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TRADEMARK

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

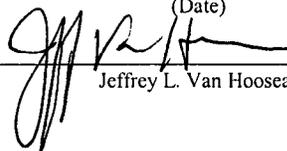
Kymsta, Corp.,)
)
Petitioner,)
)
v.)
)
Quiksilver, Inc.,)
)
Registrant.)

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

September 2, 2003

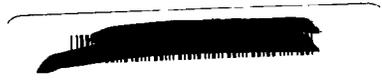
(Date)



Jeffrey L. Van Hoosear

**REPLY TO PETITIONER'S OPPOSITION TO
MOTION TO SUSPEND CANCELLATION ACTION; REGISTRANT'S OPPOSITION
TO PETITIONER'S REQUEST FOR TELEPHONIC HEARING**

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



ATT: BOX TTAB NO FEE

09-04-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Dear Sir:

Registrant, Quiksilver, Inc. ("Quiksilver"), disagrees with Petitioner, Kymsta Corp. ("Kymsta"), that the circumstances in this case are different from those normally presented by a motion to suspend.

Opposer respectfully acknowledges that the Board has discretion whether to grant or deny the Motion to Suspend Cancellation Action. However, it is indeed customary for the Board to grant a Motion to Suspend based on a pending civil action in cases such as the instant case, where the subject opposition proceeding has issues in common with the related civil action. See, e.g., Toro Co., 187 U.S.P.Q. 689; Tokaido v. Honda Assoc. Inc., 179 U.S.P.Q. 861 (T.T.A.B. 1973) (granting Motion to Suspend where outcome of civil suit may have a bearing upon issues

in the Board proceedings); Whopper-Burger, Inc. v. Burger King Corp., 171 U.S.P.Q. 805 (T.T.A.B. 1971) (granting Motion to Suspend where outcome of civil suit may have a bearing upon issues in the Board proceedings); Other Telephone Co. v. Conn. Nat'l Telephone Co., 181 U.S.P.Q. 125 (T.T.A.B. 1974) (granting Motion to Suspend as outcome of civil action will have a bearing on the issues involved in the opposition proceeding); Martin Beverage Co. v. Colita Beverage Co., 169 U.S.P.Q. 568 (T.T.A.B. 1971).

Kymsta argues that the Motion to Suspend the Cancellation Action would “cut off” Kymsta’s discovery rights. However, Kymsta was well aware of the need to take the discovery on the subject registration in the federal court action. In its counterclaim in the federal court action, Kymsta requests “that Quiksilver’s Registration Nos. [sic] 2,427,898 for ROXY, be cancelled.” While Kymsta claims this proceeding should not be suspended as Kymsta needs to take discovery to use in the federal court action, it is clear that Kymsta’s “need” for discovery is not so great that it has been over five (5) months since Kymsta filed the Petition to Cancel (March 12, 2003) and it still has not served any discovery on Registrant in this proceeding.

It is well settled that “[t]o the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the board, while the decision of the Board is not binding upon the court.” See T.B.M.P. § 510.02(a) (emphasis added); see also, Goya Foods Inc. v. Tropicana Prods. Inc., 6 U.S.P.Q.2d 195 (2d Cir. 1988); Toro Co. v. Hardigg Indus., Inc., 187 U.S.P.Q. 689, 692 (T.T.A.B. 1975), rev’d on other grounds, 193 U.S.P.Q. 149 (C.C.P.A. 1977). Hence, suspending the proceedings before the Board would, in fact, be more efficient and fair and would ultimately save time and money of the parties involved, since the decision of the federal district court will be binding on the Trademark Trial and Appeal Board (“Board”) with respect to the dispositive issues that are in common with those before the Board. The district court has already been specifically requested, by Kymsta, to rule on the cancellation of the registration in issue in the proceeding. A ruling which Kymsta admits will be given well prior to the Board having an opportunity to render a decision in this proceeding. In fact, Kymsta states in its opposition brief

“the Federal Court Action is near completion and will be decided well before this proceeding.”
Staying the subject cancellation action is the rational and reasonable approach to this matter.

For the foregoing reasons, Opposer respectfully submits that the Board correctly granted its Motion to Suspend Cancellation Action pending the outcome of the civil action.

In response to Kymsta’s request for a telephonic hearing on this motion, Quiksilver does not believe a telephonic hearing is neither necessary nor “useful to explain” the events Kymsta complains.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept. 2, 2003

By: 

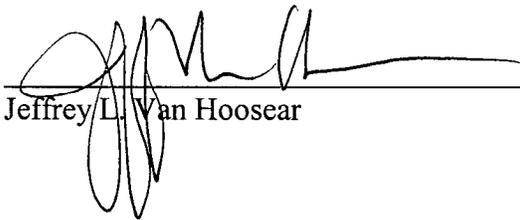
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09/11/2003 11:05 AM

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing REPLY TO PETITIONER'S OPPOSITION TO MOTION TO SUSPEND CANCELLATION ACTION; REGISTRANT'S OPPOSITION TO PETITIONER'S REQUEST FOR TELEPHONIC HEARING upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on September 2, 2003 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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