

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

**In the matter of Registration No.: 2,963,079  
Mark: PIAZZA D'ORO**

**PIAZZA ESPRESSO, INC.**

**Petitioner,**

**v.**

**SARA LEE DE/N.V.**

**Registrant.**

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**Cancellation No. 92045423**

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**DECLARATION OF RANDEL S. SPRINGER**

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

1. I am an attorney admitted to practice in the State of North Carolina and I represent Sara Lee DE/N.V. ("Registrant") in this matter. This affidavit is submitted in conjunction with Registrant's opposition to Piazza Espresso, Inc.'s ("Petitioner") motion for summary judgment filed on July 17, 2006.
2. Prior to the suspension of the proceedings pending the disposition of the Motion for Summary Judgment, this matter was in the "discovery phase" of the cancellation proceeding. The discovery period was set to close on September 22, 2006.
3. As of the date of this affidavit, no discovery has been served by either party in this proceeding.
4. Petitioner's motion for summary judgment is supported by the affidavit of Mr. Joseph Gomez, who is purportedly the Secretary/Treasurer of Piazza Espresso, Inc. Registrant has not had the opportunity to obtain any discovery from Mr. Gomez.
5. Because Petitioner has not produced any documents in this case, I have not seen (and am not familiar with) many documents attached to Mr. Gomez's affidavit and Petitioner's motion for

summary judgment. In particular, I am not familiar with the nature of the Internet printouts, nor the pictures included as Exhibits. Prior to addressing such exhibits, Registrant would need further discovery, in the form of either paper discovery or depositions, in order to ascertain the nature and relevancy of such Exhibits.

6. Unless Registrant is permitted to conduct discovery in this case, it is impossible for Registrant to determine what witnesses, if any, that it will need to depose and what, if any, additional paper discovery it will need to serve. However, once Registrant is permitted to serve paper discovery, and when responses to this discovery are received, Registrant will be able to determine what, if any, additional discovery and depositions are necessary and appropriate.

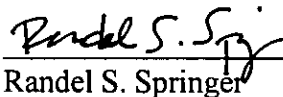
7. Registrant has not had an opportunity to conduct discovery that is necessary to respond substantively to Petitioner's motion for summary judgment. Such discovery, that can only be obtained from Petitioner, relates directly to Registrant's ability to apply the *Dupont Factors* to the facts in this case and make a meaningful comparison of Registrant's Mark to Petitioner's Marks. Discovery that is necessary in order to respond to Petitioner's motion includes, but is not limited to, the following:

- (a) specific description of the nature of Petitioner's goods for the purposes of comparing such goods to Registrant's goods, including the selling price of Petitioner's goods;
- (b) specific description of the types of consumers that purchase Petitioner's goods, including the sophistication level of such consumers and the conditions under which such sales are made, *i.e.*, impulse vs. careful purchasing;
- (c) specific description of the channels of trade used by Petitioner to sell its goods;
- (d) specific description of any and all types of advertising and promotional campaigns conducted by Petitioner for the purposes of determining if there are any similarities to Petitioner's marketing efforts and those of Registrant, including but not limited to the production of specific documents showing Petitioner's advertising, and a list of any and all publications or media outlets where such advertisements have appeared;
- (e) additional information relating to the "independent research by Piazza Espresso [which] led to the discovery that Sarah Lee [sic] had been retailing their products in the United States under the name Piazza Espresso and Piazza D'Oro Espresso" (See Petitioner's Motion for Summary Judgment, P. 2), including but not limited to the name of the person conducting such research, the dates such research was conducted, and any materials, reports or results produced as a result of such research;
- (f) additional information relating to Petitioner's statement that "a future principal of Piazza Espresso recalled purchasing a package of coffee in 2001 with the markings "Piazza Espresso," (See Petitioner's Motion for Summary Judgment, P. 2), including but not limited to the name of such individual, the name of the store where he purchased the coffee, and the circumstances that led him to conclude that Registrant's mark caused confusion;

- (g) additional information relating to Petitioner's broad, unsupported statement in Petitioner's affidavit that Petitioner's mark has achieved "fame" (See Joseph Gomez Affidavit, p. 2);
- (h) additional information relating to any specific instances of actual confusion, including a description of any such person experiencing such confusion and the nature and circumstances surrounding such confusion;
- (i) additional information relating to any other facts and opinions that Petitioner disclosed in its motion for summary judgment, including those facts and opinions disclosed in its affidavit and exhibits attached thereto;
- (j) any supplemental information that may be required by Registrant through either supplemental paper discovery or depositions, the nature of which cannot be known until Petitioner responds to the above outlined initial discovery.

8. Through the discovery described in the foregoing paragraphs of this affidavit, Registrant reasonably expects to obtain facts, information and other material which can and will be used to respond substantively to Petitioner's motion for summary judgment. Further, such discovery may yield evidence to effectively challenge the credibility and/or reliability of the various opinions stated by Mr. Joseph Gomez in his affidavit, and any exhibits attached thereto.

Date: 21 AUGUST 2006



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**CERTIFICATE OF MAILING**

I hereby certify that the foregoing DECLARATION OF RANDEL S. SPRINGER is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451, on the 21<sup>st</sup> day of August, 2006.



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Laurie A. Ricci, Senior Paralegal

**CERTIFICATE OF SERVICE**

I do hereby certify that on the 21<sup>st</sup> day of August, 2006, I served a true and complete copy of the foregoing DECLARATION OF RANDEL S. SPRINGER upon counsel for Petitioner by causing a copy of the same to be deposited with the United States Postal Service, first-class mail postage prepaid, and addressed as follows:

Robert M. Singer  
2572 Whitney Avenue  
Hamden, CT 06518



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Laurie A. Ricci, Senior Paralegal