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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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Submission	Motion to Compel Discovery
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Date	01/16/2009
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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

**RESPONDENT’S MOTION TO COMPEL DISCOVERY AND
FOR ORDER DEEMING REQUESTS FOR ADMISSIONS ADMITTED**

Respondent **VAN NELLE TABAK NEDERLAND BV** (hereinafter “Respondent”) hereby submits this motion to compel discovery pursuant to TBMP § 523.01, *et seq.*, and for an order deeming its requests for admission admitted pursuant to TBMP § 407.03 and Fed. R. Civ. P. 36(a), and in support thereof states the following.

I. INTRODUCTION

This is a Cancellation proceeding brought to cancel Respondent’s Registration No. 2,950,896 for ROUTE 66 (& Design), which issued on May 17, 2005, and Registration No. 3,328,623 for ROUTE 66, which issued on November 6, 2007, both for tobacco and related products (“Route 66 Marks”).¹ Top Tobacco (“Top”) filed its Petition for Cancellation on March 6, 2008, *less than one year after* Registration 3,328,623 issued and *less than three years after*

¹Registration No. 2950896 is for “tobacco whether manufactured or unmanufactured; tobacco products, namely, hand-rolling tobacco, cigars, cigarettes; tobacco substitutes, none being for medicinal or curative purposes; smokers’ articles, namely, cigarette lighters not of precious metal, ashtrays not of precious metal, cigarette papers, matches.” Registration No. 3,328,623 is for “cigarettes, cigars, cigarillos, tobacco, matches, lighters and ashtrays not made of precious metals, pipes, tobacco cases not made of precious metals, cigarette papers, cigarette filters, cigarette tubes, and hand-held machines for rolling and making cigarettes.”

Registration No. 2,950,896 issued. Therefore, the burden to produce evidence in support of its claims and the burden of persuasion to prove abandonment remain on Top at all times in the proceeding. *See Auburn Farms Inc. v. McKee Foods Corp.*, 51 U.S.P.Q.2d 1439, 1443 (TTAB 1999).

Top cannot rely on the statutory presumption for abandonment established by 15 U.S.C. § 1127, because it filed its Petition for Cancellation before three years had run from the date of either registration. In *Oromeccanica, Inc. v. Ottmar Botzenhardt G.m.b.H. & Co.*, Petitioner sought to cancel a registration owned by a competitor based on abandonment, but filed the petition less than one year after the date the registration issued. The Board found that Petitioner thus could not validly allege the necessary statutory period of non-use under Section 45, 15 U.S.C. § 1127. *Oromeccanica, Inc. v. Ottmar Botzenhardt G.m.b.H. & Co.*, 223 USPQ 59, 63 (TTAB 1983)

Even if the allegations in the petition were sufficient to sustain a *prima facie* case of abandonment, Respondent's activities in the United States, including market surveys which were initiated prior to initiation of this proceeding, are sufficient to rebut any inference of abandonment. In response to Top's discovery requests, Respondent has produced evidence of (1) extensive consumer research into the U.S. market for products bearing the ROUTE 66 Marks conducted in the U.S. in 2005 and 2006; (2) preparation of preliminary U.S. packaging bearing the marks created in 2008; (3) Respondent's application to sell ROUTE 66 brand tobacco products in the U.S. in compliance with the Master Settlement Agreement; (4) internal business documents that reference ROUTE 66 as a brand intended for use in the U.S. market. These continuous efforts to expand business to the U.S. are sufficient to rebut a presumption of non-use. *Id.* at 64. Further, as Top Tobacco was no doubt aware before it filed its application for

registration of "ROUTE 66", Respondent has used the mark in many other countries for many years.

Despite the evidence of Respondent's use and the unavailability of any statutory presumption in Top's favor, Top has evaded its discovery obligations and refused to produce a single document or provide any substantive information that would reveal the grounds it had for asserting abandonment of Respondent's ROUTE 66 Marks. It has also refused to provide information as to its knowledge of Respondent's use of ROUTE 66 Marks prior to filing Top's application for registration of "ROUTE 66", nor complete responses to Respondent's discovery requests directed to Top's own intended use. Top must be compelled to respond to Respondent's discovery requests or face an entry of judgment dismissing its Petition.

II. BACKGROUND

On June 23, 2008,² Respondent served Petitioner Top with: (a) Respondent's First Set of Interrogatories; (b) Respondent's First Request for Production of Documents and Things; and (c) Respondent's First Set of Requests for Admission (collectively "Discovery Requests"). *See* Affidavit of Amy S. Cahill (Exhibit A hereto) at ¶ 2, and Discovery Requests attached as Exhibit B hereto.

Additionally, on June 26, 2008, Respondent's counsel sent Top an electronic copy of two pages that Top reported missing from the Discovery Requests as originally served. *See* Cahill Affidavit (Exhibit A hereto) at ¶ 3 and attached as Exhibit C hereto.

Top provided unsatisfactory and incomplete written responses to the Discovery Requests on July 28, 2008 (Exhibit D hereto). Respondent promptly and comprehensively addressed Top's deficiencies by letters of September 16, 2008, November 3, 2008, and December 11, 2008

² Discovery in this matter opened on June 22, 2008.

(Exhibit E hereto). Petitioner has refused to supplement its responses, with the exception of thirty-six pages of documents produced on November 25, 2008. (Petitioner's written correspondence dated November 25, 2008 accompanying the production is attached hereto as Exhibit F hereto).

Among the requests that Top has refused to answer are Petitioner's Requests for Admission Nos. 6 -16 and Interrogatories 5, 6, and 9 directed to the discovery of evidence to support claims of abandonment, which form the basis for Top's Petition for Cancellation. Top is mistaken if it believes that it may rest on the allegations contained in its Petition for Cancellation to prove its abandonment claims. In fact, in a case such as this, Top has an affirmative duty to come forward with evidence to support its claims, or it will face a an entry of judgment against it. Abandonment being in the nature of a forfeiture must be strictly proved, and non use should not be inferred to account for any portion of the three-year statutory period. *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo*, 196 USPQ 801, 805 (CCPA 1978), citing McCarthy on Trademarks and Unfair Competition § 17.3. The same high standard applies to proof of a period of non-use. *Id.*

Top simply states that it conducted an investigation into Respondent's use of its ROUTE 66 Marks in the U.S. in answer to Respondent's Interrogatory No. 12 but has provided no specifics as to the nature and extent of the "investigation" or produced any documents generated in connection with the alleged investigation, despite Respondent's request seeking such documents. In a further effort to avoid summary judgment, Top has refused to answer substantively a number of requests for admissions depriving the Board and Respondent the ability to narrow the facts in dispute. Accordingly, Respondent moves to have Requests for Admission Nos. 6 - 16 deemed admitted.

Other interrogatories and requests for production to which Top has not responded, in full or in part, are directed to Top's knowledge of Respondent's extensive use of ROUTE 66 abroad and Top's purported plans to use its purported ROUTE 66 mark in the U.S. Top filed its U.S. application for ROUTE 66 with full knowledge of Respondent's long history of use the ROUTE 66 mark abroad in an effort to block Respondent's expansion of ROUTE 66 sales into the U.S. Top has raised the nature of its own planned use of ROUTE 66 by relying on Section 2(d), 15 U.S.C. § 1052(d), to assert standing in its Petition for Cancellation. *See* Petition for Cancellation, ¶ 11.

Either Top had absolutely no evidence to support its contention that Respondent has abandoned its ROUTE 66 Marks, as it has alleged in the Petition, or it has refused to produce the evidence. If Top has no evidence, in view of the evidence of non-abandonment provided by Respondent and the fact that less than three years have passed since the challenged registrations issued,³ Respondent is entitled to summary judgment on the merits of this proceeding. Based on its discovery production to date, it is hard to imagine how Top has fulfilled its obligation under Rule 11 of the Federal Rules of Civil Procedure to conduct a reasonable inquiry such that that the claims in its Petition were warranted by existing law and facts and not presented for an improper purpose. Fed.R.Civ.P. 11.

³ A Petitioner seeking to cancel a registration in effect less than three years maintains the burden of production and the burden of proof to show abandonment. For purposes of calculating the three-year statutory presumption for abandonment, the period of non-use begins upon the registration date of the contested mark. *Consolidated Cigar Corporation*, 65 USPQ2d 1153, 1155 (TTAB 2002) citing *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 14 USPQ2d 1390 (Fed. Cir. 1990) (A Section 44(e) registrant is "granted a dispensation from actual use prior to registration, but after registration, there is no dispensation of use requirements. If the registrant fails to make use of the registered mark for two years, the presumption of abandonment may be invoked against that registrant, as against any other.")

III. ARGUMENT

A. Top Has Failed to Admit or Deny Respondent's Requests for Admission

Under Federal Rule of Civil Procedure 36(a), a matter is admitted unless, within thirty days after being served, the party to whom the request is directed serves a written answer or objection addressed to the matter. Fed. R. Civ. P. 36(a)(3). But a party may not avoid the consequences of this Rule simply by submitting meaningless responses to the requests. "If a matter is not admitted, the answer must specifically deny it, or state in detail why the answering party cannot truthfully admit or deny it." Fed.R.Civ. P. 36(a)(4).

If a propounding party is dissatisfied with an answer or objection to a request for admission, the propounding party may file a motion with the Board to determine the sufficiency of the answer or objection. If the Board determines that an answer does not comply with the requirements of Fed.R.Civ.P. 36(a), it may order either that the matter stand admitted or that an amended answer be served. TBMP § 411.02.

Top has refused to respond fairly or to properly object to Request for Admission Nos. 6 – 16. Each of the requests asks Top to admit or deny that it has in its possession, documentary or other evidence that supports its claims of abandonment. In each case, Top objects to the request, and then generally "denies" the request on the basis that it is unaware of Respondent's use of its mark. A sample request and response follow.

REQUEST NO. 6. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent discontinued use in the United States of the mark ROUTE 66 in any and all forms in connection with Applicant's goods.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely, the existence of documents to prove the absence of a fact.

Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

Top's boilerplate "non-response" has four parts: (1) an objection on the grounds that the request is "premature", (2) an objection on the grounds that the request seeks information protected by privilege or work-product doctrine, (3) an objection on the grounds that the request seeks a "legal impossibility", and (4) a general denial on the basis that Top is unaware of Respondent's use of the mark.

If a matter is not admitted, the response must specifically deny it or state in detail why the responding party cannot truthfully admit or deny it. Fed.R.Civ.P. 36(a). Top has not admitted the requests, but neither has it specifically denied them. Instead, Top objects to the requests on three grounds –prematurity, privilege/work product, and the ground of "legal impossibility." None of these objections is valid and the general denials offered are ineffective in its failure to respond to the substance of the requests.

In light of Respondent's complete discovery responses and document production, Top's objection that the requests are premature is baseless.⁴ Top does not even attempt to explain the application of the work product doctrine or attorney-client privilege to Respondent's requests for admissions, which are directed to the mere existence of certain documents. Work product and privilege clearly cannot protect Top from stating "Admit" or "Deny" in response to the requests, as appropriate. Finally, Top's "legal impossibility" objection does not make sense. The requests are not asking Top to prove anything, legally impossible or not. The requests only require Top to admit, or to deny, whether it has specific evidence in its possession that supports its claims of abandonment. If it does not, it must admit that it does not.

⁴ Discovery in this matter was scheduled to close on December 19, 2008. Petitioner filed its motion to compel on December 11, 2009.

Even a proper objection to a part of a request does not excuse the answering party from properly responding to the other parts of the request to which the answering party has raised no specific objection. *Jackson Buff Corp. v. Marcelle*, 20 FRD 139, 140 (EDNY 1957)(defendant cannot object to all requests on basis of objection to some). It appears that Top attempts a “partial and qualified denial” to Request Nos. 6 - 16 premised on its stated lack of awareness of any use of ROUTE 66 by Respondent. Regardless of whether a partial or complete denial is intended by the responding party, the same standards and requirements of Rule 36 apply. The partial or complete denial *must be stated specifically and the response must fairly respond to the substance of the matter*. *Panara v. Hertz Penske Truck Leasing, Inc.*, 122 FRD 14, 17 (ED Pa. 1988)(ambiguous denial insufficient). These requirements are strictly construed. *United States v. Jefferson Trust & Sav. Bank*, 31 F.R.D. 137, 139 (SD Ill. 1962)(requirements strictly construed and rigidly enforced). Failure to comply with the Rule 36(a) standards may warrant sanctions. *Martin v. Brown*, 151 FRD 580, 594 (WD Pa. 1993)(when responding to requests for admissions, failure to meet requirements is ground for sanctions).

In each case, Top’s general denial is not directed to what the request seeks. Respondent asks Top whether it is aware of any documentary or other evidence that supports its contention that the challenged marks have been abandoned. Either it is aware of evidence meeting this description or it is not. If it is not, the entire request should have been admitted. If it is, the entire request should have been denied.

From these responses, it is clear that Top has no documentary evidence to support its position that Respondent has abandoned rights in its ROUTE 66 marks. Accordingly, each of the requests for admission nos. 6-16 propounded to Top should “stand admitted.” TBMP § 407.03(a); Fed. R. Civ. P. 36(a).

B. Top Should Be Compelled to Supplement Discovery Responses

Top has refused to produce any meaningful discovery in support of its Petition for Cancellation, despite the fact that it carries the burden of both production of evidence and of proof on the question of abandonment. *See Auburn Farms Inc. v. McKee Foods Corp.*, 51 U.S.P.Q.2d 1439, 1443 (TTAB 1999). Respondent addresses Top's deficient discovery responses below *seriatim*.

Top's Awareness of Respondent's ROUTE 66 Mark

DOCUMENT REQUEST NO. 8: Any and all documents regarding any action taken by Petitioner in response to its awareness of Respondent's Marks.

RESPONSE: Petitioner object to this document request as overly broad, unduly burdensome, vague and ambiguous with respect to the phrase "any action taken by Petitioner in response to its awareness." Petitioner does not understand what documents Respondent seeks by this document request.

Top was no doubt well aware of Respondent's years of use of ROUTE 66 in connection with tobacco products abroad and has attempted to preempt Respondent's expansion into the U.S. Although foreign use is generally irrelevant to Board proceedings, there is an exception applicable here where one party's adoption and use of a mark in the United States was made in bad faith for the purposes of forestalling a foreign user's expansion into the United States. TBMP § 414(13); *see Double J. of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991)(in view of Applicant's knowledge of Opposer's claim to mark in foreign countries and of Opposer's intention to enter U.S. market, it appears that Applicant intended to preclude opposer from entering U.S. market). Top should be compelled to produce documents that reflect any knowledge of Respondent's prior use of its ROUTE 66 Marks or of Respondent's plans to expand use of its ROUTE 66 marks into the U.S.

Opinions Top Received on Respondent's Alleged Abandonment

INTERROGATORY NO. 11 State whether Petitioner received any opinions concerning the non-use, abandonment, or intent not to resume use of Respondent's Marks.

ANSWER: Petitioner objects to this interrogatory to the extent it seeks information protected by the attorney-client privilege and work product doctrine.

Top's interpretation of the law of privilege is incorrect.⁵ As Top is no doubt aware, a "yes" or "no" answer as to whether a trademark abandonment opinion was sought is not privileged information, and a refusal to answer cannot be justified by reliance on the attorney-client privilege. What the interrogatory seeks is not the substance of communications, but rather the fact of whether or not such an opinion was sought. It is well-established that the attorney-client privilege applies to *the substance of* communications between attorneys and clients. Respondent requests an Order directing Top to respond fully to this inquiry.

Top's Research into Respondent's Alleged Abandonment of ROUTE 66

INTERROGATORY NO. 12: Identify any market research (including surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Petitioner regarding Respondent's Marks.

ANSWER: Petitioner objects to this interrogatory to the extent it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that it performed an investigation regarding any possible use of Respondent's Marks in commerce in the United States but has not conducted any other market research regarding Respondent's Marks.

Top states affirmatively that it performed an investigation "regarding any possible use of Respondent's marks in commerce in the United States" in response to Interrogatory No. 12, but does not identify the nature of the investigation conducted. Moreover, Respondent's Request for Production No. 36 requests production of all documents identified in Respondent's answers to interrogatories, yet no investigative documents were produced. Top has refused to supplement the response to Interrogatory No. 12 or to Request for Production No. 36.

⁵ Moreover, Top has not provided a Privilege Log identifying documents it claims are protected by attorney-client privilege or work product, despite Respondent's request.

If Top maintains that no documents were generated in connection with the investigation it admits took place, it should so state in a supplemental response (verified as to interrogatory answers). If Top admits that documents were generated in connection with the investigation, these documents should be identified because the Board has held 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, Respondent seeks an order directing Top to identify and produce any non-privileged documents generated in connection with the investigation into Respondent's use of ROUTE 66 that Top confirms occurred, and that any relevant privileged documents be included in a separate Privilege Log.

Top's Advertising Plans

INTERROGATORY NO. 14: Identify all plans Petitioner has to advertise, offer and sell products using "ROUTE 66" and identify all documents relating thereto, and the persons most knowledgeable thereof.

ANSWER: Subject to and without waiving its general objections, Petitioner intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the ROUTE66 mark in commerce in the United States. Petitioner identifies Seth Gold as the most knowledgeable person regarding these plans.

In correspondence, Top's attorneys rely on documents produced to respond to this interrogatory. But all that has been produced is a one page letter to the National Association of Attorneys General dated February 21, 2008 (TOP66 0001) and one page of product packaging (YOP66002)(Confidential). Top's statement that it intends to "advertise . . . tobacco, cigarette papers, and other related products under the ROUTE 66 mark in commerce . . . in the United States" is hardly forthcoming. Top should be ordered to supplement this interrogatory answer.

Top's Packaging and Marketing Materials

REQUEST NO. 5 Samples or products, packaging or marketing materials used by Petitioner displaying the ROUTE 66 Mark.

RESPONSE: Subject to and without waiving its general objections, as Request No. 5 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

Top states that it had not used the ROUTE 66 mark in commerce and therefore has no such documents, but Top later produced a single page of what appears to be product packaging on November 25, 2008, marked "CONFIDENTIAL." Top should supplement the response to this request for production (and supplement production as necessary) to reflect the current facts relating to its development of packaging and marketing materials for use in commerce.

Top's Agreements Regarding ROUTE 66

INTERROGATORY NO. 24: Identify all agreements to which Petitioner 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: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

INTERROGATORY NO. 25: Identify all licensing agreements, authorizations, or any other rights granted to Petitioner in connection with the ROUTE 66 designation and with respect to each such agreement, authorization or other right, state:

- (a) the names and addresses of all participating parties;
- (b) all terms, including dates of commencement and termination and geographic scope;
- (c) the nature of the rights involved;
- (d) the specific designation to which Petitioner gained the license, authorization or any other right;
- (e) any provisions
- (f) the person(s) most knowledgeable about such agreement, authorization, license or grant.

ANSWER: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Petitioner further objects to Interrogatory No. 25 as duplicative in Interrogatory Nos. 17 and 24.

REQUEST NO. 31 All documents that disclose, describe, or otherwise relate to any license or assignment agreement(s) to which Petitioner is a party concerning any ROUTE 66 designation.

RESPONSE: Petitioner objects to this request on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

Top refuses to provide information about or produce the agreements relating to Top Tobacco's alleged ROUTE 66 mark on the basis of relevance. However, agreements regarding a mark at issue, including license agreements or other arrangements between the owner and third-parties, are discoverable in Board proceedings. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 16771 (TTAB 1988). Top has rendered agreements relating to its own proposed ROUTE 66 mark relevant by relying on its rights to the mark in its Petition.

IV. CONCLUSION

Petitioner Top initiated this proceeding. Top may not now shirk its obligations under the Federal Rules of Civil Procedure to respond fully to discovery, whether in the form of responses to interrogatories and requests for production of documents, or requests for admissions. If Top has no evidence in support of its contentions of abandonment, the Petition should be dismissed.

For the foregoing reasons, Respondent requests that the Board grant its Motion to Compel Discovery in the form of complete supplemental responses to Interrogatory Nos. 5, 6, 9, 11, 12, 14, 24, and 25 and Requests for Production Nos. 5, 8, 31, and 36, and for an Order Deeming its Requests 6 – 16 for Admission Admitted.

Respondent, through counsel, has made a good faith effort to resolve with Petitioner's counsel, the issues presented in this motion and has been unable to reach an agreement. *See Cahill Exhibit attached as Exhibit A.*

Respectfully Submitted,
STITES & HARBISON, PLLC



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January 16, 2009

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing MOTION TO COMPEL DISCOVERY AND FOR ORDER DEEMING REQUESTS FOR ADMISSIONS ADMITTED was *mailed via first class mail*, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Klapper, Esquire and Gregory J. Leighton, Esquire, NEAL, GERBER & EISENBERG LLP; Two North LaSalle Street, Chicago, Illinois 60602-3801, on this the 16th day of January 2009.



Amy S. Cahill

308LT:20399:75139:2:ALEXANDRIA

EXHIBIT "A"

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

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

DECLARATION OF AMY S. CAHILL, ESQ.

I, Amy S. Cahill, under penalty of perjury pursuant to 28 U.S.C. § 1746, state as follows:

1. I am an attorney at the law firm of Stites & Harbison, PLLC, am over the age of 18 and am co-counsel of record for Respondent Van Nelle Tabak Nederland BV (“Respondent”), in this proceeding in which Petitioner Top Tobacco, LP (“Petitioner”) seeks to cancel U.S. Registration Nos. 2,950,896 and 3,328,623. I am a member in good standing of the bars of the Commonwealth of Kentucky, the Commonwealth of Virginia, and the District of Columbia. I submit this Declaration based on my own personal knowledge unless otherwise stated in support of Respondent’s Motion to Compel Discovery and for Order Deeming Requests for Admissions Admitted (“Respondent’s Motion”).

2. On June 23, 2008, Respondent served Petitioner with the following: (a) Respondent’s First Set of Interrogatories, (b) Respondent’s First Request for Production of Documents and Things, and (3) Respondent’s First Set of Requests for Admission, (collectively “First Set of Discovery Requests”). A copy of the First Set of Discovery Requests is attached to Respondent’s Motion as Exhibit B.

3. On June 26, 2008, Christian Ryan, acting at my direction, sent to Petitioner a copy of two pages that Petitioner reported were missing from the First Set of Discovery Requests. A copy of the June 26, 2008 transmission is attached to Respondent's Motion as Exhibit C.

4. Petitioner provided written responses to the First Set of Discovery Requests on July 28, 2008. Copies of Petitioner's responses to the First Set of Discovery Requests are attached to Respondent's Motion as Exhibit D. Believing these responses to be incomplete or otherwise improper, I contacted counsel for Petitioner by mail setting forth with particularity the alleged deficiencies in the responses on September 16, 2008, November 3, 2008, and December 11, 2008. Copies of my correspondence is attached to Respondent's Motion as Exhibits E.

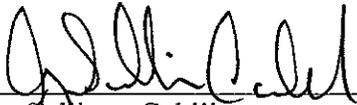
5. On November 25, 2008, Petitioner produced thirty-six pages of documents. A copy of the correspondence accompanying this production is attached to Respondent's Motion as Exhibit F.

6. To date, Petitioner has not supplemented its discovery responses.

7. I, along with the other attorneys of record for Respondent, have made a good faith effort to resolve with Petitioner's counsel, the issues presented in Respondent's Motion and have been unable to reach an agreement.

I affirm under penalty of perjury that the foregoing is true and correct.

Executed on January 16, 2009
Louisville, Kentucky



Amy Sullivan Cahill
Counsel for Respondent
Van Nelle Tabak Nederland BV

EXHIBIT "B"

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

In the Matter of
Registration Nos. 2,950,896, and 3,328,623

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

RESPONDENT'S FIRST SET OF INTERROGATORIES TO PETITIONER

Respondent, **VAN NELLE TABAK NEDERLAND BV** ("Respondent"), serves the following interrogatories under Rule 33, Fed.R.Civ.P., and Trademark Rules 2.116(a) and 2.120(d)(1), to be answered separately and fully in writing under oath by an officer or agent of Petitioner, **TOP TOBACCO, LP** ("Petitioner"). Each separately numbered or lettered sub-part of each interrogatory requires a separate answer thereto. Furthermore, these interrogatories shall be deemed to be continuing to the fullest extent permitted by the Rules, and Petitioner shall provide Respondent with any supplemental answers and additional information that are requested herein which shall become available to Petitioner at a later date.

DEFINITIONS AND INSTRUCTIONS

The following interrogatories and Respondent's accompanying requests are subject to the definitions set forth below:

A. The term "document" shall be construed in its broadest permissible sense, and shall include any and all means of conveying, storing, or memorializing information, whether in paper or other

tangible physical form, or in electronic form, in the possession, custody, or control of Petitioner. Each comment, or addition to, or deletion from, a document shall constitute a separate document.

B. If Petitioner refuses to identify and/or produce any document(s) based upon a claim of confidentiality, privilege, or work product immunity, Petitioner shall, in log form, (i) identify each document by its author, intended recipient(s), the date of the document, and its general subject matter, and (ii) set forth for each withheld document the particular basis for the refusal of production.

C. As used herein, the term "regarding" means relating or referring to, incorporating, comprising, touching upon, indicating, evidencing, affirming, denying, concerned with, relevant to, or likely to lead to admissible evidence concerning.

D. As used herein, the term "Respondent's Marks" shall refer to the ROUTE 66 and ROUTE 66 ORIGINAL (& Design) marks of Registration Nos. 3,328,623 and 2,950,896, that are the subjects of the Petition for Cancellation, as amended by the Board's Order of May 27, 2008.

E. As used herein, the phrase "Respondent's Products" shall refer to goods bearing Respondent's Marks.

INTERROGATORIES

INTERROGATORY NO. 1

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "long prior to the filing of the applications that resulted in Registration Nos. 2,950,896, and 3,328,623, Respondent discontinued use in the United States of mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future", including all documents relating thereto and the persons most knowledgeable thereof.

INTERROGATORY NO. 2

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "Respondent has not used the '896 and '623 Registrations, which are based on foreign registrations, during the period between the dates of registration and the filing of this Petition, and such non-use of the marks in commerce is not excusable non-use", including all documents relating thereto and the persons most knowledgeable thereof.

INTERROGATORY NO. 3

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "Respondent has abandoned the registered ROUTE 66 & Design , ROUTE 66 ORIGINAL & Design or ROUTE 66 marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127, and has not complied with the requirements of Section 44 of the Trademark Act, 15 U.S.C. § 1126", including all documents relating thereto and the persons most knowledgeable thereof.

INTERROGATORY NO. 4

Identify the factual basis for the allegations in paragraph 11 of the Petition for Cancellation that "Respondent's continued registration of the ROUTE 66 & Design, ROUTE 66 ORIGINAL & Design, and ROUTE 66 marks, would likely result in damage and injury to Top Tobacco in that it is likely to cause confusion, or to cause mistake, or to deceive with respect to Top Tobacco's ROUTE 66 mark", including all documents relating thereto and the persons most knowledgeable thereof.

INTERROGATORY NO. 5

Describe any evidence you have that supports the abandonment of Respondent's Marks.

INTERROGATORY NO. 6

Describe any evidence you have that supports the non-use of Respondent's Marks and the

intent not to resume use of Respondent's Marks.

INTERROGATORY NO. 7

Identify any evidence of which you are aware that shows the relevant purchasing public's cessation of identification of Respondent's Marks as indicators of source when used in connection with Respondent's Products.

INTERROGATORY NO. 8

Describe the basis for your belief that Petitioner would be damaged by the registration of the Respondent's Marks on the Principal Register.

INTERROGATORY NO. 9

Identify any information you have gathered regarding Respondent, Respondent's Marks, Respondent's business, or Respondent's Products that would be relevant to the claims or defenses in this action.

INTERROGATORY NO. 10

State whether your claims that Applicant has abandoned Applicant's Marks rely on the adoption of new marks by Applicant that continue to incorporate the word mark ROUTE 66 and if so, describe the bases for these claims.

INTERROGATORY NO. 11

State whether Petitioner received any opinions concerning the non-use, abandonment, or intent not to resume use of Respondent's Marks.

INTERROGATORY NO. 12

Identify any market research (including surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Petitioner regarding Respondent's Marks.

INTERROGATORY NO. 13

Identify those persons having the most knowledge of any market research (including

surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Petitioner regarding Respondent's Marks.

INTERROGATORY NO. 14

Identify all plans Petitioner has to advertise, offer and sell products using "ROUTE 66" and identify all documents relating thereto, and the persons most knowledgeable thereof.

INTERROGATORY NO. 15

State the full name of each business, company, person, or other entity affiliated with Petitioner that has at any time used any ROUTE 66 designation in connection with tobacco or any other product(s), and for each, identify its principals(s) and, if applicable, its state and country of organization.

INTERROGATORY NO. 16

Identify each ROUTE 66 designation or any designation that is visually or phonetically similar thereto, used or owned at any time by Petitioner and, with respect to each such designation, identify the designation, the goods used therewith, and the inclusive dates of use thereof.

INTERROGATORY NO. 17

Identify each transaction by which Petitioner claims that any right (including permission to use or other license) in any ROUTE 66 designation has passed to Petitioner, including setting forth the date of each such transaction and indentifying the parties to the transaction and all documents related thereto.

INTERROGATORY NO. 18

Identify by common commercial name each product that Petitioner markets, distributes, sells or offers for sale, under or in connection with any ROUTE 66 designation, and with respect to each such product;

- (a) set forth the actual geographic scope of use;
- (b) set forth the annual actual volume of sales of the product in both dollars and units per year;
- (c) set forth the unit sizes in which the product is sold;
- (d) identify each class or expected class of purchasers of the product;
- (e) describe the channels of trade by which the product reaches the ultimate user of such goods;
- (f) state all types of stores or forums in which the products are offered or sold; and
- (g) identify the persons most knowledgeable of such use, as well as all documents relating thereto.

INTERROGATORY NO. 19

Identify each package or label designer, advertising agency, market research expert or consultant who has performed services in connection with tobacco or any other product(s) planned to be promoted or sold by Petitioner under or in connection with any ROUTE 66 designation, and, for each such entity, describe in detail the services performed and the inclusive dates of such services.

INTERROGATORY NO. 20

Identify all persons involved on behalf of Petitioner in planning the advertising, marketing, promotion, distribution and sale of tobacco or any other product(s) under or in connection with any ROUTE 66 designation.

INTERROGATORY NO. 21

State whether Petitioner has ever issued or published, or caused to be issued or published or caused to be issued or published, any press or publicity release concerning tobacco or any other product(s) promoted or planned to be promoted under or in connection with any ROUTE

66 designation, and, if so, identify each such release and all publications or other media in or through which information contained therein was disseminated.

INTERROGATORY NO. 22

State whether Petitioner has ever objected to the use or registration of any other mark comprising the designation ROUTE 66, and if so, with respect to each such objection, identify the mark or designation to which the objection, identify the mark or designation to which the objection was made, the user thereof, the nature of the objection, the disposition of the objection, the persons most knowledgeable of the objection, and all documents relating to the objection.

INTERROGATORY NO. 23

Identify by title, index number and tribunal each civil action or inter partes proceeding in which Petitioner has been or is involved, other than the present cancellation proceeding, that refers or relates in any way to any ROUTE 66 designation, setting forth the disposition of each such proceeding or, if not disposed of, its current status.

INTERROGATORY NO. 24

Identify all agreements to which Petitioner 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.

INTERROGATORY NO. 25

Identify all licensing agreements, authorizations, or any other rights granted to Petition in connection with the ROUTE 66 designation and with respect to each such agreement, authorization or other right, state:

- (a) the names and addresses of all participating parties;
- (b) all terms, including dates of commencement and termination and geographic scope;

- (c) the nature of the rights involved;
- (d) the specific designation to which Petitioner gained the license, authorization or any other right;
- (e) any provisions
- (f) the person(s) most knowledgeable about such agreement, authorization, license or grant.

INTERROGATORY NO. 26

Identify the wholesale and retail price at which all products bearing any ROUTE 66 designation are sold, or are expected to be sold; explain the process by which this price was determined; and identify those persons who participated in all decisions regarding the setting of these prices.

INTERROGATORY NO. 27

Explain Petitioner's reason(s) for filing pending application, Serial No. 77/393,701, for ROUTE 66, and identify all persons involved in filing the application, as well as all documents relating thereto.

INTERROGATORY NO. 28

Identify all entities that will sell Petitioner's tobacco or any other product(s) bearing any ROUTE 66 designation in the United States, and state the date when such entities executed the Master Settlement Agreement.

INTERROGATORY NO. 29

For each expert Petitioner has retained to give testimony in this proceeding, provide the information required in Rule 26(a)(2)(B), Fed.R.Civ.P.

INTERROGATORY NO. 30

Identify, on an interrogatory-by-interrogatory basis, each person furnishing information

upon which any part of any answer to these interrogatories is based, indicate the parts based on information so furnished by each such person, and whether such information is within the personal knowledge of such person, and if not within such person's knowledge, identify the source of the information so furnished.

Respectfully Submitted,
STITES & HARBISON, PLLC

Brewster Taylor w/ permission by ASC
Brewster Taylor
Transpotomac Plaza
1199 North Fairfax Street
Suite 900
Alexandria, Virginia 22314
(703) 739-4900
June 23, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Respondent's First Set of Interrogatories to Petitioner was *mailed via first class mail*, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, NEAL, GERBER & EISENBERG LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this the 23rd day of June 2008.

Brewster Taylor w/ permission by ASC
Brewster Taylor

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

In the Matter of
Registration Nos. 1,686,628, 2,950,896, and
3,328,623

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

**RESPONDENT'S FIRST REQUEST FOR
PRODUCTION OF DOCUMENTS AND THINGS**

Respondent, VAN NELLE TABAK NEDERLAND BV ("Respondent"), hereby requests, pursuant to Rule 34, Fed.R.Civ.P., and Trademark Rules 2.116(a) and 2.120(d)(2), that Petitioner, TOP TOBACCO, LP ("Petitioner"), produce the documents and things listed below for inspection and copying, and that said production be made accompanying Petitioner's service of its responses to this Request upon Respondent at the offices of Stites & Harbison, PLLC, 1199 North Fairfax Street, Alexandria, Virginia 22314.

DEFINITIONS AND INSTRUCTIONS

A. The definitions and instructions contained in Respondent's First Set of Interrogatories (the "interrogatories") are incorporated herein by reference.

B. With respect to any document requested below for which a claim of privilege, work product or confidentiality is made, specify (in log form) the nature of the document, identify by name, address, title and business affiliation, the writer, the addressee and all

recipients thereof, and set forth the general subject matter to which the document relates, and its date.

C. Petitioner shall separately identify the Request by number pursuant to which each document or thing is produced.

D. A written response to this Request is required pursuant to Rule 34, Fed.R.Civ.P.

REQUESTS

1. Any and all documents regarding the date and circumstances under which Petitioner became aware of the use or application for registration of Respondent's Marks.

2. Any and all documents referring or relating to any use by Respondent of Respondent's Marks.

3. Any and all documents referring or relating to any period(s) of non-use by Respondent of Respondent's Marks.

4. Any and all documents referring or relating to any use by any third-party of ROUTE 66 in connection with tobacco products.

5. Samples of products, packaging or marketing materials used by Petitioner displaying the ROUTE 66 Mark.

6. All documents to support Petitioner's allegation that Respondent has abandoned Respondent's Marks with an intent not to resume use.

7. All documents which evidence Petitioner's objection to any third-party use of a mark that includes ROUTE 66.

8. Any and all documents regarding any action taken by Petitioner in response to its awareness of Respondent's Marks.

9. Any and all copies of any surveys, market research tests, demographic or

consumer profile studies, and focus group inquiries regarding the ultimate purchasers or potential ultimate purchasers of products intended to be sold, offered for sale, advertised or promoted in connection with the ROUTE 66 mark, including the results thereof.

10. Any and all copies of any studies, surveys, market research tests, and those documents relating thereto, including the results thereof, concerning Respondent's Products advertised, promoted, distributed and sold in commerce in connection with Respondent's Marks, including, but not limited to, those relating to the consumer perception of Respondent's Marks.

11. Any and all documents and things forming the basis for the denial, in whole or in part, of Petitioner's responses to Respondent's First Requests for Admissions.

12. For each expert Petitioner intends to call to provide testimony in this proceeding, produce.

a) any written report provided by said expert relating to the subject matter of this proceeding;

b) a complete written statement of all opinions to be expressed by the expert in this proceeding, and the basis and reason therefor;

c) all documents reflecting the data or other information considered by the expert in forming his/her opinions;

d) all exhibits to be used by the expert as a summary of or support for his/her opinions;

e) those documents stating the qualifications of the expert, such as would be reflected in a resume, *curriculum vitae*, biography, summary or otherwise;

f) a written list of all publications authored by the witness within the last ten years;

g) documents reflecting the compensation to be paid for the expert's preparation time and time taken to provide testimony; and

h) a written list of any other cases in which the witness has testified as an expert at trial, in an administrative proceeding or by deposition within the past four years.

13. All documents which disclose, describe, or otherwise relate to the following:

a) When Petitioner was first licensed to do business;

b) All places where Petitioner is licensed or qualified to do business; and/or

c) All corporations or other entities in which Petitioner has a controlling interest.

14. All documents that disclose, describe, or otherwise relate to tobacco or any other products(s) offered or planned to be offered by Petitioner under any ROUTE 66 designation.

15. All documents that disclose, describe, or otherwise relate to the persons most familiar with and primarily responsible for Petitioner's use or intended use of any ROUTE 66 designation.

16. All documents that disclose, describe, or otherwise relate to the manner in which Petitioner uses or intends to use any ROUTE 66 designation.

17. All documents that disclose, describe, or otherwise relate to the geographic scope of Petitioner's past, current or anticipated efforts to market tobacco or any other product(s) under any ROUTE 66 designation.

18. All documents that disclose, describe or otherwise relate to the geographic scope in which Petitioner has or intends to sell or otherwise use any ROUTE 66 designation in connection with tobacco or any other product(s).

19. All documents that disclose, describe, or otherwise relate to the date Petitioner

first marketed or intends to first market or offer to provide tobacco or any other product(s) under any ROUTE 66 designation.

20. All documents that disclose, describe, or otherwise relate to the date Petitioner first sold or intends to first sell or provide tobacco or any other product(s) under any ROUTE 66 designation in intrastate commerce, interstate commerce and/or foreign commerce.

21. Documents sufficient to identify the person(s) most knowledgeable concerning the date when Petitioner first used or expects to first use any ROUTE 66 designation in intrastate commerce, interstate commerce and/or foreign commerce.

22. All documents that disclose, describe or otherwise relate to Petitioner's plans for the type, price and quality of the products that it offers or intends to offer under any ROUTE 66 designation.

23. For each and every good offered or intended to be offered by Petitioner bearing any ROUTE 66 designation, documents sufficient to identify:

a) the prices Petitioner charges or plans to charge in connection with each such good.

b) Petitioner annual sales (in units and dollars) of each such good, by state (and country if applicable); and

c) Petitioner's current inventory, if any, of each such good.

24. All documents sufficient to fully describe the manner by which Petitioner advertises and promotes or intends to advertise or promote tobacco or any other product(s) under and ROUTE 66 designation.

25. All documents that identify, constitute, or otherwise relate to any publications in which Petitioner has placed or intends to place print advertisements, articles or other information

concerning Petitioner's tobacco or any other product(s) offered or planned to be offered under any ROUTE 66 designation.

26. All documents that disclose, depict, or otherwise relate to any Internet website referencing Petitioner's use or anticipated use of any ROUTE 66 designation, including but not limited to printouts of all such website pages.

27. All documents that disclose, describe, or otherwise relate to the characteristics or profiles of the type of person or entity that purchases or receives, or is expected to purchase or otherwise receive, the type of products that are sold or provided, or are planned to be sold and/or provided, by Petitioner under any ROUTE 66 designation.

28. All documents that disclose, describe, or otherwise relate to whether Petitioner has conducted or caused to be conducted a search, investigation or other inquiry, including any trademark search in the United States Patent and Trademark Office, concerning whether any ROUTE 66 designation(s) has been or were being used by other parties, or whether other parties have applied for or received registrations for such marks.

29. All documents that disclose, describe, or otherwise relate to the decision by Petitioner or its affiliates, or their predecessors, to apply or not to apply for registration of any ROUTE 66 designation, including Serial No. 77/393,701, including but not limited to all documents related to any discussions concerning such decision(s).

30. All documents that disclose, describe, or otherwise relate to the pending trademark application, Serial No. 77/393,701, including all communications with the United States Patent & Trademark Office.

31. All documents that disclose, describe, or otherwise relate to any license or assignment agreement(s) to which Petitioner is a party concerning any ROUTE 66 designation.

32. Specimens of representative packaging, hang tags, wrappings, promotional literature, and labeling of every product or service that Petitioner has marketed, distributed, sold or offered for sale under any ROUTE 66 designation at any time in the past, or which it intends to market, distribute, sell or offer for sale in the future.

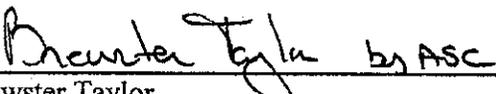
33. All documents filed with either the United States Patent and Trademark Office or any state's trademark office concerning any attempted registration by Petitioner or its affiliates or their predecessors of any ROUTE 66 designation.

34. All documents that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States.

35. Documents sufficient to identify all entities that currently sell and/or will sell Petitioner's tobacco or any other product(s) bearing any ROUTE 66 designation in the United States.

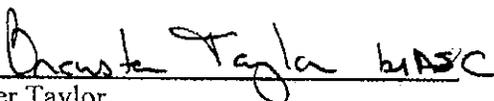
36. Produce those documents, not otherwise requested herein, and referred to by Petitioner in responding to the interrogatories.

Respectfully Submitted,
STITES & HARBISON, PLLC


Brewster Taylor
Transpotomac Plaza
1199 North Fairfax Street
Suite 900
Alexandria, Virginia 22314
(703) 739-4900
June 23, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Respondent's First Request for Production of Documents to Petitioner was *mailed via first class mail*, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, NEAL, GERBER & EISENBERG LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this the 23rd day of June 2008.



Brewster Taylor

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

In the Matter of Registration Nos. 2,950,896, and 3,328,623

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

RESPONDENT'S FIRST REQUEST FOR ADMISSIONS

Respondent, **VAN NELLE TABAK NEDERLAND BV** ("Respondent"), pursuant to Rule 36 of the Federal Rules of Civil Procedure, and Trademark Rules 2.116 and 2.120, hereby requests that Petitioner, **TOP TOBACCO, LP** ("Petitioner"), admit the following requests.

DEFINITIONS AND INSTRUCTIONS

- A. The Definitions and Instructions forming a part of Respondent's First Set of Interrogatories are incorporated herein by reference.
- B. Additionally, if Petitioner denies or objects, in whole or in part, to any Request below, Petitioner shall state in detail reasons for such denial or objection.

REQUESTS

- 1. Admit that Respondent uses Respondent's ROUTE 66 Mark of Registration No. 3,328,623 in connection with Respondent's Products.
- 2. Admit that Respondent uses Respondent's ROUTE 66 ORIGINAL (& Design) Mark of Registration No. 2,950,896 in connection with Respondent's Products.

3. Admit that Petitioner does not use any mark incorporating "ROUTE 66" in connection with tobacco products.
4. Admit that Petitioner has not used any mark incorporating "ROUTE 66" in connection with tobacco products.
5. Admit that Petitioner does not have plans to use any mark incorporating "ROUTE 66" in connection with tobacco products.
6. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent discontinued use in the United States of the mark ROUTE 66 in any and all forms in connection with Applicant's goods.
7. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent never used the mark ROUTE 66 of Registration No. 3,328,623 in the United States.
8. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent never used the mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 in the United States.
9. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent has not used the mark ROUTE 66 of Registration No. 3,328,623 during the period between the date of registration and the filing of the Petition for Cancellation.
10. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has not used the mark ROUTE 66 ORIGINAL (& Design) of

Registration No. 2,950,896 during the period between the date of registration and the filing of the Petition for Cancellation.

11. Admit that Petitioner is aware of no documentary or other evidence that any period of nonuse of Respondent's mark ROUTE 66 of Registration No. 3,328,623 is not excusable non-use.

12. Admit that Petitioner is aware of no documentary or other evidence that any period of nonuse of Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 is not excusable non-use.

13. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has abandoned rights in Respondent's mark ROUTE 66 of Registration No. 3,328,623.

14. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has abandoned rights in Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896

15. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent intends not to resume use of Respondent's mark ROUTE 66 of Registration No. 3,328,623.

16. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent intends not to resume use of Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,508,896.

17. Admit that Petitioner has not objected to the use or registration of any mark, other than Respondent's Mark, comprised in whole or in part of ROUTE 66

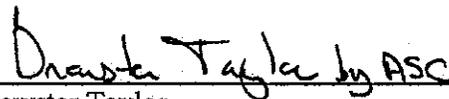
18. Admit that Petitioner does not have specimens of any packaging for any product marketed, distributed, sold or offered for sale by Petitioner bearing the mark ROUTE 66.

19. Admit that Petitioner does not have specimens of any promotional materials for any product marketed, distributed, sold or offered for sale by Petitioner bearing the mark ROUTE 66.

20. Admit that Petitioner bases its claims of abandonment asserted in the Petition for Cancellation on the allegation that Respondent has altered the appearance of its mark ROUTE 66 of Registration No. 3,328,623 as used in commerce.

21. Admit that Petitioner bases its claims of abandonment asserted in the Petition for Cancellation on the allegation that Respondent has altered the appearance of its mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 as used in commerce.

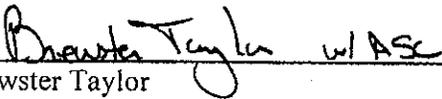
Respectfully Submitted,
STITES & HARBISON, PLLC



Brewster Taylor
Transpotomac Plaza
1199 North Fairfax Street
Suite 900
Alexandria, Virginia 22314
(703) 739-4900
June 23, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Respondent's First Request for Admissions to Petitioner was *mailed via first class mail*, postage prepaid, to counsel for Petitioner, Antony J. McShane, Esquire, Lara V. Hirshfeld, Esquire and Gregory J. Leighton, Esquire, NEAL, GERBER & EISENBERG LLP, Two North LaSalle Street, Chicago, Illinois 60602-3801, on this the 23rd day of June 2008.

 w/ASC

Brewster Taylor

EXHIBIT "C"

Attachments: SFX23C1.pdf, SFX23CA.pdf, SFX23BB.pdf



SFX23BB.pdf (313
KB)



SFX23CA.pdf (259
KB)

-----Original Message-----

From: Ryan, Christina
Sent: Thursday, June 26, 2008 5:55 PM
To: 'lhirshfeld@ngelaw.com'
Cc: Cahill, Amy
Subject: RE: Cancellation No. 92048989

Dear Lara,

Our records indicate complete copies of the discovery requests were served on June 23rd. Please let us know which pages were missing from the discovery requests you reviewed. Additional copies of the discovery requests are attached for your convenience.

Christina

Christina I. Ryan
(502) 587-2087
Stites & Harbison, PLLC
400 W. Market, Suite 1800
Louisville, KY 40202

NOTICE: This message is intended only for the addressee and may contain information that is privileged, confidential and/or attorney work product. If you are not the intended recipient, do not read, copy, retain or disseminate this message or any attachment. If you have received this message in error, please call the sender immediately at (502) 587-2087 and delete all copies of the message and any attachment. Neither the transmission of this message or any attachment, nor any error in transmission or misdelivery shall constitute waiver of any applicable legal privilege.

-----Original Message-----

From: Hirshfeld, Lara [mailto:lhirshfeld@ngelaw.com]
Sent: Thursday, June 26, 2008 03:44 PM Eastern Standard Time
To: Cahill, Amy
Subject: Cancellation No. 92048989

Amy -

There are pages missing from the copies of Van Nelle's First Requests for Admission and First Set of Interrogatories that we received in the mail. This further exemplifies why we suggested exchanging at least courtesy copies of discovery requests and other papers in this proceeding via email. Therefore, please email us copies of these as soon as possible.

Regards,

Lara

Lara V. Hirshfeld
NEAL ? GERBER ? EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street ? Suite 2200
Chicago IL ? 60602-3801
312.269.5385 direct 312.980.0701 fax
lhirshfeld@ngelaw.com ? www.ngelaw.com <<http://www.ngelaw.com/>>

Please consider the environment before printing this email.

Confidentiality Notice: This communication is confidential and may contain privileged information. If you have received it in error, please notify the sender by reply e-mail and immediately delete it and any attachments without copying or further transmitting the same.

-----Original Message-----

From: Hirshfeld, Lara [mailto:lhirshfeld@ngelaw.com]
Sent: Friday, June 27, 2008 11:44 AM
To: Ryan, Christina
Cc: Cahill, Amy; McShane, Antony J.
Subject: RE: Cancellation No. 92048989

Page 2 of Van Nelle's First Requests for Admission and Page 2 of Van Nelle's First Set of Interrogatories was missing. Therefore, we will consider these requests served when we received complete copies on June 26, 2008.

Lara V. Hirshfeld
NEAL • GERBER • EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street • Suite 2200
Chicago IL • 60602-3801
312.269.5385 direct 312.980.0701 fax
lhirshfeld@ngelaw.com • www.ngelaw.com

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-----Original Message-----

From: Ryan, Christina [mailto:cryan@stites.com]
Sent: Thursday, June 26, 2008 4:55 PM
To: Hirshfeld, Lara
Cc: Cahill, Amy
Subject: RE: Cancellation No. 92048989

<<SFX23BB.pdf>> Dear Lara,

Our records indicate complete copies of the discovery requests were served on June 23rd. Please let us know which pages were missing from the discovery requests you reviewed. Additional copies of the discovery

requests are attached for your convenience.

Christina

Christina I. Ryan
(502) 587-2087
Stites & Harbison, PLLC
400 W. Market, Suite 1800
Louisville, KY 40202

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-----Original Message-----

From: Hirshfeld, Lara [mailto:lhirshfeld@ngelaw.com]
Sent: Thursday, June 26, 2008 03:44 PM Eastern Standard Time
To: Cahill, Amy
Subject: Cancellation No. 92048989

Amy -

There are pages missing from the copies of Van Nelle's First Requests for Admission and First Set of Interrogatories that we received in the mail. This further exemplifies why we suggested exchanging at least courtesy copies of discovery requests and other papers in this proceeding via email. Therefore, please email us copies of these as soon as possible.

Regards,

Lara

Lara V. Hirshfeld
NEAL ? GERBER ? EISENBERG

Neal, Gerber & Eisenberg LLP
Two North LaSalle Street ? Suite 2200
Chicago IL ? 60602-3801
312.269.5385 direct 312.980.0701 fax
lhirshfeld@ngelaw.com ? www.ngelaw.com <<http://www.ngelaw.com/>>

Please consider the environment before printing this email.

Confidentiality Notice: This communication is confidential and may contain privileged information. If you have received it in error, please notify the sender by reply e-mail and immediately delete it and any attachments without copying or further transmitting the same.

EXHIBIT "D"

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

**In the Matter of
Registration Nos. 2,950,896, and 3,328,623**

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

**PETITIONER'S RESPONSE TO RESPONDENT'S
FIRST SET OF INTERROGATORIES**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.120, Petitioner, Top Tobacco, L.P., by its attorneys, Neal, Gerber & Eisenberg LLP, hereby responds to Respondent's First Set of Interrogatories.

GENERAL OBJECTIONS

The following objections apply to each Interrogatory and are hereby incorporated by reference into each answer given below:

1. Petitioner objects to answering any Interrogatory or subpart thereof that is:
 - (a) subject to the attorney/client privilege;
 - (b) subject to work product immunity doctrine; or
 - (c) subject to any other applicable privilege.

2. Petitioner generally objects to these Interrogatories to the extent they seek information that is not relevant to any disputed issue in this case.

3. Petitioner's partial response to any Interrogatory is not a waiver of its Objections or right to object to any additional, supplemental or further Interrogatory, or part thereof, but is instead offered in an effort to resolve a potential discovery dispute.

4. Petitioner objects to these Interrogatories to the extent they attempt to impose any burden on Petitioner beyond that permitted by the Federal Rules of Civil Procedure.

5. Petitioner generally objects to each interrogatory as overly broad and unduly burdensome to the extent it seeks information without limits as to time.

INTERROGATORY NO. 1

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "long prior to the filing of the applications that resulted in Registration Nos. 2,950,896, and 3,328,623, Respondent discontinued use in the United States of mark ROUTE 66 (in any and all forms) in connection with the registered goods, to the extent Respondent ever used these marks, with the intent not to resume use in the United States in the foreseeable future", including all documents relating thereto and the persons most knowledgeable thereof.

RESPONSE: Petitioner objects to this interrogatory as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its general and specific objections, Petitioner states that it has found no evidence of any use in commerce in the United States at any time by Respondent of the mark ROUTE 66 (in any and all forms) in connection with any goods. Answering further, Petitioner states that Seth Gold is the person associated with Petitioner who is the most knowledgeable of the foregoing.

INTERROGATORY NO. 2

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "Respondent has not used the '896 and '623 Registrations, which are based on foreign registrations, during the period between the dates of registration and the filing of this Petition, and such non-use of the marks in commerce is not excusable non-use", including all documents relating thereto and the persons most knowledgeable thereof.

RESPONSE: Petitioner objects to this interrogatory as premature in that most of the requested

documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its general and specific objections, Petitioner states that it has found no evidence of any use in commerce in the United States at any time by Respondent of the mark ROUTE 66 (in any and all forms) in connection with any goods. Petitioner identifies Seth Gold as the most knowledgeable person.

INTERROGATORY NO. 3

Identify the factual basis for the allegations in paragraph 9 of the Petition for Cancellation that "Respondent has abandoned the registered ROUTE 66 & Design, ROUTE 66 ORIGINAL & Design or ROUTE 66 marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127, and has not complied with the requirements of Section 44 of the Trademark Act, 15 U.S.C. § 1126", including all documents relating thereto and the persons most knowledgeable thereof.

RESPONSE: Petitioner objects to this interrogatory as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its general and specific objections, Petitioner states that it has found no evidence of any use in commerce in the United States at any time by Respondent of the mark ROUTE 66 (in any and all forms) in connection with any goods. Petitioner identifies Seth Gold as the most knowledgeable person.

INTERROGATORY NO. 4

Identify the factual basis for the allegations in paragraph 11 of the Petition for Cancellation that "Respondent's continued registration of the ROUTE 66 & Design, ROUTE 66 ORIGINAL & Design, and ROUTE 66 marks, would likely result in damage and injury to Top Tobacco in that it is likely to cause confusion, or to cause mistake, or to deceive with respect to Top Tobacco's ROUTE 66 mark", including all documents relating thereto and the persons most knowledgeable thereof.

RESPONSE: Subject to its general objections, Petitioner states that it filed an application to

register its ROUTE 66 mark with the United States Patent & Trademark Office, Serial No. 77/393,701. Subsequently, Petitioner received an office action refusing registration based upon a likelihood of confusion between its ROUTE 66 mark and Respondent's Marks. Therefore, Petitioner will be prejudiced in terms of its ability to register and use its ROUTE 66 mark if Respondent's Marks are not cancelled. Petitioner identifies Seth Gold as the most knowledgeable person.

INTERROGATORY NO. 5

Describe any evidence you have that supports the abandonment of Respondent's Marks.

RESPONSE: Petitioner objects to this interrogatory as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this interrogatory as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact.

INTERROGATORY NO. 6

Describe any evidence you have that supports the non-use of Respondent's Marks and the intent not to resume use of Respondent's Marks.

RESPONSE: Petitioner objects to this interrogatory as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this interrogatory as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact.

INTERROGATORY NO. 7

Identify any evidence of which you are aware that shows the relevant purchasing public's cessation of identification of Respondent's Marks as indicators of source when used in connection with Respondent's Products.

RESPONSE: Petitioner objects to this interrogatory as vague and ambiguous as it does not understand what is meant by the phrase “shows the relevant purchasing public’s cessation of identification of Respondent’s Marks as indicators of source when used in connection with Respondent’s Products.” Petitioner further objects to this interrogatory on the ground that it is unintelligible. As presently understood, however, Petitioner further objects to this interrogatory in that it requests a legal impossibility – namely, evidence of the purchasing public’s cessation of identification of Respondent’s mark as an indication of source, where, in fact, Petitioner is unaware of any use by Respondent of the mark, and Respondent’s own filings do not claim use of the mark. Petitioner also objects to this interrogatory, as presently understood, as premature in that most of the documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents.

INTERROGATORY NO. 8

Describe the basis for your belief that Petitioner would be damaged by the registration of the Respondent’s Marks on the Principal Register.

RESPONSE: Petitioner objects to this interrogatory as duplicative of Interrogatory No. 4.

INTERROGATORY NO. 9

Identify any information you have gathered regarding Respondent, Respondent’s Marks, Respondent’s business, or Respondent’s Products that would be relevant to the claims or defenses in this action.

RESPONSE: Petitioner objects to this interrogatory as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact. Subject to and without waiving its general and specific objections, Petitioner states that it has not been able to find any information indicating that Respondent has used, is using, or intends to use Respondent’s Marks in commerce in the United States.

INTERROGATORY NO. 10

State whether your claims that Applicant has abandoned Applicant's Marks rely on the adoption of new marks by Applicant that continue to incorporate the word mark ROUTE 66 and if so, describe the bases for these claims.

RESPONSE: Petitioner objects to this interrogatory as vague and ambiguous in that there is no claim that Applicant has abandoned Applicant's Marks. Petitioner also objects to this interrogatory on the ground that it is otherwise unintelligible.

INTERROGATORY NO. 11

State whether Petitioner received any opinions concerning the non-use, abandonment, or intent not to resume use of Respondent's Marks.

RESPONSE: Petitioner objects to this interrogatory to the extent it seeks information protected by the attorney-client privilege and work product doctrine.

INTERROGATORY NO. 12

Identify any market research (including surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Petitioner regarding Respondent's Marks.

RESPONSE: Petitioner objects to this interrogatory to the extent it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that it performed an investigation regarding any possible use of Respondent's Marks in commerce in the United States but has not conducted any other market research regarding Respondent's Marks.

INTERROGATORY NO. 13

Identify those persons having the most knowledge of any market research (including surveys, studies, investigations and focus group inquiries) conducted by or on behalf of Petitioner regarding Respondent's Marks.

RESPONSE: Petitioner objects to this interrogatory to the extent that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably

calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its specific and general objections, Petitioner identifies Seth Gold as having information regarding Petitioner's investigation of any possible use of Respondent's Marks in commerce in the United States.

INTERROGATORY NO. 14

Identify all plans Petitioner has to advertise, offer and sell products using "ROUTE 66" and identify all documents relating thereto, and the persons most knowledgeable thereof.

RESPONSE: Subject to and without waiving its general objections, Petitioner intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the ROUTE 66 mark in commerce in the United States. Petitioner identifies Seth Gold as the most knowledgeable person regarding these plans.

INTERROGATORY NO. 15

State the full name of each business, company, person, or other entity affiliated with Petitioner that has at any time used any ROUTE 66 designation in connection with tobacco or any other product(s), and for each, identify its principals(s) and, if applicable, its state and country of organization.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its specific and general objections, Petitioner states that no such business, company, person or affiliate has used the ROUTE 66 designation.

INTERROGATORY NO. 16

Identify each ROUTE 66 designation or any designation that is visually or phonetically similar thereto, used or owned at any time by Petitioner and, with respect to each such designation, identify the designation, the goods used therewith, and the inclusive dates of use thereof.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner further states that pursuant to Federal Rule of Civil Procedure 33(d), it will produce non-privileged documents from which the ROUTE 66 designations that have been used by Petitioner may be derived or ascertained.

INTERROGATORY NO. 17

Identify each transaction by which Petitioner claims that any right (including permission to use or other license) in any ROUTE 66 designation has passed to Petitioner, including setting forth the date of each such transaction and identifying the parties to the transaction and all documents related thereto.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that no rights in any ROUTE 66 designation have passed to Petitioner from another party.

INTERROGATORY NO. 18

Identify by common commercial name each product that Petitioner markets, distributes, sells or offers for sale, under or in connection with any ROUTE 66 designation, and with respect to each such product;

- (a) set forth the actual geographic scope of use;
- (b) set forth the annual actual volume of sales of the product in both dollars and units per year;
- (c) set forth the unit sizes in which the product is sold;
- (d) identify each class or expected class of purchasers of the product;

(e) describe the channels of trade by which the product reaches the ultimate user of such goods;

(f) state all types of stores or forums in which the products are offered or sold; and

(g) identify the persons most knowledgeable of such use, as well as all documents relating thereto.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that it has not yet marketed, distributed, sold, or offered for sale a product under its ROUTE 66 mark.

INTERROGATORY NO. 19

Identify each package or label designer, advertising agency, market research expert or consultant who has performed services in connection with tobacco or any other product(s) planned to be promoted or sold by Petitioner under or in connection with any ROUTE 66 designation, and, for each such entity, describe in detail the services performed and the inclusive dates of such services.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that packaging, design, and marketing services are provided by DRL Enterprises, Inc. In addition, Petitioner states that in consultation with DRL Enterprises, Steven Sandman, Vice President Sales & Marketing of Republic Tobacco, L.P., performed services in connection with the packaging and marketing of the products Petitioner intends to sell under its ROUTE 66 mark.

INTERROGATORY NO. 20

Identify all persons involved on behalf of Petitioner in planning the advertising, marketing, promotion, distribution and sale of tobacco or any other product(s) under or in connection with any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, Petitioner identifies the

following individuals as involved in its plans to market, promote, distribute and sell products under its ROUTE 66 mark: Seth Gold, Steven Sandman, and Claus Platt.

INTERROGATORY NO. 21

State whether Petitioner has ever issued or published, or caused to be issued or published any press or publicity release concerning tobacco or any other product(s) promoted or planned to be promoted under or in connection with any ROUTE 66 designation, and, if so, identify each such release and all publications or other media in or through which information contained therein was disseminated.

RESPONSE: Subject to and without waiving its general objections, Petitioner has not issued or published any press or publicity release concerning products under a ROUTE 66 designation.

INTERROGATORY NO. 22

State whether Petitioner has ever objected to the use or registration of any other mark comprising the designation ROUTE 66, and if so, with respect to each such objection, identify the mark or designation to which the objection, identify the mark or designation to which the objection was made, the user thereof, the nature of the objection, the disposition of the objection, the persons most knowledgeable of the objection, and all documents relating to the objection.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, other than in this proceeding, Petitioner has not objected to the use or registration of any mark comprising the designation ROUTE 66.

INTERROGATORY NO. 23

Identify by title, index number and tribunal each civil action or inter parties proceeding in which Petitioner has been or is involved, other than the present cancellation proceeding, that refers or relates in any way to any ROUTE 66 designation, setting forth the disposition of each such proceeding or, if not disposed of, its current status.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably

calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, other than this proceeding, Petitioner has not been involved in any civil action or inter parties proceeding regarding the ROUTE 66 designation.

INTERROGATORY NO. 24

Identify all agreements to which Petitioner 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.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

INTERROGATORY NO. 25

Identify all licensing agreements, authorizations, or any other rights granted to Petitioner in connection with the ROUTE 66 designation and with respect to each such agreement, authorization or other right, state:

- (a) the names and addresses of all participating parties;
- (b) all terms, including dates of commencement and termination and geographic scope;
- (c) the nature of the rights involved;
- (d) the specific designation to which Petitioner gained the license, authorization or any other right;
- (e) any provisions
- (f) the person(s) most knowledgeable about such agreement, authorization, license or grant.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that

is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Petitioner further objects to Interrogatory No. 25 as duplicative of Interrogatory Nos. 17 and 24.

INTERROGATORY NO. 26

Identify the wholesale and retail price at which all products bearing any ROUTE 66 designation are sold, or are expected to be sold; explain the process by which this price was determined; and identify those persons who participated in all decisions regarding the setting of these prices.

RESPONSE: Petitioner objects to this interrogatory on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that it has not sold any products bearing the ROUTE 66 mark. Petitioner further states that its distributor, Republic Tobacco, L.P., will determine the prices for Petitioner's products to be sold under its ROUTE 66 mark.

INTERROGATORY NO. 27

Explain Petitioner's reason(s) for filing pending application, Serial No. 77/393,701, for ROUTE 66, and identify all persons involved in filing the application, as well as all documents relating thereto.

RESPONSE: Subject to and without waiving its general objections, Petitioner filed pending application, Serial No. 77/373,701, because it intends to market, sell and distribute products under its ROUTE 66 mark. Petitioner further states that Seth Gold was involved in filing the application, and that it will produce non-privileged documents related to the application.

INTERROGATORY NO. 28

Identify all entities that will sell Petitioner's tobacco or any other product(s) bearing any ROUTE

66 designation in the United States, and state the date when such entities executed the Master Settlement Agreement.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will sell products under its ROUTE 66 mark and that it entered the Master Settlement Agreement in 1999. Petitioner further states that Republic Tobacco, L.P. will be the exclusive distributor for such products and will distribute the products to wholesalers and retailers of tobacco products.

INTERROGATORY NO. 29

For each expert Petitioner has retained to give testimony in this proceeding, provide the information required in Rule 26(a)(2)(B), Fed.R.Civ.P.

RESPONSE: Petitioner objects to this interrogatory as premature. The Board has set a schedule in this proceeding that does not require the parties to disclose experts until November 19, 2008. Therefore, Petitioner will supplement this response at the appropriate time later in these proceedings.

INTERROGATORY NO. 30

Identify, on an interrogatory-by-interrogatory basis, each person furnishing information upon which any part of any answer to these interrogatories is based, indicate the parts based on information so furnished by each such person, and whether such information is within the personal knowledge of such person, and if not within such person's knowledge, identify the source of the information so furnished.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that Seth Gold provided information necessary to answer these interrogatories.

Dated: July 31, 2008

Respectfully Submitted,

TOP TOBACCO, L.P.

By:


One of its Attorneys

Antony J. McShane

Lara V. Klapper

Gregory Leighton

Neal, Gerber & Eisenberg LLP

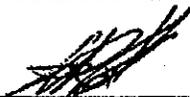
Two N. LaSalle Street, Suite 2200

Chicago, Illinois 60602

(312) 269-8000

VERIFIED AS TO FACTS

I declare that these Responses to Respondent's First Set of Interrogatories are correct to the best of my present knowledge and belief.



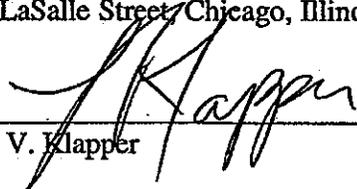
Seth Gold

CERTIFICATE OF SERVICE

I, Lara V. Klapper, an attorney, state that I served a true and correct copy of PETITIONER'S RESPONSE TO RESPONDENT'S FIRST SET OF INTERROGATORIES, upon:

Brewster Taylor
STITES & HARBISON, PLLC
Suite 900 1199 North Fairfax Street
Alexandria, VA 22314-1437

by depositing said copy in a properly addressed envelope, first class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on this 31st day of July 2008.



Lara V. Klapper

4. Petitioner generally objects to these document requests to the extent they seek information that is not relevant to any disputed issue in this case.

5. Petitioner generally objects to each document request as overly broad and unduly burdensome to the extent it seeks documents without limits as to time.

REQUESTS

1. Any and all documents regarding the date and circumstances under which Petitioner became aware of the use or application for registration of Respondent's Marks.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, regarding the date and circumstances under which it became aware of Respondent's Marks.

2. Any and all documents referring or relating to any use by Respondent of Respondent's Marks.

RESPONSE: Petitioner objects to this document request as premature in that most of the requested documents are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its specific and general objections, as Request No. 2 is presently understood, Petitioner states that it has no such documents.

3. Any and all documents referring or relating to any period(s) of non-use by Respondent of Respondent's Marks.

RESPONSE: Petitioner objects to this document request as premature in that most of the requested documents are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its specific and general objections, as Request No. 3 is presently understood, Petitioner states that it has no such documents.

4. Any and all documents referring or relating to any use by any third-party of ROUTE 66 in connection with tobacco products.

RESPONSE: Petitioner objects to this request on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

5. Samples of products, packaging or marketing materials used by Petitioner displaying the ROUTE 66 Mark.

RESPONSE: Subject to and without waiving its general objections, as Request No. 5 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

6. All documents to support Petitioner's allegation that Respondent has abandoned Respondent's Marks with an intent not to resume use.

RESPONSE: Petitioner objects to this document request as premature in that most of the requested documents are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Subject to and without waiving its specific and general objections, Petitioner states that it has not found any documents that show Respondent has used, is using, or will use Respondent's Marks in commerce in the United States, and, therefore, it has no such documents.

7. All documents which evidence Petitioner's objection to any third-party use of a mark that includes ROUTE 66.

RESPONSE: Subject to and without waiving its general objections, as Request No. 7 is presently understood, Petitioner states that it has no such documents.

8. Any and all documents regarding any action taken by Petitioner in response to its awareness of Respondent's Marks.

RESPONSE: Petitioner objects to this document request as overly broad, unduly burdensome, vague and ambiguous with respect to the phrase "any action taken by Petitioner in response to its awareness." Petitioner does not understand what documents Respondent seeks by this document request.

9. Any and all copies of any surveys, market research tests, demographic or consumer profile studies, and focus group inquiries regarding the ultimate purchasers or potential ultimate purchasers of products intended to be sold, offered for sale, advertised or promoted in connection with the ROUTE 66 mark, including the results thereof.

RESPONSE: Subject to and without waiving its general objections, Petitioner states as Request No. 9 is presently understood, Petitioner states that it has no such documents.

10. Any and all copies of any studies, surveys, market research tests, and those documents relating thereto, including the results thereof, concerning Respondent's Products advertised, promoted, distributed and sold in commerce in connection with Respondent's Marks, including, but not limited to, those relating to the consumer perception of Respondent's Marks.

RESPONSE: Petitioner objects to this document request as unintelligible. As presently understood, however, Petitioner further objects to this document request as premature in that most of the requested documents are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. Petitioner also objects to this document request in that, as presently understood, it is duplicative of Document Request No. 2.

11. Any and all documents and things forming the basis for the denial, in whole or in part, of Petitioner's responses to Respondent's First Requests for Admissions.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, that relate to its denials of Respondent's First Requests for Admissions.

12. For each expert Petitioner intends to call to provide testimony in this proceeding, produce.

(a) any written report provided by said expert relating to the subject matter of this proceeding;

(b) a complete written statement of all opinions to be expressed by the expert in this proceeding, and the basis and reason therefor;

(c) all documents reflecting the data or other information considered by the expert in forming his/her opinions;

(d) all exhibits to be used by the expert as a summary of or support for his/her opinions; those documents stating the qualifications of the expert, such as would be reflected in a resume, curriculum vitae, biography, summary or otherwise;

(e) a written list of all publications authored by the witness within the last ten years;

(f) documents reflecting the compensation to be paid for the expert's preparation time and time taken to provide testimony; and

(g) a written list of any other cases in which the witness has testified as an expert at trial, in an administrative proceeding or by deposition within the past four years.

RESPONSE: Petitioner objects to this document as premature. The Board has set a schedule in this proceeding that does not require the parties to disclose experts until November 19, 2008. Therefore, Petitioner will supplement this response at the appropriate time later in these proceedings.

13. All documents which disclose, describe, or otherwise relate to the following:

(a) When Petitioner was first licensed to do business;

(b) All places where Petitioner is licensed or qualified to do business;
and/or

(c) All corporations or other entities in which Petitioner has a controlling interest.

RESPONSE: Petitioner objects to this document request on the ground that it seeks documents that are neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings. Subject to and without waiving its general and specific objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents regarding where it has sought authorization to sell ROUTE 66 branded products.

14. All documents that disclose, describe, or otherwise relate to tobacco or any other products(s) offered or planned to be offered by Petitioner under any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents regarding the products it plans to offer under its ROUTE 66 mark.

15. All documents that disclose, describe, or otherwise relate to the persons most familiar with and primarily responsible for Petitioner's use or intended use of any ROUTE 66 designation.

RESPONSE: Petitioner objects to this document request as overly broad and unduly burdensome to the extent it seeks "[a]ll documents that disclose, describe, or otherwise relate to the persons most familiar with and primarily responsible." Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents that are sufficient to identify the person(s) most familiar with its intended use of its ROUTE 66 mark.

16. All documents that disclose, describe, or otherwise relate to the manner in which Petitioner uses or intends to use any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, regarding the manner it intends to use its ROUTE 66 mark.

17. All documents that disclose, describe, or otherwise relate to the geographic scope of Petitioner's past, current or anticipated efforts to market tobacco or any other product(s) under any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents regarding its current or anticipated efforts to market products under its ROUTE 66 mark.

18. All documents that disclose, describe or otherwise relate to the geographic scope in which Petitioner has or intends to sell or otherwise use any ROUTE 66 designation in connection with tobacco or any other product(s).

RESPONSE: Petitioner further objects to this document request as duplicative of Request No. 17. Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents regarding the geographic scope in which it intends to sell products under its ROUTE 66 mark

19. All documents that disclose, describe, or otherwise relate to the date Petitioner first marketed or intends to first market or offer to provide tobacco or any other product(s) under any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, as Request No. 19 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

20. All documents that disclose, describe, or otherwise relate to the date Petitioner first sold or intends to first sell or provide tobacco or any other product(s) under any ROUTE 66 designation in intrastate commerce, interstate commerce and/or foreign commerce.

RESPONSE: Petitioner objects to this document request as duplicative of Request No. 19. Subject to and without waiving its general objections, as Request No. 20 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

21. Documents sufficient to identify the person(s) most knowledgeable concerning the date when Petitioner first used or expects to first use any ROUTE 66 designation in intrastate commerce, interstate commerce and/or foreign commerce.

RESPONSE: Subject to and without waiving its general objections, as Request No. 21 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

22. All documents that disclose, describe or otherwise relate to Petitioner's plans for the type, price and quality of the products that it offers or intends to offer under any ROUTE 66 designation.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that, it will produce at a mutually convenient time and place non-privileged documents, if any,

regarding its plans for the type, price, and quality of products it intends to offer under its ROUTE 66 mark.

23. For each and every good offered or intended to be offered by Petitioner bearing any ROUTE 66 designation, documents sufficient to identify:

(a) the prices Petitioner charges or plans to charge in connection with each such good.

(b) Petitioner annual sales in units and dollars) of each such good, by state (and country if applicable); and

(c) Petitioner's current inventory, if any, of each such good.

RESPONSE: Petitioner objects to this document request as duplicative of Request No.

22. Subject to and without waiving its specific and general objections, Petitioner states that at this time no documents exist regarding annual sales or inventory for products bearing the ROUTE 66 mark.

24. All documents sufficient to fully describe the manner by which Petitioner advertises and promotes or intends to advertise or promote tobacco or any other product(s) under and ROUTE 66 designation.

RESPONSE: Petitioner objects to this document request as duplicative of Request No.

16. Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, that are sufficient to describe the manner it will advertise and promote products under its ROUTE 66 mark.

25. All documents that identify, constitute, or otherwise relate to any publications in which Petitioner has placed or intends to place print advertisements, articles or other information concerning Petitioner's tobacco or any other product(s) offered or planned to be offered under any ROUTE 66 designation.

RESPONSE: Petitioner objects to this document request as duplicative of Request No.

16 and 24. Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any,

that identify any publications that it intends to place advertisements or other information about its ROUTE 66 products.

26. All documents that disclose, depict, or otherwise relate to any Internet website referencing Petitioner's use or anticipated use of any ROUTE 66 designation, including but not limited to printouts of all such website pages.

RESPONSE: Petitioner objects to this document request as duplicative of Request No. 16, 24 and 25. Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, that relate to any Internet website referencing its ROUTE 66 products.

27. All documents that disclose, describe, or otherwise relate to the characteristics or profiles of the type of person or entity that purchases or receives, or is expected to purchase or otherwise receive, the type of products that are sold or provided, or are planned to be sold and/or provided, by Petitioner under any ROUTE 66 designation.

RESPONSE: Petitioner objects to this document request on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

28. All documents that disclose, describe, or otherwise relate to whether Petitioner has conducted or caused to be conducted a search, investigation or other inquiry, including any trademark search in the United States Patent and Trademark Office, concerning whether any ROUTE 66 designation(s) has been or were being used by other parties, or whether other parties have applied for or received registrations for such marks.

RESPONSE: Petitioner objects to this document request on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

Petitioner further objects to this document request on the ground that it seeks documents protected by the attorney-client privileged or work product doctrine.

29. All documents that disclose, describe, or otherwise relate to the decision by Petitioner or its affiliates, or their predecessors, to apply or not to apply for registration of any ROUTE 66 designation, including Serial No. 77/393,701, including but not limited to all documents related to any discussions concerning such decision(s).

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, that relate to its decision to file Application Serial No. 77/393,701.

30. All documents that disclose, describe, or otherwise relate to the pending trademark application, Serial No. 77/393,701, including all communications with the United States Patent & Trademark Office.

RESPONSE: Petitioner objects to this document request as duplicative of Request No. 29. Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents that relate to Application Serial No. 77/393,701.

31. All documents that disclose, describe, or otherwise relate to any license or assignment agreement(s) to which Petitioner is a party concerning any ROUTE 66 designation.

RESPONSE: Petitioner objects to this request on the ground that it seeks information that neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

32. Specimens of representative packaging, hang tags, wrappings, promotional literature, and labeling of every product or service that Petitioner has marketed, distributed, sold or offered for sale under any ROUTE 66 designation at any time in the past, or which it intends to market, distribute, sell or offer for sale in the future.

RESPONSE: Petitioner objects to this document request as duplicative of Request No.

5:

33. All documents filed with either the United States Patent and Trademark Office or any state's trademark office concerning any attempted registration by Petitioner or its affiliates or their predecessors of any ROUTE 66 designation.

RESPONSE: Petitioner objects to this request on the ground that it seeks information that is neither relevant to the issues raised in Petitioner's Petition for Cancellation, nor reasonably calculated to lead to the discovery of admissible evidence in these proceedings.

Petitioner also objects to this document request as duplicative of Request Nos. 29 and 30.

Subject to and without waiving its specific and general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents that relate to Application Serial No. 77/393,701.

34. All documents that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States.

RESPONSE: Petitioner objects to this document request as duplicative of document requests nos. 5, 9, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, and 32.

35. Documents sufficient to identify all entities that currently sell and/or will sell Petitioner's tobacco or any other product(s) bearing any ROUTE 66 designation in the United States.

RESPONSE: Subject to and without waiving its general objections, as Request No. 35 is presently understood, Petitioner states that it has not yet used the ROUTE 66 mark in commerce and therefore has no such documents.

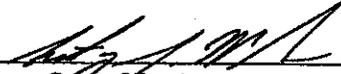
36. Produce those documents, not otherwise requested herein, and referred to by Petitioner in responding to the interrogatories.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it will produce at a mutually convenient time and place non-privileged documents, if any, referred to in its Response to Respondent's Interrogatories that were not otherwise requested.

Dated: July 28, 2008

Respectfully Submitted,

TOP TOBACCO, L.P.

By: 

One of Its Attorneys

Antony J. McShane

Lara V. Klapper

Gregory Leighton

Neal, Gerber & Eisenberg LLP

Two N. LaSalle Street, Suite 2200

Chicago, Illinois 60602

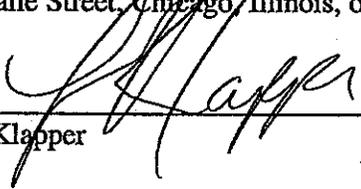
(312) 269-8000

CERTIFICATE OF SERVICE

I, Lara V. Klapper, an attorney, state that I served a true and correct copy of PETITIONER'S RESPONSE TO RESPONDENT'S FIRST SET OF REQUESTS FOR DOCUMENT PRODUCTION, upon:

Brewster Taylor
STITES & HARBISON, PLLC
Suite 900 1199 North Fairfax Street
Alexandria, VA 22314-1437

by depositing said copy in a properly addressed envelope, first class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on this 28th day of July 2008.



Lara V. Klapper

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

**In the Matter of
Registration Nos. 2,950,896, and 3,328,623**

TOP TOBACCO, LP,

Petitioner,

v.

VAN NELLE TABAK NEDERLAND BV,

Respondent

)
)
)
) **Cancellation No. 92048989**
)
)
)

**PETITIONER'S RESPONSE TO RESPONDENT'S
FIRST REQUEST FOR ADMISSIONS**

Petitioner, Top Tobacco, L.P. ("Petitioner"), by its attorneys and pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 36 of the Federal Rules of Civil Procedure, hereby responds to Respondent's First Request for Admissions.

GENERAL OBJECTIONS

1. Petitioner objects to the Requests to the extent that they seek the admission of matters that are subject to the attorney-client privilege, the attorney work product privilege, or any other recognized privilege. With respect to such Requests, Petitioner will not provide privileged information.

2. Petitioner objects to the Requests to the extent that they are vague or ambiguous, contain confusing grammatical construction or omissions, and/or substantially alter the common meaning of terms so as to render misleading the specific admissions sought.

3. Petitioner objects to the Requests to the extent that they seek to impose burdens or obligations beyond those sanctioned by the Trademark Rules of Practice and the Federal Rules of

Civil Procedure, or are not reasonably calculated to lead to the discovery of admissible evidence. Petitioner will not respond to Requests seeking admissions that are not reasonably calculated to lead to the discovery of admissible evidence.

Without waiving any of these General Objections, Petitioner responds to Respondents First Request for Admission as follows, incorporating each and every one of the foregoing General Objections into each respective Response below.

REQUESTS

1. Admit that Respondent uses Respondent's ROUTE 66 Mark of Registration No. 3,328,623 in connection with Respondent's Products.

RESPONSE: Denied.

2. Admit that Respondent uses Respondent's ROUTE 66 ORIGINAL (& Design) Mark of Registration No. 2,950,896 in connection with Respondent's Products.

RESPONSE: Denied.

3. Admit that Petitioner does not use any mark incorporating "ROUTE 66" in connection with tobacco products.

RESPONSE: Subject to and without waiving its general objections, Petitioner states that it has not yet commenced use of its ROUTE 66 mark in connection with tobacco products.

4. Admit that Petitioner has not used any mark incorporating "ROUTE 66" in connection with tobacco products.

RESPONSE: Admitted.

5. Admit that Petitioner does not have plans to use any mark incorporating "ROUTE 66" in connection with tobacco products.

RESPONSE: Denied.

6. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent discontinued use in the United States of the mark ROUTE 66 in any and all forms in connection with Applicant's goods.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely, the existence of documents to prove the absence of a fact; Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

7. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent never used the mark ROUTE 66 of Registration No. 3,328,623 in the United States.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely, the existence of documents to prove the absence of a fact; Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

8. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent never used the mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 in the United States.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact; Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

9. Admit that Petitioner is aware of no documentary or other evidence that supports its contention that Respondent has not used the mark ROUTE 66 of Registration No. 3,328,623 during the period between the date of registration and the filing of the Petition for Cancellation.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact; Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

10. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has not used the mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 during the period between the date of registration and the filing of the Petition for Cancellation.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent

has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner also objects to this request as it requests a legal impossibility, namely the existence of documents to prove the absence of a fact; Petitioner is unaware of any use at any time of the mark by Respondent in the United States. On this basis, Petitioner denies this request.

11. Admit that Petitioner is aware of no documentary or other evidence that any period of nonuse of Respondent's mark ROUTE 66 of Registration No. 3,328,623 is not excusable non-use.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility, namely, the existence of documents or other evidence to prove the absence of a fact, i.e., the presence of nonuse of a mark. On that basis, Petitioner denies this request.

12. Admit that Petitioner is aware of no documentary or other evidence that any period of nonuse of Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 is not excusable non-use.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility

– namely, the existence of documents or other evidence to prove the absence of a fact, i.e., the presence of nonuse of a mark. On that basis, Petitioner denies this request.

13. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has abandoned rights in Respondent's mark ROUTE 66 of Registration No. 3,328,623.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility, namely, the existence of documents or other evidence to prove the absence of a fact, i.e., the abandonment of rights in a mark, where, in fact, Petitioner is unaware of any use by Respondent of the mark. On that basis, Petitioner denies this request.

14. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent has abandoned rights in Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility, namely, the existence of documents or other evidence to prove the absence of a fact, i.e., the abandonment of rights in a mark, where, in fact, Petitioner is unaware of any use by Respondent of the mark. On that basis, Petitioner denies this request.

15. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent intends not to resume use of Respondent's mark ROUTE 66 of Registration No. 3,328,623.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility, namely, evidence of the Respondent's intent not to resume use of the mark, where, in fact, Petitioner is unaware of any use by Respondent of the mark, and Respondent's own filings do not claim use of the mark. On that basis, Petitioner denies this request.

16. Admit that Petitioner is aware of no documentary or other evidence that supports its position that Respondent intends not to resume use of Respondent's mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,508,896.

RESPONSE: Petitioner objects to this request as premature in that most of the requested documents and other evidentiary support are in the possession of Respondent, and Respondent has not yet responded to discovery requests or produced any documents. In addition, Petitioner objects to this request to the extent it seeks documents and information protected by the work product doctrine. Petitioner further objects to this request in that it requests a legal impossibility, namely, evidence of the Respondent's intent not to resume use of the mark, where, in fact, Petitioner is unaware of any use by Respondent of the mark, and Respondent's own filings do not claim use of the mark. On that basis, Petitioner denies this request.

17. Admit that Petitioner has not objected to the use or registration of any mark, other than Respondent's Mark, comprised in whole or in part of ROUTE 66

RESPONSE: Admitted.

18. Admit that Petitioner does not have specimens of any packaging for any product marketed, distributed, sold or offered for sale by Petitioner bearing the mark ROUTE 66.

RESPONSE: Subject to and without waiving its general objections, as stated in its Petition to Cancel, Petitioner intends to market, distribute, sell and offer for sale products bearing its ROUTE 66 mark, and Petitioner has developed preliminary packaging materials for these products that will be produced. On that basis, Petitioner denies this request.

19. Admit that Petitioner does not have specimens of any promotional materials for any product marketed, distributed, sold or offered for sale by Petitioner bearing the mark ROUTE 66.

RESPONSE: Subject to and without waiving its general objections, as stated in its Petition to Cancel, Petitioner intends to market, distribute, sell and offer for sale products bearing its ROUTE 66 mark, and Petitioner has developed preliminary packaging materials for these products that will be produced. On that basis, Petitioner denies this request.

20. Admit that Petitioner bases its claims of abandonment asserted in the Petition for Cancellation on the allegation that Respondent has altered the appearance of its mark ROUTE 66 of Registration No. 3,328,623 as used in commerce.

RESPONSE: Denied. The basis of Petitioner's claims of abandonment are set forth in its Petition to Cancel.

21. Admit that Petitioner bases its claims of abandonment asserted in the Petition for Cancellation on the allegation that Respondent has altered the appearance of its mark ROUTE 66 ORIGINAL (& Design) of Registration No. 2,950,896 as used in commerce.

RESPONSE: Denied. The basis of Petitioner's claims of abandonment are set forth in its Petition to Cancel.

Dated: July 31, 2008

Respectfully Submitted,

TOP TOBACCO, L.P.

By:



One of Its Attorneys

Antony J. McShane

Lara V. Klapper

Gregory Leighton

Neal, Gerber & Eisenberg LLP

Two N. LaSalle Street, Suite 2200

Chicago, Illinois 60602

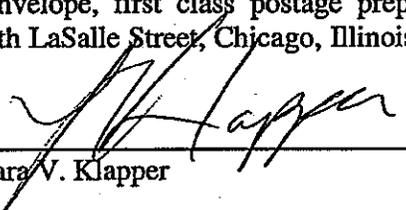
(312) 269-8000

CERTIFICATE OF SERVICE

I, Lara V. Klapper, an attorney, state that I served a true and correct copy of PETITIONER'S RESPONSE TO RESPONDENT'S FIRST SET OF REQUESTS FOR ADMISSION, upon:

Brewster Taylor
STITES & HARBISON, PLLC
Suite 900 1199 North Fairfax Street
Alexandria, VA 22314-1437

by depositing said copy in a properly addressed envelope, first class postage prepaid, and depositing same in the United States mail at Two North LaSalle Street, Chicago, Illinois, on this 31st day of July 2008.



Lara V. Klapper

EXHIBIT "E"

September 16, 2008

VIA MAIL AND EMAIL LKLAPPER@NGELAW.COM

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

Brewster Taylor
(703) 837-3906
(703) 518-2936 FAX
btaylor@stites.com

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

Dear Ms. Klapper:

We are in receipt of your letter dated August 27, 2008 and respond to your points in turn below. In addition, we address the deficiencies in Petitioner's responses to Respondent's first set of discovery requests. Finally, please advise by return as to when and how Top Tobacco will provide documents in response to our requests. We would be glad to send our document production if you will agree to do the same.

I. Respondent's Responses to Petitioner's Discovery Requests

Objection to Petitioner's Definition of the term "ROUTE 66 Mark"

Petitioner sought to include in its definition of "ROUTE 66 Mark" the mark that is the subject of expired U.S. Registration No. 1,686,628. Respondent properly objected to this definition because it renders the discovery requests unduly burdensome and not reasonably calculated to lead to the discovery of admissible evidence. Contrary to the assertions in Petitioner's letter, Petitioner's claims are now limited only to cancellation of U.S. Trademark Registration Nos. 2,950,896 and 3,328,623 on the grounds of alleged abandonment of those marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127. Petitioner's claims in connection with the expired '628 registration are moot. (Board's Order, May 27, 2008.) Both of these registrations are based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126. Accordingly, the '628 registration and the subject matter thereof are completely irrelevant to Petitioner's claims:

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

Lara V. Klapper
September 16, 2008
Page 2

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).

Moreover, the relevant timeframe with respect to Petitioner's abandonment claims begins 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)). Thus, for all of the above reasons, Petitioner maintains its objections to the definition and to the discovery requests affected thereby.

Finally, the fact that registrations existed and were cited in connection with the prosecution of the applications which issued as the registrations at issue is irrelevant to the issue of whether the marks in the registrations at issue were abandoned after the issuance of the registrations.

Respondent's Interrogatory Responses

Interrogatory No. 1

Respondent renews its objections to this interrogatory. Petitioner's suggested limitation does not confine the interrogatory either to a relevant time period or to the United States. With respect to use in the United States, Respondent has identified in response to Interrogatory No. 2 the affiliated businesses which have used the "ROUTE 66" mark in the United States during the relevant time period.

Interrogatory No. 2

The address of Commonwealth Brands, Inc. is 900 Church Street, Bowling Green, Kentucky 42101. It is Applicant's sister company. I will obtain identification of relevant principals. JL Gaddy Enterprises, Inc. is located at 6002 Wylie Ave., Hickory Grove, South Carolina 29717-7759. I believe that JL Gaddy Enterprises, Inc. is affiliated only as a wholesaler of Respondent's products but will obtain confirmation and identification of relevant principals if available.

Lara V. Klapper
September 16, 2008
Page 3

Interrogatory No. 3

Respondent specifically identified the products that had been sold under the "ROUTE 66" mark in the U.S. since the registrations issued i.e. cigarettes and stated that future use may be in relation to any of the goods listed in the registrations. Respondent cannot identify the "specific states" in which it intends to sell "ROUTE 66" products because it has not yet determined the "specific states" in which the products will be sold. Though Respondent intends to sell "ROUTE 66" products nationwide, it will begin sales regionally. The scope of the region has not yet been determined. Further, Petitioner requested Respondent "set forth the actual geographic scope of such use," not "the specific states it intends to sell ROUTE 66 products." As stated above, the only sales since the registrations issued were to the wholesaler JL Gaddy Enterprises, Inc., which is located in South Carolina. As to intended use, Respondent's reply that it intends to sell ROUTE 66 products throughout the United States is fully responsive.

Interrogatory No. 4

Subject to our objections, this is to advise that the commercial testing took place in Minneapolis, Minnesota, and Birmingham, Alabama November 27 – 30, 2006 and in Atlanta, Georgia, and Cleveland, Ohio, December 11-14, 2006. Commonwealth Brands, Inc. is located in Kentucky, and JL Gaddy Enterprises, Inc. is located in South Carolina. The commercial testing and the sale to JL Gaddy Enterprises, Inc. are the only commercial uses of the mark in the U.S. since either registration issued. Respondent will produce non-privileged documents for Petitioner to ascertain further information regarding the commercial testing and research conducted in the United States in 2006.

Interrogatory No. 13

Respondent maintains its objections to this interrogatory and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark."

Respondent's Responses to Document Requests

Document Request No. 16

Respondent renews its objections to this revised request and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark." As is evident from the TTAB case quoted above, the objections are not "groundless".

Document Request No. 17

Respondent renews its objections and response to this request and refers Petitioner to the discussion above regarding Petitioner's definition of the term "ROUTE 66 Mark."

Lara V. Klapper
September 16, 2008
Page 4

Document Request No. 32

Respondent maintains its objections to this request. Petitioner fails to appropriately limit this request, instead asking for "all documents," wherever located and whenever created. This request is clearly unreasonably vague, general, and overbroad, rendering the request burdensome and oppressive. However, I will ask if there are any documents which specifically relate to Respondent's document retention policy.

II. Petitioner's Responses to Respondent's Discovery Requests

In reviewing Petitioner's discovery responses thus far, we note the following deficiencies to be addressed.

Requests for Admission 6-16 and Interrogatories Nos. 5, 6, and 9

In response to these discovery requests, Petitioner has tendered variations of an unacceptable response that is convoluted and unintelligible. Specifically, Petitioner objects on the grounds these requests comprise "a legal impossibility, namely the existence of documents to prove the absence of a fact" and are premature because they involve information or documents in Respondent's possession. These requests specifically seek to elicit information regarding Petitioner's evidence, if any, in support of its claims of abandonment, *e.g.*, "Describe any evidence you have that supports the abandonment of Respondent's Marks." (Interrogatory No. 5.)

Petitioner initiated the current cancellation proceeding, averring that "on information and belief," Respondent had abandoned the subject marks. Now, Petitioner equivocates in response to direct inquiries regarding the substance of that information and belief. Petitioner has failed to reveal any source of information that formed the basis of its claims, now describing such information as "a legal impossibility" in contravention of its averments in the Petition to Cancel.

Further, to the extent Petitioner objects to these or other requests as premature because the requested information or documents are within Respondent's possession, Petitioner's responses are willfully deficient. Petitioner is obligated to provide responsive information and documents of which it is currently aware or to state it has no such information or documents. Respondent's requests are clearly not directed to discover information and documents in Respondent's possession.

Respondent requests that Petitioner withdraw its objections and supplement its responses to these discovery requests.

Petitioner's Responses to Interrogatories

Lara V. Klapper
September 16, 2008
Page 5

Interrogatory No. 11

Petitioner's response to Interrogatory No. 11 was limited to an objection "to the extent it seeks information protected by the attorney-client privilege and work product doctrine." This is a "yes" or "no" question. Please respond.

Interrogatory No. 12

Petitioner objected to this Interrogatory in part as irrelevant to the issues raised in Petitioner's Petition for Cancellation. To the contrary, this Interrogatory is directly relevant to Petitioner's claims of abandonment and as such, Respondent requests Petitioner withdraw its objections. Further, Petitioner's response vaguely refers to an investigation it performed regarding any possible use of Respondent's Marks in commerce in the United States. In Petitioner's supplemental response to this Interrogatory, please identify the investigation in accordance with the definition provided in the interrogatories.

Interrogatory No. 14

This Interrogatory requests Petitioner identify all plans to advertise, offer, or sell products using "ROUTE 66," all documents relating thereto, and the persons most knowledgeable thereof. Petitioner's response states only that it "intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the Route 66 mark in commerce in the United States" and identifies Seth Gold as the most knowledgeable person. Please clarify whether Petitioner has any more specific plans in connection with these products and also identify documents that relate to these plans or state that no such documents exist.

Interrogatory No. 19

This Interrogatory requests Petitioner identify those who have performed services in connection with products to be sold by Petitioner under or in connection with any ROUTE 66 designation and to "describe in detail the services performed and the inclusive dates of such services." In response, Petitioner identifies DRL Enterprises, Inc. and Steven Sandman, Vice President Sales & Marketing of Republic Tobacco, L.P but fails to provide a detailed description of the services performed and the inclusive dates of such services. Please provide this information in Petitioner's supplemental response to Interrogatory No. 19.

Interrogatory No. 24

This Interrogatory requests Petitioner identify all agreements to which it is or has been a party that refer or relate to any ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds. Contrary to Petitioner's objection, information responsive to this request is pertinent to Respondent's available claims and defenses and Petitioner's standing to petition

Lara V. Klapper
September 16, 2008
Page 6

for cancellation of Respondent's Marks, including Petitioner's pending trademark application, Serial No. 77/393,701, filed under Section 1(b) relying on Petitioner's bona fide intention to use the mark in commerce. Accordingly, please supplement your response to this Interrogatory and identify any such agreements, the persons most knowledgeable thereof, and all documents relating thereto.

Interrogatory No. 25

This Interrogatory requests information regarding any rights granted to Petitioner in connection with the ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds and as duplicative of Interrogatories Nos. 17 and 24. To this end, and in light of the preceding paragraph regarding the relevancy of Interrogatory No. 24, please confirm there are no "licensing agreements, authorizations, or any other rights granted to Petition in connection with the ROUTE 66 designation."

Interrogatory No. 26

This Interrogatory requests information related to the wholesale and retail prices at which all products bearing any ROUTE 66 designation are sold or expected to be sold. Petitioner objects on relevancy grounds, though this information relates to Petitioner's intent. Although Petitioner states its distributor will determine the prices, Petitioner provides no other information regarding the process by which the price is to be determined and the persons who participate in these decisions. Please provide this information in Petitioner's supplemental response to Interrogatory No. 26.

Petitioner's Responses to Document Production Requests

Document Production Req. No. 8

This request seeks: "Any and all documents regarding any action taken by Petitioner in response to its awareness of Respondent's Marks." This request is clear and direct and follows logically from Document Request No. 1 regarding the date and circumstances under which Petitioner became aware of the use or application for registration of Respondent's Marks. Accordingly, please provide a response to this request.

Document Request No. 10

This request seeks documents comprising or related to any studies, surveys, or market research tests concerning products advertised, promoted, distributed, and sold in commerce in connection with Respondent's Marks, including, but not limited to, those relating to the

Lara V. Klapper
September 16, 2008
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consumer perception of Respondent's Marks. This request is clear and direct. Accordingly, Respondent requests Petitioner supplement its response and provide such documents.

Document Request No. 13

This request seeks documents which disclose, describe, or otherwise relate to when Petitioner was first licensed to do business, the places it is licensed or qualified to do business, and the corporations or other entities in which Petitioner has a controlling interest. Petitioner states it will produce non-privileged documents regarding where it has sought authorization to sell ROUTE 66 branded products. In Petitioner's supplemental response to this request, please confirm Petitioner will produce non-privileged documents disclosing, describing, or otherwise relating to (i) when Petitioner was first licensed to do business in connection with the products offered or planned to be offered by Petitioner under any ROUTE 66 designation and/or (ii) the corporations or other entities in which Petitioner has a controlling interest that plan to use any ROUTE 66 designation or has at any time used any ROUTE 66 designation.

Document Request Nos. 19-21

These requests seek documents in connection with the date(s) Petitioner first marketed or sold or intends to first market or sell products under any ROUTE 66 designation, and the persons most knowledgeable regarding Petitioner's first use or intended first use of same. Petitioner's responses appear to ignore the requests to the extent they seek documents related to the date when Petitioner intends to first market or sell products, stating only that Petitioner has not yet used the mark in commerce. In Petitioner's supplemental response, please advise whether there are any responsive documents to the extent the requests involve the date Petitioner intends to first market or sell products under the ROUTE 66 designation or the person(s) most knowledgeable concerning the date when Petitioner expects to first use any ROUTE 66 designation in intrastate, interstate commerce, and/or foreign commerce.

Document Request No. 27

This Interrogatory requests Petitioner produce all documents that disclose, describe, or otherwise relate to the characteristics or profiles of the type of person or entity expected to purchase or otherwise receive the type of products planned to be sold or provided by Petitioner under any ROUTE 66 designation. Petitioner objected to this Interrogatory on relevancy grounds. Contrary to Petitioner's objection, information responsive to this request is pertinent to Respondent's intent to use the ROUTE 66 designation, including Petitioner's pending trademark application, Serial No. 77/393,701, filed under Section 1(b) relying on Petitioner's bona fide intention to use the mark in commerce. Accordingly, please supplement your response to this request.

Lara V. Klapper
September 16, 2008
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Document Request No. 28

This request seeks documents related to whether Petitioner conducted or caused to be conducted a search, investigation or other inquiry concerning whether other parties had applied for, received registrations for, were using or used any ROUTE 66 designation(s). Petitioner objects on relevancy grounds, however, this information is also relevant to Petitioner's intent. Accordingly, please supplement your response to this request.

Document Request No. 31

This request seeks documents related to any license or assignment agreements to which Petitioner is a party concerning any ROUTE 66 designation. Petitioner again objects on relevancy grounds, however, this information is also relevant to Petitioner's intent and standing in this proceeding. Accordingly, please supplement your response to this request.

Document Request No. 34

This request seeks "documents that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States." Petitioner's objection that it perceives this request to be duplicative of other document requests is insufficient to avoid Petitioner's obligation to respond. This general request is discernibly different from Respondent's other requests. Accordingly, Respondent asks that Petitioner supplement its response to this request

Document Request No. 35

This request seeks, among other things, documents sufficient to identify all entities that will sell Petitioner's product(s) bearing any ROUTE 66 designation in the United States. Petitioner appears to limit its response to entities that currently sell such products, stating only that Petitioner has not yet used the ROUTE 66 mark in commerce and therefore has no such documents. In Petitioner's supplemental response, please advise that Petitioner will produce documents sufficient to identify the entities that will sell product(s) bearing any ROUTE 66 designation.

STITES & HARBISON PLLC
ATTORNEYS

Lara V. Klapper
September 16, 2008
Page 9

Please advise at your earliest convenience.

Sincerely,

STITES & HARBISON, PLLC


Brewster Taylor

BT:CR

69985:1:ALEXANDRIA

November 3, 2008

Lara V. Klapper, Esq.
Neal Gerber Eisenberg
Two North LaSalle Street, Ste. 2200
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Amy S. Cahill
(502) 681-0597
(502) 779-9805 FAX
acahill@stites.com

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

Dear Ms. Klapper:

We have not received your response to correspondence from Brewster Taylor dated September 16, 2008 outlining the continued deficiencies in Petitioner's discovery responses. Most notably, your client has not identified or produced a single document in response to requests for production of documents or things served on June 26, 2008.

For your convenience, I summarize Petitioner's remaining deficient responses below. This correspondence serves as a final good faith effort to resolve these outstanding issues before seeking Board intervention pursuant to TBMP § 523.02.

Finally, enclosed herewith please find Respondent's responsive documents labeled VN0001 – VN0195. We ask that in addition to supplementing the discovery responses outlined in our previous correspondence and highlighted below, that your client extend the reciprocal courtesy of producing copies of responsive documents at our Alexandria, Virginia offices.

Petitioner's Deficient Responses

The primary unresolved discovery issues are those surrounding Petitioner's intended use of the ROUTE 66 mark. In its Petition for Cancellation, Petitioner states:

Top Tobacco has applied for federal registration of the trademark ROUTE 66 . . . in connection with [various goods in International Classes 7 and 34].

...

Respondent's continued registration of the ROUTE 66 . . . [marks] would likely result in damage and injury to Top Tobacco in that it is likely to cause confusion, or to cause mistake, or to deceive with respect to Top Tobacco's ROUTE 66 mark.

308LT:20399:72684:1:ALEXANDRIA

Lara Klapper, Esq.
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(Petition for Cancellation, Pars. 2, 11). As such, Petitioner relies on both its bona fide intent to use ROUTE 66 and on an asserted likelihood of consumer confusion between its proposed ROUTE 66 mark and Respondent's registered ROUTE 66 mark as grounds for its Petition.

Parties may obtain discovery regarding any matter, not privileged, that is relevant to the claim or defense of any party. Relevant information includes any discovery reasonably calculated to lead to the discovery of admissible evidence. Fed. R. Civ. P. 26(b)(1). Accordingly, discovery relating to Petitioner's planned use of ROUTE 66 including the goods to which the mark will be applied and the conditions surrounding sale that are relevant to likely confusion are also relevant to and discoverable in this proceeding.

Requests for Admission 6-16 and Interrogatory Nos. 5, 6 and 9

You have refused to admit or deny that Petitioner has, or does not have, evidence that supports its claims that Respondent abandoned the ROUTE 66 mark, and have refused to produce any documents to support such a showing. Without a proper objection or response to these requests, we will ask the Board to deem the requests admitted pursuant to TBMP § 524.01, Fed. R. Civ. P. 36(a).

Your client has now received all responsive non-privileged documents in Respondent's possession, custody or control requested in discovery. Therefore, Petitioner's previous objection that the disputed requests involve documents in Respondent's possession lacks grounds.

Please supplement the responses to requests for admissions 6-16 and interrogatories 5, 6 and 9.

Interrogatory No. 11

Your client has not responded to Interrogatory No. 11, and instead has relied on the attorney-client privilege. This reliance is improper. The identification of discovery documents (as opposed to their substance) is not privileged or confidential. TBMP § 414(1); *see Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975). Petitioner may state whether it received any opinions concerning Respondents' marks, without revealing the substance of those communications.

Interrogatory No. 12

We await production of the investigation Petitioner performed in connection with Respondent's proposed use of its ROUTE 66 mark in the United States referred to in Petitioner's previous responses.

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Interrogatory No. 14

Petitioner concedes the relevance of this interrogatory directed to its plans to use the ROUTE 66 mark in the U.S. by admitting that it "intends to advertise, offer and sell tobacco, cigarette papers, and other related products under the Route 66 mark in commerce" in the United States. However, the interrogatory seeks more than the existence of Petitioner's "intent." Please provide information about any steps Petitioner has taken towards its intended use of ROUTE 66 and any documents relating thereto.

Interrogatory No. 19

We continue to await a complete answer to this interrogatory, which seeks a description of the services performed and the dates of those services performed for Petitioner in connection with Petitioner's products to be sold in connection with any ROUTE 66 designation. Please provide this information in supplemental form.

Interrogatory Nos. 24 and 25 and Request No. 31

Agreements relating to the mark in question, including license agreements or other arrangements between the owner and third-parties are discoverable. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988). Please identify all agreements requested in these discovery requests, and those individuals with information relating thereto.

Interrogatory No. 26

Petitioner states that its distributors will set prices for the products bearing its intended ROUTE 66 mark. Please provide a manufacturer's "suggested retail price," or price range(s) at which the goods will be offered for sale to consumers.

Request No. 8

We continue to await documents regarding any action take by Petitioner in response to its awareness of Respondent's Marks. Petitioner's response states: (1) that it does not understand the request and (2) that the request is overbroad and unduly burdensome. Petitioner chose to file a petition for cancellation after becoming aware of Respondent's marks. Any documents relating to the decision on, and subsequent action related to, filing the petition are among the documents that are sought by this request.

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November 3, 2008
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Request No. 10

Studies, surveys, or market research, or documents concerning consumer perceptions relating thereto concerning Respondent's products intended to be sold under the proposed ROUTE 66 mark are relevant to the grounds Petitioner asserts in its petition for cancellation. Please supplement Petitioner's responses to include this information.

Request No. 13

You have agreed to produce responsive documents relating to when Petitioner was first licensed to do business, the places it is licensed or qualified to do business, and the corporations or other entities in which petitioner has a controlling interest. Please produce these documents at your earliest convenience.

Request Nos. 19-21

Petitioner asserts an intent to begin using ROUTE 66 as a mark in the United States in connection with specified goods. These requests nos. 19- 21 seek additional documents surrounding this intended use, including documents that show the dates on which Petitioner intends to first market or sell products under the ROUTE 66 mark, and the persons most knowledgeable of these activities. The requests are directed to intrastate, interstate and foreign commerce.

Although in some cases a party's foreign use is irrelevant in Board proceedings, there are exceptions, for example, where "there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purposes of forestalling a foreign user's expansion into the United States." TBMP § 414(13); see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991)(in view of Applicant's knowledge of opposer's claim to mark in foreign countries and of opposer's intention to enter U.S. market, it appears that applicant intended to preclude opposer from entering U.S. market).

Request No. 27

Respondent's request for production of documents relating to the types of persons expected to purchase Petitioner's planned ROUTE 66 products is relevant. The classes of customers for a party's involved goods or services are discoverable in Board proceedings. TBMP § 414(3). Please produce any documents responsive to this request.

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November 3, 2008
Page 5

Request No. 28

Documents relating to the search of a mark at issue, including search reports, are discoverable in Board proceedings. TBMP § 414(6). Please produce any searches conducted by or on behalf of Petitioner for the proposed ROUTE 66 mark and related documents encompassed by this request.

Request No. 34

To the extent that Petitioner has not responded sufficiently to the requests and interrogatories outlined in this letter, Request No. 34 seeking documents relating to Petitioner's bona fide intent to use the ROUTE 66 mark cannot be duplicative. Petitioner cannot complain about answering a question the second time, when it did not answer the request the first time around.

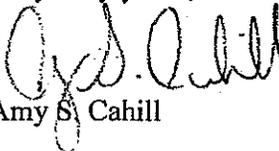
In the interest of clarity, we rephrase the request to seek "documents not otherwise produced, that disclose, describe, or otherwise relate to Petitioner's bona fide intent to use the ROUTE 66 designation in the United States."

Request No. 35

This request is similarly directed to Petitioner's intent to sell products in the United States under the ROUTE 66 mark. Obviously, the entities and sales channels through which Petitioner will sell products is relevant to the grounds Petitioner asserts for its petition, namely a likelihood of consumer confusion, and are generally discoverable in Board proceedings.

As the close of discovery is quickly approaching, we ask that you make the necessary supplementation and produce all responsive documents on or before **November 15, 2008**.

Very truly yours,


Amy S. Cahill

ASC:lms

cc: Brewster Taylor

December 11, 2008

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

Amy S. Cahill
(502) 681-0597
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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.

74189:1:ALEXANDRIA

Michael G. Kelber, Esq.
December 11, 2008
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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

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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.

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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.

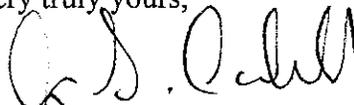
Michael G. Kelber, Esq.
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Meet and Confer and Discovery Depositions

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:lms

cc: Brewster Taylor, Esq.

EXHIBIT "F"

NEAL ■ GERBER ■ EISENBERG

Michael G. Kelber
Attorney at Law

Tel 312.269.5322
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mkelber@ngelaw.com

November 25, 2008

VIA FEDERAL EXPRESS - STANDARD

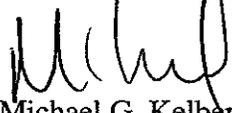
Amy S. Cahill
Stites & Harbison PLLC
400 West Market Street, Suite 1800
Louisville, KY 40202-3352

Re: *Top Tobacco L.P. v. Van Nelle Tobacco Netherland B.V.*
Cancellation No. 92048989

Dear Ms. Cahill:

Enclosed please find Top Tobacco's document production Top66 0001-0036 for the above-referenced proceeding.

Very truly yours,



Michael G. Kelber

MGK:adw
Enclosures

cc: Brewster Taylor (w/o enclosures)

NGEDOCs: 1584324.1