

ESTTA Tracking number: **ESTTA714292**

Filing date: **12/12/2015**

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

Proceeding	92059866
Party	Plaintiff Kini Kai, L.L.C.
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Attachments	2015-12-12-Reply - r1b.pdf(119593 bytes )



Registrant submitted no evidence of any use of Registrant's mark prior to September 11, 2011.

Regarding Petitioner's evidence of priority, Petitioner has placed into evidence several years of sales and shipments in U.S. commerce which pre-date Registrant's filing date. In addition, Petitioner has placed into evidence substantial advertising and promotional activities which pre-date Registrant's filing date.

This evidence is set out in the motion in Exhibits 1, 2, 3, 4, and 5 as well as the recently taken deposition of Jennifer Smith (formerly Jennifer Meadors) attached to Registrant's Opposition. Exhibit 3 shows some of the earliest shipments and sales of products, including a shipment, sale, and proof of payment of 125 swimsuits from Kini Kai's location in South Carolina to a store in Kentucky. Exhibit 3 also contains a record of substantial wholesale sales to several U.S. states from January 1, 2009 until November 11, 2011. Exhibit 4 shows the tags attached to the swimwear during this time which clearly displays the Kini Kai brand name. Exhibit 2 shows an Archive.org capture of the Kini Kai website in 2009 and 2010 which operated as full retail online store using the Kini Kai name in close proximity to the swimwear being sold. In Exhibit 1, Jennifer Smith (formerly Jennifer Meadors) testified that starting in or about March 2009, Kini Kai branded swimwear was sold all over the United States. *See* Meadors Decl. at ¶ 6. She testified that the company's swimwear was sold through Amazon.com, Ebay.com, and Etsy.com and that the brand was promoted throughout the United States, in tanning salons, in clothing boutiques, and in fitness clothing boutiques. *Id.* At ¶ 11.

This evidence is uncontroverted. Registrant has presented no evidence, sufficient to create a genuine issue of material of fact, as to Petitioner's priority. Rather, Registrant's arguments are limited to attacking certain sales to SIT, Inc. a tanning salon owned by Ms. Smith's immediate family members, and an argument that Exhibit 3 showing wholesale sales from January 1, 2009 until November 11, 2011 should be ignored because Ms. Smith was unable to break down the

number of sales by year.

In addition to evidence set out in the motion, the recent deposition of Jennifer Smith offers further evidence of Petitioner's selling and shipping of Kini Kai branded goods in U.S. commerce prior to Registrant's filing date. In fact, Ms. Smith testified that she has had consistent sales since 2009 of both retail and wholesale sales of Kini Kai products. Ms. Smith testified as follows:

Q. So since the time you started selling products under the Kini Kai name, under both Kini Kai Swimwear, L.L.C. and then later Kini Kai, L.L.C., was there any -- was there ever any gap in production of bikinis, sales of bikinis, any substantial gap in time?

A. No.

Q. What's the longest you ever went between sales since you started your business?

A. 24 hours.

*See Smith Deposition, p. 14, lines 17 – 25.*

Regarding wholesale orders, the fact that Ms. Smith was unable to break down the sales listed in Exhibit 3 by year or the fact that one wholesale customer was SIT, Inc. owned by Ms. Smith's immediate family members, does not create a genuine issue of material fact as to Petitioner's priority. Regarding SIT, Inc., as shown in Exhibit 3 the sale to SIT, Inc. was an arms-length transaction and proof of payment was provided. In addition, the declaration of Ms. Smith (formerly Ms. Meadors) as to Petitioner's sales prior to Registrant's filing date is uncontroverted. Ms. Smith states in her declaration, "From March 2009 until September 11, 2011 when Registrant's application was filed, Petitioner had already sold more than four hundred swimwear products." (*See Meadors Decl., at ¶ 9*).

Furthermore, Ms. Smith testified during her deposition that prior to Registrant's filing date

Petitioner consistently had a large web presence through Petitioner's online store. Regarding Petitioner's online store, Ms. Smith testified:

Q. At that time, back in April or May of 2009, could people make online purchases straight from your Website?

A. Yes.

Q. And this would be for the Website KiniKaiSwimwear.com?

A. Yes.

Q. If you could look at the last page of Exhibit 2.

A. Okay.

Q. Can you explain to me what that shows?

A. This is March 26th, 2010. It is a snapshot of one of our product pages from KiniKaiSwimwear.com.

Q. Does that look like, except for, obviously, the missing images, does that look like a reasonably accurate depiction of your Website at that time?

A. Yes.

Q. Do you happen to know how many visitors you had on your Website on March 26th, 2010?

A. No. Not specifically on March 26th.

Q. Okay. Do you happen to know how many visitors you had to your Website at all in the year of 2009 or 2010?

A. It was, to the best of my knowledge, approximately 100,000 visitors.

*See Smith Deposition, p. 8, line 20 through p.19, line 18.*

In addition, regarding advertising and promotion of the Kini Kai brand prior to Registrant's filing date, Ms. Smith offered the following additional evidence during her deposition:

Q. Can you tell me a little bit about the advertising that you do for your business?

A. Sure. We have advertised on Google AdWords from -- since 2009. We also have our dot com Website. We have our Etsy exposure.

Q. Can I stop you? What's your dot com Website?

A. KiniKaiSwimwear.com. KiniKaiBikini.com. KiniKaiHawaii.com. Hawaii -- we have a few under the Kini Kai name.

Q. Do they all redirect to one Website, or do you have multiple Websites and multiple domains?

A. We most redirect to Kini Kai Swimwear. That is the main hub.

Q. So your main site is KiniKaiSwimwear.com?

A. Yes.

Q. Has it always been KiniKaiSwimwear.com?

A. Yes. Would you like for me to continue?

Q. Please.

A. Okay. Just checking. So AdWords. We have also advertised through Etsy.com, which we have a storefront. We've advertised with Facebook. We've been on fashion blogs. Also we have been in the Charleston Art Magazine a number of times. We have sponsored surf events. And our advertising has even gone as far as we take a proceed of our sales and donate them to the Leukemia & Lymphoma Society. So we sponsor some of their athletes in Team in Training to

do that.

Q. Before 2012, what kinds of advertising did you do? I mean you just kind of told me all of the advertising you do. But what about the stuff that happened before 2012?

A. AdWords, Facebook.com. Sorry if I go too fast. The Leukemia & Lymphoma Society. Before 2012? Charleston – multiple Charleston magazines, including Skirt! Magazine, surf competitions. We've gone directly and sponsored Hawaii Volleyball Association events.

Q. What about before 2010?

A. Hawaii Volleyball Association, still on AdWords, Facebook. I believe Etsy. And surf competitions. And I don't know if I already said this, volleyball competitions as well.

*See Smith Deposition, p. 15, line 1 through p. 16, line 19.*

Finally, Registrant argues that it is unclear whether Petitioner is the successor in interest to Kini Kai Swimwear L.L.C. There is no admissible evidence to support this position. Jennifer Smith's recent deposition testimony as well as Exhibit 1 to the motion for summary judgment clearly show that Petitioner is the successor in interest to Kini Kai Swimwear L.L.C. Ms. Smith testified at her deposition as follows:

Q. I've put in front of you a document that I submit to you is a printout from the Secretary of State of Georgia. It says on the front it was certificate of voluntary termination for Kini Kai Swimwear, L.L.C. Does it look familiar to you at all?

A. Yes.

Q. Okay. And it says here that the termination of Kini Kai Swimwear,

L.L.C. occurred on April 14th of 2010?

A. That is correct.

Q. Are you -- do you agree that Kini Kai Swimwear, L.L.C. was voluntarily terminated approximately April of 2010?

A. Yes.

Q. Okay. And just out of curiosity, why did you voluntarily terminate Kini Kai Swimwear, L.L.C.?

A. I had moved full time to Hawaii. And we transferred everything of Kini Kai Swimwear, L.L.C. to Kini Kai, L.L.C. that we formed in Hawaii. So we needed to cancel the Georgia.

Q. Do you have any written documentation showing the transfer of all the assets and properties and good will of Kini Kai Swimwear, L.L.C. to Kini Kai, L.L.C.?

A. I did have it. Due to 17 moves in eight years, it became lost in the jumble. But it was in existence.

*See Smith Deposition, p. 11, line 12 through Page 12, line 11.*

Moreover, as detailed in the motion and supported by Ms. Smith's deposition testimony, Petitioner was formed and started business in March 2010 which itself predates Registrant's filing date of September 11, 2011. Ms. Smith testified:

All right. I've put in front of you a document that I submit to you is a printout from the State of Hawaii's corporations status Website.

A. Mm-hmm.

Q. It lists some business information for Kini Kai, L.L.C. Does this look familiar to you?

A. This does. Yes.

Q. Okay. And it says here that you registered Kini Kai, L.L.C. in Hawaii on March 20th, 2010. Does that sound approximately accurate to you?

A. Yes.

*See* Smith Deposition, p. 13, lines 8-18.

Petitioner's use, which began independently in March 2010, has priority over Registrant's September 11, 2011 filing date, irrespective of being the successor in interest to Kini Kai Swimwear, L.L.C. Regardless, the evidence in this case is that Petitioner is the successor in interest to the Georgia company.

As demonstrated in Exhibits 1, 2, 3, 4, and 5 as well as Ms. Smith's recent deposition testimony, Petitioner's use in commerce of the Kini Kai mark clearly predates Registrant Registrant's priority date. There is no evidence, sufficient to create a genuine issue of material of fact, as to whether Petitioner's Kini Kai mark has priority of Registrant's KaiKini mark and summary judgment should therefore be granted on the issue of priority.

### **III. LIKELIHOOD OF CONFUSION**

Likelihood of confusion was not challenged by Registrant in the Opposition. Likelihood of confusion is clearly demonstrated in this case simply by examining the two marks and their respective goods—both of which are which are nearly identical. Registrant's mark simply reverses the words in Petitioner's mark. Registrant offered no evidence or argument that Petitioner's Kini Kai mark is not likely to be confused with Registrant's KaiKini mark.

There is no evidence, sufficient to create a genuine issue of material of fact, as to whether there is likelihood of confusion between Petitioner's Kini Kai mark and Registrant's KaiKini mark and summary judgment should be granted on the issue of likelihood of confusion.

#### IV. FRAUD

As to fraud, Registrant admits in the Opposition that when she filed trademark application under Section 1(a), she was not using the mark in connection with many of the clothing products recited in her application. Registrant further admits that had the USPTO known that her mark was not in use in connection with all of the products listed in her application the USPTO would have refused registration of Registrant's mark. (*See* Opposition, p 6-7).

While Registrant argues she did not have the requisite intent to commit fraud, Registrant's knowledge that her mark was not in use on all of the products is all that is required to establish intent to commit fraud in the procurement of a registration. *Medinol Ltd. v. Neuro VASX Inc.*, 67 USPQ2d 1205 (TTAB 2003).

There is no evidence, sufficient to create a genuine issue of material of fact, as to whether Registrant has committed fraud and summary judgment should be granted on this issue.

#### V. CONCLUSION

For all of the foregoing reasons, Petitioner has established that there are no genuine issues of material fact regarding (i) standing of Petitioner, (ii) Petitioner's priority over Registrant's mark, (iii) a likelihood of confusion between Petitioner's Mark and Registrant's Mark, and (iv) Registrant's fraud. Consequently, Petitioner respectfully requests that the Board grant its motion for summary judgment and cancel the registration of KaiKini Registration No. 4,149,388.

Respectfully submitted,

Dated: December 12, 2015

By:   
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **PETITIONER'S REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT** has been served on the attorney of record for the Registrant, who has consented to service by email, by emailing said copy and providing links to download any attachments too large to email on December 12, 2015 to the attorney's email addresses of record:

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Mark Borghese