

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

IN THE MATTER OF APPLICATION SERIAL NO. 78/671,246
PUBLISHED IN THE OFFICIAL GAZETTE ON MAY 9, 2006

THIERRY MUGLER PARFUMS S.A.S.,)	Opposition No.: 91172690
)	
Opposer,)	
)	
v.)	
)	
DUDLEY PRODUCTS, INC.,)	
)	
Applicant.)	

**APPLICANT'S OPPOSITION TO OPPOSER'S
MOTION TO COMPEL DISCOVERY**

Applicant, Dudley Products, Inc., by and through its attorneys Burton S. Ehrlich of Ladas & Parry LL P, herein responds to the Opposer's Motion to Compel as follows:

The Applicant has moved to compel Interrogatory answers over objections, including an objection that the Interrogatories propounded exceed the allowable maximum number, including subparts (without prior leave of the Board) TMBP \$405.02. The Applicant noted in its objections served on November 9, 2007 that the Opposer's set of Interrogatories when conservatively counted were at least ninety-five (95) questions, including subparts.

Several grounds, as will be discussed exist for the denial of the Opposer's Motion; including that the Interrogatories



03-24-2008

exceed the maximum seventy-five (75) number permitted by the Board, without leave from the Board for serving excess numbers beyond 75; that the Opposer did not diligently file its Motion or even respond to the objection of the Applicant which was served on November 9, 2007; that discovery has long since closed in these proceedings on March 24, 2007, without the Opposer ever asking for any extension of the discovery time period; that Opposer did not file the Interrogatories as served upon Applicant which is a required exhibit to Opposer's Motion; and that the Opposer's counsel seeks to unilaterally require responses with confidential information, while refusing to accept the automatic Protective Order entered by the Board in these proceedings (as shown by Opposer's Exhibit A to Opposer's Motion where in a letter dated January 31, 2008 in the last paragraph of the letter the Opposer's counsel refuses the Board's Standard Protective Order applicable to every case as "too ownerous" and refuses to accept that Standard Protective Order while instead mandating its own Protective Order).

On November 9, 2007 the Applicant's counsel served its objections to the Interrogatory questions Nos. 1-21 upon Opposer's counsel. The Applicant's counsel noted that pursuant to 37 CFR §2.120(d) and TBMP §405, the Applicant objected to the excessive number of the Interrogatories served by the Opposer on the Applicant, with the Opposer's Interrogatories when counted

exceeding at least ninety-five (95) questions, including the counting of subparts (see Exhibit 1 showing this pertinent objection in the response). The numerical limits in the USPTO Rule pertains to the total number of questions in Interrogatories with subparts as limited to seventy-five (75), to be served by a party over the course of an entire proceeding. TBMP §405.02. As the Board has noted a party should not answer the first seventy-five (75) Interrogatories and object to the rest as excessive. The Applicant also incorporated its general objections in its responses and reserved the right to assert other generalized or specific objections to the Interrogatories should it become necessary or appropriate to respond further to the Interrogatories. The fact that the total number of the Interrogatories, including subparts exceeded seventy-five (75) may be easily demonstrated by the number of Interrogatory questions themselves, the number of subparts to the Interrogatories bearing letters and by simply examining Interrogatory No. 21. The Interrogatories themselves count twenty-one (21) Interrogatories; with Interrogatory No. 2 having eight (8) lettered subparts; Interrogatory No. 4 having two (2) lettered subparts; Interrogatory No. 5 having three (3) lettered subparts; Interrogatory No. 7 having four (4) lettered subparts; Interrogatory No. 9 having five (5) lettered subparts; Interrogatory No. 10 having five (5) lettered subparts;

Interrogatory No. 11 having five (5) lettered subparts;
Interrogatory No. 12 having four (4) lettered subparts;
Interrogatory No. 14 having two (2) lettered subparts;
Interrogatory No. 15 having three (3) lettered subparts. This gives rise to already, just by counting the Interrogatories and the lettered subparts, a total of sixty-two (62) questions. The twenty-one (21) Interrogatories including forty-one (41) lettered subparts would by themselves give rise to sixty-two (62) Interrogatories. However, Interrogatory No. 21 by itself asks for the person most knowledgeable of the information stated in the above twenty Interrogatories and their subparts which could give rise to another sixty-two (62) Interrogatories and would now give rise to one-hundred twenty-two (124) Interrogatories. However, just counting the Interrogatories and their lettered subparts does not give rise to the full measure of the numbered Interrogatories being propounded in that many of the Interrogatories, such as Interrogatory No. 4, which has two numbered subparts in 4(a) refers back to another two Interrogatories for responding on various information, or includes Interrogatory questions where the last numbered subpart requires the Applicant to respond to all the prior subparts (i.e. Interrogatory 2(h)). The Interrogatories also include questions that otherwise appear to be a single Interrogatory, but actually consists of a number of subpart questions, such as

Interrogatory No. 6, or Interrogatory No. 20. Furthermore, some Interrogatories include compound subparts requiring that a multitude of information be answered and then the Interrogatory question itself continues into a series of lettered subparts, such as Interrogatories Nos. 10, 11, 12, or 13. The total number of questions with subparts as counted by the Applicant total at least one-hundred twenty-five (125), as shown on Exhibit No. 2 which counts the number of Interrogatories and subparts, but actually the count could be quite higher.

Furthermore, the Opposer's Motion should be denied as not being diligent. Discovery closed on March 24, 2007. While the parties agreed to extend time for responding to outstanding discovery because of protracted settlement discussions it must be considered that back in October 2007, the Opposer objected to a twenty-one (21) day extension of time for responding to outstanding discovery, which objection by the Opposer was later denied. While Opposer seems to otherwise be in a hurry to deny the Applicant a relative routine extension and argue that extension before the Board, the Opposer failed to timely move against the response to the Interrogatories, timely filed by the Applicant on November 9, 2007. Even though discovery had closed in March 2007, the Opposer waited months after the November 9, 2007 Applicant's response at issue to even write a letter to the Applicant's counsel or move to compel any responses. Instead of

diligently moving after the supposed troublesome responses were received on November 9, 2007 and with discovery closed on March 24, 2007, the Opposer instead waited until February 29, 2008 to bring the Motion to Compel and until January 31, 2008 to even write a letter to the Applicant's counsel arguing about the Applicant's November 9, 2007 responses. In fact, the meet and confer conference did not occur until February 28, 2008 more than three and a half months after the responses at issue were served and with discovery having been closed nearly one (1) year prior to the holding of the meet and confer conference. These circumstances should not be considered to provide for the required diligence in the bringing of a Motion to Compel, which typically are required prior to the close of discovery, but certainly require a diligent filing after a troublesome response is filed where discovery has already closed. Furthermore, at no time did the Opposer ever move to extend the close of the discovery time period, or despite the notice of the objection received November 9, 2007 to move to diligently seek the Board's approval of Interrogatory questions in excess of seventy-five (75).

Given the delay the granting of such unilateral discovery to Opposer at this point in the proceeding would severely prejudice Applicant and potentially negatively impact these judicial proceedings.

In addition to the number of Interrogatories exceeding the maximum number, and the non-timeliness of any objection, or Motion, or the seeking of a discovery time period extension, or the seeking of the Board's approval of leave to serve Interrogatories in excess of seventy-five (75), it should also be noted that the Opposer is now also seeking responses from the Applicant which includes confidential information, when the Opposer itself is refusing to comply with the Board's standard Protective Order and where the Applicant also earlier raised a confidentiality objection. Exhibit A of the Opposer's counsel's Motion in the last paragraph of the letter shows the Opposer's counsel's refusal to comply with the Board's Standard Protective Order as being "too ownerous"

The granting of a Motion to Compel under the present circumstances would be highly prejudicial to the Applicant. The Applicant itself has many gripes about the discovery performance of the Opposer, including the Opposer's unilateral refusal to comply with the Standard Protective Order required by the Board in these proceedings. It is respectfully requested that Opposer's Motion to Compel be denied for the multiple grounds asserted herein with the Opposer having not sought to have extended discovery, the discovery time period should remain closed, and that the Opposer be required to move into its testimony period (based upon the limitations contained) within

its prior discovery disclosures to Applicant. Should the Board decide that a Motion to Compel at this point in the proceedings is allowable or grant the Motion then it is respectfully requested that the Board remove some of the prejudice to Applicant and provide for potential mutual relief by reopening discovery to also allow the Applicant to move, as may be necessary, on Applicant's outstanding discovery issues. In any event, it is requested that the Board mandate the Board's Standard Protective Order for all future proceedings in this case and require that the Opposer comply with that Protective Order (and make all disclosures required under the Protective Order or face sanctions against the use of any information not provided in discovery or under the Standard Protective Order).

Respectfully submitted,



By One of The Attorneys
For The Applicant

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to ATTN: TTAB; Assistant Commissioner for Trademarks, U.S. Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451 on this 20th day of March, 2008.



Burton S. Ehrlich

CERTIFICATE OF SERVICE

The undersigned, one of Applicant's attorneys, hereby certifies that on March 20, 2008, he caused a true and correct copies of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY to be served upon Opposer's counsel by First Class mail, postage pre-paid, at the following address:

Mary Catherine Merz
Ameen Imam
Merz & Associates, P.C.
1140 Lake Street
Suite 304
Oak Park, Illinois 60301-1051



Burton S. Ehrlich

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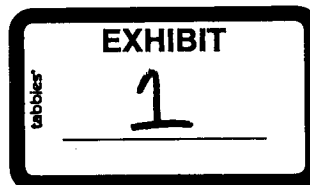
**APPLICANT'S ANSWERS TO OPPOSER'S
FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, the Applicant, Dudley Products, Inc. (Applicant) hereby responds and objects to the OPPOSER'S FIRST SET OF INTERROGATORIES, Nos. 1 through 21 as follows:

GENERAL OBJECTIONS

(1) Applicant objects to Opposer's questions to the extent that they purport to impose any duty on Applicant inconsistent with, or beyond that specified in the Federal Rules and Civil Procedure. This objection is pertinent to each of the Opposer's Interrogatories.

(2) Applicant further objects to the entire set of Interrogatories on the basis that at times the Opposer has not limited questions to a specified time period covered by the



application being opposed in these proceedings, or even subject matter covered by the application at issue. Some of the requested information is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence, and is further overly broad, burdensome and oppressive in that it requires an accumulation of information potentially on other subject matter and would cause Applicant to peruse virtually all corporate records over a lengthy time period.

(3) Further, Applicant objects to providing any information which is immune from discovery and may be protected by the attorney-client, work-product, or other privilege.

(4) Applicant objects to any Interrogatories requiring or purporting to require the search of the files of others. Applicant is not required to search and provide documents from independent, third parties under the Federal Rules.

(5) Applicant objects to providing information or documents to the extent they contain information regarded as confidential, proprietary or trade secrets. The Applicant will agree to a reasonable Protective Order to maintain the confidentiality of such information.

(6) Applicant bases its responses upon its present knowledge (a) without conceding relevancy or materiality of any requests, (b) without prejudice to Applicant's right to object to

further discovery or proof of the subject matter, and (c) incorporates its general objections into each Answer.

Applicant reserves the right to change or supplement a response should it appear to be incomplete or incorrect, or if additional information should become available.

INTERROGATORIES

INTERROGATORY NO. 1

Set forth the date upon which applicant first used applicant's mark anywhere and the date upon which applicant first used applicant's mark in interstate commerce; if applicant is not currently using its mark, indicate this as well.

INTERROGATORY NO. 2

If applicant's answer to Interrogatory No. 1, above, includes a date of first use,

(a) list all of the products/services in connection with which applicant's mark has been used;

(b) list the manner in which applicant's mark has been used (e.g., brochures, marketing materials, point of sale displays, signage, labels directly attached to the goods, product packaging, etc.);

(c) state whether such use has been continuous since the dates of first use identified in response to Interrogatory No. 1; if such use has not been continuous, explain why such use has not been continuous;

(d) identify all types of purchasers of the products/services identified in response to Interrogatory No. 2(a) and describe with particularity the channels of trade in which such products/services are offered;

(e) identify the geographic location(s) (by city and state) in which sales, sales promotion and advertising have taken place for the products/services identified in response to Interrogatory No. 2(a)

(f) set forth the annual volume of sales in units and dollars for the products/services identified in response to Interrogatory No. 2(a), along with advertising expenses, for each year since the date of first use;

(g) set forth applicant's general sale price and/or suggested list price for each product/service identified in response to Interrogatory No. 2(a), from the date of first sale to present, indicating the dates upon which such prices were effective;

(h) identify all documents which relate to information stated in answer to subparts (a) through (g) of this Interrogatory.

INTERROGATORY NO. 3

List all of the goods/services in connection with which applicant intends to use applicant's mark, for which use has not yet begun.

INTERROGATORY NO. 4

(a) Indicate and identify all types of advertisements which applicant employs or intends to employ in advertising and promoting the products/services identified in response to Interrogatory Nos. 2(a) and 3, above; and

(b) Identify all documents which relate to the information stated in answer to subpart (a) of this Interrogatory.

INTERROGATORY NO. 5

For each product/service identified in response to Interrogatory No. 2(a), above:

(a) describe with particularity the manner in which each product/service is, has been, or is intended to be brought to the end user including, but not limited to, the identification and number of distributors, retailers or other re-sellers; any minimum order size; the manner in which product is shipped; and the approximate number of retail outlets in which each product/service is, has been, or is intended to be sold;

INTERROGATORY NO. 18

Explain how applicant first became aware of opposer's "ANGEL" marks, including the date that applicant became aware of opposer's "ANGEL" marks.

INTERROGATORY NO. 19

Identify any opinions received by applicant concerning a likelihood of confusion between applicant's mark and any mark owned by opposer.

INTERROGATORY NO. 20

Identify each and every person whom applicant intends to call as a witness, including expert witnesses, and for each witness describe the nature of his or her expected testimony, including the identification of all documents about which each witness is expected to testify.

INTERROGATORY NO. 21

Identify the person(s) most knowledgeable of the information stated in answer to the above 20 Interrogatories and their subparts.

**GENERAL OBJECTIONS TO INTERROGATORY
QUESTIONS NOS. 1 THROUGH 21**

Pursuant to 37 CFR §2.120(d) and TBMP §405, Applicant hereby generally objects to the excessive number of Interrogatories served by the Opposer on the Applicant. The number of Interrogatories in the Opposer's Interrogatories when counted are at least 95 questions, including subparts.

The numerical limits in the USPTO rule pertains to the total number of questions in Interrogatories with subparts as limited

to 75, to be served by a party over the course of an entire proceeding. TMBP §405.02. As the Board has noted, a party should not Answer the first seventy-five Interrogatories and object to the rest as excessive. Accordingly, no answers or further responses to Opposer's First Set of Interrogatories to Applicant (Nos. 1-21) are warranted under the circumstances. The Applicant also herein incorporates its general objections in its responses to the Opposer's First Set of Interrogatories. The Applicant also reserves the right to assert other generalized or specific objections to the Interrogatories should it become necessary or appropriate to respond further to the Interrogatories.



By One of The Attorneys
For The Applicant

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224 South Michigan Avenue
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(312) 427-1300

CERTIFICATE OF SERVICE

The undersigned, one of Applicant's attorneys, hereby certifies that on November 9, 2007, he caused a true and correct copies of the foregoing APPLICANT'S ANSWERS TO OPPOSER'S FIRST SET OF INTERROGATORIES to be served upon Opposer's counsel by First Class mail, postage pre-paid, at the following address:

Mary Catherine Merz
Ameen Imam
Merz & Associates, P.C.
1140 Lake Street
Suite 304
Oak Park, Illinois 60301-1051



Burton S. Ehrlich

EXHIBIT 1

INTERROGATORY NO.

TOTAL NUMBER OF QUESTIONS
WITH SUBPARTS

No. 1	3
No. 2	14
No. 3	1
No. 4	5
No. 5	10
No. 6	2
No. 7	5
No. 8	1
No. 9	5
No. 10	10
No. 11	8
No. 12	17
No. 13	5
No. 14	2
No. 15	6
No. 16	1
No. 17	1
No. 18	2
No. 19	1
No. 20	5
No. 21	<u>at least 21</u>
	TOTAL: 125

