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Filing date: **04/29/2009**

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

Proceeding	91174869
Party	Plaintiff Sao Paulo Alpargatas S.A.
Correspondence Address	Frank D. Decolvenaere Gottlieb, Rackman & Reisman, P.C. 270 Madison Avenue New York, NY 10016-0601 UNITED STATES efiling@grr.com, fdecolvenaere@grr.com
Submission	Motion to Compel Discovery
Filer's Name	Richard S. Schurin
Filer's e-mail	rschurin@grr.com
Signature	/Richard S. Schurin/
Date	04/29/2009
Attachments	Motion to compel.pdf (32 pages)(823542 bytes)

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

-----X
SAO PAULO ALPARGATAS S.A., : Opposition No. 91174869
Opposer, :
-against- : MARK: OLD HAVANA
MARMOL & SON, INC., :
Applicant. :
-----X

MOTION TO COMPEL AND TO EXTEND OPPOSER'S TESTIMONY PERIOD

Opposer Sao Paulo Alpargatas S.A. (hereinafter "Opposer") herein respectfully requests that the Board compel the Applicant Marmol & Son, Inc. (hereinafter "Applicant") to respond to Opposer's discovery. In addition, Opposer respectfully requests that the Board extend Opposer's testimony period currently scheduled to close on June 5, 2009, so as to provide time for the Board to decide this motion and for Applicant to respond to Opposer's discovery.

Procedural History

On July 16, 2007, Opposer served Applicant with Opposer's First Set of Interrogatories and Opposer's First Request for Production and Things. These documents are attached hereto as Exhibit 1. When no response was received by Opposer within the time permitted, Applicant's counsel was contacted. Applicant's counsel indicated that he "would like to see whether settlement is possible before we undertake the work of providing responses to your discovery requests." See e-mail dated August 23, 2007 attached hereto as Exhibit 2. The

parties then moved to suspend proceedings so as to pursue settlement. See Docket Entry No. 7.

Over the course of the next 18 months the parties secured two additional consented suspensions, the last of which expired on April 5, 2009. Ultimately the parties were unable to resolve this dispute and on March 31, 2009, Applicant's counsel was advised that Opposer was no longer interested in settlement. Opposer also requested that Applicant now respond to Opposer's outstanding discovery. Applicant's response was requested on or before April 15, 2009. A copy of the e-mail confirmation to Applicant's counsel is attached hereto as Exhibit 3. To date, Applicant has not responded to Opposer's outstanding discovery.

Opposer's thirty day testimony period is scheduled to open on May 5, 2009. The current schedule is as reflected in Docket Entry No. 15. Given the circumstances, Opposer respectfully requests that the current schedule be amended to provide for the testimony periods to begin after it receives Applicant's overdue discovery responses.

ARGUMENT

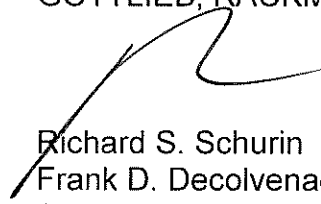
TBMP §523.01 provides in relevant part that if a party fails to answer an interrogatory or fails to permit the inspection and copying of any document or thing, then the party seeking discovery may file a motion before the Trademark Trial and Appeal Board to compel compliance. See, 37 CFR §2.120(e) and *Jain v. ramparts, Inc.* 49 USPQ2d 1429 (TTAB 1998).

A motion to compel does not necessarily have to be filed during the discovery period. However the motion should be filed within a reasonable time after the failure to respond to a request for discovery. TBMP §523.03. The period between the close of discovery and the opening of the first testimony period is an appropriate time to file a motion to compel. *Johnson & Johnson v. Diamond Medical, Inc.* 183 USPQ 615, 617 (TTAB 1974).

In this case, Opposer's motion to compel is timely, and Applicant has offered no explanation for its failure to respond. Since this motion complies in all respects with TMBP §523.02, it should be granted.

Finally, a motion to extend should be granted upon a showing of good cause. TBMP §509.01(a). Since, as explained herein, Opposer's request for an extension of time is necessitated by the Applicant's failure to respond to discovery, the good cause standard has been clearly met and Opposer's request for an extension of time should be granted.

Respectfully submitted,
GOTTLIEB, RACKMAN & REISMAN P.C.

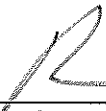


Richard S. Schurin
Frank D. Decolvenaere
Attorneys for Opposer

Dated: April 29, 2009

CERTIFICATE OF SERVICE

I, Richard Schurin, hereby certify that on April 29, 2009 a true and correct copy of this Motion to Resume Proceedings was duly served by First Class Mail and e-mail on Applicant's designated representative.



Richard Schurin

Dated: April 27, 2009

EXHIBIT 1

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

In the Matter of Application Serial No. 78/737,230
Mark: OLD HAVANA
Filed: October 20, 2005
Published: December 5, 2006

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Sao Paulo Alpargatas S.A.,	:	
	:	
Opposer,	:	
	:	Opposition No. 91174869
-against-	:	
	:	
Marmol & Son, Inc.,	:	
	:	
Applicant.	:	
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OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT

PLEASE TAKE NOTICE THAT, pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 33 of the Federal Rules of Civil Procedure, Opposer Sao Paulo Alpargatas S.A. ("Opposer"), through its attorneys, hereby serves the following interrogatories to be answered separately and fully in writing under oath by Applicant Marmol & Son, Inc. ("Applicant"). Each numbered or lettered subpart of each interrogatory requires a separate answer thereto. Furthermore, these interrogatories shall be deemed to be continuing to the fullest extent permitted by the Rules, and Applicant shall provide Applicant with any supplemental answers and additional information which shall become available to Applicant at a later date. In the event that at any later date Applicant obtains any additional facts, or forms any conclusions, opinions or contentions different from those set forth in its answers to such interrogatories, Applicant shall amend its answer to such

interrogatories promptly, and sufficiently in advance of trial periods, to fully set forth such differences. Applicant has the duty to supplement its responses to these inquiries at such time and to the extent required by Rule 26(e) of the Federal Rules of Civil Procedure.

DEFINITIONS AND INSTRUCTIONS

The following interrogatories (and OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO APPLICANT served concurrently herewith) are subject to the definitions and instructions set forth below:

A. The term "document" is defined to be synonymous in meaning and equal in scope to the usage of this term in Rule 34(a), Federal Rule of Civil Procedure. A draft or non-identical copy is a separate document within the meaning of this term.

B. The term "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise), whether oral, written or other.

C. The term "person" shall include, but is not limited to, any individual/natural person, firm, partnership, corporation, proprietorship, association, governmental body or any other organization or entity.

D. "Identify" when used with reference to a natural person, means to give, to the extent known, the person's full name, present or last known address, the present or last known place of employment, and the person's relationship to Opposer, if any. "Identify" when used with reference to any other type of person, means to give the person's full name (including any assumed or business name), address(es), form of organization (e.g., corporation, partnership, unincorporated association, etc.) and the person's relationship to Opposer, if any. Once a person had been identified in accordance with this subparagraph, only the name of that person need be listed in response to subsequent

discovery requesting the identification of that person.

E. "Identify" when used with reference to a document, means to provide, to the extent known, the (i) type of document; (ii) general subject matter; (iii) date of the document; (iv) author(s), addressee(s) and recipient(s); and the present or last known location and custodian of the document.

F. "Identify" when used with reference to an oral communication, means to identify the person or persons making the oral communication and any person(s) hearing such oral communication, and to state the date of such oral communication and what was said by all persons participating in said oral communication. If the attorney-client privilege or other exemption (under Fed. R. Civ. P. Rule 26(b)(3) or otherwise) is claimed with respect to an oral communication for which an inquiry or identification is sought herein, Applicant shall identify each such oral communication by date, speaker(s) and all other persons present, and a brief summary of the subject matter of the oral communication sufficient to establish the validity of the assertion of the privilege of exemption.

G. The term "concerning" shall mean relating to, referring to, describing, evidencing, containing, embodying or constituting.

H. "Applicant" shall mean Marmol & Son, Inc. and its predecessors, partners, officers, agents, employees, servants, subsidiaries, affiliates, divisions, any or any other "related company" (as defined in the Trademark Act of 1946, as amended) and/or any trustee in bankruptcy or any other interim trustee or organization, or other persons who are acting or have acted on behalf of Applicant or who are or have been in privity with Applicant with respect to the matters inquired about. All inquiries regarding Applicant shall also include any of Applicant's predecessors in interest which had an

interest of any kind in "Applicant's Mark" (as defined herein below).

I. "Applicant's Mark" shall mean the mark that is the subject of Application Serial No. 78/737,230, whether used alone or in combination with any other words, designs, phrases and/or numbers.

J. "Applicant's Goods" shall mean all goods set forth in Application Serial No. 78/737,230.

K. "Opposer" shall mean Sao Paulo Alpargatas S.A. and its predecessors, officers, agents, employees, servants, subsidiaries, affiliates, divisions, any or any other "related company" (as defined in the Trademark Act of 1946, as amended) or organization, or other persons who are acting or have acted on behalf of Opposer or who are or have been in privity with Opposer with respect to the matters inquired about.

L. "Opposer's Marks" shall mean the HAVAIANAS mark of Registration No. 3,069,819 and of Registration No. 1,858,280, and the HAVAIANAS & Design mark of Registration No. 1,906,924, and each of said marks.

M. "Opposer's Goods" shall mean footwear.

N. "United States commerce" shall mean commerce within the United States which may lawfully be regulated by Congress as defined by 15 U.S.C. § 1127.

O. The terms "all" and "each" shall be construed as all and each. The connectives "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the interrogatory or request for production or other discovery request all responses or production that might otherwise be construed to be outside its scope. The use of the singular form of any word includes the plural and vice versa.

P. No part of any interrogatory or request for production or other discovery request shall be left unanswered or not responded to merely because an objection is interposed to another part of the interrogatory or the request for production or other discovery request.

Q. Where an objection is made to any interrogatory or sub-part thereof under Rule 33, Federal Rules of Civil Procedure, or other applicable Rule, the objection shall state with specificity all grounds for objection. Any ground not stated in an objection within the time provided by the Federal Rules of Civil Procedure, or any extensions thereof, shall be waived.

(a) Where a claim of privilege is asserted in objecting to any interrogatory or subpart thereof, and an answer is not provided on the basis of such assertion,

(1) in the objection to the interrogatory or sub-part thereof, identify the nature of the privilege (including work product) which is being claimed and if the privilege is being asserted in connection with a claim or defense governed by state law, indicate the state's privilege rule being invoked; and

(2) the following information shall be provided in the objection, unless divulgence of such information would cause disclosure of the allegedly privileged information:

(i) for documents: (1) the type of document; (2) general subject matter of the document; (3) the date of the document; (4) such other information as is sufficient to identify the

document for a subpoena duces tecum, including, where appropriate, the author of the document, the addressee of the document, and, where not apparent, the relationship of the author and addressee to each other;

(ii) for oral communications: (1) the name of the person making the communication and the names of the persons present while the communication was made and, where not apparent, the relationship of the persons present to the person making the communication; (2) the date and place of communication; (3) the general subject matter of the communication.

(b) If any interrogatory is objected to as unduly burdensome, Applicant shall:

- (1) indicate the nature of the burden involved in providing the response being requested, e.g. the identity and number of files or documents that are responsive to the interrogatory or document request;
- (2) the manner in which Applicant's files are maintained, e.g., the subject matters of Applicant's files; and
- (2) a proposal by Applicant as to a less burdensome response that would provide responsive information and/or documents.

R. Whenever a party answers any interrogatory by reference to records from which the answer may be derived or ascertained, as permitted by Rule 33(d), Federal

Rules of Civil Procedure:

(a) The specification of documents to be produced shall be in sufficient detail to permit the interrogating party to locate and identify the records and to ascertain the answer as readily as could the party from whom discovery is sought.

(b) The producing party shall make available any computerized information or summaries thereof that it either has, or can adduce by a relatively simple procedure, unless these materials are privileged or otherwise immune from discovery.

(c) The producing party shall provide any relevant compilations, abstracts or summaries in its custody or readily obtainable by it, unless these materials are privileged or otherwise immune from discovery.

(d) The documents shall be available for inspection and copying within ten days after service of the answers to interrogatories or at a date agreed upon by the parties.

S. Where an objection is made to any request for production or sub-part thereof under Rule 34, Federal Rules of Civil Procedure, or other applicable Rule, the objection shall state with specificity all grounds for objection. Any ground not stated in an objection within the time provided by the Federal Rules of Civil Procedure, or any extensions thereof, shall be waived.

(a) Where a claim of privilege is asserted in objecting to any request for production, or subpart thereof, and documents are not provided on the basis of such assertion,

(1) in the objection to the request for production, or sub-part thereof, identify the nature of the privilege (including work product) which is being claimed and if the privilege is being asserted in connection with a claim or defense governed by state law, indicate the state's privilege rule being invoked; and

(2) the following information shall be provided in the objection, unless divulgence of such information would cause disclosure of the allegedly privileged information:

(i) for documents: (1) the type of document; (2) general subject matter of the document; (3) the date of the document; (4) such other information as is sufficient to identify the document for a subpoena *duces tecum*, including, where appropriate, the author of the document, the addressee of the document, and, where not apparent, the relationship of the author and addressee to each other;

(ii) for oral communications: (1) the name of the person making the communication and the names of the persons present while the communication was made and, where not apparent, the relationship of the persons present to the person making the communication; (2) the date and place of communication; (3) the general subject matter of the communication.

(b). If any request for production is objected to as unduly burdensome, Applicant shall

- (1) indicate the nature of the burden involved in providing the response being requested, e.g. the identity and number of files or documents that are responsive to the interrogatory or document request;
- (2) indicate the manner in which Applicant's files are maintained, e.g., the subject matters of Applicant's files; and
- (3) a proposal by Applicant as to a less burdensome response that would provide responsive information and/or documents.

T. To the extent that Applicant objects to answering any of these interrogatories or any request for production or other discovery request on the grounds that the information or documents/materials sought will require it to divulge "confidential" or other proprietary business information, counsel for Opposer agrees to keep such information and documents/materials, duly designated, on an "attorneys eyes only" basis, until such time as a protective order regarding confidential information can be agreed to between counsel.

INTERROGATORIES

1. Identify the nature of Applicant's business.
2. Identify, by name and address, for the past three years, for Applicant:
 - a) The person(s) who is/are in charge of the selection and adoption of trademarks;
 - b) The person(s) who is/are charge of advertising and promotion; and
 - c) The person(s) who is/are in charge of sales.
3. Identify all persons with primary knowledge or information concerning the actual or intended use of Applicant's Mark in connection with Applicant's Goods.
4. Describe, in detail, the actual or intended use of Applicant's Mark in connection with Applicant's Goods.
5. Identify the date of first use in United States commerce of Applicant's Mark with respect to Applicant's Goods and identify all persons with primary knowledge or information concerning the date of first use of Applicant's Mark with respect to Applicant's Goods.
6. Identify all documents showing Applicant's date of first use in United States commerce of Applicant's Mark with respect to Applicant's Goods and identify all persons with primary knowledge or information of such documents.
7. Identify all documents showing Applicant's continuous use of Applicant's Mark in United States commerce from the date of first use in United States commerce until the present with respect to Applicant's Goods and identify all persons with primary knowledge or information of such documents.
8. Identify all persons with primary knowledge or information concerning the adoption and selection of Applicant's Mark in connection with Applicant's Goods.
9. Describe, in detail, the adoption and selection of Applicant's Mark in connection with Applicant's Goods.
10. Identify all persons with primary knowledge or information concerning the offering, marketing, promotion, advertising and selling of Applicant's Goods in the United States by Applicant under Applicant's Mark.
11. Describe, in detail, the marketing, promotion, advertising, offering for sale and selling of Applicant's Goods in the United States by Applicant under Applicant's Mark.

12. Set forth, in detail, the total United States advertising and promotional expenditures of Applicant's Goods sold under Applicant's Mark for each year since said Applicant's Goods were introduced in the United States.

13. Set forth, in detail, the total United States sales of Applicant's Goods sold under Applicant's Mark for each year since said Applicant's Goods were introduced in the United States.

14. Identify all license agreements between Applicant and any third party relating or referring to Applicant's Mark.

15. Identify all persons with primary knowledge or information of the preparation, filing and prosecution of any applications in the United States for registration of Applicant's Mark.

16. Identify all persons with primary knowledge or information concerning all other proceedings (excluding this Opposition Proceeding) in which Applicant is or has been involved in connection with Applicant's Mark, whether alone or in combination with other terms.

17. Identify all proceedings (excluding this Opposition Proceeding) in which Applicant is or has been involved in connection with Applicant's Mark, whether alone or in combination with other terms.

18. Identify all persons with primary knowledge or information concerning all investigations, inquiries, or searches undertaken or made by or on behalf of Applicant in connection with the selection or use of Applicant's Mark and identify all documents concerning all such investigations, inquiries or searches.

19. Describe, in detail, all investigations, inquiries, or searches undertaken or made by or on behalf of Applicant in connection with the selection or use of Applicant's Mark.

20. Identify all persons Applicant intends to present and rely upon as a witness or otherwise in proof of any issue in this proceeding.

21. Identify any and all expert witnesses Applicant intends to present and rely upon in proof of any issue in this proceeding.

22. Identify all persons with knowledge or information concerning any survey(s) or other studies conducted by or on behalf of Applicant for purposes of determining whether or not any confusion exists between Applicant's Mark and Opposer's Marks.

23. Describe, in detail, any survey(s) or other studies conducted by or on behalf of Applicant for purposes of determining whether or not any confusion exists between Applicant's Mark and Opposer's Marks.

24. State whether Applicant has knowledge of goods bearing Opposer's Marks, and if so, identify how or where Applicant gained such knowledge and specify what Applicant knows.

25. State the date when Applicant first had knowledge of Opposer's Marks, identify how Applicant gained such knowledge, and specify such knowledge.

26. Set forth fully all facts concerning Applicant's acquisition and/or purchase of rights in or to Applicant's Mark.

27. Identify any period of time during which Applicant's Goods using Applicant's Mark have not been sold since Applicant's claimed date(s) of first use or filing date of Applicant's Mark and, for each such period, state the reasons for such non-use and the date, if any, when use resumed.

28. Identify by common commercial descriptive name each product and service sold or offered for sale by Applicant in the United States on or in connection with which Applicant's Mark has been or will be used.

29. Describe the trade channels, including individual retail outlets, in which goods using Applicant's Mark are or will be marketed in the United States.

30. Indicate the geographic area, by individual state, in which goods using Applicant's Mark are or will be distributed.

31. Identify all persons with primary knowledge or information concerning instances in which Applicant has received correspondence, telephone calls, or other communications intended for Opposer relating to Opposer's Goods or Applicant's Goods.

32. Describe, in detail, information concerning instances in which Applicant has received correspondence, telephone calls, or other communications intended for Opposer relating to Opposer's Goods or Applicant's Goods.

33. Identify all persons with primary knowledge or information concerning every instance in which Applicant has been asked if it was the same entity as, or was related to Opposer, or was related to Opposer's Marks.

34. Describe, in detail, all information concerning every instance in which Applicant has been asked if it was the same entity as, or was related to Opposer, or was related to Opposer's Marks.

35. Identify each instance of actual confusion as between Applicant's Goods which are marketed under Applicant's Mark and Opposer's Goods which are marketed under Opposer's Mark, and for each such instance:

- a) Describe each instance of actual confusion; and
- b) Identify all persons with knowledge of facts related to each instance of actual confusion.

36. Identify all third parties Applicant has communicated with regarding its alleged rights in Applicant's Mark.

37. Identify all persons who prepared, assisted in the preparation of or provided information or documents responsive to Opposer's First Set of Interrogatories to Applicant and Opposer's First Set of Requests for Production of Documents and Things to Applicant.

Dated: New York, New York
July 16, 2007

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.

By: 

Frank D. Decolvenaere

Attorneys for Applicant
270 Madison Avenue
New York, NY 10016-0601
(212) 684-3900

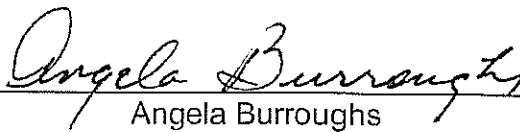
TO: Michael C. Cesarano, Esq.
Feldman Gale, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Blvd.
Miami, FL 33131

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT was served on Michael C. Cesarano, Applicant's attorney of record, on July 16, 2007, via first class mail, postage prepaid, addressed as follows:

Michael C. Cesarano, Esq.
Feldman Gale, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Blvd.
Miami, FL 33131

Dated: July 16, 2007


Angela Burroughs

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

In the Matter of Application Serial No. 78/737,230
Mark: OLD HAVANA
Filed: October 20, 2005
Published: December 5, 2006

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Sao Paulo Alpargatas S.A.,	:	
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Opposer,	:	
	:	Opposition No. 91174869
-against-	:	
	:	
Marmol & Son, Inc.,	:	
	:	
Applicant.	:	
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**OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF
DOCUMENTS AND THINGS TO APPLICANT**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and 37 C.F.R. §2.120, Opposer, Sao Paulo Alpargatas S.A. ("Opposer"), by its attorneys, hereby serves upon Applicant Marmol & Son, Inc. ("Applicant") the following requests for production of documents and things and requests that Applicant produce for inspection and copying the following documents and that said production be made within thirty (30) days following the date of service of this request upon Opposer, at the offices of Gottlieb, Rackman & Reisman, P.C., or as may otherwise be mutually agreed on by counsel for the parties.

DEFINITIONS AND INSTRUCTIONS

The definitions and instructions set forth in and forming part of Opposer's First Set of Interrogatories to Applicant served concurrently herewith are hereby incorporated by reference as though fully set forth herein.

Pursuant to Rule 34(b) of the Federal Rules of Civil Procedure, Opposer shall organize and label the documents produced to correspond with the number of the request and, for request 47, with the number of the interrogatory or interrogatories to which they are responsive or shall produce the documents as they are kept in the usual course of business.

A written response to this Opposer's First Set of Requests for Production of Documents and Things to Applicant is required pursuant to Rule 34 of the Federal Rules of Civil Procedure, applicable in accordance with Rule 2.116 of the Trademark Rules of Practice.

REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS

1. All documents evidencing Applicant's first date of use in United States commerce of Applicant's Mark in connection with Applicant's Goods.
2. Representative documents evidencing Applicant's continuous use in United States commerce of Applicant's Mark in connection with Applicant's Goods, from the first date of use and for each year until the present.
3. All documents concerning the reasons for, and circumstances of, any period of time during which Applicant's goods using Applicant's Mark have not been sold since Applicant's claimed date(s) of first use or filing date(s) of Applicant's Mark.
4. All documents concerning the actual or intended use of marks which include the term OLD HAVANA, or variations thereof, by Applicant (including predecessors and/or related companies).

5. All documents concerning Applicant's decision to use Applicant's Mark in United States commerce in connection with the goods identified in Applicant's Application Serial No. 78/737,230.
6. All documents concerning the selection and adoption of Applicant's Mark.
7. All documents, including search reports, concerning any investigations or inquiries or the results of any investigations or inquiries undertaken or made by or on behalf of Applicant in connection with the selection or use of Applicant's Mark.
8. All documents concerning all agreements (oral or reduced to writing), including but not limited to licenses, ever entered into by Applicant with respect to use of Applicant's Mark (alone or in connection with other words or symbols) on or in connection with any goods or services.
9. All documents concerning Applicant's licensing of Applicant's Mark from a third party, including, but not limited to, any license agreements Applicant has entered into.
10. All documents concerning Applicant's acquisition and/or purchase of rights in or to Applicant's Mark, including all documents and things referring or relating to Applicant's purported acquisition of its interest in or title to Applicant's Mark.
11. All advertisements, brochures, promotional materials, mailings, letterhead, business cards, or other promotional and marketing materials that were distributed, disseminated, produced and/or used in the United States that bear or make reference to Applicant's Mark.
12. Literature and other descriptive materials describing Applicant's Goods sold in connection with Applicant's Mark.

13. All packaging materials, including but not limited to boxes, envelopes, mailing labels, cardboards, cards, plastic wrap and stickers that were distributed, disseminated, produced and/or used in the United States that bear or make reference to Applicant's Mark, whether used alone or in conjunction with other written or graphic matter.

14. One specimen of each of Applicant's Goods labeled or packaged with Applicant's Mark, whether alone or in combination with other written or graphic matter.

15. Documents sufficient to establish the annual advertising and promotional expenditures in the United States by Applicant of Applicant's Goods in connection with Applicant's Mark since the date of first use of Applicant's Mark.

16. Documents sufficient to establish Applicant's annual sales in dollars in connection with Applicant's Mark for Applicant's Goods in the United States since the date of first use of Applicant's Mark.

17. All documents concerning any Internet web sites concerning the Applicant's Mark or goods bearing Applicant's Mark.

18. Documents sufficient to establish Applicant's annual sales in units or items sold in connection with Applicant's Mark for Applicant's Goods in the United States since the date of first use of Applicant's Mark.

19. Documents sufficient to establish the channels of trade and distribution of Applicant's Goods.

20. Documents sufficient to establish all retail outlets, offices or other locations at which Applicant markets, promotes, or sells goods bearing the Applicant's Mark in the United States.

21. Documents sufficient to establish the types of customers who have purchased Applicant's Goods.

22. Documents sufficient to establish the retail price(s) of products sold or to be sold under Applicant's Mark.

23. All documents concerning any other proceedings (whether administrative, judicial or other) in which Applicant is involved, or has been involved in the past, in connection with Applicant's Mark, whether alone or in conjunction with other terms.

24. All documents concerning any application for registration or any registration by Applicant of Applicant's Mark for any goods or services in the United States Patent and Trademark Office or any state or states of the United States, including corporate minutes, internal memoranda and correspondence concerning discussions and decisions.

25. All documents concerning any application for registration or any registration, by Applicant of Applicant's Mark for any goods or services in a foreign country, including corporate minutes, internal memoranda and correspondence concerning discussions and decisions, and including any earlier or otherwise different versions of similar marks or designations adopted, owned or used by Applicant.

26. All documents concerning correspondence, telephone calls or other communications received by Applicant that were intended for Opposer with regard to Applicant's Goods and/or Opposer's Goods.

27. All documents concerning instances where Applicant has been asked if it was the same entity as or was related to Opposer or to Opposer's products or to Opposer's Marks with regard to Applicant's Goods and/or Opposer's Goods that were advertised, promoted, sold or offered for sale.

28. All documents concerning instances where Applicant has been asked if it was the same entity as or was related to any other entity using the term "OLD HAVANA or "HAVAIANAS" as part of a trademark or trade name, whether alone or in combination with other terms.

29. To the extent not produced in response to Request Nos. 26, 27 and 28, all documents which refer or relate to any purported instances of actual confusion, mistake or deception between Applicant's Goods sold under Applicant's Mark and Opposer and/or Opposer's Marks, including, without limitation, inquiries, comments or other communications by or from customers, suppliers, or members of the public, either written or oral, showing any confusion, suspicion, belief or doubt as to a possible relationship between Applicant and Opposer or the origin of their respective goods or services.

30. All documents concerning any investigation, survey (proposed, pilot, completed and other), study, poll, or other market research concerning Applicant's Mark or Opposer's Marks.

31. To the extent not produced in response to Request No. 30, all documents showing that consumers associate Applicant's Mark with Opposer.

32. All documents concerning or consisting of the opinion or report of any experts consulted or retained by Applicant, or by any person or persons acting for or on behalf of Applicant, in connection with any of the issues involved in this proceeding.

33. All documents establishing Applicant's knowledge of Opposer or Opposer's Marks.

34. All documents establishing the first date when Applicant became aware of Opposer or Opposer's Marks.

35. All documents concerning how Applicant first became aware of Opposer and Opposer's Marks and the identity of all persons with primary knowledge or information concerning the same.

36. All communications threatening arbitration, litigation or other adversary proceeding (including opposition or cancellation proceedings) concerning Applicant's Mark.

37. All documents concerning third party uses, applications or registrations (or Applicant's knowledge thereof) of the Applicant's Mark, or any similar name or mark, on or in connection with products or services identical, similar or related to Applicant's.

38. All documents concerning any registrations or applications for registration (including the complete file history for each such registration or application) of Applicant's Mark anywhere in the United States (federal, state or other jurisdiction), and any earlier or otherwise different versions of similar marks or designations adopted, owned or used by Applicant, including corporate minutes, internal memoranda and correspondence concerning discussions and decisions.

39. All documents supporting and/or controverting the denial set forth in Paragraph 7 of Applicant's Answer to Notice of Opposition.

40. All documents supporting and/or controverting the denial set forth in Paragraph 8 of Applicant's Answer to Notice of Opposition.

41. All documents supporting and/or controverting the denial set forth in Paragraph 10 of Applicant's Answer to Notice of Opposition.

42. All documents supporting and/or controverting the denial set forth in Paragraph 12 of Applicant's Answer to Notice of Opposition.

43. All documents supporting and/or controverting the denial set forth in Paragraph 13 of Applicant's Answer to Notice of Opposition.

44. All documents supporting and/or controverting the denial set forth in Paragraph 14 of Applicant's Answer to Notice of Opposition.

45. All documents evidencing or otherwise concerning communications between Applicant and any third party concerning the subject opposition proceeding.

46. All documents evidencing or otherwise concerning communications between Applicant and any third party concerning Opposer.

47. All communications between Applicant and any third party regarding Applicant's alleged rights in Applicant's Mark.

48. All documents identified in Applicant's answers to Opposer's First Set of Interrogatories to Applicant.

49. All documents concerning Applicant's document retention policy.

50. To the extent not produced in response to the above requests, all documents used, considered or referred to in order to answer Opposer's First Set of Interrogatories to Applicant.

Dated: New York, New York
July 16, 2007

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.

By: 

Frank D. Decolvenaere
Attorneys for Applicant
270 Madison Avenue
New York, NY 10016-0601
(212) 684-3900

TO: Michael C. Cesarano, Esq.
Feldman Gale, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Blvd.
Miami, FL 33131

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO APPLICANT was served on Michael C. Cesarano, Applicant's attorney of record, on July 16, 2007, via first class mail, postage prepaid, addressed as follows:

Michael C. Cesarano, Esq.
Feldman Gale, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Blvd.
Miami, FL 33131

Dated: July 16, 2007


Angela Burroughs

EXHIBIT 2

ipargatas S.A. v. Marmol & Son, Inc.
 mails for a day or two. I will appreciate your keeping the offer over until the end of the week, if possible.

Thank you.

Michael Cesarano

From: Frank Decolvenaere [mailto:fdecolvenaere@grr.com]
Sent: Friday, August 31, 2007 12:33 PM
To: Michael C. Cesarano
Cc: Diana Muller
Subject: RE: Opposition No. 91174869, Sao Paulo Alpargatas S.A. v. Marmol & Son, Inc.
Importance: High

WITHOUT PREJUDICE – FED. R. EVID. 408

Dear Mr. Cesarano:

I have to date not heard from you further to your e-mail of August 23. Please contact me next week regarding the settlement proposal set forth in my August 22 e-mail and Applicant's responses to Opposer's discovery requests, absent which I will proceed with seeking a rescheduling of the testimony/trial dates (the discovery period is closed) based on Applicant's failure to respond to the outstanding discovery requests. Of course, we would be willing to extend Applicant's time to respond to the outstanding discovery if it appears that settlement along the lines proposed is likely.

Yours truly,

Frank D. Decolvenaere
 Gottlieb, Rackman & Reisman, P.C.
 270 Madison Avenue
 New York, New York 10016
 Tel: 212-684-3900
 Facsimile: 212-684-3999
fdecolvenaere@grr.com
www.grr.com

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From: Michael C. Cesarano [mailto:MCesarano@FeldmanGale.com]
Sent: Thursday, August 23, 2007 7:13 AM
To: Frank Decolvenaere
Subject: RE: Opposition No. 91174869, Sao Paulo Alpargatas S.A. v. Marmol & Son, Inc.

Dear Mr. Decolvenaere:

Thank you for your e-mail and related suggestions and proposals. I am currently away from my office, and will not return until Monday, Aug. 27. I will speak with my client when I return to see whether we may resolve the matter along the lines you have suggested. In the meantime, we will agree to an extension of the discovery and trial testimony deadlines established by the TTAB so long as they are reasonable – a few months or so. As we are interested in resolving this matter as inexpensively as possible, I would like to see whether settlement is possible before we undertake the work of providing responses to your discovery requests. I will get back in touch with you early next week.

Sincerely,

Michael Cesarano

From: Frank Decolvenaere [mailto:fdecolvenaere@grr.com]

9/14/2007

EXHIBIT 3

Richard Schurin

From: Richard Schurin
Sent: Tuesday, March 31, 2009 3:06 PM
To: 'adalvi@feldmangale.com'
Cc: Frank Decolvenaere; Diana Muller
Subject: Sao Paulo Alpargates / Marmol & Son

Dear Mr. Dalvi:

This will confirm our phone conversation of earlier today. As discussed, our client is no longer interested in settlement.

As you know, proceedings are set to resume on April 6, 2009, and certain discovery remains outstanding. Specifically, we have not yet received the Applicant's responses to Opposer's First Set of Interrogatories and First Request for Production. Additional copies of these documents are attached hereto for your reference. We would request your response to these on or before April 15th. Should you have any questions, please do not hesitate to contact us.

Very truly yours,

Richard S. Schurin, Esq.
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(212) 684-3900
(212) 684-3999
rschurin@grr.com