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QUIKS2.262CN

TRADEMARK

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

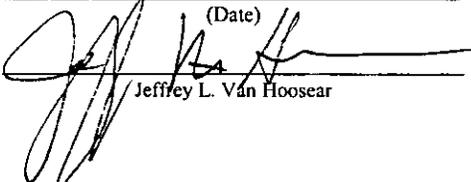
Kymsta, Corp.,)
)
Petitioner,)
)
v.)
)
Quiksilver, Inc.,)
)
Registrant.)

Cancellation No. 92041805

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on

March 22, 2004

(Date)


Jeffrey L. Van Hoosear

**NOTICE OF JUDGMENT BY THE COURT AND REQUEST FOR DECISION BASED
ON RELATED CIVIL ACTION**

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



03-25-2004

U.S. Patent & TMO/TM Mail Rcpt UL 470

ATT: BOX TTAB NO FEE

Dear Sir:

Registrant, Quiksilver, Inc. respectfully requests the Trademark Trial and Appeal Board dismiss the above-referenced cancellation action Pursuant to TBMP §510.02(b).

This cancellation proceeding had been suspended due to civil action No. 02-5497 DT (Mcx) in the United States District Court for the Central District of California. On February 19, 2004, the District Court entered its judgment affirming that Registrant Quiksilver, Inc.'s Trademark Registration No. 2,427,898 was "valid and protectable". Attached hereto as Exhibit A is a copy of the Judgment by the Court. Accordingly, the civil action has decided the issue before the Board, and the decision in the civil action is therefore dispositive of this cancellation proceeding.

For the foregoing reasons, Registrant therefore requests that the cancellation proceeding be dismissed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated March 22, 2004

By:  _____

Jeffrey A. Van Hoosear

2040 Main Street

Fourteenth Floor

Irvine, CA 92614

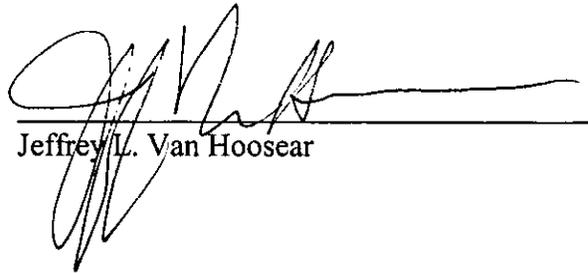
(949) 760-0404

Attorneys for Registrant, Quiksilver, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing NOTICE OF JUDGMENT BY THE COURT AND REQUEST FOR DECISION BASED ON RELATED CIVIL ACTION upon Petitioner's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on March 22, 2004 addressed as follows:

William J. Robinson
James D. Nguyen
FOLEY & LARDNER
2029 Century Park East, 35th Floor
Los Angeles, California 90067

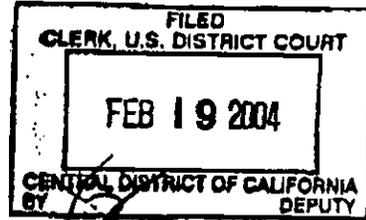


Jeffrey L. Van Hoosear

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EXHIBIT A



03-25-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

UNITED STATES DISTRICT COURT
 CENTRAL DISTRICT OF CALIFORNIA

11 QUIKSILVER, INC., a Delaware
12 corporation,

13 Plaintiff,

14 vs.

15 KYMSTA CORP., a California
16 corporation,

16 Defendant.

CASE NO. CV 02-5497 DT (Mcx)
 JUDGMENT BY THE COURT

17 AND RELATED COUNTERCLAIMS
 18

19 This Judgment pertains to the claims by plaintiff and counterclaim
 20 defendant Quiksilver, Inc. ("Quiksilver") against defendant and counterclaim
 21 plaintiff Kymsta Corp. ("Kymsta") and the claims by Kymsta against Quiksilver
 22 asserted in the above-captioned action.

23 Quiksilver's First (Federal Trademark Infringement), Second (False
 24 Designation of Origin), Third (Federal Trademark Dilution), Fourth (Statutory
 25 Unfair Competition), Fifth (Common Law Trademark Infringement), Sixth
 26 (Common Law Unfair Competition) and Seventh (State Trademark Dilution)
 27 Claims for Relief set forth in Quiksilver's Complaint and Kymsta's First (False
 28

1 Designation of Origin), Second (Statutory Unfair Competition) and Third
2 (Common Law Unfair Competition) Claims for Relief set forth in Kymsta's
3 Answer and Counterclaim came on regularly for trial by jury on January 27, 2004,
4 in the United States District Court for the Central District of California, the
5 Honorable Dickran Tevrizian presiding. On January 27, 2004, a jury of 8 persons
6 was regularly examined, impaneled and sworn.

7 On February 6, 2004, at the close of evidence on Kymsta's case,
8 Quiksilver moved for judgment as a matter of law under Federal Rule of Civil
9 Procedure 50 on: (i) Kymsta's First, Second and Third Claims for Relief against
10 Quiksilver; and (ii) Kymsta's Third (Innocent Adoption), Fourth (Priority of
11 Trademark Rights) and Fifth (Fraud) Affirmative Defenses to Quiksilver's Claims
12 for Relief. At the same time, Kymsta renewed its motion for judgment as a matter
13 of law under Federal Rule of Civil Procedure 50 on Quiksilver's First, Second,
14 Third, Fourth, Fifth, Sixth and Seventh Claims for Relief and on Kymsta's Second
15 (Laches) and Third (Innocent Adoption) Affirmative Defenses to Quiksilver's
16 Claims for Relief. After hearing oral argument, the Court granted Quiksilver's
17 motion for judgment as a matter of law in Quiksilver's favor as to: (i) Kymsta's
18 First, Second and Third Claims for Relief; and (ii) Kymsta's Third, Fourth and
19 Fifth Affirmative Defenses to Quiksilver's Claims for Relief. The Court further
20 granted Kymsta's motion for judgment as a matter of law in Kymsta's favor as to
21 Quiksilver's Third and Seventh Claims for Relief.

22
23 WHEREFORE, by virtue of law, IT IS HEREBY ORDERED,
24 ADJUDGED AND DECREED AS FOLLOWS:

25
26 1. Quiksilver's federal registered trademarks – QUIKSILVER
27 ROXY, no. 2,083,400; ROXY, no. 2,225,688; ROXY, no. 2,255,435; and ROXY,
28 no. 2,427,898 – are deemed valid and protectable trademarks;

NB1:619340.6

1 2. Quiksilver's common law trademarks - ROXY BY QUIKSILVER and
2 ROXY QUIKSILVER - are deemed valid and protectable trademarks;

3 3. Quiksilver is deemed the senior user and owner of the QUIKSILVER
4 ROXY mark; the ROXY marks; the ROXY BY QUIKSILVER mark and the
5 ROXY QUIKSILVER mark;

6 4. Quiksilver has the full right to the use and enjoyment of the
7 QUIKSILVER ROXY mark, the ROXY marks, the ROXY BY QUIKSILVER
8 mark and ROXY QUIKSILVER mark, and Kymsta is barred from precluding or
9 circumscribing any use by Quiksilver of said marks;

10 5. With reference to Kymsta's Second Affirmative Defense (Laches),
11 Quiksilver is barred from precluding or circumscribing Kymsta's present and
12 current use of Kymsta's common law unregistered trademarks - "Roxywear by
13 Roxanne Heptner," "Roxywear by Roxx," "Roxywear by Roxx" with the Asian
14 characters "Think Happy" and "Roxywear by Kymsta" (the "Roxywear marks");

15 6. With respect to Kymsta's use of its Roxywear marks, Kymsta and its
16 directors, officers, employees and agents are hereby permanently enjoined and
17 restrained from using, or permitting the use of, any of the Roxywear marks to
18 market, advertise or identify any of Kymsta's clothing products in any manner
19 other than as presently and currently used by Kymsta. Specifically, to designate
20 the source and origin of the product and to avoid confusion in the marketplace,
21 *inter alia*:

- 22 a. the term "Roxywear" must be displayed, presented, shown or
23 otherwise used as one word, with all letters in the same font,
24 same type-size, same color and same format;
- 25 b. one of the following identifiers must be conspicuously
26 displayed whenever the term "Roxywear" is displayed,
27 presented, shown or otherwise used: "by Roxanne Heptner,"
28 "by Roxx," "by Roxx" with the Asian characters "Think

- 1 Happy” or “by Kymsta”;
- 2 c. the Roxywear marks shall not be displayed, presented, shown
- 3 or otherwise used on any product classes other than clothing;
- 4 d. the Roxywear marks shall only be displayed, presented, shown
- 5 or used on the interior labels affixed to the inside of any article
- 6 of clothing, and specifically shall not be displayed, presented,
- 7 shown or used on the outside of any article of clothing, such as
- 8 imprinting on or incorporating in the design of the fabric any of
- 9 the Roxywear marks as a logo or brand or using any of the
- 10 Roxywear marks on any badging, tags or labels affixed to the
- 11 outside of any article of clothing;
- 12 e. clothing bearing any of the Roxywear marks shall only be sold
- 13 though Kymsta’s current channels of distribution. There are no
- 14 limitations on the customers, wholesale or retail, to whom
- 15 Kymsta can sell clothing using the Roxywear marks as set forth
- 16 herein through Kymsta’s current channels of distribution;
- 17 f. clothing bearing the Roxywear marks shall not be advertised or
- 18 promoted to consumers, except through co-op advertisements
- 19 placed directly be retailers;
- 20 g. the Roxywear marks shall not be displayed, presented, shown
- 21 or otherwise used on any clothing product that is confusingly
- 22 similar to or a knock-off of any ROXY clothing product sold
- 23 by Quiksilver;
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h. Kymsta shall not sell or license to any third party any of the
Roxywear marks; and,

7. Each party shall bear its own costs and attorneys' fees.

DATED: FEB 19, 2004

Dick Tevrian
DICKRAN TEVRIZIAN
United States District Judge