

ESTTA Tracking number: **ESTTA396217**

Filing date: **03/03/2011**

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

Proceeding	91124762
Party	Plaintiff Kapalua Land Company Ltd.
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Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Martin E. Hsia/
Date	03/03/2011
Attachments	Motion to Amend Cancellation and Opposition.pdf ( 5 pages )(228128 bytes ) Declaration of Martin E. Hsia.pdf ( 3 pages )(117882 bytes ) Exhibit A.pdf ( 11 pages )(420938 bytes ) Second Amended Petition to Cancel-Exhibits A-C.pdf ( 40 pages )(1654106 bytes ) Amended Notice of Opposition.pdf ( 5 pages )(160783 bytes ) Certificate of Service.pdf ( 1 page )(31183 bytes )

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

KAPALUA LAND COMPANY, LTD.,	)	
	)	
Opposer,	)	Opposition No.: 91124762
	)	Serial No. 76/023,641
v.	)	
	)	Cancellation No.: 92040092
INTERFASHION LTD. B.V.I.	)	Registration No. 2,115,124
	)	
Applicant.	)	
_____	)	

**OPPOSER’S MOTION TO AMEND CANCELLATION AND OPPOSITION**

Opposer and Petitioner KAPALUA LAND COMPANY, LTD. (“KLC”), by and through its undersigned counsel, hereby respectfully moves to amend pursuant to Rule 15(a), Fed. R. Civ. P.: (a) the First Amended Petition to Cancel<sup>1</sup> U.S. Trademark Registration Nos. 2,016,976 and 2,115,124 for “KAPALUA” originally issued to Kapalua Strickwaren GmbH (“Strickwaren”); and (b) the Notice of Opposition filed on October 31, 2001, opposing Application Serial No. 76/023,641 for “KAPALUA”, filed on or about April 11, 2000, by Interfashion Ltd. B.V.I. (“Interfashion”)<sup>2</sup>.

More specifically, Opposer seeks to further amend the cancellation petition, which is currently based on (1) Abandonment; (2) Likelihood of Confusion under Section 2(d) of the Trademark Act; (3) Dilution; and (4) Fraud in the filing of Registrant’s Section 8 Affidavit, to clarify, as suggested by the Board in its order of October 20, 2006 (copy attached hereto as

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<sup>1</sup> The First Amended Petition to Cancel was appended to KLC’s Motion to Amend Cancellation filed on January 31, 2006. That motion was granted pursuant to the Board’s order entered April 20, 2006.

<sup>2</sup> KLC has filed a Motion to Join DC Design & Concept GmbH as the apparent current Registrant and Applicant.

Exhibit “A”, at pp. 6-7), that the Abandonment claim includes abandonment due to non-use by a prior owner of the involved registration and a subsequent invalid assignment or assignments. The Board’s order had denied KLC’s motion for summary judgment “to the extent petitioner bases said [abandonment] 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.’ ” See Exhibit “A” attached hereto, at p. 6. However, the Board’s order went on to state that:

Petitioner should consider whether it will pursue at trial . . . abandonment related to chain of title issues or transfers of the involved registration. If petitioner intends to pursue the latter course, it should amend its petition for cancellation to reflect the change in focus.

In addition, this Motion seeks leave to amend the Notice of Opposition to add, as a further basis for the opposition to the subject intent-to-use application, the fact that at the times of various assignments of the application, both before and after the filing of the present opposition, there was not an ongoing and existing business (or portion thereof) to which the mark pertained, pursuant to Section 10 of the Trademark Act.

The proposed Second Amended Petition to Cancel and Amended Notice of Opposition are attached hereto (proposed new allegations underscored), and the Board is respectfully requested to allow the same to be substituted, respectively, for the Amended Petition to Cancel and the original Notice of Opposition, and to allow Applicant/Registrant time in which to answer the amended pleadings.

As grounds in support of this Motion and as confirmed by the attached Affidavit of Counsel, Opposer/Petitioner states as follows:

1. The undersigned counsel is newly appointed counsel for Opposer/Petitioner, and was not previously involved in this proceeding. The undersigned

counsel made its appearance in this proceeding on December 15, 2010. The files of KLC's former counsel in this matter were not available for review and use by the undersigned until January 6, 2011. Additional files and materials are still being received, including files from KLC's former General Counsel, which were received only last week, on February 24, 2011. These files contain, among other things, legal analysis by the former General Counsel relating to the issues in this proceeding that were not previously available or disclosed to the undersigned counsel.

2. Based on a review of these files, it appears that, for the past several years, the parties have suspended proceedings and extended the deadlines while engaged in extensive settlement negotiations. After the Board's order of October 20, 2006, denying Opposer/Petitioner's Motion for Summary Judgment and suggesting that it move to amend the Abandonment claim (and after the Board's order of May 5, 2008, denying Opposer/Petitioner's Motion for Summary Judgment on the grounds of res judicata), the parties have extended the deadlines in these proceedings for the stated purpose of settlement no fewer than eight times. See consented motions filed: June 11, 2008; January 12, 2009; April 9, 2009; July 8, 2009; September 24, 2009; January 25, 2010; April 28, 2010; and August 30, 2010. Thus, given the prospect of settlement, both parties have attempted to minimize and/or defer the expenditure of resources on trial preparation – including the preparation and submission of Opposer/Petitioner's Motion to Amend the pleadings.

3. As recently as January 12, 2011, and February 22, 2011, Opposer/Petitioner sent to Applicant/Registrant proposed settlement documents. A consented motion to extend deadlines for settlement was filed by the undersigned counsel on December 23, 2010. Unfortunately, it now appears that Applicant/Registrant, under apparent new

management, has rejected the proposed settlement terms, thus compelling Opposer/Petitioner and its newly appointed counsel to prepare for these proceedings.

4. Should the Motion be granted, Applicant/Registrant would not be prejudiced. The Motion essentially seeks to clarify the basis of the already existing Abandonment claim in the cancellation petition, in accordance with the Board's suggestion in its October 20, 2006 order. See Exhibit "A", at p. 7, attached hereto. The Board suggested that the claims be clarified by stating an additional basis – viz. "and/or abandonment related to chain of title issues or transfers of the involved registration." Id. These "abandonment related to chain of title issues" were central to Opposer/Petitioner's summary judgment motion on its Abandonment claim, and therefore, Applicant/Registrant has been aware of this issue for several years.

5. Moreover, Applicant/Registrant would not be prejudiced because it would not need time to conduct discovery on this issue. The chain of title documents and related information are items within the possession, custody, and control of Applicant/Registrant and its predecessors-in-interest.

Pursuant to Fed. R. Civ. P. Rule 15(a) and the general policy that "leave must be freely given when justice so requires," it is stated that "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02 (2d Ed. June 2003).

As shown above, the proposed amendments do not add a new claim to the cancellation petition; the Abandonment claim was already pled in the existing Amended Petition to Cancel. The proposed amendment to the cancellation petition merely clarifies the factual basis for the Abandonment claim, pursuant to the Board's suggestion. Moreover, although the

Section 10 claim was not pled in the Notice of Opposition (at least in part because some assignments took place after the filing of the Notice of Opposition), neither the addition of that statutory claim nor the requested clarification of the cancellation's Abandonment claim would be prejudicial to Applicant/Registrant.

It is recognized that there has been a long delay in the filing of this Motion. However, it would have made no sense to file it any sooner in view of the ongoing settlement discussions – discussions which have apparently been prolonged (and which only very recently have bogged down) under the new management of DC Design & Concept GmbH.

Given the policies favoring both the settlement of disputes and liberal amendment of pleadings, it is respectfully requested that: (a) this Motion be granted to allow the proposed amendments, as shown in the attached proposed Second Amended Petition to Cancel and Amended Notice of Opposition; (b) that Applicant/Registrant be given 30 days after entry of the Board's order to answer the amended pleadings; and (c) that the existing deadlines in this proceeding be reset accordingly.

DATED: Honolulu, Hawaii, March 3, 2011.



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KAPALUA LAND COMPANY, LTD.

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

KAPALUA LAND COMPANY, LTD.,	)	
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Opposer,	)	Opposition No.: 91124762
	)	Serial No. 76/023,641
v.	)	
	)	Cancellation No.: 92040092
INTERFASHION LTD. B.V.I.	)	Registration No. 2,115,124
	)	
Applicant.	)	
_____	)	

**DECLARATION OF MARTIN E. HSIA**

I, MARTIN E. HSIA, hereby declare as follows:

1. I am a partner of Cades Schutte A Limited Liability Law Partnership, counsel for Opposer/Petitioner KAPALUA LAND COMPANY, LTD. (“KLC”).
2. The undersigned counsel is newly appointed counsel for Opposer/Petitioner, and was not previously involved in this proceeding. The undersigned counsel made its appearance in this proceeding on December 15, 2010. The files of KLC’s former counsel in this matter were not available for review and use by the undersigned until January 6, 2011. Additional files and materials are still being received, including files from KLC’s former General Counsel, which were received only last week, on February 24, 2011. These files contain, among other things, legal analysis by the former General Counsel relating to the issues in this proceeding that were not previously available or disclosed to the undersigned counsel.
3. Based on a review of these files, it appears that, for the past several years, the parties have suspended proceedings and extended the deadlines while engaged in extensive settlement negotiations. After the Board’s order of October 20, 2006, denying Opposer/Petitioner’s Motion for Summary Judgment and suggesting that it move to amend the

Abandonment claim (and after the Board's order of May 5, 2008, denying Opposer/Petitioner's Motion for Summary Judgment on the grounds of res judicata), the parties have extended the deadlines in these proceedings for the stated purpose of settlement no fewer than eight times. See consented motions filed: June 11, 2008; January 12, 2009; April 9, 2009; July 8, 2009; September 24, 2009; January 25, 2010; April 28, 2010; and August 30, 2010. Thus, given the prospect of settlement, both parties have attempted to minimize and/or defer the expenditure of resources on trial preparation – including the preparation and submission of Opposer/Petitioner's Motion to Amend the pleadings.

4. As recently as January 12, 2011, and February 22, 2011, Opposer/Petitioner sent to Applicant/Registrant proposed settlement documents. A consented motion to extend deadlines for settlement was filed by the undersigned counsel on December 23, 2010. Unfortunately, it now appears that Applicant/Registrant, under apparent new management, has rejected the proposed settlement terms, thus compelling Opposer/Petitioner and its newly appointed counsel to prepare for these proceedings.

5. Should the Motion be granted, Applicant/Registrant would not be prejudiced. The Motion essentially seeks to clarify the basis of the already existing Abandonment claim in the cancellation petition, in accordance with the Board's suggestion in its October 20, 2006 order. See Exhibit "A", at p. 7, attached hereto. The Board suggested that the claims be clarified by stating an additional basis – viz. "and/or abandonment related to chain of title issues or transfers of the involved registration." Id. These "abandonment related to chain of title issues" were central to Opposer/Petitioner's summary judgment motion on its Abandonment claim, and therefore, Applicant/Registrant has been aware of this issue for several years.

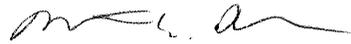
6. Moreover, Applicant/Registrant would not be prejudiced because it would not need time to conduct discovery on this issue. The chain of title documents and related

information are items within the possession, custody, and control of Applicant/Registrant and its predecessors-in-interest.

7. Attached hereto as Exhibit "A" is a true and correct copy of the Board's Order in this consolidated proceeding, dated October 20, 2006.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his own knowledge are true; and all statements made on information and belief are believed to be true.

Signed at Honolulu, Hawaii this 3rd day of March, 2011.



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MARTIN E. HSIA

32,471

# **EXHIBIT “A”**

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

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<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 A**

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.

Opposition No. 91124762 & Cancellation No. 92040092

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

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

Opposition No. 91124762 & Cancellation No. 92040092

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

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

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

Opposition No. 91124762 & Cancellation No. 92040092

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

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.

**SECOND AMENDED PETITION TO CANCEL  
EXHIBITS A-C**

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

KAPALUA LAND COMPANY, LTD.,	)	
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Opposer,	)	Opposition No.: 91124762
	)	Serial No. 76/023,641
v.	)	
	)	Cancellation No.: 92040092
INTERFASHION LTD. B.V.I.	)	Registration No. 2,115,124
	)	
Applicant.	)	
_____	)	

**SECOND AMENDED PETITION TO CANCEL**

Petitioner, Kapalua Land Company, Ltd., a limited liability corporation of Hawaii with its principal place of business in Maui, Hawaii (hereinafter “Petitioner” or “Kapalua”), petitions to cancel Registration Numbers 2,016,976 and 2,115,124 both for the trademark KAPALUA issued to the Registrant, Kapalua Strickwaren GmbH Ltd., a corporation of the Federal Republic of Germany with a principal place of business in Hamburg, Federal Republic of Germany (hereinafter “Registrant” or “KSG”), for the reasons set forth herein below.

Facts common to all allegations:

1. Kapalua is the owner and operator of KAPALUA, the internationally renowned resort in Maui, Hawaii, which Kapalua has operated since 1975. Kapalua has used the mark KAPALUA to identify its hotel and resort since at least 1975 and has used the mark KAPALUA on clothing products, soaps, shampoos and cosmetic products since at least as early as 1975. The trademark and service mark KAPALUA has become internationally well known and is a famous mark identifying Kapalua and products and services that originate from Kapalua.

2. The word KAPALUA is a word that has no meaning in any language, though it is identified on early maps of Maui as the name of a cove or beach on the property of the KAPALUA resort.

3. On information and belief, Registrant is a corporation of the Federal Republic of Germany and has no relationship to Hawaii or Petitioner.

4. Registration No. 2,016,976 is for the word trademark KAPALUA for the goods “laundry bleach and laundry detergent, perfumes, essential oils for personal use, lipstick, rouge, eyeliner, hair lotion, and dentrifice” in International Class 003 and for “footwear, headwear, gloves” in International Class 025. Registration No. 2,1 15,124 is for the word trademark KAPALUA for “clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, gloves, and hats” in Class 025.

#### **COUNT I - ABANDONMENT**

5. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in Registration No. 2,016,976, has not done so for more than three years and has no intention to use the mark on those goods in the future. On information and belief, KSG does not use the mark KAPALUA in the United States on the goods identified in registration No. 2,115,124 and has not used the mark on such goods for more than three years and has no intention to use the mark on those goods in the future.

6. On information and belief, the involved registrations were invalidly assigned, as the marks had been abandoned through non-use prior to the assignments.

7. 6.—The continued maintenance of Registration Nos. 2,016,976 and 2,115,124 for the mark KAPALUA by KSG for the goods identified in those registrations will preclude the registration and will threaten the use of the mark KAPALUA by Kapalua.

## **COUNT II- LIKELIHOOD OF CONFUSION**

8.     ~~7.~~—The marks of Kapalua and KSG are identical. As a result of Kapalua’s continued use of the trademark and service mark KAPALUA it has become internationally well known and is a famous mark identifying Kapalua and products and services that originate with Kapalua.

9.     ~~8.~~—On information and belief, if KSG uses its mark in the United States, the consumer for the goods of KSG will be the same or similar consumer of Kapalua’s goods and services.

10.    ~~9.~~—The continued maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the Principal Register is likely to cause confusion, and is likely to deceive and mislead consumers and should, therefore, be cancelled under Section 14 of the Lanham Act.

## **COUNT III - DILUTION**

11.    ~~10.~~—The service mark and trademark KAPALUA is a famous mark identifying Kapalua’s internationally famous resort and hotel on the island of Maui, Hawaii. Kapalua’s use of the KAPALUA trademark and service mark since 1975, and its extensive advertising and promotion of the mark throughout the United States and the world has caused the mark KAPALUA to become famous and to identify only Petitioner.

12.    ~~11.~~—The maintenance of the Registrations Nos. 2,016,976 and 2,115,124 on the Principal Register dilutes the fame of the mark KAPALUA of Petitioner for its like goods and services marketed to the same or similar consumers and said dilution will cause harm to the reputation and fame of the KAPALUA mark of Petitioner.

## **COUNT IV - FRAUD on the Patent and Trademark Office, Reg. No. 2,115,124**

13.    ~~12.~~—Respondent has committed fraud on the Patent and Trademark Office in its filing of its Section 8 Affidavit.

14. ~~13.~~ On May 19, 2004, Respondent filed its Declaration of Continued Use for Registration No. 2,115,124. Attached as Exhibit A is that filing. In that filing, Respondent declared that it was using the mark on all of the goods listed in the registration as of May 19, 2004.

15. ~~14.~~ On October 28, 2005, Petitioner served its First Set of Interrogatories on Respondent. See attached as Exhibit B. Respondent answered those Interrogatories on December 16, 2005. Attached as Exhibit C are those responses.

16. ~~15.~~ In its Responses to Petitioner's First Set of Interrogatories, Respondent provided the following answer to Interrogatory No. 3:

**Interrogatory No. 3**

Identify each product on which Respondent has used Respondent's Mark.

**Answer**

Pullovers, t-shirts and skirts.

17. ~~16.~~ Respondent's verified response to Interrogatory No. 3 contradicts the information provided in Respondent's Section 8 filing.

18. ~~17.~~ Respondent filed its Section 8 declaration and fraudulently declared it was using its mark on all the goods listed in Registration No. 2,115,124, namely, clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T shirts, socks, underwear, shoes, gloves, and hats. In its verified answers to Interrogatories served and answered in this case, Respondent indicated that it had only used the mark on pullovers, t-shirts and skirts.

19. ~~18.~~ By filing the incorrect Section 8 declaration, Respondent has committed fraud on the Patent and Trademark Office.

WHEREFORE, Petitioner respectfully requests this Honorable Trademark Trial and Appeal Board to cancel Registrations Nos. 2,016,976 and 2,115,124 from the Principal Register.

DATED: Honolulu, Hawaii, March 3, 2011.

Respectfully submitted,



---

Martin E. Hsia, Reg. No. 32,471

Colin O. Miwa

CADES SCHUTTE

A Limited Liability Law Partnership

P.O. Box 939

Honolulu, HI 96808

Tel: (808) 521-9200

Attorneys for Opposer and Petitioner  
KAPALUA LAND COMPANY, LTD.

~~1660631.1~~1660631.2

# **EXHIBIT “A”**

Tel: 631-549-4700  
Telefax: 631-549-0404

**Michael J. Striker**  
Attorney at Law  
103 East Neck Road  
Huntington  
New York  
11743

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

May 19, 2004

**Re: US Trademark Registration**  
**Reg. No.: 2,115,124**  
**TM: KAPALUA**  
**STYLE & SPIRIT GMBH**

Dear Sirs:

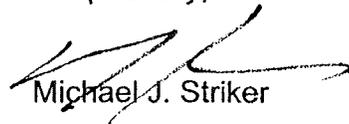
Please accept for filing the following:

- New Trademark Application
- Trademark Renewal
- Trademark Declaration of Use
- Trademark Statement of Use
- Request for Extension of Time

It is respectfully requested that the required fee be charged to the account of the undersigned (19-4675).

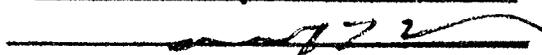
*Mail Stop: Post Reg Fee*

Respectfully,

  
Michael J. Striker

**Certificate of Mailing**

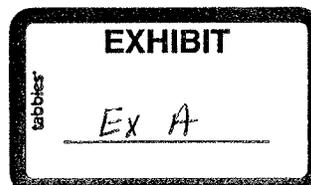
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Assistant Commissioner for Trademarks,  
2900 Crystal Drive, Arlington, VA 22202-3514.  
on 5/19/04





05-21-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #77



# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## TRANSMITTAL LETTER, DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED

Name of Owner: **STYLE & SPIRIT GMBH**Registration Number: **2,115,124**Trademark: **KAPALUA**International Class(es): **25**

### TO THE COMMISSIONER FOR TRADEMARKS:

Transmitted herewith is a Declaration of Use of a Mark under Section 8 and fee calculated as follows:

Total # Classes	Fee/class		
1	x	\$100.00	=
		<b>BASIC FEE</b>	<b>\$100.00</b>
<b>Check here if filing during grace</b>		<input checked="" type="checkbox"/>	<b>GRACE PERIOD FEE</b>
		<b>TOTAL FEE</b>	<b>\$200.00</b>

- A check in the amount of \_\_\_\_\_ is attached.
- Please charge Deposit Account No. **19-4675** in the amount of **\$200.00**
- The Director is hereby authorized to charge payment of any fees associated with this Declaration of Use or credit any overpayment to Deposit Account No. **19-4675**

#### Certificate of Mailing by Express Mail

I certify that this document and fee is being deposited on
(Date)
with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
_____ <i>Signature of Person Mailing Correspondence</i>
_____ <i>Typed or Printed Name of Person Mailing Correspondence</i>
_____ <i>"Express Mail" Mailing Label Number</i>

#### Certificate of Mailing by First Class Mail

I certify that this document and fee is being deposited on
MAY 19, 2004 (Date)
with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
_____ <i>Signature of Person Mailing Correspondence</i>
<b>MICHAEL J. STRIKER</b>
_____ <i>Typed or Printed Name of Person Mailing Correspondence</i>

Dated: **MAY 19, 2004**

  
Signature

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED  
(With Power of Attorney)

To The Commissioner for Trademarks

Docket No. **144**  
Trademark: **KAPALUA**

Registration Number: **2,115,124**  
Registration Date: **NOVEMBER 25, 1997**  
Name of Owner: **STYLE & SPIRIT GMBH**  
Address of Owner: **OBENHAUPTSTRASSE 15**  
**22335 HAMBURG**  
**GERMANY**

The Owner hereby appoints the below named domestic representative upon whom notice or process in the proceedings affecting the mark may be served.

Name of Domestic Rep.: **MICHAEL J. STRIKER**  
Address of Domestic Representative: **103 EAST NECK ROAD**  
**HUNTINGTON, NY 11743**

*(Required ONLY if the owner's address is outside the United States)*

The Owner is using the above-identified mark in commerce on or in connection with all goods listed in the above-identified registration, except for the following:

as evidenced by the attached specimen(s) showing the mark as currently used in commerce.

**DECLARATION**

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document, declares that I am properly authorized to execute this document on behalf of the Owner; and all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

Signature: \_\_\_\_\_

Name:

**MICHAEL J. STRIKER**

Title:

**AUTHORIZED ATTORNEY**

Date:

**MAY 19, 2004**

Indicate below the nature of authority under which signatory signs:

- A person with legal authority to bind the Owner; or
- A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the Owner; or
- An attorney as defined in 37 C.F.R. 10.1(c) who has an actual or implied written or verbal power of attorney from the Owner.

**Contact Information:**

Address all correspondence in this application to the following:

Name:

**MICHAEL J. STRIKER**

Company/Firm Name:

**STRIKER, STRIKER & STENBY**

Address Line 1:

**103 EAST NECK ROAD**

Address Line 2:

City:

**HUNTINGTON**

State:

**NY**

Country:

**USA**

ZIP Code/Postal Code:

**11743**

Telephone Number:

**(631) 549 4700**

Fax Number:

**(631) 549 0404**

Email Address:

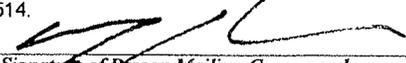
**STRIKER@STRIKERLAW.COM**

- Owner will accept correspondence by email.
- Owner will **not** accept correspondence by email.

**Send to:**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

**Certificate of Mailing by First Class Mail**

I certify that this document and fee is being deposited on
<b>MAY 19, 2004</b> <small>(Date)</small>
with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
 <i>Signature of Person Mailing Correspondence</i>
<b>MICHAEL J. STRIKER</b> <i>Typed or Printed Name of Person Mailing Correspondence</i>

**Certificate of Mailing by Express Mail**

I certify that this document and fee is being deposited on
<small>(Date)</small>
with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.
<i>Signature of Person Mailing Correspondence</i>
<i>Typed or Printed Name of Person Mailing Correspondence</i>
<i>"Express Mail" Mailing Label Number</i>

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

DECLARATION OF USE OF A MARK UNDER SECTION 8 OF THE TRADEMARK ACT OF 1946, AS AMENDED  
(With Power of Attorney)

Docket No.           **144**  
Trademark:           **KAPALUA**

Registration Number:   **2,115,124**  
Registration Date:      **NOVEMBER 25, 1997**  
Name of Owner:         **STYLE & SPIRIT GMBH**  
Address of Owner:      **OBENHAUPTSTRASSE 15**  
                              **22335 HAMBURG**  
                              **GERMANY**

\_\_\_\_\_  
TO THE COMMISSIONER OF TRADEMARKS

**POWER OF ATTORNEY**

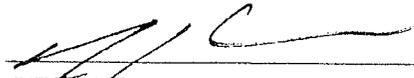
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Dear Sir:  
I hereby appoint:

**MICHAEL J. STRIKER**  
**REG. NO.: 27233**

as principal attorneys to submit this document and to transact all business in the Patent and Trademark Office connected therewith.

By:



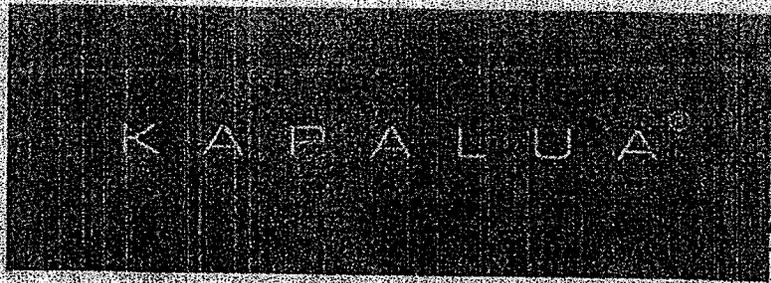
\_\_\_\_\_  
**MICHAEL J. STRIKER**  
as authorized attorney

Dated:   MAY 19, 2004



THIS BAG IS NOT A TOY. KNOT BAG BEFORE THROWING AWAY.  
 BABIES AND CHILDREN. DO NOT USE IN CRIBS, BEDS, CARRIAGES OR PLAY PENS.  
 WARNING: TO AVOID DANGER OF SUFFOCATION, KEEP THIS BAG AWAY FROM  
 THIS IS NOT A TOY.

CE SAC N'EST PAS UN JOUET. NOUVER CE SAC AVANT DE LE JETER.  
 LES LANDAIS OU LES PARCS D'ENFANTS.  
 NE SURTOUT PAS UTILISER CE SAC DANS LES BERCEAUX, LES LITS D'ENFANTS,  
 SAC À LA PORTE DE BÉBÉS OU D'ENFANTS.  
 ATTENTION: POUR ÉVITER TOUT DANGER DE SUFFOCATION, NE PAS LAISSER CE  
 CEOL N'EST PAS UN JOUET.



**QUALITY PRODUCT  
 DESIGNED IN GERMANY**

# **EXHIBIT “B”**

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

KAPALUA LAND Co. Ltd.

Petitioner,

v.

KAPULA STRICKENWAREN GmbH

Respondent.

Cancellation No. 92/040,092

**PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Trademark Rules 2.116 and 2.120, Petitioner hereby requests that Respondent answer separately and fully, in writing and under oath, each of the following interrogatories, and serve such answers on counsel for Petitioner within thirty days of service of these interrogatories. Respondent shall supplement and/or amend its responses to the interrogatories in accordance with Rule 26(e) of the Federal Rules of Civil Procedure.

**INSTRUCTIONS**

1. In answering these interrogatories, please furnish all information currently known or available to you or your attorneys.
2. Please record a separate answer for each interrogatory and interrogatory subpart. Please set forth and identify the source of each answer separately by identifying each person who you know has personal knowledge of the facts or information forming the basis of the answer which you give.

**EXHIBIT**

*B*

tabbles

3. If you contend that any information is protected by privilege, identify the privilege relied on, the persons who have the requested information and any document which contains the information, including for each document:

- a) the type of document;
- b) the author;
- c) the recipients;
- d) the date;
- e) the subject matter;
- f) the basis of the privilege.

4. If you are unable to respond fully to any interrogatory herein, you should respond to the extent possible and provide an explanation as to why a full response is not possible.

5. All interrogatories herein are directed to that information or those documents within your possession, custody or control, or within the possession, custody or control of your agents, servants and employees and, unless privileged, your attorney. They are also directed to those firms, corporations, partnerships, or trusts that you control and to documents in the possession, custody or control of the employees, agents, next friends, trustees, guardians and/or representatives of such entities.

6. These interrogatories shall be deemed to be continuing. Your attention is directed to Rule 26(e)(2) of the Federal Rules of Civil Procedure which provides as follows:

A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

### **DEFINITIONS**

The following definitions shall apply to these interrogatories and instructions thereto:

1. "You," "Your" or "Respondent" refers to Kapalua Strickenwaren GmbH and any successors, affiliates, agents, employees, distributors and representatives.

2. "Petitioner" refers to Kapalua Land Co., Ltd. and any of its employees and representatives.

3. "Document" means that the original and all non-identical copies of any writing of any kind, which is known by you to exist or to have existed or which at any time has been in your possession, custody, or control, including, but not limited to letters, envelopes, forms, affidavits, correspondence, telegraphs, telecopies, telefaxes, paper communications, signed statements, tabulations, charts, memoranda, checks, appointment books, records, proposals, memoranda or other transcripts by mechanical device, by long hand or short hand recording, tape recorded or by electronic or by any other means, computer generated information, computer software, data stored in a computer, intra-office communications, inter-office communications, all summaries of all communications, telephonic or otherwise, microfiche, microfilm, lists, bulletins, calendars, circulars, desk pads, opinions, ledgers, minutes, agreements, journals, diaries, contracts, invoices, balance sheets, telephone messages or other messages, magazines,

pamphlets, articles, notices, newspapers, studies, worksheets, telexes, cables and all other graphic materials, writings and instruments, however produced or reproduced. A document includes all documents appended thereto.

4. “Relating to” or “Relate to” means constituting, discussing, mentioning, containing, analyzing, embodying, reflecting, identifying, incorporating, describing, commenting on, referring to, considering, recommending, dealing with or pertaining to in whole or in part.

5. “Identify” with respect to persons 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, present or last known place of employment. Once a person has been identified in accordance with this paragraph, only the name of that person need to be listed in response to subsequent discovery requests in the identification of that person.

6. “Identify” with respect to each document means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) the author(s), addressee(s), and recipient(s).

7. “Identify” with respect to oral communications shall mean: (a) the communication medium, i.e., in person or telephonic; (b) the date of each such communication; (c) the full name and current business and residence address of those who were present at each communication; and (d) the substance and nature of each such communication.

8. “Person” means any natural person or any business, legal or governmental agency or association.

9. The connectors “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 its scope.

10. “Including” means including without limitation.

11. “Registration” means Registration Nos. 2,016,976 and 2,115,124.

12. “Respondent’s Mark” means the mark KAPALUA set forth in Registration Nos. 2,016,976 and 2,115,124.

13. “Commerce” is defined as set forth in 15 U.S.C. §1127.

14. Respondent’s Products shall mean those products of Respondent identified in Registration Nos. 2,016,976 and 2,115,124 that bear or are associated with Respondent’s Mark.

## **INTERROGATORIES**

### **INTERROGATORY NO. 1**

State the type of business in which Respondent is engaged, and identify any subsidiaries, parent companies or related companies which use Respondent’s Mark or any other name or mark in which the term KAPALUA appears.

### **INTERROGATORY NO. 2**

Identify the person(s) most knowledgeable about the selection, adoption, use and registration of Respondent’s Mark and identify all documents which are relevant to Respondent’s selection, adoption and use of Respondent’s Mark.

### **INTERROGATORY NO. 3**

Identify each product on which Respondent has used Respondent’s Mark.

INTERROGATORY NO. 4

With respect to each of the products identified in Registration Nos. 2,016,976 and 2,115,124, state for each such product whether Respondent has used Respondent's Mark in commerce in connection with each product and, if so, how the mark was used for each product in commerce, the date on which Respondent's Mark was first used in commerce on each product, and identify all documents evidencing and/or relating to the use of Respondent's Mark in connection with each identified product for each year from the alleged date of first use.

INTERROGATORY NO. 5

For each product identified in Registration Nos. 2,016,976 and 2,115,124 state if the use of the Respondent's Mark has been continuous.

INTERROGATORY NO. 6

For each product listed in Registration No. 2,016,976, indicate the first sale date in the United States for such product.

INTERROGATORY NO. 7

For each product listed in Registration No. 2,115,124, indicate the first sale date in the United States for such product.

INTERROGATORY NO. 8

If Respondent asserts a different date than set forth in answer to Interrogatory Nos. 5 and 6 for its first sales in "commerce", state such date for each product and describe such sales.

INTERROGATORY NO. 9

State in round numbers the dollar amount of gross sales in commerce in connection with each product rendered under Respondent's Mark for each year beginning with the date of first use.

INTERROGATORY NO. 10

Identify all documents on which Respondent relies to establish its sales of each of Respondent's Products in commerce.

INTERROGATORY NO. 11

Identify all media forms in which Respondent's Products have been advertised or promoted in connection with Respondent's Mark through the date of response to this Interrogatory.

INTERROGATORY NO. 12

State in round numbers the dollar amount Respondent has expended in connection with each medium identified in response to the preceding interrogatory for each year beginning with the date of first use of the Respondent's Mark in connection with such product up to the present.

INTERROGATORY NO. 13

Identify all documents relating to or referring to expenditures for advertising and/or promoting Respondent's Products under Respondent's Mark.

INTERROGATORY NO. 14

(a) Describe the channels of distribution through which Respondent's Products are sold under Respondent's Mark and identify the types of classes of purchasers or prospective purchasers of such products at each level of distribution.

(b) Describe the demographics of the typical consumer of Respondent's Products.

INTERROGATORY NO. 15

Identify all web sites where goods bearing Respondent's Mark have been available and/or are currently available.

INTERROGATORY NO. 16

- (a) State if Respondent has a web site.
- (b) If so, what is the domain name?
- (c) If so, how long has Respondent's website been active?
- (d) If so, can a consumer order Respondent's Products on-line or is the website only for promotional purposes?
- (e) If so, identify the dollar amount of sales of Respondent's Products through Respondent's website.
- (f) If so, identify customers in the U.S. who purchase Respondent's Products through Respondent's website.

INTERROGATORY NO. 17

Identify every trade show or meeting of any type where Respondent has displayed, advertised and/or promoted its products in association with Respondent's Marks and for each:

- (a) state the years Respondent attended each such show or meeting; and identify all documents relating to or referring to each such show or meeting identified in this interrogatory.

INTERROGATORY NO. 18

Identify representative samples of advertisements, labels, brochures, catalogs, packages or other physical indicia employed by Respondent in the use of Respondent's Mark for each of the products listed in Respondent's registrations involved herein.

INTERROGATORY NO. 19

Identify each and every U.S. retailer of Respondent's Products.

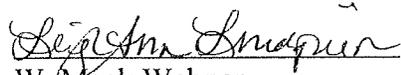
INTERROGATORY NO. 20

Identify all persons who participated in answering the foregoing interrogatories.

Respectfully submitted,

KAPALUA LAND COMPANY, LTD.

By:



W. Mack Webner

Leigh Ann Lindquist

SUGHRUE, MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037-3202

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

Attorneys for Petitioner

Date: October 28, 2005

**CERTIFICATE OF SERVICE**

I, Leigh Ann Lindquist, Esquire, hereby certify that on this 28<sup>th</sup> day of October, 2005, true and correct copies of the foregoing **PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT and PETITIONER'S FIRST REQUEST FOR PRODUCTION OF DOCUMENT'S AND THINGS** have been properly served, via First Class U.S. Mail, postage prepaid to:

Michael J. Striker  
103 East Neck Road  
Huntington, New York 11743  
Attorney for Respondent

  
\_\_\_\_\_  
Leigh Ann Lindquist

# **EXHIBIT “C”**

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

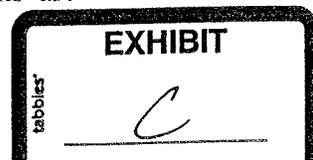
KAPALUA LAND CO., LTD.	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92/040,092
	)	
KAPALUA STRICKENWAREN GmbH	)	
	)	
Respondent.	)	

**RESPONDENT'S ANSWERS TO PETITIONER'S  
FIRST SET OF INTERROGATORIES TO RESPONDENT, NOS. 1-20**

Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Respondent, by and through its attorneys MICHAEL BEST & FRIEDRICH, LLP, 401 North Michigan Avenue, Suite 1900, Chicago, Illinois 60611, hereby answers Petitioner's First Set of Interrogatories as follows:

Each answer is subject to all objections as to competence, relevance, materiality, propriety and admissibility, and to any and all other objections on any grounds that would require the exclusion of any statements contained herein if such answers were asked of, or statements contained herein were made by, a witness present and testifying in court, all of which objections and grounds are expressly reserved and may be interposed at the time of trial. The answers given herein are without prejudice to respondent's right to supplement or to revise these answers if further investigation or discovery so indicates.

Respondent's answers shall not be deemed to constitute an admission (i) that any particular information or document(s) exists, is relevant, non-privileged, or admissible in evidence, or (ii) that any statement or characterization in Petitioner's interrogatories is accurate or complete. In addition, willingness to produce documents in answer to any particular request is in no way a concession that such documents exist, or that any such documents are within respondent's possession, custody or control.



## GENERAL OBJECTIONS

A. Respondent objects to these discovery requests to the extent they purport to impose obligations beyond those imposed by the Federal Rules of Civil Procedure and by the Local Rules of this Court.

B. Respondent objects to these discovery requests to the extent that they seek information which does not appear reasonably calculated to lead to discovery of admissible evidence and, thus, are not within the scope of permissible discovery under Rule 26 of the Federal Rules of Civil Procedure.

C. Respondent objects to these discovery requests to the extent the requests seek information and documents protected by the attorney-client privilege, the attorney work-product immunity, or any other privilege or immunity.

D. Respondent objects to these discovery requests to the extent the requests seek information and documents in respondent's possession, the disclosure of which is subject to or precluded by restrictions of confidentiality imposed by, or pursuant to an agreement with, a third party.

E. Respondent will respond to these discovery requests based upon its current understanding of the facts of the case and the investigation it has conducted to date. Respondent specifically reserves the right to revise, correct, supplement or clarify any of these answers at any time during the discovery and trial preparation processes. Respondent objects to these discovery requests to the extent that they are inconsistent with these conditions.

Respondent specifically incorporates each of these General Objections into its specific answers to each of respondent's discovery requests, whether or not each such General Objection is expressly referred to in respondent's answer to a specific discovery request.

INTERROGATORY NO. 1

State the type of business in which Respondent is engaged, and identify any subsidiaries, parent companies or related companies which use Respondent's Mark or any other name or mark in which the term KAPALUA appears.

ANSWER:

Manufacture and distribution of clothing.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption, use and registration of Respondent's Mark and identify all documents which are relevant to Respondent's selection, adoption and use of Respondent's Mark.

ANSWER:

Ms. Tan. In lieu of identifying documents, respondent will make available for inspection and copying non-privileged documents responsive to this request subject to entry of a protective order.

INTERROGATORY NO. 3

Identify each product on which Respondent has used Respondent's Mark.

ANSWER:

Pullovers, t-shirts and skirts.

INTERROGATORY NO. 4

With respect to each of the products identified in Registration Nos. 2,016,976 and 2,115,124, state for each such product whether Respondent has used Respondent's Mark in commerce in connection with each product and, if so, how the mark was used for each product in commerce, the date on which Respondent's Mark was first used in commerce on each product, and identify all documents evidencing and/or relating to the use of Respondent's Mark in connection with each identified product for each year from the alleged date of first use.

**ANSWER:**

The mark has been used in commerce on pullovers, t-shirts and skirts. The date of first use is at least as early as 1994. Respondent objects to identifying all documents “evidencing and/or relating to the use of Respondent’s Mark in connection with each identified product for each year from the alleged date of first use” on the ground that this request is overly burdensome. Without waiving this objection and in lieu of identifying documents, respondent will make available for inspection and copy representative documents after a Protective Order is agreed to and entered. Respondent will also make available for inspection and copying documents showing how the mark was used for each product.

**INTERROGATORY NO. 5**

For each product identified in Registration Nos. 2,016,976 and 2,115,124 state if the use of the Respondent’s Mark has been continuous.

**ANSWER:**

No.

**INTERROGATORY NO. 6**

For each product listed in Registration No. 2,016,976, indicate the first sale date in the United States for such product.

**ANSWER:**

Unknown.

**INTERROGATORY NO. 7**

For each product listed in Registration No. 2,115,124, indicate the first sale date in the United States for such product.

**ANSWER:**

Respondent objects to this interrogatory on the ground that it is redundant of Interrogatory No. 4. Notwithstanding this objection, the first sale was at least as early as 1994.

**INTERROGATORY NO. 8**

If Respondent asserts a different date than set forth in response to Interrogatory Nos. 5 and 6 for its first sales in “commerce”, state such date for each product and describe such sales.

**ANSWER:**

No response required.

**INTERROGATORY NO. 9**

State in round numbers the dollar amount of gross sales in commerce in connection with each product rendered under Respondent’s Mark for each year beginning with the date of first use.

**ANSWER:**

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 10**

Identify all documents on which Respondent relies to establish its sales of each of Respondent’s Products in commerce.

**ANSWER:**

In lieu of identifying such documents, respondent will make available for inspection and copying non-privileged documents responsive to this interrogatory upon entry of a Protective Order by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 11

Identify all media forms in which Respondent's Products have been advertised or promoted in connection with Respondent's Mark through the date of response to this Interrogatory.

ANSWER:

Respondent is checking its records and will supplement this response in due course.

INTERROGATORY NO. 12

State in round numbers the dollar amount Respondent has expended in connection with each medium identified in response to the preceding interrogatory for each year beginning with the date of first use of the Respondent's Mark in connection with such product up to the present.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 13

Identify all documents relating to or referring to expenditures for advertising and/or promoting Respondent's Products under Respondent's Mark.

ANSWER:

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

INTERROGATORY NO. 14

- (a) Describe the channels of distribution through which Respondent's Products are sold under Respondent's Mark and identify the types of classes of purchasers or prospective purchasers of such products at each level of distribution.
- (b) Describe the demographics of the typical consumer of Respondent's Products.

ANSWER:

- (a) This information is being gathered and respondent will supplement this answer in due course.
- (b) This information is being gathered and respondent will supplement this answer in due course.

INTERROGATORY NO. 15

Identify all web sites where goods bearing Respondent's Mark have been available and/or are currently available.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 16

- (a) State if Respondent has a web site.

ANSWER:

Yes

- (b) If so, what is the domain name?

**ANSWER:**

**www.kapalua.de**

- (c) If so, how long has Respondent's website been active?

**ANSWER:**

Respondent is checking its records and will supplement this answer in due course.

- (d) If so, can a consumer order Respondent's Products on-line or is the website only for promotional purposes

**ANSWER:**

Respondent is checking its records and will supplement this answer in due course.

- (e) If so, identify the dollar amount of sales of Respondent's Products through Respondent's website,

**ANSWER:**

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

- (f) If so, identify customers in the U.S. who purchase Respondent's Products through Respondent's website.

**ANSWER:**

The information requested is confidential. Respondent defers disclosing such information until a suitable Protective Order is entered by the Trademark Trial and Appeal Board.

**INTERROGATORY NO. 17**

Identify every trade show or meeting of any type where Respondent has displayed, advertised and/or promoted its products in association with Respondent's Marks and for each:

**ANSWER:**

Respondent is checking its records and will supplement this answer in due course.

- (a) state the years Respondent attended each such show or meeting; and identify all documents relating to or referring to each such show or meeting identified in this interrogatory.

**ANSWER:**

Respondent is checking its records and will supplement this answer in due course.

**INTERROGATORY NO. 18**

Identify representative samples of advertisements, labels, brochures, catalogs, packages or other physical indicia employed by Respondent in the use of Respondent's Mark for each of the products listed in Respondent's registrations involved herein.

**ANSWER:**

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 19

Identify each and every U.S. retailer of Respondent's Products.

ANSWER:

Respondent is checking its records and will supplement this answer in due course.

INTERROGATORY NO. 20

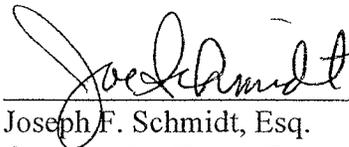
Identify all persons who participated in answering the foregoing interrogatories.

ANSWER:

Respondent will supplement its answer when it supplements the preceding interrogatory.

December 16, 2005

By:



Joseph F. Schmidt, Esq.

Gretchen M. Hosty, Esq.

**MICHAEL BEST & FRIEDRICH LLP**

401 North Michigan Avenue, Suite 1900

Chicago, IL 60611

(312) 661-2100

(312) 222-0818 (fax)

Attorneys for Respondent

**VERIFICATION**

I, \_\_\_\_\_, declare as follows:

1. I am the \_\_\_\_\_ of \_\_\_\_\_, the Respondent in this proceeding.

2. Respondent's Answers to Petitioner's First Set of Interrogatories to Respondent, Nos. 1-20 were prepared by counsel in consultation with me.

3. The facts stated in the Answers are based in part on the business records of \_\_\_\_\_ and in part upon my personal knowledge.

4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

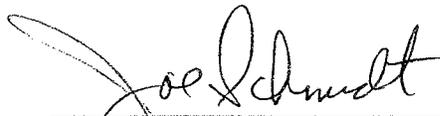
\_\_\_\_\_

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of **RESPONDENT'S ANSWERS TO PETITIONER'S FIRST SET OF INTERROGATORIES TO RESPONDENT, NOS. 1-20** was served by first class mail, postage pre-paid, on this 16<sup>th</sup> day of December upon:

W. Mack Webner  
Leigh Ann Lindquist  
SUGHRUE, MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3202

via first class mail, postage prepaid, this 16th day of December 2005.

  
\_\_\_\_\_  
One of the Attorneys for Respondent

VERIFICATION

I, Nicolaus Reusch, declare as follows:

1. I am the Managing Director of STYLE & SPIRIT GmbH, the Respondent in this proceeding.
2. Respondent's Answers to Petitioner's First Set of Interrogatories to Respondent, Nos. 1-20 were prepared by counsel in consultation with me.
3. The facts stated in the Answers are based in part on the business records of STYLE & SPIRIT GmbH and in part upon my personal knowledge.
4. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

22.12.05



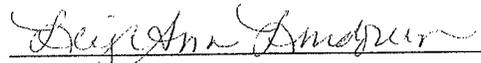
N. Reusch

Attorney Ref.: 500162

**CERTIFICATE OF SERVICE**

I, Leigh Ann Lindquist, hereby certify that on January 31, 2006, a true copy of **PETITIONER'S MOTION TO AMEND CANCELLATION** with enclosures was sent via First Class U.S. Mail, postage prepaid to:

Joseph F. Schmidt  
Michael Best & Friedrich, LLP  
401 N. Michigan Avenue, Suite 1900  
Chicago, IL 60611

  
\_\_\_\_\_  
Leigh Ann Lindquist

**AMENDED NOTICE OF OPPOSITION**



2. As a result of Opposer's long use of its KAPALUA mark and its extensive advertising and promotion of the various products in the clothing, leather goods, bags, eyeglasses, clocks and watches, jewelry, soaps, shampoos, cosmetics and related fields under that mark, KAPALUA has become exclusively associated with products originating with Opposer, has become extremely well-known to the public and has become famous.

3. Notwithstanding Opposer's long prior use of KAPALUA for clothing, leather goods, bags, eyeglasses, clocks and watches, jewelry, soaps, shampoos, cosmetics and related products, on April 11, 2000, Applicant filed an application for the mark KAPALUA. That application was filed based on an intent to use and covers the goods described as "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," in International Class 003, "eyeglass frames and cases," in International Class 009, "precious metals and their alloys; goods of precious metals or coated therewith, namely, jewelry, ashtrays, belts for clothing, candelsticks [sic] cigarette holders; jewelry precious gemstones, horological and chronometers instruments, namely, clocks, watches and chronometers," in International Class 014, "leather and imitation leather sold in bulk; leather and imitation leather goods, namely, handbags, tote bags, shopping bags, keyfobs, purses, trunks and traveling bags, umbrellas, parasols and walking sticks," in International Class 018, "clothing, namely, dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, socks, underwear, shoes, footwear, headwear," in International Class 025, and "dental floss," in International Class 021. The application was published on October 2, 2001.

4. Applicant's registration and use of KAPALUA is likely to cause confusion of the purchasing public as to the source or origin of the goods bearing its mark, and/or the

relationship between Applicant and Opposer, and/or whether Applicant is related to, licensed by or operates and sells its said equipment under the authority of Opposer when in truth and fact Applicant's goods do not originate with Opposer, Opposer is not related to Applicant, and Opposer has not approved or licensed Applicant's use of the word KAPALUA.

5. Opposer's KAPALUA trademark is well-known and famous as defined in Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). KAPALUA identifies Opposer as the source of the goods bearing this mark.

6. Applicant filed its intent to use application for registration of KAPALUA well after the Opposer's KAPALUA mark became famous. Applicant's registration and use of the KAPALUA mark will also have occurred well after the Opposer's KAPALUA mark became famous and will cause dilution of the distinctive quality of Opposer's trademark resulting in injury to the Opposer.

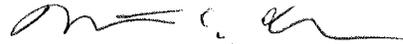
7. On information and belief, Applicant adopted the trademark KAPALUA with full knowledge of Opposer's use of KAPALUA, and notwithstanding this knowledge, adopted and applied for registration of the mark KAPALUA recognizing that the public would erroneously believe that the Applicant's goods were made by Opposer with the intent to capitalize on Opposer's good name and the goodwill associated therewith.

8. Applicant is not entitled to registration of KAPALUA because, on information and belief, the subject Application Serial No. 76/023,641 is an intent-to-use application that was invalidly assigned where there was not an ongoing and existing business (or portion thereof) to which the mark pertained, pursuant to Section 10 of the Trademark Act.

WHEREFORE, Opposer believes that it will be damaged by the registration of the Applicant's mark and prays that this Opposition be sustained and the registration of Application No. 76/023,641 be denied.

DATED: Honolulu, Hawaii, March 3, 2011.

Respectfully submitted,



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Martin E. Hsia, Reg. No. 32,471  
Colin O. Miwa  
CADES SCHUTTE  
A Limited Liability Law Partnership  
P.O. Box 939  
Honolulu, HI 96808  
Tel: (808) 521-9200

Attorneys for Opposer and Petitioner  
KAPALUA LAND COMPANY, LTD.

~~1632502.1~~1632502.2

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

KAPALUA LAND COMPANY, LTD.,	)	
	)	
Opposer,	)	Opposition No.: 91124762
	)	Serial No. 76/023,641
v.	)	
	)	Cancellation No.: 92040092
INTERFASHION LTD. B.V.I.	)	Registration No. 2,115,124
	)	
Applicant.	)	
_____	)	

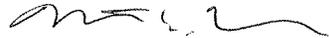
**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on this date, a true and correct copy of the foregoing was duly served by electronic mail and U.S. first class mail, postage prepaid, addressed as follows:

JOSEPH F. SCHMIDT, ESQ.  
Husch Blackwell Sanders Welsh & Katz  
120 South Riverside Plaza, 22<sup>nd</sup> Floor  
Chicago, IL 60606-3912

Attorney for Applicant and Respondent

DATED: Honolulu, Hawaii, March 3, 2011.



\_\_\_\_\_  
Martin E. Hsia, Reg. No. 32,471  
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