

ESTTA Tracking number: **ESTTA551997**

Filing date: **08/03/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Kai, LLC
Granted to Date of previous extension	08/03/2013
Address	3003 Malibu Canyon Road Malibu, CA 90265 UNITED STATES
Correspondence information	Shaun Murphy, E75sq. Attorney of Record Slovak Baron Empey Murphy & Pinkney 1800 E. Tahquitz Canyon Way Palm Springs, CA 92262 UNITED STATES murphy@sbemp.com, m3btmks@me.com Phone:760.322.22

Applicant Information

Application No	85779409	Publication date	06/04/2013
Opposition Filing Date	08/03/2013	Opposition Period Ends	08/03/2013
Applicant	Intrawest Honua Kai Hospitality Management LLC 1621 18th Street, Suite 300 Denver, CO 80202 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Bar soap; Body lotions; Body masks; Body scrub; Facial beauty masks; Facial scrubs; Foot scrubs; Hair shampoos and conditioners; Lotions for face and body care; Skin masks
Class 025. All goods and services in the class are opposed, namely: Bathrobes; Hats; Polo shirts; T-shirts; Visors

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2638344	Application Date	09/25/2000
Registration Date	10/22/2002	Foreign Priority Date	NONE
Word Mark	KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1998/12/15 First Use In Commerce: 1998/12/15 Perfume		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	KAI		
Goods/Services	Clothing		

U.S. Application No.	85038236	Application Date	05/13/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	KAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand cr�me, body butter, body wash, soap, fragrance infused sponges, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skincare preparations for face and body, body glow, shaving preparations, shaving gel and cream, body and skin beauty care preparations, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations</p> <p>Class 004. First use: Candles</p>		

U.S. Registration No.	4264957	Application Date	05/13/2010
Registration Date	12/25/2012	Foreign Priority Date	NONE
Word Mark	KAI BY GAYE STRAZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2011/06/01 First Use In Commerce: 2011/06/01 Fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand		

	<p>crème, body butter, body wash, soap, fragrance infused sponges primarily used for imparting fragrance, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skin care preparations for face and body, body glow, shaving preparations, shaving gel and cream, body and skin beauty care preparations, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations</p> <p>Class 004. First use: First Use: 2011/06/01 First Use In Commerce: 2011/06/01</p> <p>Candles</p>
--	-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

U.S. Application No.	85317593	Application Date	05/10/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	KAI TERRE BY GAYE STRAZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use:</p> <p>Fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand crème, body butter, body wash, soap, fragrance infused sponges primarily used for imparting fragrance, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skin care preparations for face and body, body glow, shaving preparations, shaving gel and cream, cosmetic preparations for body care and skin beauty care, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations</p> <p>Class 004. First use:</p> <p>Candles</p>		

Attachments	Executed Intrawest Notice of Opposition.pdf(188487 bytes)
-------------	------------------------------------------------------------

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/
Name	Shaun Murphy, E75sq.
Date	08/02/2013

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

Kai, LLC,)	
)	
Opposer,)	In the Matter of Application
v.)	Serial No. 85779409
)	for the Mark SPA HONUA KAI
Intrawest Honua Kai Hospitality)	
Management,)	Published in the Official Gazette
)	on June 4, 2013
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Kai, LLC, a California limited liability company, having a principal place of business at 3003 Malibu Canyon Road, Malibu, California 90265 (“Opposer”), believes that it would be damaged by registration of the mark KAI (Stylized), which mark is the subject of U.S. Trademark Application No. 85685828, filed by The Madden Corporation, a Hawaii corporation, and which mark was published for opposition in the *Official Gazette* on May 9, 2013.

The grounds for the Opposition are as follows:

1. Kai, LLC, through its predecessor in interest and title, and through its licensees (hereinafter individually and/or collectively referred to as “Opposer”), has been engaged in the manufacture and sale of fragrance since 1998 and beauty and body care products since 2003. Opposer’s products are marketed and sold on a nationwide basis and have been the subject of numerous unsolicited media features and stories.
2. Opposer has adopted and uses the mark KAI to identify its fragrance and beauty and body care products manufactured and sold by Opposer.

3. Opposer has, by virtue of extensive usage, advertising and promotion, built up a high level of consumer and trade recognition symbolized by its trade name and trademark KAI, and variants thereof, for its wide range of products. Due to public exposure to and awareness by consumers of the trade name and trademark KAI, such name and mark is famous and has acquired and now possesses an extremely favorable reputation and distinctiveness with an invaluable amount of goodwill, solely signifying Opposer as the source of high quality products.

4. Opposer has used the trade name and trademark KAI continuously in connection with perfume since 1998 and in connection with a range of beauty and body care products, namely, creams, lotions, sprays, body scrubs, home fragrance and candles, since at least 2003, and long prior to Applicant's filing date.

5. Opposer is the owner of U.S. Trademark Registration No. 2638344 issued on October 22, 2022 for the mark KAI for *perfume* in Class 003. The '344 Registration is valid, subsisting, in full force and effect, and is incontestable under Section 15 of the Lanham Act.

6. Opposer is the owner of the U.S. Trademark Application No. 85038236 which was filed on May 13, 2012 and Allowed on March 22, 2011, for the mark KAI for *fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand crème, body butter, body wash, soap, fragrance infused sponges, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skincare preparations for face and body, body glow, shaving preparations, shaving gel and cream, body and skin beauty care preparations, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential*

oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations in Class 003 and candles in Class 004.

7. Opposer is the owner of the U.S. Trademark Registration No. 4264957 which issued on December 25, 2012 for the mark KAI BY GAYE STRAZA for *fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand crème, body butter, body wash, soap, fragrance infused sponges primarily used for imparting fragrance, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skin care preparations for face and body, body glow, shaving preparations, shaving gel and cream, body and skin beauty care preparations, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations in Class 003 and candles in Class 004.*

8. Opposer is the owner of the U.S. Trademark Application No. 85317593, which was filed on May 10, 2011 and Allowed on November 29, 2011, for the mark KAI TERRE BY GAYE STRAZA for *fragrance, perfume, eau de parfum, eau de toilette, cologne, body lotion, hand crème, body butter, body wash, soap, fragrance infused sponges primarily used for imparting fragrance, body soap for bath and shower, deodorant for personal use, body fragrant mist, bubble bath, bath gels, bath salts, shampoo, conditioner, oils for hair treatment, hair care lotion, body scrub, non-medicated body soaks, linen soap and detergent, scented room and linen spray, lip conditioner, lip scrub, sun care lotions, nail polish, non-medicated skin care preparations for face and body, body glow, shaving preparations, shaving gel and cream,*

cosmetic preparations for body care and skin beauty care, liquid hand soap, sunscreen, tanning oils and lotions, hair care lotions, creams and gels; potpourri, incense, scented oils, essential oils for household use, sachets, room fragrances, bath and bar soap, and, household cleaning preparations in Class 003 and *candles* in Class 004 (hereinafter all of the above referenced KAI trademarks and variants thereof, including those registered and/or used in commerce by Opposer, and the trade name KAI, are referred to individually and/or collectively as the “KAI Marks”).

9. Applicant seeks to register the mark SPA HONUA KAI as a trademark for *bar soap, body lotions, body masks, body scrub, facial beauty masks, facial scrubs, foot scrubs, hair shampoos and conditioners, lotions for face and body care, and skin masks.*

10. The opposed Application was filed on November 14, 2012 based upon use in commerce in connection with the above referenced goods.

11. Opposer has priority over Applicant because its use, application filing dates and/or registration date for the KAI Marks long precede Applicant’s filing date for its application and/or any subsequent claimed use by Application of the purported mark SPA HONUA KAI.

12. Registration of the SPA HONUA KAI mark is barred by the provisions of Section 2(d) of the Lanham Act because the said mark consists of or comprises a mark which identical to a mark previously used in commerce in the United States by Opposer, and previously registered in the United States by Opposer, and not abandoned, as to be likely, when used in connection with Applicant’s goods, to cause confusion, mistake and/or deception.

13. Applicant’s mark SPA HONUA KAI is confusingly similar to Opposer’s aforementioned previously used and registered KAI Marks.

14. Applicant’s alleged mark SPA HONUA KAI so resembles Opposer’s aforementioned previously used and/or registered and famous KAI Marks, as to be likely to

cause confusion, to cause mistake or to deceive. The likelihood of confusion, mistake or deception that would arise from concurrent use and registration of Applicant's mark SPA HONUA KAI with Opposer's use and registration of its KAI Marks is that persons are likely to believe that Applicant and its goods are in some way legitimately connected or affiliated with, sponsored, approved, endorsed or licensed by Opposer when, in fact, they are not.

15. Opposer's goods offered in connection with the KAI Marks are identical or closely related to the opposed goods recited in Application Serial No. 85779409, and on information and belief, are or will be offered to the same class of customers through the same channels of trade.

16. If Applicant uses its mark SPA HONUA KAI in connection with the goods recited in Application Serial No. 85779409, such use would be likely to cause confusion, mistake, and/or deception of the relevant trade and public. Customers and potential customers are likely to believe that Applicant's goods offered under the mark SPA HONUA KAI mark emanate from, or are licensed or approved by Opposer, when, in fact, they are not. Such confusion, mistake and/or deception would be a source of damage to Opposer.

17. Deficiencies or faults in the quality of Applicant's goods or services are likely to reflect negatively upon, tarnish and seriously injure the reputation which Opposer has established for the goods sold in connection with the KAI Marks. This injury is likely to result in loss of revenues to Opposer and damage Opposer's reputation.

18. Accordingly, registration of Applicant's alleged mark SPA HONUA KAI is barred by the provisions of Section 2(d) and Section 43(a) of the Lanham Act.

19. Further, Opposer's distinctive trade name and trademark KAI became famous long prior to the filing date of Application Serial No. 85779409, as well as any claimed dates of

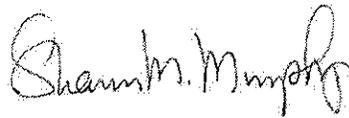
first use, and the registration and use of Applicant's alleged mark SPA HONU A KAI is likely to dilute the distinctive quality of Opposer's trade name and trademark KAI. Accordingly, Applicant's alleged mark SPA HONU A KAI is not entitled to registration under Section 43(a) of the Lanham Act.

WHEREFORE, Opposer prays that Application Serial No. 85779409 be rejected, and that registration of the mark SPA HONU A KAI be denied and refused.

This Notice of Opposition is being filed electronically pursuant to the ESTTA system.

Respectfully submitted,

KAI, LLC



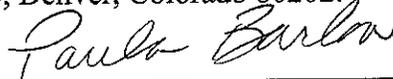
Date: August 1, 2013

By: _____

Shaun M. Murphy, Esq.
Slovak Baron Empey Murphy & Pinkney LLP
Attorney for Opposer
1800 East Tahquitz Canyon Way
Palm Springs, California 92262
Tel: 760-322-2275
Fax: 760-322-2107

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 1st day of August, 2013, a true and complete copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage pre-paid on, Rima E. L. Schafer, CIPP/US, Corporate Counsel and Chief Privacy Officer, Intrawest, 1621 18th Street, Suite 300, Denver, Colorado 80202.



Name: Paula Barlow