

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

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|---------------------------|---|---------------------------|
| ----- | : | |
| Atotech Deutschland GmbH, | : | |
| | : | Cancellation No. 92047816 |
| Petitioner, | : | |
| | : | Mark: TRIBLACK |
| v. | : | |
| | : | Reg. No. 3,106,449 |
| MacDermid Acumen, Inc. | : | |
| | : | Registered: June 20, 2006 |
| Registrant. | : | |
| ----- | : | |



12-26-2007

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

U.S. Patent & TMO/TM Mail Repl. 01 #74

Petitioner Atotech Deutschland GmbH ("Petitioner") hereby requests that Registrant MacDermid Acumen, Inc. ("Registrant") produce and permit Petitioner to inspect and copy the following designated documents and things, pursuant to Rule 2.120 of the Trademark Rules of Practice and Rule 34 of the Federal Rules of Civil Procedure, at the office of Frommer Lawrence & Haug LLP, 745 Fifth Avenue, New York, New York 10151, or at some other location mutually agreed upon, thirty (30) days after receipt hereof.

DEFINITIONS AND INSTRUCTIONS

1. As used herein the term "Petitioner" means and shall refer to Petitioner herein, each of its predecessors, subsidiaries, licensees, divisions, affiliates, directors, officers, employees, agents and attorneys and each person acting on its behalf or under its control

2. As used herein, the term "Registrant" means and shall refer to Registrant herein, each of its predecessors, subsidiaries, licensees, divisions, affiliates, directors, officers, employees, agents and attorneys and each person acting on its behalf or under its control.

3. As used herein, the term "Person" as well as pronouns referring thereto shall include any business, legal or government entity or association, as well as natural persons.

4. 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.

5. With respect to each Document to which an objection as to production is made, state:

- a. The nature of the Document;
- b. The date of the Document;
- c. The name of the person(s) to whom the Document was addressed;
- d. The name of the person(s) who received such Document;
- e. The name of the person(s) who prepared or sent the Document;
- f. The general subject matter of the Document; and
- g. The specific grounds upon which the objection is made.

6. As used herein, the term "date" means the exact date, if known, and, if not known, the approximate date.

7. Any word written in the singular shall be construed as plural or vice-versa when necessary to facilitate a response to a request for production of a document or thing.

8. As used herein, the term "all" and "each" shall be construed as all and each to bring within the scope of the discovery request all responses that might be construed to be outside of its scope.

9. 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 requests all responses that might otherwise be construed to be outside of its scope.

10. "Refer" "relate" or "relating," "regarding," "concerning," "reflecting" or "containing" shall mean directly or indirectly, in whole or in part, referring to, relating to, connected with, commenting on, discussing, impacting upon, affecting, responding to, explaining, showing, indicating, describing, analyzing, reflecting, evidencing or constituting.

11. As used herein, the term "Registrant's Mark" means and shall refer to the Registration No. 3,106,449, which is the subject of the instant Cancellation proceeding.

12. As used herein, the term "Petitioner's Mark" means and shall refer to the mark CORRO TRIBLACK and pending application Serial No. 76/651,121.

REQUESTED DOCUMENTS AND THINGS

REQUEST NO. 1

All Documents concerning the design, selection, adoption, creation and development of Registrant's Marks.

REQUEST NO. 2

All Documents concerning Registrant and/or Registrant's Mark.

REQUEST NO. 3

A specimen of each and every brochure, business plan, marketing plan, proposal, or other Document created at any time that describes the business of Registrant and its plans for goods bearing Registrant's Mark.

REQUEST NO. 4

A specimen or photographs of each product, including the packaging for each product, that has been, is being, or will be sold or offered for sale using Registrant's Mark.

REQUEST NO. 5

All Documents concerning the date on which Registrant began using Registrant's Mark for any goods or services in commerce in the United States.

REQUEST NO. 6

All Documents concerning the date on which Registrant made its first sale of any product using Registrant's Mark.

REQUEST NO. 7

All Documents concerning the creation or design of any advertising or promotional materials that have been or are being used by Registrant and that contain Registrant's and/or Applicant's Mark.

REQUEST NO. 8

All Documents concerning each trademark search, clearance or other inquiry conducted by or on behalf of Applicant that refers or relates to Applicant's Mark or any variation thereof.

REQUEST NO. 9

All Documents concerning any survey, test survey, informal survey, consumer questionnaire, consumer study questionnaire, market analysis, market research, investigation or other inquiry conducted by or on behalf of Registrant or of which Registrant has become aware that refers or relates to Registrant, Registrant's Mark, Petitioner or Petitioner's Marks.

REQUEST NO. 10

All Documents concerning the channels of trade through which products and/or services offered for sale or sold using Registrant's Mark travel from Registrant to the ultimate consumers of the products in the United States.

REQUEST NO. 11

All Documents, from the time Registrant began using Registrant's Mark until the present, concerning Registrant's gross income derived from the sale of products offered for sale or sold using Registrant's Mark in the United States.

REQUEST NO. 12

All Documents concerning Registrant's estimated or projected gross income to be derived from the sale of products offered for sale or sold using Registrant's Mark in the United States.

REQUEST NO. 13

All Documents, from the time Registrant began using Registrant's Mark until the present, concerning the number of units of products offered for sale or sold using Registrant's Mark in the United States.

REQUEST NO. 14

All Documents concerning Registrant's estimated or projected number of units of products which will be offered for sale or sold using Registrant's Mark in the United States.

REQUEST NO. 15

All Documents concerning the geographic locations in which Registrant offers for sale and sells, or has offered for sale and sold, each product using Registrant's Mark.

REQUEST NO. 16

All Documents concerning the geographic locations in which Registrant intends to offer for sale and sell products using Registrant's Mark.

REQUEST NO. 17

A representative sample of each class or type of promotional material, including, but not limited to, advertisements, catalogs, brochures, posters, sales sheets, point of sale displays, flyers and price lists, which is, has been, or is intended to be used to promote products using Registrant's Mark in the United States.

REQUEST NO. 18

All Documents concerning or identifying the customers to whom goods bearing Registrant's Mark are promoted.

REQUEST NO. 19

All Documents concerning purchasers of the goods sold or to be sold under Registrant's Mark.

REQUEST NO. 20

All invoices, or other Documents, from the time Registrant began using Registrant's Mark until the present, concerning Registrant's sales of products using Registrant's Mark in the United States.

REQUEST NO. 21

All invoices, or other Documents, from the time Registrant began using Registrant's Mark until the present, concerning the dollar amounts spent by Registrant, for advertising and promoting products and/or retail stores using Registrant's Mark in the United States.

REQUEST NO. 22

All Documents concerning all communication between Registrants, on the one hand, and any and all of Registrant's manufacturers, suppliers, wholesalers, distributors and/or licensees, on the other hand, concerning products offered for sale and sold using Registrant's Mark in the United States, including but not limited to, Documents concerning Registrant's purchase of products or materials used in manufacturing, labeling, packaging or distributing such products.

REQUEST NO. 23

All Documents, from the time Registrant began using Registrant's Mark until the present, concerning Registrant's inventory of products offered for sale and sold using Registrant's Mark in the United States.

REQUEST NO. 24

All Documents concerning all license agreements, distribution agreements, sponsorship agreements, or any other agreement, whether in draft or final form, wherein Registrant allows, allowed or will allow the use of Registrant's Mark by another.

REQUEST NO. 25

All Documents concerning all assignments or any other agreement to which Registrant, or its predecessors in interest, is a party involving Registrant's Mark.

REQUEST NO. 26

All Documents concerning each instance in which any person has been in any way confused, mistaken or deceived as to the origin or sponsorship of any product or service which is sold or offered for sale by or on behalf of Registrant using Registrant's Mark.

REQUEST NO. 27

All Documents concerning all communications between Registrant, on the one hand, and any individual or entity, on the other hand, concerning Petitioner, Petitioner's Marks, and/or Registrant's Mark.

REQUEST NO. 28

Each Document which concerns any experts who have been retained or specially employed by Registrant, and any facts known or opinions held by any such experts regarding any aspect of this proceeding.

REQUEST NO. 29

For each expert whose opinion may be relied upon in this proceeding, each documents which concerns: (i) any opinions that may be presented at trial; (ii) the reasons for any such opinions; (iii) any data or information considered by the witness in forming the opinions; (iv) any exhibits used in support of or summarizing the opinions; (v) the compensation being paid to

the witness, and (vi) any cases which the witness has testified at trial or by deposition from 1995 to date.

REQUEST NO. 30

All Documents reflecting, relating to, pertaining to, or referring to any disputes, disagreements or controversies Applicant has had in the past or now has with a party other than Petitioner.

REQUEST NO. 31

All Documents pertaining or relating to any litigation, including administrative proceeding, in which Registrant has been involved, either as a party or otherwise, which involved any trademark, service mark, trade name, or copyright claims of any kind.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP
Attorneys for Petitioner

Dated: December 20, 2007

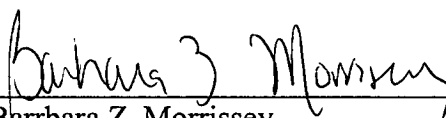
By: 

Barbara Z. Morrissey, Reg. No. 41,205
Deena Levy Weinhouse
745 Fifth Avenue
New York, New York 10151
(212) 588-0800

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing Petitioner's Petitioner's First Request For Production Of Documents And Things directed to Registrant, MacDermid Acumen, Inc. was served via U.S. First Class Mail, postage prepaid, on this 20th day of December 2007 to the last known address of the attorney of record as follows:

Fatima Lahnin
Carmody & Torrance LLP
195 Church Street
P.O. Box 1950
New Haven, CT 06509-1950



Barbara Z. Morrissey
Deena Levy Weinhaus
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745 Fifth Avenue
New York, NY 10151