent and Trademark Office to register the mark.” In response to each of these, Applicant did not object, but merely referred to her answer to Opposer’s Interrogatory 14, an answer that is entirely non-responsive. (Ex. 1 at 8-10; *see* Ex. 3 at 3.) Obviously, Applicant is exclusively in possession of any evidence that supports her own denials of the facts alleged in the notice of opposition. If she claims that there was no fraud, she should be prepared -- and obligated -- to back up that claim with facts.

#### *Interrogatories 19-20*

Opposer’s Interrogatory 19 asked Applicant to describe the basis for the denial in her answer that her conduct “constitutes fraud on the Patent and Trademark Office,” and Interrogatory 20 asked her to describe the basis for her denial that, “[a]s a result of Applicant’s false statement, Applicant’s mark has been passed to publication and may issue to registration.” In response to each, Applicant objected only on the basis that the interrogatories had “exceed[ed] the numbers permissible under the FRCP,” and again referred to her answer to Opposer’s Interrogatory 14, which was entirely unrelated. (Ex. 1 at 10-11.) Because Applicant’s count of the interrogatories was based on the mistaken assumption that Opposer was limited to twenty-five interrogatories, because Opposer did not actually exceed its limit with these interrogatories (*see* section (3) *supra*), and because Applicant’s answer was and remains non-responsive, she should be ordered to provide substantive written responses to both interrogatories.

#### *Interrogatory 24*

Opposer’s Interrogatory 24 asked Applicant about the basis for her defenses of acquiescence and estoppel. In response, Applicant objected on the basis that the interrogatories had “exceed[ed] the numbers permissible under the FRCP,” and referred to her answer to Opposer’s Interrogatory 12, which included an objection on the basis that the interrogatory was irrelevant and contains “self serving legal conclusions.” (Ex. 1 at 7, 13.) As noted above, Applicant’s count of the interrogatories was improper, and Opposer did not exceed its limit. Moreover, Applicant has offered and can offer no reason why affirmative defenses that *she*

*herself advanced* are or should be considered irrelevant, or why an interrogatory seeking the basis for these defenses should be considered “self serving.”

## **B. Document Requests**

As detailed below, Applicant has raised spurious objections in its written responses, failed to produce a privilege log, and either stonewalled or refused to provide – or even identify – documents in response to many of Opposer’s reasonable document requests.

### *1. Applicant Must Produce Documents in Response to Opposer’s Second Set of Document Requests*

First, while Opposer served Applicant with a second set of document requests (Ex. 4), Applicant never provided any written response to these requests, or produced any documents that it indicated were responsive to these requests. (Gourvitz Decl. ¶ 10.) The responses were due May 30, 2008. (See Ex. 4.)

Given this failure, Opposer requests that Applicant be found to have forfeited her right to object to these requests on their merits, and be ordered to produce all documents responsive to each of those requests at the offices of Opposer’s counsel within fourteen days. See TBMP § 406.04(a); *No Fear*, 54 U.S.P.Q.2d at 1555-56.

### *2. Applicant Must Produce Electronically-Stored Documents Where Applicable*

In responding to document requests, including requests seeking electronically-stored information, a party producing documents must “produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request.” Fed. R. Civ. P. 34(b)(2)(E); TBMP § 406.04(b). Here, in response to Opposer’s Document Requests 1, 2, 4, 5, and 6, Applicant referred Opposer to unspecified pages on her website. (Ex. 2 at 1-2.) Moreover, while Applicant has sent a few scanned documents to Opposer in PDF form, and while in June she provided one video commercial, she does not yet

appear to have produced any of her business emails, or any other electronic documents, in response to Opposer's relevant discovery requests.

Opposer expressed its concerns about this issue in its April 24, 2008 letter. First, it noted that while "your client maintains emails or other electronically stored information relating to her business that are responsive to the discovery requests," Applicant had not provided any such documents. (Ex. 3 at 3.) Next, as for Applicant's answers referring to its website, Opposer noted that "[i]t is not our . . . obligation to hunt through your client's website to determine what is or is not relevant to our document requests," and asked that Applicant "produce documents or identify documents with specificity that are responsive to the requests." (*Id.*)

In her response almost three months later, Applicant's counsel said "reference to the website is clearly responsive to this request," and that "I have requested that the website be electronically stored on disc and upon my receipt of same I will forward it to you," but she did not agree to identify or produce any specific pages responsive to specific requests. (Ex. 10.) Applicant's supplemental discovery responses did not remedy these deficiencies (*see* Ex. 11), and to date Applicant still has not produced any such documents.

3. *Applicant Must Remedy its Deficient Responses to Opposer's First Set of Document Requests and Produce Documents Where Appropriate*

*Request 2*

As noted above, in response to this Request, which sought documents sufficient to identify all goods sold or intended to be sold by Applicant in connection with its mark, Applicant did not object, or produce or identify any specific documents, but merely referred Opposer to her website. (Ex. 2 at 1.) Opposer noted that this response was improper (Ex. 3 at 3) and, after repeated follow-up, Applicant first said that two more pages, one of which had small pictures of two dresses, were responsive (*see* Gourvitz Decl. ¶ 14), and later claimed that part of its

production (described as a “Look Book,” but not identified by Bates ranges) was responsive to this Request (Ex. 11 at 1). However, Applicant still has not produced or identified documents that fully respond to this request. She should be ordered to do so.

*Request 3*

In response to this truly critical Request, which sought documents sufficient to show Applicant’s date of first use of its Mark on or in connection with each of the goods set forth in her Application, and how the mark was used on or in connection with each such product as of the date of first use, Applicant referred only to (i) “Invitations to Trunk Shows” in her production, (ii) portions of her application provided in her production, and (iii) her application on the PTO website. (Ex. 2 at 1-2.) As Opposer noted, none of these documents substantiated Applicant’s date of first use for each of the goods set forth in her application, and Applicant failed to identify any documents showing how the mark was used on or in connection with each such product as of the date of first use. (Ex. 3 at 3.) A small supplemental production did not cure the deficiency.

If Applicant does not have documents responsive to this request she must say so, and an adverse inference should be entered that in fact Applicant has no documents to support her claimed date of first use for each of the goods set forth in her application. Fed. R. Civ. P. 37(b)(2)(A); 37 C.F.R. § 2.120(g); TBMP § 411.04.

*Requests 4-6*

In response to Opposer’s requests for documents sufficient to show (i) each version of Applicant’s mark she has used or intends to use for the goods in her Application, (ii) a sample (or high-quality photo) of each product sold or intended to be sold under her mark, and (iii) a sample of each “label, package, tag, brochure, price list, catalog, display, or other item” bearing her mark, Applicant again merely referred Opposer to her website and “Look Book.” (Ex. 2 at

2.) Opposer again noted that this response was deficient (Ex. 3 at 4), but Applicant has to date refused to provide or identify documents responsive to these requests.

*Request 14*

Opposer's Request 14 sought documents sufficient to show Applicant's annual sales for each product she offered under her mark since her date of first use. Applicant objected and refused to produce any responsive documents. (Ex. 2 at 2.) Clearly, this request was relevant to whether the mark was used on all of the goods in the application as of the claimed first date of use (if at all), and hence directly relevant to its fraud claim. (Ex. 3 at 4.)

*Requests 15-16*

Opposer's Request 15 sought documents sufficient to show Applicant's advertisements for its goods sold in connection with its mark, and how the mark is or was used in each, while Request 16 sought documents sufficient to show how and where Applicant advertises or intends to advertise those goods. Applicant objected to both as being "inapplicable." (Ex. 2 at 2-3.) But advertising indicates use, which is directly relevant to Opposer's fraud claim. (See Ex. 3 at 4.)

*Request 23*

Opposer's Request 23 sought all documents (including emails) concerning Opposer. Applicant objected on the basis of privilege. (Ex. 2 at 3.) But while Opposer requested a privilege log (Ex. 8 at 4), Applicant has not provided it or agreed to do so. To the extent documents responsive to this request are privileged, Applicant should be ordered to do so. See Fed. R. Civ. P. 26(b)(5); *Red Wing Co. v. J.M. Smucker Co.*, 59 U.S.P.Q.2d 1861, 1864 n.5 (T.T.A.B. 2001) (party making a claim of privilege must do so expressly and otherwise describe the nature of the documents, communications, or things not produced or disclosed in a manner enabling the other party to assess the applicability of the claim of privilege without disclosing the

privileged information itself). To the extent they are not privileged, they should be produced.

*Requests 27-33*

Opposer's Requests 27-33 sought documents supporting or contravening certain statements in Applicant's answer to the notice of opposition, denying that her application was fraudulent. In response to each Applicant did not object, but merely referred to her response to Request 3, which in turn referred to (i) portions of her application provided in her production, and (ii) her application on the PTO website. (Ex. 2 at 1-4.) Opposer noted that this response was insufficient, and that Applicant was obligated to produce documents supporting her claimed dates of use of her mark for each product in her application. (Ex. 3 at 4-5.) Nevertheless, Applicant still has not remedied this response or agreed to do so. (See Ex. 11 at 4.)

*Request 36*

Opposer's Request 36 sought documents supporting or contravening Applicant's affirmative defenses of acquiescence and estoppel. In response, she said "[s]ee attached items from the Trademark Electronic Search System." (Ex. 2 at 4.) But while, in response to Opposer's request, she confirmed that this answer referred to the third-party registrations in her document production (*see* Ex. 11 at 4), she refused to confirm, as requested (Ex. 3 at 5), that these were "the only documents that support your affirmative defense." She must do so, or be precluded from introducing further documents in support of these defenses.

**II. THE BOARD ALSO SHOULD SUSPEND THIS CASE WITH RESPECT TO ALL MATTERS NOT GERMANE TO THIS MOTION**

Opposer also requests that, as required by 37 C.F.R. § 2.120(e)(2), the Board suspend this case with respect to all matters not germane to this motion during the pendency of the motion.

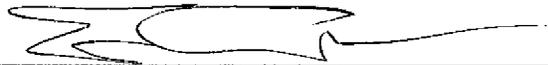
**CONCLUSION**

Given the information and argument above, Opposer respectfully requests that its motion be granted in its entirety, and that Applicant be ordered to: (1) respond properly and fully to the Requests; (2) produce all documents in her possession, custody, or control responsive to Opposer's document requests; and (3) confirm for each document request for which she has no responsive documents that such is the case, within fourteen (14) days of the Board's Order.

Opposer also respectfully requests that the Board order that (1) if Applicant has any evidence responsive to the Requests that she does not produce forthwith she shall be precluded from offering that evidence at trial, and an adverse inference that she has no such responsive evidence shall be entered, and (2) if Applicant fails to comply with her obligations above, judgment shall be entered against her.

Dated: New York, New York  
August 1, 2008

FROSS ZELNICK LEHRMAN & ZISSU, P.C.



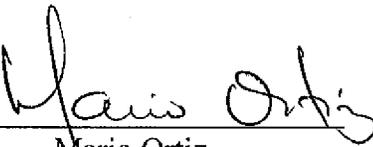
By: Barbara A. Solomon  
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Attorneys for Opposer  
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New York, New York 10017  
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Fax: (212) 813-5901

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 1, 2008, a true and correct copy of the attached OPPOSER'S MOTION TO COMPEL AND DETERMINE SUFFICIENCY AND MEMORANDUM IN SUPPORT THEREOF, the DECLARATION OF EVAN GOURVITZ IN SUPPORT OF OPPOSER'S MOTION TO COMPEL, and its Exhibits 1-12, were served by First Class Mail, Postage Prepaid, on Applicant's counsel at:

Kathy Lane, Esq.  
Newman Dichter LLP  
505 Fifth Ave South, Suite 610  
Seattle, WA 98104

Kathy Lane, Esq.  
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488 Madison Avenue, 10<sup>th</sup> Floor  
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Mario Ortiz