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

Proceeding	92057460
Party	Defendant ALOHA AIRLINES, INC.
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Attachments	Cancellation No. 92057460_Motion to Suspend.pdf(509535 bytes)

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

HAWAIIAN AIRLINES, INC., a Delaware corporation,

Petitioner,

v.

YUCAIPA CORPORATE INITIATIVES
FUND I, L.P., a Delaware limited partnership,
and

YUCAIPA CORPORATE INITIATIVES
FUND I, L.L.C., a Delaware limited liability
company,

Respondents.

Cancellation Nos. 92057460 (parent)¹ /
Registration No. 2,303,334

Cancellation No. 92057479/
Registration No. 2,347,989

Cancellation No. 92057493/
Registration No. 3,071,580

Cancellation No. 92057541/
Registration No. 3,215,210

**RESPONDENTS YUCAIPA CORPORATE INITIATIVES FUND I, L.P. AND
YUCAIPA CORPORATE INITIATIVES FUND I, L.L.C.'S
MOTION TO SUSPEND CANCELLATION PROCEEDING**

I. INTRODUCTION

Pursuant to 37 C.F.R. Section 2.117(a) and Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Respondents Yucaipa Corporate Initiatives Fund I, L.P. and Yucaipa Corporate Initiative Fund I, L.L.C. (“Respondents”) hereby move the Trademark Trial and Appeal Board (the “Board”) to suspend this cancellation action (the “Cancellation”) regarding Registration Numbers 2303334, 2347989, 3071580 and 3215210 (the “Registrations”) pending the outcome of the civil action between Respondents and Petitioner Hawaiian Airlines, Inc. (“Petitioner”) that is presently before the United States District Court for the Central District of California, case number 13cv09060 MRW (the “District Court Action”). A copy of the complaint filed by Respondents in the District Court Action is attached hereto as Exhibit A (the “Complaint”).

¹ Cancellation proceeding numbers 92057460, 92057479, 92057493, and 92057541 were consolidated by the Trademark Trial and Appeal Board by Order dated October 1, 2013. Pursuant to that Order, cancellation proceeding number 92057460 is the “parent” case and the record therefore only is being maintained in this case.

II. ARGUMENT

Flowing from the Board’s “inherent power to schedule disposition of the cases on its docket,” the Board has broad “power to stay proceedings,” which power it may exercise “upon its own initiative” or “upon motion” of a party. TBMP § 510.01. Pursuant to applicable regulations, proceedings before the Board may be suspended “for good cause,” as well as because the parties “are engaged in a civil action or another Board proceeding which may have a bearing on the case” pending before the Board. 37 C.F.R. § 2.117(a), (c). Where the other proceeding “may have a bearing on the issues before the Board,” the Board will “[o]rdinarily ... suspend the proceedings in the case before it[.]” TBMP § 510.02(a); *see also, e.g., New Orleans Louisiana Saints LLC & NFL Props. LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (other action “does not have to be dispositive of the Board proceeding to warrant suspension” but rather “need only have a bearing on the issues before the Board”). Here, there is good cause to suspend the Cancellation because the District Court Action is entirely dispositive of the issues in this proceeding.

As set forth in the Complaint, Respondent Yucaipa Corporate Initiatives Fund I, L.P.² in the District Court Action seeks a declaration that each of the four Registrations at issue in this proceeding are valid and that they may not be cancelled for alleged abandonment of the trademarks underlying the Registrations. *See* Ex. A ¶¶ 9, 34, 39. Because cancellation of the Registrations for abandonment is precisely the issue before the Board in this proceeding, the outcome of the District Court Action has significant – and case-dispositive – “bearing on the case.” 37 C.F.R. § 2.117(a). Indeed, because the outcome of the District Court Action is binding on the Board in this proceeding, the Cancellation will be mooted entirely upon resolution of the District Court Action. *See* TBMP § 510.02(a) (“To the extent that a civil action is a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.”); *New Orleans*, 99 USPQ2d at 1552 (same). Thus, suspension is appropriate. *See, e.g., New Orleans*, 99 USPQ2d at 1552 (“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”) (quotations omitted).

² Although two Respondents are named in this Cancellation proceeding, only Respondent Yucaipa Corporate Initiatives Fund I, L.P. is the owner of the Registrations.

Moreover, there is “good cause” to suspend the Cancellation because, if it proceeds in parallel with the District Court Action, there is substantial risk that the time, effort and resources dedicated to the Cancellation by the Board and the parties will be wasted if precisely the same issues are resolved in the District Court Action. To avoid such unnecessary waste of time and expense, the Cancellation should be suspended until the District Court Action concludes. *See, e.g., Farah v. Topiclear Beauty Prods., Inc.*, Opp. No. 151,334, 2003 TTAB Lexis 405, at *17-18 (TTAB Aug. 21, 2003) (suspending Board proceeding pending outcome of other proceeding involving “common legal and factual issues” in order to “minimize waste of both the parties’ and the Board’s resources”).

III. CONCLUSION

For the foregoing reasons, Respondents respectfully request that this Cancellation proceeding be suspended until resolution of the District Court Action pending presently between the parties.³

Dated: December 11, 2013

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By: 

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³ Given that suspension is appropriate in this matter, to avoid unnecessary motion practice, Respondents sought a stipulation from Petitioner to suspend this proceeding pending resolution of the Arbitration. However, Petitioner failed to respond, forcing this Motion.

EXHIBIT A

FILED

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10
11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA

13
14 YUCAIPA CORPORATE
INITIATIVES FUND I, LP, a
15 Delaware Limited Partnership,

CASE NO. CV 13-09060-MRW

Complaint For:

16 Plaintiff,

(1) Declaratory Judgment of No
Abandonment

17 v.

(2) Declaratory Judgment of Validity

18 HAWAIIAN AIRLINES, INC., a
19 Delaware corporation,

(3) Trademark Infringement
(Lanham Act, 15 U.S.C. § 1114)

20 Defendant.

(4) Unfair Competition/False
Designation Of Origin
(Lanham Act, 15 U.S.C. § 1125(a))

(5) Common Law Trademark
Infringement

(6) Common Law Unfair Competition

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25 DEMAND FOR JURY TRIAL
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1 Plaintiff Yucaipa Corporate Initiatives Fund I, LP (“Yucaipa”), for its
2 Complaint against Defendant Hawaiian Airlines, Inc. (“Hawaiian Airlines”),
3 alleges as follows:

4 **THE PARTIES**

5 1. Yucaipa is a Delaware limited partnership with a principal place of
6 business in Los Angeles, California.

7 2. On information and belief, Hawaiian Airlines is a Delaware
8 corporation with a principal place of business in Honolulu, Hawaii.

9 **JURISDICTION AND VENUE**

10 3. This is a civil action alleging trademark infringement, false
11 designation of origin, and unfair competition under the Lanham Act, 15 U.S.C.
12 §§ 1114(a), 1125(a); California common law trademark infringement and unfair
13 competition; and declaratory relief under the Declaratory Judgment Act, 28 U.S.C.
14 § 2201, of non-abandonment of certain trademarks, and validity of certain federal
15 trademark registrations under 15 U.S.C. §§ 1119, 1127 and 1064.

16 4. Pursuant to 15 U.S.C. § 1121 and 28 U.S.C. § 1338(a), this Court has
17 subject matter jurisdiction over Yucaipa’s claims for relief for violation of the
18 federal trademark and unfair competition statutes. Pursuant to 28 U.S.C.
19 § 1338(b), this Court has supplemental jurisdiction over Yucaipa’s state law unfair
20 competition claim, in that the claim is joined with substantial and related claims
21 under the Lanham Act. This Court also has supplemental jurisdiction over
22 Yucaipa’s state law claims pursuant to 28 U.S.C. § 1367(a), in that all of the claims
23 arise out of a common nucleus of operative facts.

24 5. The Court has personal jurisdiction over Hawaiian Airlines because
25 Hawaiian Airlines has sufficient minimum contacts in the State of California to
26 satisfy California’s long-arm statute and Constitutional due process requirements,
27 including because it transacts substantial business in the State of California.

28 6. Venue in this Court exists under 28 U.S.C. § 1391(b)(2) because a

1 substantial part of the events giving rise to the claims alleged in this Complaint
 2 occurred in this District. In addition, venue in this Court exists under 28 U.S.C.
 3 § 1391(b)(1) because Hawaiian Airlines, as a corporation, is “deemed to reside ...
 4 in any judicial district in which [it] is subject to the court’s personal jurisdiction,”
 5 and because of Hawaiian Airlines’ contacts with this District described in the
 6 preceding paragraphs. 28 U.S.C. § 1391(c)(2).




7 **GENERAL ALLEGATIONS**

8 **A. Aloha Airlines and the Aloha Marks and Registrations**

9 7. Aloha Airlines, Inc. (“Aloha Airlines”) opened its doors in 1946 and
 10 served the Hawaiian islands and multiple U.S. and international destinations for
 11 over 60 years.

12 8. During its long history, Aloha Airlines flew to over 15 different cities
 13 and served millions of travelers.

14 9. In connection with its air travel and other services, Aloha Airlines
 15 developed and used numerous trademarks, including in particular the ALOHA,
 16 ALOHA AIRLINES, and ALOHA AIRLINES VACATIONS marks (the “Aloha
 17 Marks”). In addition, Aloha Airlines obtained federal registrations with the U.S.
 18 Patent and Trademark Office (“PTO”) in connection with many of its trademarks,
 19 including the following four registrations (the “Aloha Registrations”):

Mark	Registration
ALOHA AIRLINES VACATIONS	U.S. Reg. No. 3,071,580 (issued March 21, 2006)
	U.S. Reg. No. 3,215,210 (issued March 6, 2007)
	U.S. Reg. No. 2,303,334 (issued Dec. 28, 1999)
	U.S. Reg. No. 2,347,989 (issued May 9, 2000)

1 10. Due to its lengthy and extensive marketing and use of the marks over
2 several decades, Aloha Airlines developed substantial recognition and goodwill in
3 the Aloha Marks.

4 **B. Yucaipa Acquires the Aloha Marks and Registrations**

5 11. On March 20, 2008, Aloha Airlines and several affiliated companies
6 filed for bankruptcy protection under Chapter 11 of the United States Bankruptcy
7 Code, due to rising fuel costs and fare wars with competing airlines. Ultimately,
8 the Aloha bankruptcy was converted into a Chapter 7 liquidation.

9 12. During its bankruptcy, Aloha Airlines was unable to operate
10 commercially, and therefore was not able to utilize the Aloha Marks in the
11 ordinary course of business. However, Aloha Airlines expected that its marks
12 would be used again.

13 13. As part of its liquidation, pursuant to a December 30, 2010 Asset
14 Purchase Agreement and a February 7, 2011 Bill of Sale, Aloha Airlines sold and
15 assigned certain assets to Yucaipa, including the Aloha Marks and Aloha
16 Registrations. Since that time, and through today, Yucaipa has been and is the
17 owner of all rights and interests in the Aloha Marks and the Aloha Registrations.

18 **C. Yucaipa Markets the Marks and Registrations and Intends that**
19 **the Marks be Used**

20 14. At all times since acquiring the Aloha Marks and Aloha Registrations,
21 Yucaipa has intended to resume use of the Aloha Marks. Yucaipa's conduct
22 evidences this intent unmistakably. As an initial matter, Yucaipa paid a substantial
23 sum to obtain the rights to the Aloha Marks and Aloha Registrations (among other
24 Aloha Airlines assets). Yucaipa's intent that the Aloha Marks would be used is
25 clear in view of its significant investment to obtain such marks.

26 15. Moreover, rather than sitting on the Aloha Marks or otherwise
27 allowing them to lie dormant and unused, Yucaipa began taking steps to license or
28 sell them immediately after acquiring them.

1 16. As long ago as November 2008, Yucaipa (acting in its capacity as the
2 majority investor of Aloha Airlines) reached an agreement with Mesa Air Group
3 (“Mesa”) to license the Aloha Marks to Mesa. However, in May 2009, the
4 Bankruptcy Court presiding over the Aloha Airlines bankruptcy blocked this deal.

5 17. Following this court decision, as the U.S. economy continued to
6 decline and the commercial air industry suffered economically, it became
7 increasingly difficult to locate potentially interested purchasers or licensees.
8 Indeed, 2009 saw the worst drop in history in airline revenues (see, e.g.,
9 http://money.cnn.com/2010/01/20/news/economy/air_traffic_2009/), and these
10 economic conditions continued into 2010 and 2011 (see, e.g.,
11 <http://www.iata.org/pressroom/pr/pages/2011-06-06-01.aspx>).

12 18. Despite these difficulties, Aloha and Yucaipa persisted in their intent
13 that the Aloha Marks (among others) be used again. In or around December 2009,
14 Yucaipa worked with Aloha Airlines to renew the Aloha Registrations by filing
15 Renewal Applications with the PTO. Yucaipa and Aloha Airlines took these steps
16 with the intention that the Marks would be used again.

17 19. By at least April 2011, Yucaipa had engaged in substantial efforts to
18 license, sub-license or sell the trademarks to air carriers. Among others, Yucaipa
19 approached licensing companies and airlines regarding the Aloha Marks. In or
20 around June 2012, at least one domestic air carrier contacted Yucaipa regarding a
21 possible purchase of the Marks and Registrations. In or around October 2012,
22 Yucaipa contacted another major airline regarding a possible purchase of the Aloha
23 Marks and Aloha Registrations.

24 20. Further to Yucaipa’s steady marketing and sales efforts, in or around
25 November 2012, Yucaipa formally retained The Falcon Group, Inc. (“Falcon”), an
26 airline industry marketing and consulting firm, to market Yucaipa’s interest in the
27 Aloha Marks and Aloha Registrations. As of February 2013, Falcon had been in
28 contact with at least six different airlines regarding a potential sale or license of the

1 Aloha Airlines brand. Falcon had also initiated conversations with at least one
2 non-airline investor.

3 21. Falcon also researched placing advertisements in airline industry
4 publications to solicit interest in licensing or purchasing the Aloha Marks and
5 Aloha Registrations.

6 22. Yucaipa's intent to resume use of the Aloha Marks is further
7 demonstrated by its conduct in defending them against attack. For example,
8 Yucaipa is currently defending a registration for its **ALOHA AIRLINES** mark in
9 an opposition proceeding before the European Office for Harmonization in the
10 Internal Market (file no. 018688-0018; Community Trademark Application
11 008658281). Yucaipa's investment of funds and resources to protect the Aloha
12 Airlines marks and registrations is unmistakable evidence of its intent that the
13 Aloha Marks be used again.

14 **D. Despite Yucaipa's Sales and Marketing Efforts, Hawaiian Airlines**
15 **Claims the Marks and Registrations Were Abandoned, and Is**
16 **Now Infringing Those Marks**

17 23. Hawaiian Airlines was Aloha Airlines' major competitor in the
18 Hawaiian airline market when Aloha Airlines was still in operation, and the
19 companies fiercely competed for market share.

20 24. Since Aloha Airlines ceased operations after bankruptcy, Hawaiian
21 Airlines has systematically attempted to appropriate and trade off of the substantial
22 goodwill in the Aloha Marks, which is particularly strong in the Hawaiian market.

23 25. Hawaiian Airlines attempted to purchase the Aloha Marks and
24 Registrations in the bankruptcy, but was outbid by Yucaipa.

25 26. Hawaiian Airlines subsequently has launched several ad campaigns
26 using confusingly similar marks, implying that Hawaiian Airlines has assumed
27 ownership of, or restarted operation of, Aloha Airlines, including the following ad
28 slogans: THIS AIRCRAFT IS FULLY EQUIPPED WITH ALOHA;

1 EXPERIENCE THE SPIRIT OF ALOHA; ALOHA ON BOARD; NON-STOP
2 ALOHA TO HAWAII; and NON-STOP ALOHA (the “ALOHA Slogan Marks”).

3 27. Tellingly, on information and belief, Hawaiian made virtually no use
4 of the word “Aloha” in its advertising slogans before Aloha Airlines filed for
5 bankruptcy – a tacit acknowledgement that Aloha was a strong mark, protected by
6 Aloha Airlines’ intellectual property rights. Since Aloha Airlines ceased
7 operations, though, it is clear that Hawaiian is making a conscious effort to
8 appropriate that trademark, attempting to capitalize improperly on the associated
9 goodwill that Aloha Airlines developed over decades.

10 28. Hawaiian Airlines also filed a U.S. federal trademark application for
11 the mark ALOHA AIRLINES SERVICES on April 16, 2013 (Serial No.
12 85/905732) for use in connection with “air transportation services” in Class 39.
13 This application was rejected by the PTO due to the Aloha Registrations, which
14 had clear priority over Hawaiian Airlines’ application.

15 29. On or about July 1, 2013, Hawaiian Airlines filed four Petitions for
16 Cancellation with the Trademark Trial and Appeal Board (“TTAB”) seeking
17 cancellation of each of the Aloha Registrations, purportedly on the basis that the
18 Aloha Marks were abandoned under 15 U.S.C. § 1119. The Petitions have been
19 consolidated into a single proceeding before the TTAB, styled *Hawaiian Airlines,*
20 *Inc. v. Yucaipa Corporate Initiatives Fund I, L.P. et al.*, Cancellation Nos.
21 92058460 (parent), 92057479, 92057493, 92057541 (the “Cancellation Action”).

22 **FIRST CLAIM FOR RELIEF**

23 **Declaratory Judgment Act, 28 U.S.C. § 2201**

24 **Declaration of No Abandonment**

25 30. Yucaipa incorporates by reference the factual allegations set forth
26 above.

27 31. Given the filing of the Cancellation Action, in which Hawaiian
28 Airlines asserts that the Aloha Registrations should be cancelled because the Aloha

1 Marks were abandoned under 15 U.S.C. §§ 1064 and 1127, an actual and
2 justiciable controversy has arisen and now exists between Yucaipa and Hawaiian
3 Airlines concerning whether the Aloha Marks have been abandoned under 15
4 U.S.C. §§ 1064 and 1127.

5 32. Yucaipa now seeks a judicial determination of its rights and duties
6 and a declaration that the Aloha Marks have not been abandoned under 15 U.S.C.
7 §§ 1119 and 1127.

8 33. Because Yucaipa intends to resume use of the Aloha Marks, as
9 evidenced by, among other things, Yucaipa's persistent efforts to market and sell
10 or license the Aloha Marks and associated Aloha Registrations, none of the Aloha
11 Marks has been "abandoned" under 15 U.S.C. §§ 1064 and 1127.

12 34. Accordingly, Yucaipa seeks, and is entitled to, a judicial declaration
13 that none of the Aloha Marks has been abandoned under 15 U.S.C. §§ 1064, 1127.

14 **SECOND CLAIM FOR RELIEF**

15 **Declaratory Judgment Act, 28 U.S.C. § 2201**

16 **Declaration of Validity of Registrations**

17 35. Yucaipa incorporates by reference the factual allegations set forth
18 above.

19 36. Given the filing of the Cancellation Action, in which Hawaiian
20 Airlines demands that the Aloha Registrations be cancelled for abandonment under
21 15 U.S.C. § 1064, an actual and justiciable controversy has arisen and now exists
22 between Yucaipa and Hawaiian Airlines concerning whether the Aloha
23 Registrations should be cancelled for abandonment under 15 U.S.C. § 1064.

24 37. Yucaipa desires a judicial determination of its rights and duties and a
25 declaration that the Aloha Registrations are valid and not subject to cancellation
26 for abandonment under 15 U.S.C. § 1064.

27 38. Because none of the Aloha Marks has been abandoned under
28 15 U.S.C. § 1127, none of the corresponding Aloha Registrations are subject to

1 cancellation under 15 U.S.C. § 1064(3), which provides for cancellation “if a
2 registered mark ... has been abandoned.”

3 39. Accordingly, Yucaipa seeks, and is entitled to, a judicial declaration
4 that the Aloha Registrations are valid and not subject to cancellation for
5 abandonment under 15 U.S.C. § 1064.

6 **THIRD CLAIM FOR RELIEF**

7 **Lanham Act - Federal Trademark Infringement - 15 U.S.C. § 1114**

8 40. Yucaipa incorporates by reference the factual allegations set forth
9 above.

10 41. Yucaipa is the owner of all rights, title, and interest in and to the
11 Aloha Registrations, including the right to sue for and recover all past, present and
12 future damages for infringement of the rights conferred by the Aloha Registrations.

13 42. The Aloha Marks are strong and distinctive, and have extensive public
14 recognition and goodwill in the U.S. and worldwide.

15 43. As described above, on information and belief, Hawaiian Airlines has
16 used and continues to use in commerce the ALOHA Slogan Marks, as well as the
17 ALOHA AIRLINES SERVICES mark (collectively, the “Accused Marks”), in
18 connection with airline services.

19 44. Yucaipa is the senior owner of the Aloha Marks, as its predecessor-in-
20 interest began use of the marks in interstate commerce prior to Hawaiian Airlines’
21 first use of the Accused Marks.

22 45. Hawaiian Airlines does not have authorization, license or permission
23 from Yucaipa to use the Aloha Marks, which are confusingly similar to the
24 Accused Marks.

25 46. On information and belief, Hawaiian Airlines’ use of the Accused
26 Marks was intended to confuse consumers into believing that Hawaiian Airlines’
27 services originated from, are licensed, sponsored or approved by, or are somehow
28 affiliated, connected, or associated with Yucaipa. Thus, Hawaiian Airlines’

1 unauthorized use of the Aloha Marks was, and continues to be, knowing,
2 intentional, and willful.

3 47. On information and belief, Hawaiian Airlines' use of the Accused
4 Marks is likely to cause confusion or mistake, or to deceive as to the source, origin,
5 affiliation or sponsorship of Hawaiian Airlines' services.

6 48. As a direct and proximate result of Hawaiian Airlines' wrongful
7 conduct, Yucaipa has been and will continue to be damaged.

8 49. Hawaiian Airlines' actions thus constitute trademark infringement in
9 violation of the Lanham Act, 15 U.S.C. §1114.

10 50. Unless an injunction is issued enjoining any continuing or future use
11 of the Accused Marks, such continuing or future use is likely to continue to cause
12 confusion, mistake or to deceive as to source, origin, affiliation or sponsorship, and
13 thereby to damage Yucaipa irreparably.

14 51. Hawaiian Airlines' activities have caused and will cause irreparable
15 harm to Yucaipa for which Yucaipa has no adequate remedy at law, in that (i) the
16 Aloha Marks comprise unique and valuable property rights that have no readily
17 determinable market value; (ii) Hawaiian Airlines' infringement constitutes an
18 interference with Yucaipa's goodwill; and (iii) Hawaiian Airlines' wrongful
19 conduct, and the damages resulting to Yucaipa, are continuing. Accordingly,
20 Yucaipa is entitled to injunctive relief pursuant to 15 U.S.C. § 1116(a).

21 52. Pursuant to 15 U.S.C. §1117(a), Yucaipa is entitled to an order:
22 (a) requiring Hawaiian Airlines to account to Yucaipa for any and all profits
23 derived by Hawaiian Airlines from its actions, to be increased in accordance with
24 the applicable provisions of law; and (b) awarding all damages sustained by
25 Yucaipa caused by Hawaiian Airlines' conduct.

26 53. Hawaiian Airlines' conduct was intentional and without foundation in
27 law, and thus, pursuant to 15 U.S.C. § 1117(a), Yucaipa is entitled to an award of
28 treble damages against Hawaiian Airlines.

1 relationship between Hawaiian Airlines and Yucaipa.

2 62. As a direct and proximate result of Hawaiian Airlines' wrongful
3 conduct, Yucaipa has been and will continue to be damaged.

4 63. Hawaiian Airlines' actions thus constitute false designation of origin
5 and unfair competition in violation of the Lanham Act, 15 U.S.C. §1125(a).

6 64. Unless an injunction is issued enjoining any continuing or future use
7 of the Accused Marks, such continuing or future use is likely to continue to cause
8 confusion, mistake or to deceive as to source, origin, affiliation or sponsorship, and
9 thereby to damage Yucaipa irreparably.

10 65. Hawaiian Airlines' activities have caused and will cause irreparable
11 harm to Yucaipa for which Yucaipa has no adequate remedy at law in that (i) the
12 Aloha Marks comprise unique and valuable property rights that have no readily
13 determinable market value; (ii) Hawaiian Airlines' infringement constitutes an
14 interference with Yucaipa's goodwill; and (iii) Hawaiian Airlines' wrongful
15 conduct, and the damages resulting to Yucaipa, are continuing. Accordingly,
16 Yucaipa is entitled to injunctive relief pursuant to 15 U.S.C. § 1116(a).

17 66. Pursuant to 15 U.S.C. §1117(a), Yucaipa is entitled to an order:
18 (a) requiring Hawaiian Airlines to account to Yucaipa for any and all profits
19 derived by Hawaiian Airlines from its actions, to be increased in accordance with
20 the applicable provisions of law; and (b) awarding all damages sustained by
21 Yucaipa caused by Hawaiian Airlines' conduct.

22 67. Hawaiian Airlines' conduct was intentional and without foundation in
23 law, and thus, pursuant to 15 U.S.C. § 1117(a), Yucaipa is entitled to an award of
24 treble damages against Hawaiian Airlines.

25 68. Hawaiian Airlines' acts make this an exceptional case under 15
26 U.S.C. § 1117(a). Yucaipa is thus entitled to an award of attorneys' fees and costs.

27
28

1 **FIFTH CLAIM FOR RELIEF**

2 **Common Law Trademark Infringement**

3 69. Yucaipa incorporates by reference the factual allegations set forth
4 above.

5 70. Yucaipa has valid and protectable common law rights in the Aloha
6 Marks.

7 71. Yucaipa is the senior owner of the Aloha Marks.

8 72. Hawaiian Airlines' conduct, as described above, constitutes
9 infringement of Yucaipa's common law rights in the Aloha Marks.

10 73. Hawaiian Airlines' use of the Accused Marks on or in connection
11 with unauthorized services, as described above, is likely to cause confusion as to
12 the origin of Hawaiian Airlines' services and is likely to cause the mistaken belief
13 that there is a relationship between Hawaiian Airlines and Yucaipa.

14 74. Hawaiian Airlines' wrongful acts have permitted and will permit it to
15 receive substantial profits based on the strength of the reputation and the
16 substantial goodwill of the Aloha Marks.

17 75. As a direct and proximate result of Hawaiian Airlines' wrongful
18 conduct, Yucaipa has been and will continue to be damaged.

19 76. Unless an injunction is issued enjoining any continuing or future use
20 by Hawaiian Airlines of the Accused Marks, such continuing or future use is likely
21 to continue to cause confusion and thereby to damage Yucaipa irreparably.

22 Yucaipa has no adequate remedy at law.

23 **SIXTH CLAIM FOR RELIEF**

24 **Common Law Unfair Competition**

25 77. Yucaipa incorporates by reference the factual allegations set forth
26 above.

27 78. Yucaipa and its predecessor, Aloha Airlines, expended significant
28 time and expense in developing the Aloha Marks, which have been very successful

1 and have developed a substantial reputation and goodwill in the marketplace.

2 79. Through its actions as described above, Hawaiian Airlines has
3 misappropriated Yucaipa's efforts and is exploiting the Aloha Marks and their
4 reputation and goodwill to market and sell its own services utilizing the Accused
5 Marks, which are confusingly similar to the Aloha Marks. These actions constitute
6 unfair competition.

7 80. As a direct and proximate result of Hawaiian Airlines' wrongful
8 conduct, Yucaipa has been and will continue to be damaged.

9 81. Unless an injunction is issued enjoining Hawaiian Airlines' unfairly
10 competitive conduct, Yucaipa will continue to be damaged irreparably. Yucaipa
11 has no adequate remedy at law.

12 82. On information and belief, Hawaiian Airlines has acted willfully,
13 intentionally and maliciously, such that Yucaipa is entitled to punitive damages.

14 **PRAYER FOR RELIEF**

15 WHEREFORE, Yucaipa respectfully prays for the following relief:

16 A. A judicial determination and declaration that none of the Aloha Marks
17 has been abandoned within the meaning of 15 U.S.C. § 1064 and 1127.

18 B. A judicial determination and declaration that Yucaipa's Registration
19 Nos. 3,071,580; 3,215,210; 2,303,334; 2,347,989 are valid and not subject to
20 cancellation for abandonment under 15 U.S.C. §§ 1064 and 1127.

21 C. An injunction ordering that Hawaiian Airlines, its officers, agents,
22 servants, employees, and attorneys, and all other persons who are in active concert
23 or participation with them, who receive actual notice of the injunction order by
24 personal or other service:

25 (1) cease all use and never use the Accused Marks, or any other mark
26 likely to cause confusion with the Aloha Marks, in connection with the promotion,
27 advertising, offering for sale, or sale, of any products or services;

28 (2) never use any false designation of origin, false representation, or

1 any false or misleading description of fact, that can, or is likely to, lead the
2 consuming public or individual members thereof, to believe that any products or
3 services produced, offered, promoted, marketed, advertised, provided or sold by
4 Hawaiian Airlines are in any manner associated or connected with Yucaipa, or are
5 licensed, approved or authorized in any way by Yucaipa;

6 (3) never represent, suggest in any fashion to any third party, or
7 perform any act that may give rise to the belief that Hawaiian Airlines, or any of its
8 goods or services, are related to, authorized or sponsored by Yucaipa;

9 (4) never unfairly compete with Yucaipa in any manner whatsoever,
10 or engage in any unfair, fraudulent or deceptive business practices that relate in
11 any way to the production, distribution, marketing, and/or sale of products and
12 services bearing the Aloha Marks;

13 (5) withdraw all pending federal and state trademark applications for
14 the Accused Marks, and never apply for or seek to register the Aloha Marks or any
15 mark that is likely to cause confusion with the Aloha Marks.

16 D. An order pursuant to 15 U.S.C. § 1116(a) directing Hawaiian Airlines
17 to file with this Court and to serve upon Yucaipa's counsel, within thirty (30) days
18 after the entry and service on Hawaiian Airlines of an injunction, a report in
19 writing and under oath setting forth in detail the manner and form in which
20 Hawaiian Airlines has complied with the injunction.

21 E. A judgment that, by the acts complained of above, Hawaiian Airlines
22 has infringed the Aloha Marks in violation of 15 U.S.C. § 1114.

23 F. A judgment that, by the acts complained of above, Hawaiian Airlines
24 has created a false designation of origin and/or a false representation of
25 association, in violation of 15 U.S.C. § 1125(a).

26 G. A judgment that, by the acts complained of above, Hawaiian Airlines
27 has engaged in common law trademark infringement.

28 H. A judgment that, by the acts complained of above, Hawaiian Airlines

1 has engaged in common law unfair competition.

2 I. An order pursuant to 15 U.S.C. § 1117(a) compelling Hawaiian
3 Airlines to account to Yucaipa for any and all profits derived from its unlawful and
4 infringing conduct.

5 J. An order awarding Yucaipa: (i) pursuant to 15 U.S.C. § 1117(a),
6 Yucaipa's actual damages, as well as all of Hawaiian Airlines' profits or gains of
7 any kind from its acts of trademark infringement, false designation of origin, and
8 unfair competition, including a trebling of those damages; and (ii) punitive
9 damages based on Hawaiian Airlines' unfair competition under California common
10 law.

11 K. An order pursuant to 15 U.S.C. § 1117(a) finding that this is an
12 exceptional case and awarding Yucaipa its reasonable attorneys' fees.

13 L. An order awarding Yucaipa all of its costs, disbursements and other
14 expenses incurred due to Hawaiian Airlines' unlawful conduct, pursuant to
15 15 U.S.C. § 1117(a).

16 M. An order awarding Yucaipa interest.

17 N. An order awarding Yucaipa such other relief as the Court may deem
18 appropriate.

19 **DEMAND FOR JURY TRIAL**

20 Pursuant to Rule 38 of the Federal Rules of Civil Procedure and Local Rule
21 38-1, Yucaipa hereby demands a trial by jury.

22

23 Dated: December 9, 2013

LATHAM & WATKINS LLP

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By: 

David B. Hazlehurst
Jennifer L. Barry

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Attorneys for Plaintiff
Yucaipa Corporate Initiatives Fund I, LP

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above document has been served on Hawaiian Airlines, Inc. on December 11, 2013 via email, per the agreement of the parties, to:

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