

TTAB

1 JOHN JOSEPH HALL
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5 ATTORNEY FOR REGISTRANT

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

11 PLEASANT TRAVEL SERVICE,)
12 a California corporation,)
13 Petitioner) Cancellation No. 92044469
14 v.)
15 MARISOL, LLC, a limited) REGISTRANT'S OPPOSITION TO
16 liability company,) PETITIONER'S MOTION TO AMEND
17 Registrant) PLEADINGS TO CONFORM TO EVIDENCE,
18) COMBINED STATEMENT OF REASONS AND
19) MEMORANDUM OF POINTS AND
20) AUTHORITIES, DECLARATION OF
21) JOHN JOSEPH HALL

20 **COMBINED STATEMENT OF REASONS AND
MEMORANDUM OF POINTS AND AUTHORITIES**

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

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

26 **A. Petitioner's Exhibit 39 Shows the Use of Beachcombers**
27 **Restaurant at Location 3. (Exhibit 1 to Hall Declaration)**
28

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).

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:

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

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

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

13 The above testimony confirms the discussion under Point A above
14 showing that a restaurant named Beachcombers was at location 3, and
15 was operating as a restaurant, not a banquet facility.
16

17 Further, Registrant notes that Petitioner's attorney did not
18 object to the above testimony or examine the witness to claim that
19 Beachcombers was operating as a banquet facility in November, 2003
20 and not as a restaurant. Nor did the witness change his testimony by
21 claiming location 3 was a banquet facility and not a restaurant.
22

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

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

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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