

**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 STRICKWAREN GmbH)	
)	
Respondent.)	

**RESPONDENT'S MOTION FOR LEAVE TO AMEND RESPONDENT'S
RESPONSE TO PETITIONER'S FIRST SET OF ADMISSIONS
IN SUPPORT OF RESPONDENT'S BRIEF IN OPPOSITION
TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

Pursuant to TMBP § 407.04 and TMBP § 525, Respondent hereby requests leave to amend Respondent's Response to Petitioner's First Set of Admissions to Respondent which were served on Petitioner on February 23, 2006. While preparing its response to Petitioner's motion for summary judgment, Respondent realized that certain of its responses to Petitioner's admissions were incomplete and in accurate. When filing its brief in opposition to Petitioner's motion for summary judgment, Respondent attached, and also separately served Petitioner with a copy of, Respondent's Amended Response to Petitioner's First Set of Admissions to Respondent.

Attached as Exhibits 1 and 2, respectively, are copies of Respondent's Response to Petitioner's First Set of Admissions to Respondent and Respondent's Amended Response to Petitioner's First Set of Admissions to Respondent.

The basis for this motion was that Respondent's response to Petitioner's Interrogatory Nos. 3 and 4, and Respondent's responses to Petitioner's Request for Admissions Nos. 10, 11, 12 and 26 were incomplete and inaccurate (Reusch Declaration, paragraphs 8, 9, 10, 11 and 12. The



Declaration of Nicolas Reusch in Opposition to Petitioner's Motion for Summary Judgment is attached hereto as Ex. 3 hereto). Mr. Reusch states in his Declaration that he did not fully understand what information was being requested (Reusch Decl., ¶ 8), that while he speaks German and English, all of his communications with his attorney in Germany were in German, and that he had difficulty locating documents because they were in different locations (Reusch Decl., ¶ 7). Mr. Reusch was also somewhat confused by the translation of the goods from German to English and from English to German (Reusch Decl., ¶ 9). Until July 31, 2006, all of Mr. Reusch's communications in this case were with his attorney in Hamburg (Reusch Decl., ¶ 4).

The issues were brought to Mr. Reusch's attention after Petitioner filed its Motion for Summary Judgment and were clarified for him in a telephone conference on July 31, 2006, with his attorney in Germany, Ms. Petra Goldenbaum; the U.S. attorney assisting Respondent with this matter, Joseph F. Schmidt of Michael Best & Friedrich LLP; and Ms. Chris Tan, the creative director, chief designer and founder of the KAPALUA line. Upon a further review of these issues and additional documents Mr. Reusch was then able to locate, Mr. Reusch reconfirmed that the mark KAPALUA was in use in the United States in May 2004, in connection with all of the items listed in U.S. Registration No. 2,115,124. (Reusch Decl., ¶ 11). Respondent's amended response to admissions (Exhibit 2) reflect this fact, and are relevant to Petitioner's motion for summary judgment.

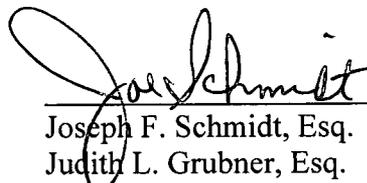
The presentation of the merits of this proceeding will be subserved if Respondent is not allowed to amend its responses to Petitioner's admissions, which establish that there are material questions of fact relating to Petitioner's motion for summary judgment. Moreover, Petitioner cannot show any prejudice. In raising this issue in its reply brief in support of its motion for

summary judgment, Petitioner merely argues that Respondent's amended responses are not properly before the Board and should not be considered in deciding Petitioner's motion for summary judgment. This is not prejudice. Even where a motion to withdraw admissions by default was denied, to the extent the admissions are contradicted by the evidence, the admissions will not be relied on for purpose of deciding whether entry of summary judgment is appropriate. *BankAmerica Corp. v. International Travelers Cheque Co.*, 205 USPQ 1233, 1235 (TTAB 1979). As shown in Respondent's brief in opposition to Petitioner's motion for summary judgment, the evidence contradicts Respondent's initial responses to Petitioner's requests for admission which have now been amended. Granting this motion does not prejudice Petitioner in maintaining this action, but to deny this motion would severely prejudice Respondent.

For the foregoing reasons, Respondent's motion should be granted.

August 29, 2006

By:



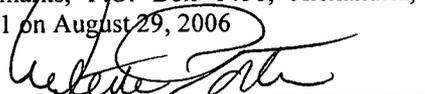
Joseph F. Schmidt, Esq.
Judith L. Grubner, Esq.
MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson Avenue
Suite 2000
Chicago, IL 60611
(312) 222-0800
(312) 222-0818 (fax)
Attorneys for Respondent

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail and is addressed to the Box TTAB - No FEE, Commissioner For Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on August 29, 2006

Signature:

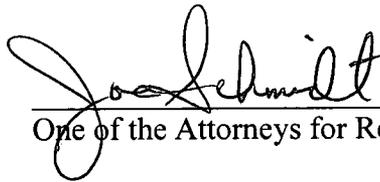
Print:


Arlette Porter

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of RESPONDENT'S MOTION FOR LEAVE TO AMEND RESPONDENT'S RESPONSE TO PETITIONER'S FIRST SET OF ADMISSIONS IN SUPPORT OF RESPONDENT'S BRIEF IN OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served by first class mail, postage pre-paid, on this 29th day of August 2006 upon:

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

A handwritten signature in cursive script, appearing to read "Joe Schmidt", is written over a horizontal line.

One of the Attorneys for Respondent

039

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

KAPALUA LAND CO., LTD.)
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Petitioner,)
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v.)
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KAPALUA STRICKENWAREN GmbH)
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Respondent.)

Cancellation No. 92/040,092

**RESPONDENT'S RESPONSE TO PETITIONER'S
FIRST SET OF ADMISSIONS TO RESPONDENT**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, Respondent Kapalua Strickwaren GmbH responds to Petitioner Kapalua Land Co., Ltd.'s First Set of Admissions to Respondent as follows:

1. Admit that Respondent was aware of Petitioner's KAPALUA mark when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

RESPONSE:

Denied.

2. Admit that Respondent was aware of Petitioner's KAPALUA trade name when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

RESPONSE:

Denied.

3. Admit that Respondent has never sold or offered for sale dresses under the mark KAPALUA in the United States.

RESPONSE:

Denied.

4. Admit that Respondent has never sold or offered for sale jackets under the mark KAPALUA in the United States.

RESPONSE:

Denied.

5. Admit that Respondent has never sold or offered for sale suits under the mark KAPALUA in the United States.

RESPONSE:

Denied.

6. Admit that Respondent has never sold or offered for sale sweaters under the mark KAPALUA in the United States.

RESPONSE:

Denied.

7. Admit that Respondent has never sold or offered for sale pants under the mark KAPALUA in the United States.

RESPONSE:

Denied.

8. Admit that Respondent has never sold or offered for sale shorts under the mark KAPALUA in the United States.

RESPONSE:

Denied.

9. Admit that Respondent has never sold or offered for sale shirts under the mark KAPALUA in the United States.

RESPONSE:

Denied.

10. Admit that Respondent has never sold or offered for sale socks under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

11. Admit that Respondent has never sold or offered for sale underwear under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

12. Admit that Respondent has never sold or offered for sale shoes under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

13. Admit that Respondent has never sold or offered for sale gloves under the mark KAPALUA in the United States.

RESPONSE:

Denied.

14. Admit that Respondent has never sold or offered for sale hats under the mark KAPALUA in the United States.

RESPONSE:

Denied.

15. Admit that Respondent has never sold or offered for sale laundry bleach under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

16. Admit that Respondent has never sold or offered for sale laundry detergent under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

17. Admit that Respondent has never sold or offered for sale perfumes under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

18. Admit that Respondent has never sold or offered for sale essentially oils for personal use under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

19. Admit that Respondent has never sold or offered for sale lipstick under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

20. Admit that Respondent has never sold or offered for sale rouge under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

21. Admit that Respondent has never sold or offered for sale eyeliner under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

22. Admit that Respondent has never sold or offered for sale hair lotion under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

23. Admit that Respondent has never sold or offered for sale dentifrice under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

24. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,016,976.

RESPONSE:

Admitted.

25. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,115,124.

RESPONSE:

Admitted.

26. Admit that Respondent did not use the mark KAPALUA on all the goods listed in Registration No. 2,115,124 when Respondent filed its Section 8 Declaration on May 19, 2004.

RESPONSE:

Respondent admits that the mark was not used for socks, underwear and shoes. The mark was used for dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, gloves and hats.

27. Admit that Respondent has documents in its possession which refer to Petitioner.

RESPONSE:

Respondent's attorney has documents in its possession which refer to Petitioner which Respondent's attorney received from Petitioner's attorney after this dispute began.

28. Admit that Registration No. 2,115,124 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoengensverwaltungsgesellschaft mbH on or about August 8, 2001.

RESPONSE:

Admitted.

29. Admit that Registration No. 2,016,976 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoengensverwaltungsgesellschaft mbH on or about August 8, 2001.

RESPONSE:

Admitted.

30. Admit that Chris Tan Vermoengensverwaltungsgesellschaft mbH assigned Registration No. 2,115,124 to Kapalua GmbH on or about September 14, 2001.

RESPONSE:

Admitted.

31. Admit that Chris Tan Vermoengensverwaltungsgesellschaft mbH assigned Registration No. 2,016,976 to Kapalua GmbH on or about September 14, 2001.

RESPONSE:

Admitted.

32. Admit that Kapalua GmbH assigned Registration No. 2,115,124 to Nelly GmbH on or about October 30, 2002.

RESPONSE:

Admitted.

33. Admit that Kapalua GmbH assigned Registration No. 2,016,976 to Nelly GmbH on or about October 30, 2002.

RESPONSE:

Admitted.

34. Admit that Nelly GmbH changed its name to Kapalua GmbH Luxus in Simplicity on or about April 14, 2003.

RESPONSE:

Admitted.

35. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,115,124 to Style & Spirit GmbH on or about November 4, 2003.

RESPONSE:

Admitted.

36. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,016,976 to Style & Spirit GmbH on or about November 4, 2003.

RESPONSE:

Admitted.

37. Admit that Nicolaus Reusch is the CEO of Style & Spirit GmbH.

RESPONSE:

Admitted.

38. Admit that there has never been any use of the mark KAPALUA on shoes, gloves or socks anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,115,124.

RESPONSE:

Denied.

39. Admit that there has never been any use of the mark KAPALUA on laundry bleach, laundry detergent, essential oils or dentifrice anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,016,976.

RESPONSE:

Admitted.

Dated: February 23, 2006

By:



Joseph F. Schmidt, Esq.

Gretchen M. Hosty, Esq.

MICHAEL BEST & FRIEDRICH LLP

Two Prudential Plaza

180 North Stetson

Suite 2000

Chicago, IL 60601

(312) 661-2100

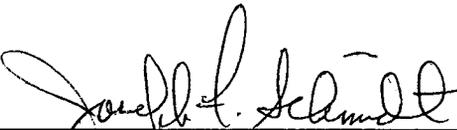
(312) 222-0818 (fax)

Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **RESPONDENT'S RESPONSE TO PETITIONER'S FIRST SET OF ADMISSIONS TO RESPONDENT** was served by first class mail, postage pre-paid, on this 23rd day of February upon:

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



One of the Attorneys for Respondent

Dkt

US

**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 STRICKWAREN GmbH)	
)	
Respondent.)	

**RESPONDENT'S AMENDED RESPONSE TO PETITIONER'S
FIRST SET OF ADMISSIONS TO RESPONDENT**

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, Respondent Kapalua Strickwaren GmbH responds to Petitioner Kapalua Land Co., Ltd.'s First Set of Admissions to Respondent as follows:

1. Admit that Respondent was aware of Petitioner's KAPALUA mark when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

RESPONSE:

Denied.

2. Admit that Respondent was aware of Petitioner's KAPALUA trade name when it filed U.S. trademark application Serial Nos. 74/657,998 and 75/038,334.

RESPONSE:

Denied.

3. Admit that Respondent has never sold or offered for sale dresses under the mark KAPALUA in the United States.

RESPONSE:

Denied.

4. Admit that Respondent has never sold or offered for sale jackets under the mark KAPALUA in the United States.

RESPONSE:

Denied.

5. Admit that Respondent has never sold or offered for sale suits under the mark KAPALUA in the United States.

RESPONSE:

Denied.

6. Admit that Respondent has never sold or offered for sale sweaters under the mark KAPALUA in the United States.

RESPONSE:

Denied.

7. Admit that Respondent has never sold or offered for sale pants under the mark KAPALUA in the United States.

RESPONSE:

Denied.

8. Admit that Respondent has never sold or offered for sale shorts under the mark KAPALUA in the United States.

RESPONSE:

Denied.

9. Admit that Respondent has never sold or offered for sale shirts under the mark KAPALUA in the United States.

RESPONSE:

Denied.

10. Admit that Respondent has never sold or offered for sale socks under the mark KAPALUA in the United States.

RESPONSE:

Denied.

11. Admit that Respondent has never sold or offered for sale underwear under the mark KAPALUA in the United States.

RESPONSE:

Denied.

12. Admit that Respondent has never sold or offered for sale shoes under the mark KAPALUA in the United States.

RESPONSE:

Denied.

13. Admit that Respondent has never sold or offered for sale gloves under the mark KAPALUA in the United States.

RESPONSE:

Denied.

14. Admit that Respondent has never sold or offered for sale hats under the mark KAPALUA in the United States.

RESPONSE:

Denied.

15. Admit that Respondent has never sold or offered for sale laundry bleach under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

16. Admit that Respondent has never sold or offered for sale laundry detergent under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

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RESPONSE:

Admitted.

18. Admit that Respondent has never sold or offered for sale essentially oils for personal use under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

19. Admit that Respondent has never sold or offered for sale lipstick under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

20. Admit that Respondent has never sold or offered for sale rouge under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

21. Admit that Respondent has never sold or offered for sale eyeliner under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

22. Admit that Respondent has never sold or offered for sale hair lotion under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

23. Admit that Respondent has never sold or offered for sale dentifrice under the mark KAPALUA in the United States.

RESPONSE:

Admitted.

24. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,016,976.

RESPONSE:

Admitted.

25. Admit that Respondent has not used the KAPALUA mark continuously from the date of registration to the present on the goods listed in Registration No. 2,115,124.

RESPONSE:

Admitted.

26. Admit that Respondent did not use the mark KAPALUA on all the goods listed in Registration No. 2,115,124 when Respondent filed its Section 8 Declaration on May 19, 2004.

RESPONSE:

Denied.

27. Admit that Respondent has documents in its possession which refer to Petitioner.

RESPONSE:

Respondent's attorney has documents in its possession which refer to Petitioner which Respondent's attorney received from Petitioner's attorney after this dispute began.

28. Admit that Registration No. 2,115,124 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoegensverwaltungsgesellschaft mbH on or about August 8, 2001.

RESPONSE:

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29. Admit that Registration No. 2,016,976 was assigned by Interfashion Ltd. BVI to Chris Tan Vermoegensverwaltungsgesellschaft mbH on or about August 8, 2001.

RESPONSE:

Admitted.

30. Admit that Chris Tan Vermoegensverwaltungsgesellschaft mbH assigned Registration No. 2,115,124 to Kapalua GmbH on or about September 14, 2001.

RESPONSE:

Admitted.

31. Admit that Chris Tan Vermoegensverwaltungsgesellschaft mbH assigned Registration No. 2,016,976 to Kapalua GmbH on or about September 14, 2001.

RESPONSE:

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32. Admit that Kapalua GmbH assigned Registration No. 2,115,124 to Nelly GmbH on or about October 30, 2002.

RESPONSE:

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33. Admit that Kapalua GmbH assigned Registration No. 2,016,976 to Nelly GmbH on or about October 30, 2002.

RESPONSE:

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34. Admit that Nelly GmbH changed its name to Kapalua GmbH Luxus in Simplicity on or about April 14, 2003.

RESPONSE:

Admitted.

35. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,115,124 to Style & Spirit GmbH on or about November 4, 2003.

RESPONSE:

Admitted.

36. Admit that Kapalua GmbH Luxus in Simplicity assigned Registration No. 2,016,976 to Style & Spirit GmbH on or about November 4, 2003.

RESPONSE:

Admitted.

37. Admit that Nicolaus Reusch is the CEO of Style & Spirit GmbH.

RESPONSE:

Admitted.

38. Admit that there has never been any use of the mark KAPALUA on shoes, gloves or socks anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,115,124.

RESPONSE:

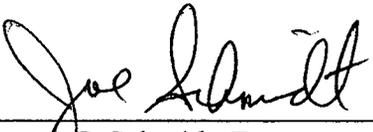
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39. Admit that there has never been any use of the mark KAPALUA on laundry bleach, laundry detergent, essential oils or dentifrice anywhere in the world by any of the owners of the mark in the chain of title of Registration No. 2,016,976.

RESPONSE:

Admitted.

Dated: August 8th, 2006

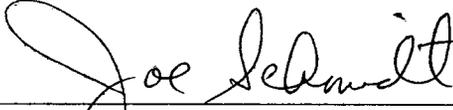
By: 

Joseph F. Schmidt, Esq.
Judith L. Grubner, Esq.
MICHAEL BEST & FRIEDRICH LLP
Two Prudential Plaza
180 North Stetson
Suite 2000
Chicago, IL 60601
(312) 661-2100
(312) 222-0818 (fax)
Attorneys for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of **RESPONDENT'S RESPONSE TO PETITIONER'S FIRST SET OF ADMISSIONS TO RESPONDENT** was served by first class mail, postage pre-paid, on this 8th day of August 2006 upon:

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



One of the Attorneys for Respondent

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

KAPALUA LAND CO., LTD.)
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 Petitioner,)
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 v.)
)
 KAPALUA STRICKWAREN)
 GmbH Ltd.,)
)
 Respondent.)

Cancellation No. 92/040,092
Reg. No. 2,115,124

**DECLARATION OF NICOLAUS REUSCH IN OPPOSITION TO
PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

- I reside in Germany and I am the Co-Chief Executive Officer of DC Design & Concept GmbH ("DC"), which acquired the mark KAPALUA and U.S. Registration No. 2,115,124 from Style & Spirit GmbH ("S&S") as of April 1, 2006.
- Prior to the transfer of the mark KAPALUA and U.S. Registration No. 2,115,124 from S&S to DC, I was the Managing Director of S&S. S&S acquired the rights to the mark KAPALUA and U.S. Registration No. 2,115,124 from Kapitalua GmbH Luxus in Simplicity in November 2003. Other predecessors included Kapitalua GmbH, Interfashion Ltd. B.V.I., and Kapitalua Strickenwaren GmbH Ltd. Kapitalua Strickenwaren GmbH Ltd. is the respondent in this proceeding. I have been involved with the KAPALUA brand line of women's clothing since 5.1.2001
- DC and S&S are German companies with offices in Germany. S&S's office was located in Hamburg, Germany, and DC's office is located in Osnabrück, Germany. Documents relating to the KAPALUA mark are located in a warehouse in

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: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 on the date shown below:
Mark A. Weaver
(Typed or Printed Name of Person Signing Certificate)
Mark A. Weaver
(Date) August 8, 2006

FROM KAPALUA

Hamburg and in DC's office in Osnabrück, Germany. For these reasons, it has been difficult for me to locate all relevant documents relating to the KAPALUA mark.

4. The respondent is represented by Petra Goldenbaum of the CMS Hasche Sigle law firm in Hamburg, Germany. Until July 31, 2006, all of my communications in this case have been with my attorneys in Hamburg.

5. In the Fall of 2005, respondent's attorneys in Germany retained new counsel in the United States to represent respondent in this matter, namely, Joseph F. Schmidt of Michael Best & Friedrich LLP, located in Chicago, Illinois.

6. In May 2004, I was contacted by my attorney in Germany, Petra Goldenbaum, who advised me that, in order to maintain U.S. Registration No. 2,115,124 for the mark KAPALUA, a Declaration of Use had to be filed by May 19, 2004. Ms. Goldenbaum inquired whether the mark KAPALUA was in use on all of the goods listed in U.S. Registration No. 2,115,124, and I advised her that it was, and I authorized the filing of the Declaration of Use by our former attorney in the United States, Michael Striker of Striker & Striker.

7. In December 2005 and in early 2006, my attorney in Germany requested that I gather information and documents for responding to petitioner's discovery requests in this cancellation proceeding. While I speak and understand English, all of my communications with my attorney in Germany were in German. Because the documents regarding the KAPALUA mark were in various locations, I have had difficulty locating documents.

8. When my attorney in Germany asked what products the mark KAPALUA had been used on, I responded "pullovers, t-shirts and shirts" because the KAPALUA



women's clothing line consisted primarily of women's knit clothing. Thus, Respondent's Answers to Petitioner's First Set of Interrogatories To Respondent, Nos. 1-20, specifically Interrogatory Nos. 3 and 4, were answered as follows:

Interrogatory No. 3. Identify each product on which Respondent has used Respondent's Mark.

ANSWER:

Pullovers, t-shirts, and shirts.

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.

I realize now that, at that time, I did not fully understand what information was being requested, and the answers to Interrogatory Nos. 3 and 4 were incomplete. I asked my



attorney to prepare amended answers. Attached as Exhibit 1 is a copy of Respondent's Amended Answers to Petitioner's First Set of Interrogatories to Respondent, Nos. 1-20.

9. For these same reasons, I also did not initially answer correctly Petitioner's First Set of Admissions to Respondent. Respondent's Response to Petitioner's First Set of Admissions to Respondent, Nos. 10, 11, 12 and 26, were as follows:

10. Admit that Respondent has never sold or offered for sale socks under the mark KAPALUA in the United States.

RESPONSE
Admitted.

11. Admit that Respondent has never sold or offered for sale underwear under the mark KAPALUA in the United States.

RESPONSE
Admitted.

12. Admit that Respondent has never sold or offered for sale shoes under the mark KAPALUA in the United States.

RESPONSE
Admitted.

26. Admit that Respondent did not use the mark KAPALUA on all the goods listed in Registration No. 2,115,124 when Respondent filed its Section 8 Declaration on May 19, 2004.

RESPONSE
Respondent admits that the mark was not used for socks, underwear and shoes. The mark was used for dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts, T-shirts, gloves and hats.

I did not fully understand the questions, and I was somewhat confused by the translation and meaning of the goods from German to English and from English to German. The



FROM KAPALUA

KAPALUA line is promoted as a line of women's knit clothing. Most of the revenue results from the sale of knit clothing. However, the line also includes various accessory items, such as, shoes, ankle cuffs (socks), gloves, caps (hats) and undergarments (underwear). The various accessory items are also shown in "Look Books." Attached as Exhibit 5 are excerpts from the Autumn/Winter 2000/2001 "LOOK BOOK" which consists of photographs of the KAPALUA line from a fashion show, and lists the article number and color of the shoes in the line in the index of items depicted in the "LOOK BOOK." Attached as Exhibit 6 are excerpts from the 2006/2007 KAPALUA accessories book, which shows leg warmers and leg warmers with feet (socks), hats and gloves. Attached as Exhibit 7 are excerpts from the Spring/Summer 2006 Accessories catalog which depict shoes. These accessory items help to give the line a complete look, but account for a small percentage of overall sales of KAPALUA brand products. Therefore, I do not always refer to the accessory items when describing and promoting the line, and did not think to do so when advising my attorney how to respond to Petitioner's Requests to Admit, Nos. 10, 11, 12 and 26.

10. I believe I also was confused as to what products are covered by U.S. Registration No. 2,115,124. The identification of goods lists certain words, such as "underwear." I am not sure exactly what that term encompasses in English. When asked if the KAPALUA mark is used on underwear, my initial reaction was that it is not to the extent that underwear is commonly referred to as men's or women's briefs. However, the KAPALUA mark is applied to undergarments, such as a corset bra. Also, while the KAPALUA mark is not applied to traditional socks, it is used on "ankle cuffs" and "leg warmers," which I believe fall within the category of socks. When initially responding to



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the Petitioner's Interrogatories and Admissions, I did not consider these issues in such detail. I did not understand the significance of these points at that time.

11. The issues were brought to my attention after Petitioner filed its Motion for Summary Judgment and the issues were clarified for me in a telephone conference on July 31, 2006, with my attorney in Germany, Ms. Petra Goldenbaum, the U.S. attorney assisting my company with this matter, Joseph F. Schmidt of Michael Best & Friedrich LLP, and Ms. Chris Tan, the creative director, chief designer and founder of the KAPALUA line. Upon a further review of these issues and additional documents I was able to locate, I am able to confirm that the mark KAPALUA was in use in the United States in May 2004, in connection with all of the items listed in U.S. Registration No. 2,115,124. Accordingly, I asked my attorney to prepare amended responses. Attached as Exhibit 2 is a copy of Respondent's Amended Response to Petitioner's First Set of Admissions to Respondent.

12. In 2003 and 2004, S&S was distributing in the United States the items listed in Registration No. 2,115,124 through Signum International in New York. All of the items listed in the Registration were shipped to Signum and on display for sale in Signum's showroom on Seventh Avenue in New York City, and/or available through sketch books which displayed the clothing and accessory lines. Attached as Exhibit 3 are excerpts from the KAPALUA Autumn/Winter 2003/2004 sketch books (collection 1) which shows many different examples of the KAPALUA clothing line, including accessories such as hats and leg warmers (socks). Attached as Exhibit 4 are excerpts from the KAPALUA Autumn/Winter 2003/2004 sketch book (collection 2) which also shows numerous examples of the KAPALUA clothing line, including undergarments,



such as corset bras and gloves. Attached as Exhibit 8 is a copy of a Fall/Winter 2003 KAPALUA catalog. Attached as Exhibit 9 is a copy of a Spring/Summer 2004 KAPALUA catalog. The catalogs depict shoes sold as part of the KAPALUA line in 2003 and 2004. Exhibit 9 lists the delivery dates as February and March 2004, and lists the U.S. distributor, Signum International. In late 2003 and early 2004, the items in U.S. Registration No. 2,115,124, namely, shoes, undergarments (underwear), ankle cuffs (socks), gloves, caps (hats), dresses, skirts, jackets, suits, pullovers, sweaters, pants, shorts, shirts and t-shirts, were shipped to Signum for delivery in January or February 2004, for display and sale in the United States in the spring and summer of 2004.

I hereby declare under penalty of perjury and the penalties under 18 U.S.C. § 1001 that the foregoing statements are true and correct.

By 
 Nicolaus Reusch

Date: August 8, 2006

