

ESTTA Tracking number: **ESTTA318421**

Filing date: **11/23/2009**

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

Proceeding	91189629
Party	Plaintiff Borghese Trademarks Inc.
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Attachments	Opposer's Reply in Support of Request for Discovery.pdf ( 6 pages )(257021 bytes )

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

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Borghese Trademarks, Inc.

Opposition No.: 91189629

Opposer,

Mark: PRINCE LORENZO  
BORGHESE'S LA DOLCE VITA

v.

Application No.: 77/435,171

Multi Media Exposure, Inc.

Applicant.

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**OPPOSER'S REPLY IN SUPPORT OF ITS REQUEST FOR DISCOVERY PURSUANT  
TO RULE 56(F)**

Opposer, Borghese Trademarks, Inc. ("Opposer"), respectfully moves this Honorable Board for leave to file a reply brief in support of its Request for Discovery Pursuant to Rule 56(f).

**Preliminary Statement**

Applicant's summary judgment motion contains numerous unsupported claims regarding channels of trade and dissimilarity of the relevant goods—unsupported as no evidence has been provided by Applicant in response to Opposer's discovery requests. In addition, Applicant included a Declaration signed by its vice president, within which are made unsubstantiated claims. Opposer needs the information referred to in its Rule 56(f) Request for Discovery in order to effectively oppose Applicant's motion for summary judgment.

**Discovery is required in order to properly respond to Applicant's summary judgment motion.**

Applicant's statement that none of Opposer's discovery demands are tailored to address any of the DuPont factors strains credulity. Nothing could be farther from the truth. Opposer's specified discovery requests relate to channels of trade, the formulation of the goods, marketing and promotional materials, and admissions concerning the similarity of the goods and the connection with the Borghese family. As reiterated below, this information is necessary in order to properly defend against the claims made in Applicant's summary judgment motion.

**Discovery related to channels of trade.**

As one of the factors Applicant used to support its "no likelihood of confusion" argument in its summary judgment motion, Applicant claimed that the channels of trade were different for its goods and Opposer's goods. Since the channels of trade are not limited in either Applicant's application or Opposer's registration, they may be considered substantially identical. Indeed, Applicant cites Guardian Products Company, Inc. v. Scott Paper Company, 200 USPQ 738, (TTAB 1978) for the premise that "the Board presumes that the goods recited in a registration 'are or can be sold through all of the trade channels that can be utilized for such goods.'" And, although it refused to provide answers to Opposer's discovery questions regarding the intended channels of trade for its goods, Applicant happily manages to include some channels of trade in the declaration attached to its summary judgment motion and makes the unconvincing argument that even if its goods were sold in the same places as Opposer's goods (i.e. department stores, spas, drug stores, pharmacies and over the Internet) they would be sold "in a department or aisle quite separate and apart..." and so, therefore, Opposer does not need discovery pertaining to channels of trade. 1

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1 Channels of trade cannot be looked at in the abstract only considering the subject goods, but must also look at

Opposer notes that in today's world of big box stores (i.e. Walmart, B.J.'s, Costco, etc.) and online shopping (i.e. Home Shopping Network, QVC, companies "shop" web pages) the lines regarding "channels of trade for goods of that type" have become blurred and there is a greater chance consumers will consider confusingly similar marks related when they see them in the same store or website regardless of aisle. Specifics are needed. It is obvious the information about Applicant's channels of trade exists and that information is under its control. What is not so obvious is why Applicant is doing its utmost to prevent Opposer from obtaining that information. It smacks of having something to hide. Although in its summary judgment response Opposer could argue the channels of trade factor in the abstract, thereby wasting the Board's time, it does not have the actual information which would prove its point that there are genuine issues of material fact with regard to a likelihood of confusion between the marks, based on this particular DuPont factor.

**Other relevant discovery.**

As for Applicant's claim that the other areas of Opposer's proposed discovery are irrelevant, that statement, too, is ludicrous. Opposer's request regarding ingredients in the products goes to the relatedness and similarity of the respective goods. The remaining specified discovery requests concerning Applicant's promotional, advertising and marketing materials address Applicant's attempts to associate itself with Princess Marcella Borghese, the founder of Opposer's line of goods and one of the marks at issue in this case. This information goes directly to the likelihood of confusion issue as it can prove Opposer's point that Applicant is attempting to create in consumers an association between Applicant and the name and trademark of Princess Marcella Borghese. It is clear why Applicant does not want to supply Opposer with

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related goods. Clearly, the parties goods may be considered related as evidenced by registrations/applications for pet goods and other goods by Ralph Lauren, Martha Stewart, Paul Mitchell, Brooks Brothers, etc.

answers to these discovery requests, because the answers go directly to prove that consumers are more likely rather than less likely to be confused and assume that Applicant's goods are somehow related to or licensed by Opposer.

Applicant claims Opposer's discovery requests are "an expensive fishing expedition." Yet it would rather go to the trouble and expense of filing a summary judgment motion rather than simply respond to discovery with the documents and information that we know now do exist. As explained earlier, while Opposer may argue the points raised in Applicant's summary judgment motion as general issues in the abstract, that will do nothing to assist the Board in determining whether a likelihood of confusion exists between the marks that are the subject of the present matter. The DuPont factors "each may from case to case play a dominant role." In re E.I. DuPont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973). The factors that Opposer believes play a dominant role in this case, in addition to the similarity of the marks as to appearance, sound, connotation and commercial appearance, include the similarity of the goods, the similarity of the trade channels, the extent of potential confusion and the market interface between the parties. In its Request for Discovery under Rule 56(f), Opposer has limited its requests to those discovery questions that are most directly related to these dominant DuPont factors.

**Potential deposition of declarant.**

The TBMP clearly states that "an adverse party may have an opportunity for direct examination of the [declarant], if a Fed. R. Civ. P. 56(f) motion to take the discovery deposition of the [declarant] is made and granted." TBMP §528.06. The TBMP also states that affidavits/declarations may be submitted in support of a summary judgment motion provided that they "set forth such facts as would be admissible in evidence." TBMP §528.05(b). The

declaration is full of statements by Applicant's vice president that are not made on personal knowledge but rather are gleaned from Internet downloads referred to in and attached to the declaration. As far as Opposer is aware, Applicant is not a veterinarian, dermatologist, zoologist, or marketing expert who could make the sort of claims as declarant has made. Furthermore, the internet downloads attached to the declaration in support of the summary judgment motion are not allowable evidence in the nature of "official records" or "printed publications." Therefore, Opposer respectfully renews its request that it be granted the opportunity to depose the declarant.

**Opposer's request for discovery did not include a response to the summary judgment motion.**

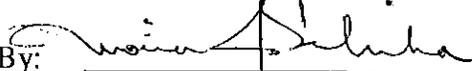
Applicant's claim that Opposer has responded to the summary judgment motion on its merits is nothing short of disingenuous. Applicant appears to be referring to a parenthetical statement within a longer sentence. How Applicant could equate a parenthetical statement—within a declaration, in support of a request for discovery—as a *substantive* response to a summary judgment motion is astonishing. Opposer respectfully requests that the Board give no consideration to that feeble argument.

**Conclusion**

In light of the above, Opposer's Request for Discovery Pursuant to Rule 56(f) should be granted in all respects.

Dated: November 23, 2009

BAKER AND RANNELLS, P.A.

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing OPPOSER'S REPLY IN SUPPORT OF ITS REQUEST FOR DISCOVERY PURSUANT TO RULE 56(F) in re: Borghese Trademarks, Inc. v. Multi Media Exposure, Inc., Opposition No. 91189629, was served on counsel for Applicant, this 23<sup>rd</sup> day of November, 2009, by sending same via First Class Mail, postage prepaid, to:

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Moira J. Selinka