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

ELON UNIVERSITY,

Opposer,

v.

KABUSHIKI KAISHA PHENIX,

Applicant.

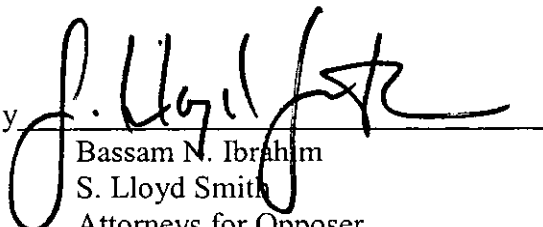
Opposition No. 91159927

MOTION TO COMPEL

Pursuant to 37 C.F.R. § 2.120, Opposer hereby moves to compel responses to Opposer's First Set of Interrogatories to Applicant (Exhibit A) and First Set of Document Requests to Applicant (Exhibit B). These discovery requests were served on Applicant May 26, 2004. Applicant has not responded. Accordingly, Opposer moves to compel responses to these discovery requests.

Opposer has attempted to contact opposing counsel concerning this motion and currently has had no response.

ELON UNIVERSITY

By 
Bassam N. Ibrahim
S. Lloyd Smith
Attorneys for Opposer

Date: October 12, 2004

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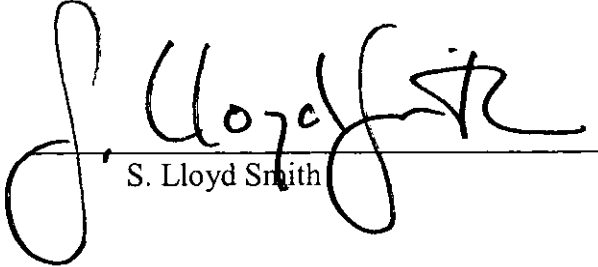
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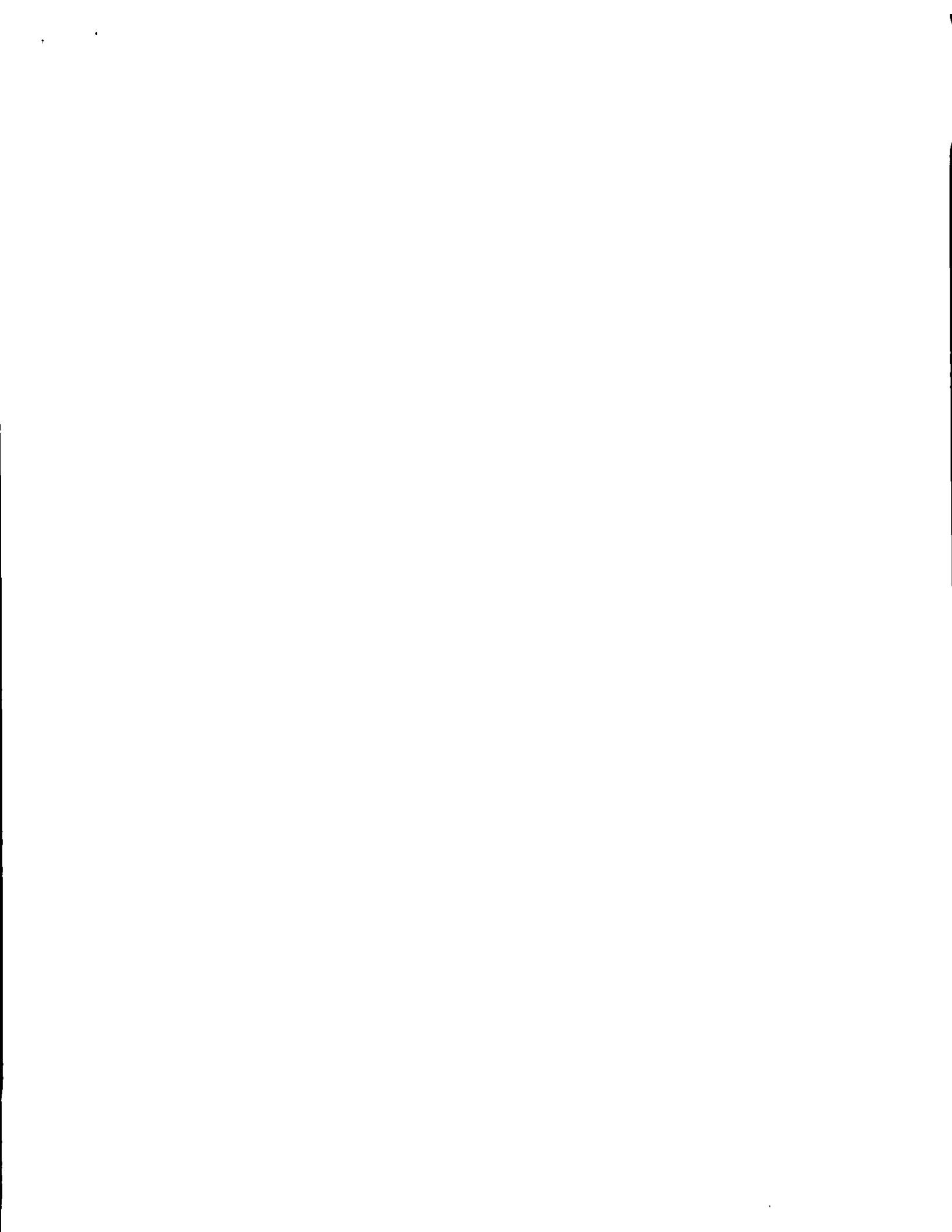
U.S. Patent & TMO/TM Mail Rcpt Dt. #72

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S MOTION TO COMPEL
was served this 12th day of October, 2004 by first-class mail, postage prepaid, on:

William J. Spatz, Esq.
Theodore Mlynar, Esq.
KRAMER LEVIN NAFTALIS & FRANKEL LLP
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New York, NY 10022


S. Lloyd Smith



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ELON UNIVERSITY,

Opposer,

v.

KABUSHIKI KAISHA PHENIX,

Applicant.

Opposition No. 91159927

OPPOSER’S FIRST SET OF INTERROGATORIES TO APPLICANT

Opposer, Elon University, in accordance with Rule 33 and other applicable rules of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, requests that the above-named Applicant respond to Opposer’s First Set of Interrogatories (“Interrogatories”) as set forth below. These Interrogatories shall be deemed continuing in nature pursuant to Rule 26(e)(2) of the Federal Rules of Civil Procedure.

DEFINITIONS AND INSTRUCTIONS

All Interrogatories shall be answered in a format such that it is clear as to which Interrogatory each answer pertains. All requests pertain solely to activities in the United States.

As used herein and in any subsequent Interrogatories, the following definitions apply:

1. Communication. The term “communication” means the transmittal of information (in the form of facts, ideas, inquiries or otherwise).
2. Document. The term “document” means every writing or record of any type and description that is or has been in the possession, control or custody of Opposer, of which Opposer has knowledge, including without limitation correspondence, memoranda, tapes, stenographic or handwritten notes, studies, publications, books, pamphlets, pictures, films, voice

recordings, maps, reports, surveys, minutes, statistical compilations, trademark appraisals, trademark registrability or availability searches or reports, trademark infringement reports, opinions of counsel, and any other information-containing paper, writing or physical thing; every copy of such writing or record where the original is not in the possession, custody, or control of Opposer; and every copy of every such writing or record where such copy is not an identical copy of an original or where such copy contains any commentary or notations whatsoever that do not appear on the original. Additionally, the term "document" shall include any document considered privileged by Opposer.

3. Identify (With Respect to Persons). When referring to a person, to "identify" means to give, to the extent known, the person's full name, present or last known address, and when referring to a natural person, additionally, the present or last known place of employment. Once a person has been identified in accordance with this subparagraph, only the name of that person need be listed in response to subsequent discovery requesting the identification of that person.

4. Identify (With Respect to Documents). When referring to documents, to "identify" means to give, to the extent known, (a) the type of document; (b) its general subject matter; (c) the date of the document; (d) the author(s), addressee(s) and recipient(s); and (e) the present location or custodian of the document.

5. Parties. The terms "Applicant and "Phenix" shall mean the Applicant, and where applicable, its officers, directors, employees, partners, corporate parent, subsidiaries of affiliates.

6. Person. The term "person" is defined as any natural person or any business, legal or governmental entity or association.

7. Concerning. The term "concerning" means relating to, referring to, describing, evidencing or constituting, and vice versa.

8. All/Each. The terms “all and “each” shall be construed as all and each.
9. And/Or. 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.
10. Number. The use of the singular form of any word includes the plural and vice versa.
11. Date. The term “date” means the exact day, month and year if ascertainable or, if not, the best approximation thereof (including chronological relationship to other events).
12. Applicant’s Mark. The term “Applicant’s Mark” shall mean the mark identified in U.S. Trademark Application Serial No. 76/485,30
13. Applicant’s Goods. The term “Applicant’s Goods” shall mean the goods identified in the U.S. Trademark Application Serial No. 76/485,30
14. Opposer’s Marks. The term “Opposer’s Marks” means those marks designated by Opposer in numbered paragraphs 3-5 in the Notice of Opposition as well as any other marks upon which Opposer intends to rely on in the subject opposition proceeding.
15. Opposer’s Goods/Services. The term “Opposer’s Goods/Services” refers to those goods and/or services identified with Opposer’s Marks in numbered paragraphs 3-5 in the Notice of Opposition.

INTERROGATORY NO. 1:

Identify all products and services, if any, on or in connection with which Applicant’s Mark has been used by Applicant in commerce.

INTERROGATORY NO. 2:

For each good or service identified in response to Interrogatory No. 1, please state:

- (a) A description thereof;

- (b) the number of units sold each year since the product or service was first sold;
- (c) the dollar amount of sales by product for each year since the product or service was first sold;
- (d) the geographic scope of sales for each product or service;
- (e) identify the channels of trade through which the product or service has been sold;
- (f) identify the distribution outlets through which the product or service was sold;
- (g) the date on which each product or service was first sold.

INTERROGATORY NO. 3:

State whether Applicant has ever advertised or promoted goods or services bearing Applicant's Mark or intends to do so, and if so, provide a breakdown including:

- (a) the form of media promotion or advertisement and its identity;
- (b) the inclusive dates and areas of promotion or advertisement;
- (c) the total annual advertising, marketing and promotional expenditures; and
- (d) the name and address of each and every advertising agency used at any time by

Applicant which did any work with regard to the Applicant's Mark.

INTERROGATORY NO. 4:

Identify all agreements relating to the Applicant's Mark, including, without limitation, agreements relating to distribution or licensing of goods or services under the Mark.

INTERROGATORY NO. 5:

Identify each period of time during which Applicant wholly or partially failed to use continuously Applicant's Mark, either in whole or in part, in connection with any of the service or products identified in response to Interrogatory No. 1, and state:

- (a) the precise element of the mark that was not continuously used;
- (b) the dates of non-use;

- (c) the reasons for non-use;
- (d) the reasons for resumed use; if applicable; and
- (e) the products in connection with which use of the mark was not continuous.

INTERROGATORY NO. 6:

Identify any prior owner of Applicant's Mark through which Applicant claims title and describe in detail the relationship between Applicant and the prior owner.

INTERROGATORY NO. 7:

For your company:

- (a) State the full complete name of the company and any changes in such name, with the date of each change; and,
- (b) state the country and date of incorporation and the present status of the corporation.

INTERROGATORY NO. 8:

State whether Applicant has licensed or granted authority to furnish goods or services under the Applicant's Mark and if so, identify all such persons and the goods or services covered by each license and identify all documents evidencing or relating to each such license agreement, including, without limitation, any rules, directions or guidelines intended for licensees or distributors of Applicant covering decoration, layout, signage and background music which may accompany or is part of the display or presentation of the Applicant's goods.

INTERROGATORY NO. 9:

State the date and circumstances under which Applicant first learned of Opposer's Marks and identify the person or persons who initially obtained this information.

INTERROGATORY NO. 10:

Identify all instances of actual confusion that have arisen in connection with Applicant's use of Applicant's Mark and the Opposer's Marks. For each such instance state:

(a) the name, or other means of identification, address, and occupation of the persons who were confused, mistaken or deceived;

(b) the date and place the instance occurred;

(c) a description of the circumstance that led to the person being confused, mistaken or deceived;

(d) the means by which Applicant received notice thereof;

(e) the name, address and occupation of the person from whom such notice was received;

(f) whether any record was made of the instance, and if so, the name and address of the person who has custody of the records; and

(g) the persons at Applicant most knowledgeable about the subject matter

Subparagraphs (a) and (f) hereof.

INTERROGATORY NO. 11:

Identify all third party uses of any mark containing a design representing a Phoenix bird as a part, or as an entire mark, as well as all use of similar designs of which Applicant is aware.

INTERROGATORY NO. 12:

Identify each legal proceeding, other than the current proceeding, involving the Applicant's Mark. If any, state the outcome of the proceeding.

INTERROGATORY NO. 13:

Identify all consumer and/or purchaser surveys, studies or market research relating to Opposer's Marks or Applicant's Mark.

INTERROGATORY NO. 14:

Identify each person employed by or associated with Applicant who has primary responsibility in connection with product sold under the Applicant's Mark, for:

- (a) Sales;
- (b) Marketing;
- (c) Advertising;
- (d) Customer relations;
- (e) Manufacturing;
- (f) Service;
- (g) Product or service names and marks;
- (h) Financial records, including sales and profits; and
- (i) New product planning.

INTERROGATORY NO. 15:

Identify the principal competitors in the businesses in which Applicant uses or intends to use Applicant's Mark.

INTERROGATORY NO. 16:

Identify current and prospective customers, purchasers and/or end-users for the goods and services offered under or using the Applicant's Mark.

INTERROGATORY NO. 17

(a) State whether Applicant has employed, or intends to employ, an expert to act on its behalf in this matter, and if so, for each such expert state:

- (i) His or her identify;
- (ii) His or her field of specialization and background as an expert; and

(iii) Whether Applicant proposes to call him or her as a witness, and if so, the substance of the proposed testimony.

(b) State whether Applicant has conducted, or intends to conduct, any survey with regard to:

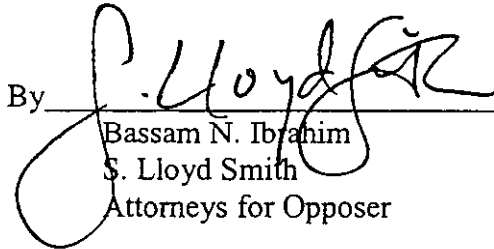
- (i) Likelihood of confusion, or
- (ii) Public recognition of the Applicant's Mark.

(c) With respect to any survey referred to in paragraph B hereof, state the date and the area in which each survey was or will be conducted, and the name and address of the person who conducted or shall conduct same.

INTERROGATORY NO. 18

Identify each person who participated in formulating Applicant's Answers to these Interrogatories, stating specifically the number of each Interrogatory to which such person contributed information.

ELON UNIVERSITY

By 
Bassam N. Ibrahim
S. Lloyd Smith
Attorneys for Opposer

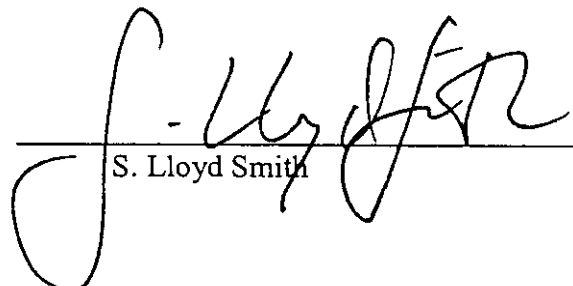
Date: May 26, 2004

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Telephone: 703/836-6620
Facsimile: 703/836-2021

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT was served this 26th day of May, 2004 by first-class mail, postage prepaid, on:

William J. Spatz, Esq.
Theodore Mlynar, Esq.
KRAMER LEVIN NAFTALIS & FRANKEL LLP
919 Third Avenue
New York, NY 10022


S. Lloyd Smith



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Opposition No. 91159927

OPPOSER'S FIRST SET OF DOCUMENT REQUESTS TO APPLICANT

Opposer, Elon University, in accordance with Rule 34 and other applicable rules of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, requests that the above-named Applicant respond to Opposer's First Set of Document Requests ("Requests") as set forth below. These Document Requests shall be deemed continuing in nature pursuant to Rule 26(e)(2) of the Federal Rules of Civil Procedure.

DEFINITIONS

Opposer hereby incorporates the definitions set forth in its First Set of Interrogatories to Applicant served concurrently herewith:

DOCUMENT REQUEST NO. 1:

All documents and tangible things identified in response to Opposer's First Set of Interrogatories to Applicant.

DOCUMENT REQUEST NO. 2:

All documents and tangible things concerning or relating to the origination, development, selection or adoption of Applicant's Mark by Applicant.

DOCUMENT REQUEST NO. 3:

All documents and tangible things concerning or relating to the use or future use of the Applicant's Mark in connection with any goods or services other than those listed in Applicant's Mark.

DOCUMENT REQUEST NO. 4:

Any trademark searches, including but not limited to searches of databases such as LEXIS/NEXIS, DIALOG or TRADEMARKSCAN, reports or investigations related to Applicant's Mark.

DOCUMENT REQUEST NO. 5:

All documents concerning enforcement of Applicant's Mark.

DOCUMENT REQUEST NO. 6:

Any documents and tangible things concerning Applicant's first use in the United States of the Applicant's Mark for each and every type of product or service in connection with which the Applicant's Mark has been used in the United States.

DOCUMENT REQUEST NO. 7:

A specimen of all products bearing the Applicant's Mark.

DOCUMENT REQUEST NO. 8:

All documents including correspondence concerning the consideration and decision on whether to implement changes to the logo or design of the Applicant's Mark.

DOCUMENT REQUEST NO. 9:

All documents concerning the filing in the United States of any federal trademark applications for Applicant's Mark, including but not limited to copies of corporate minutes, internal memoranda and correspondence concerning discussions and decisions to file such documents.

DOCUMENT REQUEST NO. 10:

All documents regarding marketing or consumer research, including individual questionnaires, pilot studies focus groups and surveys undertaken concerning the Applicant's Mark or Opposer's Marks.

DOCUMENT REQUEST NO. 11:

All documents regarding publicity (both solicited and unsolicited) in the United States concerning the Applicant's Mark or the goods and services sold under the Applicant's Mark, including press releases and articles of any kind.

DOCUMENT REQUEST NO. 12:

All documents regarding inquiries from and negotiations with third parties concerning the possibility of a license, franchise, sublicense, sub-franchise, assignment or distribution agreement with sublicense, sub-franchise, assignment or distribution agreement with Applicant concerning the Applicant's Mark or the goods and services offered under the Applicant's Mark in the United States.

DOCUMENT REQUEST NO. 13:

All past and current licenses, franchises, sublicenses, sub-franchises, distributorships and assignments and other agreements, together with related correspondence or other documents concerning Applicant's Mark.

DOCUMENT REQUEST NO. 14:

All security agreements concerning the Applicant's Mark.

DOCUMENT REQUEST NO. 15:

All documents and tangible things concerning the types of locations in the United States at which Applicant has promoted, advertised and sold goods and services using the Applicant's Mark.

DOCUMENT REQUEST NO. 16:

All documents and tangible things concerning the manner of marketing (past, current and contemplated) of goods and services under or using the Applicant's Mark in the United States.

DOCUMENT REQUEST NO. 17:

All documents and tangible things concerning the channels of trade in which Applicant has offered or may offer goods and services under or using the Applicant's Mark.

DOCUMENT REQUEST NO. 18:

All documents and tangible things which identify the actual or prospective class of customers and purchasers of goods and services offered under or using the Applicant's Mark.

DOCUMENT REQUEST NO. 19:

Documents sufficient to identify the amount of sales in the United States of goods and services offered under or using the Applicant's Mark over the past two (2) years.

DOCUMENT REQUEST NO. 20:

Document sufficient to identify the amount of advertising and promotional expenditures for goods and services offered under or using the Applicant's Mark in the United States over the past two (2) years.

DOCUMENT REQUEST NO. 21:

All documents that refer or relate to the significance of the Applicant's Mark as used on or in connection with or contemplated to be used on or in connection with goods and services offered for sale by Applicant.

DOCUMENT REQUEST NO. 22:

All documents relating to threatening or pending arbitration, litigation or other adversarial proceedings (including oppositions and cancellations) concerning Applicant's Mark.

DOCUMENT REQUEST NO. 23:

All documents and tangible things concerning the Applicant's knowledge of Opposer or Opposer's Marks.

DOCUMENT REQUEST NO. 24:

All documents and tangible things evidencing any confusion between Applicant's Mark or goods and services offered under or using Applicant's Mark and Opposer, Opposer's Marks, or goods and services offered under or using Opposer's Marks, including inquiries, comments or other communications by or from customers, suppliers, or members of the public, either written or oral, showing any confusion, suspicion, belief or doubt as to a possible relationship between Opposer and Applicant or the origin of their respective products and/or services.

DOCUMENT REQUEST NO. 25:

All communications between Applicant and any third party concerning Opposer or Opposer's Marks.

DOCUMENT REQUEST NO. 26:

All communications between Applicant and any third party concerning this opposition proceeding.

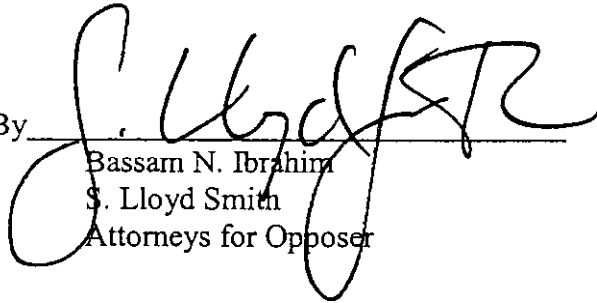
DOCUMENT REQUEST NO. 27:

All documents supporting the statements set forth in Applicant's Answer to the Notice of Opposition.

DOCUMENT REQUEST NO. 28

All documents upon which Applicant intends to rely to support or prove Applicant's case in this proceeding.

ELON UNIVERSITY

By 
Bassam N. Ibrahim
S. Lloyd Smith
Attorneys for Opposer

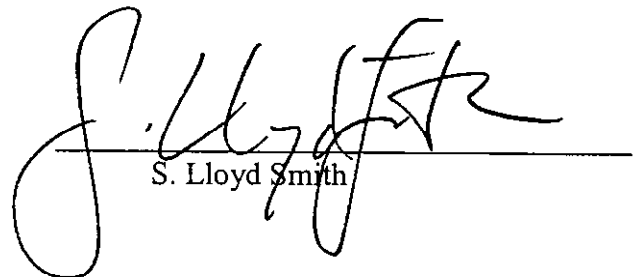
Date: May 26, 2004

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S FIRST SET OF DOCUMENT REQUESTS TO APPLICANT was served this 26th day of May, 2004 by first-class mail, postage prepaid, on:

William J. Spatz, Esq.
Theodore Mlynar, Esq.
KRAMER LEVIN NAFTALIS & FRANKEL LLP
919 Third Avenue
New York, NY 10022


S. Lloyd Smith