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

Proceeding	91215912
Party	Plaintiff Stepan Company
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Submission	Motion to Compel Discovery
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Date	06/16/2015
Attachments	Opposer's Motion to Compel v-2.pdf(154025 bytes) Exhibit A1.pdf(35346 bytes) Exhibit A2.pdf(37294 bytes) Exhibit B.pdf(92519 bytes) Exhibit C.pdf(1288129 bytes) Exhibit D.pdf(99108 bytes)

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

Stepan Company Opposer, v. Ishihara Sangyo Kaisha, Ltd. Applicant.	)	In the matter of Application Serial No.: 79140926 Mark: TEPPAN Opposition No.: 91215912

OPPOSER'S COMBINED MOTION TO COMPEL, MOTION FOR EXTENSION OF DISCOVERY AND TRIAL DATES, AND MOTION FOR SANCTIONS

Opposer Stepan Company ("Opposer") respectfully moves the Board for entry of an Order (1) compelling Applicant Ishihara Sangyo Kaisha, Ltd. ("Applicant") to serve its initial disclosures, participate in a Rule 201 Discovery Conference, and respond to Opposer's discovery requests served by Opposer on February 2, 2015, (2) suspending this matter until Applicant has provided full and complete written responses to Opposer's discovery requests (all objections having been waived), and (3) extending the discovery period to permit the taking of depositions and follow-up discovery.

DISCUSSION

On April 4, 2015, Opposer filed its Notice of Opposition (the "Notice") against the registration of the TEPPAN mark in Application Serial No. 79140926. In its Notice, Opposer asserts that there will be a likelihood of confusion between Applicant's TEPPAN mark and

Opposer's registered trademarks including STEPAN, Registration No. 2691918. Applicant answered the opposition on June 24, 2014.

On July 21, 2014, the parties moved to suspend these proceedings pending settlement negotiations. The parties requested a second extension on March 4, 2015.

On February 2, 2015, Opposer served its First Set of Interrogatories and First Request for Production of Documents and Things on Applicant. *See* Exhibit A. Opposer requested that Applicant provide its answers and produce the request documents and things with in thirty days, or by March 2, 2015. No answers or documents have been received. Further, Applicant has not yet served its initial disclosures in this matter.

On March 4, 2015, the parties requested a 90-day extension of the discovery deadlines to continue settlement discussions and provide Applicant a further opportunity to respond to the outstanding discovery requests and produce the requested documents. Discovery in this matter is set to close on June 19, 2015, and Applicant still has not served its initial disclosures, answers to Opposer's interrogatories, or produced the documents requested in Opposer's request for documents and things.

On May 12, 2015, counsel for Opposer emailed counsel for Applicant regarding potential settlement of this matter and Applicant's outstanding discovery. *See* Exhibit B. Counsel for Applicant responded and informed Opposer that he had retired and a new attorney had taken over the matter. *Id*.

Counsel for Opposer attempted on several occasions to contact Applicant's new counsel by telephone. Receiving no response, on June 3, 2015, counsel for Opposer sent a correspondence to Applicant's new counsel by email and courier requesting a Rule 201 discovery conference. *See* Exhibit C. Opposer's counsel sent a second correspondence to

Applicant's new counsel by email on June 9, 2015. Applicant's new counsel responded that he has "been instructed by our client's Japanese counsel to take no further action in this opposition." *See* Exhibit D.

MOTION TO COMPEL

Applicant has failed to serve its initial disclosures, respond to interrogatories, and produce any requested documents. Moreover, Applicant's counsel has made it clear that it has been instructed not to cooperate in discovery in this matter. As such, Opposer respectfully requests that the Board order Applicant to comply with Opposer's discovery requests under the Federal Rules of Civil Procedure and participate in discovery in this matter pursuant to TMEP 523.01 and 37 CFR § 2.120(e)(1). Specifically, Opposer seeks an order compelling Applicant to:

1. participate in a discovery conference;
2. provide its initial disclosures;
3. respond fully and completely, without objection, to Opposer's First Set of Interrogatories[1]; and
4. produce its documents in response to Opposer's First Set of Requests for Documents and Things.

Pursuant to 37 CFR § 2.120(e)(2), Opposer further requests that this matter be suspended pending the Board's resolution of this Motion to Compel.

[1] Pursuant to F.R.C.P. 33(b)(4), Applicant has waived all objections.

MOTION FOR EXTENSION OF DISCOVERY AND TRIAL DATES

Opposer further requests that the close of discovery and all subsequent trial dates be extended by ninety days so that Opposer may conduct discovery based on the information to be provided in Applicant's initial disclosures, interrogatory responses and documents, including depositions of Applicant's identified witnesses. Accordingly, Opposer proposes that the close of discovery and all subsequent trial dates be reset, as follows, or as appropriate following a suspension of this matter as requested in the Motion to Compel and Motion for Sanctions:

Discovery period to close:	September 19, 2015
Testimony period for party in position of plaintiff to close (opening 30 days prior thereto):	December 17, 2015
Testimony period for party in position of defendant to close (opening 30 days prior thereto):	February 16, 2016
Rebuttal testimony period to close (opening fifteen days prior thereto):	March 31, 2016

Briefs on final hearing shall become due as provided in Trademark Rule 2.128.

In light of the events occurring since the last extension of this matter, Opposer's proposal is made in good faith, and Opposer believes that good cause exists for extending the close of discovery and all subsequent trial dates, as above.

MOTION FOR SANCTIONS

As discussed above, despite the efforts of Opposer's counsel, Applicant's counsel has made it clear that it has been instructed by its client not to cooperate in discovery in this matter. As such, Applicant has refused to participate in a discovery conference and has failed to serve its initial disclosures, respond to interrogatories, or produce requested documents. Specifically,

Opposer requested a Rule 201 conference to discuss Applicant's failure to respond to discovery. *See* Exhibits B, C, and D. Applicant responded that it would undertake no action in this proceeding. *See* Exhibit D

Sanctions available under 37 CFR § 2.120(g) are appropriate when, as here, a party refuses to make its initial disclosures or respond to discovery and advises that no disclosure or responses will be made.

Pursuant to 37 CFR § 2.120(g)(2), Opposer is entitled to a sanctions ordering Applicant's response to interrogatories and requests for production of documents and things because Applicant (1) has failed to respond and (2) has informed Opposer that no response will be made. TBMP § 527.01(b). Opposer is also entitled to sanctions for Applicant's failure to provide initial disclosures because Applicant has expressly stated that it does not intend to meet its obligation. *Id.*

As sanctions for Applicant's refusal to participate in discovery in this matter, Opposer respectfully requests that the Board order the following:

1. Applicant must serve its initial disclosures;
2. Applicant respond fully and without objection to Opposer's First Set of Interrogatories;
3. Applicant must produce, without objection, its documents in response to Opposer's First Set of Requests for Documents and Things;
4. Applicant has forfeited its right to object to any discovery request on its merits, *See* TBMP § 527.01(c); and
5. The matter shall be stayed until Applicant has responded to Opposer's discovery requests.

Respectfully submitted,

Date: June 16, 2015

/ Ronald A. DiCerbo/

Thomas J. Wimbiscus
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500 West Madison Street
Suite 3400
Chicago, Illinois 60661
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Fax: (312) 775-8100

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on June 16, 2015, the foregoing OPPOSER'S COMBINED MOTION TO COMPEL, MOTION FOR EXTENSION OF DISCOVERY AND TRIAL DATES, AND MOTION FOR SANCTIONS was served on counsel of record for Applicant via first class and electronic mail to:

Frank Presta
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Arlington, VA 22203-1808
nixonptomail@nixonvan.com
fpp@nixonvan.com

Dated: June 16, 2015

/ Ronald A. DiCerbo/

Ronald A DiCerbo
Attorney for Opposer

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

Stepan Company Opposer, v. Ishihara Sangyo Kaisha, Ltd. Applicant.	)	In the matter of Application Serial No.: 79140926 Mark: TEPPAN Opposition No.: 91215912

OPPOSER'S FIRST SET OF INTERROGATORIES

Pursuant to Rules 26 and 33 of the Federal Rule of Civil Procedure and 37 C.F.R. § 2.120, Opposer, Stepan Company, hereby requests that Applicant, Ishihara Sangyo Kaisha, Ltd., answer the following interrogatories, under oath, within thirty (30) days of the date of service hereof.

INSTRUCTIONS AND DEFINITIONS

1. "Opposer" means the opposer, Stepan Company, and includes any of its agents, officers, employees, representatives, and any predecessors in interest, subsidiaries, controlled, controlling and affiliated companies, and their agents, officers, employees, representatives and attorneys.

2. "Applicant" means the applicant, Ishihara Sangyo Kaisha, Ltd., and includes any of its agents, officers, employees, representatives, and any predecessors in interest, subsidiaries,

controlled, controlling and affiliated companies, and their agents, officers, employees, representatives and attorneys.

3. The terms “document” or “documents” shall mean any and all documents and things as those terms are defined under and come within the scope of the Federal Rules of Civil Procedure, including but not limited to any papers or writings including drafts in Opposer’s possession, custody, or control, or of which the Opposer has knowledge, wherever located and however produced, whether original or copy, whether electronic or otherwise, including agreements, financial statements, invoices, statements, minutes, memoranda, notes, records, purchase orders, interoffice communications, correspondence, tapes or recordings, telegrams, telexes, facsimiles, cable grams, drawings, data, reports, printed matter, publications, photographs, advertisement brochures, catalogues, price lists, publicity releases, and the like. Any copy containing thereon or attached thereto, any alterations, notes, comments, or other material not included in the original, shall be deemed a separate document within the foregoing definition.

4. The terms “identify” or “state the identity” mean:

(a) in the case of a person, to state: (1) name, (2) current business or residence address, (3) all current employers or business affiliations, and (4) all current occupations or business positions held. The term person(s) includes a natural person, a company, firm, corporation, or association.

(b) in the case of a company, firm, corporation, or association, to state: (1) name, (2) business address, and (3) identity of person(s) having knowledge of the matter about which the company is named.

(c) in the case of a document, to state: (1) the author of the document, (2) its title, or a description of the general nature of its subject matter, (3) the identity of the recipient(s) of the original and copies (if any), (4) its dates of preparation, (5) its date and manner of distribution and publication (if any), (6) its present location and custodian, and (7) any privileges claimed, describing the specific basis therefore.

5. The term "person" is defined as any natural person, any company, firm, corporation, or any business, legal, or governmental entity or association.

6. The term "referring or relating" means relating to, referring to, describing, evidencing, concerning, involving, or constituting.

7. The terms "all" and "each" shall be construed as all and each.

8. The connectives "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.

9. The use of the singular form of any word includes the plural and vice-versa.

10. "Opposed Application" shall mean Applicant's application identified in this proceeding, and namely, U.S. Appl. Ser. No. 79140926, as filed with the U.S. Patent and Trademark Office ("USPTO").

11. The term "Lanham Act" means the Trademark Act of 1946 as amended.

12. The term "TEPPAN" means the mark TEPPAN, as identified in U.S. Appl. Ser. No. 79140926, as well as all similar variations thereof (e.g., abbreviations, different spellings with same or similar phonetics, without spaces, different capitalization, different punctuation).

13. "Opposer's Registrations" shall mean U.S. Trademark Registration Nos. 700332, 1330347, 1278476, 1593709, 553048, 1379902, 3095539, 1278478, 1625492, 2691918, and 1034168, as registered with the U.S. Patent and Trademark Office ("USPTO").

14. "Opposer's Trademarks" shall mean Opposer's trademarks identified in this proceeding including, but not limited to, the trademarks identified in Opposer's Registrations.

15. These interrogatories seek answers as of the date of the execution of same, but shall be deemed to be continuing so that any additional information relating in any way to these interrogatories which Applicant acquires, or which becomes known to Applicant up to and including the time of trial shall be furnished to Opposer reasonably promptly after such information is acquired or becomes known.

Interrogatory No. 1:

Identify and describe each and every product or service in connection with which the mark TEPPAN has been, is, is intended to be, and/or will be used in the U.S. Applicant's response should separately include, at a minimum, each of the products identified in the Opposed Application.

Interrogatory No. 2:

For each product or service requested to be identified by Interrogatory No. 1, describe the circumstances of Applicant's first use of the mark TEPPAN in connection with that particular product or service, including but not limited to the date and manner of such use, and identify the person (other than legal counsel) most knowledgeable concerning each use.

Interrogatory No. 3:

For each product or service requested to be identified by Interrogatory No. 1, describe the circumstances of Applicant's last use of the mark TEPPAN in connection with that particular product or service, including but not limited to the date and manner of such use, and identify the person (other than legal counsel) most knowledgeable concerning each use.

Interrogatory No. 4:

For each product or service requested to be identified by Interrogatory No. 1, identify and describe the channels of distribution and/or trade and the intended channels of distribution and/or trade through which the mark TEPPAN has been used from its inception to date, the date on which the mark TEPPAN was first used in each channel of distribution and/or trade, and the date on which the mark TEPPAN was last used in each channel of distribution and/or trade.

Interrogatory No. 5:

For each product or service requested to be identified by Interrogatory No. 1, identify each geographic location where the mark TEPPAN has been used in connection with that particular product or service, identify the dates when the mark TEPPAN was used in connection with that particular product or service in each location, and describe the manner in which the mark TEPPAN was used in connection with that particular product or service in each location.

Interrogatory No. 6:

For each product or service requested to be identified by Interrogatory No. 1, state Applicant's annual sales in the United States, in units and in dollars.

Interrogatory No. 7:

Identify and describe (1) the forms and media through which the mark TEPPAN has been advertised, promoted or marketed, and the dates the mark TEPPAN was advertised, promoted or marketed; (2) for each form or media, the geographical regions in which the mark TEPPAN was advertised, promoted or marketed; (3) the customer base, including location, that Applicant targeted with such advertisement, promotion or marketing; (4) the dollar amounts expended by or on behalf of Applicant on the advertisement, promotion or marketing of the mark TEPPAN; and (5) the person (other than legal counsel) most knowledgeable about the advertisement, promotion and marketing of the mark TEPPAN.

Interrogatory No. 8:

For the Opposed Application, state all information on which Applicant bases its belief that Applicant's use in the United States of the mark identified therein is not likely to cause confusion, to cause mistake, and/or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer and identify the person (other than legal counsel) most knowledgeable about the same.

Interrogatory No. 9:

Identify and describe all instances of actual confusion of which Applicant is aware involving the mark TEPPAN and Opposer's Trademarks, including but not limited to, the person(s) involved in such instance of confusion, the nature of such instance of confusion, and the date(s) of such instance of confusion.

Interrogatory No. 10:

Identify and describe any efforts by Applicant to obtain trademark protection, in either the United States or abroad, for the mark TEPPAN.

Interrogatory No. 11:

Identify and describe the terms of any assignment, license, or other transfer of rights relating in any way to the mark TEPPAN.

Interrogatory No. 12:

Identify and describe any efforts by or against Applicant to enforce any alleged rights in the mark TEPPAN, including sending/receiving any cease and desist letter or the initiation of any lawsuit, opposition or other adversarial proceeding.

Interrogatory No. 13:

Identify and describe the circumstances by which Applicant first learned of Opposer's use in commerce of any of Opposer's Trademarks.

Interrogatory No. 14:

Identify and describe the circumstances by which Applicant first learned of Opposer's registration of the mark STEPAN, including but not limited to any of the marks Identified in U.S. Reg. Nos. 700332, 1330347, 1278476, 1593709, 553048, 1379902, 3095539, 1278478, 1625492, 2691918, and 1034168, as registered with the USPTO, including the exact date and manner Applicant learned of Opposer's use, application, or registration and identify the person (other than legal counsel) most knowledgeable about the same.

Interrogatory No. 15:

Identify and describe any and all trademark searches and/or watches conducted by Applicant, or on Applicant's behalf, referring or relating to the mark TEPPAN.

Interrogatory No. 16:

Identify each person who participated in the preparation of Applicant's responses to the foregoing interrogatories, and for each person, specify the interrogatory or interrogatories for which each such person provided information or participated in the response hereto.

Interrogatory No. 17:

Identify the witnesses Applicant intends to call to testify on its behalf in connection with this proceeding, and state the facts or subject matter concerning which they are each expected to testify.

Interrogatory No. 18:

State all information on which Applicant bases its belief that Opposer's Notice fails to state a claim upon which relief may be granted, as asserted in Applicant's First Affirmative Defense.

Interrogatory No. 19:

State all information on which Applicant bases its belief that Applicant has priority over Opposer "with respect to the products identified in the application that is the subject of this Opposition" as asserted in Applicant's Tenth Affirmative Defense.

Respectfully submitted,

Date: February 2, 2015

/ *Ronald A. DiCerbo*/

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on February 2, 2015, the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES was served on counsel of record for Applicant via first class and electronic mail to:

Robert W Adams
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901 North Glebe Road
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rwa@nixonvan.com
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Dated: February 2, 2015

/ Ronald A. DiCerbo/

Ronald A DiCerbo
Attorney for Opposer

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

Stepan Company Opposer, v. Ishihara Sangyo Kaisha, Ltd. Applicant.	)	In the matter of Application Serial No.: 79140926 Mark: TEPPAN Opposition No.: 91215912

OPPOSER'S FIRST REQUEST FOR
PRODUCTION OF DOCUMENTS AND THINGS

Pursuant to Rules 26 and 34 of the Federal Rule of Civil Procedure and 37 C.F.R. § 2.120, Opposer, Stepan Company, hereby requests that Applicant, Ishihara Sangyo Kaisha, Ltd., produce for inspection and copying by the Opposer the following documents and tangible things at the law offices of McAndrews, Held & Malloy, Ltd., Citicorp Center, 34th Floor, 500 West Madison Street, Chicago, Illinois 60661, within thirty (30) days from the date of service thereof, or at any such other place and time as may be agreed to by counsel for the parties.

INSTRUCTIONS AND DEFINITIONS

1. The instructions and definitions set forth in "Opposer's First Set of Interrogatories" are incorporated herein by reference.

2. If any requested document cannot be produced in full, produce it to the extent possible, and state the reason(s) for Applicant's inability to produce the remainder.

3. Any document that is not produced by reason of a claim of privilege or otherwise, shall be identified in writing by: (a) date; (b) author(s); (c) recipient(s); (d) subject matter; (e) identity of the persons to whom the contents of the document have been revealed; (f) identity of the person or entity now in possession or control of the document; and (g) the basis upon which the document is being withheld.

4. Each document shall be identified separately by the request number pursuant to which it is being produced.

5. A written response to this request is required pursuant to Rule 34 of the Federal Rules of Civil Procedure.

6. Applicant is reminded of its obligation for timely supplementation pursuant to Rule 26(e) of the Federal Rules of Civil Procedure.

REQUESTS FOR PRODUCTION

Request for Production No. 1:

Produce all documents requested to be identified in Opposer's First Set of Interrogatories to Applicant or which Applicant considered, reviewed, or relied upon in responding to Opposer's First Set of Interrogatories.

Request for Production No. 2:

Produce all documents relating to, referring to, or involving the Applicant's first use of the mark TEPPAN in commerce, including specimens showing how the mark was used in connection with the mark TEPPAN and documents sufficient to show the nature of the first use including the geographical location(s) and date on which such use occurred. For this request, please provide separate responses for each different product/service identified in Applicant's

Response to Interrogatory No. 1, including but not limited to each of the products identified in the Opposed Application.

Request for Production No. 3:

To the extent that the first use of the TEPPAN mark identified in connection with Request 2 above was not in interstate commerce, produce all documents relating to, referring to, or involving the Applicant's first use of the mark TEPPAN in interstate commerce, including specimens showing how the mark was used in connection with the mark TEPPAN and documents sufficient to show the nature of the first use including the geographical location(s) and date on which such use occurred. Again, for this request, please provide separate responses for each different product/service identified in Applicant's Response to Interrogatory No. 1, including but not limited to each of the products identified in the Opposed Application.

Request for Production No. 4:

For each different product/service identified in Applicant's Response to Interrogatory No. 1, produce representative specimens or documents sufficient to establish that the mark TEPPAN has been in continuous use in commerce and interstate commerce by Applicant, including the nature, date, and geographic location(s) of such use.

Request for Production No. 5:

Produce representative samples of all marketing, advertising, catalogues, publications, flyers, mailers and/or product literature, labeling, and packaging referring or relating to any product or service on which or for the mark TEPPAN has been, is, is intended to be, and/or will be used in the United States.

Request for Production No. 6:

Produce summary documents sufficient to show the volume and geographical location of all recipients of Applicant's marketing materials, advertisements, and catalogues.

Request for Production No. 7:

Produce all documents relating to, referring to, or involving the nature of and/or similarity or dissimilarity between the goods or services in connection with which Applicant uses the mark TEPPAN, and the goods and services listed in Opposer's Registrations.

Request for Production No. 8:

Produce all documents relating to, referring to, or showing the channels of distribution and/or trade in which Applicant's goods are (and/or are intended to be) sold, offered for sale, or distributed.

Request for Production No. 9:

Produce all documents relating to, referring to, or involving any actual instance of Applicant's goods or services and the goods and services listed in Opposer's Registrations occupying the same or similar channels of trade.

Request for Production No. 10:

Produce all documents relating to, referring to, or involving demographics and/or sophistication of purchasers of Applicant's goods or services in connection with which the mark TEPPAN is used.

Request for Production No. 11:

Produce all documents supporting or contradicting Applicant's belief that Applicant's use in the United States of the marks listed in the Opposed Applications in connection with the products and services identified therein is not likely to cause confusion, to cause mistake, and/or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer.

Request for Production No. 12:

Produce all documents that refer to, relate to, or comment upon any instance or incident of actual or potential confusion between Applicant's use of the mark TEPPAN and Opposer's Trademarks.

Request for Production No. 13:

Produce all documents supporting or contradicting Opposer's belief that Opposer will be damaged by the registration of the Opposed Application.

Request for Production No. 14:

Produce summary documents sufficient to show the gross dollar value of Applicant's annual sales and volume of sales of goods or services sold or rendered in connection with the mark TEPPAN.

Request for Production No. 15:

Produce summary documents sufficient to show the dollar value of Applicant's advertising or promotion of goods or services sold or rendered in connection with the mark TEPPAN including on an annual and/or quarterly basis where available.

Request for Production No. 16:

Produce all documents that refer to, relate to, or comment upon any surveys, polls, and/or consumer testing, whether formal or informal, that Applicant has commenced, completed, commissioned, has access to, and/or may rely upon regarding the mark TEPPAN.

Request for Production No. 17:

Produce all documents that refer to, relate to, or comment upon any efforts by Applicant to obtain trademark protection, in either the United States or abroad, for the mark TEPPAN.

Request for Production No. 18:

Produce all documents within Applicant's possession relating to, referring to, stating, involving, evidencing, and/or identifying Applicant or Applicant's use, application or registration of the mark TEPPAN.

Request for Production No. 19:

Produce all documents relating to, referring to, stating, involving, evidencing, and/or identifying the date when Applicant first learned of Opposer's use, application, or registration of the mark STEPAN.

Request for Production No. 20:

Produce all documents constituting, relating to, reporting on, requesting, referring to, involving, identifying, memorializing, concerning and/or stating any evaluation, search, watch, study, and/or investigation of the mark TEPPAN.

Request for Production No. 21:

Produce all documents relating to, referring to, or involving the extent to which parties other than Applicant have used and/or may use the mark TEPPAN.

Request for Production No. 22:

Produce all agreements, policies or procedures within Applicant, or between Applicant and any other person(s), including, but not limited to, any of Applicant's subsidiaries, distributors, or retailers, which relate to, refer to, or involve the use of the mark TEPPAN or any variants thereof, including all amendments or modifications to any such agreements, policies or procedures.

Request for Production No. 23:

Produce all documents relating or referring to every objection, opposition, cancellation, infringement proceedings, or protests of any kind including oral or written contacts to others, made by or against Applicant regarding the mark TEPPAN, including, without limitation, all documents showing the status, disposition, or outcome of such objections, oppositions, cancellations, infringement proceedings, or protests.

Request for Production No. 24:

Produce all documents supporting or contradicting Opposer's First Affirmative Defense that Opposer's Notice fails to state a claim upon which relief may be granted.

Request for Production No. 25:

Produce all documents supporting or contradicting Opposer's Second Affirmative Defense that the TEPPAN mark is so different in terms of appearance, sound, and meaning that there is no reasonable likelihood of confusion.

Request for Production No. 26:

Produce all documents supporting or contradicting Opposer's Third Affirmative Defense that the parties' products are different and unrelated and that there is no reasonable likelihood of confusion.

Request for Production No. 27:

Produce all documents supporting or contradicting Opposer's Fourth Affirmative Defense that the parties' products travel through different channels of trade and that there is no reasonable likelihood of confusion.

Request for Production No. 28:

Produce all documents supporting or contradicting Opposer's Fifth Affirmative Defense that the parties' products are sold to and used by different classes of consumers and that there is no reasonable likelihood of confusion.

Request for Production No. 29:

Produce all documents supporting or contradicting Opposer's Sixth Affirmative Defense that the parties' products are sold under conditions of great care and that there is no reasonable likelihood of confusion.

Request for Production No. 30:

Produce all documents supporting or contradicting Opposer's Seventh Affirmative Defense that the parties' products are sold to and used by highly sophisticated customers and that there is no reasonable likelihood of confusion.

Request for Production No. 31:

Produce all documents supporting or contradicting Opposer's Eighth Affirmative Defense that the parties' products have a relatively high price so as to enhance greater care when purchasing and that there is no reasonable likelihood of confusion.

Request for Production No. 32:

Produce all documents supporting or contradicting Opposer's Ninth Affirmative Defense that the parties' products are toxic or otherwise dangerous so that they are handled and used under greater conditions of care and that there is no reasonable likelihood of confusion.

Request for Production No. 33:

Produce all documents supporting or contradicting Opposer's Tenth Affirmative Defense that Applicant has priority over Opposer "with respect to the products identified in the application that is the subject of this Opposition" and that there is no reasonable likelihood of confusion.

Respectfully submitted,

Date: February 2, 2015

/ *Ronald A. DiCerbo*/

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on February 2, 2015, the foregoing OPPOSER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS was served on counsel of record for Applicant via first class and electronic mail to:

Robert W Adams
Nixon & Vanderhye PC
901 North Glebe Road
11th Floor
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nixonptomail@nixonvan.com
rwa@nixonvan.com
fbe@nixonvan.com

Dated: February 2, 2015

/ Ronald A. DiCerbo/

Ronald A DiCerbo
Attorney for Opposer

From:	rwa@nixonvan.com
To:	Ron Dicerbo
Cc:	fpp@nixonvan.com; rwa@nixonvan.com
Subject:	RE: Stepan Company v. Ishihara Sangyo Kaisha, Ltd. (Opposition No. 9121912)
Date:	Tuesday, May 12, 2015 4:38:03 PM

Hi Ron:

I recently retired and Frank Presta has taken over this matter. I do not know whether he will be in the office tomorrow. However, I am copying him on this email. Best regards.

Bob Adams

From: Ron Dicerbo [mailto:RDICERBO@mcandrews-ip.com]
Sent: Tuesday, May 12, 2015 5:24 PM
To: Bob Adams
Subject: Stepan Company v. Ishihara Sangyo Kaisha, Ltd. (Opposition No. 9121912)

Hello Bob,

I have Stepan coming into my office tomorrow afternoon. Will you have time tomorrow morning to discuss if there is a potential middle ground for the parties to explore and discovery in this matter?

Best regards,
Ron

Ronald A DiCerbo
McANDREWS HELD & MALLOY LTD.
500 WEST MADISON STREET, 34th FLOOR
CHICAGO ILLINOIS 60661
(T) 312 775 8000
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http://www.mcandrews-ip.com

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Claudette Doss

From: Claudette Doss
Sent: Wednesday, June 03, 2015 4:19 PM
To: 'fpp@nixonvan.com'
Cc: Ron Dicerbo; Tom Wimbiscus; Alex Menchaca
Subject: Stepan v. Ishihara Sangyo Kaisha, Opp. No. 91215912
Attachments: Letter to Frank P. Presta {6-3-15}.pdf

Dear Mr. Presta:

Please see the attached correspondence from Mr. DiCerbo. Should you have any questions or comments, please do not hesitate to contact us.

Sincerely,
Claudette Doss
Legal Secretary

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June 3, 2015

Via E-mail
Confirmation via Federal Express
fpp@nixonvan.com

Mr. Frank P. Presta
Nixon & Vanderhye PC
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808

Re: Stepan v. Ishihara Sangyo Kaisha; Opp. No. 91215912

Dear Mr. Presta,

I understand from Bob Adams that he has retired and you have assumed control of the above referenced opposition. If this is not correct, please let me know.

We have not yet received your client's Rule 26 Initial Disclosures. Nor have we received responses to Stepan's First Request for Production of Documents and Things and First Set of Interrogatories, which were served in February. In this regard, please let me know if you are available June 4 or 5, 2015, for a Rule 201 discovery conference.

In light of the upcoming discovery deadline of June 19, 2015, I suggest that the parties move for another 90 day extension of time. Please let me know if you consent to the extension.

Pursuant to Rule 26, we provide the following information:

1. **Witnesses**. The name, address, and telephone number of each individual likely to have discoverable information that may support my claims, and the information they possess (unless they will be used solely for impeachment).

   Initial Disclosure: Ellen W. Novak, Product Manager – Amphoterics, is the individual most likely to have information regarding the use of Stepan's trademark. Ms. Novak is located at Stepan's corporate headquarters, 22 West Frontage Rd., Northfield, IL 60093, Phone: 847-446-7500.

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2. **Documents and things**. Copies, or descriptions by category and location, of all documents or things I have in my possession or control that I may use to support my claims (unless they will be used solely for impeachment).

   Initial Disclosure: It is anticipated that all discoverable documents and things relating to this matter will be located at Stepan's corporate headquarters, 22 West Frontage Rd., Northfield, IL 60093.

3. **Damages computation**. A calculation of any category of damages I have suffered.

   Initial Disclosure: Not Applicable.

4. **Liability insurance**. Any insurance agreement under which an insurance business may be liable to satisfy all or part of a possible judgment in the action or to indemnify or reimburse for payments made to satisfy the judgment.

   Initial Disclosure: Not Applicable.

I look forward to hearing from you.

Best Regards,

Ronald A. DiCerbo
Attorney for Stepan Company

From: (312) 775-8237 Origin ID: CHIA
Ronald A. DiCerbo
McAndrews Held & Malloy, LTD.
500 West Madison Street
34th Floor
Chicago, IL 60661

FedEx. Express

J151215022303uv

Ship Date: 03JUN15
ActWgt: 0.5 LB
CAD: 102168899/INET3610

Delivery Address Bar Code

SHIP TO: (703) 816-4000 BILL SENDER
Frank P. Presta
Nixon & Vanderhye PC
901 North Glebe Road, 11th Floor
Suite 1100
ARLINGTON, VA 22203

Ref # 01895-51752US01
Invoice #
PO #
Dept #

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From: fpp@nixonvan.com
To: Ron Dicerbo
Cc: Tom Wimbiscus; Alex Menchaca
Subject: RE: Stepan v. Ishihara Sangyo Kaisha, Opp. No. 91215912
Date: Wednesday, June 10, 2015 9:33:38 AM

Dear Ron:

I am now representing Ishihara Sangyo Kaisha in the above opposition.

We have been instructed by our client's Japanese counsel to take no further action in this opposition.

Best regards,

Frank

From: Ron Dicerbo [mailto:RDICERBO@mcandrews-ip.com]
Sent: Tuesday, June 09, 2015 10:50 AM
To: Frank Presta
Cc: Tom Wimbiscus; Alex Menchaca
Subject: FW: Stepan v. Ishihara Sangyo Kaisha, Opp. No. 91215912

Mr. Presta,

Please confirm that you are now representing Ishihara Sangyo Kaisha in the above opposition. If not, please provide the name of the attorney that is.

If you are handling the opposition, please let me know your availability for a Rule 201 conference.

Best regards,
Ron

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From: Claudette Doss
Sent: Wednesday, June 03, 2015 4:19 PM
To: 'fpp@nixonvan.com'
Cc: Ron Dicerbo; Tom Wimbiscus; Alex Menchaca
Subject: Stepan v. Ishihara Sangyo Kaisha, Opp. No. 91215912

Dear Mr. Presta:

Please see the attached correspondence from Mr. DiCerbo. Should you have any questions or comments, please do not hesitate to contact us.

Sincerely,
Claudette Doss
Legal Secretary

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