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

EDGAR RICE BURROUGHS, INC.,	:	
	:	
Opposer,	:	
	:	Opposition
v.	:	No. 91154731
	:	
LETOURNEAU, INC.,	:	
	:	
Applicant.	:	
	:	

DECLARATION OF EVAN GOURVITZ
IN SUPPORT OF OPPOSER'S MOTION TO COMPEL

Evan Gourvitz declares and says:

1. I am a member of the Bar of the State of New York and an associate at the law firm of Fross Zelnick Lehrman & Zissu, P.C., counsel for Opposer Edgar Rice Burroughs, Inc. ("Opposer") in the above-captioned opposition proceeding. I submit this declaration in support of Opposer's Motion to Compel based on my personal knowledge and on the files in this action.

2. This declaration sets forth the relevant history of this opposition and Opposer's good-faith efforts to seek the cooperation of Applicant LeTourneau, Inc. ("Applicant") in discovery. Despite repeated attempts over the course of more than five months to resolve the disputes delineated in this Declaration and in the accompanying brief in support of Opposer's motion, Applicant has failed to cure the bulk of the deficiencies in its responses to Opposer's First Set of Interrogatories, First Set of Requests for Production of Documents and Things, and First Set of Requests for Admission. Despite repeated requests, Applicant also has failed to provide sufficient explanation for this failure to cure, despite assurances -- including after the discovery period ended – that information would be forthcoming.

A. **Background**

3. On October 30, 2001, Applicant filed an intent-to-use application with the U.S. Patent & Trademark Office, Serial. No. 76/332,326, to register the TARZAN mark for "mechanically elevated off-shore platforms for use in the exploration and production of petroleum and minerals" in International Class 7 ("the Application").

4. On May 8, 2002, Opposer, which owns all trademarks and existing copyrights for the TARZAN character, and federal registrations of the TARZAN mark for a variety of goods and services, filed a Notice of Opposition to the Application. In this Notice, Opposer alleged, based on its extensive rights in its famous TARZAN mark and character, its extensive licensing of the TARZAN character and under the TARZAN mark, and its numerous federal registrations for the TARZAN mark, that Applicant's registration of the applied-for mark is likely to cause confusion with, and is likely to dilute, its famous TARZAN mark.

5. On March 10, 2003, Applicant filed its Answer, which, *inter alia*, admitted that Applicant was aware of Opposer's mark when it filed its application, and denied that Opposer's TARZAN mark was famous or well-known.

6. On January 27, 2003, the Board issued its initial scheduling order. That scheduling order has been altered by consent of both parties several times. Under the current scheduling order, discovery, which originally opened on February 16, 2003, closed on October 15, 2003.

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

7. On March 28, 2003 our firm served a copy of Opposer's first set of document requests on counsel for Applicant. A true and correct copy of this first set of requests is attached hereto as Exhibit 1.

8. Applicant served its written responses and objections to Opposer's first document requests on counsel for Opposer on May 2, 2003. A true and correct copy of Applicant's responses is attached hereto as Exhibit 2. Applicant's responses were deficient in several respects. Applicant objected to, and did not state that it would produce documents in response to, Opposer's requests 22-29, which requested documents concerning, *e.g.*, (i) the quality and safety of the product on which Applicant intends to use the TARZAN mark, or similar or related products, and (ii) the types of persons who would visit or work on such a product, and hence might come into contact with Applicant's proposed use of the TARZAN mark. (Ex. 2 at 18-23.)

9. On June 6, 2003, our firm sent a letter to Applicant's counsel noting the deficiencies in its responses, explaining in detail, request by request, why Opposer's document requests were relevant, noting that we were willing to clarify any requests that Applicant considered unclear, and insisting that Applicant produce documents responsive to our requests, subject to a suitable protective order, if necessary. A true and correct copy of this letter is attached hereto as Exhibit 3.

10. On June 6, 2003 our firm also served a copy of Opposer's first interrogatories on counsel for Applicant. A true and correct copy of this first set of interrogatories is attached hereto as Exhibit 4.

11. On July 2, 2003, Applicant's counsel responded to my June 6, 2003 letter regarding Applicant's deficiencies in their document request responses. A true and correct copy of this letter is attached hereto as Exhibit 5. This letter did not respond to Opposer's discussion of Applicant's deficiencies on a request-by-request basis, but instead merely expressed general reservations regarding the breadth of certain of Opposer's requests. (Ex. 5 at 2.) Applicant's counsel suggested that its upcoming document production would "provide . . . more

information," and stated that "if after receiving these materials you still feel that you are entitled to more information and documents after receiving our production, then I think we should discuss those issues and your requests in more detail." (*Id.* at 2.)

12. Applicant also served its written answers and objections to Opposer's First Set of Interrogatories on counsel for Opposer on July 2, 2003. A true and correct copy of Applicant's responses to these requests is attached hereto as Exhibit 6. These answers were deficient in many respects, including, *inter alia*, by their failure to sufficiently describe Applicant's use to date of the TARZAN mark, to explain how the TARZAN mark was selected, to explain what sort of trademark search was conducted prior to Applicant's choice of the TARZAN mark, and to provide information regarding the quality and safety of the product on which Applicant intends to use the TARZAN mark, or similar or related products. (*See* Ex. 6.)

13. On July 16, 2003, I sent another letter to Applicant's counsel. A true and correct copy of this letter is attached hereto as Exhibit 7. This letter, *inter alia*, repeated Opposer's concerns about deficiencies in Applicant's document production, explained why Opposer believed the documents it had requested were relevant and appropriate, and insisted that Applicant address these deficiencies or be subject to a motion to compel. It also noted deficiencies in Applicant's interrogatory answers, explaining in detail, request by request, why Opposer's interrogatories were relevant and appropriate, and insisting that Applicant produce proper answers to these requests.

14. On August 1, 2003, I sent a follow-up letter to Applicant's counsel that, *inter alia*, provided the first 770 pages of Opposer's non-confidential document production, and noted that we had not yet received a response to my letter of July 16, 2003. A true and correct copy of this letter is attached hereto as Exhibit 8.

15. On August 7, 2003, Applicant's counsel sent a letter stating that he had been out of the office but would "try to respond to your letters early next week." A true and correct copy of this letter is attached hereto as Exhibit 9.

16. On August 7, 2003, I sent a follow-up letter to Applicant's counsel asking for responses to my July 16, 2003 and August 1, 2003 letters, and requesting that Applicant begin its document production. A true and correct copy of this letter is attached hereto as Exhibit 10.

17. On August 11, 2003 I served a copy of Opposer's requests for admission on counsel for Applicant. A true and correct copy of these requests is attached hereto as Exhibit 11.

18. On August 12, 2003 Applicant's counsel sent a letter responding to Opposer's July 16, 2003 letter. A true and correct copy of this letter (without its attached draft protective order) is attached hereto as Exhibit 12. This letter alleged that certain of Opposer's document requests were overbroad and irrelevant, but did not expand upon Applicant's objections as stated in their July 2, 2003 letter. Applicant's August 12, 2003 letter also responded to some, but not all, of Opposer's concerns regarding deficiencies in Applicant's interrogatory answers, and erroneously stated, *e.g.*, that trademark searches are "privileged, whether or not performed by an attorney." (Ex. 12 at 2.) Applicant's counsel repeatedly assured Opposer that "I believe that the documents LeTourneau plans to produce under the protective order should resolve your questions and concerns . . ." or that "many, if not all, of the concerns you have expressed will be resolved when the parties are able to exchange and review the other's documents. . . ." (*Id.* at 3, 4.)

19. On August 26, 2003, Applicant finally produced the beginning of its document production. This production also included documents produced by its parent company Rowan Companies, Inc. (which were not designated separately) in response to a subpoena by Opposer. Applicant's production, which consisted of less than 250 pages of non-confidential documents,

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