ESTTA Tracking number: **ESTTA376654**
Filing date: **11/03/2010**

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

Proceeding	91192099
Party	Plaintiff McDonald's Corporation
Correspondence Address	LAWRENCE E. JAMES, JR. NEAL, GERBER & EISENBERG LLP 2 NORTH LaSALLE STREET, SUITE 1700 CHICAGO, IL 60602 UNITED STATES apeterson@ngelaw.com, jcullis@ngelaw.com, mturner@ngelaw.com, rbrowne@ngelaw.com
Submission	Reply in Support of Motion
Filer's Name	Lawrence E. James, Jr.
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Signature	/Lawrence E. James, Jr./
Date	11/03/2010
Attachments	Opposer's Reply In Support of Its Motion for an Extenson.pdf (37 pages)(1314771 bytes)

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

McDONALD'S CORPORATION,	)		
	)	Opposition No. 91192099	
Opposer,	)		
	)		
v.	)	Mark:	McSWEET
	)	Application S/N:	77/722,272
McSWEET, LLC,	)	Filed:	April 24, 2009
	)	Published:	September 1, 2009
Applicant.	)		

OPPOSER'S REPLY IN SUPPORT OF ITS MOTION FOR AN EXTENSION OF TIME TO SERVE RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO OPPOSER

Applicant's response brief, filed October 25, 2010, opposing Opposer's Motion for a one-day extension of time to serve responses to Applicant's First Set of Requests for Admissions to Opposer ("Response Brief") does not set forth a single reason why Opposer's request for a one-day extension should not be granted. Lacking any good-faith basis to oppose that one-day extension, Applicant instead attacks the substance of Opposer's Responses to the Requests for Admissions, as if it were moving to test the sufficiency of those Responses. However, Applicant's Response Brief is the first time that it has ever complained of the content of Opposer's Responses to the Requests for Admissions; it has never so much as mentioned any dissatisfaction with Opposer's Responses, let alone met and conferred with Opposer as required by 37 C.F.R. § 2.120(h) before a motion to test the sufficiency of responses to requests for admissions may be filed. Moreover, as set forth below, Applicant's purported objection to the content of Opposer's Responses to the Requests for Admissions is wholly unfounded. In sum, Applicant has provided no legitimate good-faith reason for opposing Opposer's Motion for a one-day extension of time, which should be granted.

A. Good Cause Exists for a One Day Extension of Time

Federal Rule of Civil Procedure 6(b) provides that a court may extend time to act for good cause. Fed. R. Civ. P. 6(b). Pursuant to 37 C.F.R. § 2.120(a), "the time to respond [to interrogatories, requests for production of documents and things, and requests for admission] may be extended upon stipulation of the parties, or upon motion granted by the Board, or by order of the Board." 37 C.F.R. § 2.120(a); TBMP 403.04. Furthermore, Federal Rule 36(a)(3) provides that "[a] shorter or longer time for responding [to requests for admissions] may be stipulated to under Rule 29 or be ordered by the Court." Fed. R. Civ. P. 36(a)(3). In sum, contrary to the assertion in the Response Brief at p. 1, it is clear that extensions of time may be granted for responses to Requests for Admissions. Furthermore, in contrast to a request for an extension of time under Rule 6(b), under Rule 36(a)(3) an extension of time to respond to requests for admissions does not require a showing of good cause. *See* Fed. R. Civ. P. 36(a)(3); Moore's Federal Practice 3d, §6.06[4], August, 2010 ("Though Rule 6 and Rule 31 require a showing of good cause to justify an extension of a time period, Rule 33, Rule 34, and Rule 36 do not.") Nevertheless, as set forth below, good cause exists here for granting the one-day extension sought by Opposer.

On August 30, 2010, Applicant served 105 Requests for Admissions on Opposer, and, the next day, August 31, 2010, Applicant served 96 Requests for Production of Documents on Opposer. Opposer promptly and diligently began conducting the necessary investigation required to respond to those over 200 discovery requests and began drafting responses thereto, creating a first draft of the responses by September 9, 2010 and thereafter continued to revise those responses. Declaration of Lawrence E. James, Jr., filed herewith ("James Decl.") at ¶1. Opposer's responses to the Requests for Admissions were due on Monday October 4, 2010, and its responses to the Requests for Production were due on Tuesday, October 5, 2010. The week of

September 26, which was the week before the responses to both sets of discovery were due, Opposer's Managing Counsel was out of the office at a mandatory conference for in-house counsel and unable to review drafts of the responses. James Decl. at ¶ 2. Opposer's managing counsel and outside counsel extensively discussed the discovery responses on Monday, October 4, 2010, but were unable to complete the Responses to the Requests for Admissions that day. James Decl. at ¶ 3. Opposer served Applicant's counsel with the Responses to the Requests for Admission and the Requests for Production the next day, October 5, 2010, and provided Applicant's counsel with a courtesy copy via email to ensure that Applicant's counsel would receive the discovery responses as early as possible. James Decl. at ¶ 6. Accordingly, Opposer submits that there is sufficient justification for a one-day extension of time for its discovery responses.

Applicant will not be prejudiced in any way by the requested one-day extension. When the discovery responses were served, more than two months remained in the discovery period leaving Applicant plenty of time to conduct any follow-up discovery. Furthermore, by emailing a courtesy copy of the discovery responses to Applicant, Opposer ensured that Applicant would receive them as early as possible, and, indeed sooner than Applicant would have received them had they been sent via first class mail only. James Decl. at ¶ 6. Notably, Applicant does not claim that it will be prejudiced in any manner by a one-day extension.

Each of the cases cited by Applicant in support of its argument that the extension should be denied involve vastly different circumstances than those at issue here. *See Instruments SA Inc. v. ASI Instruments Inc.*, 53 U.S.P.Q.2d 1925, 1926 (TTAB 1999)(considering a motion <u>to extend the close of discovery</u>, following a two and one-half month period during which the movant took no discovery); *HKG Industries, Inc. v. Perma-Pipe, Inc.*, 49 U.S.P.Q.2d 1156, 1157

(T.T.A.B. 1998) (considering a motion to reopen the testimony period, which requires a showing of excusable neglect-a higher standard than good cause necessary for an extension of time); *Leumme, Inc. v. D.B. Plus, Inc.*, 53 U.S.P.Q.2d 1758 (T.T.A.B. 1999) (considering motion to extend the close of discovery where movant had not taken any depositions and filed discovery on the last day); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848 (TTAB 2000)(seeking an extension of one month to comply with the Board's ordered discovery, not one day). None involves a single day extension of time. In contrast to those cases, here, the significant quantity of discovery requests served by Applicant, coupled with the unavailability of Opposer's Managing Counsel, and the complete lack of prejudice to Applicant provide good cause to justify an extension of a single day to respond to Requests for Admissions.

B. Although Unnecessary, Opposer Advised Applicant of its Request and Sought Applicant's Consent to the Extension of Time, Which Applicant Unreasonably Refused.

Although the non-movant's consent it not necessary for the Board to grant an extension of time, Opposer sought Applicant's consent for an extension hoping that the parties could avoid burdening the Board with a motion for a one-day extension of time. Opposer attempted to contact Applicant's counsel via telephone and email on October 4, 2010. James Decl. at ¶ 4. Specifically, Mr. James placed two calls to Applicant's counsel's office. During the first call, Mr. James spoke with Mr. Washburn and was told initially that Ms. Hendricks, lead counsel for Applicant, was unavailable, but that she was checking her voice mails. *Id.* Accordingly, Mr. James left a voicemail for Ms. Hendricks requesting Applicant's consent to the extension of time. *Id.* Mr. James followed the first call with an email to Ms. Hendricks and Ms. Oliphant, another attorney for Applicant. James Decl. at ¶ 2. Hendricks Aff. at ¶ 5. Having received no response to either the voice mail or email, Mr. James placed a second call seeking to speak with Ms. Hendricks or Ms. Oliphant, but was informed that Ms. Oliphant was out of the office and

that Ms. Hendricks had left the office for the day. James Decl. at ¶ 5; Washburn Aff. at ¶ 3. Later that afternoon, Opposer filed the present motion seeking a one-day extension of time; and, the next day, Opposer served its discovery responses. James Decl. at ¶¶ 5, 6.

Ms. Hendricks did not respond to either that voice mail or email from October 4, 2010. Still hoping to avoid burdening the Board with a motion for a one-day extension of time, later in the week, Mr. James left a voice mail with Ms. Hendricks and emailed Ms. Hendricks and Ms. Oliphant to inquire if Applicant was willing to stipulate to that extension, so that the motion could be withdrawn. James Decl. at ¶ 7. Ms. Hendricks finally responded to Opposer's request for Applicant's to consent to the extension via email on Monday October 11, 2010. James Decl. at ¶ 8. In that email, Applicant refused to consent to the extension, but did not provide any reason for its refusal to do so. *Id.*

Even in its Response Brief, Applicant provides no justification for its refusal to consent to the one-day extension of time. Instead, it is apparent that its refusal is merely a tactic to gain a perceived advantage in this proceeding. Applicant's lack of any good-faith basis for the refusal to consent to the one-day extension is out of step with expected standards of civility and behavior in the Patent and Trademark Office. Furthermore, Applicant's refusal to consent to a single day extension of time and its subsequent opposition to this motion unnecessarily drives up the cost of litigation.

C. <u>Applicant's Response Unjustifiably Attacks the Content of Opposer's Responses to the Requests for Admissions.</u>

Lacking any good-faith justification for opposing the one-day extension, Applicant's Response Brief instead complains of the content of Opposer's Responses to the Requests for Admissions and seemingly attempts to treat the Response Brief as a motion to test the sufficiency thereof. Indeed, the Board seemed to construe the Response Brief as such in its

October 28, 2010 Order, Dckt. No. 26. However, those attacks are both procedurally and substantively unfounded.

Procedurally, a motion to test the sufficiency of responses to a requests for admission must "be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement." 37 C.F.R. §2.120(h). Applicant's Response Brief contains no such statement because there has been no conference or correspondence regarding the substance of the requests for admissions. In fact, the Response Brief is the first time that Applicant has so much as mentioned any concern regarding the content of Opposer's Responses to the Requests for Admission.[1] Thus, if Applicant's Response Brief is to be construed as a motion to test the sufficiency of Opposer's Responses to the Requests for Admissions, it must be denied or stricken for failure to comply with 37 C.F.R. §2.120(h).[2]

Moreover, the complaints regarding the substance of Opposer's responses are unjustified. For example, Applicant complained that Opposer denied its Request for Admission No. 1 that Opposer "Admit that Opposer does not promote, offer and distribute goods under its marks to liquor stores." Importantly, Applicant served a series of similar, but slightly different requests seeking admissions that Opposer does not sell its products "to liquor stores **for resale to**

---

1 Applicant did not even mention Opposer's Responses to the Requests for Admissions in a letter sent to Opposer October 25, 2010, the same day that Applicant filed its Response Brief. *See* James Decl. ¶9. Thus, Applicant had Opposer's responses for over twenty days and never so much as mentioned any concern with the content of the responses until it filed its Response Brief.

2 Opposer respectfully submits that the proceeding should not be suspended under Trademark Rule 2.127(d) since Opposer's Motion for an Extension of Time is not a potentially dispositive motion. Even if Applicant's response could be construed as a motion to test the sufficiency of Opposer's Responses to the Requests for Admissions (which Opposer submits that it should not be) the suspension should be governed by Rule 2.120(h), which expressly provides that the time for a party to respond to outstanding discovery requests or to appear for any noticed discovery deposition is not tolled.

consumers", which Opposer admitted. *See* Request for Admission No. 57; Hendricks Aff., p. 19. Clearly, Applicant itself drew a distinction between a "sale to a liquor store" and a "sale to a liquor store for resale to consumers." Opposer accurately denied that it does not promote, offer and distribute goods under its marks to liquor stores, explaining that it "promotes, offers and distributes goods to all classes of consumers including proprietors, owners and employees of liquor stores." Response to Request for Admission No. 1; Hendricks Aff. p. 3-4. Indeed, an owner or manager of a liquor store can walk into one of Opposer's restaurants and purchase lunch for his or her employees using a company credit card. That business is well within the class of consumers to which Opposer promotes offers and distributes its goods. Moreover, in response to the Requests for Admissions as to whether Opposer sells a certain product **to** liquor stores, *see e.g.* Request for Admission No. 87, Opposer admitted that it does not sell that product **in** liquor stores, but denied that it does not sell the product to liquor stores for the reasons explained above. Even though Opposer was not obligated to admit that it did not sell such products **in** liquor stores, it did so for clarity and to avoid unnecessarily prolonging the discovery process. Thus, Applicant's attacks on the substance of Opposer's Responses to the Requests for Admissions are entirely unfounded. In fact, Opposer's Responses are not only sufficient, but they contain clear explanations of the basis for any denials. Applicant's complaint regarding the sufficiency of those Responses is merely a smoke-screen for its unreasonable opposition to Opposer's request for a one-day extension of time. As such, they should not be considered by the Board.

WHEREFORE, Opposer respectfully requests that the Board grant it a one-day extension of time to serve its Responses to Applicant's Requests for Admissions and remove this proceeding from suspension.

Respectfully submitted,

McDONALD'S CORPORATION

Date: November 3, 2010

By: /Lawrence E. James, Jr./
One of the Attorneys for Opposer

Robert E. Browne
Michael G. Kelber
John A. Cullis
Lawrence E. James, Jr.
NEAL, GERBER & EISENBERG, LLP
2 N. LaSalle Street, Suite 2200
Chicago, IL 60602
(312)269-8000

CERTIFICATE OF SERVICE

I, Lawrence E. James, Jr., state that I served a copy of the foregoing OPPOSER'S REPLY IN SUPPORT OF ITS MOTION FOR AN EXTENSION OF TIME To SERVE RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS TO OPPOSER, via first class U.S. mail and email, postage pre-paid, upon:

Katherine Hendricks
HENDRICKS & LEWIS PLLC
901 Fifth Ave., Ste 4100
Seattle, WA 98164

on this November 3, 2010.

/Lawrence E. James, Jr./
Lawrence E. James, Jr.

NGEDOCS: 1748269.3

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

McDONALD'S CORPORATION,	)	
	)	
Opposer,	)	Opposition No. 91192099
	)	
v.	)	
	)	
McSWEET, LLC,	)	Serial No. 77/722,272
	)	
Applicant.	)	

DECLARATION OF LAWRENCE E. JAMES JR.

I, Lawrence E. James, Jr., hereby declare that I am an attorney admitted to practice before the Supreme Court of the State of Illinois and before the United States Patent and Trademark Office, (Registration No. 63395). I am one of the attorneys representing Opposer, McDonald's Corporation, in the above-identified Opposition, and this declaration is filed in support of Opposer's Motion for an Extension of Time to Serve Responses to Applicant's First Set of Requests for Admission to Opposer. If called as a witness in this proceeding, I could and would state competently as follows:

1. I completed a first draft of the Responses to Applicant's First Set of Requests for Admissions to Opposer on September 9, 2010. Thereafter, I continued to revise the responses.

2. Opposer's Managing Counsel, Jennifer O'Malley, was out of the office the week of September 26, 2010, to attend a mandatory conference for in-house counsel.

3. I spoke with Ms. O'Malley extensively concerning Opposer's responses to Applicant's First Set of Requests for Production and First Set of Requests for Admissions on Monday, October 4, 2010, but we were unable to complete the Responses to the Requests for Admissions on that day.

4. On Monday, October 4, 2010, I placed two calls to Applicant's counsel at Hendricks & Lewis, LLC. Mr. Washburn of Applicant's counsel's office answered both calls. During the first call, I asked to speak with Ms. Hendricks, counsel for Applicant, but was told that she was unavailable and that she was checking her voice mail. I asked Mr. Washburn to transfer me to Ms. Hendricks' voice mail and left her a voice mail message asking if Applicant would consent to a one-day extension of time for Opposer to serve its Responses to the Requests for Admissions.

5. That same day, I also sent an email message to Ms. Hendricks and Caitlin Oliphant, another attorney for Applicant, asking if Applicant would consent to a one-day extension of time for Opposer to serve its Responses to the Requests for Admissions. A true and correct copy of that email is attached as Exhibit A. Later that afternoon, having received no response from Applicant's counsel, I placed a second telephone call to Ms. Hendricks, which was answered by Mr. Washburn who informed me that Ms. Hendricks had left the office and that Ms. Oliphant was out of the office for the remainder of the week. Thereafter, I filed the present Motion for an Extension of time.

6. The following day, October 5, 2010, on behalf of Opposer, I served copies of the Opposer's Responses to Applicant's Requests for Admissions on Applicant's counsel via first class mail and via email to Ms. Hendricks and Ms. Oliphant. A true and correct copy of the email (without the attached responses) is attached hereto as Exhibit B.

7. Later that same week, having received no response to the request for a stipulation, I placed another call to Ms. Hendricks and inquired again if Applicant would consent to the requested stipulation, so that the motion could be withdrawn. I then sent an email to Ms.

Hendricks and Ms. Oliphant on Friday, October 8, 2010, inquiring if Applicant would consent to the requested stipulation. A true and correct copy of that email is attached hereto as Exhibit C.

8. I did not receive any response from Applicant's counsel until October 11, 2010, when I received an email from Ms. Hendricks refusing to consent to an extension, and lacking a reason for Applicant's refusal to consent to an extension. A true and correct copy of that email response is attached hereto as Exhibit D.

9. A true and correct copy of correspondence sent to Opposer from Applicant on October 25, 2010, is attached hereto as Exhibit E. That correspondence does not mention any concern with Opposer's Responses to Applicant's First Set of Requests for Admissions to Opposer.

I hereby declare under penalty of perjury under the laws of the United States that the above is true and correct based on my own knowledge or on information supplied to me by others which I believe to be true.

Dated: November 3, 2010

Lawrence E. James, Jr.
Counsel for Opposer

NGEDOCS: 049872.4395:1748581.1

EXHIBIT A

James Jr., Lawrence E.

From: James Jr., Lawrence E.
Sent: Monday, October 04, 2010 4:19 PM
To: Katherine Hendricks; 'Caitlin A. Oliphant'
Cc: Browne, Robert E.; Cullis, John A.
Subject: McDonald's Corp. v. McSweet, LLC - Opposition No. 91192099

Kate,

As follow up to the voice-mail message that I left for you, please let me know if you will consent to a one-day extension of time for McDonald's Responses to Applicant's First Set of Requests for Admissions to Opposer, which are due today. Please advise us by the close of business (5:00 CST) today, because we will have to file a request for an extension of time with the Board if we do not receive your consent.

Thanks,

-Lee

Lee James
NEAL ▪ GERBER ▪ EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street ▪ Suite 2200
Chicago IL ▪ 60602-3801
Phone: (312) 269-8266 / Fax: (312) 750-6553
E-mail: ljames@ngelaw.com
www.ngelaw.com

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EXHIBIT B

James Jr., Lawrence E.

From: James Jr., Lawrence E.
Sent: Tuesday, October 05, 2010 6:57 PM
To: Katherine Hendricks; 'Caitlin A. Oliphant'
Cc: Browne, Robert E.; Cullis, John A.; Turner, Mike R.
Subject: McDonald's Corp. v. McSweet - Discovery Responses
Attachments: Responses to Applicant_s_First_Set_of_Requests_for_Production_to_Opposer.pdf; Responses_to_First_Set_of_RFAs.pdf

Kate and Caitlin,

Attached are McDonald's Responses to Applicant's First Set of Requests for Admissions and Applicant's First Set of Requests for Production. Hard copies have been sent via U.S. Mail.

Regards,

-Lee

Lee James
NEAL ▪ GERBER ▪ EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street ▪ Suite 2200
Chicago IL ▪ 60602-3801
Phone: (312) 269-8266 / Fax: (312) 750-6553
E-mail: ljames@ngelaw.com
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EXHIBIT C

James Jr., Lawrence E.

From: James Jr., Lawrence E.
Sent: Friday, October 08, 2010 7:27 PM
To: Katherine Hendricks; 'Caitlin A. Oliphant'
Cc: Browne, Robert E.; Cullis, John A.
Subject: McDonald's Corp. v. McSweet, LLC - Opposition No. 91192099

Kate and Caitlin,

I am writing as follow up to my email from Monday, October 4, and the multiple voice-mail messages left this week inquiring if you will consent to the one-day extension of time that we have sought for service of Opposer's Responses to the First Set of Requests for Admissions in the above referenced proceeding. Please let us know if you are willing to stipulate to that extension, so that we can withdraw our motion and avoid unnecessarily burdening the Board with it.

Regards,

-Lee

Lee James
NEAL ▪ GERBER ▪ EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street ▪ Suite 2200
Chicago IL ▪ 60602-3801
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EXHIBIT D

James Jr., Lawrence E.

From: Katherine Hendricks [Kh@hllaw.com]
Sent: Monday, October 11, 2010 3:28 PM
To: James Jr., Lawrence E.
Subject: RE: McDonald's Corp. v. McSweet, LLC - Opposition No. 91192099
Attachments: image001.gif

Dear Lee:

McSweet LLC does not stipulate to the extension McDonald's requested.

As I understand it, you called twice last Monday afternoon to request an extension. As you were advised, I had left the office because I was not feeling well. Caitlin was out of the office and not expected in all week. You then filed our motion, making the prior telephone request moot. I am aware of one voicemail message following.

Kate

Katherine Hendricks
Partner
Hendricks & Lewis
Tel: (206) 624-1933
Fax: (206) 583-2716
Email: kh@hllaw.com
Web: http://www.hllaw.com

United States Treasury Regulations require us to disclose the following: Any tax advice included in this document and its attachments was not intended or written to be used, and it cannot be used, for the purpose of avoiding penalties under the Internal Revenue Code.

This email message and any attachments are confidential and may be privileged. If you are not the intended recipient, please destroy all copies of this message and any attachments without reading or disclosing their contents. Thank you.

From: James Jr., Lawrence E. [mailto:ljames@ngelaw.com]
Sent: Friday, October 08, 2010 5:27 PM
To: Katherine Hendricks; Caitlin A. Oliphant
Cc: Browne, Robert E.; Cullis, John A.
Subject: McDonald's Corp. v. McSweet, LLC - Opposition No. 91192099

Kate and Caitlin,

I am writing as follow up to my email from Monday, October 4, and the multiple voice-mail messages left this week inquiring if you will consent to the one-day extension of time that we have sought for service of Opposer's Responses to the First Set of Requests for Admissions in the above referenced proceeding. Please let us know if you are willing to stipulate to that extension, so that we can withdraw our motion and avoid unnecessarily burdening the Board with it.

Regards,

-Lee

Lee James
NEAL ▪ GERBER ▪ EISENBERG

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Chicago IL ▪ 60602-3801
Phone: (312) 269-8266 / Fax: (312) 750-6553
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EXHIBIT E

HENDRICKS & LEWIS PLLC
901 Fifth Avenue Suite 4100 Seattle, Washington 98164
TEL: (206) 624-1933 FAX: (206) 583-2716 WEB: www.hllaw.com

October 25, 2010

John A. Cullis, Esq.
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 2200
Chicago, Illinois 60602-3801

Re: McDonald's Corporation v. McSweet, LLC, Proceeding No. 91192099

Dear Mr. Cullis:

This letter is in response to your September 28, 2010, letter regarding the substance of the discovery conference on January, 7, 2010, between McDonald's Corporation ("McDonalds") and McSweet, LLC ("McSweet") in Proceeding No. 911922099, and the proposed stipulations made therein.

During the discovery conference, we do not recall having any discussion regarding the merits of the claims and defenses; however, we are happy to discuss it in the future.

1. **Temporal Limitation of Discovery**

In response to McDonald's proposed temporal limitation of discovery, McSweet agrees that McDonald's will not be obligated to produce documents with respect to its trademark policing and acquisition efforts dating prior to January 1, 2003.

2. **Production of Documents**

Applicant agrees that documents previously produced in Proceeding No. 91178758 ("McSweet I"), need not be produced in the present proceeding to avoid unnecessary duplication of document production. The parties further agreed that this stipulation is not to be construed to prevent either party from seeking additional document production in the present proceeding beyond the scope of the document production in McSweet I.

The remainder of your discussion regarding documents goes beyond the scope of what Applicant was and is willing to agree to. Applicant does not agree that the use of all future documents produced in McSweet I will be used for this proceeding as well as treating all documents produced in this proceeding as already produced in McSweet I. McDonald's

proposed agreement strongly resembles a consolidation of proceedings, something to which Applicant has specifically declined to agree to.

Applicant is prepared to stipulate only to the use of documents that were previously produced in McSweet I in this present proceeding.

3. Proposed Amendments to the Protective Order in McSweet I

McSweet believes that the standard protective order offered by the Board modified to protect documents previously product should be entered into this proceeding. A proposed protective order is enclosed.

In accordance with paragraph 3 of the protective order, the order may be modified by written agreement of the parties or their attorneys. Accordingly, enclosed is a letter agreement modifying the protective order so that it reflects the same modification stipulated by both parties in the protective order entered into by the Trademark Trial and Appeal Board on June 18, 2008, in McSweet I, and to modify the protective order to permit the use and production of all documents previously produced in McSweet I within this proceeding. We have also enclosed two copies of a draft protective order for entry in this proceeding which reflects the change of proceeding numbers and a modification stipulated in McSweet I and the modification to permit the use and production of all documents previously produced in McSweet I within this proceeding.. Please have McDonald's sign both copies and forward them to us so that it can be executed by both parties in this proceeding.

4. Expert Discovery

The expert proposal you now make is not something we discussed. Irrespective of the proposed changes to FRCP 26, McSweet did not and does not stipulate to McDonald's proposals regarding expert discovery. McDonald's suggestion that its proposal is "consistent with the proposed amendments to FRCP 26" mischaracterizes the proposed changes to FRCP 26 which do not limit **all** discovery regarding the communications between counsel and an expert. Further, the changes to FRCP 26 have not yet taken effect and do not currently apply to this proceeding.

This should resolve the outstanding issues concerning McDonald's proposals discussed during the discovery conference. Please contact us regarding your approval of paragraph (3)

regarding the entry of the standard protective order offered by the Board modified to protect documents previously produced.

Sincerely,

HENDRICKS & LEWIS

Caitlin A. Bellum

Enclosure

HENDRICKS & LEWIS PLLC
901 Fifth Avenue Suite 4100 Seattle, Washington 98164
TEL: (206) 624-1933 FAX: (206) 583-2716 WEB: www.hllaw.com

October 25, 2010

John A. Cullis, Esq.
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 2200
Chicago, Illinois 60602-3801

Re: McDonald's Corporation v. McSweet, LLC, Proceeding No. 91192099

Dear Mr. Cullis:

The parties hereby agree that the standard protective order ("Protective Order") offered by the Board shall govern the above noted matter ("Asparagus").

In accordance with paragraph 3 of the Protective Order, the parties wish to modify the Protective Order so that it contains the same modifications stipulated by both parties in the protective order entered by the Trademark Trial and Appeal Board on June 18, 2008, in Proceeding No. 91178758 ("McSweet I"). The parties also wish to modify the Protective Order to permit the use and production of all documents previously produced in McSweet I within this proceeding.

IN WITNESS WHEREOF, the parties hereto have executed this letter agreement as of the date last indicated below.

Attorney for Applicant
Caitlin A. Bellum
Hendricks & Lewis, PLLC

Caitlin A Bellum
Name

10/25/10
Date

Attorney for Opposer
John A. Cullis
Neal, Gerber & Eisenberg, LLP

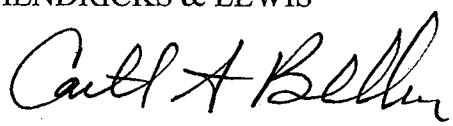
Name

Date

{93378.DOC}

Sincerely,

HENDRICKS & LEWIS



Caitlin A. Bellum

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

In the Matter of:
Application Serial No. 77/722,272
Published in the *Official Gazette*
September 1, 2009

McDONALD's CORPORATION,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91192099
	)	
McSWEET, LLC,	)	
	)	Serial No. 77/722,272
Applicant.	)	

STIPULATED ORDER AS TO PROVISIONS FOR PROTECTING CONFIDENTIALITY OF INFORMATION REVEALED DURING BOARD PROCEEDING

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, either the parties have agreed to be bound by the terms of this order, in its standard form or as modified by agreement, and by any additional provisions to which they may have agreed and attached to this order, or the Board has ordered that the parties be bound by the provisions within. As used in this order, the term "information" covers both oral testimony and documentary material.

Agreement of the parties is indicated by the signatures of the parties' attorneys and/or the parties themselves at the conclusion of the order. Imposition of the terms by the Board is indicated by signature of a Board attorney or Administrative Trademark Judge at the conclusion of the order. If the parties have signed the order, they may have created a contract. The terms are binding from the date the parties or their attorneys sign the order, in standard form or as modified or supplemented, or from the date of imposition by a Board attorney or judge.

TERMS OF ORDER

1) Classes of Protected Information.

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

Confidential -Material to be shielded by the Board from public access.

Highly Confidential -Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

Trade Secret/Commercially Sensitive -Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

All documents produced with the designation 'CONFIDENTIAL," "HIGHLY CONFIDENTIAL" or "TRADE SECRET/COMMERCIALLY SENSITIVE" shall only be used for the purpose of this Opposition.

2) Information Not to Be Designated as Protected.

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

3) Access to Protected Information.

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.

- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel** , including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.

- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.

- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

Parties and their attorneys shall have access to information designated as confidential or highly confidential, subject to any agreed exceptions.

Outside counsel, but not in-house counsel, shall have access to information designated as trade secret/commercially sensitive.

Independent experts or consultants , non-party witnesses, and any other individual not otherwise specifically covered by the terms of this order may be afforded access to confidential **or** highly confidential information in accordance with the terms that follow in paragraph 4.

Further, independent experts or consultants may have access to trade secret/commercially sensitive information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

4) Disclosure to Any Individual.

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual.

No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

5) Disclosure to Independent Experts or Consultants.

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

6) Responses to Written Discovery.

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

7) Production of Documents.

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, or previously provided document in Proceeding No. 91178759then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure

without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

8) Depositions.

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

9) Orders to Produce Protected Information.

In the event that a receiving party is ordered by another court or governmental entity to produce the Protected Information of the producing party, the receiving party shall notify the producing party immediately of that order and, if same order is in writing, shall provide the producing party with a copy of said order.

10) Protected Information Reveal During Depositions.

In the event that a deposition in this action is, at the request of a party, attended by a person not authorized to receive Protected Information, then any other party may have such person excluded from the deposition during any portion(s) of the examination that it reasonably believes may result in the disclosure of its Protected Information.

Documents, things, or deposition testimony requested or obtained through subpoenas to the parties or non-parties served in connection with this proceeding may be designated by the subpoenaed party or non-party as Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive within the meaning of this Protective Order provided that such non-parties agree to be bound by the terms of this Protective Order and, if so, the

Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information so subpoenaed and designated shall be governed by the terms of this Protective Order.

11) Interviews or Testimony Regarding Protected Information.

A person not otherwise listed under Paragraph 3 may be interviewed, may be examined as a witness at deposition or at trial and may testify concerning Protected Information as follows:

(a) An employee or a former employee of a party or of the party's parent company, corporate affiliates, or subsidiaries may be examined and may testify concerning any Protected Information produced by that party;

(b) A present or former consultant to a party may be examined and may testify concerning any Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information produced by that party which was lawfully communicated to such consultant; and

(c) A non-party who has had any contact or relationship with either party may be interviewed and examined and may testify:

i. Concerning any Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information which was lawfully communicated between the non-party and the producing party; and

ii. Concerning any Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information of either party which documentary or testimonial evidence establishes was lawfully communicated between the non-party and the producing party.

12) Disclosure of Protected Information to Parties' Employees or Affiliates.

Nothing herein shall prevent disclosure of any Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information by the party producing such Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information, to (a) any employee or officer of the producing party or (b) any person no longer affiliated with the producing party, who either authored, in whole or in part, or received the Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information prior to the initiation of this Opposition.

13) Filing Notices of Reliance.

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

14) Briefs.

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

15) Handling of Protected Information.

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

16) Redaction; Filing Material With the Board.

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied n anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record.

Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. Occasions when a whole document or brief must be submitted under seal should be very rare.

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes

or containers shall be prominently stamped or marked with a legend in substantially the following form:

CONFIDENTIAL

This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.

17) Acceptance of Information; Inadvertent Disclosure.

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

Upon prompt notice by the producing party showing that the information was inadvertently disclosed and designating the information confidential, the receiving party shall return the originals and all copies of the documents or things containing the Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information so that the producing party may designate them as containing such information.

18) Challenges to Designations of Information as Protected.

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected must be made substantially contemporaneous with the designation, or as soon as practicable after the basis for challenge is known. When a challenge is made long after a designation of information as protected, the challenging party will be expected to show why it could not have made the challenge at an earlier time. In any disagreement over the designation of Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information, the producing party bears the ultimate burden of showing that the designated information is Confidential Information, Highly Confidential Information, or Trade Secret/Commercially Sensitive Information. No party to this action shall be obligated to challenge the propriety of any designation, and a failure to do so shall not act as a waiver of its right to make a subsequent attack on the propriety of such designation, nor shall such failure to challenge constitute an admission that any information is, in fact, confidential.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

19) Board's Jurisdiction; Handling of Materials After Termination

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties agree that one archival copy of evidence and briefs may be retained by counsel, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of both proceedings, the parties and their attorneys shall return to each disclosing party or certify in writing the destruction of all Protected Information disclosed during the proceedings, and shall include any briefs, memoranda, summaries, and the like, which are not Work Product but which discuss or in any way refer to Protected Information.

20) Other Rights of the Parties and Attorneys.

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.

Any party for good cause may apply to the Board for a modification of this Protective Order.

By signatures of their representatives affixed below, each of the parties warrants that it knowingly and willingly enters into this Stipulation.

MCDONALD'S CORPORATION

By:_____
Jennifer A. O'Malley, Esq.
Managing Counsel
McDonald's Corporation

Dated:_____

MCSWEET, LLC

By:_____
James B. McCaslin
Owner
McSweet, LLC

Dated:_____

Dated:

SO ORDERED

TRADEMARK TRIAL AND
APPEAL BOARD