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

Proceeding	91169763
Party	Plaintiff Malie Inc.
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Submission	Motion for Summary Judgment
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Date	05/05/2006
Attachments	Opposition No. 91169763 - Opposer's MSJ and Memo in Support of Opposer's MSJ.PDF ( 58 pages )(2050135 bytes )

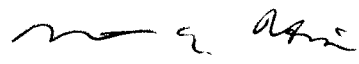
**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MALIE, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91169763
v.	)	Serial No. 78/582924
	)	
MALIE KAI CHOCOLATES LLC,	)	
	)	
Applicant.	)	
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**OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

Opposer MALIE, INC. (“Opposer”), by and through its undersigned attorney, hereby moves for summary judgment pursuant to Rule 56(a), Fed. R. Civ. P., and 37 CFR § 2.127(e)(1). As set forth in the attached memorandum and based on the attached exhibits and declaration, Opposer respectfully submits that its opposition to trademark Application Serial No. 78/582924 must be sustained, as there are no genuine issues of fact and Opposer is entitled to judgment as a matter of law.

DATED: Honolulu, Hawaii, 5/5, 2006.

  
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**MEMORANDUM IN SUPPORT OF  
OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

**I. INTRODUCTION.**

Opposer MALIE, INC. (“Opposer”) files this memorandum in support of its Motion For Summary Judgment (the “Motion”). As discussed below, Opposer respectfully submits that the Motion must be granted and that its opposition to trademark Application Serial No. 78/582924 (the “Application”), filed by Applicant MALIE KAI CHOCOLATES LLC (“Applicant”), must be sustained pursuant to Section 2(d) of the Lanham Act because Opposer has priority of use of the mark “MALIE”, and there is a likelihood of confusion between Applicant’s mark “MALIE KAI” as applied to the chocolate goods of the Application, and Opposer’s mark “MALIE” as applied to candles and cosmetics, so Opposer will be damaged.

**II. FACTUAL AND PROCEDURAL BACKGROUND.**

This opposition is based on Opposer’s use of “MALIE” since at least as early as April 16, 2004, as confirmed by U.S. Registration No. 3,044,014 (“Opposer’s Registration”) for the trademark “MALIE” (“Opposer’s Mark”) in connection with “candles” and U.S. Trademark Application Serial Number 76/621291 (“Opposer’s Application”) for Opposer’s Mark in

connection with “scented room sprays, scented linen sprays, scented linen washes, soaps, and cosmetics and cleaners, namely body cleaners, body cream and perfume” in International Class 3. Opposer’s Registration was issued by the U.S. Patent and Trademark Office (“USPTO”) on January 17, 2006. A true and correct copy of this registration is attached hereto as Exhibit “A”. See Declaration of Shaun Roberts (“Roberts Dec.”) and Declaration of Counsel (“Counsel Dec.”) attached hereto. Opposer’s Application was filed on November 19, 2004, and is presently involved in unrelated opposition proceedings.

Opposer’s cosmetics, candles and other goods covered by Opposer’s Registration and Opposer’s Application are hereinafter collectively referred to as the “Opposer’s Goods.”

As stated in the Roberts Dec., Opposer has used Opposer’s Mark in connection with scented room sprays, scented linen sprays, soaps and perfume since at least as early as April 16, 2004, and it has continuously used Opposer’s Mark to the present.

On March 8, 2005, Applicant filed the subject application Serial No. 78/582924 (“Applicant’s Application”) to register the mark, “MALIE KAI” (“Applicant’s Mark”) in connection with “chocolate.” As stated in Applicant’s Application, Applicant has used Applicant’s Mark in connection with “chocolate” since September 2004. See Exhibit “B” attached hereto.

On December 6, 2005, Applicant’s Application was published for opposition. Opposer timely filed its Notice of Opposition on February 22, 2006. Applicant filed its Answer on April 18, 2006.

Opposer respectfully submits that this opposition must be sustained for the reasons set forth below.

### III. ARGUMENT.

#### A. Opposer Has Standing To Oppose the Application.

“Standing is a threshold inquiry directed solely to establishing a plaintiff’s interest in the proceeding. The purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, i.e. where a plaintiff is no more than a mere intermeddler.” Harjo v. Pro Football Inc., 30 USPQ 2d 1828, 1830 (TTAB 1994). “As in opposition proceedings, a Petitioner for Cancellation need not prove actual damage. Traditionally, all the petitioner need show is a likelihood of damage from the continuing registration of the mark.” See 3 McCarthy on Trademarks and Unfair Competition, § 20:46 at 20-93 (4th ed. 2005). If registration of Applicant’s Mark is allowed, Applicant would gain the prima facie exclusive right to use the “MALIE KAI” mark in commerce on all goods related to Opposer’s Goods, so that confusion in trade would result to the detriment of Opposer. As shown from the examples below, cosmetics and chocolate are related goods, as are candles and chocolate. In addition, Applicant’s Mark is pronounced identically to Opposer’s Mark, except for the omission of the word “KAI”. “Kai” means “sea” in the Hawaiian language. The Application is also unrestricted in terms of the channels of trade, and therefore, it is assumed that Applicant’s Goods are sold everywhere that is normal for such goods. These channels will be the same as those for Opposer’s related goods. Thus, if Applicant is allowed to register Applicant’s Mark, a cloud will be placed on Opposer’s title in and to Opposer’s Mark and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods, all to the damage and harm of Opposer. See Dec.

In addition, registration of Applicant’s Mark would grant Applicant nationwide priority as of its filing date, 15 U.S.C. 1057(c), so that Opposer would be vulnerable to infringement claims by Applicant when Opposer expands its actual use of the Mark to new territories or

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