

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

U.S Trademark Registration No.: 2,554,110
Trademark: EXP

TTAB

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

GIBSON GUITAR CORP.)
309 Plus Park Blvd.)
Nashville, Tennessee 37217)

Petitioner,)

) Cancellation Nos.: 92041175
) and 92041688

v.)

J. D'ADDARIO & CO., INC.)
595 Smith Street)
Farmingdale, New York 11735)

Registrant.)
_____)

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**PETITIONER'S BRIEF IN SUPPORT OF ITS
PETITION FOR CANCELLATION**



07-01-2004

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STATEMENT OF THE ISSUES

Whether Registrant J. D'Addario & Co., Inc.'s ("Registrant") U.S. Registration No. 2,554,110 for the mark EXP should be cancelled because (1) Petitioner Gibson Guitar Corp. ("Gibson") owns the trademark EXP in connection with guitars, (2) Registrant's mark is likely to create confusion with Gibson's mark, and (3) Gibson is the senior user in the United States.

Gibson's Answer: Yes.

Whether Registrant's U.S. Registration No. 2,554,111 for the mark EXP COATED should be cancelled because (1) Gibson owns the trademark EXP in connection with guitars, (2) Registrant's mark is likely to create confusion with Gibson's mark, and (3) Gibson is the senior user in the United States.

Gibson's Answer: Yes.

I. INTRODUCTION

For more than 100 years, Petitioner Gibson Guitar Corp. ("Gibson") has been engaged in the business of designing, manufacturing and distributing for sale a variety of musical instruments, including string instruments such as mandolins and banjos, as well as accessories, such as amplifiers and strings, throughout the United States and internationally. Berryman Tr. 9:6-10. Gibson is best known for its guitars, including both acoustic and electric guitars.

One of Gibson's longstanding guitar designs is the EXPLORER guitar. The EXPLORER guitar is a solid body guitar with offsetting angles and a curved headstock which was developed by Gibson. Berryman Tr. 7:25-8:3. Since at least as early as 1958, Gibson has used the mark EXPLORER in connection with guitars. Berryman Tr. 8:4-7. In addition, Gibson has used the mark EXP as a designation for the EXPLORER guitar since at least as early as 1993. Berryman Tr. 9:17-24; 14:4-8.

In 2001, 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) for stringed musical instruments, namely electric guitars. The U.S. Patent and Trademark Office refused to register Gibson's marks because of U.S. Trademark Registration No. 2,554,110.

Registrant, J. D'Addario & Co, Inc. ("Registrant") obtained U.S. Trademark Registration No. 2,554,110 for EXP and U.S. Registration No. 2,554,111 for EXP COATED in connection with strings for musical instruments. The date of first use of

the registrant's marks is January 22, 2001. Registrant's intent to use applications were filed December 8, 2000.

Registrant's priority date is December 8, 2000. Gibson's priority date is at least as early as 1993. Therefore, Gibson's use of EXP is senior to Registrant's use of EXP and EXP COATED.

Registrant's registrations are for EXP and EXP COATED in connection with strings for stringed musical instruments such as guitars which, under the du Pont factors, create a likelihood of confusion with Gibson's senior mark EXP used in connection with stringed instruments - guitars. As a result, Registrant's registrations for EXP and EXP COATED should be canceled.

II. DESCRIPTION OF RELEVANT PORTION OF THE RECORD

David H. Berryman, President of Gibson, testified on Gibson's behalf on January 7, 2004 and April 16, 2004. Pursuant to T.B.M.P. 703.01(h) and 703.01(l), when trial testimony is filed with the Board, it automatically constitutes part of the evidentiary record. On February 3, 2004, the January 7, 2004 Transcript of David H. Berryman ("Berryman Tr. ___:___") and Exhibits 1-14 were filed with the Board. On April 23, 2004, the April 16, 2004 Transcript of David H. Berryman ("Berryman Reb. Tr. ___:___") and Exhibit 17 were filed with the Board.

Mr. James D'Addario, President and CEO of Registrant, testified on Registrant's behalf on March 4, 2004. Pursuant to T.B.M.P. 703.01(h) and 703.01(l), when trial testimony is filed with the Board, it automatically constitutes part of the evidentiary record. On March 23, 2004, pages 1-2, 63-90, and 94-95 of the March 4,

2004 Transcript of James D'Addario ("D'Addario Tr. ___:___") and Exhibits 15, 16, CC, CD, CE, CH, CJ, CK, CL, CO, and CR were filed with the Board.

The record also consists of the files for Registrant's U.S. Registrations 2,554,110 and 2,554,111, pursuant to 37 C.F.R. 2.122(b)(1).

III. STATEMENT OF THE FACTS

Gibson manufactures and sells guitars under the EXP mark. Berryman Tr. 8:12-22. In connection with the sale of its guitars, Gibson has used its EXP trademark since at least as early as September 15, 1993. Berryman Tr. 13:15-14:3; Exhibit 1 to deposition. Gibson has sold the EXPLORER guitar since 1958. Berryman Tr. 8:4-7.

Gibson sells its products, including the EXPLORER guitar, to approximately 1,000 retail dealers throughout the U.S. Berryman Tr. 9:17-24. These retail dealers in turn sell the guitars to the end user. Berryman Tr. 9:25-10:2. Gibson also sells its guitars to international distributors throughout the world. Berryman Tr. 9:17-24.

In connection with the distribution of EXP goods, Gibson uses the EXP mark on price lists provided to every retailer Gibson has and copies of the price lists are also made available to guitar buyers. Berryman Tr. 14:4-8. For example, regarding the price list dated September 15, 1993, several thousand such price lists were distributed. Berryman Tr. 14:4-23; Ex. 1. Gibson has an employee who is responsible for preparing price lists and it is Gibson's practice to issue such price

lists and retain copies of price lists in the ordinary course of business, making these price list admissible. Berryman Tr. 15:7-25.

Gibson has established widespread knowledge of and goodwill for the EXP mark, as evident from the repetitive and continuous use of the mark on documents provided to the distributors, retailers, and consumers in the industry. Gibson additionally provides invoices which use the EXP mark to dealers. Berryman Tr. 24:3-14; Exhibit 8 to deposition. Such invoices are routinely prepared by an employee at Gibson and those invoices are kept in the ordinary course of business, making the invoices admissible. Berryman Tr. 24:15-23. The EXP mark is also used in a warranty booklet that goes out with each EXPLORER guitar since April 2001. Berryman Tr. 29:12-25, 30:4-9 and Ex. 14.

Gibson has embarked upon a program of perfecting its rights to its EXP mark. 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. 2,554,110.

Registrant registered its mark EXP for strings for musical instruments in International Class 15. U.S. Registration No. 2,554,110. The date of first use of the Registrant's mark is January 22, 2001. U.S. Registration No. 2,554,110. Registrant also registered its mark EXP COATED for strings for musical instruments in International Class 15. U.S. Registration No. 2,554,111. The date of first use of the Registrant's mark is January 22, 2001. U.S. Registration No. 2,554,111.

Gibson uses EXP for stringed instruments (guitars) whereas Registrant has registered EXP and EXP COATED in connection with strings for stringed instruments (including guitars). Gibson also sells guitar strings. Berryman Tr. 9:11-16. Registrant is aware of Gibson's sales of guitar strings. D'Addario Tr. 71:22-24, 86:2-3. Registrant is also aware that their strings get placed on Gibson guitars. D'Addario Tr. 73:4-10. Registrant's promotional materials show its EXP strings used on Gibson stringed instruments. D'Addario Tr. 81:10-82:9, 85:6-22, Exs. CH (146, 160) and CR (278, 283).

Guitars and strings are sold in the same stores. Berryman Tr. 10:17-21. D'Addario Tr. 38:10-16. Gibson and Registrant advertise in the same magazines. D'Addario Tr. 75:8-25. Registrant and Gibson show products at the same trade shows. D'Addario Tr. 35:8-20, 76:2-11.

ARGUMENT

IV. U.S. REGISTRATION NUMBERS 2,554,110 AND 2,554,111 SHOULD BE CANCELLED BECAUSE REGISTRANT'S "EXP" AND "EXP COATED" MARKS CREATE A LIKELIHOOD OF CONFUSION WITH GIBSON'S SENIOR EXP TRADEMARK.

Gibson will be damaged by the registrations for the EXP and EXP COATED marks in connection with strings for musical instruments. With regard to standing, Gibson does not have to prove actual damage; rather it is only necessary to show the likelihood of damage due to the continued existence of the registration. Golden Gate Salami Co. v. Gulf States Paper Corp., 332 F.2d 184, 141 U.S.P.Q. 661, 664 (C.C.P.A. 1964); Harjo v. Pro Football Inc., 30 U.S.P.Q.2d 1828, 1832 (T.T.A.B. 1994). Because Gibson's application to register EXP has been denied

because of the Registrations, Gibson has standing. Further, Gibson's proof of likelihood of confusion is sufficient to create standing.

Gibson need only prove its case by a preponderance of the evidence. Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 U.S.P.Q. 272, 275 (C.C.P.A. 1974).

A. GIBSON IS THE PRIOR USER OF THE "EXP" MARK.

In order to succeed in a cancellation proceeding, the petitioner need not assert "technical" trademark rights, i.e., rights in a mark that would be eligible for federal registration. 3 J. McCarthy, McCarthy On Trademarks And Unfair Competition, § 20:16 at 20-34 (4th ed. 2004). It is sufficient for the petitioner to assert prior rights in the mark which are "analogous" to trademark rights. McCarthy § 20:16 at 20-35. Such prior rights can be based on "use analogous to trademark use" which has been defined as "non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide a basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met." Shalom Children's Wear Inc. v. In-Wear A/S, 26 U.S.P.Q.2d 1516, 1519 (T.T.A.B. 1993). Although such use has never been considered a sufficient basis for registration, it has "consistently been held sufficient use to establish priority rights as against subsequent users of the same or similar marks." Id.

As the T.T.A.B. has stated, "... prior use of a designation as a distinguishing feature of a trade name, in a descriptive sense, in a manner analogous to trademark

use, or any other manner of public use, is sufficient” to defeat registration by another. Reynolds Televator Corp. v. Pfeffer, 173 U.S.P.Q. 437, 440 (T.T.A.B. 1972). Thus, a party may rely on advertising, promotions, or other public use of a term, slogan, mark, or other designation and even on the copyrighted appearance of its products. See In re Nuclear Research Corp., 16 U.S.P.Q.2d 1316, 1317 (T.T.A.B. 1990) (Priority of use based on use analogous to trademark use in the form of letterhead and a page from an advertising brochure).

In National Cable Television Association v. American Cinema Editors, Inc., 937 F.2d 1572, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991), the National Cable Television Association appealed the T.T.A.B.’s decision granting the American Cinema Editors’ petition to cancel their registration for the service mark “ACE.” The Federal Circuit affirmed the decision, finding that the American Cinema Editors had prior use of the mark based on their use of the mark in publications and correspondence as well as the public’s use of the mark. “[A]bbreviations and nicknames of trademarks or names used *only* by the public give rise to protectable rights in the owners of the trade name or mark which the public modified.” Id. at 1428; see also Volkswagen A.G. v. Thermo-Chem Corp., 185 U.S.P.Q. 561 (T.T.A.B. 1977) (“BUG” nickname for automobile).

Since at least September 15, 1993, Gibson has been using the mark EXP to designate its EXPLORER guitars. This use by Gibson predates D’Addario’s earliest priority date for the EXP and EXP COATED marks, thus establishing Gibson’s

prior rights to the mark sufficient to justify cancellation of the D'Addario registrations.

Each year, Gibson sells between that 5,000 and 10,000 EXPLORER guitars. Berryman Tr. 14:16-23. At least two times each year, Gibson distributes price lists using the EXP mark. Each time a new price list is released, several thousand price lists displaying the EXP mark are distributed to Gibson retailers. Berryman Tr. 14:4-15. Not only do the retailers use the price lists internally, they also distribute the price lists to end consumer, i.e., guitar buyers. Berryman Tr. 14:4-15. In fact, many retailers request extra copies of the price lists just for this purpose. Berryman Tr. 14:9-15. Representative price lists are kept in the ordinary course of business making them admissible business records. Berryman Tr. 16:6-25, 18:2-10, 19:2-14, 20:3-13, 21:1022:2, 25:10-26:10, 27:3-25, 28:1-17; Exhibits 2-7 and 9-13 to deposition. Therefore, long before Registrant's December 8, 2000 priority date, consumers associated EXP with Gibson's EXPLORER guitar as a result of Gibson's use of the mark.

In addition to using the mark on price lists, the EXP mark was also displayed on Gibson's invoices long before Registrant's December 8, 2000 priority date. Berryman Tr. 29:15-25, 30:1-9, 28:20-25, 29:1-9; Exhibit 14 to deposition. In Martahus v. Video Duplication Services, Inc., 3 F.3d 417, 27 U.S.P.Q.2d 1846 (Fed. Cir. 1993), the Federal Circuit affirmed the T.T.A.B.'s decision to grant priority of use to cancellation petitioner based on the use of the mark on invoices and a single contract, stating that use of the mark on invoices was inherently a use of the mark

in connection with a sale. Id.; see also Sealy, Inc. v. Simmons Co., 265 F.2d 934, 937, 121 U.S.P.Q. 456, 459 (CCPA 1959) (use of mark in sales invoices considered probative evidence of priority of use of trademark). Those invoices were prepared by Gibson, used the EXP mark, the invoices were regularly used, and were kept in the ordinary course of business by Gibson. Berryman Tr. 22:4-8, 22:22-25, 23:17-25, 24:3-7, 24:12-23, 26:10-25, 26:8-12, 28:20-25, 29:1-10; Exhibits 7-8, 10, and 14 to deposition.

Furthermore, Gibson has displayed the EXP mark on hang tags attached to the goods since April of 2001. Berryman Tr. 29:15-25, 30:1-9, 28:20-25, 29:1-9; Exhibit 14 to deposition.

As a result of Gibson's efforts, the consuming public knows the EXPLORER guitar as EXP and EX. Berryman Tr.8:12-22. Consumers use EXP as a short hand designation for the EXPLORER guitar. Berryman Tr.8:12-22. Guitar buyers order EXPLORER guitars using the EXP mark. Berryman Tr. 199:19-200:5. Martahus, 3 F.3d 417, 27 U.S.P.Q.2d 1846 (Court relied upon unrebutted testimony of petitioner's president that public used mark in question). The common nature of the musical industry developing shorthand trademarks for its products was demonstrated by how Registrant sells its strings. Registrant's customers order its strings by model name and number. D'Addario Tr. 83:2-12. For example, Registrant's customers will call and make an order such as "I want some EXP 15's." D'Addario Tr. 83:13-15.

Perhaps the most telling proof of consumer association with EXP is that when third parties illegally copy Gibson's EXPLORER guitar body shape, the infringers generally call it the EXP to call to mind consumer association with the Explorer guitar. Berryman Tr. 12:20-24. For example, during the course of the testimony periods, Gibson learned that yet another infringer, Ed Roman Guitars, was using "EXP" to sell its knock-off of Gibson's EXPLORER/EXP guitar. Berryman Tr. 46:5-14. After being contacted by counsel for Gibson, Ed Roman Guitars stopped selling its knock-off guitars and stopped using the EXP trademark in connection with guitars. Berryman Reb. Tr. 5:9-23.

All of this evidence supports the conclusion that Gibson has established prior use of the EXP mark. See West Florida Seafood, Inc. v. Jet Restaurants, Inc., 31 F.3d 1122, 31 U.S.P.Q.2d 1660 (Fed. Cir. 1994) (Finding prior use of the mark based on three newspaper advertisements, a health inspection report and a state business license and registration; proper determination requires consideration of the evidence as a whole). As a result of Gibson's efforts, guitar dealers, guitar distributors, and guitar buyers associate the EXP mark with Gibson's EXPLORER guitar. Berryman Tr. 8:16-22. In response to the many price lists, invoices, and copyists that are proof of consumer association between the EXPLORER guitar and the EXP mark, Registrant's only proof to the contrary will be the self-serving denial from Registrant's President, James D'Addario. Therefore, Gibson has demonstrated, by a preponderance of the evidence, that the EXP mark became protectable through

analogous use at least as early as 1993, thereby making Gibson's EXP mark senior to Registrant's EXP and EXP COATED marks.

B. REGISTRANT'S "EXP" AND "EXP COATED" MARKS CREATE A LIKELIHOOD OF CONFUSION WITH GIBSON'S EXP MARK.

As the Board is well aware, likelihood of confusion is determined under the du Pont factors. Application of E. I. du Pont De Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

i. THE MARKS ARE SO SIMILAR AS TO CREATE A LIKELIHOOD OF CONFUSION.

The first factor is "[t]he similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. Id. It is well established that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992).

Registrant's EXP mark is identical to Gibson's EXP trademark. Registrant's EXP COATED mark is used on strings for musical instruments that are coated for extended play. D'Addario Tr.70:12-71:9. Therefore, the term "coated" is descriptive and adds nothing to distinguish EXP COATED from EXP for trademark purposes. Therefore, for trademark purposes, EXP and EXP COATED are identical and both are identical to Gibson's EXP trademark.

Therefore, the marks are so similar as to create a likelihood of confusion.

ii. **THE GOODS OFFERED UNDER THE MARKS ARE SO RELATED AS TO CREATE A LIKELIHOOD OF CONFUSION.**

The second factor to consider is “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. When considering the relatedness of the goods, “even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” Recot, Inc. v. Becton, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1898 (Fed. Cir. 2000). For example, in an opposition concerning FRITO-LAY snacks and FIDO LAY pet snacks, it was proper for the Board to consider evidence that several companies produced and sold both pet and human food, and to consider co-merchandising efforts. Id. Certainly, the second du Pont factor directly addresses whether “a consumer would likely think that [a company] produced, sponsored, or licensed its mark for use for [alternate] products.” Id.

In another case applying the second du Pont factor, the Federal Circuit affirmed the Board’s decision that a likelihood of confusion existed between two identical marks, one for bread and the other for cheese. In re Martin’s Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984). Although the Board recognized that the goods “exhibit cognizable differences,” it expressed that bread and cheese are “sold by the same retail outlets.” Id. at 1290. The Court

noted that “[t]he Board considered the fact that bread and cheese are likely to be used together as relevant to the question of likelihood of confusion.” Id. The Court concluded by stating that “complementary use has long been recognized as a relevant consideration in determining a likelihood of confusion.” Id.

Gibson sells the EXP guitar. Berryman Tr. 8:4-15. Gibson sells bass guitars and acoustic guitars. D’Addario Tr. 89:14-21. Gibson also sells guitar strings and bass strings. Berryman Tr. 9:11-16. Registrant is aware of Gibson’s sales of guitar strings. D’Addario Tr. 71:22-24, 86:2-3.

Registrant sells acoustic guitar strings, electric guitar strings, bass guitar strings, classic guitar strings, and mandolin strings using the EXP or EXP COATED marks. D’Addario Tr. 27:6-24, 89:9-13. Registrant sells guitar strings which fit most guitars, including Gibson’s EXP guitar. Berryman Tr. 11:13-22. Registrant acknowledges that many guitar companies put D’Addario strings on their guitars. D’Addario Tr. 72:4-6. Registrant is also aware that their strings are placed on Gibson guitars by the guitar users. D’Addario Tr. 73:4-10.

The relationship between Gibson guitars and D’Addario strings is further promoted by materials provided by Registrant. For example, Registrant’s 2002 calendar shows photos of musicians playing Gibson guitars. D’Addario Tr. 81:10-25, 82:1-9. Registrant also uses advertising for strings showing a mandolin which Registrant acknowledges is a Gibson product. D’Addario Tr. 85:6-22.

First, Gibson’s EXP guitar would clearly be related to Registrant’s EXP guitar strings in the mind of the consuming public as to the origin of the goods. A

consumer would likely think that Gibson produced, sponsored, or licensed the EXP mark for guitar strings. Second, this Board has recognized that complementary use, such as use of EXP guitar strings on an EXP guitar, is certainly relevant in determining the likelihood of confusion. Because a guitar requires guitar strings, a consumer would likely think that Gibson is involved in the production and sales of EXP guitar strings. Accordingly, the goods offered under the EXP mark are not only related, but they must be used together.

Therefore, Gibson's guitars and Registrant's strings are sufficiently similar and complimentary to warrant a finding of likelihood of confusion.

iii. THE CHANNELS OF TRADE ARE THE SAME THEREBY CREATING A LIKELIHOOD OF CONFUSION.

The third factor to consider when determining whether a likelihood of confusion exists is “[t]he similarity or dissimilarity of established, likely-to-continue trade channels.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. In Jockey International Inc. v. Butler, the Board stated that “absent any limitations in the parties’ identifications, the goods must be assumed to move through all normal channels of trade for goods of this type and to reach all normal purchasers and users.” 3 U.S.P.Q.2d 1607, 1611 (T.T.A.B. 1987); see also In re Nobody's Perfect Inc., 44 U.S.P.Q.2d 1054, 1055 (T.T.A.B. 1997). The Court of Appeals for the Federal Circuit has noted that when two parties “advertise in the same media, offer the same services to the same types of purchasers, and employ the same trade channels” that such activities “enhance the likelihood of confusion.” Century 21 Real Estate, 23 U.S.P.Q.2d at 1700.

Gibson and Registrant both sell the relevant products through the same retailers. Berryman Tr. 9:17-24; D'Addario Tr. 79:3-11. Similarly, Gibson and Registrant advertise the relevant products in the same trade magazines, including *MMR* magazine, *Guitar Player* magazine, *Guitar One* magazine, and *Guitar World* magazine. D'Addario Tr. 34:20-25, 35:1-7, 75:8-25. Gibson and Registrant show the relevant products at the same trade shows. D'Addario Tr. 35:8-20, 76:2-11.

The identity of trade channels warrants a finding of likelihood of confusion.

iv. THE PRICE OF REGISTRANT'S PRODUCTS MERITS A FINDING OF LIKELIHOOD OF CONFUSION.

The fourth factor is “[t]he conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful, sophisticated purchasing.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Registrant’s strings retail in the range of \$9.99-\$14.99. D'Addario Tr. 19:25-20:5. Therefore, once a Gibson consumer has purchased an EXP guitar that it really likes for several hundred dollars or more, the \$9.99-\$14.99 strings displaying the EXP mark will not create a consumer sufficiently careful to preclude a likelihood of confusion. Therefore, the price of Registrant’s products merits a finding of likelihood of confusion.

v. THE EXP MARK HAS BEEN USED FOR SUCH A LONG TIME AS TO BE VERY STRONG THEREBY WARRANTING A FINDING OF LIKELIHOOD OF CONFUSION.

Gibson's prior use of the EXP mark has created a strong mark. It is estimated that between 5,000 and 10,000 Explorer guitars are sold each year. Berryman Tr. 14:16-23. Price lists displaying the EXP mark are distributed twice a year to the several thousand Gibson retailers and additionally to consumers. Berryman Tr. 14:4-15. The EXP mark was also displayed on invoices by Gibson long before Registrant's December 8, 2000 priority date and had been displayed on hang tags since April of 2001. Berryman Tr. 29:15-25, 30:1-9, 28:20-25, 29:1-9; Exhibit 14 to deposition. Perhaps the most telling proof of consumer association with EXP and its strength is that when third parties illegally copy Gibson's EXPLORER guitar body shape, the infringers generally call it the EXP to call to mind consumer association with Gibson's guitar. Berryman Tr. 12:20-24. Therefore, the duration of use of and the strength of Gibson's EXP mark warrants a finding of likelihood of confusion.

vi. THERE ARE FEW SIMILAR MARKS THEREBY DEMONSTRATING LIKELIHOOD OF CONFUSION.

The sixth factor is "[t]he number and nature of similar marks in use on similar goods." du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Regarding the sixth du Pont factor, Registrant has the burden to show such widespread, significant and unrestrained third party use of the mark to the extent that it cannot serve as an

indicator of origin. See Hilson Research Inc. v. Society for Human Resource Management, 27 U.S.P.Q.2d 1423, 1431 (T.T.A.B. 1993).

Registrant did not provide admissible evidence of use by third parties. Its only proof of third party use is inadmissible hearsay. Further, Registrant offers no proof as to the numbers of products sold by these third parties. Registrant does nothing more than provide the fact that a web search uncovered a few users of EXP.

Even if it were admissible, Registrant's proof of third party use of EXP is too limited to meet its burden. Gibson challenges Registrant to show that its hearsay evidence provides any proof that guitars displaying EXP are presently available from more than one or two third parties. Unfortunately, the internet contains a great deal of information that is outdated and needs to be removed. As Gibson learns of a third party user of EXP, it acts to stop such infringement. Berryman Reb. Tr. 4:11 – 5:6. Registrant notified Gibson of three then-current users of EXP in connection with guitars – Ed Roman Guitars, Legend Guitars, and Peavey Electronics. Gibson sent cease and desist letters to Ed Roman Guitars and Legend Guitars, both of whom have stopped using the EXP mark. Berryman Reb. Tr. 5:9 – 6:21. Gibson and Peavey Electronics are in discussions. Berryman Reb. Tr. 7:17 – 8:10.

Therefore, the lack of third party users of EXP supports a finding of likelihood of confusion.

vii. KNOWN INCIDENTS OF ACTUAL CONFUSION ARE NOT REQUIRED TO ESTABLISH A LIKELIHOOD OF CONFUSION BETWEEN THE MARKS.

The seventh factor to be considered is “[t]he nature and extent of any actual confusion.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. However, evidence of actual confusion is not required. Id. Rather, if such evidence is of record, then such evidence must be considered. Id. It should be noted that the absence of evidence of actual confusion, when inexpensive products are involved, does not necessarily support a finding of no likelihood of confusion. Beer Nuts, Inc. v. Clover Club Foods Company, 805 F.2d 920, 231 U.S.P.Q. 913, 918 (10th Cir. 1986). It is not necessary to provide evidence of actual confusion to establish a likelihood of confusion. Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 218 U.S.P.Q. 390, 396 (Fed. Cir. 1983).

Since it is unnecessary to show actual confusion to establish a likelihood of confusion between marks, the absence of actual confusion is a factor which favors neither Registrant nor Gibson.

viii. THE LENGTH OF CONCURRENT USE IS TOO SHORT TO OVERCOME A FINDING OF LIKELIHOOD OF CONFUSION.

The eighth factor is “[t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Registrant has only been using its mark for a few years. Therefore, the concurrent use is too short to overcome a finding of

likelihood of confusion. Therefore, this factor supports a finding of likelihood of confusion.

ix. THE VARIETY OF GOODS UPON WHICH THE MARK IS DISPLAYED MERITS A FINDING OF LIKELIHOOD OF CONFUSION.

The ninth factor is “[t]he variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Gibson uses EXP on guitars. D’Addario uses EXP and EXP COATED on the strings that go on those guitars. Therefore, no analysis of house marks is required. Therefore, this factor supports a finding of likelihood of confusion.

x. THERE IS NO MARKET INTERFACE TO PRECLUDE A FINDING OF LIKELIHOOD OF CONFUSION.

The tenth factor to consider is “[t]he market interface between applicant and the owner of a prior mark.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. Registrant demonstrates no interface that can overcome a likelihood of confusion. There is no consent or other agreement between the parties and Registrant offers no credible proof of laches or estoppel indicative of a lack of confusion. Therefore, this factor merits a finding of likelihood of confusion.

xi. THE MISCELLANEOUS FACTORS DO NOT WARRANT AGAINST A FINDING OF LIKELIHOOD OF CONFUSION.

The eleventh factor is “[t]he extent to which applicant has a right to exclude others from use of its mark on its goods.” du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. The final two factors are “[t]he extent of potential confusion, i.e., whether de

minimis or substantial” and “[a]ny other established fact probative of the effect of use.” Id. The final three factors have no application in the present matter.

xii. ANY DOUBTS THAT THIS BOARD MAY HAVE CONCERNING CONFUSION SHOULD BE RESOLVED IN FAVOR OF THE PETITIONER, WHO IS NOT THE NEWCOMER.

If the Board has any doubts regarding the likelihood of confusion, then such doubts must be resolved against the newcomer. Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 U.S.P.Q. 221, 223 (C.C.P.A. 1974). Stated another way, when a case is “difficult to resolve,” then it should be resolved against the newcomer. Century 21 Real Estate, 23 U.S.P.Q.2d at 1701.

Registrant’s first use of EXP and EXP COATED was January 22, 2001 and the registrations have a filing and priority date of December 8, 2000. U.S. Registration Nos. 2,554,110 and 2,554,111. Gibson’s use of EXP, which began as early as 1993, consists of thousands of price lists and invoices distributed by Gibson with the mark. Berryman Tr. 14:4-8. Clearly, Gibson’s use of EXP predates that of Registrant. Therefore, any doubt should weigh in favor of cancellation.

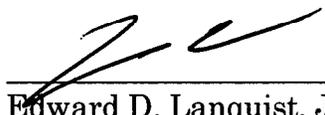
V. CONCLUSION

Because Gibson demonstrates ownership of the EXP mark and a likelihood of confusion, Gibson respectfully submits that the registrations should be cancelled.

Petitioner does not believe that a fee is due. If a fee is due, however, please charge it to our Deposit Account No. 23-0035.

GIBSON GUITAR CORP.

By: _____


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VI. EVIDENTIARY OBJECTIONS

Petitioner objects to admission of the following evidence offered by Registrant:

1. Petitioner objects on the grounds of lack of prior production under Rule 26 of the Federal Rules of Civil Procedure, lack of foundation as to authenticity under Rule 901 of the Federal Rules of Evidence, and hearsay under Rule 802 of the Federal Rules of Evidence to the admission of Exhibit Nos. C, D, E, F, G, H, I, J, K, and L of the deposition of David H. Berryman on January 7, 2004.

2. Petitioner objects on the grounds of relevance under Rule 402 of the Federal Rules of Evidence to the admission of the testimony on page 50, lines 10-11; page 52, line 15-25; and page 53, lines 5-17 of the transcript of the deposition of David H. Berryman on January 7, 2004. The activities being described by Mr. Berryman do not pertain to the issue in the case.

3. Petitioner objects on the grounds of relevance under Rule 402 of the Federal Rules of Evidence to the admission of the testimony on page 87, lines 15-23; and page 89, lines 1-9 of the transcript of the deposition of David H. Berryman on January 7, 2004. The activities being described by Mr. Berryman do not pertain to the issue in the case.

4. Petitioner objects on the grounds of lack of foundation as to authenticity under Rule 901 of the Federal Rules of Evidence to the admission of the testimony on page 91, lines 8-25 and page 92, lines 1-17 of the transcript of the deposition of David H. Berryman on January 7, 2004.

5. Petitioner objects on the grounds of relevance under Rule 402 of the Federal Rules of Evidence to the admission of the testimony on page 97, lines 8-10; page 98, lines 9-25; and page 99, lines 1-7 of the transcript of the deposition of David H. Berryman on January 7, 2004. The activities being described by Mr. Berryman do not pertain to the issue in the case.

6. Petitioner objects on the grounds of hearsay under Rule 802 of the Federal Rules of Evidence to the admission of Exhibit No. BU to the deposition of James D'Addario on March 4, 2004.

7. Petitioner objects on the grounds of hearsay under Rule 802 of the Federal Rules of Evidence to the admission of Exhibit Nos. CA and CB to the deposition of James D'Addario on March 4, 2004.

8. Petitioner objects on the grounds of prior redaction under Rule 26 of the Federal Rules of Civil Procedure to the admission of Exhibit No. CL to the deposition of James D'Addario on March 4, 2004.

9. Petitioner objects on the grounds of hearsay under Rule 802 of the Federal Rules of Evidence to the admission of Exhibit No. CT to the deposition of James D'Addario on March 4, 2004.

10. Petitioner objects on the grounds of attorney client privilege under Rule 501 of the Federal Rules of Evidence to the admission of the testimony on page 13, lines 7-10 of the transcript of the deposition of David H. Berryman on April 16, 2004.

11. Petitioner objects on the grounds of relevance under Rule 402 of the Federal Rules of Evidence to the admission of the testimony on page 18, lines 22-25; and page 19, lines 1-12 of the transcript of the deposition of David H. Berryman on April 16, 2004. The activities being described by Mr. Berryman do not pertain to the issue in the case.

12. Petitioner objects on the grounds that the question was beyond the scope of direct under Rule 611 of the Federal Rules of Evidence to the admission of the testimony on page 32, lines 6-9 of the transcript of the deposition of David H. Berryman on April 16, 2004.

CERTIFICATE OF EXPRESS MAILING

“EXPRESS MAIL” mailing label number: EV 547566485 US

Date of deposit: July 1, 2007

I hereby certify that the original and two copies of PETITIONER'S BRIEF IN SUPPORT OF ITS PETITION FOR CANCELLATION are being deposited with the United States Postal Service as “Express Mail” Post Office to Addressee under 37 C.F.R. § 1.10 on the date indicated above and is addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

July 1, 2007

Date


Edward D. Lanquist, Jr., Esq.

CERTIFICATE OF SERVICE

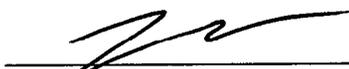
I hereby certify that on this day, that a true copy of the foregoing PETITIONER'S BRIEF IN SUPPORT OF ITS PETITION FOR CANCELLATION was this day deposited with the United States Postal Service, with sufficient postage as first class mail in an envelope addressed to:

BODNER & O'ROURKE, LLP

Gerald T. Bodner, Esq.
425 Broadhollow Road
Melville, New York 11747

July 1, 2007

Date


Edward D. Lanquist, Jr., Esq.