

TTAB

JOHN JOSEPH HALL  
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ATTORNEY FOR REGISTRANT

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

PLEASANT TRAVEL SERVICE, )  
a California corporation, )  
Petitioner ) Cancellation No. 92044469  
v. ) REGISTRANT'S OPPOSITION TO  
MARISOL, LLC, a limited ) PETITIONER'S MOTION TO AMEND  
liability company, ) PLEADINGS TO CONFORM TO EVIDENCE,  
Registrant ) COMBINED STATEMENT OF REASONS AND  
MEMORANDUM OF POINTS AND  
AUTHORITIES, DECLARATION OF  
JOHN JOSEPH HALL

COMBINED STATEMENT OF REASONS AND  
MEMORANDUM OF POINTS AND AUTHORITIES

Petitioner's motion to amend pleadings to conform to evidence  
should be denied for the following reasons:

I. THE PROBATIVE EVIDENCE OF RECORD PROVES THAT THE FOOD FACILITY  
AT PETITIONER'S ROYAL LAINA RESORT LOCATION 3 WHICH WAS OPERATED AS  
BEACHCOMBERS WAS ALWAYS REFERRED TO AS A RESTAURANT ONLY.

A. Petitioner's Exhibit 39 Shows the Use of Beachcombers  
Restaurant at Location 3. (Exhibit 1 to Hall Declaration)

1       Petitioner's (P's) Exhibit 39 is a portion of a sales kit and its  
2 page 2 contains a property map (P's Bates No. 0039). P's Exhibit 39  
3 is attached to Hall declaration as H Exh 1-1,2,3. H Exh 1-2 lists  
4 locations of various facilities of Petitioner's Royal Lahaina Resort  
5 and shows location 3 as Beachcombers.(P's Bates No. 0039).

6  
7 Petitioner's vice-president Glenn Hogan testified that the property  
8 map shows that" ... number 3 is Beachcombers." GH Test. Depo.

9 Tr.,Vol.I, P.87, L 9, taken on December 28, 2007. The third page of  
10 P's Exh 39; H Exh.1-3, P's Bates No. 0044, has a list of food and  
11 beverage services, and shows in pertinent part:

12  
13       "BEACHCOMERS RESTAURANT

14       Serving a wide variety of Pacific Rim favorites, including  
15       Hawaiian, Thai, Japanese, Chinese and American specialties."

16       Glenn Hogan further testified that the sales kit (P's Exh.39;  
17 H Exh. 1) was used by Petitioner during " Late 1990s and 2000s".

18       When asked by Petitioner's attorney, [referring to the kit of  
19 P's Exh.39; H Exh.1)]:

20       "Q. Is it still in use? A I believe it is." GH Test. Depo. Tr.,  
21 Vol.I, P.87, LL 15-20, taken on December 28, 2007.

22       Registrant notes that neither Glenn Hogan's testimony above nor  
23 P's Exh.39, H Exh.1-2, refers to location 3 as a banquet facility.  
24 Registrant notes further that neither Glenn Hogan's above testimony  
25 nor P's Exh 39, H Exh 1 refers to the presence or operation of a DON  
26 THE BEACHCOMBER restaurant at location 3 or anywhere else during the  
27 period "Late 1990s and 2000s" to December 28, 2007.  
28

1        **B. In November, 2003, the Food Establishment at Location 3 Was**  
2 **Operating as Beachcombers, And as a Restaurant, But Not as DON THE**  
3 **BEACHCOMBER.**

4  
5        In his 30(b)(6) discovery deposition, Glenn Hogan testified as  
6 follows in pertinent part:

7        "Q All right. But what I am asking you is: That in November of  
8 2003, was the restaurant at location 3 operating under the  
9 name of Beachcombers?

10        A It was operating under Beachcombers here."

11        GH Disc.Depo.Tr., P.88, LL 7-10, taken on April 6, 2006.

12        The above testimony confirms the discussion under Point A above  
13 showing that a restaurant named Beachcombers was at location 3, and  
14 was operating as a restaurant, not a banquet facility.  
15

16        Further, Registrant notes that Petitioner's attorney did not  
17 object to the above testimony or examine the witness to claim that  
18 Beachcombers was operating as a banquet facility in November, 2003  
19 and not as a restaurant. Nor did the witness change his testimony by  
20 claiming location 3 was a banquet facility and not a restaurant.  
21

22        **C. Petitioner's Exhibits of Yellow Page Hawaii Telephone**  
23 **Directories Show Beachcombers Only Under the Heading Restaurants**  
24 **During the Period 1994 through 2007, Not Don the Beachcomber.**

25        In his testimony deposition taken on December 28, 2007, Glenn  
26 Hogan, Petitioner's Vice-President, testified regarding Beachcombers  
27 being listed in the Yellow Page Hawaii Telephone Directories as a  
28

1 restaurant continuously during the period beginning 1994 through 2007  
2 as follows: (Registrant notes no listing of Beachcomber as a banquet  
3 facility)

4 "Q. Mr. Hogan, for each year Pleasant Travel Service placed ads  
5 in the Yellow Pages for its Beachcombers' restaurants, as  
6 reflected in the exhibits 9 through 20, was there a restaurant  
operating at the Royal Lahaina Resort under the name  
'Beachcombers'?

7 A. For what period of time?

8 Q. Each year that the company placed a Yellow Pages ad.

9 A. Yes." (GH Test.Depo.Tr.Vol.I, P.40, LL 2-10)

10 P's Exhibit 9, H Exhibit 2 is a copy of listings of restaurants  
11 under the heading restaurants for June, 1994 and lists Beachcombers  
12 under the heading of restaurants. (P's Exh 9; H Exh. 2-1,2-2)

13 P's Exhibit 20 is a copy of listings of restaurants under the  
14 heading Restaurants for the year 2007 and lists Beachcombers  
15 under the heading of restaurants. (P's Exh.20; H Exh 3-1, 3-2)

16 Registrant notes that none of the listings of restaurants in the  
17 Yellow Pages of Hawaii telephone directories during the period 1994  
18 to 2007 lists a restaurant under the name DON THE BEACHCOMBER as  
19 shown by Petitioner's Exhibits 9 through 20. Registrant only copied  
20 Exhibits 9 and 20 as H Exh. 2-1,2-2 and 3-1, 3-2 after noting that  
21 all of Exhibits 9 through 20 listed only Beachcomber as a restaurant  
22 and not Don the Beachcomber.  
23  
24

25 Petitioner's own evidence fails to show any telephone listing of  
26 a Don the Beachcomber restaurant during the period 1994 to 2007.  
27  
28

1       **D. The Record Has No Probative Evidence that a Restaurant or a**  
2 **Banquet Facility Was Open and Operating Under the Name Don the**  
3 **Beachcomber During the Year 2002 at Location 3 of the Royal Lahaina**  
4 **Resort Property Map, Petitioner's Exhibit 39, P 2; H Exh 1-2.**

5  
6       Petitioner purports to claim that Exhibit 46 shows that a  
7 restaurant under the name Don the Beachcombers was open and operating  
8 during the year 2002. An examination of Exhibit 46, page 2 shows only  
9 that a Don the Beachcombers restaurant was "(Opening Soon)".

10  
11       A restaurant that is advertised as "Opening Soon" in the absence  
12 of probative evidence that the restaurant was open and operating on a  
13 specified date, is no proof that the restaurant was operating under  
14 the name Don the Beachcomber in 2002. See P's Exh 46; H Exh 4-1,4-2.

15       Registrant notes that this advertisement is of a restaurant, not  
16 a banquet facility. The word banquet is absent from Exh 46;H Exh 4-2.

17  
18       **E. Petitioner's Own Evidence Shows That Only the Beachcomber**  
19 **Restaurant Provided Banquets, And There Was No Operating Don the**  
20 **Beachcomber Restaurant for Banquets or Otherwise.**

21       Glenn Hogan, Petitioner's Vice-President, testified regarding  
22 Exhibits 47-49 in his testimony deposition Vol.1, taken on December  
23 28, 2007.

24  
25       A copy of Exhibit 47 is attached to the Hall declaration as  
26 H Exhibit 5. A copy of Exhibit 48 is attached to the Hall declaration  
27 as H Exhibit 6. A copy of Exhibit 49 is attached to the Hall  
28 declaration as H Exhibit 7.



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