

TTAB



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

YKK CORPORATION,)
)
Opposer)
)
v.)
)
JUNGWOO ZIPPER CO., LTD.,)
)
Applicant)

Opposition No. 117,745



01-31-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #77

OPPOSER'S MOTION TO DISMISS

Opposer YKK Corporation ("YKK") filed this opposition on March 14, 2000 against Application Serial No. 75/643,359 for the mark YPP covering "zippers and slide fasteners," filed by Jungwoo Zipper Co., Ltd. (the "YPP Application").

On May 26, 2000, YKK filed a civil action in the United States District Court for the Central District of California against Jungwoo Zipper Co., Ltd., and its U.S. counterpart YPP (U.S.A.), Inc. alleging, among other things, that the defendants' use of the YPP name and mark in connection with zippers and slide fasteners infringed and diluted YKK's famous YKK name and mark and constituted unfair competition.

Because the civil action was dispositive of the issues involved in this opposition (i.e., the registration of the YPP mark), the Board suspending the opposition pending the final outcome of the civil action. After full discovery in the civil action, YKK filed a motion for summary judgment. On April 25, 2002, the court ruled that the YKK mark is

mk

out the world” and that the defendants’ use of the YPP mark constitutes
“famous” judgement and unfair competition as a matter of law.

trademark earned through discovery in the civil action that Jungwoo Zipper Co., Ltd.
YPP Application to YPP Zipper Co., Ltd. on February 17, 2001. That same
Zipper Co., Ltd. assigned the YPP Application to YPP (U.S.A.), Inc. Those
assignments were recorded with the U.S. Patent & Trademark Office, as evidenced by the
printout from the DIALOG computer database attached as Exhibit A. A copy
of assignments themselves are attached as Exhibit B.

After the court’s decision on liability in the civil action, YKK and YPP (U.S.A.),
Inc. settled the remaining issues in the case and agreed to enter into a final Judgment of
Permanent Injunction and Other Relief Against Defendant YPP (U.S.A.), Inc., which the
Court entered on September 12, 2002. The final judgment orders, among other things,
that YPP (U.S.A.), Inc. be permanently enjoined from using, registering, or seeking to
register any mark comprised of or containing the term YPP, or any confusingly similar or
diluting mark.

Under the settlement agreement entered into between the parties, YPP (U.S.A.),
Inc. assigned the YPP Application to YKK. YKK filed the papers necessary to record
that assignment with the Patent and Trademark Office and, on October 8, 2002, the
assignment was recorded under Reel 002597, Frame 0595, copies of which are attached
as Exhibit C.

Because YKK now owns the YPP Application, this opposition is moot.
Accordingly, YKK asks that the action be dismissed without prejudice.

Dated: January 31, 2003

Respectfully submitted,



Mark Sommers, Esq.
Douglas A. Rettew, Esq.
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street N.W.
Washington, DC 20005
Tel: (202) 408-4000
Fax: (202) 408-4400

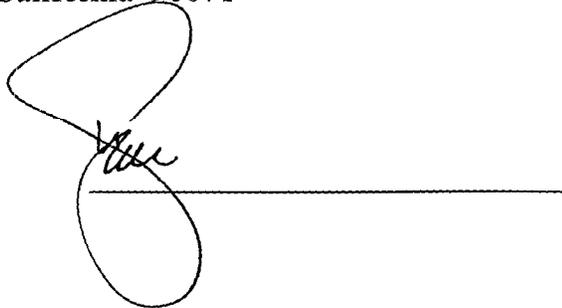
CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing OPPOSER'S MOTION TO DISMISS was served via facsimile and United States first class mail, postage prepaid, this 31st day of January, 2003, upon counsel for Jungwoo Zipper Co. Ltd. at the following address:

Marc E. Hankin, Esq.
Gordon & Rees L.L.P.
300 South Grand Avenue
Twentieth Floor
Los Angeles, California 90071

I certify that a true and accurate copy of the foregoing OPPOSER'S MOTION TO DISMISS was served via facsimile and United States first class mail, postage prepaid, this 31st day of January, 2003 upon counsel for YPP (U.S.A.), Inc. at the following address:

Randy McElvain, Esq.
Weston & McElvain
555 South Flower Street, Suite 4530
Los Angeles, California 90071

A handwritten signature in black ink, appearing to read "Randy McElvain", is written over a solid horizontal line. The signature is stylized and loops around the line.

2/19/1

DIALOG(R) File 226:TRADEMARKSCAN(R)-US FED
(c) 2002 Thomson & Thomson. All rts. reserv.

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YPP

INTL CLASS: 26 (Fancy Goods)
U.S. CLASS: 37 (Paper & Stationery)
39 (Clothing)
40 (Fancy Goods, Furnishings, & Notions)
42 (Knitted, Netted, Textile Fabrics, & Substitutes)
50 (Merchandise Not Otherwise Classified)

STATUS: Pending-Published for Opposition; Opposition Filed

GOODS/SERVICES: ZIPPERS AND SLIDE FASTENERS

SERIAL NO.: 75 -643,359

FIRST USE: January 15, 1998 (Intl Class 26)

FIRST COMMERCE: April 28, 1998 (Intl Class 26)

FILED: February 17, 1999

PUBLISHED: November 16, 1999

ORIGINAL APPLICANT: JUNGWOO ZIPPER CO., LTD. (Republic of Korea Corporation), KUNPO-SHI, 331-3 DANGJUNG-DONG, KYUNGGI-DO, KR (Republic of Korea)

OWNER AT PUBLICATION: JUNGWOO ZIPPER CO., LTD. (Republic of Korea Corporation), KUNPO-SHI, 331-3 DANGJUNG-DONG, KYUNGGI-DO, KR (Republic of Korea)

ASSIGNEE(S): YPP ZIPPER CO., LTD. (Republic of Korea Corporation), 331-4 DANGJUNG-DONG KUNPO-SHI, KYUNGGI-DO, KR (Republic of Korea)

Assignor(s): JUNGWOO ZIPPER CO., LTD. (Republic of Korea Corporation)

Reel/Frame: 2305/0725

Recorded: May 22, 2001

Brief: ASSIGNS THE ENTIRE INTEREST AND GOOD WILL

ASSIGNEE(S): YPP (U.S.A.) INC. (California Corporation), 245 E. REDONDO BEACH BOULEVARD, GARDENS, CA (California), 90248, USA (United States of America)

Assignor(s): YPP ZIPPER CO., LTD. (Republic of Korea Corporation)

Reel/Frame: 2305/0833

Recorded: May 23, 2001

Brief: ASSIGNS THE ENTIRE INTEREST AND GOOD WILL

OPPOSITION ACTION: 117745

Filed: March 14, 2000

Outcome: PENDING

Date of Outcome: April 11, 2000

Opposing TM: YKK

Opposing SN: 72-290,795

Opposing RN: 865,610

Opposer: YKK CORPORATION

FILING CORRESPONDENT: SEBONG HONG, MARC E. HANKIN, SONNENSCHNEIN NATH & ROSENTHAL, 601 S. FIGUEROA STREET, SUITE 1500, LOS ANGELES, CA 90017

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Sub account: 06110.8051

\$1.64 0.298 DialUnits File226

\$2.20 1 Type(s) in Format 19

\$2.20 1 Types

\$3.84 Estimated cost File226

\$0.21 TELNET

\$4.05 Estimated cost this search

ASSIGNMENT OF A TRADEMARK APPLICATION

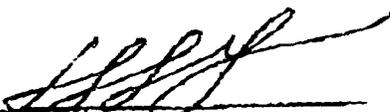
WHEREAS, YPP ZIPPER CO., LTD., a Republic of Korea Corporation, 331-4 Dangjung-dong Kunpo-shi Kyunggi-do, Republic of Korea, is the owner of the mark YPP, and U.S. Trademark Application Serial No. 75/643,359, which currently is the subject of Opposition No. 117,745; and

WHEREAS, YPP (U.S.A.), INC., a California Corporation, 245 E. Redondo Beach Boulevard, Gardena, California 90248, is desirous of acquiring said mark and said trademark application, subject to Opposition No. 117,745, including any and all goodwill associated with the mark, together with the right to sue for infringement or dilution thereof;

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, Assignor, YPP ZIPPER CO., LTD., does hereby forever assign unto said Assignee, YPP (U.S.A.), INC., whatever rights, title, and interest it has or may have in the mark YPP, together with the goodwill of the business within the United States, as symbolized by the mark, and the above-identified trademark application therefor.

YPP ZIPPER CO., LTD.

Date: 02/17/01

By: 
Name: HAN SUNG YEOL
Title: PRESIDENT

of the *ME* *Hand*
ASSIGNMENT OF A TRADEMARK APPLICATION

WHEREAS, JUNGWOO ZIPPER CO., LTD., a Republic of Korea Corporation, 331-4 Dangjung-dong Kunpo-shi Kyunggi-do, Republic of Korea, is the owner of the mark YPP, and U.S. Trademark Application Serial No. 75/643,359, which currently is the subject of Opposition No. 117,745; and

WHEREAS, YPP ZIPPER CO., LTD., a Republic of Korea Corporation, 331-4 Dangjung-dong Kunpo-shi Kyunggi-do, Republic of Korea, is desirous of acquiring said mark and said trademark application, subject to Opposition No. 117,745, including any and all goodwill associated with the mark, together with the right to sue for infringement or dilution thereof.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, Assignor, JUNGWOO ZIPPER CO., LTD., does hereby forever assign unto said Assignee, YPP ZIPPER CO., LTD., whatever rights, title, and interest it has or may have in the mark YPP, together with the goodwill of the business within the United States, as symbolized by the mark, and the above-identified trademark application therefor.

JUNGWOO ZIPPER CO., LTD.

Date: 02/17/01

By: *[Signature]*

Name: SUNG DAE CHO

Title: President

W-0121-V-2

Feb. 15 2001 05:15PM 95

FDX NO. : 13183242997

FROM : YPP(U.S.A.) INC.

JWZ 001453

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02/17/01 11:41

TX/RX NO.5458

P.005



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MSS/DAR/KUK

JANUARY 21, 2003

Chief Information Officer
Washington, DC 20231
www.uspto.gov

FINNEGAN, HENDERSON, FARABOW ET AL
DOUGLAS RETTEW
1300 I STREET, M.W.
WASHINGTON, DC 20005-3515

RECEIVED
PTAS

JAN 27 2003



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FINNEGAN, HENDERSON, FARABOW
UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 10/08/2002

REEL/FRAME: 002597/0595
NUMBER OF PAGES: 3

BRIEF: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

ASSIGNOR:
YPP (U.S.A), INC.

DOC DATE: 08/30/2002
CITIZENSHIP: CALIFORNIA
ENTITY: CORPORATION

ASSIGNEE:
YKK CORPORATION
1, KANDA IZUMI-CHO
CHIYODA-KU, TOKYO, JAPAN

CITIZENSHIP: JAPAN
ENTITY: CORPORATION

APPLICATION NUMBER: 75643359
REGISTRATION NUMBER:

FILING DATE: 02/17/1999
ISSUE DATE:

MARK: YPP
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

002597/0595 PAGE 2

TARA WASHINGTON, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

10-15-2002

To the Honorable Commissioner of Patents and Trademarks

ments or copy thereof.

102249154

1. Name(s) of conveying party(ies):
YPP (U.S.A.), Inc.

- Individual(s)
- Association
- Limited Partnership
- Corporation - California
- General Partnership
- Other:



Additional name(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

- Assignment
- Merger
- Security Agreement
- Change of Name
- Other:

10-8-02

Execution Date: August 30, 2002

2. Name(s) and address(es) of receiving party(ies):

Name: YKK Corporation
Address: 1, Kanda Izumi-cho
Chiyoda-ku, Tokyo, Japan

- Individual(s)
- Association
- General Partnership
- Limited Partnership
- Corporation - Japan
- Other:

If assignee is not domiciled in the United States, a domestic representative is attached: Yes No

(Designation must be a separate document from Assignment)

Additional name(s) & address(es) attached? Yes No

4. Application number(s) or registration number(s):

A. Trademark Application Number(s):

75/643,359

B. Trademark Registration Number(s):

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Douglas A. Rettew
Address: FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005-3515

6. Total number of applications and registrations involved: 1

7. Total fee (37 CFR 3.41): \$40

- Enclosed
- Authorized to be charged to deposit account
- Authorized to be charged to deposit account only if fee is deficient

8. Deposit Account No.: 06-0916

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Douglas A. Rettew

Name of person signing

Signature

October 8, 2002

Date

Total number of pages including cover sheet, attachments and documents: 3



Attorney Docket: 06110.005E

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: YKK Corporation (by assignment)
Serial Number: 75/643,359
Filing Date: February 17, 1999
Mark: YPP

Examining Atty: Henry S. Zak, Esq.
Law Office: 108

COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

ATTN: BOX NO FEE

DESIGNATION OF DOMESTIC REPRESENTATIVE

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., having a postal address at 1300 I Street, N.W., Washington, D.C. 20005-3315, is hereby designated as the applicant's representative upon whom notices or process in proceedings affecting the mark may be served.

YKK Corporation

By: *Yoshitaka Nagai*

Name: Yoshitaka NAGAI

Title: General manager of intellectual
Property Dept.

Date: Oct. 2 2002

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

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Washington, DC 20005
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ASSIGNMENT

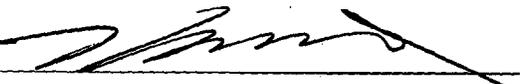
YPP (U.S.A.), Inc., a California company with a place of business at 245 Redondo Beach Boulevard, Gardena, California 90246 ("Assignor"), is the owner of the mark YPP in the United States, and of trademark application Serial No. 75/643,359 before the U.S. Patent & Trademark Office (hereinafter "the Trademark").

YKK Corporation, a Japanese corporation with a place of business at 1, Kanda Izumi-cho, Chiyoda-ku, Tokyo, Japan ("Assignee"), wishes to acquire the Trademark.

In consideration of the foregoing and for other good and valuable consideration, receipt of which is hereby acknowledged, Assignor hereby assigns to Assignee all its right, title, and interest in and to the Trademark, together with the goodwill of the business associated with the Trademark, and the right to sue and recover for past infringements, dilution, and other violations.

The Commissioner is requested to issue the certificate of registration to Assignee.

YPP (U.S.A.), Inc.

By: 

Name: Da-jia Kim

Title: C. E. O.

Date: Aug 30 2002.