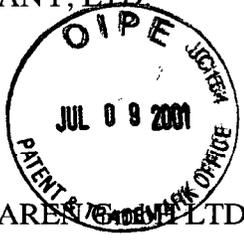


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



KAPALUA LAND COMPANY, LTD. )  
 Petitioner )  
 v. )  
 KAPALUA STRICKENWAREN GMBH LTD. )  
 Registrant )



07-09-2001

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #7E

Cancellation No. \_\_\_\_\_

PETITION TO CANCEL  
Reg. Nos.: 2,016,976 and 2,115,124

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. 2,115,124 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. 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

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.
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.
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

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.
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.

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.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'W. Mack Webner', written in a cursive style.

W. Mack Webner  
Sughrue, Mion, Zinn  
Macpeak & Seas PLLC  
Attorneys for Kapalua Land Company Ltd.