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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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BUO

Mailed: March 1, 2016

Cancellation No. 92059866

Kini Kai, L.L.C.

v.

Taryn Rodighiero d/b/a KaiKini

Before Greenbaum, Adlin and Goodman,
Administrative Trademark Judges.

By the Board:

Background

Petitioner has petitioned to cancel Registration No. 4149388 (“the ’388 registration”) for the mark KAIKINI, in standard character format, for various articles of clothing, including “sun protective clothing, namely, swimwear, board shorts, rash guards [and] swimwear” In International Class 25.¹ The registration issued on May 29, 2012, from an application filed September 11, 2011.

¹ The identification of goods, in its entirety, is as follows: “Bottoms; clothing, namely, wrap-arounds; headbands for clothing; hoods; infant and toddler one piece clothing; infant cloth diapers; jackets; jerseys; shoulder wraps; shoulder wraps for clothing; sun protective clothing, namely, swimwear, board shorts, rash guards; swimwear; tops; triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; wearable garments and clothing, namely, shirts; women's clothing, namely, shirts, dresses, skirts, blouses; wraps.”

Petitioner pleads use of the mark KINI KAI prior to Taryn Rodighiero d/b/a KaiKini's ("Respondent") adoption of the KAIKINI mark.² 1 TTABVUE 5, ¶ 11. Petitioner alleges further that "the dominant features of the marks, namely the words Kini Kai and the words KaiKini are identical and cover identical products, [Respondent's] KaiKini Mark creates a likelihood of confusion with Petitioner's Kini Kai Mark." 7 TTABVUE 6.

Petitioner also alleges that Respondent "committed fraud in registering the KaiKini Mark and the registration certificate which issued is void *ab initio*." *Id.* at 6.³ Petitioner's fraud claim is based upon the allegations that "[Respondent] was not [and is not] using the mark KaiKini on or in connection with all the goods listed in Reg. No. 4,149,388 when she filed the application on September 11, 2011," and she thus signed the supporting declaration "in bad faith and in an attempt to perpetrate a fraud upon the PTO because [Respondent] knew or should have known that she was

² Petitioner's pleading of prior use and common law rights in the allegedly similar mark KINI KAI in connection with apparel, particularly swimwear, is sufficient to allege its standing to bring this action. 1 TTABVUE 3-4 and 5-6 ¶¶ 3 and 11-15. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1028 (Fed. Cir. 1999); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) (plaintiff may show standing based on common law rights in a mark that is distinctive, inherently or otherwise); *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (standing based on common law use of mark).

³ Citations to the record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

not using the mark KaiKini in connection with all the goods identified in the application.” 1 TTABVUE 5, ¶¶ 7 and 8.

Respondent, in her answer to the petition filed September 13, 2014, denied the salient allegations of the petition to cancel, except that Respondent admitted that “she submitted a sworn declaration to the PTO in connection with Application Serial No. 85419812, and that her application recited a first use in commerce date of at least as early as December 1, 2010.” 5 TTABVUE 3, ¶ 6.

Summary Judgment

Now before the Board is Kini Kai L.L.C.’s (“Petitioner”) motion, filed May 1, 2015, for summary judgment under Fed. R. Civ. P. 56(a) on its pleaded claims of likelihood of confusion and fraud.

By its motion, Petitioner alleges that through Respondent’s discovery responses, the record now establishes that “[t]he KaiKini Mark is void *ab initio* as [Respondent] admits in responses to requests for admission that she has never used the KaiKini Mark in commerce on numerous goods identified in the Registration.” 7 TTABVUE 3. Petitioner also asserts that based on the evidence made of record in connection with the present motion, “Petitioner’s Kini Kai Mark has priority over [Respondent’s] mark because Petitioner first used its Kini Kai Mark in commerce almost two years prior to [Respondent’s] claimed date of first use in commerce of December 1, 2010,”⁴

⁴ In its petition to cancel, Petitioner alleged that its use of the mark began “as early as March 15, 2010,” 1 TTABVUE 3-4, ¶ 3, the same date alleged in its pleaded application; however, it now alleges a date “almost two years” prior to December 1, 2010. Petitioner is advised that the higher standard of clear and convincing evidence must be met to prove use on a date earlier than its previously alleged date. *See Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

and given the similarity of the marks and relatedness of the goods, confusion among consumers is likely. *Id.* at 11, 12 and 13.

In the instant motion, Respondent contends that Petitioner's proffered evidence fails to "demonstrate the absence of genuine issues of material fact as to ... Petitioner's alleged priority in the KINI KAI mark." 13 TTABVUE 8. Additionally, with respect to Petitioner's fraud claim, Respondent argues that Petitioner has failed to establish the requisite subjective intent to show fraud on the USPTO. *Id.* at 7. The motion has been fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts. *See* Fed. R. Civ. P. 56(a). Summary judgment is appropriately entered where "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." *See* Fed. R. Civ. P. 56(c)(1)(A); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

All evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The burden is on the party moving for summary

judgment to demonstrate the absence of any genuine dispute of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c).

In support of its motion, Petitioner submitted the declaration of Jennifer K. Meadors, one of its principals, which authenticated the following accompanying exhibits:

- printouts from the website Archive.org purporting to show webpages from the website KiniKaiSwimwear.com dated April 11, 2009, May 21, 2009, and March 26, 2010;⁵
- copies of invoices, including an invoice for importation of goods identified simply as swimwear from Vietnam and sent to Ms. Meadors, another showing a banner purchased and billed to Kini Kai Swimwear, neither of which references any particular trademark; and an invoice dated March 25, 2009, for a sale of “kini kai swim wear” made to a Kentucky company;⁶
- a summary of sales of items that were purportedly sold by Kini Kai LLC between January 1, 2009, and November 11, 2011, without any indication of when each sale was made;⁷
- pictures of hangtags and promotional material with unidentified handwriting purportedly describing the dates the materials were in use from 2009 through 2015;⁸

⁵ 7 TTABVUE 25-29. Although Respondent has not objected, the Board notes that this type of evidence is generally unreliable, particularly where there is no foundation in the form of testimony from someone familiar with the processes of Archive.org. *See Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1858-59 (TTAB 2007) (a declaration may be “insufficient to authenticate printouts ... from the Internet Archive and its ‘Wayback Machine’ feature, because the declarant lacked the requisite personal knowledge to establish that the documents were what he proclaimed them to be.”).

⁶ *Id.* at 31-34

⁷ *Id.* at 35-46.

⁸ *Id.* at 48-49.

- the entire file record of application Serial No. 85419812, which matured into the '388 registration;⁹
- a copy of Respondent's responses to Petitioner's First Set of Requests for Admission;¹⁰
- a copy of Respondent's responses to Petitioner's First Set of Interrogatories;¹¹
- an Office Action issued against Petitioner's pleaded application stating, *inter alia*, that registration has been refused under Trademark Act Section 2(d) in light of a likelihood of confusion with Respondent's involved Registration;¹²
- copies of the petition to cancel and answer filed in this proceeding;¹³ and
- undated photos tagged with "kinikaibikini" showing women wearing bikini swimwear.¹⁴

A. Fraud

⁹ *Id.* at 51-99. The file of the involved registration forms part of the record of the proceeding without any action by the parties. Trademark Rule 2.122. *Id.* Therefore, it was unnecessary for Petitioner to include the printout of the entire underlying application file as an exhibit with its motion for summary judgment, and the Board generally discourages doing so. *See Hunt Control Sys. Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1563 (TTAB 2011) (record includes pleadings and registration file for respondent's mark); *Hiraga v. Arena*, 90 USPQ2d 1102, 1105 (TTAB 2009) (respondent's registration file is automatically part of the record of the proceeding and need not be introduced under a notice of reliance).

¹⁰ *Id.* at 101-108. It is noted, however, that requests for admission that have been denied have no probative value.

¹¹ *Id.* at 110-112.

¹² *Id.* at 114-123.

¹³ *Id.* at 125-137. Again, it was unnecessary for Petitioner to attach this evidence to its motion for summary judgment. It is superfluous inasmuch as it is already of record and can be referenced for any purpose.

¹⁴ *Id.* at 139-142.

Fraud in procuring a trademark registration occurs when an applicant for registration *knowingly* makes a false, material representation of fact in connection with an application to register with the *intent* of obtaining or maintaining a registration to which it is otherwise not entitled. *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). Intent to deceive is an indispensable element of the analysis in a fraud case. *See In re Bose Corp.*, 91 USPQ2d at 1941.

Relying on cases which are no longer good law, Petitioner states that “[t]he facts in this case are almost identical to those in both *Hurley*¹⁵ and *Medinol Ltd. v. Neuro VASX Inc.*, 67 USPQ2d 1205 (TTAB 2003).” 7 TTABVUE 9. Petitioner cites *Hurley* for the proposition that “proof of specific intent is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false.” 82 USPQ2d at 1345 (quoting *General Car and Truck Leasing Sys. Inc. v. General Rent-A-Car Inc.*, 17 USPQ2d 1398, 1400-01 (D.C. S.Fla. 1990)).

However, the “knew or should have known” standard relied upon in *Hurley* and *Medinol* was overturned by the Court of Appeals for the Federal Circuit in *Bose*. The court found that such a standard “erroneously lowered the fraud standard to a simple negligence standard.” *In re Bose*, 91 USPQ2d at 1940. The court held that “[s]ubjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis.” *Id.* at 1941.

¹⁵ *Hurley Int’l LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007).

Inasmuch as Petitioner failed to argue, much less provide sufficient evidence to show that Respondent had the requisite subjective intent to deceive the USPTO into issuing the involved registration, its motion for summary judgment must fail on this ground.¹⁶

B. Likelihood of Confusion

In a likelihood of confusion analysis, two key factors are the degree of similarity of the parties' marks and the degree to which their respective goods or services are related. See *In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The U.S. Court of Customs and Patent Appeals in *du Pont* discussed thirteen factors relevant to a determination of likelihood of confusion. However, not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 567-68; see also *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) ("Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered."); See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000).

Although Respondent did not offer any argument regarding the similarity of the marks or relatedness of the goods, but instead focused on the issue of priority, the Board will not treat those issues as conceded, but will consider likelihood of confusion on its merits based upon the facts of the case and Petitioner's assertions.

¹⁶ In light of this information, Petitioner is encouraged to consider the efficacy of pursuing its fraud claim beyond this motion for summary judgment.

In support of its motion for summary judgment, Petitioner submitted evidence showing use of its KINI KAI mark on or in connection with swimwear, particularly bikinis, which establishes that the parties' goods are at least in-part identical or closely related. Nonetheless, even where the goods of the parties are closely related or identical, likelihood of confusion may not be found if the subject marks are not sufficiently similar. *See Marcal Paper Mills, Inc. v. Am. Can Co.*, 212 USPQ 852, 863 (TTAB 1981). Further, although confusion can be found between two marks consisting of reverse combinations of the same elements, this depends on a finding that despite the transposition of the terms the overall marks nonetheless convey the same meaning or create substantially similar commercial impressions. *See Bank of Am. Nat'l Trust and Sav. Assoc. v. The Am. Nat'l Bank of St. Joseph*, 201 USPQ 842, 845 (TTAB 1978), and cases cited therein. *Cf. In re Akzona Inc.*, 219 USPQ 94, 96 (TTAB 1983) ("Applicant's mark 'SILKY TOUCH,' conveys the impression that applicant's synthetic yarns are silky to the touch. On the other hand, registrant's mark 'TOUCH O' SILK,' suggests that registrant's clothing products contain a small amount of silk."); *Murphy, Brill and Sahner, Inc. v. New Jersey Rubber Co.*, 102 USPQ 420 (Commr. Pat. 1954) (finding that TOPFLITE for shoe soles conveys a different meaning than FLITE TOP for hosiery). Moreover, the determination of the similarity of marks is particularly fact intensive and relative rather than absolute.

Furthermore, Respondent's contention that "there remains genuine issues of material fact as to ... whether Petitioner [Kini Kai, L.L.C.] can benefit from the alleged commercial use of KINI KAI by Kini Kai Swimwear L.L.C.," is accurate.

Petitioner has failed to establish through its evidence that it indeed is the prior user of its KINI KAI mark.

Viewing the evidence in a light favorable to Respondent, we find that Petitioner has failed to demonstrate the absence of genuine disputes of material fact.¹⁷ In particular, we find that, with regard to Petitioner's fraud claim, genuine disputes of material fact exist at least as to Respondent's subjective intent to deceive the USPTO, and with regard to the likelihood of confusion claim, genuine disputes exist as at least as to priority, and the degree of similarity between Petitioner's mark and Respondent's mark.¹⁸

Accordingly, Petitioner's motion for summary judgment is **DENIED**.

Accelerated Case Resolution

In light of this motion for summary judgment and the relatively straight-forward issues that remain to be resolved, the Board strongly encourages the parties to stipulate to resolution of this proceeding by means of the Board's Accelerated Case Resolution ("ACR") procedure. They may do so through the current record and/or

¹⁷ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981). However, should the parties stipulate to resolve this proceeding using the Board's Accelerated Case Resolution model, as explained further below, they may stipulate that the Board may resolve the matter relying on the record as presented in support and defense of this motion.

¹⁸ The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

supplemental summary judgment-type briefs accompanied by additional evidence. *See e.g., Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (parties agreed that evidence and arguments submitted with petitioner's motion for summary judgment and respondent's response could be treated as the final record and briefs). *See also* TBMP § 528.05(a)(2) (2015) and authorities cited therein. Finally, the parties will need to stipulate that the Board may resolve any genuine disputes of material fact the Board may find to exist. The burden of proof, except as previously noted regarding Petitioner's claims of likelihood of confusion if Petitioner attempts to assert a date of use prior to March 15, 2010, and fraud, will be a preponderance of the evidence. *See* TBMP § 702.04 for more information.

The parties are therefore encouraged to jointly contact the assigned Board Interlocutory Attorney responsible for this proceeding by telephone to discuss the possibility of ACR, any necessary stipulations and an agreed-upon schedule for proceeding under ACR.

If the parties determine not to proceed via ACR the proceeding will continue on the schedule as set below.

Schedule

The proceeding is **RESUMED**, and discovery, disclosure and trial dates are reset as follows:

Discovery Closes	3/12/2016
Plaintiff's Pretrial Disclosures	4/26/2016
Plaintiff's 30-day Trial Period Ends	6/10/2016
Defendant's Pretrial Disclosures	6/25/2016
Defendant's 30-day Trial Period Ends	8/9/2016
Plaintiff's Rebuttal Disclosures	8/24/2016

Plaintiff's 15-day Rebuttal Period Ends

9/23/2016

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of that testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.