

PTO Form 1857 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78618407
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
REMARKS	
<p><b>1. <u>Section 2(d) Refusal</u></b></p> <p>The Examining Attorney has continued the refusal of registration pursuant to Trademark Act Section 2(d) on the grounds that there is a likelihood of confusion between Applicant's mark QUIKSILVER and the prior registered marks QUICKSILVER for "comic books featuring a fictional character with super-human powers", Reg. No. 2,288,626; QUICKSILVER for "life jackets and batteries", Reg. No. 2,286,955; QUICKSILVER for "sporting goods, namely, water skis, kneeboards and wakeboards", Reg. No. 2,346,307; QUICKSILVER for "vinyl floor coverings", Reg. No. 1,876,013; and QUICKSILVER for "skateboards", Reg. No. 1,080,515 (collectively, the "Cited Registrations"). Applicant respectfully disagrees with the Examining Attorney's Section 2(d) refusal and submits the following evidence and arguments in support of registration.</p> <p><b>A. <u>Confusion is Not Likely Between Applicant's Mark</u></b></p> <p><b><u>And The Marks In The Cited Registrations.</u></b></p> <p>1. <u>The '626 Reg.</u></p> <p>Applicant notes that it owns Reg. No. 2,142,055 for QUIKSILVER, which predates the '626 Reg. and covers goods in Class 16. With regard to the conflict between the instant application and the '626 Reg., Applicant has deleted the Class 16 goods from the application. Therefore, the refusal of registration based on the '626 Reg. is moot and should be withdrawn.</p> <p>2. <u>The '955 Reg.</u></p> <p>Applicant notes that according to the Trademark Office's TESS online registration status database, the '955 Reg. was not renewed prior to the expiration of the grace period for filing a Section 8 Declaration on April 19, 2006. Because the cited '955 Reg. is dead, it should be removed as a bar to registration of Applicant's instant application. Such action is respectfully requested.</p>	

### 3. The '307 Reg.

The Examining Attorney has refused registration on the basis of the '307 Reg. for QUICKSILVER in connection with "sporting goods, namely, water skis, kneeboards and wake boards". Applicant notes that it is also the registrant of Reg. No. 2,106,684, which predates the cited '307 Reg. Among other things, Applicant's '684 Reg. covers retail store services in the fields of clothing, headwear, footwear, wetsuits, luggage, bags, sunglasses, watches, jewelry and accessories. Applicant operates retail stores in locations across the United States, including in major shopping centers and malls in many major metropolitan areas. It began as and continues to be a provider of surfing-related apparel, and its founders are widely credited with creating innovative surfing "boardshorts" (shorts specifically designed for wear while surfing) that have been used and widely promoted by world-famous surfers and athletes the world over. See <http://www.k5.com/getbrand.asp?b=99> . Applicant's longstanding use of the QUICKSILVER mark in connection with the mass-market sale of sportswear, particularly surfing-, skateboarding-, beach-lifestyle- and watersports-related apparel speaks for itself in establishing Applicant's QUICKSILVER mark as a leading, widely recognized brand in the field. The longstanding coexistence on the Principal Register of Applicant's '684 Reg. with the cited '307 Reg. should be sufficient to cause the Examining Attorney to reconsider and withdraw the '307 Reg. as basis for the refusal of registration under Section 2(d) in the instant application for the QUICKSILVER mark.

### 4. The '013 Reg.

The Examining Attorney has maintained its refusal of registration based on the '013 Reg. for QUICKSILVER, which covers "vinyl flooring". Applicant has amended the identification of goods in Class 27 to exclude vinyl floor coverings. Applicant submits that its proposed Class 27 goods would be sold exclusively directly from Applicant through its own Quiksilver and Quiksilver Boardrider's Club retail outlets and its web site, therefore Applicant's and the cited registrant's goods would be sold through mutually exclusive channels where confusion would be nonexistent. For the foregoing reasons, and because the '013 Reg. covers only the narrow category of "vinyl flooring", Applicant submits that the Section 2(d) refusal in connection with the '013 Reg. is inappropriate and should be withdrawn.

### 5. The '515 Reg.

The Examining Attorney has refused registration on the basis of the '515 Reg. for QUICKSILVER in connection with "skateboards". Applicant notes that it is also the registrant of Reg. No. 2,106,684. Among other things, Applicant's '684 Reg. covers retail store services in the fields of clothing, headwear, footwear, wetsuits, luggage, bags, sunglasses, watches, jewelry and accessories. Applicant operates retail stores in locations across the United States, including in major shopping centers and malls in many major metropolitan areas. It began as and continues to be a provider of boardriding apparel, including skateboarding lifestyle clothing. Applicant's longstanding use of the QUICKSILVER mark in connection with the mass-market sale of sportswear, particularly skateboarding-related apparel speaks for itself in establishing Applicant's QUICKSILVER mark as a leading, widely recognized brand in the field. The longstanding coexistence on the Principal Register of Applicant's '684 Reg. with the cited '515 Reg. should be sufficient to cause the Examining Attorney to reconsider and withdraw the '515 Reg. as basis for the refusal of registration under Section 2(d) in the instant application for the QUICKSILVER mark.

### CONCLUDING REMARKS

With the above, it is believed that the application is in condition for publication. Such action is respectfully requested. The Examining Attorney is encouraged to contact the undersigned to resolve any issues arising from the foregoing arguments.

**GOODS AND/OR SERVICES SECTION (004)(no change)**

**GOODS AND/OR SERVICES SECTION (009)(no change)**

**GOODS AND/OR SERVICES SECTION (011)(no change)**

**GOODS AND/OR SERVICES SECTION (014)(no change)**

**GOODS AND/OR SERVICES SECTION (016)(no change)**

**GOODS AND/OR SERVICES SECTION (018)(no change)**

**GOODS AND/OR SERVICES SECTION (020)(no change)**

**GOODS AND/OR SERVICES SECTION (021)(no change)**

**GOODS AND/OR SERVICES SECTION (024)(no change)**

**GOODS AND/OR SERVICES SECTION (025)(no change)**

**GOODS AND/OR SERVICES SECTION (027)(no change)**

**GOODS AND/OR SERVICES SECTION (028)(no change)**

**GOODS AND/OR SERVICES SECTION (035)(no change)**

**GOODS AND/OR SERVICES SECTION (036)(no change)**

**GOODS AND/OR SERVICES SECTION (041)(current)**

INTERNATIONAL CLASS	041
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DESCRIPTION

Education; training; entertainment; sporting, recreational and cultural events and activities; organization and conducting of competitions in this class including those relating to recreational activities, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; rental of sports and recreation equipment including that relating to surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; organization of exhibitions for cultural, entertainment or educational purposes relating to recreational activities, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; provision and management of sports and recreation facilities; timing of sports events; sports and physical training services including athlete and team coaching, including in the fields of surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; holiday and sport camp services; club services in this class; health club services; services relating to the development, writing, direction, recording, editing and production of films and other audio visual programs for cinema, video or DVD; recording studio services; production and distribution of cinema, video, DVD, television and online content; rental of films, video tapes, DVDs, CD-ROMs, sound recordings and other audio visual recordings; radio and television entertainment; film festivals; presentation of live performances; variety events; organization of social events; game services provided on-line; news reporter services; photographic reporting; photography; arranging and conducting of conferences, seminars and workshops; publishing services in this class; providing online electronic publications (not downloadable);

providing information and advice in relation to all of the foregoing	
FIRST USE ANYWHERE DATE	At least as early as 12/00/1986
FIRST USE IN COMMERCE DATE	At least as early as 12/00/1986
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (041)(proposed)</b>	
INTERNATIONAL CLASS	041
DESCRIPTION	
<p>Educational services, namely, conducting classes and workshops in the field of a wide variety of sports; training in the field of sports; entertainment in the nature of concerts, cultural events, sporting events and competitions; sporting, recreational and cultural events and activities in the nature of concerts, cultural events, sporting events and competitions; organization and conducting of sports competitions, namely, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; rental of sports and recreation equipment relating to surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding, namely, boards and protective equipment; organization of exhibitions for cultural, entertainment or educational purposes for educational, cultural, sporting, or entertainment purpose and exhibitions relating to recreational activities in the nature of sports and entertainment, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; provision of sports and recreation facilities; timing of sports events; sports and physical training services, namely, athlete and team coaching in the fields of surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; holiday and sport camp services; entertainment and hospitality services, namely, night clubs, country clubs, sports clubs (skateboarding, watersports, surfing, volleyball, skiing, golf, snowboarding, wakeboarding); health club services, namely providing instruction and equipment in the field of physical exercise; motion picture film production; production of video cassettes and DVDs; recording studio services; television production; production of online content in the nature of sports and entertainment; rental of films, video tapes, DVDs, CD-ROMs, sound recordings and other audio visual recordings; radio entertainment production; Entertainment services, namely, providing a television program in the field of a wide variety of sports via a global computer network; conducting film festivals; presentation of live performances in the nature of musical concerts; variety events in the nature of community and cultural events exhibitions and fairs, Organization of dancing events; organisation of a wide variety of sports games; computer game services provided on-line; news reporting services; photographic reporting; photography; arranging and conducting of educational conferences, seminars and workshops in the field of sports; publishing of books and newsletters; providing online electronic publications in the nature of books and newsletters in the field of sports and entertainment; providing educational and entertainment information and advice in relation to all of the foregoing in International Class 41</p>	
FIRST USE ANYWHERE DATE	At least as early as 12/00/1986
FIRST USE IN COMMERCE DATE	At least as early as 12/00/1986
FILING BASIS	Section 1(b)
<b>SIGNATURE SECTION</b>	
DECLARATION SIGNATURE	/victor sapphire/

SIGNATORY'S NAME	Victor Sapphire
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	11/09/2006
RESPONSE SIGNATURE	/victor sapphire/
SIGNATORY'S NAME	Victor Sapphire
SIGNATORY'S POSITION	Attorney for Applicant
DATE SIGNED	11/09/2006
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu Nov 09 19:32:49 EST 2006
TEAS STAMP	USPTO/ROA-63.107.117.10-2 0061109193249700249-78618 407-34085fca2f07e90ab954a a29ff70d7ed5-N/A-N/A-2006 1109191948238128

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **78618407** has been amended as follows:

#### **Argument(s)**

In response to the substantive refusal(s), please note the following:

#### REMARKS

##### **1. Section 2(d) Refusal**

The Examining Attorney has continued the refusal of registration pursuant to Trademark Act Section 2 (d) on the grounds that there is a likelihood of confusion between Applicant's mark QUIKSILVER and the prior registered marks QUICKSILVER for "comic books featuring a fictional character with super-human powers", Reg. No. 2,288,626; QUICKSILVER for "life jackets and batteries", Reg. No. 2,286,955; QUICKSILVER for "sporting goods, namely, water skis, kneeboards and wakeboards", Reg. No. 2,346,307; QUICKSILVER for "vinyl floor coverings", Reg. No. 1,876,013; and QUICKSILVER for "skateboards", Reg. No. 1,080,515 (collectively, the "Cited Registrations"). Applicant respectfully disagrees with the Examining Attorney's Section 2(d) refusal and submits the following evidence and arguments in support of registration.

**A. Confusion is Not Likely Between Applicant's Mark****And The Marks In The Cited Registrations.****1. The '626 Reg.**

Applicant notes that it owns Reg. No. 2,142,055 for QUIKSILVER, which predates the '626 Reg. and covers goods in Class 16. With regard to the conflict between the instant application and the '626 Reg., Applicant has deleted the Class 16 goods from the application. Therefore, the refusal of registration based on the '626 Reg. is moot and should be withdrawn.

**2. The '955 Reg.**

Applicant notes that according to the Trademark Office's TESS online registration status database, the '955 Reg. was not renewed prior to the expiration of the grace period for filing a Section 8 Declaration on April 19, 2006. Because the cited '955 Reg. is dead, it should be removed as a bar to registration of Applicant's instant application. Such action is respectfully requested.

**3. The '307 Reg.**

The Examining Attorney has refused registration on the basis of the '307 Reg. for QUICKSILVER in connection with "sporting goods, namely, water skis, kneeboards and wake boards". Applicant notes that it is also the registrant of Reg. No. 2,106,684, which predates the cited '307 Reg. Among other things, Applicant's '684 Reg. covers retail store services in the fields of clothing, headwear, footwear, wetsuits, luggage, bags, sunglasses, watches, jewelry and accessories. Applicant operates retail stores in locations across the United States, including in major shopping centers and malls in many major metropolitan areas. It began as and continues to be a provider of surfing-related apparel, and its founders are widely credited with creating innovative surfing-related "boardshorts" (shorts specifically designed for wear while surfing) that have been used and widely promoted by world-famous surfers and athletes the world over. See <http://www.k5.com/getbrand.asp?b=99>. Applicant's longstanding use of the QUIKSILVER mark in connection with the mass-market sale of sportswear, particularly surfing-, skateboarding-, beach-lifestyle- and watersports-related apparel speaks for itself in establishing Applicant's QUIKSILVER mark as a leading, widely recognized brand in the field. The longstanding coexistence on the Principal Register of Applicant's '684 Reg. with the cited '307 Reg. should be sufficient to cause the Examining Attorney to reconsider and withdraw the '307 Reg. as basis for the refusal of registration under Section 2 (d) in the instant application for the QUIKSILVER mark.

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#### CONCLUDING REMARKS

With the above, it is believed that the application is in condition for publication. Such action is respectfully requested. The Examining Attorney is encouraged to contact the undersigned to resolve any issues arising from the foregoing arguments.

#### **Classification and Listing of Goods/Services**

**Applicant hereby amends the following class of goods/services in the application as follows:**

Current: Class 041 for Education; training; entertainment; sporting, recreational and cultural events and activities; organization and conducting of competitions in this class including those relating to recreational activities, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; rental of sports and recreation equipment including that relating to surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; organization of exhibitions for cultural, entertainment or educational purposes relating to recreational activities, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; provision and management of sports and recreation facilities; timing of sports events; sports and physical training services including athlete and team coaching, including in the fields of surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; holiday and sport camp services; club services in this class; health club services; services relating to the development, writing, direction, recording, editing and production of films and other audio visual programs for cinema, video or DVD; recording studio services; production and distribution of cinema, video, DVD, television and online content; rental of films, video tapes, DVDs, CD-ROMs, sound recordings and other audio visual recordings; radio and television entertainment; film festivals; presentation of live performances; variety events; organization of social events; game services provided on-line; news reporter services; photographic reporting; photography; arranging and conducting of conferences, seminars and workshops; publishing services in this class; providing online electronic publications (not downloadable); providing information and advice in relation to all of the foregoing

Original Filing Basis: 1(b).

Proposed: Class 041 for Educational services, namely, conducting classes and workshops in the field of a wide variety of sports; training in the field of sports; entertainment in the nature of concerts, cultural events, sporting events and competitions; sporting, recreational and cultural events and activities in the nature of concerts, cultural events, sporting events and competitions; organization and conducting of sports competitions, namely, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; rental of sports and recreation equipment relating to surfing,

bodyboarding, snowboarding, skiing, kiteboarding and skateboarding, namely, boards and protective equipment; organization of exhibitions for cultural, entertainment or educational purposes for educational, cultural, sporting, or entertainment purpose and exhibitions relating to recreational activities in the nature of sports and entertainment, extreme sports and ball sports such as bodyboarding, skiing, skateboarding, surfing, volleyball and tennis; provision of sports and recreation facilities; timing of sports events; sports and physical training services, namely, athlete and team coaching in the fields of surfing, bodyboarding, snowboarding, skiing, kiteboarding and skateboarding; holiday and sport camp services; entertainment and hospitality services, namely, night clubs, country clubs, sports clubs (skateboarding, watersports, surfing, volleyball, skiing, golf, snowboarding, wakeboarding); health club services, namely providing instruction and equipment in the field of physical exercise; motion picture film production; production of video cassettes and DVDs; recording studio services; television production; production of online content in the nature of sports and entertainment; rental of films, video tapes, DVDs, CD-ROMs, sound recordings and other audio visual recordings; radio entertainment production; Entertainment services, namely, providing a television program in the field of a wide variety of sports via a global computer network; conducting film festivals; presentation of live performances in the nature of musical concerts; variety events in the nature of community and cultural events exhibitions and fairs, Organization of dancing events; organisation of a wide variety of sports games; computer game services provided on-line; news reporting services; photographic reporting; photography; arranging and conducting of educational conferences, seminars and workshops in the field of sports; publishing of books and newsletters; providing online electronic publications in the nature of books and newsletters in the field of sports and entertainment; providing educational and entertainment information and advice in relation to all of the foregoing in International Class 41

Filing Basis: 1(b).

#### **Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii). If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. Secs. 2.34(a)(1)(i). The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /victor sapphire/ Date: 11/09/2006

Signatory's Name: Victor Sapphire

Signatory's Position: Attorney for Applicant

#### **Response Signature**

Signature: /victor sapphire/ Date: 11/09/2006

Signatory's Name: Victor Sapphire

Signatory's Position: Attorney for Applicant

Serial Number: 78618407

Internet Transmission Date: Thu Nov 09 19:32:49 EST 2006

TEAS Stamp: USPTO/ROA-63.107.117.10-2006110919324970

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