

TTAB

CERTIFICATE OF MAILING  
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: BOX TTAB — NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the date below:

03/29/04

Date

Valerie A. Kelso

Signature

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



GEORGIA-PACIFIC CORPORATION  
and FORT JAMES OPERATING  
COMPANY,

Opposers,

v.

SOLO CUP COMPANY,

Applicant.

04-02-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #78

Opposition No. 91157923

**Applicant's Motion to Extend Discovery Period by Six Months**

Pursuant to 37 C.F.R. § 2.120(a), TBMP § 403.04, and Fed. R. Civ. P. 6(b), Applicant, Solo Cup Company ("Applicant"), requests a six-month extension of the discovery period in the present Opposition proceeding. The previously scheduled date for the close of discovery is April 17, 2004. Applicant moves for extension of this date to October 17, 2004, for the reasons explained herein. Opposers have indicated they do not stipulate to the request for additional time, but have not yet informed Applicant whether they intend to oppose this Motion.

## THE BASIS OF APPLICANT'S REQUEST FOR ADDITIONAL TIME

### **I. The Board May Grant An Extension For Cause Shown**

The Board has broad discretion to enlarge the discovery period in an Opposition proceeding, based on a showing of cause for the extension when a motion is filed before the expiration of the original period. *See* Fed. R. Civ. P. 6(b); 37 C.F.R. § 2.120(a); TBMP § 403.04.

### **II. Applicant Has Ample Cause For Its Request To Extend Discovery Time**

In this case, there is ample cause for an extension of the discovery period. The primary reason for the needed extension of time is Opposer's delay in providing discovery requested by Applicant, and the need for additional time for additional party and third-party discovery. This is certainly not a situation in which Applicant has delayed initiating discovery. To the contrary, Applicant has been diligent in initiating discovery and negotiating objection issues.

#### **A. Discovery From Opposers Is Significantly Delayed**

Applicant served written discovery requests on Opposers, in the form of both document requests and Interrogatories, on November 11, 2003. After expiration of the response period, and a 45 day extension of time of the response date, Opposers served their unverified Responses on January 30, 2004 and their verified Responses on February 12, 2004. However, Opposers' Responses were in large part incomplete, and expressed the need for a comprehensive Protective Order to protect confidential information. No documents have yet been produced by Opposers.

Further, Opposers have not returned a signed copy of the proposed Protective Order sent by Applicant, nor have Opposers provided Applicant suggested revisions to that Protective Order.

After receiving Opposers' discovery responses, Applicant wrote a detailed letter (**EXHIBIT A**) explaining the deficiencies of Opposers' Responses, and raising objections to Opposers' refusal to produce certain responsive information and/or documents. Applicant's letter was followed by a lengthy telephone conference, and a response letter from Opposers (**EXHIBIT B**). The end result of this exchange is: (1) no documents have been produced by Opposers; (2) Applicant will certainly need to file a Motion to Compel discovery refused by Opposers; and, (3) Opposers have indicated that they will amend their discovery Responses, and likely file a Motion to Amend the Notice of Opposition. This delay of discovery itself serves as good cause for extending the discovery period (see TBMP Chapter 400, page 400-11 to 12).

#### **B. Additional Time Is Needed To Gather And Produce Discovery**

Applicant is in the process of preparing responses to recent discovery requests served by Opposers, and has requested additional time to complete this task<sup>1</sup>. Opposers have requested large amounts of information serving 75 Requests for Admission, 59 document requests, and 27 Interrogatories. Therefore, much of the now remaining discovery period is consumed by the time needed for Applicant to seek and produce discovery responsive to Opposers' requests. At the same time, Opposers will be using much of the remaining discovery period to provide information or documents thus far either withheld or unavailable for production to Applicant (as is outlined above). Even after these tasks are completed, however, additional time is needed to

---

<sup>1</sup> Opposer did not serve its initial discovery requests until February 13, 2004, several months after the filing of the Notice of Opposition and Applicant's Answer.

negotiate terms of the proposed Protective Order, and for presenting any disputed issues concerning the Protective Order to the Board.

Another time-consuming issue is for Applicant to investigate new avenues of responsive documents and information due to a corporate acquisition. Applicant has recently acquired the business entity of Sweetheart Cup Company, Inc., which was formerly a competitor with a lid product in the relevant hot-cup lid market. Indeed, Opposers have identified Sweetheart's hot-cup lid product as purportedly supporting Opposers' contention that Applicant's Mark is not distinctive. The very recent acquisition of Sweetheart by Applicant demands additional time for Applicant's attorneys to investigate the discovery available from Sweetheart, and to seek persons from Sweetheart with knowledge of facts and responsive documents and things.

Merely based on the amount of the discovery that is presently pending, there is a need for additional time for completing discovery. Even apart from the likely Motion(s) to Compel pending discovery, the amount of discovery presently pending will require much more time than that which remains in the schedule.

### **C. Additional Time Is Needed For Party And Third Party Discovery**

#### **1. The parties must complete "contention" and expert discovery**

The parties have not yet designated expert witnesses, nor have the parties even fully completed exchange of fact and "contention" discovery. Opposers have repeatedly objected to discovery requests as being "premature contention" requests, indicating that they are still developing their case, and will supplement with additional explanation of their contention at a later date.

Even after the contentions of Opposers are fully disclosed, expert discovery on those contentions may be necessary. In this case, such expert discovery would likely include information regarding consumer survey(s), and possibly testimony on technical issues relating to Opposers' contentions regarding alleged "functionality." Of course, responsive expert witness work will likely be necessary in response to disclosure of each party's expert testing and opinions, followed by expert witness depositions. Such expert discovery is conditioned on first receiving fact discovery, and Opposers' responses to the "premature contention" discovery requests. Therefore, there is a great need for additional time to complete this discovery, which will require at least six months.

## **2. Additional discovery from Opposers is necessary**

Based on Opposers' discovery responses delivered to date, additional discovery will be necessary. Some of this additional discovery will be obtained through further discovery requests being prepared by Applicant, and which would likely have been served earlier or not even made necessary, but for Opposers' delay in responding and their continued refusal to produce materials in response to Applicant's "meet and confer" efforts.

Other additional discovery is likely needed after resolution of Opposers' refusal to produce discovery already requested. For example, Opposers have refused to produce discovery relating to marketing information and consumer testing of plastic cup lids. And Opposers have refused to produce discovery regarding the cost of manufacture of hot-cup lids. These topics are at issue by Opposers' own contentions - - alleging a lack of distinctiveness, and alleging that Applicant's lid is less costly to make than comparable lids such as Opposers' lids. Nevertheless, Opposers' refusal to produce discovery will likely need to be resolved by a Motion to Compel.

After resolution of the Motion, additional follow-up discovery will likely be needed, including witness testimony on topics withheld by Opposers.

Further, Opposers have promised to provide a “privilege log” identifying documents and things withheld from production due to attorney-client privilege and/or work product immunity. Such a log, however, has not yet been provided, despite the extended dates for Opposers’ discovery responses. Once such a log of withheld materials is provided, additional discovery may be needed, and/or additional time will be needed to resolve any challenges to the selection of withheld materials.

**3. Third-party discovery is likely needed**

Third-party discovery is likely necessary in this case, and will need to be initiated in the near future, though the need for such discovery is best determined after Opposers produce document discovery and discloses the details of their contentions. Once Applicant has reviewed the documents to be produced by Opposers, Applicant expects that its review will lead to the identification of various fact witnesses for deposition.

Opposers have indicated that competing hot-cup lids in the market is evidence of an alleged lack of distinctiveness of Applicant’s Mark. This includes Opposers’ contention that the following parties have produced such competing lids: (1) Chinet; (2) Dupaco; (3) Insular; (4) International Paper; and, (5) Letica. Opposers have provided minimal discovery regarding these contentions, which presently appear to primarily consist of arguments of fact without much evidentiary support. One or both of the parties to this Opposition will likely take discovery from each of these third parties, to ascertain facts concerning each third parties’ competing lid product, and other market information relevant to Opposers’ contentions.

III. CONCLUSION

An extension of the discovery period is necessary to complete adequate discovery in this case. There is good cause for such an extension, which should expand discovery at least to October 17, 2004. In view of the foregoing, Applicant respectfully requests the Board to extend the discovery period in the present Opposition proceedings by six months, to end October 17, 2004.

Respectfully submitted,

SOLO CUP COMPANY

Dated: March 29, 2004

By: Bradley F. Rademaker

Linda A. Kucma, Esq.  
Bradley F. Rademaker, Esq.  
Gregory G. Schlenz, Esq.  
WALLENSTEIN, WAGNER & ROCKEY, ITD.  
311 South Wacker Dr., 53rd Floor  
Chicago, Illinois 60606-6604  
Telephone: (312) 554-3300  
Facsimile: (312) 554-3301

Attorneys for Applicant

A



February 19, 2004

**Wallenstein  
Wagner &  
Rockey**  
INTELLECTUAL PROPERTY LAW

311 South Wacker Drive, 53rd Floor  
Chicago, Illinois 60606-6630  
phone: 312-554-3300  
fax: 312-554-3301  
www.wwrfirm.com

**Linda A. Kuczma**  
**L.Kuczma@wwrfirm.com**

**VIA FACSIMILE**  
**CONFIRMATION BY MAIL**

Timothy M. Kenny, Esq.  
FULBRIGHT & JAWORSKI L.L.P  
80 South Eighth Street, Suite 2100  
Minneapolis, MN 55402-2112

**Re: Georgia-Pacific Corporation and Fort James  
Operating Company v. Solo Cup Company  
Opposition No.: 91157923  
Our File: 3177 T 476**

Dear Tim:

We have received your letter of January 30, 2004, along with Fort James' and Georgia-Pacific's Responses to Solo's First Set of Interrogatories and Responses to Solo's First Request for Production of Documents and Things. Due to the nature of the objections raised in the Responses, and the delay in obtaining discovery in this matter, the issues outlined below must be addressed. We request a phone conference in the next few days, to resolve these issues and schedule dates for production of discovery and/or amended discovery Responses.

**1. Production of Documents**

We previously agreed to extend the date for you to serve Opposer's Responses to the outstanding discovery requests, including responses to Applicant's Requests for Documents. On the original due date, we received Opposer's Objections. Now we have received Opposer's written Responses. However, we have yet to receive the documents that are to be produced. There appears to be no reason for such a long delay in having Opposer's responsive documents photocopied and produced to us. And, to the extent certain documents are to be produced after a

Timothy M. Kenny, Esq.

February 19, 2004

Page 2

Protective Order is signed, in the very near future we will send you a draft Protective Order for your review and comment, or to sign and return to us for filing.

**2. Privilege and Work Product Index**

Opposers have objected to several discovery requests on the basis of attorney-client privilege and/or work-product immunity. Please provide a suitable Index of such withheld materials, as required under the Rules. The Index should include at least the following information: the date(s) of the document; author(s); recipient(s); privilege or immunity claimed; and a summary of the nature of the document, including the type of document and the subject matter of the content.

**3. Request for "any and all" Documents**

Opposers objected to Document Requests Nos. 1-19 and 23, stating that these Requests are allegedly too broad and burdensome in seeking "any and all" documents relevant to the specified issue. This sort of objection was also identified in Opposers' General Objection No. 4, in which it indicates that "Opposer is conducting a diligent search for responsive documents." In order to resolve this issue, we request that you either withdraw the objection regarding requested "any and all" documents, or that you expressly acknowledge that all responsive documents uncovered from Opposers' diligent searches will be produced.

**4. "Plastic Cup Lids" v. "Hot Cup Lids"**

Opposers have objected to Requests referencing "plastic cup lids," such as in Opposers' General Objection No. 4 to Interrogatories, and its General Objection No. 2 to the Document Requests. Taking the position that the term "plastic cup lids" is over-inclusive, Opposer has unilaterally limited its responses to only "hot cup lids," excluding materials Opposers reference as "cold cup lids."

It is inappropriate for Opposer to unilaterally limit the scope of responsive discovery, especially since the discovery Requests closely tracked the very same language used in Opposers' Notice of Opposition in which Opposer repeatedly referenced the plastic cup lids of Opposer and others in the industry.

Opposers' objections must be withdrawn at once. Further, information related to cold cup lids may have a bearing on Opposers' allegations and arguments in this proceeding, including allegations regarding cost of manufacture and certain structural/functional allegations being made. Thus, please confirm in writing that all such objections and unilateral limitations of discovery are withdrawn, and that you thereafter supplement the Answers and Responses to provide all responsive information, without regard to whether the information relates to hot or cold cup lids.

## **5. Objection of Alleged "Premature" Document Requests**

Our letter of January 23, 2004, challenged Opposers' objections to Document Requests 4-18, in which Opposer alleges "premature contention document requests." Although Opposers appear to have deleted the word "contention" from each objection, they continue to assert the objections and allege the Requests are "premature." We renew our challenge to these objections, and must have resolution on this issue as we proceed in discovery. Simply put, these document Requests cannot be said to be "premature." In fact, these Requests relate to the very statements and factual assertions made by Opposers in the Notice of Opposition.

Also, aside from eventual expert discovery, where additional documents are likely to be created, the statement that a document request is "premature" is nonsensical. Either Opposers have responsive documents in their custody or control, or they do not. If Opposers believe that they will somehow procure additional responsive documents, they are free to supplement their Responses.

Therefore, we ask that you withdraw the objection of alleged "premature" Requests. In the alternative, confirm that the objection in no way limits or hinders prompt production of responsive documents and things in Opposers' custody or control.

## **6. Document Request 8**

Opposer has responded to Request 8 by stating that Opposer has no responsive documents. This Request calls for all documents supporting Opposer's allegation that Applicant's Mark results from a "comparatively simple and inexpensive method of manufacture."

First, it does not seem probable that Opposer has the ability to plead such an allegation, yet have no documents or things that support the allegation.

Secondly, by Opposer's own contentions, as expressed in its Interrogatory Answers, Opposer has opened the door to numerous responsive documents and things that must be produced. Opposer contends that "Applicant's design results from a comparatively simple and inexpensive method of manufacture." As explained in the answer to Interrogatory 12 (the Interrogatory regarding this contention), Opposer specifically relies on relative cost of the plastic, the "conventional" manufacturing equipment, the cost of manufacturing molds, and the relative pricing of the lid products. Further, Opposers' Interrogatory Answers clearly express that the relevant field of "comparative" products include "at least seven manufacturers other than Applicant -- Opposers, Chinnet, Dupaco, Insular, IP, Letica and Sweetheart" (Answers to Interrogatories 14, 16-19 and 23).

Therefore, according to Opposers' own arguments, at least the following materials in Opposers' custody and control are responsive: summaries of manufacturing costs for Opposers'

“hot cup” lids; Opposer lid cost projections, plastic lid equipment costs; plastic lid material costs; plastic lid pricing information; “hot cup lid” competitor information and cost/pricing studies; cost studies relating to Opposer’s selection of its “current domed hot cup lid” design; and, estimates or studies of manufacturing costs for proposed plastic lid designs not chosen for commercial production by Opposer. Please provide confirmation that Opposer will produce such responsive materials, and indicate when such production will take place.

**7. Interrogatory 12 Answer**

On a related matter, we request you to supplement Opposers’ Response to Interrogatory No. 12. Opposers have articulated some facts and circumstances which they contend indicates Applicant’s Mark results from a simple and inexpensive method of manufacture. However, Opposers have not fully articulated their contention concerning the *comparatively* simple or inexpensive manufacturing process. Opposers’ own cost figures and estimates for their own commercial (and proposed) “hot cup” lid designs are directly relevant to Opposers’ contention of *comparative* simplicity or inexpensiveness. Thus, Opposers’ response is incomplete and does not fully explain the comparison proffered.

**8. Document Request 9**

Opposer alleges to have no documents within their custody and control that are responsive to Document Request 9, which states: “Any and all documents and things supporting Opposer’s allegation in Paragraph 13 of the Notice of Opposition that Applicant’s Mark is not inherently distinctive.”

On the one hand, you allege this Request is premature, implying that a search for responsive materials is being made. On the other hand, you affirmatively state that no responsive documents are within Opposer’s custody and control. Since these two statements appear directly in conflict and create vast uncertainty in discovery, we request that you clarify your answer to advise whether responsive documents and things will be produced.

**9. Document Request 16**

Document Request 16 calls for “all documents and things supporting Opposer’s allegation in Paragraph 17 of the Notice of Opposition that Applicant’s Mark ‘designates a type of product (plastic cup lids) rather than identify the source of the particular product.’” Opposer asserts it has no documents responsive to Request 16 in its custody or control. We request that you immediately amend this response to Request No. 16, and produce responsive materials.

Since this Request relates to an affirmative allegation of Opposers as plead in the Notice of Opposition, it seems unlikely that they have absolutely no responsive documents. Either Opposers have no basis in fact for this allegation, or there are documents that Opposers are withholding from discovery.

Timothy M. Kenny, Esq.  
February 19, 2004  
Page 5

Further, Opposers' own Interrogatory Answers show that numerous documents and things in Opposers' custody that should be produced. Opposers answered Interrogatory No. 23 by explaining their contention as follows:

“Applicant’s hot cup lid is not distinctive of Applicant’s goods in that at least seven manufacturers other than Applicant – Opposers, Chinnet, Dupaco, Insular, IP, Leticia, and Sweetheart – have been selling similar hot cup lids in the marketplace in the United States.”

Therefore, documents relating to the alleged support for Opposers' contention, at the very least, include the following: competitor “hot cup lid” surveys and/or consumer studies; consumer testing/studies regarding preferences for hot cup lids; consumer correspondence and/or comments regarding Opposers' hot cup lids; any secondary meaning surveys for hot cup lid designs; and, any secondary meaning surveys or studies regarding product shape.

Please provide confirmation that Opposer will produce such responsive materials, and indicate when such production will take place.

#### **10. Document Requests 17 & 18**

Opposer alleges to have no documents within their custody and control that are responsive to Document Requests 17 and 18, which relate to Opposers' contentions of alleged damage, and allegation of “hindered competition.” However, as indicated by Opposers' Answer to Interrogatory 25, Opposers allege that they would be damaged (and competition would be hindered) by Applicant's registration “substantially limiting the lid configuration that [Opposers] may adopt.”

According to Opposers' own contentions, therefore, at least the following documents and things in Opposers' custody/control should be produced: documents/samples regarding any proposed plastic lid designs; documents relating to Opposers' strategic plans or proposals for changing its plastic lid design; customer surveys/studies relating to lid designs or preferences; engineering drawings of lid designs; engineering studies/tests regarding lid designs; and any competitor surveys and/or studies relating to plastic lids.

Please confirm that Opposers will produce all such responsive materials, and indicate when such production will take place.

#### **11. Document Request 19**

In response to Document Request 19, Opposers state objections, but do not indicate whether they have responsive documents and, if so, whether they will produce such documents. Please immediately supplement Opposers' Response to Request 19.

**12. Document Request 20 and 21**

Opposers object to Document Requests Nos. 20 and 21 on the basis of relevance, asserting that documents "related to 'marketing ... and/or confusion,'" are not relevant. Opposers then state that "Opposer will produce responsive, non-privileged documents relating to hot cup lids."

We strongly object to these Responses, to the extent Opposer intends to modify or limit its responses to the Requests, such as to exclude documents "related to 'marketing ... and/or confusion.'" Therefore, we must demand that you either withdraw the objection, or give written assurance that the objection in no way modifies or limits Opposers' production of responsive documents and things including all materials relating to surveys, testing or studies on "marketing and/or confusion".

Also, Opposers inappropriately limited their Responses to "hot cup lids." As expressed in Paragraph 4 above, please withdraw this objection and the resulting limitation to discovery, and confirm that all responsive materials relating to plastic cup lids will be produced.

**13. Document Requests 2 and 3**

Opposers objected to Document Requests Nos. 2 and 3 on the basis of relevance, and failed to indicate that responsive materials will be produced. In an effort to resolve any issues concerning these Requests, Applicant voluntarily proposes amendment of Requests 2 and 3 as follows, and asks that you immediately respond to the amended Requests and immediately produce all responsive documents:

**REQUEST NO. 2:**

Documents sufficient to identify each geographical area and channel of trade of distribution of plastic cup lids offered by Opposer, including all summaries, reports, sales presentations, and projections that identify or summarize the geographical areas and/or channels of trade.

**REQUEST NO. 3:**

Sufficient Documents to identify the types of customers with whom Opposer does or intends to do business, and the ultimate consumers to whom Opposer offers or intends to offer its plastic cup lids, including any and all summary reports or lists identifying such customers and ultimate consumers.

Timothy M. Kenny, Esq.  
February 19, 2004  
Page 7

#### **14. Interrogatory Objections**

##### **A. "Premature"**

Opposers continue their objections to Interrogatories Nos. 9-15, 17-24, and 26 as alleged "premature" interrogatories. We dispute the basis for this objection, and request that the objection be withdrawn, or that written confirmation be given that the Interrogatory answers are complete and will be promptly supplemented as additional facts become known.

##### **B. "Legal Conclusions"**

Although not previously raised as objections by Opposers, Opposers now seek to raise objections to Interrogatories 9, 11, 13-15, 19, 20, and 22-26 as allegedly "calling for a legal conclusion." On the contrary, these Interrogatories ask Opposers to provide the facts and circumstances in support of Opposers' allegations stated in the Notice of Opposition. Thus, Opposers' new objections are unfounded, and should be withdrawn. Further, any such objections have been waived by Opposers as untimely.

We look forward to resolving the issues set forth in this letter as soon as possible. In addition, we are still awaiting Opposers' responses to the points raised in our letter of January 23, 2004. We will plan to discuss those issues in the same conference call.

Very truly yours,



Linda A. Kuczma

B



# FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP  
2100 IDS CENTER  
80 SOUTH EIGHTH STREET  
MINNEAPOLIS, MINNESOTA 55402-2112  
WWW.FULBRIGHT.COM

TIMOTHY M. KENNY  
PARTNER  
TKENNY@FULBRIGHT.COM

DIRECT DIAL: (612) 321-2805  
TELEPHONE: (612) 321-2800  
FACSIMILE: (612) 321-9600

March 2, 2004

## VIA DIGITAL SENDER AND U.S. MAIL

Brad Rademaker, Esq.  
Wallenstein & Wagner, Ltd.  
311 South Wacker Drive  
53rd Floor  
Chicago, Illinois 60606-6630

Re: Georgia-Pacific Corporation and Fort James Operating Company v.  
Solo Cup Company  
Our Matter No.: GEPA:007 (10308254)

Dear Brad:

We write in response to Linda's letters of January 23, 2004 and February 19, 2004 and further to our telephone conversation with you and Greg on February 27, 2004. For the sake of clarity, we will respond to each paragraph of your February 19, 2004 letter under a similar heading. As we discussed, this letter covers all of the issues within both of Linda's previous letters, addresses our conversation regarding those issues, and identifies areas of potential or actual continued dispute.

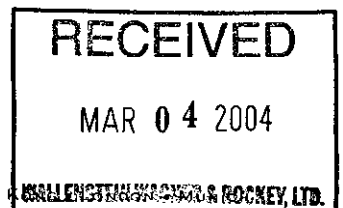
### 1. **Production of Documents**

Opposers have documents ready for production. Those documents will be produced once an appropriate protective order has been put in place. We are reviewing Solo's draft protective order and will provide comments shortly.

### 2. **Privilege and Work Product Index**

We will produce a privilege log. There is no dispute on this point. As we discussed, we have tentatively set the cut off date for inclusion of documents on the privilege log as the date this Opposition was filed (September 5, 2003).

25390713.1



**3. Request for “any and all” Documents**

As I indicated to you during our teleconference, Opposers are not withholding any documents based on this objection. Opposers have made a diligent search and will produce all we have been able to find (subject to other objections). If you feel it necessary, Opposers will amend their written responses to include this explanation.

**4. “Plastic Cup Lids” v. “Hot Cup Lids”**

As we discussed, Opposers are willing to amend the Notice of Opposition to refer to the more limited designation of “hot cup lids” vs. “plastic cup lids.” Please let us know if Solo stipulates to that amendment. With respect to the amendment, and the impact that will have on narrowing Solo’s discovery requests, you seemed amenable to this compromise. You indicated, however, that you thought there may be requests where information related to plastic cold cup lids is relevant. You indicated you would review the requests again and let us know which, if any, of the requests require information/documents on more than just hot cup lids. We will then revisit the issue of Opposers’ objection and corresponding limitations in its responses if necessary.

**5. Objection of Alleged “Premature” Document Requests**

Opposers withdraw this objection with the understanding that they reserve the right to supplement our productions if we later discover documents which are relevant to these requests.

**6. Document Request 8**

As we indicated in our teleconference, the only document we have that is responsive to this request is a copy of Solo’s own patent. The only documentary basis for Opposers’ claim that Solo’s lid is made through a comparatively simple and inexpensive method of production is statements made by Solo in Solo’s patent. Opposers’ view of the concept of comparative production is encompassed in general knowledge regarding the comparison of different methods of production, regardless of the party who produces the lid. Opposers’ documents related to their own costs of production are not relevant and not reasonably calculated to lead to the discovery of admissible evidence.

Methods – and general costs – of production are generally understood in the industry. Every participant understands how these different lids are made. We do not have any responsive documents related to our competitors’ costs, which obviously are dependent on numerous variables.

Brad Rademaker, Esq.  
Wallenstein & Wagner, Ltd.  
March 2, 2004  
Page 3

You indicated in our teleconference that you believe that Opposers' will eventually be forced to produce documents and provide interrogatory answers on this question. If you would like to provide some case law on this issue that supports Solo's view for our review, we will review it and discuss this issue further. Until then, we disagree with this assessment and continue to maintain our relevance objection.

Other than Solo's own patent, Opposers are not prepared to produce any documents relevant to this request. If additional responsive information or documents are identified by Opposers as this proceeding goes forward, Opposers will supplement their responses and production accordingly.

**7. Interrogatory 12 Answer**

Please see our response under numbered paragraph 6.

**8. Document Request 9**

Opposers do not currently have documents responsive to this request. Opposers are willing to withdraw their objection to this request with the express understanding that they reserve the right to supplement their production if additional documents and/or information are discovered.

**9. Document Request 16**

Opposers' allegation in paragraph 13 of the Notice of Opposition is a legal allegation. There are no documents currently in Opposers' custody and control which are responsive to this request.

You expressed Solo's suspicion that Opposers' have market studies or competitive testing reports which are responsive to this request. It is our understanding that Opposers do not have such responsive documents, but we will discuss that fact with our clients and provide you with a response in the near future.

**10. Document Requests 17 & 18**

This situation is the same as in numbered paragraph 9 above. We will discuss this issue with Opposers and provide you with a response in the near future.

**11. Document Request 19**

We do not agree that these documents are relevant. We disagree that Opposers' motivation for bringing this Opposition is relevant to the issues in this proceeding: functionality and distinctiveness.

**12. Document Requests 20 & 21**

Opposers objection to these requests was "to the extent" that the requests related to marketing and confusion. Opposers placed no limitation on time in their search for these documents. Anything we found that is relevant and not otherwise objectionable will be produced.

With respect to Opposers' objection to producing responsive "marketing" documents, we disagree that Opposers marketing surveys, testing or studies are relevant or reasonably calculated to lead to the discovery of admissible evidence. However, in light of the question you raised regarding the interplay of "marketing" and "secondary meaning" studies, we will review Opposers' documents and clarify whether Opposers have responsive documents or not to Applicant's request for "marketing" surveys, testing or studies, so we can re-visit that specific objection.

With respect to Opposers' objection to producing responsive "confusion" documents, rather than fight in the abstract over Opposers' objection to Applicant's written request, Opposers confirm they have no responsive "confusion" documents.

**13. Document Requests 2 & 3**

We agree that Solo is entitled to know to what extent Opposers were in the market, with Opposers' lids. Opposers therefore accept Applicant's proposed amended Request Nos. 2 and 3 set forth on page 6 of Linda's February 19 letter. Opposers are searching for representative documents that identify the geographic area, channels of trade and types of customers. Opposers' marketing plans, however, are not relevant.

We continue, however, to object to the term "all" in the amended requests, for the same reasons discussed previously. Opposers responses to the amended requests are also conditioned upon their right to supplement their responses if they discover any additional responsive documents.

**14. Interrogatory Objections**

**A. "Premature"**

Opposers continue to maintain this objection as it relates to the interrogatories. Opposers are not withholding any relevant documents or information based on this objection and will supplement their responses as more facts become known.

Brad Rademaker, Esq.  
Wallenstein & Wagner, Ltd.  
March 2, 2004  
Page 5

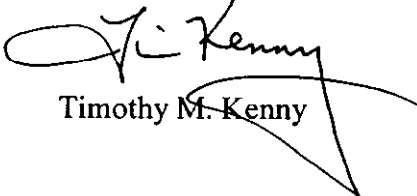
**B. "Legal Conclusions"**

Opposers' objection to any requests searching for legal conclusions is "to the extent" that the individual interrogatory seeks such information. Opposers are not withholding any of their contentions or facts based on this objection. In light of our discussion regarding Applicant's request and Opposers' objection, I do not believe we have any remaining disputes on this issue.

\* \* \* \* \*

It appears that the areas where we still have potential and real disputes are: "plastic cup lids v. hot cup lids," Opposers' Response to Document Request 8/Interrogatory No. 12, and Opposers' Response to Document Request No. 19. Other disputes *may* exist depending on our further response to you regarding: Opposers Response to Document Request Nos. 16, 17/18 and 20/21. Please let us know if our identification of these remaining issues is inconsistent with your view of them. We will proceed to investigate the action items we have identified and will contact you to discuss those issues in the near future. Please let me know if you would like to discuss anything in this letter in the meantime.

Very truly yours,

  
Timothy M. Kenny

TMK/jcd

Cc: Linda Kuczma, Esq. (via email)

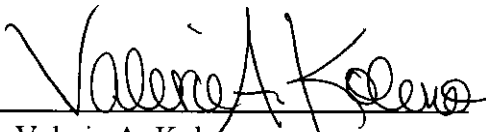
**Certificate of Service**

I HEREBY CERTIFY that a true and correct copy of Applicant's Motion to Extend Time for Applicant's Response to Discovery Requests has been served upon counsel for Georgia-Pacific Corporation and Fort James Operating Company, this 29th day of March, 2004, directed to counsel at the following address and in the below-stated manner:

William G. Barber, Esq.  
Timothy M. Kenny, Esq.  
Carrie L. Johnson, Esq.  
FULBRIGHT & JAWORSKI L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701-3248

**VIA FIRST CLASS MAIL  
(POSTAGE PRE-PAID)**

DATED: March 29, 2004

  
Valerie A. Koleno