

---

**To:** Quiksilver, Inc (trademarks@quiksilver.com)  
**Subject:** TRADEMARK APPLICATION NO. 78618407 - QUIKSILVER - N/A  
**Sent:** 12/26/2006 1:12:58 PM  
**Sent As:** ECOM104@USPTO.GOV  
**Attachments:** Attachment - 1  
Attachment - 2  
Attachment - 3  
Attachment - 4  
Attachment - 5  
Attachment - 6  
Attachment - 7  
Attachment - 8  
Attachment - 9  
Attachment - 10  
Attachment - 11  
Attachment - 12  
Attachment - 13  
Attachment - 14  
Attachment - 15  
Attachment - 16  
Attachment - 17  
Attachment - 18  
Attachment - 19  
Attachment - 20  
Attachment - 21  
Attachment - 22  
Attachment - 23  
Attachment - 24  
Attachment - 25  
Attachment - 26  
Attachment - 27  
Attachment - 28  
Attachment - 29  
Attachment - 30  
Attachment - 31  
Attachment - 32  
Attachment - 33  
Attachment - 34  
Attachment - 35  
Attachment - 36  
Attachment - 37  
Attachment - 38

- Attachment - 39
- Attachment - 40
- Attachment - 41
- Attachment - 42
- Attachment - 43
- Attachment - 44
- Attachment - 45
- Attachment - 46
- Attachment - 47
- Attachment - 48
- Attachment - 49
- Attachment - 50
- Attachment - 51
- Attachment - 52
- Attachment - 53
- Attachment - 54
- Attachment - 55
- Attachment - 56
- Attachment - 57
- Attachment - 58
- Attachment - 59
- Attachment - 60
- Attachment - 61
- Attachment - 62
- Attachment - 63
- Attachment - 64
- Attachment - 65
- Attachment - 66
- Attachment - 67
- Attachment - 68
- Attachment - 69
- Attachment - 70
- Attachment - 71
- Attachment - 72
- Attachment - 73
- Attachment - 74
- Attachment - 75
- Attachment - 76

---

**[Important Email Information]**  
**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 78/618407

APPLICANT: Quiksilver, Inc

**CORRESPONDENT ADDRESS:**

Attn: Legal Dept.Trademarks  
Quiksilver, Inc.  
15202 Graham Street  
Huntington Beach CA 92649-1109

**RETURN ADDRESS:**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

If no fees are enclosed, the address should  
include the words "Box Responses - No Fee."

MARK: QUIKSILVER

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

trademarks@quiksilver.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/618407

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the point(s) at issue in the final action. TMEP §715.03(a). Therefore, the request for reconsideration is **denied** and the final refusal under Section 2(d) for U.S. Registration Nos. 2346307 and 1080515 are continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The refusal under Section 2(d) for U.S. Registration Nos. 2288626 and 1876013 is withdrawn based upon the amended identification of goods. The refusal under Section 2(d) for U.S. Registration No. 2286955 is withdrawn because the registration has been cancelled.

The filing of a request for reconsideration does *not* extend the time for filing a proper response to the final action, which runs from the date the final action was mailed. 37 C.F.R. §2.64(b); TMEP §§715.03 and 715.03(c).

**MAINTAINED REFUSAL – 2(d)s**

The refusal to register is MAINTAINED under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the mark for which registration is sought so resembles the marks shown in U.S. Registration Nos. 2346307 and 1080515 as to be likely, when used on or in connection with the identified goods/services, to cause confusion, or to cause mistake, or to deceive.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal under Section 2(d) is MAINTAINED.

Taking into account the relevant *DuPont* factors, a likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to

origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Trademark Act Section 2(d) bars registration where an applied-for mark so resembles a registered mark that it is likely, when applied to the goods and/or services, to cause confusion, mistake or to deceive the potential consumer as to the source of the goods and/or services. TMEP §1207.01. The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression, and the relatedness of the goods and/or services. The overriding concern is to prevent buyer confusion as to the source of the goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (C.C.P.A. 1974).

The applicant applied to register QUIKSILVER for goods including, but not limited to, "protective helmets for use in sports; recorded materials featuring surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding, pre-recorded video tapes, digital video discs and CD-ROMs featuring surfing, bodyboarding, snowboarding, skiing, kite boarding and skateboarding; sporting and gymnastic wear, ski wear and snowboard wear namely ski suits, ski pants, ski trousers, ski jackets, snowboard pants, snowboard trousers and snowboard jackets, skateboard wear, surf caps, surf hoods, slippers, boots, shoes, beach shoes, thonged and strapped sandals, sporting and gymnastic footwear, athletic shoes, boots for sports, snow boots, snowboard boots, ski boots, après ski boots, kiteboard boots, surfboard boots, wakeboard boots; Surfboards, bodyboards, kneeboards, wakeboards, sailboards, surf skis, snowboards, snow skis, water-skis, skateboards, kite boards; sporting accessories namely leg ropes and security leashes for sporting apparatus, sporting apparatus being ropes especially adapted and fitted as tow-in ropes and skiing ropes, ski bindings, surfboard deck grips, web gloves; swim fins including swim fins for bodyboarding, wax for skis and surfboards; covers and protective bags for sporting apparatus namely bags for surfboards, bodyboards, kneeboards, wakeboards, sailboards, surf skis, snowboards, snow skis, water-skis, skateboards and kiteboards; wakeboard bindings; snowboard bindings; bindings for skis; wax combs."

The registered marks are QUICKSILVER for "sporting goods, namely, water skis, kneeboards and wake boards" and QUICKSILVER for "skateboards."

Despite applicant's arguments, the marks are highly similar in that the marks contain QUIKSILVER (or the phonetic equivalent, QUICKSILVER).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *Online Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

All of the marks are used to identify water skis, kneeboards, wake boards, and/or skateboards. Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that

the goods and/or services listed therein, namely, water skis, kneeboards, wake boards, and/or skateboards, are of a kind that may emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

The same consumers will be exposed to the goods identified with both of the marks. The similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion. Any doubt regarding a likelihood of confusion is resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); TMEP §§1207.01(d)(i).

For the foregoing reasons, the refusal of registration pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), is believed proper and is made MAINTAINED.

/Carol Spils/  
Trademark Attorney  
United States Patent and Trademark Office  
Law Office 104  
(571)272-9226

**Note:**

**In order to avoid size limitation constraints on large e-mail messages, this Office Action has been split into 2 smaller e-mail messages. The Office Action in its entirety consists of this message as well as the following attachments that you will receive in separate messages:**

Email 1 includes the following 45 attachments

1. 75176585P001OF003
2. 75176585P002OF003
3. 75176585P003OF003
4. 75227517P001OF002
5. 75227517P002OF002
6. 75261301P001OF002
7. 75261301P002OF002
8. 75261302P001OF001
9. 75468335P001OF003
10. 75468335P002OF003
11. 75468335P003OF003
12. 75468557P001OF002
13. 75468557P002OF002
14. 75687623P001OF003
15. 75687623P002OF003
16. 75687623P003OF003
17. 75790621P001OF003
18. 75790621P002OF003
19. 75790621P003OF003
20. 75814508P001OF002
21. 75814508P002OF002
22. 76109257P001OF002
23. 76109257P002OF002
24. 76170700P001OF003
25. 76170700P002OF003
26. 76170700P003OF003
27. 76520855P001OF003
28. 76520855P002OF003
29. 76520855P003OF003
30. 76537255P001OF003
31. 76537255P002OF003
32. 76537255P003OF003
33. 76537256P001OF003
34. 76537256P002OF003
35. 76537256P003OF003
36. 76571002P001OF002
37. 76571002P002OF002
38. 78161759P001OF002
39. 78161759P002OF002
40. 78171840P001OF003
41. 78171840P002OF003
42. 78171840P003OF003
43. 78293762P001OF003

44. 78293762P002OF003
45. 78293762P003OF003

Email 2 includes the following 31 attachments

1. 78589778P001OF002
2. 78589778P002OF002
3. 78595136P001OF002
4. 78595136P002OF002
5. 78629919P001OF003
6. 78629919P002OF003
7. 78629919P003OF003
8. 78641133P001OF003
9. 78641133P002OF003
10. 78641133P003OF003
11. 79000117P001OF002
12. 79000117P002OF002
13. 79000532P001OF002
14. 79000532P002OF002
15. 79000533P001OF002
16. 79000533P002OF002
17. 79001170P001OF002
18. 79001170P002OF002
19. 79005555P001OF004
20. 79005555P002OF004
21. 79005555P003OF004
22. 79005555P004OF004
23. 79005581P001OF003
24. 79005581P002OF003
25. 79005581P003OF003
26. 79008116P001OF003
27. 79008116P002OF003
28. 79008116P003OF003
29. 79009951P001OF003
30. 79009951P002OF003
31. 79009951P003OF003

Please ensure that you receive all of the aforementioned attachments, and if you do not, please contact the assigned-examining attorney.

**TYPED DRAWING**

**Serial Number**

75176585

**Status**

REGISTERED

**Word Mark**

KANA BEACH

**Standard Character Mark**

No

**Registration Number**

2436065

**Date Registered**

2001/03/20

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

KANA BEACH PRIVATE LIMITED COMPANY FRANCE Z.A. Pen Ar Menez 29280  
LOCMARIA PLOUZANE FRANCE

**Goods/Services**

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:  
diving suits; gloves for divers; optical goods, namely, sunglasses,  
eyeglasses, eyeglass frames and eyeglass cases.

**Goods/Services**

Class Status -- ACTIVE. IC 025. US 022 039. G & S: bathing caps,  
bathing shorts, bathing trunks, bath slippers; headbands; belts; hats;  
socks; athletic footwear, namely, football shoes; beach shoes, ski  
boots, athletic footwear, gymnastic shoes; slippers; wet suits for water  
skiing; ear muffs; rope-soled sandals, espadrille; gloves; clothing,  
namely, T-shirts, sweatshirts, long sleeve shirts, short-sleeve  
shirts, undershirts, polo shirts, pullover shirts, jersey shirts,  
vests, jackets, parkas, overalls, coveralls, trousers, pants, walking  
shorts, skirts, dresses, tops, brassieres, swimwear, underwear, hats,  
caps, and stockings; underwear, sweat absorbent underwear; children,  
surf wetsuits, windsurf wetsuits, water ski wet suits, diving  
wetsuits, ski suits, snow suits, snowboard suits, outdoor suits.

**Goods/Services**

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S:  
skateboards; sailboards; surfboards; rollerskates; elbow guards for  
athletic use; knee guards for athletic use; shin guards for athletic  
use; water skis and surf skis; ear plugs for divers, scuba diving  
masks and skin diving masks.

**Foreign Country Name**

FRANCE

**Foreign Priority**

FOREIGN PRIORITY CLAIMED

**Foreign Application Number**

96635665

**Foreign Filing Date**

1996/07/18

**Foreign Registration Number**

96635665

**Foreign Registration Date**

1996/07/18

**Foreign Expiration Date**

2006/07/18

**Foreign Country Name**

FRANCE

**Foreign Priority**

FOREIGN PRIORITY CLAIMED

**Foreign Application Number**

96624124

**Foreign Filing Date**

1996/04/30

**Foreign Registration Number**

96624124

**Foreign Registration Date**

1996/04/30

**Foreign Expiration Date**

2006/04/30

**Filing Date**

**Print: Dec 26, 2006**

**75176585**

1996/10/03

**Examining Attorney**  
LAMOthe, LESLEY

**Attorney of Record**  
JO M FAIRBAIRN

Print: Dec 26, 2006

75227517

**DESIGN MARK**

**Serial Number**

75227517

**Status**

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

**Registration Number**

2220842

**Date Registered**

1999/01/26

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(2) DESIGN ONLY

**Owner**

ILC TRADEMARK CORPORATION CORPORATION BR.VIRGIN ISLANDS TROPIC ISLE  
BUILDING PO BOX 3443 ROAD TOWN, TORTOLA BR.VIRGIN ISLANDS

**Goods/Services**

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S:  
surfboards; windsurfing boards; skateboards; kneeboards; wakeboards;  
skimboards; snow skis; snow ski poles; water skis; volleyballs; and  
toys, namely, board games; toy cars; beach balls, kites and windsocks.  
First Use: 1971/12/01. First Use In Commerce: 1971/12/01.

**Prior Registration(s)**

1099609;1151095;1163645;AND OTHERS

**Filing Date**

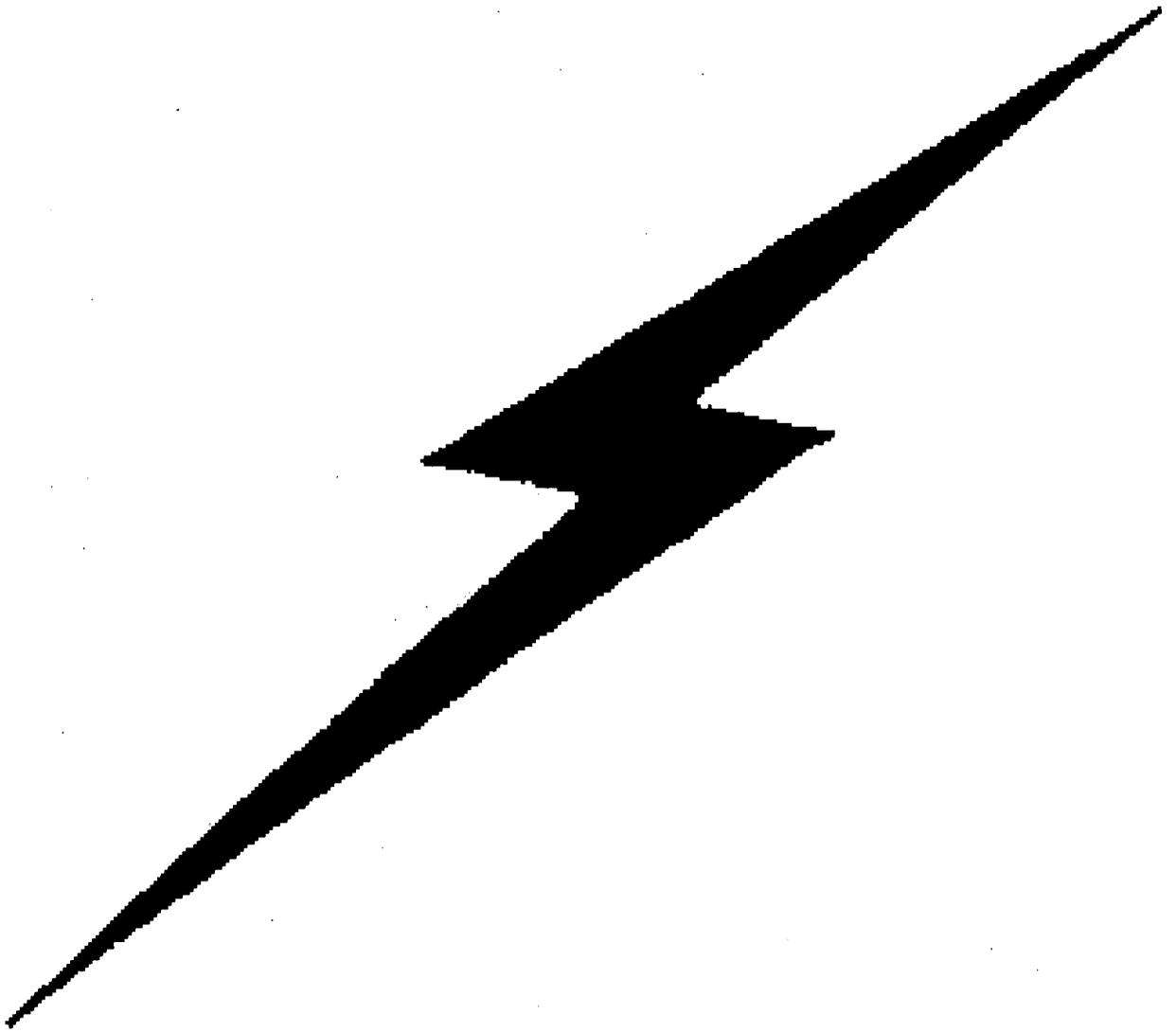
1997/01/17

**Examining Attorney**

GRUNDY, JUDITH

**Attorney of Record**

PAUL B EPNER



Print: Dec 26, 2006

75261301

**DESIGN MARK**

**Serial Number**

75261301

**Status**

CANCELLED - SECTION 8

**Registration Number**

2140941

**Date Registered**

1998/03/03

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(2) DESIGN ONLY

**Owner**

Hang Ten International CORPORATION CALIFORNIA 705 12th Avenue San  
Diego CALIFORNIA 92101

**Goods/Services**

Class Status -- SECTION 8 - CANCELLED. IC 028. US 022 023 038 050.  
G & S: surfboards, skateboards, snowboards, water skis, wakeboards,  
kneeboards, bodyboards. First Use: 1965/06/01. First Use In  
Commerce: 1965/06/01.

**Prior Registration(s)**

0811306;1033976;1143042

**Filing Date**

1997/03/21

**Examining Attorney**

SLONIM, HOPE



**TYPED DRAWING**

**Serial Number**

75261302

**Status**

CANCELLED - SECTION 8

**Word Mark**

HANG TEN

**Standard Character Mark**

No

**Registration Number**

2139079

**Date Registered**

1998/02/24

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

Hang Ten International CORPORATION CALIFORNIA 705 12th Avenue San Diego CALIFORNIA 92101

**Goods/Services**

Class Status -- SECTION 8 - CANCELLED. IC 028. US 022 023 038 050. G & S: surfboards, skateboards, snowboards, water skis, wakeboards, kneeboards, bodyboards. First Use: 1975/01/24. First Use In Commerce: 1975/01/24.

**Prior Registration(s)**

0811306;1033976;1143042

**Filing Date**

1997/03/21

**Examining Attorney**

SLONIM, HOPE

**DESIGN MARK**

**Serial Number**

75468335

**Status**

REGISTERED

**Registration Number**

2688885

**Date Registered**

2003/02/18

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(2) DESIGN ONLY

**Owner**

McCoy, Jeffrey A. INDIVIDUAL UNITED STATES 33752 Robles Drive Dana Point CALIFORNIA 92629

**Goods/Services**

Class Status -- ACTIVE. IC 025. US 022 039. G & S: CLOTHING AND HEADWEAR, NAMELY, T-SHIRTS, TANK TOPS, SWEATSHIRTS, GOLF SHIRTS, CASUAL SHIRTS, KNIT SHIRTS, TRUNKS, SHORTS, SWEAT PANTS, OVERALLS, JACKETS, SNOWBOARD PANTS, SKI PANTS, JACKETS, PARKAS, BEANIES, HATS, BANDANNAS, HEAD BANDS, SUN VISORS, WET SUITS, SHIRTS IN THE NATURE OF RASH GUARDS, SKI BIBS, SKI SUITS. First Use: 1999/06/00. First Use In Commerce: 1999/06/00.

**Goods/Services**

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S: SPORTING GOODS, NAMELY, SURFBOARDS, SNOWBOARDS, BODY BOARDS, SKIM BOARDS, SKATEBOARDS, ROLLER SKATES, IN-LINE SKATES, SNOW SKIS, WATER SKIS, KNEE BOARDS, SWIM FINS, BODY BOARD FINS, SURFBOARD FINS; LEASHES FOR SURFBOARDS AND BODYBOARDS; DECK GRIPS FOR USE WITH SURF BOARDS; SURFBOARD WAX AND CASES AND BAGS FOR THE AFORESAID GOODS. First Use: 1999/06/00. First Use In Commerce: 1999/06/00.

**Filing Date**

1998/04/15

**Examining Attorney**

BAIRD, MICHAEL

**Print: Dec 26, 2006**

**75468335**

**Attorney of Record**  
STEVEN J NATAUPSKY

