

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

HEINEKEN BROUWERIJEN B.V.,

Opposer,

v.

THE SLEEMAN BREWING & MALTING CO.  
LTD.,

Applicant.

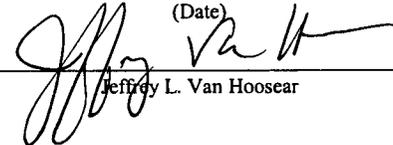
Opposition No. 91166542

Serial No. 78336,665

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on

February 2, 2006

(Date)



Jeffrey L. Van Hoosear

**APPLICANT'S RESPONSE TO OPPOSER'S MOTION:**

**(1) TO COMPEL DISCOVERY, (2) TO TEST THE SUFFICIENCY OF ADMISSIONS RESPONSES, (3) FOR ENTRY OF A PROTECTIVE ORDER, (4) TO DIRECT APPLICANT TO SUBMIT A PRIVILEGE LOG, (5) TO SUSPEND PROCEEDINGS, AND (6) TO RE-SET THE DISCOVERY AND TESTIMONY PERIODS**

Assistant Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451



02-07-2006

U.S. Patent & TMOtc/Tt.1 Mail R-rp1 Dt. #26

Dear Sir:

The Sleeman Brewing & Malting Co. Ltd. ("Applicant"), by and through its counsel, hereby replies to Heineken Brouwerijen B.V.'s ("Opposer") Motion (1) To Compel Discovery, (2) To Test the Sufficiency of Admissions Responses, (3) For Entry of a Protective Order, (4) To Direct Applicant to Submit a Privilege Log, (5) To Suspend Proceedings, and (6) To Re-Set the Discovery and Testimony Periods ("Motion").

First, even though it does contain differences from the Trademark Trial and Appeal Board's proposed protection order, Applicant has no objection to the proposed protective order

submitted by Opposer as Exhibit B to its Motion. Further, Applicant has no objection to the Motion with respect to suspension of proceedings during the pendency of the Motion, nor does Applicant take any issue with the Opposer's request to re-set the discovery and testimony periods. Applicant does, however, object to the Motion to the extent that it mischaracterizes Applicant's responses to Opposer's discovery requests and seeks to compel discovery, test the sufficiency of admission responses, and to submit a privilege log.

Opposer submitted discovery requests dated September 30, 2005. Applicant sought and was granted an extension of time to respond to these requests until November 18, 2005. Applicant dutifully responded to these discovery requests by the extended deadline.

Opposer wrote a letter to Applicant dated December 12, 2005, offering the same proposed protective order to which Applicant makes no objections here, and demanding supplemental responses to the discovery already served by December 16, 2005, four days after the letter. As Opposer states in its Motion, Opposer talked with Applicant's counsel on December 15, 2005. Applicant's counsel was unable to offer a substantive reply to Opposer's counsel a mere three days after the letter was sent, nor immediately after the holiday season (January 3, 2006). Applicant and Applicant's Canadian counsel have been discussing Opposer's letter and formulating a response. Opposer submitted this present motion only ten days after the return from the holiday season.

Applicant is well-aware of its responsibility under Fed. R. Civ. P. 26(e) and TBMP § 408.03 to supplement its discovery responses and will comply with those responsibilities. As there is now an agreed upon protective order that the Board may enter, Applicant will supplement its responses that may overcome Opposer's objections to the Interrogatory responses and Document Requests, including answering Interrogatories related to future business plans which

otherwise would have been made public and viewable by competitors. It is Applicant's position that the answers given thus far are appropriate and responsive.

Opposer also objected to the Document Requests for having to access Applicant's place of business for the purposes of inspecting and copying responsive documents. This is well within Applicant's rights as governed by 37 CFR § 2.120(d)(2), which states, "The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept ..." Opposer has since offered to reimburse Opposer for copying and shipping costs if it will ship copies of the relevant documents to Opposer's counsel. Applicant will agree to this and provide relevant documents upon the entry of the proposed protective order.

Opposer also challenges Applicant's responses to its Requests for Admission. Applicant respectfully suggests that it has provided answers to the best of its ability, and Opposer may not merely object to answers that it does like. Again, Applicant is aware of its duty to supplement its responses and will do so if the circumstances warrant it. The application is an intent-to-use application. Applicant cannot therefore be held to answer requests that ask about "Applicant's Products bearing Applicant's Mark." Applicant has maintained that its mark is not in bona fide commercial use in its application, in its response to the Notice of Opposition, and in its responses to Opposer's discovery requests. To the extent that Opposer wishes Applicant to respond differently to its Requests 66 through 69, Applicant cannot.

Based on the foregoing, Applicant believes that Motion to test sufficiency of admission responses is baseless and unwarranted.

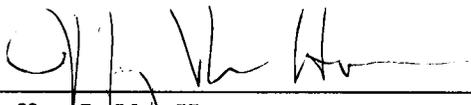
In view of the above, Applicant has no objection to and thus respectfully requests that the portions of Opposer's Motion for: a) Entry of a Protective Order; b) To Suspend Proceedings; and c) To Re-Set the Discovery and Testimony Periods be granted. Applicant respectfully

submits that it has complied with the Federal Rules of Civil Procedure regarding discovery based on its initial responses. Supplemental responses will be forthcoming upon entry of the protective order. As such, Applicant respectfully requests that the TTAB deny the portions of Opposer's Motion which relates to the following: d) To Compel Discovery; e) To Test the Sufficiency of Admissions Responses, and f) To Direct Applicant to Submit a Privilege Log.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

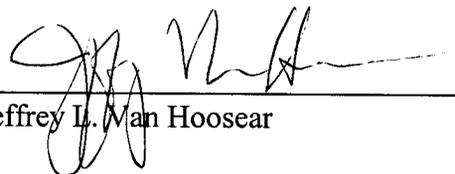
Dated: February 2, 2006

By:   
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Attorneys for The Sleeman Brewing & Malting  
Co. Ltd., Applicant

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S MOTION: TO COMPEL DISCOVERY, (2) TO TEST THE SUFFICIENCY OF ADMISSIONS RESPONSES, (3) FOR ENTRY OF A PROTECTIVE ORDER, (4) TO DIRECT APPLICANT TO SUBMIT A PRIVILEGE LOG, (5) TO SUSPEND PROCEEDINGS, AND (6) TO RE-SET THE DISCOVERY AND TESTIMONY PERIODS** upon Opposer's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on February 2, 2006, addressed as follows:

Jonathan Hudis  
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, VA 22314

  
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Jeffrey L. Man Hoosear

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