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

U.S Trademark Registration No.: 2,554,111
Trademark: EXP COATED



GIBSON GUITAR CORP.)
309 Plus Park Blvd.)
Nashville, Tennessee 37217)
)
Petitioner)
)
v.)
)
J. D'ADDARIO & CO., INC.)
595 Smith Street)
Farmingdale, New York 11735)
Registrant)
)
)

10-16-2002

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #70

Cancellation No.

TRADEMARK TRIAL AND
APPEAL BOARD
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PETITION TO CANCEL

Petitioner, Gibson Guitar Corp. ("Gibson"), a Delaware Corporation with a business address of 309 Plus Park Blvd., Nashville, Tennessee 37217, hereby petitions to cancel U.S Trademark Registration No. 2,554,111 for the trademark EXP COATED issued March 26, 2002 in connection with strings for musical instruments to J. D'Addario & Co, Inc. ("Registrant").

As grounds in support of their petition, Petitioner asserts as follows:

1. Gibson owns the trademark EXPLORER in connection with stringed musical instruments. Gibson has used the EXPLORER mark since at least as early as December 31, 1958. Gibson and the consuming public know the EXPLORER guitar as EXP and EX. Consumers use EXP or EX as a short hand designation for the EXPLORER guitar. On price sheets and order forms, GIBSON uses EXP or EX

as a designation for the EXPLORER. Therefore, Gibson owns the rights to the EXP trademark and the EX trademark in connection with stringed instruments.

2. Gibson filed trademark applications seeking to register EXP (U.S. Application Serial No. 76/230,198) and EX (U.S. Application Serial No. 76/230,185). The U.S. Patent and Trademark Office refused to register Gibson's marks because of U.S. Trademark Registration No. 2,554,111.

3. Registrant's date of first use of the mark EXP COATED in connection with string for musical instruments is January 22, 2001 and has a priority date of December 8, 2000. Gibson used the EX and EXP marks in interstate commerce prior to December 8, 2000. Therefore, Gibson's use of EX and EXP has priority over Registrant's use of EXP COATED.

4. Registrant's mark EXP COATED means, according to Registrant, a coating that provides extended play. Therefore, EXP COATING has a specific meaning when applied to the goods. Therefore, Registrant's mark is merely descriptive when applied to the goods. Therefore, Registrant's registration was improperly granted.

5. According to the records of the U.S. Patent and Trademark Office, someone, probably the Registrant, told the Patent and Trademark Office that EXP COATED meant "expired coated." If made by Registrant, such a representative amounts to fraud of the Trademark Office given that EXP COATED means, according to Registrant, a coating that provides extended play.

6. Petitioner is harmed and/or will be harmed by U.S. Registration No. 2,554,111.

WHEREFORE, Petitioner prays that the petition be sustained and that U.S. Registration No. 2,554,111 be cancelled.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment coincident to this Answer to Notice of Opposition to Deposit Account 23-0035.

Respectfully submitted,



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CERTIFICATE OF EXPRESS MAIL

I hereby certify that this Petition to Cancel along with two copies and a check in the amount of \$300.00 is being deposited with the United States Postal Service, via Express Mail, Label No. EV 105954792 US on October 6, 2002, addressed to:

BOX TTAB
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



Edward D. Lanquist, Jr.