

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

LABORATOIRES DR. N.G. PAYOT, S.A.

Opposer,

v.

ADEM COSMETIC COMPANIES, INC.,

Applicant.

Opposition No. 118,374

Attorney Docket No.  
010047-0004-999

**OPPOSER'S FIRST REQUEST TO APPLICANT  
FOR PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 34 of the Federal Rules of Civil Procedure, Opposer, Laboratoires Dr. N.G. Payot, S.A. ("Payot"), request that Applicant, Adem Cosmetic Corporation ("Adem"), produce for discovery and inspection at the offices of Pennie & Edmonds, 1155 Avenue of the Americas, New York, New York 10036, or such other location as shall be mutually agreed upon by counsel for the parties, the following documents and things within thirty (30) days of service hereof as provided in said Rules.

### Definitions and Instructions

1. As used herein, the term “person” as well as pronouns referring thereto shall include juristic persons as well as natural persons.

2. As used herein, the term “document” includes any tangible thing from or on which information can be stored, recorded, processed, transmitted, inscribed or memorialized in any way by any means regardless of technology or form.

3. “Applicant” means and shall refer to the Applicant herein, Adem, each of its predecessors, subsidiaries, directors, officers, employees, agents and attorneys and each person acting on their behalf or under their control.

4. “Opposer” means and shall refer to the Opposer herein, Payot, each of their predecessors, subsidiaries, directors, officers, employees, agents and attorneys and each person acting on their behalf or under their control.

5. Any word written in the singular shall be construed as plural or vice-versa when necessary to facilitate the answer to a discovery request.

6. As used herein, the connectives “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope.

7. As used herein, unless the context indicates otherwise, the term “the products in International Class 3” refers to the products in said class described in Applicant's U.S. Application Serial No. 75/527,525, i.e., “cosmetic products and color cosmetics, namely lipstick, foundations, blushes, eye shadow, mascaras, eyeliners, lipstick liners, nail polishes, nail care preparations, skin treatment products, namely cleansers, toners, moisturizers, eye creams, hand and body and facial

soap and fragrance products, namely, cologne, perfume, splashing water, scented soaps, body powders, bath oils, and sun screen preparations.”

8. Unless otherwise specified herein, the discovery requests are limited in scope to the United States.

9. Where a claim of privilege is asserted as to any documents requested herein, the nature of the privilege shall be identified and the following information shall be provided:

- (a) the type of document;
- (b) the general subject matter thereof;
- (c) the date thereof; and
- (d) the author(s), addressee(s) and recipient(s) of the document and the relationship(s) among them.

### **DOCUMENT REQUESTS**

1. A specimen of each product that has been sold, offered for sale or intended to be offered for sale by Applicant under the designation NUTRICIA, or in lieu thereof a photograph of each such product that shows the manner in which the designation NUTRICIA has been used on or in connection with the same.

2. Each document that refers or relates to the conception, adoption or selection by Applicant of the designation NUTRICIA, including without limitation, all documents showing each other proposed mark considered by Applicant and the reasons for rejection of the same in favor of NUTRICIA.

3. Each document that refers or relates to the first use and, if different, the first use in commerce by Applicant of the designation NUTRICIA for each of the products in International Class

3.

4. A sample of each container, label, nameplate, tag, or package insert that has been or is intended to be applied to or used for Applicant's products in International Class 3 bearing the designation NUTRICIA.

5. Each document that summarizes or from which may be determined Applicant's sales of each of the products in International Class 3 bearing the designation NUTRICIA from the date of first use thereof to the present.

6. Each document that summarizes or from which it may be determined Applicant's advertising or promotional expenditures for products bearing the designation NUTRICIA for each of the past five (5) years to the present.

7. Ten representative published advertisements that refer or relate to Applicant's products in International Class 3 bearing the designation NUTRICIA.

8. Ten representative items of promotional materials, such as catalogs, posters, brochures, flyers, sales sheets or price lists, that have been or are intended to be used to promote Applicant's products in International Class 3 bearing the designation NUTRICIA.

9. Any and all press releases or publicity for Applicant's products in International Class 3 bearing the designation NUTRICIA.

10. Any business or marketing plans prepared by or for Applicant referring or relating to the products in International Class 3 of Applicant bearing the designation NUTRICIA.

11. Any and all documents setting forth, referring or relating to any activities engaged in by Applicant or other events involving Applicant or other facts to which Applicant has referred in its answer, as demonstrating or constituting Applicant's interests in the designation NUTRICIA as emanating from any prior rights of Imperial Toiletries Ltd. as a trademark for the products in International Class 3.

12. Each document, that sets forth, refers or relates to any use by third parties of trademarks having or incorporating the element NUTRICIA.

13. Any and all documents, including without limitation opinions of counsel, that refer or relate to Opposer or their NUTRICIA trademark.

14. Any and all documents that set forth, refer or relate to any instances of actual confusion between Applicant or its mark NUTRICIA and Opposer or their NUTRICIA trademark.

PENNIE & EDMONDS LLP

Dated: New York, New York  
December 11, 2000

By:   
James W. Dabney, Esq.  
Jacqueline M. Lesser, Esq.  
1155 Avenue of the Americas  
New York, New York 10036  
(212) 790-9090

Attorneys for Opposer  
Laboratoires Dr. N.G. Payot, S.A.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Opposer's First Request To Applicant For Production Of Documents And Things has been served by mail upon Sharon Blinkoff, Esq., an attorney for Applicant, at Sweeney Lev & Blinkoff LLP, 708 Third Avenue, 14th Fl., New York, NY 10017-4901, that being the address designated by said attorney for that purpose, by depositing a true copy of same in a postpaid properly addressed envelope in an official depository under the exclusive care and custody of the United States Postal Service on December 11, 2000.

  
\_\_\_\_\_  
Jacqueline M. Lesser

TAB

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



04-02-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #26

LABORATOIRES DR. N.G. PAYOT, S.A.  
  
Opposer,  
  
v.  
  
ADEM COSMETIC COMPANIES, INC.  
  
Applicant

Opposition No.

Attorney Docket No.  
10047-004-999

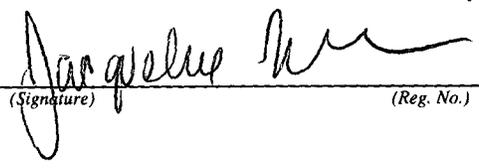
**NOTICE OF TAKING TESTIMONY DEPOSITION**

PLEASE TAKE NOTICE that pursuant to Rule 30(b) 6 of the Federal Rules of Civil Procedure, Opposer will take testimony by oral examination of Adem Cosmetic Companies, Inc., a party witness, by its designated representative(s) most knowledgeable of the subjects as designated on Schedule A attached hereto, commencing on April 9, 2003 at 10:00 a.m. at the law firm of Pennie & Edmonds LLP, 1155 Avenue of the Americas, New York, NY 10036. The testimony will be taken before an officer duly authorized to administer oaths under the laws of the United States.

CERTIFICATION UNDER 37 C.F.R. 1.10

I hereby certify that this paper is being deposited with the United States Postal Service as Express mail, label No. EL 477 836 555 US in the envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on Mar 31, 2003

Jacqueline M. Lesser  
(Name)

  
(Signature)

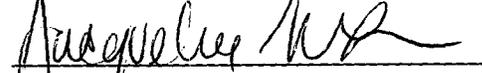
(Reg. No.)

March 31, 2003  
(Date of Signature)

Such testimony will be taken pursuant to and in accordance with the Trademark Rules of Practice and the Federal Rules of Civil Procedure. You are invited to attend to exercise your rights under the applicable rules.

Dated: March 31, 2003,

Respectfully submitted,



James W. Dabney

Jacqueline M. Lesser

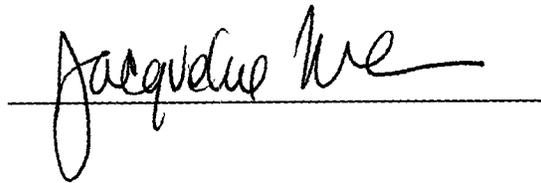
PENNIE & EDMONDS LLP  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090  
Attorneys for Opposer  
Laboratoires Dr. N.G. Payot, S.A.

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF  
TAKING TESTIMONY has been served upon:

By Fax and First Class Mail

Sharon Blinkoff, Esq.  
Buchanan & Ingersoll  
140 Broadway  
New York, NY 10005

A handwritten signature in cursive script, appearing to read "Jacqueline We", is written over a horizontal line.

Schedule A

1. Custody maintenance and control of all documents requested by Opposer First Set of Request for Production of Documents and Things, dated December 11, 2000, as attached hereto.