

**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

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.)

08-17-2004
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and 92041688

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

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I. INTRODUCTION

The only two issues before the Board are (1) whether Petitioner Gibson Guitar Corp. (“Gibson”) used the EXP mark in connection with stringed instruments in commerce before Registrant D’Addario & Co, Inc. (“Registrant”) filed its intent to use applications for EXP and EXP COATED in connection with strings for musical instruments and (2) whether Registrant’s use of EXP and EXP COATED creates a likelihood of confusion.

ARGUMENT

II. 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.

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

Many of the facts in this case are undisputed and these facts support Gibson’s right to the EXP mark as a prior user. Since at least as early as 1958, Gibson has used the mark EXPLORER in connection with guitars. (Berryman Tr. 8:4-7). Since at least as early as 1993, Gibson has used the EXP mark on price lists and invoices for its guitars. (Berryman Tr. 9:17-24; 14:4-8). Registrant’s intent to use applications were filed December 8, 2000, giving Registrant a priority date of December 8, 2000. Therefore, the Board need only decide whether Gibson’s use of the mark is sufficient to establish prior rights to the EXP mark.

Applying Registrant’s strict standard, there would be no place for analogous use in trademark law. Instead, the only type of acceptable use would be actual use.

In its brief in support of its petition to cancel, Gibson discusses in detail the background law of use analogous to trademark use. In a nutshell, use analogous to trademark use, which has long been sufficient to establish prior rights to a trademark, is non-technical use of a trademark in connection with the promotion or sale of a product. Shalom Children's Wear Inc. v. In-Wear A/S, 26 U.S.P.Q.2d 1516, 1519 (T.T.A.B. 1993). Here, Gibson will apply only the undisputed facts of this case to the case law of the Board and of the Federal Circuit to demonstrate that while Registrant may try to contest statements that consumers associate EXP with the EXPLORER, Registrant cannot contest Gibson's analogous use of the EXP mark nor the way in which the public uses EXP.

1. THE INVOICES AND PRICE LISTS ESTABLISH ANALOGOUS USE.

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 the 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 (C.C.P.A. 1959) (use of mark on sales invoices considered probative evidence of priority of use of trademark). It is undisputed that Gibson has been using the EXP mark on sales invoices since at least 1993, well before Registrant's December 8, 2000 priority date. (Berryman Tr. 29:15-25, 30:1-9, 28:20-25, 29:1-9; Exhibit 14). Thus, Gibson's use of the mark on

sales invoices is inherently a use of the mark in connection with a sale which predates Registrant's date of first use.

In addition, there is no dispute that at least two times each year, Gibson distributes price lists using the EXP mark. Each time a new price list is released, several thousand copies of that price list 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 consumers, i.e., guitar buyers. (Berryman Tr. 14:4-15). Many retailers request extra copies of the price lists just for this purpose. (Berryman Tr. 14:9-15, 16:6-25, 18:2-10, 19:2-14, 20:3-13, 21:10; 22:2, 25:10-26:10, 27:3-25, 28:1-17; Exhibits 2-7 and 9-13). Therefore, under the Martahus case, Gibson has demonstrated analogous use of the EXP mark which predates Registrant's date of first use.

2. THE PUBLIC KNOWS THE EXPLORER GUITAR AS THE EXP.

Registrant may contest the Berryman testimony that, as a result of Gibson's efforts, the consuming public knows the EXPLORER guitar as EXP and EX. (Berryman Tr. 8:12-22). However, Registrant does not and cannot contest the objective proof supporting this statement. There is no dispute that consumers use EXP as a short hand designation for the EXPLORER guitar in their dealings with Gibson. (Berryman Tr. 8:12-22). There is no dispute that guitar buyers order EXPLORER guitars using the EXP mark. (Berryman Tr. 199:19-200:5); see 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). There is no dispute

that the common practice of the music industry to develop 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).

Furthermore, there is no dispute that when third parties illegally copy the body shape of Gibson's EXPLORER guitar, the infringers generally call the copy EXP in an effort to call to mind and benefit from the association consumers have with Gibson's EXPLORER guitar. (Berryman Tr. 12:20-24).

In its brief, Registrant quotes the Federal Circuit: "[a] showing of analogous use does *not* require direct proof of an association in the public mind." Herbko International, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1162, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002), citing T.A.B. Systems v. Pactel Teletrac, 77 F.3d 1372, 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996) (emphasis added). Immediately thereafter, Registrant says that Gibson has offered no proof that demonstrates an association between EXP and Gibson or its products among consumers. (Registrant's Brief p. 24). However, as shown by the quote used by Registrant, there is no requirement for direct proof of an association in order to show analogous use. Herbko International, 308 F.3d at 1162, 64 U.S.P.Q.2d at 1378. Despite that fact, Gibson has offered proof in the form of both the third party copiers who use the EXP mark to take advantage of consumers' association of the mark with the guitar in order to benefit their own infringing guitars as well as the consumers themselves, who use

the EXP mark when dealing with Gibson. Thus, Gibson has established that consumers associate the EXP mark with Gibson.

3. THE CASES CITED BY REGISTRANT EITHER SUPPORT GIBSON'S ANALOGOUS USE OR ARE EASILY DISTINGUISHABLE.

Registrant cites National Cable Television Association v. American Cinema Editors, Inc., 937 F.2d 1572, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) and argues that the case does not support Gibson's position. Registrant acknowledges that the Federal Circuit in National Cable Television found analogous use where the longer mark was shortened to ACE by "officers, by members, by film professionals and in the press." Id. at 1574, at 1426. Registrant then wrongfully states that no such proof has been offered to this Board.

There is no dispute that consumers use EXP as a short hand designation for the EXPLORER guitar in their dealing with Gibson. (Berryman Tr.8:12-22). There is no dispute that guitar buyers order EXPLORER guitars using the EXP mark. (Berryman Tr. 199:19-200:5). If consumers use EXP for the EXPLORER guitar, then consumers clearly acknowledge an association between Gibson and the mark.

Furthermore, Registrant failed to acknowledge that abbreviations of trademarks used solely by the public can give rise to protectable rights in the trademark owners. See National Cable Television, 19 U.S.P.Q.2d 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).

The next analogous use case cited by Registrant found no analogous use where the claimant had only published one book. Herbko International, Inc. v. Kappa Books, Inc., 308 F.3d 1156, 1162, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002).¹ Finding that book titles are often descriptive, the Federal Circuit found the use insufficient, relying on its precedent that the title of a single book cannot serve as a source identifier to hold that “the publication of a single book cannot create, as a matter of law, an association between the book's title (the alleged mark) and the source of the book (the publisher.)” Id. at 1062-63. Here, not only does the present case not concern a book title, but Gibson’s proof goes far beyond use on a single book to the many price lists and invoices on which the mark has been used over the years and which create the requisite association in consumers’ minds.

The next analogous use case cited by Registrant is Malcolm Nicol & Co., Inc. v. Witco Corporation, 881 F.2d 1063, 11 U.S.P.Q.2d 1638 (Fed. Cir. 1989). The quote from this case included in Registrant’s brief acknowledges that “analogous use” is appropriate. However, Registrant attempts to establish that “analogous use” requires use in the finite list of media of “advertising brochures, in catalogues and newspapers, and in press releases” listed in the case. Obviously, the Federal Circuit intended its list to be exemplary and not exclusive. Otherwise, the Malcolm Nicol case would preclude the use of the third party correspondence as proof of analogous use and that type of proof was sufficient for the same court in the National Cable Television Association case.

¹ Registrant cites Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 U.S.P.Q. 40 (C.C.P.A. 1981) in its analogous use section. However, that case relates to descriptiveness and not analogous use.

Registrant then states that in the Malcolm Nicol case, “the evidence that was held not to satisfy the opposer’s burden of proof that there was analogous trademark use was described at 1065-1066 (11 U.S.P.Q. 2d at 1640).” (Registrant’s Brief p. 25). However, the Federal Circuit found analogous use and granted the analogous user’s petition to cancel based on promotional literature, listings in buyers guides and the testimony of two officers of the petitioner. Malcolm Nicol, 881 F.2d at 1064, 11 U.S.P.Q.2d at 1639. The Federal Circuit did what Registrant would have the Board forbear – review the proof of use in its entirety and not individually. Id., 881 F.2d at 1063, 11 U.S.P.Q.2d at 1638-1639.

The next analogous use case cited by Registrant is Jim Dandy Co. v. Martha White Foods, Inc., 458 F.2d 1397, 173 U.S.P.Q. 673 (C.C.P.A. 1972). In that case, the court affirmed the Board’s findings that some speculative billboard advertising and some limited and speculative radio and television ads were insufficient to create analogous use. Id. at 1399, at 676. Here, the use of EXP on price lists and on invoices is not speculative. The use of EXP by consumers to order products and by infringers to take advantage of consumer association establishes all elements of analogous use.

The next analogous use case cited by Registrant is T.A.B. Systems, 77 F.3d 1372, 37 U.S.P.Q.2d 1879. In that case, the Federal Circuit did not find that there was no analogous use. Instead, the court remanded for further findings on the issue of analogous use. The court considered twelve press clippings and a trade show appearance. Here Gibson shows not only its efforts to create consumer recognition

of EXP but also its successes in conditioning consumers to use EXP when ordering guitars from Gibson as well as the use of the EXP mark by infringers of Gibson's EXPLORER guitars to reap the benefit of consumers' association of the EXP mark with Gibson and its guitar.

Other than the National Cable Television Association case, Registrant did not address the many cases cited by Gibson that discuss other analogous use factors and demonstrate analogous use in similar situations. Again, Registrant may argue against the conclusory statement that consumers do not generally associate EXP and EXPLORER. However, Registrant does not and cannot dispute that consumers use EXP to order the EXPLORER, that EXP has been used on invoices for many years, that EXP has been used on price lists for many years, and that third party infringers use EXP to take advantage of the association of consumers between EXP and EXPLORER.

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

The facts demonstrate that there is a likelihood of confusion 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). In its brief, Registrant returns again and again to the issue of analogous use, even in its discussions of the du Pont factors. Gibson has addressed Registrant's arguments regarding analogous use in the previous section of this reply memorandum and will focus this section of its brief only on an analysis of the du Pont factors.

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

In discussing this du Pont factor, Registrant does not demonstrate that EXP is dissimilar to EXP and EXP COATED. In fact, 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, despite all of Registrant's efforts to obfuscate regarding this du Pont factor, Registrant's use of EXP and EXP COATED on strings for musical instruments such as guitars is likely to create confusion with Gibson's EXP mark on guitars.

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

While Registrant's goods, guitar strings as well as strings for other instruments, are not exactly the same as Gibson's goods, guitars, they are so related that use of the same mark on both creates a likelihood of confusion. Registrant's guitar strings must be used with a guitar and Registrant's strings fit Gibson's EXP guitar. (Berryman Tr. 11:13-22).

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 recognized 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. Here, Registrant's stings and Gibson's guitars are complementary goods.

Registrant fails to address the many undisputed facts set forth in Gibson's original brief. In addition to guitars, Gibson also sells guitar strings and bass strings. (Berryman Tr. 9:11-16). 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's guitar strings 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). Registrant's 2002 calendar shows photos of musicians playing Gibson guitars. (D'Addario Tr. 81:10-25, 82:1-9). Registrant also uses as advertising for its strings a picture showing a mandolin which Registrant acknowledges is a Gibson product. (D'Addario Tr. 85:6-22).

Despite all of these undisputed facts, Registrant tries to establish that there will be no likelihood of confusion between Gibson's more expensive guitars and Registrant's less expensive strings simply because of the difference in price. This argument fails.

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

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

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," such activities "enhance the likelihood of confusion." Century 21 Real Estate, 23 U.S.P.Q.2d at 1700.

Registrant fails to address the facts set forth in Gibson's brief. Gibson and Registrant both sell the relevant products through the same retailers. (Berryman Tr. 9:17-24; D'Addario Tr. 79:3-11). 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.

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

Despite earlier stating that the price difference between Registrant's strings and Gibson's guitars precludes likelihood of confusion, Registrant now argues that its products are expensive. However, despite the fact that Registrant's string are more expensive than other strings, the strings only cost \$9.99 to \$14.99. (D'Addario Tr. 19:25-20:5). Once a Gibson consumer has purchased an EXP guitar that he or she really likes for several hundred dollars or more, the \$9.99-\$14.99 price for strings displaying the EXP mark will not create a consumer sufficiently careful to preclude a likelihood of confusion. Therefore, this factor favors a finding of likelihood of confusion.

5. GIBSON'S EXP MARK HAS BEEN USED FOR SUCH A LONG TIME AS TO BE VERY STRONG THEREBY WARRANTING A FINDING OF LIKELIHOOD OF CONFUSION.

Registrant tries to establish the strength of its mark. However, even if it is assumed that everyone is aware of Registrant's mark, the strength of Registrant's mark would then create reverse confusion with Gibson's prior-used mark. Section 2(d) of the Lanham Act also seeks to preclude reverse confusion. 3 J. McCarthy, McCarthy On Trademarks And Unfair Competition, § 20:10 (4th ed).

Registrant does not contest the facts that Gibson demonstrates. 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 as well as 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 has 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 their knock-off guitars EXPs, to call to mind consumers' association of EXP with Gibson's guitar. (Berryman Tr. 12:20-24). Therefore, the duration of use of and the strength of Gibson's EXP mark warrant a finding of likelihood of confusion.

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

Registrant attempts to demonstrate that there are many third party users of EXP. As the Board is well aware, Registrant has the burden to show such widespread, significant and unrestrained third party use of the mark 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 has failed to provide admissible evidence of use by third parties. Registrant does nothing more than provide the fact that a web search uncovered a few users of EXP, making its only proof of third party use inadmissible hearsay.

Further, Registrant offered no proof as to the numbers of products sold by these third parties or even whether these third parties are currently using the mark.

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 how its hearsay evidence provides any proof that guitars displaying EXP are presently available from more than one or two third parties. As the Board is aware, the internet contains a great deal of information that is outdated.

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 third parties which Gibson was able to determine were 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.

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

Evidence of actual confusion is not required. du Pont, 476 F.2d at 1361, 177 U.S.P.Q. at 567. 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), nor is it 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).

Registrant makes the erroneous argument that no proof of confusion over the three and one half years of concurrent use is compelling. However, even a 25 year history without reported incidents of actual confusion does not prevent a finding that confusion is likely between identical marks. See CAE, Inc. v. Clean Air Engineering, Inc., 267 F.3d 660, 686, 60 U.S.P.Q.2d 1449 (7th Cir. 2001) (“[T]he most that the absence of evidence of actual confusion can be said to indicate is that the record does not contain any evidence of actual confusion known to the parties.”).

Registrant again addresses the strength of its mark. However, as discussed previously, a showing of strength would only establish the risk of reverse confusion.

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.

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

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.

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

Gibson uses EXP on guitars. D'Addario uses EXP and EXP COATED on the strings that go on those guitars. No analysis of house marks is required. Therefore, this factor supports a finding of likelihood of confusion.

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

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.

11. 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 twelfth and thirteenth 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.

C. 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. Soundsciber

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.

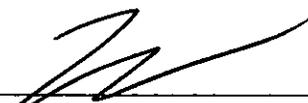
III. CONCLUSION

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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CERTIFICATE OF EXPRESS MAILING

“EXPRESS MAIL” mailing label number: EV 447699189 US

Date of deposit: August 16, 2004

I hereby certify that the original and two copies of PETITIONER'S REPLY 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

August 16, 2004

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 REPLY 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

August 16, 2004

Date


Edward D. Lanquist, Jr., Esq.