

04-16-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #73

**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: March 31, 2003

QUIKSILVER, INC.
1740 Monrovia Avenue
Costa Mesa, CA 92627

Cancellation No. 92041805
Reg. No. 2427898

JAMES D NGUYEN
FOLEY & LARDNER
2029 CENTURY PARK EAST 35TH FLOOR
LOS ANGELES, CA 90067

KYMSTA CORP.

V.

QUIKSILVER, INC.

James Scott Legal Assistant

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as

well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open:	April 20, 2003
Discovery period to close:	October 17, 2003
30-day testimony period for party in position of plaintiff to close:	January 15, 2004
30-day testimony period for party in position of defendant to close:	March 15, 2004
15-day rebuttal testimony period for plaintiff to close:	April 29, 2004

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

03-12-2003

U.S. Patent & TMO/TM Mail Rpt. Dt. #40

TTAB

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

KYMSTA CORP.,
a California corporation,

Petitioner,

vs.

QUIKSILVER, INC.,
a Delaware corporation,

Respondent

PETITION FOR CANCELLATION OF
TRADEMARK REGISTRATION

CANCELLATION No.

41805

REGISTRATION No. 2,427,898

DATE OF ISSUE: FEBRUARY 13,
2001

Petitioner, Kymsta Corp. ("Kymsta") is a California corporation, with its principal place of business at 1506 West 12th Street, Los Angeles, California 90015. Kymsta believes that it is or will be damaged by Registration No. 2,427,898 and hereby petitions to cancel same.

Description of Respondent's Registration: Filed on December 12, 1998 for the mark ROXY registered on the Principal Register, in International Class 25 for clothing, footwear, headgear, namely, t-shirts, dresses, skirts, pajamas, swim suits, sweatshirts, sweat pants, tank tops, shorts, pants, jackets, sweaters, socks, belts, wetsuits, ski wear, snowboard clothing, namely, snow pants, powder pants, jackets, snow bibs, gloves, thermal wear, shoes, athletic shoes, sandals, slippers, boots, beach footwear, hats, caps, and visors; claiming first use on January 1, 1992.

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300.00 DP

As grounds for this Petition, Kymsta alleges as follows:

1. Kymsta is a leading apparel company that manufactures and sells apparel, throughout the United States, and internationally. Kymsta sells junior tops and bottoms clothing, throughout the United States, under the ROXYWEAR mark, which incorporates its designer's, Roxanne Heptner's personal nickname Roxy.

2. Respondent Quiksilver, Inc. ("Quiksilver") is the owner of federal trademark registration no. 2,427,898. A true and correct copy of said registration is attached hereto as Exhibit 1. Kymsta is informed and believes that Quiksilver's current principal place of business is located at 15202 Graham Street, Huntington Beach, California 92749.

3. Kymsta adopted the ROXYWEAR mark, for junior tops and bottoms clothing, in December 1991, and first used the ROXYWEAR mark, for these goods, in interstate commerce, in January 1992. Kymsta has extensively, and continuously, used the ROXYWEAR mark, on these goods, throughout the United States, since January 1992. Kymsta's sales of junior tops and bottoms clothing, under the ROXYWEAR mark, in the United States, have averaged about \$2 million per year since 1992.

4. Kymsta is informed and believes, and on that basis alleges, that it adopted and used the ROXYWEAR mark, for junior tops and bottoms clothing, in interstate commerce, prior to Quiksilver's adoption, or first use of Quiksilver's registered mark for clothing.

5. Kymsta's ROXYWEAR mark, for junior tops and bottoms clothing, by virtue of its substantial use and promotion, has acquired significant value as an identifier of Kymsta's junior tops and bottoms clothing, and distinguishes these goods of Kymsta from those of others.

6. As a result of Kymsta's extensive sales, customers readily recognize, identify and distinguish Kymsta's junior tops and bottoms clothing from the goods of others by the ROXYWEAR mark.

7. Kymsta's ROXYWEAR mark is a valuable symbol of Kymsta, as representative of its high quality line of junior tops and bottoms clothing, and of the substantial customer good will that Kymsta has earned over many years in the U.S., and international, market.

8. Kymsta is informed and believes, and on that basis alleges, that subsequent to Kymsta's adoption, and first use, of its ROXYWEAR mark, Quiksilver began selling clothing under the ROXY mark to some of the same retail stores where Kymsta's junior tops and bottoms clothing was, and had been sold.

9. Kymsta is informed and believes, and on that basis alleges, that Quiksilver incorporated the ROXY part of Kymsta's ROXYWEAR mark in Quiksilver's registered mark, for clothing. Kymsta is further informed and believes, and on that basis alleges, that Quiksilver's clothing using the registered mark is marketed to the same consumers, through the same channels of trade, as Kymsta's junior tops and bottoms clothing.

10. Quiksilver's registered mark is confusingly similar to Kymsta's ROXYWEAR mark, and will likely cause confusion among consumers and retail customers about the origin of Kymsta's junior tops and bottoms clothing and/or the origin of Quiksilver's clothing. Kymsta is informed and believes, and on that basis alleges, that actual confusion between Kymsta's ROXYWEAR mark and Quiksilver's use of the registered mark has occurred.

11. By virtue of its use of the registered mark, Quiksilver has created injury or a likelihood of injury to Kymsta's business and to Kymsta's ROXYWEAR mark.

PRAYER

WHEREFOR, Petitioner Kymsta Corp. requests that this Petition for Cancellation be granted in its favor, and Registration No. 2,427,898 be canceled.

The filing fee for this Petition in the amount of \$300.00 is enclosed.

DATED: March 12, 2003

Respectfully submitted,

KYMSTA CORP.

By: 

William J. Robinson

James D. Nguyen

FOLEY & LARDNER

2029 Century Park East, 35th Floor

Los Angeles, California 90067

Telephone: (310) 277-2223

Facsimile: (310) 557-8475

Attorneys for Petitioner **KYMSTA CORP.**

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" Mailing label Number: **EL 857559607 US**

Date of Deposit: March 12, 2003

I hereby certify that this PETITION FOR CANCELLATION OF TRADEMARK REGISTRATION and related correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Address" service on the date indicated above and is addressed to: BOX TTAB — FEE, Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, Virginia 22202-3513

Name of Person Signing this Certificate: **Mayra Contreras**

Signature of Person Signing this Certificate:

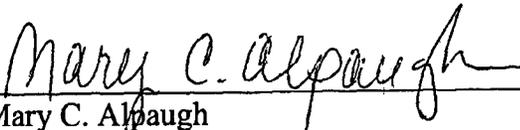
Mayra Contreras

Date of Signature: March 12, 2003

CERTIFICATE OF SERVICE

I hereby certify that this PETITION FOR CANCELLATION OF TRADEMARK REGISTRATION has been served upon the attorney for the trademark owner, Quiksilver, Inc., by depositing same in the United States mail, first class postage prepaid, in an envelope addressed as follows:

**Michael G. Yoder, Esq.
O'Melveny & Myers LLP
610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660-6429**



Mary C. Alpaugh
Date of Signature: March 12, 2003

BRUSSELS
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WASHINGTON, D.C.
WEST PALM BEACH

[REDACTED]
03-12-2003
U.S. Patent & TMO/TM Mail Rpt. Dt. #40

FOLEY LARDNER
ATTORNEYS AT LAW

March 12, 2003

VIA EXPRESS MAIL

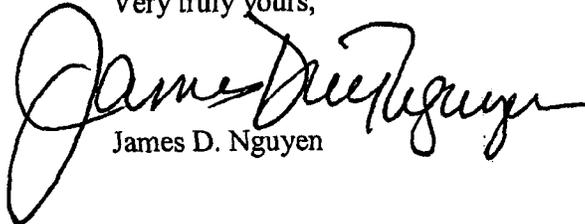
BOX TTABB—FEE
COMMISSIONER FOR TRADEMARKS
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Mark: ROXY[✓]
Reg. No.: 2,427,898

Dear Sir or Madam:

We represent Kymsta Corp. Enclosed is a Kymsta's Petition for Cancellation of the above mark, along with the \$300 fee. The mark is owned by Quiksilver, Inc., and a copy of the Petition is also being served to counsel for Quiksilver.

Very truly yours,


James D. Nguyen

JDN/mca
Enclosures (as noted)

cc: Michael G. Yoder, Esq. (counsel for Quiksilver, Inc., via mail, w/ copy of Petition)

TRADEMARK TRIAL AND APPEAL BOARD
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FOLEY & LARDNER
2029 CENTURY PARK EAST, SUITE 3500
LOS ANGELES, CALIFORNIA 90067-3021
310.277.2223 TEL
310.557.8475 FAX
WWW.FOLEYLARDNER.COM

WRITER'S DIRECT LINE
310.975.7837
EMAIL ADDRESS
jnguyen@foleylaw.com

CLIENT/MATTER NUMBER
025090-9001
015.578214.1

