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

Proceeding	92048989
Party	Defendant Van Nelle Tabak Nederland BV
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TOP TOBACCO, L.P.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92048989
)	
VAN NELLE TABAK NEDERLAND, BV,)	
)	
Respondent.)	
)	
)	

**RESPONDENT'S RESPONSE TO MOTION TO COMPEL DISCOVERY
AND FOR EXTENSION OF DISCOVERY AND TRIAL PERIODS**

Respondent Van Nelle Tabak Nederland, BV ("Respondent") hereby responds to Petitioner Top Tobacco, LP's Motion to Compel Discovery and for Extension of Discovery and Trial Periods and for its Response states as follows.

I. ARGUMENT

1. Top Tobacco's Motion to Compel is Based on a False Statement of the Issues

This proceeding involves an effort by Top Tobacco to preempt Respondent from using in the U.S. a mark which has been used by Respondent for tobacco products for many years in many countries outside of the U.S. The issues in this proceeding are whether U.S. Registration No. 2,950,896 ("ROUTE 66" plus design for tobacco and tobacco products), which issued as a registration on May 17, 2005, and U.S. Registration No. 3,328,623 ("ROUTE 66" for tobacco products), which issued as a registration on August 21, 2007, should be cancelled on the grounds of abandonment.

Top Tobacco has based its Motion to Compel almost entirely on a false statement of the issues to be decided by the Board. It has shown various forms of the "ROUTE 66" mark, and

has falsely stated that “Respondent has taken the position that these marks are not related to each other, and therefore information outside of Registration Nos. ‘623 and ‘896 is not relevant, and therefore not discoverable.” (Mot. p. 4). In fact, Respondent has been completely willing to provide and has provided all information and documents pertaining to the use and intent to use the “ROUTE 66” mark in any form in the U.S. since the filing date of the application which issued as the first of the two registrations to issue i.e. February 6, 2003.

Respondent accepted Top Tobacco’s definition of the “ROUTE 66 Mark” in Top Tobacco’s discovery requests as including “ROUTE 66” in all of the forms identified by Top Tobacco, and Respondent’s responses to Top Tobacco’s discovery requests are provided in terms of the “ROUTE 66 Mark” as defined by Top Tobacco (Mot. Exs. C and E).

The lack of any limitation as to the form of the ROUTE 66 mark is also apparent in Respondent’s Supplemental Responses (attached hereto together with Respondent’s letter of December 11 as Exhibit A), which were prepared and served on December 11, 2008, (the same day on which the Motion to Compel was precipitously and wastefully filed) in response to Top Tobacco’s letter of November 21, 2008.

Petitioner has objected only to providing information and documents relating to use and intent to use prior to February 6, 2003, the filing date of the application which issued as the first of the two registrations at issue in the proceeding. Such information is simply not relevant to whether the two registrations at issue should be cancelled on the grounds of abandonment.

Top Tobacco’s own Exhibit H reflects the fact that following Respondent’s letter concerning discovery of September 16, 2008, Top Tobacco did nothing for over two months, until, in response to Respondent’s letter concerning discovery deficiencies of November 3, Top Tobacco finally followed up on November 21. Without warning or waiting for a response, Top

Tobacco then filed its motion to compel. The discovery issues raised in the Motion to Compel can be divided into two categories: (1) the issue of whether Top Tobacco is entitled to discovery directed to the cancelled Registration No. 1,686,628, and use and intent to use Respondent's mark prior to February 6, 2003, and (2) other discovery issues that Respondent has addressed fully in Respondent's Supplemental Answers to Petitioner's First Set of Interrogatories and supplemental document production served on Petitioner on December 11, 2008. Thus, the only issue before the Board is whether Respondent should be compelled to provided discovery pertaining to cancelled Registration No. 1,686,628.

2. Discovery Relating to Registration No. 1,686,628 and Use and Intent to Use Prior to February 6, 2003, Is Not Relevant

The Board dismissed the proceeding with respect to Registration No. 1,686,628 in its Order dated May 27, 2008, in which it wrote:

This Cancellation was instituted against U.S. Registration Nos. 1686628, 2950896, and 3328623. It has come to the attention of the Board that U.S. Registration No. 1686628 should have been cancelled by the Director before the institution of the instant cancellation proceeding. However, due to Office error, U.S. Registration No. 1686628 was not automatically cancelled. The error has been corrected and U.S. Registration No. 1686628 has now been cancelled by the Director under Section 8 of the Trademark Act of 1946, 35 U.S.C. § 1058.

In view thereof, the cancellation proceeding will move forward on U.S. Registration Nos. 2950896 and 3328623 only.

Board Order dated May 27, 2008. Registration No. 1,686,628 has been cancelled, so it cannot be the proper subject of this cancellation proceeding, nor of discovery served in this cancellation proceeding.

Top Tobacco argues that the registration is relevant because it Respondent claimed ownership of the registration in the applications which issues as the registrations at issue in this proceeding. However, as the prosecution history files show, the claim of ownership was simply

in response to the Examining Attorney's requirement of a claim of ownership based of the then technically "live" registration. The registration should have been automatically cancelled years before the institution of this cancellation proceeding, and, accordingly, the Board denied Petitioner's request to enter judgment in its favor on the expired registration, and instead dismissed it altogether from the subject proceeding (Board Order dated May 27, 2008).

As the Board wrote in *Hawaiian Host, Inc. v. Rowntree MacKintosh PLC*, 225 USPQ 628, 630 (TTAB 1985):

The fact that applicant allowed its U.S. registration to expire does not establish an abandonment of its rights in the mark. **More importantly, however, is the fact that this is a new application and the circumstances surrounding applicant's prior application and resulting registration are of no consequence here.** A foreign national qualified under the provisions of Section 44(b), such as this applicant, seeking registration under Section 44(e) of the Act needs not allege or demonstrate use of the mark on or before the filing date of the U.S. application for registration.

Hawaiian Host, Inc. v. Rowntree MacKintosh PLC, 225 USPQ 628, 630 (TTAB 1985)
(emphasis added).

Top Tobacco seeks to rely on *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 USPQ 147 (TTAB 1985). This holding is totally inapposite. *Sunkist* simply held that sales volumes since 1931 were relevant to issues of abandonment and likelihood of confusion involving a registration which claimed use since 1931. *Id.* at 149. Respondent did not base its applications on use, but, as stated, has provided Top Tobacco with all information and documents pertaining to its use and intent to use since the relevant date - - February 6, 2003.

Under established principles, the relevant time frame with respect to Top Tobacco's abandonment claims would begin when the '896 and '623 registrations actually issued. *Consolidated Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153, 1155 (TTAB 2002). Prior to these dates, there was a dispensation of use requirements in keeping with the Section 44(e) basis for

Respondent's registrations. *Id.* (citing *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575 (Fed. Cir. 1990)). However, in view of the requirements that applications under Section 44(e) also be based on good faith intent to use, Applicant has stated that it will provide information concerning use and intent to use as of the earliest application filing date.

3. Respondent Has Provided the "Other" Relevant Information and Documents Addressed in Petitioner's Motion to Compel

Respondent identified corporate principals Tim Jones, Bill Melton, and Graham Bolt in response to Interrogatory No. 3 in July 2008. Respondent has now identified additional relevant principals of Respondent and its affiliated U.S. subsidiary, Commonwealth Brands, Inc., in its Supplemental Answers to Interrogatories served December 11, 2008.

JL Gaddy Enterprises, Inc. bears no corporate relationship to Respondent and therefore information about JL Gaddy's principals was not provided in response to Interrogatory No. 2, which seeks the identity of principals of "each business, company, person or other entity affiliated with Respondent." *See* Respondent's Supplemental Answer to Interrogatory No. 2.

Respondent has also produced documents describing its internal document retention policies. These confidential documents were produced under cover letter dated December 11, 2008.

3. The Wholesale Extension of Discovery and Trial Periods Is Unwarranted

Petitioner has failed to avail itself of the original discovery period to notice the Rule 30(b)(6) deposition of Respondent or to take the deposition of principals which were identified as early as July 28, 2005, five months before discovery was to close. Further, as shown by Top Tobacco's own Exhibit H, it delayed for more than two months before following up on Respondent's letter of September 16 and only followed up after receiving Respondent's letter of November 3. However, to the extent that the identification of additional principals at

Commonwealth Brands, Inc. may have delayed the discovery deposition of these individuals in their personal capacities, Respondent would agree to an extension of the discovery deadlines for thirty days for the sole purpose of taking the individual depositions of those additional persons at Commonwealth Brands, Inc. identified in the Supplemental Responses.

III. CONCLUSION

For the forgoing reasons, Respondent requests that Petitioner's motion to compel discovery be denied and that the discovery period be extended for thirty days for the sole purpose of taking the individual depositions of those additional persons at Commonwealth Brands, Inc. identified in the Supplemental Responses.

Respectfully submitted,

/ Amy S. Cahill
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Counsel for Respondent
VAN NELLE TABAK NEDERLAND, BV

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Response to Motion to Compel Discovery and for Extension of Discovery and trial Periods is being mailed via first class mail, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara Klapper, Esquire and Gregory J. Leighton, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 31st day of December 2008.

s/Amy S. Cahill

Amy S. Cahill

308LT:20399:75101:1:ALEXANDRIA

EXHIBIT A

December 11, 2008

Lara V. Klapper, Esq.
Michael G. Kelber, Esq.
Neal Gerber Eisenberg
Two North LaSalle Street, Ste. 2200
Chicago, Illinois 60602

Amy S. Cahill
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RE: Top Tobacco, L.P. v. Van Nelle Tabak Nederland BV;
Cancellation No. 92048989

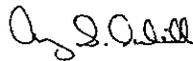
Dear Ms. Klapper and Mr. Kelber:

We enclose herewith:

- (1) Respondent's First Supplemental Answers to Petitioner's First Set of Interrogatories, and
- (2) Respondent's Supplemental Document Production, Document Nos. VN0196 - VN0276.

These answers and documents supplement our client's current discovery responses. Please note that many of the enclosed documents have been designated under the Stipulated Protective Order as CONFIDENTIAL – ATTORNEYS EYES ONLY and others as CONFIDENTIAL.

Very truly yours,



Amy S. Cahill

ASC:lms

cc: Brewster Taylor

- (b) The right to object on any ground to the use of said responses, or to the subject matter thereof, in any aspect of this or any other court action or judicial or administrative proceedings or investigation; and
- (c) The right to object on any ground at any time to other interrogatories, requests for production, requests for admission, or other discovery procedures involving or relating to the subject matter of these interrogatories.

3. Respondent is responding to Petitioner's interrogatories, and each interrogatory therein, as it interprets and understands that interrogatory with respect to the issues framed in connection with this proceeding. If Petitioner asserts an interpretation of any part of the interrogatory that differs from the understanding of Respondent, Respondent reserves the right to supplement or amend its responses and objections.

4. Respondent objects to each instruction, definition, and interrogatory to the extent it purports to impose any requirement or discovery obligation on Respondent greater or different from those imposed by the Federal Rules of Civil Procedure, the Trademark Rules of Practice, the discovery schedule in this case, or any other schedule or ruling that may be set forth by the Trademark Trial and Appeal Board, or other applicable rule or statute.

5. Respondent objects to each instruction, definition, and interrogatory to the extent it seeks information protected from disclosure by the attorney-client privilege, work product doctrine, or any other applicable privilege or immunity, including any applicable right of privacy.

6. Respondent objects to each instruction, definition, and interrogatory to the extent it calls for a privilege log with greater or different requirements from those prescribed by the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

7. Respondent objects to any request to identify privileged information, documents, or things generated after the filing date of this proceeding. Such material is privileged, and it is unduly burdensome to require the inclusion of any such material in any privilege log. Respondent does not waive any applicable privilege by inadvertent production of any privileged information.

8. Respondent objects to terms and phrases defined or used by Petitioner to the extent those terms and/or phrases are vague and/or ambiguous or beyond their customary meaning. To the extent Respondent adopts any terms or phrases defined or used by Petitioner, they are adopted solely for the sake of convenience in responding to these interrogatories, and Respondent does not accept or concede that any of the terms, phrases or definitions are appropriate, descriptive or accurate.

9. Respondent objects to each interrogatory to the extent that it seeks publicly available information that is equally available to Petitioner.

10. Respondent objects to each interrogatory to the extent it is overbroad in that it seeks information that is neither relevant nor reasonably calculated to lead to the discovery of admissible evidence relevant to the subject matter of this proceeding. Any inadvertent production of information not related to the subject matter of this litigation does not waive this objection.

11. Respondent objects to each interrogatory to the extent it is unduly burdensome insofar as it may be construed to require Respondent to compile information no longer available or to require Respondent to make an unduly burdensome search for information.

12. Respondent objects to each interrogatory to the extent it covers information and/or documents outside the possession, custody or control of Respondent.

13. In addition to these General Objections, Respondent has specific objections to certain definitions, instructions, and interrogatories as set forth below. Respondent does not waive any of these General Objections that may also be applicable to a specific interrogatory.

14. Respondent objects on the basis that the scope of the interrogatories violates the requirements of Federal Rule of Civil Procedure 26(g).

15. By making certain general and specific objections, Respondent does not waive other objections that might be applicable or become applicable at some time in the future. Respondent expressly reserves the right to assert additional objections which may become apparent in the course of producing information, documents, or things.

OBJECTIONS TO DEFINITIONS

1. Respondent objects to the defined term "Petitioner" to the extent it includes the phrase "as well as its predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees" as being vague, ambiguous and overly broad as Petitioner fails to identify or to give Respondent notice of the identity of Petitioner's predecessors, officers, directors, subsidiaries, divisions, representatives, employees, agents and assignees.

2. Respondent objects to the defined term "Respondent" to the extent Petitioner seeks to include within the penumbra of this definition any person or entity that is not properly within Respondent's control or any other person or entity that is not involved in and otherwise

has no connection to this proceeding, rendering Petitioner's interrogatories overly broad, unduly burdensome, irrelevant, and not likely to lead the discovery of admissible evidence.

3. Respondent objects to the defined term "person" in that it is overly broad and unduly burdensome and also to the extent that it exceeds the requirements for answering an interrogatory under Federal Rule of Civil Procedure 33.

4. Respondent objects to the defined term "identify" to the extent Petitioner seeks to add multiple, additional subparts to its interrogatories that exceed the allowable limit under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice, to the extent it renders Petitioner's interrogatories voluminous and overly burdensome, and to the extent it exceeds the requirements for answering an interrogatory under Federal Rule of Civil Procedure 33.

5. Respondent objects to the defined term "documents" to the extent Petitioner seeks to broaden the definition of "documents" provided by the Federal Rules of Civil Procedure, to the extent Petitioner seeks documents no longer in Respondent's possession, custody, or control, to the extent the definition seeks to include drafts or other preliminary versions of documents which are neither relevant nor likely to lead to the discovery of admissible evidence, and to the extent Petitioner seeks documents protected from disclosure by the attorney-client privilege, work product doctrine, or are otherwise immune from discovery.

OBJECTIONS TO INSTRUCTIONS

1. Respondent objects to Instruction No. 4 to the extent it exceeds or is otherwise inconsistent with the obligations to supplement discovery responses under the Federal Rules of Civil Procedure.

2. Respondent objects to Instruction No. 5 to the extent it calls for a privilege log with greater or different requirements from those prescribed by the Federal Rules of Civil Procedure or the Trademark Rules of Practice.

INTERROGATORIES

INTERROGATORY NO. 1. State the full name of Respondent as well as the full name of all of its respective affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest, and for each, identify its principal(s) and, if applicable, its state and country of organization.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it seeks information concerning Respondent's "affiliated and/or controlled businesses, companies, and other entities and each of their predecessors-in-interest" that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to a relevant time period, and to the extent it is not confined to the United States. Respondent also objects to this interrogatory as being vague with respect to the term "principal(s)." In addition, Respondent objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that Van Nelle Tabak Nederland BV was incorporated in the Netherlands on April 3, 1998. Respondent will also will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) subject to the protective order in this case.

SUPPLEMENTAL ANSWER: Subject to and without waiver of its forgoing objections, Respondent states that Tim Jones and William Melton are the relevant principals of its related company, Commonwealth Brands, Inc., which was wholly acquired by Respondent's

parent company, Imperial Tobacco Group, in April 2007. In addition, Respondent has produced organizational charts reflecting its corporate structure and the relationships between Respondent Van Nelle Tabak, Nederland, BV, Commonwealth Brands, Inc., and their parent company, Imperial Tobacco Group.

INTERROGATORY NO. 2: State the full name of each business, company, person, or other entity affiliated within Respondent that has at any time used the ROUTE 66 Mark in the United States in connection with cigarettes or any other product(s), and for each, identify its principal(s) and, if applicable, its state and country of organization.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period. Respondent also objects to this interrogatory as being vague with respect to the phrase “affiliated within Respondent.” In addition, Respondent objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states it has used the ROUTE 66 Mark in the United States in advertising and in commercial testing. Respondent states further that one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Respondent otherwise claims no use of the ROUTE 66 Mark on packaging of cigarettes sold in the United States since February 6, 2003.

SUPPLEMENTAL ANSWER: Subject to and without waiver of its forgoing objections, Respondent indentifies William Melton and Tim Jones as the persons affiliated with

Respondent's related company, Commonwealth Brands, Inc., with the most knowledge of the shipment of ROUTE 66 products from Commonwealth Brands, Inc. to J.L. Gaddy Enterprises, Inc. on May 8, 2008. There is no person "within Respondent" at J.L. Gaddy with knowledge of this transaction as there is no corporate connection between J.L. Gaddy and Respondent.

Subject to and without waiver of its forgoing objections, Respondent will rely on its extensive market testing conducted in the U.S. in 2005 and 2006 that included the ROUTE 66 brand. Respondent has produced the relevant market surveys and other internal documents to support its ongoing plans to launch the ROUTE 66 brand in the U.S. in response to Petitioner's document requests. Respondent also will rely, in part, on its past use of the ROUTE 66 brand abroad and on its corporate web site to support its defenses to Petitioner's abandonment claims in this proceeding. To this end, Respondent has produced samples of product advertisements used abroad and screen shot print outs from its English language web site www.imperial-tobacco.com showing its sales of the ROUTE 66 brand.

INTERROGATORY NO. 3. Identify by common commercial name each product that Respondent markets, distributes, sells, or offers for sale, or intends to market, distribute, sell or offer for sale, under or in connection with the ROUTE 66 Mark, and with respect to each such product:

- (a) set forth the actual geographic scope of such use;
- (b) set forth the annual actual volume of sales of the product in both dollars and units per year;
- (c) identify the years of such use; and
- (d) identify the persons most knowledgeable of such use, as well as all documents relating thereto.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory

as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Respondent otherwise claims no use of the ROUTE 66 Mark on packaging of cigarettes sold in the United States since February 6, 2003. Respondent states that future use may be in relation to any of the goods covered by U.S. Reg. No. 2,950,896 and U.S. Reg. No. 3,328,623. Moreover, with respect to future use, Respondent states as follows:

(a) Respondent intends to sell ROUTE 66 products throughout the United States. However, it is likely that the brand would be launched regionally first to identify any marketing revisions to be considered before expanding nationally.

(b) Not applicable.

(c) Not applicable.

(d) Tim Jones, Bill Melton, and Graham Bolt.

SUPPLEMENTAL ANSWER: Subject to and without waiver of its forgoing objections, Respondent will rely on its extensive market testing conducted in the U.S. in 2005 and 2006 that included the ROUTE 66 brand. Respondent has produced the relevant market surveys and other internal documents to support its ongoing plans to launch the ROUTE 66

brand in the U.S. in response to Petitioner's document requests. Respondent also will rely, in part, on its past use of the ROUTE 66 brand abroad and on its corporate web site to support its defenses to Petitioner's abandonment claims in this proceeding. To this end, Respondent has produced samples of product advertisements used abroad and screen shot print outs from its English language web site www.imperial-tobacco.com to support its sales of the ROUTE 66 brand abroad and to support its continued efforts to launch ROUTE 66 brand products in the U.S. Depending on the success of Respondent's tobacco products in the U.S., Respondent intends to expand use of its ROUTE 66 mark to additional products, including through licensing arrangements.

INTERROGATORY NO. 4: For each product identified in response to Interrogatory No. 3 identify the dates on which the ROUTE 66 Mark was first used or on which Respondent intends to first use the ROUTE 66 Mark: (i) anywhere in the United States and (ii) in interstate commerce.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent states that the ROUTE 66 Mark has been used in advertising on the Internet since at least as early as February 1, 2003, and has been used in commercial testing and research in the United States in 2006. In addition, one case of cigarettes was shipped in ROUTE 66 packaging from Commonwealth Brands, Inc. to JL Gaddy Enterprises, Inc. on May 8, 2008. Otherwise, Respondent claims no

use of the ROUTE 66 Mark in sales of cigarettes in the United States since February 6, 2003.

No decision has been made regarding the specific future launch date for ROUTE 66 products in the United States.

SUPPLEMENTAL ANSWER: Subject to and without waiver of its forgoing objections, Respondent states that it does not have a precise date for the planned introduction of the ROUTE 66 brand products in the U.S., but Respondent is in the process of printing packaging for its ROUTE 66 brand products for approval under the Master Settlement Agreement. Copies of proposed packaging have been produced. A copy of Respondent's application to join the Master Settlement Agreement has been produced. Print outs of JPEG images of packaging designed for researching U.S. sales of Respondent's tobacco products have been produced. A copy of an email from Respondent's advertising group forwarding proposed packaging for market research to Respondent's representatives dated October 19, 2005 has been produced.

Respondent will rely on its extensive market testing conducted in the U.S. in 2005 and 2006 that included the ROUTE 66 brand to support its ongoing efforts to launch the ROUTE 66 brand products in the U.S. Respondent has produced the relevant market surveys and other internal documents to support its ongoing plans to launch the ROUTE 66 brand in the U.S. in response to Petitioner's document requests. Respondent also will rely, in part, on its past use of the ROUTE 66 brand abroad and on its corporate web site www.imperial-tobacco.com to support its defenses to Petitioner's abandonment claims in this action. To this end, Respondent has produced samples of product advertisements used abroad and screen shot print outs from its English language web site www.imperial-tobacco.com showing its sales of the ROUTE 66 brand.

INTERROGATORY NO. 5: Identify every promotional effort, advertisement, commercial, catalogue, and/or promotional piece by which for each product identified in response to Interrogatory No. 3 was, is or will be advertised and promoted in the United States, and the associated expenditure and date of publication and/or distribution for each such ad (including production and media buys).

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it not confined to the relevant time period. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) subject to the protective order in this case.

SUPPLEMENTAL ANSWER: Respondent has spent considerable amounts in connection with its efforts to launch the ROUTE 66 brand in the U.S. These costs include the expense of professional marketing surveys conducted in 2005 and 2006, copies of which have been produced under protective order in response to Petitioner's Requests for Production of Documents, the creation of product packaging for use in U.S. markets, and the costs of complying with various regulatory requirements that precede U.S. tobacco sales, including application to the National Association of Attorneys General to participate in the Master Settlement Agreement and submission of related applications to the various states in which Respondent plans to offer ROUTE 66 brand tobacco products for sale. Respondent has produced, under protective order, a copy of its application to join the Master Settlement Agreement submitted to the National Association of Attorneys General, as well as print outs of

jpegs of proposed packaging for U.S. markets in response to Petitioner's requests for production of documents to support these costs incurred. In addition, Respondent has produced internal documents that show the proposed cost of conducting marketing surveys in the U.S., which surveys were eventually commissioned by Respondent.

INTERROGATORY NO. 7: Identify each package or label designer, advertising agency, market research expert or consultant who has performed or will perform services in connection with cigarettes or any other product(s) promoted or sold by Respondent under or in connection with the ROUTE 66 Mark, and, for each such entity, describe in detail the services performed and the inclusive dates of such services.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it is not confined to the relevant time period and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory as being vague with respect to the phrase "market research expert or consultant". Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

SUPPLEMENTAL ANSWER: Subject to and without waiver of the foregoing objections, Bataafsche, Teeken, Maatschappij of the Netherlands designed product packaging for Respondent's ROUTE 66 brand for purposes of performing market research in the U.S. Copies of jpegs showing the product packaging forwarded to Respondent by Bataafsche, Teeken,

Maatschappij have been produced. Respondent is in the process of printing packaging for its ROUTE 66 brand products and has produced images of the packaging.

INTERROGATORY NO. 10: Identify all agreements to which Respondent or any business, company, or other entity identified in response to Interrogatory Nos. 1 or 2 has been or is a party that refer or relate in any way to any ROUTE 66 designation, including all amendments and modifications thereto, and identify the persons most knowledgeable thereof and all documents relating thereto.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence to the extent that it seeks information concerning agreements that are not even reasonably related or relevant to any issue in this proceeding, to the extent it is not confined to the relevant time period, and to the extent it is not restricted to the United States. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) subject to the protective order in this case.

SUPPLEMENTAL ANSWER: Subject to and without waiver of the foregoing objections, Respondent states that it applied to join the Master Settlement Agreement in connection with its ROUTE 66 brand tobacco products and has produced, under protective order, a copy of its application to join the Master Settlement Agreement submitted to the National Association of Attorneys General in response. This application remained pending for over one year and was not approved until November 2007. The persons most knowledgeable of the

preparation and submission of this document are Graham Bolt and Simon Haines of Imperial Tobacco Group.

INTERROGATORY NO .11: Explain the reason(s) for Respondent's selection and adoption of its ROUTE 66 Mark, and identify all persons who participated in each such decisions as well as all documents relating thereto.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory as overly broad, unduly burdensome, and not reasonably calculated to lead to the discovery of admissible evidence because it seeks information that is not even reasonably related or relevant to any issue in this proceeding, because it is not confined to the relevant time period, and because it is not restricted to the United States. In addition, Respondent objects to this interrogatory to the extent because it seeks information that is protected from disclosure by the attorney-client privilege and/or work product doctrine. Respondent also objects to this interrogatory on the grounds that it includes multiple, discrete subparts that should be included in the total number of interrogatories for purposes of the allowable number permitted under the Federal Rules of Civil Procedure and/or Trademark Rules of Practice.

Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

SUPPLEMENTAL ANSWER: Subject to and without waiver of the forgoing objections, Respondent states that its decision to launch the ROUTE 66 brand in the U.S. was based on the company's long-term successful use of the ROUTE 66 mark overseas and its plans to expand its business model to include U.S. tobacco sales. The mark ROUTE 66 has been an important part of Respondent's corporate identity internationally for many years.

INTERROGATORY NO. 14: Describe the bases for Respondent's belief that it has not abandoned the ROUTE 66 Mark in the United States.

ANSWER: In addition to the incorporated General Objections, Objections to Definitions, and Objections to Instructions, Respondent specifically objects to this interrogatory because it seeks information that is protected from disclosure by the attorney-client privilege and/or work product doctrine. Respondent also objects to this interrogatory because it calls for legal conclusions or presents questions of law. Subject to and without waiver of the foregoing objections, Respondent will produce non-privileged documents sufficient for Petitioner to ascertain information responsive to this interrogatory pursuant to Fed. R. Civ. P. 33(d) and subject to the protective order in this case.

SUPPLEMENTAL ANSWER: As Petitioner filed its Petition to Cancel Respondent's registrations for ROUTE 66 less than three years after the registrations had issued, the burden is on Petitioner to produce evidence in support of its claims in the Petition. Moreover, Respondent need not specify in detail in advance of trial the evidence it intends to present in support of its position. TBMP § 414(7). Respondent otherwise refers to its supplemental answers herein.

Respectfully submitted,



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Counsel for Respondent
VAN NELLE TABAK NEDERLAND, BV

VERIFICATION

I, Trevor Williams, verify that I am currently the assistant company secretary of Imperial Tobacco Limited; that I am hereby signing the Supplemental Answers to Petitioner's First Set of Interrogatories, and I am authorized to do so; that the matters stated therein are not all within my personal knowledge; that I am informed that there is no single person at Van Nelle Tabak Nederland, BV ("Respondent") who has personal knowledge of all such matters; that the facts stated therein have been assembled by employees of and counsel for Respondent; and to the best of my present knowledge and information, believe that the facts so stated are true and accurate.

I declare, under penalty of perjury that the foregoing is true and accurate.

Date: _____

Trevor Williams

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Answer to Petitioner's First Set of Interrogatories is being mailed via first class mail, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara Klapper, Esquire and Gregory J. Leighton, Esquire, Neal, Gerber & Eisenberg LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this 11th day of December 2008.



Amy S. Cahill

308LT:20399:73164:1:ALEXANDRIA

December 11, 2008

Michael G. Kelber
NEAL GERBER EISENBERG LLP
Two North LaSalle Street
Chicago, IL 60602

Amy S. Cahill
(502) 681-0597
(502) 779-9805 FAX
acahill@stites.com

RE: *Top Tobacco, L.P. / Van Nelle Tabak Nederland*
Cancellation No. 92048989
C/M Code: 308LT/20399

Dear Mr. Kelber:

Thank you for your correspondence of November 21, 2008 and for Top Tobacco's first document production (Doc. Nos. Top66 0001-0036). We believe that many of the issues you raise regarding our client's discovery responses have been addressed in the supplemental responses recently served. To the extent your letter raises additional issues, those issues are addressed below.

Van Nelle's Responses to Top Tobacco's Discovery Requests

Cancelled Registration No. 1686,628 is not at issue and therefore discovery requests directed to that registration are not relevant to this proceeding. As we have already troubled the Board with this particular issue and received a clear ruling, I suggest that we agree on this point.

Discovery requests directed to Respondent's use of ROUTE 66 "in any format" is a related issue. The cases cited in support of our position that a Section 44(e) registrant need not show use in commerce in order to establish a right to registration in the U.S. are on point, whether or not decided at the summary judgment stage of the proceedings. Moreover, as is made clear in Respondent's supplemental discovery responses, Respondent will not rely on use in the United States to defend against your client's claims of abandonment, nor does it need to. Because Respondent concedes that it has not used ROUTE 66 in the U.S. to date, evidence of Respondent's use of ROUTE 66 in "any format" is equally inapplicable to these proceedings.

Because your client filed the Petition to Cancel Respondent's registrations less than three years after the registrations issued, your client is not entitled to a legal presumption of abandonment. To the contrary, both the burden of persuasion and the burden of coming forward with evidence remain on your client to prove abandonment. Respondent has produced all documents in its possession relating to its preparations to begin use in the U.S. Therefore, the record is complete with respect to Respondent's preparations to begin use, subject to possible supplementation should Respondent become aware of additional information and documents.

Michael G. Kelber, Esq.
December 11, 2008
Page 2

Interrogatory No. 1

As the case law demonstrates, a Registrant's use of a mark overseas, which mark is the subject of a Section 44(e) registration, is relevant only to the extent that it is evidence of the Registrant's good faith intent and ability to use the same mark in the United States for purposes of registration. See *Oromeccanica, Inc. v. Ottmar Botzenhardt G.m.b.H. & Co. KG*, 223 USPQ 59, 64 (TTAB 1983). Respondent will rely on its foreign use only for this purpose, as permitted by law, and to this end, has produced foreign advertisements and declarations from senior executives that establish with sufficiency that the ROUTE 66 mark has been used abroad for a number of years in connection with tobacco products, a fact well known to your client.

Interrogatory No. 2

Please see Respondent's Supplemental Answer to Interrogatory No. 2.

Interrogatory No. 13

Respondent has not begun use of ROUTE 66 on products sold in the United States. Therefore, Respondent's "intent not to resume use" of the mark, in any form, is not applicable to this proceeding.

Document Request Nos. 16-17

For the reasons set forth above and described in Respondent's supplemental discovery responses, documents relating to Respondent's "decision to abandon" and "intent not to resume use" of its ROUTE 66 mark, including its '628 Registration, are not relevant to these proceedings. Moreover, because Respondent concedes that use of the ROUTE 66 mark in the sale of tobacco products and other goods in the ordinary course of trade has not yet begun in the U.S., such documents do not exist.

Document Request No. 32

We have now produced documents relating to Respondent's document retention policy (Doc. Nos. VN0196-VN0235). Accordingly, we assume that this objection has been satisfied.

Top Tobacco's Responses to Van Nelle's Discovery Requests

Top Tobacco's Intended Use of the ROUTE 66 Mark

We received a total of thirty-six (36) pages of documents to support Top Tobacco's intent to use the ROUTE 66 mark in the U.S. We will assume that these documents reflect all of the

Michael G. Kelber, Esq.
December 11, 2008
Page 3

documents within your client's custody or control that support Top Tobacco's bona fide intent to use the mark as of the date of filing its U.S. application under Section 1(b) of the Trademark Act.

Requests for Admission 6 – 16 and Interrogatories 5,6, and 9

We will consider your responses to Requests for Admissions 6 – 16 to be denials as you state in your November 21, 2008 letter. As for Interrogatory Nos. 5, 6 and 9, because your client has now received Respondent's responsive documents requested in discovery, we assume that you are in a position to supplement these answers.

Interrogatory No. 11

Your interpretation of the law on this point is incorrect. As you are no doubt aware, a "yes" or "no" answer as to whether a trademark availability opinion was sought is not privileged information, and a refusal to answer cannot be justified by reliance on the attorney-client privilege. What is sought is not the substance of a communication, but rather the fact of whether or not such an opinion as sought. It is well established that the attorney-client privilege applies to the substance of communications between attorneys and clients. Please supplement this answer.

Interrogatory No. 12 and Request No. 36

You state affirmatively that Petitioner performed an investigation in response to Interrogatory No. 12. Respondent's Request No. 36 requests production of all documents identified in Respondent's answers to interrogatories, yet no investigative documents were produced.

If Petitioner maintains that no documents were generated in connection with the investigation it admits took place, please so state in a supplemental responses (verified as to interrogatory answers). If you admit that documents were produced in connection with the investigation, we refer again to the TTAB's own holding that the identification of documents (as opposed to their substance) cannot be privileged. *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975). Thus, please identify all and produce any non-privileged documents generated in connection with the investigation you confirm occurred. Please include the documents you claim to be protected by privilege in your privilege log.

Interrogatory No. 14

Again, we understand that we have received all document that evidence Petitioner's efforts towards using the ROUTE 66 mark in the United States. Please advise if our understanding is incorrect.

Michael G. Kelber, Esq.
December 11, 2008
Page 4

Interrogatory No. 19

We have not received the documents to which you refer in response to Interrogatory No. 19 as “business records identifying the services performed by DRL Enterprises, Inc.” in connection with Petitioner’s products to be sold in connection with any ROUTE 66 designation in the United States.

Interrogatory Nos. 24, 25 and Request No. 31

We understand that you are refusing to provide information about or produce the agreements relating to Top Tobacco’s alleged ROUTE 66 mark on the basis of relevance. Accordingly, we will reserve this dispute for disposition by the Board’s interlocutory attorney.

Interrogatory No. 26

We accept your answer to this interrogatory that no ROUTE 66 products have been sold and no prices set for those products.

Document Request No. 8

You rely in full on documents on file with the USPTO and on materials you assert are protected from disclosure by the attorney-client privilege and work product doctrine in response to this request. We ask that you provide a Privilege Log identifying the attorney-client privileged documents at your earliest convenience.

Document Request No. 10

We find it interesting that your client’s position on evidence of its own use or intent to use the ROUTE 66 mark in the U.S. is completely contrary to the position it has taken in the parallel circumstance presented by the AMPHORA Cancellation Proceeding No. 92046734 in which you have aggressively sought the identical information, and is contrary to the Board’s holding in that case. Nevertheless, we understand your position to be that you will not produce voluntarily the requested documents (studies, surveys and market research relating to the ROUTE 66 brand) on the basis of relevance and we reserve our right to raise these issues with the interlocutory attorney.

Document Request No. 13

You state that your client will produce “non-privileged documents regarding where it has sought authorization to sell ROUTE 66 branded products.” Are you referring to your letter to the National Association of Attorneys General in which your client states that it is “trying to qualify these brands in all of the states”? This letter, without more, obviously begs the question of

Michael G. Kelber, Esq.
December 11, 2008
Page 5

exactly what steps have been taken in this effort to qualify the purported brand in “all of the states.” Please supplement this response.

We understand that you are refusing to produce documents that address the facts surrounding Petitioner’s licensure to do business and its corporate structure in the U.S. and reserve our rights to pursue this information.

Document Request Nos. 19-21

We understand your letter to state: (1) that there are no additional documents beyond those documents produced to date that relate to Top Tobacco’s intent to first market or sell the products under the ROUTE 66 designation, and (2) that Seth Gold is the only person with knowledge of these plans. Please advise if our understanding is incorrect.

Document Request No. 27

You rely again on relevance in refusing to produce documents that demonstrate the characteristics of Petitioner’s customers for its planned ROUTE 66 brand products on the basis that the current proceeding does not involve a likelihood of confusion determination. Again, given your inconsistent position on the relevance of this information, we reserve our right to raise the issue with the Interlocutory Attorney at a later time.

Document Request No. 28

We have directed you to Board rules and applicable cases that shed light on discovery practices before the Board. In response, you write “Top Tobacco’s application for a nearly identical mark and for nearly identical goods as those of Van Nelle’s registrations, and thus, any factors contributing to the likelihood of confusion are not at issue.” If likelihood of confusion is not at issue, why is it of any importance that Petitioner and Respondent’s marks are “nearly identical mark(s) and for nearly identical goods”? Petitioner seems to want to have it both ways as it has relied on likely confusion in the Petition for Cancellation. We reserve our right to the documents requested underlying Petitioner’s claims of likely confusion.

Document Request Nos. 34 and 35

We understand that Petitioner has no documents other than the thirty-six pages already produced that relate in any way to Petitioner’s bona fide intent to use the ROUTE 66 designation in the United States. Please confirm. We note that none of the documents produced relates to the entities and sales channels through which Petitioner intends to sell goods in the United States as requested in Request No. 35.

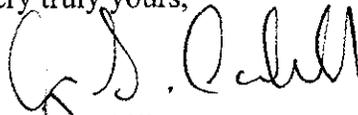
Michael G. Kelber, Esq.
December 11, 2008
Page 6

Meet and Confer and Discovery Depositions

We are willing to take part in a "meet and confer" telephone call if you believe that this would assist in resolving these matters, but we are not optimistic. It is not our understanding that the Board would require such a call, given the parties' extensive written efforts to explore the outstanding issues.

As the discovery period will close shortly, we will agree to a thirty day extension until January 19, 2008 for the purpose of scheduling depositions only and to resolve the issues addressed in this letter. Please advise of your intent to schedule discovery depositions so that we may determine availability.

Very truly yours,



Amy S. Cahill

ASC:ims

cc: Brewster Taylor, Esq.