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Filing date: **09/16/2014**

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

Proceeding	91213744
Party	Defendant Pearl Enterprises, LLC
Correspondence Address	CHRISTOHER R KINKADE FOX ROTHSCHILD LLP 997 LENOX DRIVE, BUILDING 3 LAWRENCEVILLE, NJ 08648 UNITED STATES ckinkade@foxrothschild.com, mleonard@foxrothschild.com, ipdocket@foxrothschild.com
Submission	Answer and Counterclaim
Filer's Name	Christopher R. Kinkade
Filer's e-mail	ipdocket@foxrothschild.com, ckinkade@foxrothschild.com, smooore@foxrothschild.com
Signature	/Christopher R. Kinkade/
Date	09/16/2014
Attachments	Answer and Counterclaim with Exhibits.pdf(1121451 bytes)

Registration Subject to the filing

Registration No	3943580	Registration date	04/12/2011
Registrant	Fujita, Yuko 1738-2 Kikugawa Shimada, Shizuoka, 428-0037 JAPAN		

Goods/Services Subject to the filing

Class 005. First Use: 2010/07/10 First Use In Commerce: 2010/07/10

All goods and services in the class are requested, namely: wound dressings; gauze; adhesive bandages; bandages for dressings; medical adhesives for binding wounds, namely, adhesive pads

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

YUKO FUJITA,

Opposer,

v.

PEARL ENTERPRISES, LLC,

Applicant.

Opposition No. 91213744

Mark: KINOKI

Serial No. 85941092

Published in *Official Gazette*:

September 10, 2013

ANSWER TO NOTICE OF OPPOSITION

Applicant, Pearl Enterprises, LLC (“Pearl” or “Applicant”), by and through its undersigned attorneys, in answer to the Notice of Opposition (the “Notice”) of the asserted Opposer, Yuko Fujita (“Fujita” or “Opposer”), states as follows.

Applicant has no direct knowledge of the legal status, address, and authorization of or on behalf of the asserted Opposer as set forth in the preamble of the Notice of Opposition and thus demands strict proof of same. Applicant denies knowledge of the allegation of damage and applicability of the statutory authority set forth in the preamble. Applicant admits that the USPTO records for the subject application, serial no. 85941092, identifies Pearl Enterprises, LLC as a New Jersey limited liability company located at 379 E 7th St., Lakewood, New Jersey 08701. Applicant denies all other averments in the preamble.

In response to the numbered paragraphs of the Notice, Applicant responds as follows:

1. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 1; accordingly, they are denied.

2. Applicant admits that the USPTO records list Opposer as the owner of U.S. Registration No. 3,943,580 but denies that Opposer is the lawful owner or has any legally

protectable rights in the purported mark or registration. Applicant admits that Exhibit A to the Notice is a TSDR status report for U.S. Registration No. 3,943,580 dated 2013-11-25 17:32:19 EST. Applicant denies the remaining averments of paragraph 2 of the Notice.

3. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 3; accordingly, they are denied. By way of further response, the allegations of paragraph 3 are conclusions of law to which no response is required; accordingly, they are denied.

4. Admitted.

5. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 5; accordingly, they are denied.

6. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 6; accordingly, they are denied. By way of further response, the allegations of paragraph 6 are conclusions of law to which no response is required; accordingly, they are denied.

7. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. The allegations of paragraph 7 are conclusions of law to which no response is required; accordingly, they are denied.

8. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 8; accordingly, they are denied. By way of further

response, the allegations of paragraph 8 are conclusions of law to which no response is required; accordingly, they are denied.

9. Applicant denies that Opposer has any legally protectable rights in the purported registration or mark. Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of paragraph 9; accordingly, they are denied. By way of further response, the allegations of paragraph 9 are conclusions of law to which no response is required; accordingly, they are denied.

Additional Defenses

By way of further answer, Applicant responds as follows:

1. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.
2. Opposer lacks prior rights in Applicant's applied-for mark.
3. Opposer has not used its purported "KINOKI" mark.
4. Opposer has abandoned its purported "KINOKI" mark.
5. Opposer is not the proper or lawful owner of U.S. Registration No. 3,943,580.
6. Opposer is not the real party in interest.
7. Opposer lacks standing.
8. There is no likelihood of confusion between Applicant's applied-for mark and Opposer's purported "KINOKI" mark.
9. Opposer does not own a purported "KINOKI" mark and thus lacks standing to bring this opposition.
10. Opposer's cited basis of opposition, Registration No. 3,943,580, is invalid or unenforceable.

11. Applicant reserves the right to raise additional defenses and to supplement those asserted herein upon discovery of further information and investigation into the Opposer's claims. These additional defenses cannot be articulated at this time due to the Opposer's failure to properly describe its claims with sufficient particularity in its trademark application and the Notice of Opposition.

WHEREFORE, Applicant prays that Application Serial No. 85941092 be allowed to proceed to registration, and that the Opposition be dismissed with prejudice.

COUNTERCLAIM
(Cancellation of U.S. Registration No. 3,943,580)

Applicant, Pearl Enterprises, LLC ("Pearl" or "Applicant"), by and through its undersigned attorneys, in support of its Counterclaim against the asserted Opposer, Yuko Fujita ("Fujita" or "Opposer") for cancellation of U.S. Registration No. 3,943,580, states as follows.

1. Applicant is a New Jersey limited liability company having a business address of 379 E 7th St., Lakewood, New Jersey 08701.
2. According to USPTO records, Opposer, by its Notice of Opposition (the "Notice"), claims that there is an individual Japanese citizen named Yuko Fujita doing business at 1738-2 Kikugawa, Shimada, Shizuoka 428-0037 Japan.
3. U.S. Registration No. 3,943,580 is for the mark "KINOKI" for "wound dressings; gauze; adhesive bandages; bandages for dressings; medical adhesives for binding wounds, namely, adhesive pads" in International Class 5 (the "Registration").
4. Opposer has asserted the Registration as a basis for Opposer's Notice against Applicant's U.S. Application Serial No. 85941092 for the mark "KINOKI."
5. Opposer attached, as Exhibit A to the Notice, a TSDR status report for the Registration, dated 2013-11-25 17:32:19 EST.

6. The Registration issued on April 12, 2011, and resulted from U.S. application serial no. 85092943, filed July 26, 2010 (“Opposer’s Application”), by Annette P. Heller of Heller & Associates, the same counsel for Opposer in this Opposition, on behalf of Yuko Fujita.

7. Opposer’s Registration is for the same literal mark as Applicant’s “KINOKI” trademark.

8. Applicant uses the mark “KINOKI” that is the subject of Applicant’s opposed U.S. Application Serial No. 85941092 in connection with cleansing foot pads. Attached as **Exhibit 1** is a TSDR status report for Applicant’s U.S. Application Serial No. 85941092.

9. In the alternative, for at least the reason that Opposer has asserted the Registration against Applicant’s application in this Opposition, Applicant will be damaged by the maintenance of the Registration.

COUNT I – FRAUD

10. Applicant repeats and re-alleges the allegations in the foregoing paragraphs as if fully set forth herein.

11. Ms. Heller signed Opposer’s Application on behalf of Yuko Fujita, including the declaration in support of Opposer’s Application. Yuko Fujita did not sign the application or the declaration.

12. Upon information and belief, there does not exist a person named Yuko Fujita who is connected with the Registration or the sale of the products claimed in the Registration.

13. The specimen of use filed in support of Opposer’s Application was described in the application as “instruction sheet sold with products.”

14. The specimen of use filed in support of Opposer's Application was merely a PDF copy of a purported specimen; it was not a scanned copy or photograph of an actual instruction sheet enclosed with the purported goods that are the subject of Opposer's Application.

15. Opposer's Application did not include any specimen that purportedly showed the mark "KINOKI" on the purported goods that are the subject of Opposer's Application.

16. According to USPTO records, Opposer's claimed address of 1738-2 Kikugawa, Shimada, Shizuoka 428-0037 Japan is the same address as Kenrico Ltd., a Japanese corporation (*see, e.g.*, U.S. Serial Nos. 85035463, 85070983, 85035458, 77794199, 77858709, 77858704, 77858699, 77858696, 77794229, 77794223, 77794218, 77794204, 77794192, 77794181, 77794177, 77794172, 77794165, 77794158, 77794152, 77794141, 77794133, 77778592, 77778569, and 77778556).

17. Upon information and belief, Kenrico Ltd. operates its Kikugawa factory at 1738-2 Kikugawa, Shimada, Shizuoka 428-0037 Japan. *See Exhibit 2; see also* www.kenrico.com/company.html (last visited September 16, 2014).

18. Upon information and belief, Opposer does not reside at 1738-2 Kikugawa, Shimada, Shizuoka 428-0037 Japan.

19. Kenrico Ltd. is not an owner of the Registration.

20. Kenrico Ltd. is not a party to this Opposition.

21. Upon information and belief, Opposer is not registered to do business in the United States and does not have any FDA registrations in the United States.

22. Upon information and belief, Opposer's specimen submitted in support of Opposer's Application was created solely for the purpose of obtaining a registration and not part of a bona fide use of the mark in interstate commerce.

23. Despite not making a bona fide use of the mark “KINOKI” in the United States, Opposer, through its attorney of record, filed Opposer’s Application with a false declaration.

24. For at least the foregoing reasons, Opposer is not a bona fide owner of any rights in the mark “KINOKI” and does not have any valid, subsisting rights in the Registration.

25. For at least the foregoing reasons, Opposer is not, and was not at the time of filing its application for registration, the rightful owner of the registered mark.

26. Upon information and belief, Opposer knew that the aforementioned representations were false and material to Opposer’s right to registration.

27. Upon information and belief, Opposer intended to deceive the USPTO by making such false representations.

28. For at least the foregoing reasons, Opposer’s Application resulting in the Registration contained knowingly false material statements and a fraudulent specimen, submitted with intent to deceive the USPTO.

29. For at least the foregoing reasons, Opposer’s Registration was fraudulently obtained.

COUNT II – NON-USE

30. Applicant repeats and re-alleges the allegations in the foregoing paragraphs as if fully set forth herein.

31. Upon information and belief, Opposer has never sold in the United States any wound dressings; gauze; adhesive bandages; bandages for dressings; or medical adhesives for binding wounds, namely, adhesive pads.

32. Upon information and belief, Opposer has never sold in the United States any wound dressings; gauze; adhesive bandages; bandages for dressings; or medical adhesives for binding wounds, namely, adhesive pads under the mark “KINOKI.”

33. Upon information and belief, Opposer has never sold, distributed, or marketed in the United States any goods under the mark “KINOKI.”

34. For at least the foregoing reasons, there was no bona fide use of Opposer’s mark in commerce prior to the filing of the use-based application for its registration under Trademark Act § 1(a), 15 U.S.C. § 1051(a).

COUNT III - ABANDONMENT

35. Applicant repeats and re-alleges the allegations in the foregoing paragraphs as if fully set forth herein.

36. Upon information and belief, Opposer has not used its purported mark for a period of at least three consecutive years. Such nonuse is prima facie evidence of abandonment.

37. For at least the foregoing reasons, to the extent Opposer has ever used its purported mark, Opposer’s mark has been abandoned due to nonuse with intent not to resume use. Since, upon information and belief, Opposer has not made a bona fide use of the mark, Opposer lacks a bona fide intent to resume use.

WHEREFORE, Applicant will be damaged by maintenance of Opposer’s U.S. Registration No. 3,943,580 and prays that this Counterclaim be sustained.

Dated: September 16, 2014

FOX ROTHSCHILD LLP

/Christopher R. Kinkade/

Christopher R. Kinkade

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Attorneys for Applicant Pearl Enterprises, LLC

CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of September, 2014, a true and correct copy of the foregoing Answer to Notice of Opposition has been served via email, per agreement, upon the following counsel of record for Opposer:

Annette P. Heller
Heller & Associates
400 Chesterfield Center, Suite 400
Chesterfield, MO 63017
Tel: (314) 469-2610
Fax: (314) 469-4850

Attorney for Opposer Yuko Fujita

/Christopher R. Kinkade/
Christopher R. Kinkade
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Lawrenceville, NJ 08648
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Fax: (609) 896-1469
Email: ckinkade@foxrothschild.com

Attorneys for Applicant Pearl Enterprises, LLC

Exhibit 1

Generated on: This page was generated by TSDR on 2014-09-16 18:18:50 EDT

Mark: KINOKI

Kinoki

US Serial Number: 85941092
Application Filing Date: May 23, 2013
Filed as TEAS Plus: Yes
Currently TEAS Plus: Yes
Register: Principal
Mark Type: Trademark
Status: An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.
Status Date: Nov. 27, 2013
Publication Date: Sep. 10, 2013

Mark Information

Mark Literal Elements: KINOKI
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK
Translation: The wording "KINOKI" has no meaning in a foreign language.

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream

International Class(es): 003 - Primary Class
U.S Class(es): 001, 004, 006, 050, 051, 052
Class Status: ACTIVE
Basis: 1(a)
First Use: Mar. 23, 2011
Use in Commerce: Mar. 23, 2011

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Pearl Enterprises, LLC
Owner Address: 379 E 7th St.
Lakewood, NEW JERSEY 08701
UNITED STATES
Legal Entity Type: LIMITED LIABILITY COMPANY
State or Country Where Organized: NEW JERSEY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jacob Laufer, Esq.
Attorney Primary Email Address: lauferja@aol.com
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: CHRISTOHER R KINKADE
FOX ROTHSCHILD LLP
997 LENOX DRIVE
BUILDING 3
LAWRENCEVILLE, NEW JERSEY 08648
UNITED STATES

Phone: 718-331-7999

Fax: 718-259-2479

Correspondent e-mail: yyfeingold@yeshivanet.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Nov. 27, 2013	OPPOSITION INSTITUTED NO. 999999	213744
Sep. 18, 2013	EXTENSION OF TIME TO OPPOSE RECEIVED	
Sep. 10, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 10, 2013	PUBLISHED FOR OPPOSITION	
Aug. 21, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 08, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Aug. 06, 2013	ASSIGNED TO LIE	68171
Aug. 06, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 06, 2013	EXAMINER'S AMENDMENT ENTERED	88888
Aug. 06, 2013	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Aug. 06, 2013	EXAMINERS AMENDMENT E-MAILED	6328
Aug. 06, 2013	EXAMINERS AMENDMENT -WRITTEN	68603
Aug. 06, 2013	ASSIGNED TO EXAMINER	68603
Jun. 04, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 31, 2013	TEAS AMENDMENT ENTERED BEFORE ATTORNEY ASSIGNED	88889
May 31, 2013	TEAS VOLUNTARY AMENDMENT RECEIVED	
May 27, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: EVANKO, PATRICIA MALES

Law Office Assigned: LAW OFFICE 119

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Aug. 08, 2013

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91213744](#)

Filing Date: Nov 27, 2013

Status: Pending

Status Date: Nov 27, 2013

Interlocutory Attorney: BENJAMIN U OKEKE

Defendant

Name: Pearl Enterprises, LLC

Correspondent Address: CHRISTOHER R KINKADE
FOX ROTHSCHILD LLP
997 LENOX DRIVE, BUILDING 3
LAWRENCEVILLE NJ , 08648
UNITED STATES

Correspondent e-mail: ckinkade@foxrothschild.com , mleonard@foxrothschild.com , ipdocket@foxrothschild.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
KINOKI	Opposition Pending	85941092	

Plaintiff(s)**Name:** Yuko Fujita**Correspondent Address:** ANNETTE P HELLER
HELLER & ASSOCIATES
400 CHESTERFIELD CENTER
CHESTERFIELD MO , 63017
UNITED STATES**Correspondent e-mail:** tmattorneyheller@aol.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
KINOKI	Registered	85092943	3943580

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 27, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 27, 2013	Jan 06, 2014
3	PENDING, INSTITUTED	Nov 27, 2013	
4	D MOT FOR EXT W/ CONSENT	Jan 02, 2014	
5	EXTENSION OF TIME GRANTED	Jan 02, 2014	
6	D MOT FOR EXT W/ CONSENT	Mar 06, 2014	
7	EXTENSION OF TIME GRANTED	Mar 06, 2014	
8	D MOT FOR EXT W/ CONSENT	Apr 03, 2014	
9	EXTENSION OF TIME GRANTED	Apr 03, 2014	
10	D MOT TO DISMISS: FRCP 12(B)	May 06, 2014	
11	CHANGE OF CORRESP ADDRESS	May 07, 2014	
12	SUSP PEND DISP OF OUTSTNDNG MOT	May 10, 2014	
13	Confidential Plaintiff's Opposition/Response to Motion	May 14, 2014	
14	P OPP/RESP TO MOTION	May 14, 2014	
15	D REPLY IN SUPPORT OF MOTION	May 29, 2014	
16	PROCEEDINGS RESUMED	Aug 27, 2014	

Type of Proceeding: Extension of Time**Proceeding Number:** [85941092](#)**Filing Date:** Sep 17, 2013**Status:** Terminated**Status Date:** Jan 08, 2014**Interlocutory Attorney:****Defendant****Name:** Pearl Enterprises, LLC**Correspondent Address:** ROCHEL TRENK
PEARL ENTERPRISES, LLC
379 E 7TH ST
LAKEWOOD NJ , 08701-2008
UNITED STATES**Associated marks**

Mark	Application Status	Serial Number	Registration Number
KINOKI	Opposition Pending	85941092	

Potential Opposer(s)**Name:** YukoFujita**Correspondent Address:** Annette P. Heller
Heller & Associates
400 Chesterfield Center
Chesterfield [St Louis] MO , 63017
UNITED STATES**Correspondent e-mail:** tmattorneyheller@aol.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
Prosecution History			

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Sep 17, 2013	
2	EXTENSION OF TIME GRANTED	Sep 18, 2013	

Exhibit 2

[□ Products](#)
 [Research](#)
 [□ Investor Relations](#)
 [Broadcasting](#)
 [Kenrico](#)
 [Home](#)

ABOUT US

From our humble beginnings in Japan, we have grown into a true worldwide community of prescription and alternative medicines. We have a distributor network ranging from Europe to as far away as America. We understand the importance of reliability and reputation, and we're confident that we can make the process simple, effective, and easy for our customers. We are committed to make our products fresh and safe. We guarantee they are made to the highest possible standards.

Forged from our experience and expertise, we continue to build our success, bringing nature and health closer to your everyday lives. We are a global, financially-secure company in Japan, one that our clients can count on for many years to come.



■ Company name	Kenrico LTD
■ President	Nurman Salim
■ Policy	Brings nature closer to our heart.
■ Yearly Revenue	USD\$ 80 million (2007), USD\$ 82 million (2008), USD\$ 100 million (2009), USD\$ 102 million (2010), USD\$ 102 million (2011), USD\$ 149 million (2012), USD\$ 238 million (2013)
■ Address	Facility I 1796-6 Kanaya Kawara. Haibara-Gun. Kanaya, Shizuoka 428-0021 JAPAN Facility II 1738-2 Kikugawa. Shimada, Shizuoka 428-0037 JAPAN
■ Contact us	Phone: +81-547-47-3220 Fax: +81-547-47-3221 Email: kenrico@kenrico.com

Access Map

How to visit Kenrico in Japan



Bank Information
Our official bank in Japan

- Name of Bank Shizuoka Bank
- Bank address Kanaya branch
2130 Kanaya Kawara.
Shimada, Shizuoka 428-0043
Japan
- Account name Kenrico LTD

■ Account number	0341571
■ Swift Code	SHIZ JP JT
■ Bank Code (BIC)	0149
■ Branch code	173
■ Corresponding Banks	The Bank of Tokyo-Mitsubishi, LTD. Resona Bank, Limited. Sumitomo Mitsui Banking Corporation. UFJ Bank Limited.
■ Currency	Japanese YEN * All transactions, including credit cards (VISA, MASTERCARD, AMEX, & DINERS), Paypal and Telegraphic Transfer (T/T), must be made in Japanese Yen. Please note that extra fees will apply for payment by credit cards and Paypal.

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