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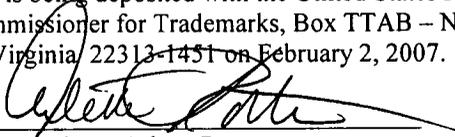
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

KAPALUA LAND COMPANY, LTD	)	
	)	Consolidated Case
Petitioner/Opposer,	)	
	)	Opposition No. 91124762
	)	Cancellation No. 92040092
v.	)	
	)	
INTERFASHION LTD. B.V.I. et al.	)	
	)	
Respondent/Applicant.	)	
	)	

**RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITIONER'S  
MOTION FOR SUMMARY JUDGMENT**

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, Box TTAB – NO FEE, P.O. Box 1451, Alexandria, Virginia 22313-1451 on February 2, 2007.

Signature:   
 Print: Arlette Porter

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## INTRODUCTION

This is a consolidated proceeding in which petitioner opposes respondent's application Serial No. 76/023,641, and seeks to cancel respondent's Registration Nos. 2,016,976 and 2,115,124. The application and both registrations are for the mark KAPALUA.

This is petitioner's second motion for summary judgment. Petitioner's first motion, which sought summary judgment with respect to Registration Nos. 2,016,976 and 2,115,124, based solely on the ground of abandonment, was denied as to Registration No. 2,115,124.

This second motion seeks summary judgment against Registration No. 2,115,124 and Serial No. 76/023,641 on the basis of *res judicata*. Petitioner's *res judicata* theory is based on likelihood of confusion and the following paragraph in the Board's opinion of October 20, 2006 (Ex. 1), relating to petitioner's first motion for summary judgment:

Registration No. 2,016,976 – During the pendency of this proceeding, respondent failed to file an acceptable Section 8 affidavit for Registration No. 2,016,976. Accordingly, Registration No. 2,016,976 was cancelled on September 28, 2006. In response to the summary judgment motion, respondent stated that it is not contesting Petitioners request to cancel Registration No. 2,016,976. In view thereof, judgment is hereby entered against respondent with respect to Registration No. 2,016,976.

Respondent did not state that "it is not contesting Petitioners request to cancel Registration No. 2,016,976." Respondent stated that it "does not contest the cancellation of Registration No. 2,016,976 because respondent did not respond to a post-registration Office Action dated October 14, 2005, issued in response to Respondent's Declaration of Excusable Non-Use." Respondent did not agree to entry of a judgment as to the '976 Registration. Since the Registration was being canceled by operation of law, independent from this proceeding,

petitioner's summary judgment motion was moot as to the '976 Registration. Thus, there was no point in contesting something that had already occurred. At this point in time, the cancellation proceeding as to the '976 Registration should have been dismissed without prejudice as being moot, or petitioner should have been given an opportunity to pursue a decision on the merits.

The dates relevant to the cancellation of the '976 Registration are as follows:

- October 14, 2005: U.S. Patent and Trademark Office issues Section 8 Post Registration Office Action
- April 14, 2006: Deadline to respond to Office Action , and no response or appeal was filed.
- April 15, 2006: Cancellation of the '976 Registration by operation of law was inevitable as of this date.
- June 13, 2006: Petitioner files its first motion for summary judgment to cancel Respondent's Registration Nos. 2,016,976 and 2,115,124.
- August 8, 2006: Respondent files brief in opposition to motion for summary judgment.
- September 28, 2006: U.S. Patent and Trademark Office formally cancels the Respondent's '976 Registration
- October 20, 2006: Trademark Trial and Appeal Board's opinion on Petitioner's first motion for summary judgment.

Petitioner's motion should be denied for the following reasons:

1. The doctrine of *res judicata* does not apply because there was no decision on the merits, and the basis for petitioner's first summary judgment motion, abandonment, differs from the basis of petitioner's second summary judgment motion, likelihood of confusion.
2. The '976 registration was cancelled by operation of law prior to the Board's decision entering judgment canceling the '976 registration.

3. Respondent did not consent to entry of judgment against the '976 registration.

**I. RESPONDENT'S RESPONSE TO PETITIONER'S STATEMENT OF MATERIAL FACTS NOT IN ISSUE**

**A. Registration No. 2,016,976**

1. Registration No. 2,016,976, issued on November 19, 1996 and was cancelled by the Trademark Trial and Appeal Board in its decision on October 20, 2006. It covered goods in Classes 3 for "laundry bleach and laundry detergent, **perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentifrice**" and goods in Class 25 for "**footwear, headwear, gloves.**" Emphasis added.

**RESPONSE:** Respondent admits that Registration No. 2,016,976 issued on November 19, 1996 for "laundry bleach and laundry detergent, perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentifrice" in Class 3 and "footwear, headwear, gloves" in Class 25. Respondent denies that Registration No. 2,016,976 was cancelled by the Trademark Trial and Appeal Board in its opinion of October 20, 2006. Registration No. 2,016,976 was cancelled by operation of law as of April 14, 2006, and the cancellation made of record by the U.S. Patent and Trademark Office on September 23, 2006. (Ex. 2).

2. The Petition to Cancel Registration No. 2,016,976 filed on July 9, 2001, alleged, *inter alia*, likelihood of confusion.

**RESPONSE:** Undisputed.

3. Long after the Petition to cancel was filed on July 9, 2001 and after Interfashion had answered the Petition to Cancel on August 31, 2005, Interfashion declared in its May 22, 2006 Answer to the First Amended Complaint that it had abandoned Registration No. 2,016,976. (Answer to First Amended Complaint ¶ 5.)

**RESPONSE:** Respondent disputes the allegations of ¶3. In its Answer to First Amended Complaint, Respondent stated that it "has allowed Registration No.

2,016,976 to be cancelled ....” Registration No. 2,016,976 was cancelled by operation of law on September 23, 2006. (Ex. 2).

4. Interfashion did not request KLC’s acquiescence to the abandonment of the registration and KLC gave no consent to the abandonment.

**RESPONSE:** KLC’s acquiescence was not relevant as to whether or not Interfashion responded to the post registration Office Action. That KLC did not consent is not disputed.

5. The Trademark Trial and Appeal Board entered judgment against Interfashion relative to the Petition to Cancel Registration No. 2,016,976 in its Order of October 20, 2006.

**RESPONSE:** Judgment should not have been entered, and the Trademark Trial and Appeal Board should clarify or amend its opinion of October 20, 2006.

**B. Registration No. 2,115,124**

6. Registration No. 2,115,124 issued on November 25, 1997 for “clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, **shoes, gloves, and hats**” in Class 25. (Emphasis added.)

**RESPONSE:** Undisputed.

7. The Petition to Cancel Registration No. 2,115,124 filed on July 9, 2001 alleged, *inter alia*, likelihood of confusion.

**RESPONSE:** Undisputed.

**C. Application Serial No. 76/023,641**

8. Application Ser. No. 76/023,641 covers the following goods:

IC003. US 001 004 006 050 051 052. G&S: Soaps; **perfume, essential oils for personal use**, cosmetics, namely, **eyeliner, lipstick**, foundation, mascara, rouge, skin care lotion and crème; **hair lotions, dentifrices**, toothpaste, mouth wash

IC 009. US 021 023 026 036 038. G&S: Eyeglass frames and cases.

IC 014. US 002 027 028 050. G&S: Precious metals and their alloys; goods of precious metals or coated therewith, namely, jewelry, ashtrays, belts for clothing, candlesticks (sic), cigarette holders; jewelry precious gemstones, horological and chronometers instruments, namely, clocks, watches and chronometers

IC 018. US 001 002 003 022 041. G&S: Leather and imitation leather sold in bulk; leather and imitation leather goods, namely, handbags, tote bags, shopping bags, keyfobs (sic), purses, trunks and traveling bags, umbrellas, parasols and walking sticks

IC 025. US022 039. G&S: Clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, **shoes, footwear, headwear**

IC 021. US 002 013 023 029 030 040 050. G&S: Dental floss.

(Emphasis added).

**RESPONSE:** Undisputed.

9. KLC filed a Notice of Opposition against Application Serial No. 76/023,641 on October 31, 2001 on grounds of likelihood of confusion.

**RESPONSE:** Undisputed.

10. The application is based on Interfashion's Intent To Use.

**RESPONSE:** Undisputed.

## **II. RESPONDENT'S STATEMENT OF SUPPLEMENTAL UNCONTESTED FACTS**

### **A. Registration No. 2,016,976**

1. Registration No. 2,016,976 was canceled by operation of law under § 8 on September 28, 2006. (Ex. 2).
2. Respondent did not file an express abandonment of Registration No. 2,016,976.
3. Respondent did not agree to entry of a judgment.

**B. The TTAB's Opinion Dated October 20, 2006**

4. The TTAB's opinion of October 20, 2006, limited judgment to the abandonment by operation of law of Registration No. 2,016,976, stating:

During the pendency of this proceeding, respondent failed to file an acceptable Section 8 affidavit for Registration No. 2016976. Accordingly, Registration No. 2016976 was cancelled on September 28, 2006.

(Ex. 1).

5. Petitioner's summary judgment motion was denied as to Registration No. 2,115,124 because petitioner did not demonstrate the absence of a genuine issue of material fact for trial. (Ex. 1).
6. The TTAB's opinion of October 20, 2006, did not address likelihood of confusion with respect to Registration No. 2,016,976; Registration No. 2,115,124; or Application Serial No. 76/023,641. (Ex. 1).

**III. ARGUMENT**

**A. *RES JUDICATA* DOES NOT APPLY**

Based on the Board's opinion of October 20, 2006, petitioner argues that summary judgment should be granted based on *res judicata* as to Registration No. 2,115,124 and Application Serial No. 76/023,641 because likelihood of confusion "has already been determined" as to the '976 registration. (Petitioner's Brief, p. 2). Not only was there no determination of likelihood of confusion, likelihood of confusion was not even an issue in petitioner's first motion. The judgment, to the extent it should have been entered, was limited to abandonment of the '976 registration because Respondent failed to file an acceptable Section 8 affidavit (Ex. 1 at pp. 4 and 5). Thus, not having been litigated, the issue of likelihood of

confusion cannot properly serve as a basis for *res judicata*, particularly with respect to Registration No. 2,115,124 and Serial No. 76/023,641.

The term *res judicata* includes claim preclusion and issue preclusion. “Issue preclusion refers to the effect of a judgment in foreclosing re-litigation of a matter that has been litigated and decided.... Claim preclusion refers to the effect of a judgment in foreclosing litigation of a matter that never has been litigated, because of a determination that it should have been advanced in an earlier suit.” *Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, 448 F.3d 1368, 1370 (Fed. Cir. 2006), quoting *Migra v. Warren City Sch. Dist. Bd. Of Educ.*, 465 U.S. 75, 77 n.1 (1984). Issue preclusion does not apply in this case because the merits of Petitioner’s cancellation of Reg. No. 2,016,976 were not litigated and decided. If *res judicata* applies, it can only rest on principles of claim preclusion.

Petitioner cannot establish the facts necessary for claim preclusion to apply. “For claim preclusion based on a judgment in which the claim was not litigated, there must be (1) an identity of parties or their privies, (2) a final judgment on the merits of the prior claim, and (3) the second claim must be based on the same transactional facts as the first and should have been litigated in the prior case.” *Thinksharp*, 448 F.3d 1368 at 1370. For *res judicata* to apply against respondent, it must be on the premise that the issue of likelihood of confusion of the ‘124 Registration and the ‘641 Application should have been litigated in the cancellation of the ‘976 Registration.

There was no final judgment on the merits of the prior claim, and the issue of likelihood of confusion was not litigated because it was not at issue. The sole basis of petitioner’s first motion for summary judgment was abandonment. Moreover, the transactional facts of the cases

are not the same, which is supported by the TTAB's decision to deny summary judgment as to the '124 Registration in its opinion of October 20, 2006.

Petitioner relies upon *Miller Brewing Company v. Coy International Corporation*, 230 U.S.P.Q. 675 (TTAB 1986). Similar to the situation in *Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, the instant case differs from *Miller Brewing* in that "this is not a situation where the applicant after a judgment had been entered against it, adopted a second mark in an attempt to avoid the preclusive effect of a previous judgment." See *Thinksharp*, 448 F.3d at 1371. Respondent does not attempt to evade the preclusive effect of the judgment entered against it with respect to the '976 Registration. The '641 Application and '124 Registration were filed well before petitioner objected to the '124 and '976 Registrations on July 9, 2001. See *Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d (BNA) (TTAB 1993) ("when the second application was filed, the opposition to the first had not yet even been instituted"). Further, respondent continues to defend the opposition as to the '641 Application and Cancellation as to the '124 Registration.

The purpose of *res judicata* is to prevent a party from being required to relitigate the same issue against the same party in a separate action. *Thinksharp*, 448 F.3d at 1372. That is not the situation here. Moreover, "[T]he Supreme Court has cautioned that the offensive use of *res judicata* should be examined carefully to determine whether it would be unfair to the defendant." *Thinksharp, Inc.*, 448 F.3d at 1371, citing *Parklane Hosiery Co. v. Shore*, 439 U.S. 323, 327 n.5 (1979). "Precedent cautions that *res judicata* is not readily extended to claims that were not before the court, and precedent weighs heavily against denying litigants a day in court unless there is a clear and persuasive basis for that denial." *Id.* (Citations omitted). Petitioner has failed to offer a clear and persuasive basis to deny respondent its day in court. Thus, denying

Respondent the opportunity to litigate the issue of likelihood of confusion as to the '124 Registration or the '641 Application would be patently unfair.

**B. THE '276 REGISTRATION WAS CANCELLED BY OPERATION OF LAW**

In filing the Section 8 declaration of non-use, respondent's former attorney alleged grounds which were rejected by the U.S. Patent and Trademark Office. Respondent made a legal decision that it was not in a position to respond to the post registration Office Action, and allowed the time to respond to expire. Thus, it was inevitable that the '976 Registration would be canceled by operation of law. Thus, the cancellation of the '976 Registration did not result from the claims asserted in this proceeding, or relate to the basis of petitioner's first summary judgment motion. The decision to allow the '976 Registration to be canceled was not for the purpose of avoiding the proceeding or an adverse judgment. Respondent had no other option in view of the grounds initially asserted in the Section 8 declaration of non-use. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154 (TTAB 1989)(although judgment entered on ground of abandonment in view of concession that failure to file Section 8 affidavit was due to discontinued use of mark, judgment was not entered on ground of likelihood of confusion where respondent showed that failure to file Section 8 affidavit with respect to that ground was result of deliberate business decision made prior to commencement of proceeding and not for purposes of avoiding proceeding). "Precedent and sound administrative policy support the ...reasoning that a trademark owner is entitled to choose which opposition [or cancellation] to defend, when the proceedings are not an attempt to evade the effect of a previous adverse judgment on the merits." *Id.*; *see Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993); *Mayer/Berkshire Corp. v. Berkshire Fashions*, 424 F.3d 1229, 1234 (Fed. Cir. 2005)("Caution is warranted in the application of preclusion by the PTO."); *see also* TBMP § 602.02(b)(The purpose of 37 C.F.R. § 2.134(b) is to prevent a cancellation proceeding respondent from being

able to moot the proceeding, and avoid judgment, by deliberately failing to file a required affidavit of use under Section 8).

**C. RESPONDENT DID NOT CONSENT TO JUDGMENT CANCELING THE '976 REGISTRATION**

In its brief in opposition to Petitioner's first motion for summary judgment, respondent did not consent to entry of a judgment against the '976 Registration, nor did respondent expressly abandon or cancel the '976 Registration. Respondent merely stated that it was not contesting the cancellation because respondent was not able to respond to a post registration Office Action and, therefore, the Registration was subject to cancellation by operation of law. The U.S. Patent and Trademark Office did, in fact, formally cancel the '976 Registration on September 28, 2006, which was prior to the Board's opinion of October 20, 2006. Thus, the motion for summary judgment as to the '976 Registration was moot. There was simply no point in briefing the issue. Respondent's response to the Office Action was due April 14, 2006, which was prior to the filing of petitioner's summary judgment motion on June 13, 2006. Thus, the '976 Registration was already cancelled by operation of law prior to the filing of petitioner's summary judgment motion on June 13, 2006.

It was obviously not respondent's intent to concede cancellation of the '976 Registration on the merits in the cancellation proceeding when it was contesting summary judgment as it related to the '124 Registration.

CONCLUSION

In view of the foregoing, the Board's opinion of October 20, 2006, should be clarified or amended and petitioner's motion should be denied.

February 2, 2007

By:



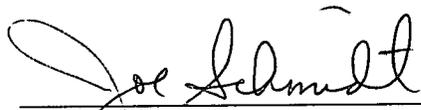
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of **RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT** was served by first class mail, postage pre-paid, on this 2nd day of February 2007 upon:

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\_\_\_\_\_

One of the Attorneys for Respondent

THIS OPINION IS NOT CITABLE  
AS PRECEDENT OF  
THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Greenbaum

Mailed: October 20, 2006

Opposition No. 91124762  
Cancellation No. 92040092

Kapalua Land Company, Ltd.

v.

Interfashion Ltd. B.V.I. (by  
assignment from Kapalua  
Strickenwaren GmbH<sup>1</sup>) and Style  
& Spirit GmbH (joined as party  
defendant)

Before Holtzman, Rogers and Kuhlke, Administrative Trademark  
Judges.

By the Board:

Now ready for decision are petitioner's motion for  
summary judgment, and respondent Kapalua Strickenwaren  
GmbH's cross-motion for leave to amend its responses to  
petitioner's first set of requests for admissions, both  
filed in the cancellation proceeding.<sup>2</sup> The parties have  
fully briefed the motions, and we have considered

<sup>1</sup> Reel 1972, Frame 0571, recorded October 4, 1999. The record in  
the cancellation proceeding indicates that there have been  
numerous other assignments of the involved registration, and one  
name change, none of which have been recorded with the Assignment  
Services Division of the USPTO. Upon the filing with the Board  
of a copy of the assignment(s), the Board may join the assignee  
as party defendant. See TBMP § 512.01 (2<sup>nd</sup> ed. rev. 2004). Upon  
recordation of the assignment, the Board may substitute the  
assignee as party defendant. Id.

<sup>2</sup> Opposition No. 91124762 is suspended pursuant to the Board's  
July 30, 2006 order.

EXHIBIT

1

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petitioner's reply regarding its summary judgment motion.

See Trademark Rule 2.127(a).

**Motion for Leave to Amend Responses to Requests for Admissions**

We turn first to respondent's motion for leave to amend its responses to petitioner's requests for admissions, pursuant to Fed. R. Civ. P. 36(b).

As background, respondent's responses to petitioner's requests for admissions include an admission that respondent has not used the involved mark on shoes, socks and underwear, i.e., three of the 15 items identified in Registration No. 2115124, and an admission that the mark has been used on the other 12 items listed in the registration. These admissions directly contradict the Section 8 affidavit that respondent previously filed, and form the basis for petitioner's pending summary judgment motion on the issue of fraud, discussed below.

Respondent now seeks to replace these admissions with denials, based on information set forth in declarations from Nicolaus Reusch<sup>3</sup> and Christine Tan<sup>4</sup>. The declarations,

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<sup>3</sup> Mr. Reusch was the Managing Director of Style & Spirit GmbH when he signed the Section 8 affidavit, and currently is the Co-CEO of DC Design & Concept GmbH. Mr. Reusch also provided the conflicting information contained in respondent's responses to petitioner's interrogatories and requests for admissions.

<sup>4</sup> Ms. Tan states that she currently is the "Creative Director and chief designer for the KAPALUA Brand line of women's clothing for DC Design & Concept GmbH." Ms. Tan states that she created this line of clothing in 1994, and that she has designed the line for various predecessors to DC Design & Concept GmbH, including Style & Spirit GmbH in 2003 and 2004.

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which were submitted in response to petitioner's summary judgment motion, demonstrate that the mark was in use on all of the goods identified in Registration No. 2115124 on the filing date of the Section 8 affidavit. The declarations, and particularly Mr. Reusch's explanation regarding translation and comprehension difficulties, persuade us that the merits of the case would be subserved by allowing respondent to amend its admissions.

In making this determination, we are mindful that it is the policy of the law to decide cases on their merits, whenever possible. See *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 18 USPQ2d 1719, 1722 (TTAB 1989).

Moreover, petitioner has not persuaded us that it will be unfairly prejudiced by the amendment of the admissions. In this regard, the concept of prejudice does not simply mean that a party who obtained the admissions will now have to prove the previously admitted facts but, rather, refers to the special difficulty a party may face in proving its case, e.g., if key witnesses or evidence have become unavailable, or if there is insufficient time before trial for that party to obtain the necessary evidence or witnesses. See, generally, *Wright & Miller*, 8A Federal Practice and Procedure: Civil 2d § 2264 (1994).

In addition, petitioner's testimony period has not yet opened. By reopening the discovery period, which we do

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below, petitioner will have sufficient time before trial to obtain necessary evidence and witnesses. See *Hobie Designs v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990). See also *Johnston/Pump*, supra, 18 USPQ2d 1719 (case was still in pre-trial stage and prejudice to the party propounding admission requests could be avoided or mitigated by reopening discovery for that party).

In view of the foregoing, respondent's motion for leave to amend its admissions is granted, and respondent's amended responses to petitioner's requests for admissions are accepted.

**Motion for Summary Judgment**

We now turn to petitioner's motion for summary judgment on the issue of abandonment with respect to Registration No. 2016976, the issue of fraud with respect to respondent's filing of a Section 8 affidavit for Registration No. 2115124, and the issue of respondent's abandonment of Registration No. 2115124 for failure to file an acceptable Section 8 affidavit.

**Registration No. 2016976**

During the pendency of this proceeding, respondent failed to file an acceptable Section 8 affidavit for Registration No. 2016976. Accordingly, Registration No. 2016976 was cancelled on September 28, 2006. In response to the summary judgment motion, respondent stated that it "is

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not contesting Petitioner's request to cancel" Registration No. 2016976. In view thereof, judgment is hereby entered against respondent with respect to Registration No. 2016976.

**Registration No. 2115124**

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the summary judgment motion in favor of respondent as the nonmoving party, we find that petitioner has not demonstrated the absence of a genuine issue of material fact for trial.

In light of respondent's supporting declarations, discussed above, respondent's answer to the amended petition for cancellation, and respondent's supplemental and/or amended responses to petitioner's discovery requests, respondent has established the existence of a genuine issue of fact as to whether the Section 8 affidavit that

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respondent filed in Registration No. 2115124 contains fraudulent statements and representations.

In addition, inasmuch as the Post Registration section of the USPTO accepted respondent's Section 8 affidavit on September 17, 2006, Style & Spirit GmbH is currently viewed by the office as the record owner of Registration No. 2115124.<sup>5</sup> Thus, petitioner also has failed to establish the absence of a genuine issue with respect to respondent's alleged abandonment of Registration No. 2115124, to the extent petitioner bases said claim on respondent's purported "failure to comply with the Post-Registration requirements and the timely filing by the owner of the mark of a Declaration of Use."

In view thereof, petitioner's summary judgment motion is denied as to Registration No. 2115124.<sup>6</sup>

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<sup>5</sup> The Board relies on this Post Registration determination solely for the purpose of identifying Style & Spirit GmbH as the current record owner of Registration No. 2115124, and therefore a real party in interest. However, Post Registration's acceptance of the Section 8 affidavit does not foreclose the possibility of further investigation by petitioner on the issues related to the various transfers of this registration and the identity of any other real party in interest. In this vein, either party may file an appropriate motion, with supporting evidence, to add DC Design & Concept GmbH, and/or any previous or subsequent assignees, as additional defendants.

<sup>6</sup> The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. See, for example, *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

**Entry of Standard Protective Order**

To the extent that discovery has been stalled due to the need for agreement to and entry of a confidentiality agreement, it is appropriate to impose the Board's standardized protective order on the parties. The protective agreement is available on-line at <http://www.uspto.gov/web/offices/dcom/ttab/ttabdocs.htm> and hereby binds the parties. As the parties can see from the terms of the agreement, they are free to agree to modifications or seek modifications by motion to the Board.

**Observations and Discovery Reminders**

Petitioner may wish to reconsider its abandonment claim, in light of the matters discussed hereinabove, and particularly in light of Post Registration's acceptance of respondent's Section 8 affidavit on September 17, 2006. Specifically, petitioner should consider whether it will pursue at trial allegations of respondent's non-use of the mark in commerce, as originally pleaded, and/or abandonment related to chain of title issues or transfers of the involved registration. If petitioner intends to pursue the latter course, petitioner should amend its petition for cancellation to reflect the change in focus.

The Board reminds respondent that it has a duty to make a good faith effort to satisfy petitioner's discovery needs. See TBMP section 402.01 (2<sup>nd</sup> ed. rev. 2004). Respondent is

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further reminded that it has a duty to thoroughly search its records for all information properly sought by any discovery request, and to provide such information to petitioner within the time allowed for responding to the request. See TBMP section 408.02 (2<sup>nd</sup> ed. rev. 2004). Furthermore, a party that has responded to a discovery request has an ongoing duty to supplement or correct that response. See Fed. R. Civ. P. 26(e); TBMP § 408.03 (2<sup>nd</sup> ed. rev. 2004).

In addition, respondent is reminded that a responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question). See *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). Respondent is also reminded that, when a party, without substantial justification, fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not so disclosed. See Fed. R. Civ. P. 37(c)(1).

#### Consolidation

Fed. R. Civ. P. 42(a), as made applicable by Trademark Rule 2.116(a), provides with respect to consolidation of proceedings that, when actions involve a common question of

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law or fact, the Board may order a joint hearing or trial of any or all of the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.

It is adjudged that in Opposition No. 91124762 and Cancellation No. 92040092, there is a sufficient commonality of factual issues in the proceedings that consolidation is appropriate. Consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays.

Accordingly, Opposition No. 91124762 and Cancellation No. 92040092 are hereby consolidated and may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618

(TTAB 1989). From this date forward, **Opposition No. 91124762** will be designated the "parent" case in which all papers shall be filed. However, every paper must henceforth reference both proceeding numbers as shown in the caption of this order. The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42.

**Dates Reset**

Proceedings are resumed. Discovery is reopened for a limited period solely to allow petitioner to take discovery

Opposition No. 91124762 & Cancellation No. 92040092

on the issues raised by respondent's amended responses to petitioner's requests for admissions. If petitioner notices a deposition on written questions, petitioner must promptly inform the Board.

If respondent has not already supplemented its document production with the recently discovered documents referenced in respondent's response to petitioner's summary judgment motion, respondent has until THIRTY DAYS from the mailing date of this order to do so.<sup>7</sup>

Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE: **November 24, 2006**

Thirty-day testimony period for party in position of plaintiff to close: **February 22, 2007**

Thirty-day testimony period for party in position of defendant to close: **April 23, 2007**

Fifteen-day rebuttal testimony period to close: **June 7, 2007**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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<sup>7</sup> The parties should note that this is merely a scheduling order, and not an order compelling discovery.

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-02-01 13:15:29 ET

Serial Number: 74657998 Assignment Information

Registration Number: 2016976

Mark (words only): KAPALUA

Standard Character claim: No

Current Status: Registration canceled under Section 8.

Date of Status: 2006-09-28

Filing Date: 1995-03-13

Transformed into a National Application: No

Registration Date: 1996-11-19

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-09-28

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. INTERFASHION LTD. B.V.I.

**Address:**

INTERFASHION LTD. B.V.I.  
PASETA ESTATE, P.O. 3149  
ROAD TOWN, TORLOTA  
Br. Virgin Islands

**Legal Entity Type:** Ltd Liab Co

**State or Country Where Organized:** Not Provided

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**GOODS AND/OR SERVICES**

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**International Class:** 003

**Class Status:** Section 8 - Cancelled

laundry bleach and laundry detergent, perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentrifice

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)



**First Use in Commerce Date:** (DATE NOT AVAILABLE)

**International Class:** 025

**Class Status:** Section 8 - Cancelled

footwear, headwear, gloves

**Basis:** 44(e)

**First Use Date:** (DATE NOT AVAILABLE)

**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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#### ADDITIONAL INFORMATION

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**Translation:** "KAPALUA" means butterfly in the Hawaiian language.

**Foreign Registration Number:** 2039249

**Foreign Registration Date:** 1993-06-25

**Country:** Fed Rep Germany

**Foreign Expiration Date:** 2003-04-30

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#### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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#### PROSECUTION HISTORY

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2006-09-28 - Canceled Section 8 (6-year)

2006-02-19 - TEAS Change Of Correspondence Received

2005-12-01 - Attorney Revoked And/Or Appointed

2005-12-01 - TEAS Revoke/Appoint Attorney Received

2005-10-14 - Post Registration action mailed - Section 8

2005-01-26 - Response received to Post Registration action - Sections 8

2005-07-21 - Assigned To Paralegal

2005-01-26 - PAPER RECEIVED

2004-07-12 - Post Registration action mailed - Section 8

2003-05-19 - Section 8 (6-year) and Section 15 Filed

2003-05-19 - PAPER RECEIVED

2001-11-02 - Cancellation Instituted No. 999999

1996-11-19 - Registered - Principal Register

1996-06-17 - ITU claim deleted

- 1996-06-17 - Notice of Allowance canceled
- 1996-05-28 - Notice of allowance - mailed
- 1996-03-05 - Published for opposition
- 1996-02-02 - Notice of publication
- 1996-01-03 - Approved for Pub - Principal Register (Initial exam)
- 1995-11-03 - Communication received from applicant
- 1995-08-25 - Non-final action mailed
- 1995-08-24 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Joseph F. Schmidt

**Correspondent**

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