

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

In the Matter of  
Trademark Registration No. 2,772,766  
For the Mark SAN DIMAS GUITARS THE  
CALIFORNIA GUITAR COMPANY  
Registration Date: October 7, 2003



12-13-2004

U.S. Patent &amp; TMOtc/TM Mail Rcpt Dt. #11

JACKSON/CHARVEL MANUFACTURING,  
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

**MOTION TO COMPEL RESPONSES TO REGISTRANT'S  
FIRST SET OF INTERROGATORIES**

Registrant Lloyd A. Prins moves the Board for an order compelling Petitioner Jackson/Charvel Manufacturing, Inc. to provide answers to Registrant's First Set of Interrogatories. Petitioner has refused to participate in the discovery process in good faith, and has refused to answer nearly all Interrogatories from the Registrant's First Set of Interrogatories, city nearly identical objections in each case, including those Interrogatories directed to the factual bases for Petitioner's own pleadings. As such, the motion sought should be granted and answered to each Interrogatory from the First Set should be provided.

After receipt of Petitioner's Responses to Registrant's First Set of Interrogatories, Lloyd Prins (Registrant) attempted to confer with Counsel for Petitioner concerning Jackson/Charvel's failure to adequately respond to Registrant's First Set of Interrogatories. Attached as Exhibit A are Petitioner's Responses to Respondent's First Set of Interrogatories. In a letter dated November 13, 2004, (Exhibit B) Registrant detailed the relevancy and propriety of each Interrogatory in the Registrant's First Set of Interrogatories and again requested that Petitioner supply the requested information. Registrant provided reasonable time in which to supplement Petitioner's first set of Responses to Registrant's First Set of Interrogatories. Neither Petitioner nor Petitioner's counsel acknowledged receipt of this request until after three days beyond the period in which Registrant requested a reply. On November 23, 2004, Petitioner's counsel contacted Registrant by telephone requesting two additional weeks for which to provide an appropriate reply to Registrant's First Set of Interrogatories. Registrant agreed to extend his deadline to Friday, December 3, 2004. Friday, December 3, 2004 came and passed with no additional word from Petitioner or Petitioner's Counsel. Finally on December 6, 2004, Petitioner's counsel emailed Registrant stating that "we will get you additional information, as well as specific responses to your objections, this week."

In spite of the general and repetitive nature of Petitioner's objections to the First Set of Interrogatories, Registrant has endeavored to provide specific reasoning and support for each of its Interrogatories hereinbelow stating why each Interrogatory is both proper and relevant to the specific issues involved in this case. Interrogatories discussed below are numbered to correspond with those enumerated in Petitioner's Responses to Respondent's First Set of Interrogatories.

## **ARGUMENTS AGAINST PETITIONER'S GENERAL OBJECTIONS**

### **GENERAL ARGUMENT NO.1: BLANKET OBJECTIONS**

The TTAB has held that blanket objections of the type found in Petitioner's Responses to Respondent's First Set of Interrogatories will not suffice as proper responses to discovery requests because they are vague and conclusionary. See Medtronic Inc., v. Pacesetter Systems, Inc., 222 USPQ 80, 83 (TTAB 1984) (where the TTAB ruled that a blanket objection by one party that the discovery requests of an opponent were too burdensome or numerous was an insufficient response to the discovery requests). Medtronic also obligates each party and its attorney to make a good faith effort to satisfy the discovery needs of its opponent. Id. At 83.

### **GENERAL ARGUMENT NO.2: CONFIDENTIALITY**

Regarding Petitioner's general objection that Registrant's First Set of Interrogatories seek competitively sensitive information or information of a confidential nature, Registrant is willing to enter into a Confidentiality Agreement and Protective Order. Registrant prepared and delivered to Petitioner a standard TTAB protective order for the protection of both parties' confidential information (Exhibit C). Petitioner has not acted upon this document, only to state that they are still working on it.

### **GENERAL ARGUMENT NO. 3: USE OF THE TERM PETITIONER:**

Regarding Petitioner's general objection that Registrant's use of the term "Petitioner" or "Petitioner's" is vague, ambiguous, and undefined in that it does not include predecessors-in-interest, Registrant disagrees with Petitioner's attempt to modify its Petition for Cancellation by naming Akai and IMC as Joint Petitioners. Registrant recognizes that previous owners of Jackson/Charvel may be predecessors-in-interest,

however assignment of that term to Akai, IMC or any other entity relies on facts not in evidence. Additionally, a person, company or entity whose status is “predecessor-in-interest” does not by that status alone, qualify that person, company or entity as a Joint Petitioner.

**GENERAL ARGUMENT NO. 4: INTERROGATORIES ARE UNREASONABLE**

Registrant’s discovery requests are sufficiently described so as to be deemed “reasonable”. Requests are not barred for being overly broad when the circumstances dictate that the requests be framed broadly. See Data-Link Sys., Inc. v. Data Line Serv. Co., 148 F.R.D. 225, 228 (N.D. Ill. 1992). The lack of public available information regarding the claims made in Jackson/Charvel’s Petition for Cancellation necessitates that discovery be broad so that the dispute may be speedily resolved. Therefore, any burden imposed by these requests is outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence, and that requests are not unduly burdensome in light of the needs of the case and the amount in controversy.

**ARGUMENTS AGAINST PETITIONER’S  
SPECIFIC RESPONSES AND OBJECTIONS**

**INTERROGATORY NO. 1:**

Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person:

- A. His/her qualifications and current curriculum;
- B. The subject matter on which the expert may be called to testify;

- C. The substance of the facts and opinions to which the expert may be called to testify;
- D. A summary of the grounds for each opinion; and

**RESPONSE TO INTERROGATORY NO.1:**

Petitioner responded that they have not yet determined whether they will or will not offer expert testimony, and qualified this with sixteen (16) objections.

**ARGUMENT:**

FRCP Rule 26(a)(2)(A) is clear and precise and therefore warrants an unqualified, clear and non-evasive response and within the full scope of FRCP Rule 26(a)(2)(B).

**INTERROGATORY NO. 2:**

Identify each and every person who may offer factual testimony in the above captioned proceeding and state after each person the subject and/or subjects which he/she may be called to testify.

**RESPONSE TO INTERROGATORY NO. 2:**

Petitioner's response included a list of seventeen (17) employees and six (6) non-employees. However, Petitioner qualified this list with sixteen general objections plus an objection that the request is overly broad. Additionally, completely ignored Registrant's relevant and appropriate instructions in identifying these individuals.

**ARGUMENT:**

This interrogatory seeks to discover information regarding individuals who Petitioner may call upon to offer factual testimony in support of their pleadings. The response offered by Petitioner falls short in that the instructions that accompanied this interrogatory requested detailed information that was omitted in Petitioner's response.

For example, Petitioner has provided no mention of job title, contact information, or where appropriate, last known whereabouts. Information sought in this interrogatory is within the scope and provision of the Federal Rules of Civil Procedure (see FRCP 26(a)(1) and (3)) and warrants a thorough and comprehensive answer.

**INTERROGATORY NO. 3:**

Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel. For each person, the answer should include what knowledge it is Petitioner claims each person has.

**RESPONSE TO INTERROGATORY NO. 3:**

Petitioner objected to this request with sixteen (16) general objections plus the specific objection that Interrogatory No. 3 is overly broad.

**ARGUMENT:**

In this response, Petitioner completely avoids the opportunity to provide factual information that can support Petitioner's position and pleadings in this proceeding. Information sought through this Interrogatory may establish the extent that Petitioner has rights to the San Dimas trademark, and as such, the Interrogatory is reasonable and the information sought should be put forth.

**INTERROGATORY NO. 4:**

Identify each and every document and tangible thing that Petitioner claims support the facts and claims set forth in its Petition to Cancel.

**RESPONSE TO INTERROGATORY NO. 4:**

Petitioner responded to this request with sixteen (16) general objections and added that this Interrogatory is also overly broad and burdensome.

**ARGUMENT:**

See General Argument No. 4.

See Argument regarding Interrogatory No. 3

**INTERROGATORY NO. 5:**

Set forth in detail any efforts undertaken by Petitioner or any of its employees, or by any vendor, person, company or entity acting for the Petitioner, for the purpose of obtaining information concerning the Registrant's activities related to the San Dimas mark.

**RESPONSE TO INTERROGATORY NO. 5:**

Petitioner objected to this Interrogatory with sixteen (16) general objections and objects that it is vague, ambiguous, undefined, and not reasonably calculated to lead to the discovery of admissible evidence.

**ARGUMENT:**

Registrant contends that information gathered through this Interrogatory will provide admissible evidence relevant to Registrant's affirmative defenses. As such, Interrogatory No. 5 should be answered fully and completely and without objection.

**INTERROGATORY NO. 6:**

Set forth in narrative form any investigations, internal or otherwise conducted by Petitioner, where the Registrant was either directly or indirectly the focus of such investigation(s).

- A) State what type of investigation was conducted including dates, times and places;

- B) Identify any person who participated in such investigations and/or interviews and indicate whether the person was the interviewer, interviewee, observer or served any other role;
- C) Identify all documents that were generated in the course of such investigation. Include hand-written notes, minutes, follow-up memos, and employee discipline reports; and
- D) Summarize the findings of such investigation.

**RESPONSE TO INTERROGATORY NO. 6:**

Petitioner objected to this Interrogatory with sixteen (16) general objections plus the additional objections that this request is vague, irrelevant, not reasonably calculated to lead to the discovery of admissible evidence and that the term “investigate” is undefined. Additionally Petitioner objects that Interrogatory No. 6 seeks information covered by the attorney-client or attorney work product privileges.

**ARGUMENT:**

Registrant does not seek information that is subject to attorney client privileges, nor does he seek information that Petitioner developed in anticipation of this proceeding.

Interrogatory No. 6 seeks detailed information regarding Petitioner’s conduct to obtain information related to Registrant’s activities associated with Registrant’s San Dimas mark.

Regarding Petitioner’s specific objection that the term “investigation” is vague, and undefined, Petitioner merely needs to reference a commonly used dictionary for guidance. For such an objection to stand, one could conclude that every word used in a discovery request be either specifically defined or captured under a general definition

statement. Additionally, Petitioner's objection is counter-productive to the discovery process and sets up an endless cycle of objections and counter-objections while word meanings are debated.

Interrogatory No. 6 seeks to discover information specific to the Petitioner's activities to track, study, search, collect, or interview for (collectively and commonly referred to as "investigate") information where the Registrant was the focus of such activities. This interrogatory is neither vague in its request, nor is it outside the scope and provisions of the Federal Rules of Civil Procedures.

Interrogatory No. 6 seeks information regarding when and under what circumstances Petitioner first became aware of Registrant's mark. This information is relevant to both the likelihood of confusion between the Petitioner's alleged mark and Registrant's mark (as pleaded by Petitioner), as well as a determination of good faith on the part of the Petitioner in its Petition for Cancellation.

Lastly, Registrant contends that information gathered through this Interrogatory will provide admissible evidence relevant to Registrant's affirmative defenses. Like Interrogatory No. 5, Interrogatory No. 6 should be answered fully and completely and without objection.

**INTERROGATORY NO. 7:**

Set forth in narrative form, any and all documentary evidence, photographs or testimony Petitioner intends to rely on that disputes the accuracy or facts of Registrants claim to the use of the San Dimas trademark.

**RESPONSE TO INTERROGATORY NO. 7:**

In addition to sixteen (16) general objections, Petitioner claims that Interrogatory No. 7 seeks to discover information that is overly broad, unduly burdensome, and nonsensical. Additionally, Petitioner claims that it is not required to offer testimony to a claim that is not a pleading in this proceeding.

**ARGUMENT:**

Registrant accepts Petitioner's claim that Interrogatory No. 7 seeks information regarding a claim that is not a pleading in this proceeding. However, Registrant does not accept Petitioner's sixteen (16) general objections associated with this response. See General Argument No. 1.

**INTERROGATORY NO. 8:**

Completely list and describe all documents and other tangible things (including but not limited to tapes, photographs, diaries, logs, schedules, data files, etc) that Petitioner intends to use in the preparation the above referenced proceeding.

**RESPONSE TO INTERROGATORY NO. 8:**

Petitioner objected to this request with sixteen (16) general objections plus the objection that Interrogatory No. 8 is overly broad and unduly burdensome.

**ARGUMENT:**

This interrogatory seeks to discover documents and tangible things that Petitioner claims support the facts in its pleadings. Referencing Argument related to Interrogatory No. 4 above, this request, although potentially lengthy in its reply, is within the scope and provisions of discovery (see FRCP 26(b)(1)) and any burden imposed by this request is outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence.

**INTERROGATORY NO. 9:**

Set forth in narrative form the facts and circumstances relate to the Petitioner's purchase of the Jackson/Charvel Division from Akai Musical Instruments Corporation. Include the purchase price, the date of purchase, a complete list of all assets purchased, all trademarks purchased and the value of good will included in the purchase.

**RESPONSE TO INTERROGATORY NO. 9:**

Petitioner objected to this request with sixteen (16) general objections plus the objection that Interrogatory No. 9 is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence. Petitioner further objected that this Interrogatory requests confidential information.

**ARGUMENT:**

This interrogatory seeks information pertaining to the facts, circumstances and specific terms of Petitioner's purchase of Jackson/Charvel from Akai. In its Petition for Cancellation, Petitioner alleges that it purchased all trademarks and intellectual property including the San Dimas trademark. This claim has not been supported by any testimony or documentary evidence. Furthermore, Interrogatory No. 9 seeks information that may indicate a potential dispute of ownership of Petitioner's alleged trademarks. If Petitioner does not own the trademarks claimed in the Petition for Cancellation, or acquired them improperly, this is certainly information crucial to the current dispute.

With respect to confidential information, see General Argument No. 2.

See also Arguments related to Interrogatories No. 3 and 4.

**INTERROGATORY NO. 10:**

Set forth in detail all trademarks, registered or unregistered, for which the Petitioner claims ownership. For registered trademarks provide registration. For non-registered marks, provide a description of mark, date of first use, the geographic locations where product(s) is/was sold using the non-registered mark, and date of last use.

**RESPONSE TO INTERROGATORY NO. 10:**

Same response as Interrogatory No. 9. Additionally, Petitioner objects to the phrase “date of last use.

**ARGUMENT:**

Petitioner errors in interpreting the phrase “date of last use” as being synonymous with “no longer in use”. Trademarks currently in use (i.e. those not terminated) could have a date of last use of “today”.

Petitioner alleges in its Petition for Cancellation that it purchased various trademarks including the San Dimas trademark. A detailed listing of these trademarks and the circumstances surrounding the use and/or non-use of these trademarks is likely to lead to admissible evidence.

Interrogatory No. 10 also seeks information that characterizes the business practices by which Petitioner obtains and maintains trademark protections and rights.

Given the reasons stated above, Registrant believes that a thorough and complete answer to Interrogatory No. 10 will likely lead to admissible evidence in support of relevant to Registrant’s affirmative defenses.

**INTERROGATORY NO. 11:**

Set forth in narrative form the facts and circumstances related to all trademarks for which the Petitioner is not currently using but plans to use in the future. Identify all persons who have knowledge of such plans and Identify all documents and tangible things that support this answer.

**RESPONSE TO INTERROGATORY NO. 11:**

Petitioner objected to this request with sixteen (16) general objections and further objected that Interrogatory No. 11 is overly broad, unduly burdensome, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence.

**ARGUMENT:**

See Argument regarding Interrogatory No. 10.

**INTERROGATORY NO. 12:**

Set forth in detail the facts and circumstances that resulted in Petitioner's first use of the San Dimas mark. Include in the answer:

- A) The date of first use of the San Dimas trademark;
- B) The physical address of each manufacturing plant where San Dimas trademarked products were produced;
- C) A specimen of the San Dimas mark and how it was used in association with the sale of product;
- D) A listing of all employees (present and past) who were involved in the design, manufacturing, marketing and selling;
- E) Each product's serial numbers;
- F) Each product's date of manufacturing;
- G) Each product's work order or production control number;

- H) The geographic location where San Dimas trademarked items were sold;  
and
- I) Any and all persons credited with originating the San Dimas trademark  
concept.

**RESPONSE TO INTERROGATORY NO. 12:**

Petitioner objected to Interrogatory No. 12 with sixteen (16) general objections plus objections that this request is vague, ambiguous, overly broad, and unduly burdensome.

**ARGUMENT:**

Interrogatory No. 12 with its nine (9) sub-parts request that the Petitioner delineate the facts and circumstances that resulted in the launch of a newly trademarked product in June of 1993 (i.e. Petitioner's alleged San Dimas mark).

Additionally, Registrant's requests for product serial numbers, dates of manufacturing and workorder numbers are relevant in that this information will likely lead to admissible evidence relative to the strength of Petitioner's mark. Registrant will accept disclosure of representative samples for each year 1993 through 2002 on the condition and stipulation that if requested, a full listing is made available to Registrant for inspection at a later date.

Registrant's request that Petitioner identify the person or persons credited with originating Petitioner's San Dimas trademark concept (a concept that allegedly has resulted in the "sale of tens of hundreds of thousand of dollars worth" of product). This request is clear and unambiguous. It is relevant in that it seeks to identify an individual

or individuals who may offer testimony key to these proceedings and will likely lead to admissible evidence in support of the pleadings in this proceeding.

Given these reasons, Interrogatory No. 12 and its nine (9) sub-parts A through I warrant a separate, and complete response, within the guidelines of FRCP Rule 33(b)(1).

**INTERROGATORY NO. 13:**

Set forth in detail the method by which Petitioner used the San Dimas mark to distinguish products sold under this mark from Petitioner's non-San Dimas products. Limit answer to products manufactured prior to October 2002.

**RESPONSE TO INTERROGATORY NO. 13:**

Petitioner objected to this request with sixteen (16) general objections plus objections that this request is vague and ambiguous.

**ARGUMENT:**

This interrogatory asks Petitioner to describe in detail the differences, if any, that exist between Petitioner's products that carry the San Dimas trademark and Petitioner's products that do not carry the San Dimas trademark. This request is neither vague nor ambiguous. If Petitioner claims that each and every electric guitar manufactured for sale by Petitioner carries the San Dimas trademark, then state as such. If Petitioner claims that only some of electric guitar manufactured by Petitioner carry the San Dimas trademark, Registrant propounds Petitioner to delineate in detail the method by which Petitioner used the San Dimas mark to distinguish Petitioner's San Dimas trademarked products from Petitioner's non San Dimas trademarked products. A thorough and complete answer to this interrogatory is warranted in that it seeks to produce evidence that Petitioner's use of the term "San Dimas" constitutes a trademark as defined by §45

(15 U.S.C. §1127) and if so, produce evidence that supports Petitioner's claims in its Petition for Cancellation.

**INTERROGATORY NO. 14:**

Set forth in individual year summaries, the year-end total dollar sales for all Jackson/Charvel guitars and basses for each year 1993 to present.

- A) For each year's total dollar sales, identify how many total dollars came through the sale of San Dimas trademarked product.

**RESPONSE TO INTERROGATORY NO. 14:**

Petitioner objected to this request with sixteen (16) general objects plus objections that this request is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible. Petitioner further objects that this Interrogatory seeks confidential information.

**ARGUMENT:**

Interrogatory No. 14 seeks to discover information that supports Petitioner's claim of the financial contribution that comes to Petitioner through the use of Petitioner's San Dimas mark. It also seeks to discover the strength of Petitioner's San Dimas mark to identify and distinguish its goods from other goods and as a source identifier. It also seeks to discover if and/or how Petitioner will be damaged by Registrant's use of the San Dimas trademark. This request is neither overly broad nor irrelevant in that a thorough and complete response is likely to result in admissible evidence in support of the pleading of this proceeding.

With respect to Petitioner's objection to the release of confidential information, see General Argument No. 2.

**INTERROGATORY NO. 15:**

Set forth in individual year summaries, the year-end total number of Jackson/Charvel guitars and basses sold for each year 1993 to present.

- A) For each year's total number identify how many total dollars came through the sale of San Dimas trademarked product.

**RESPONSE TO INTERROGATORY NO. 15:**

Same response as Interrogatory No. 14.

**ARGUMENT:**

See Argument regarding Interrogatory No. 14.

**INTERROGATORY NO. 16:**

Set for in specific detail the legal argument on which Petitioner claims ownership and rights to exclusive use of the San Dimas mark.

**RESPONSE TO INTERROGATORY 16:**

Petitioner states in its response that "Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory assumes facts not in evidence; Jackson/Charvel is seeking cancellation of Registration No. 2,772,766."

**ARGUMENT:**

In its pleadings, Petitioner (Jackson/Charvel) claims that 1) Jackson/Charvel purchased all trademarks from Akai Musical Instruments Corporation; 2) Jackson/Charvel has used the San Dimas trademark continuously since at least 1993; and that 3) Jackson Charvel has not authorized Petitioner to incorporate San Dimas into a trademark.

Interrogatory No. 16 seeks information regarding the facts and legal positions upon which Petitioner bases the claims and pleadings contained in each and every paragraph numbers 1 through 12 of its Petition for Cancellation. These facts and arguments are the central issues of this proceeding and Petitioner should welcome the opportunity to respond fully to this request. Interrogatory No. 16 is within the scope of FRCP Rule 26(b)(1) and therefore warrants a thorough and comprehensive reply.

**INTERROGATORY NO. 17:**

Specific to the Charvel products promoted in a 1995 catalog and again in a 1996 catalog, set forth in detail the facts and circumstances surrounding the introduction and cessation of these products. Include in the answer a description of the specimen trademark; describe how this trademark was used in association with the sale of these products; and state whether these products were replicas of an earlier era product and if not, how they differed.

- A) Identify any and all persons who originated this concept, those who were responsible for its introduction, and those who were responsible for its cessation.

**RESPONSE TO INTERROGATORY NO. 17:**

In addition to the sixteen (16) general objections, Petitioner specifically objects that Interrogatory 17 is overly broad, unduly burdensome, vague, ambiguous, and assumes facts not in evidence (e.g., “cessation”). Further, Petitioner objects that “whether these products were replicas of an earlier era product and if not, how they differed” is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence.

**ARGUMENT:**

Similar to Interrogatory No. 12, this interrogatory seeks to understand how Petitioner made use of the San Dimas trademark on specific products built in 1995 and 1996 so as to evaluate this use against the standards set forth in §45 (15 U.S.C. §1127). This request also seeks to understand the strength of Petitioner's San Dimas mark, the mark's effectiveness to identify and distinguish its goods from other goods, and the mark's ability to serve as a source identifier.

Petitioner has provided Registrant with photocopies of a 1995 and a 1996 Charvel Guitar catalog that Petitioner claims to establish Petitioner's use of the San Dimas trademark. Registrant's reference to these publications is not for the purpose of entering facts not yet in evidence, but rather to aid Petitioner in identifying the products and time period referenced in this interrogatory. Absent catalogs beyond the year 1996, the inference exists that Petitioner ceased the production of these products.

The discovery sought in Interrogatory No. 17 is clear and unambiguous and if answered thoroughly would resolve any disputes in the accuracy of the facts. For this reason, full disclosure to this interrogatory is warranted.

**INTERROGATORY NO. 18:**

Set forth in narrative form the facts and circumstances that led to Petitioner's first knowledge of Registrant's use of the San Dimas trademark.

**RESPONSE TO INTERROGATORY NO. 18:**

Petitioner objected to this request with sixteen (16) general objections.

**ARGUMENT:**

See Arguments regarding Interrogatory Nos. 5 and 6.

**INTERROGATORY NO. 19:**

Set forth in narrative form the facts and circumstances related to the Petitioner's use of the San Dimas trademark commencing with the twenty-fifth anniversary Charvel guitar.

- A) Include the dates and times for all meetings;
- B) Identify all persons who participated in these meetings;
- C) Identify any product prototypes built, where they were built and identify all persons involved in building them; and
- D) Identify the location of the manufacturing plant where any and all products are built.

**RESPONSE TO INTERROGATORY NO. 19:**

Petitioner objected to this request with sixteen (16) general objections plus objections that Interrogatory No. 19 is overly broad, unduly burdensome, and irrelevant. Petitioner also objects on the grounds that "the introduction of the 25<sup>th</sup> Anniversary SAN DIMAS brand guitar occurred after the filing date of Prins' use-based application."

**ARGUMENTS:**

With respect to Petitioner's objections that this request is overly broad and unduly burdensome, refer to Argument regarding Interrogatory No. 4.

With respect to Petitioner's objection that this request is irrelevant, Petitioner argues that in its Petition for Cancellation, Petitioner claims continuous use of the San Dimas trademark since 1993. Because Petitioner's introduction of the 25<sup>th</sup> Anniversary Charvel pre-dates Petitioner's cancellation filing by three months, and because Petitioner affixed the words "San Dimas" to this product, the facts and circumstances related to this

product launch are relevant to this proceeding. Accordingly, Interrogatory No. 19 seeks information regarding when and under what circumstances Petitioner introduced the 25<sup>th</sup> Anniversary Charvel guitar. Because this information is not available through public means, Registrant must rely on Petitioner to provide the facts and circumstances sought in this discovery request. This information is relevant, as it is likely to lead to admissible evidence in determining, among other things, good faith on the part of the Petitioner in its introduction of this product. For these reasons, Interrogatory No. 19 warrants a thorough and comprehensive reply.

**INTERROGATORY NO. 20:**

Is it Petitioner's response to each request for admission served with these interrogatories an unqualified admission? If not, for each response that is not an unqualified admission:

- A) State the number of the request
- B) State the facts on which Petitioner bases its response; and
- C) State the names, addresses and telephone numbers of all persons who have knowledge of those facts.

**RESPONSE TO INTERROGATORY NO. 20:**

Petitioner objected to this request with sixteen (16) general objections plus objections that Interrogatory No. 20 vague, ambiguous, and confusing.

**ARGUMENT:**

Interrogatory No. 20 is neither vague, unambiguous nor confusing in that it merely seeks to understand the facts upon which Petitioner relies in its answers to Registrant's requests for admissions. If Petitioner is able to deny an admission, Petitioner must be able to state the facts upon which each denial based. Registrant firmly believes

that facts derived from this interrogatory are material to the pleadings of this proceeding and will likely lead to admissible evidence. For this reason, a thorough and comprehensive reply is warranted.

Respectfully submitted,



\_\_\_\_\_  
Lloyd A. Prins

Registrant

San Dimas Guitar Company

December 7, 2004

## Certificate of Mailing and Notice of Service

### Certificate of Mailing (37 C.F.R. 1.10)

I certify that a copy of:

**MOTION TO COMPEL RESPONSES TO REGISTRANT'S FIRST SET OF INTERROGATORIES**

was mailed on December 7, 2004 via U.S. Postal Service, was deposited with sufficient postage and was addressed to:

Box TTAB No Fee  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

### Notice of Service

I also certify that a copy of:

**MOTION TO COMPEL RESPONSES TO REGISTRANT'S FIRST SET OF INTERROGATORIES**

was served upon:

Mr. Salvador K. Karottki  
Goldberg Kohn  
55 East Monroe Street  
Suite 3700  
Chicago, IL 60603-5802

on December 7, 2004 via U.S. Postal Service and was deposited with sufficient postage.

  
Lloyd A. Prins      12/7/04  
Date

# Exhibit

# A

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

In the Matter of	)	
Trademark Registration No. 2,772,766	)	
For the Mark SAN DIMAS GUITARS THE	)	
CALIFORNIA GUITAR COMPANY (Design)	)	
Registration Date: October 7, 2003	)	
	)	
JACKSON/CHARVEL MANUFACTURING,	)	Cancellation No. 92042614
INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	
PRINS, LLOYD A.,	)	
Registrant-Respondent.	)	

**PETITIONER'S ANSWERS TO RESPONDENT'S FIRST SET OF  
INTERROGATORIES**

Petitioner Jackson/Charvel Manufacturing, Inc. ("Jackson/Charvel"), by its undersigned attorneys and pursuant to Rule 33 of the Federal Rules of Civil Procedure and Trademark Rule 2.119(c), hereby answers Respondent Lloyd A. Prins' ("Prins") First Set of Interrogatories as follows:

**GENERAL RESPONSES AND OBJECTIONS**

A. Jackson/Charvel objects to Prins' Interrogatories, including any instructions and definitions (herein collectively referred to as the "Interrogatories"), to the extent that they impose upon it discovery obligations beyond the scope allowed under the Federal Rules of Civil Procedure and the Rules of Practice and Procedure before the Trademark Trial and Appeal Board.

B. Jackson/Charvel objects to Prins' Interrogatories to the extent that they require disclosure of information subject to the work product immunity, the attorney-client privilege, and/or any other applicable privilege or doctrine.

C. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek competitively sensitive information or information of a confidential nature, including but not limited to customer information. To the extent that confidential information is sought, Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

D. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek personal information, such as their home addresses, of current employees of Jackson/Charvel or personal information, such as social security numbers and dates of birth, of former employees of Jackson/Charvel or its predecessors-in-interest.

E. Jackson/Charvel objects to Prins' Interrogatories to the extent that they are overly broad and/or unduly burdensome.

F. Jackson/Charvel objects to Prins' Interrogatories to the extent that they are vague, ambiguous and/or otherwise incapable of reasonable ascertainment.

G. Jackson/Charvel objects to the term "Petitioner" or "Petitioner's" as used in Prins' Interrogatories as vague, ambiguous, and undefined. Any answer to Prins' Interrogatories provided by Jackson/Charvel specifically incorporates Jackson/Charvel's predecessors-in-interest, including Akai Musical Instruments Corporation ("Akai") and International Music Company ("IMC"), ("Predecessors-in-Interest") in the definitions of the terms "Petitioner" and "Petitioner's." It should be understood that Jackson/Charvel's answers to Prins' Interrogatories, wherein the terms "Petitioner" or "Petitioner's" were used, that employ the term "Jackson/Charvel" also include Jackson/Charvel's Predecessors-in-Interest.

H. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek information that is irrelevant and/or not reasonably calculated to lead to the discovery of admissible evidence.

I. Jackson/Charvel objects to Prins' Interrogatories to the extent that they seek information that can be obtained from other sources that are more convenient, less burdensome, and/or less expensive.

J. Jackson/Charvel objects to Prins' Interrogatories to the extent that they assume facts not in evidence.

K. Jackson/Charvel expressly reserves its right to supplement its answers.

L. Jackson/Charvel's answers to the Interrogatories are based on information available to Jackson/Charvel at the time, and Jackson/Charvel reserves the right to revise, correct, supplement, or clarify its objections and responses given subsequently identified information.

M. Jackson/Charvel objects to Prins' Interrogatories to the extent that they request that Jackson/Charvel describe, list, or characterize documents otherwise requested pursuant to Rule 34 of the Federal Rules of Civil Procedure. The documents speak for themselves. Requests for written descriptions of documents are unduly burdensome to Jackson/Charvel, and the burden of deriving or ascertaining the answer to such Interrogatories is substantially the same for Prins as Jackson/Charvel.

N. Jackson/Charvel objects to Prins' Interrogatories to the extent that they request the attachment of documents. Jackson/Charvel has contemporaneously responded to Document Requests served by Prins and objects to any additional requirement for identifying or attaching documents to these Interrogatories as unduly burdensome.

O. Pursuant to Rule 33 (d) of the Federal Rules of Civil Procedure, Jackson/Charvel specifically reserves the right to answer any Interrogatories by producing certain documents or business records when the answers to Interrogatories can be adduced by reviewing such documents or business records and the burden of deriving or ascertaining the

answers to Interrogatories from such documents or business records is substantially the same for Prins as for Jackson/Charvel.

P. Jackson/Charvel does not waive any of its objections by providing any of the following answers, but instead expressly answers subject to those objections.

### **INDIVIDUAL RESPONSES AND OBJECTIONS**

Subject to and without waiving the foregoing General Responses and Objections, Jackson/Charvel responds to the Interrogatories as follows:

1. Identify each and every person, company, or entity that may offer expert testimony in the above captioned proceeding and state after each person:
  - A. His/her qualifications and current curriculum;
  - B. The subject matter on which the expert may be called to testify;
  - C. The substance of the facts and opinions to which the expert may be called to testify;
  - D. A summary of the grounds for each opinion; and

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Without waiving its General Responses and Objections, Jackson/Charvel answers that it has not yet determined whether it will offer expert testimony in the above-captioned proceeding. Jackson/Charvel will seasonably update its Interrogatory answer pursuant to Rule 26(e) of the Federal Rules of Civil Procedure if and when it makes such a determination.

2. Identify each and every person who may offer factual testimony in the above captioned proceeding and state after each person the subject and/or subjects which he/she may be called to testify.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad. Without waiving its specific objections or its General Responses and Objections,

Jackson/Charvel answers that the following employees may offer testimony on the use of the SAN DIMAS trademark by Jackson/Charvel or its Predecessors-in-Interest, the association of Jackson/Charvel as the source of origin for goods marketed in conjunction or connection with the SAN DIMAS trademark, and the secondary meaning achieved by Jackson/Charvel's SAN DIMAS trademark among consumers and the industry:

Donnie Wade  
Tim Wilson  
Mike Shannon  
Manny Ledesma  
Greg Burnett  
Carlos Leone  
Alberto Robles  
Juan Antonio Gonzalez  
Juan Pablo Santana  
Felipe Muro Fonseca  
Edel Diaz  
John Walker  
Jeff Cary  
Richard McDonald  
Brian McDonald  
Andy Rossi  
Mark Van Vleet

The foregoing individuals are employed by Jackson/Charvel or Fender Musical Instruments Corporation and may be contacted through undersigned counsel.

Jackson/Charvel answers further that the following individuals or entities may offer testimony on the use of the SAN DIMAS trademark by Jackson/Charvel or its Predecessors-in-Interest, the association of Jackson/Charvel as the source of origin for goods marketed in conjunction or connection with the SAN DIMAS trademark, and the secondary meaning achieved by Jackson/Charvel's SAN DIMAS trademark among consumers and the industry:

Steve Blucher  
Steve Kaufman  
Bret Dennis  
Todd Taliaforo

Mike Johnson  
Tommy Moore

Any customers purchasing SAN DIMAS brand guitars from Jackson/Charvel or its Predecessors-in-Interest identified on customer lists or sales invoices

The foregoing individuals are not currently employed by Jackson/Charvel or Fender Musical Instruments Corporation. Investigation continues concerning the current addresses of these individuals.

3. Identify each and every person whom Petitioner claims to have knowledge of the facts and claims as set forth in its Petition to Cancel. For each person, the answer should include what knowledge it is Petitioner claims each person has.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 2.

4. Identify each and every document and tangible thing that Petitioner claims support the facts and claims set forth in its Petition to Cancel.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome.

5. Set forth in detail any efforts undertaken by Petitioner or any of its employees, or by any vendor, person, company or entity acting for the Petitioner, for the purpose of obtaining information concerning the Registrant's activities related to the San Dimas mark.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Jackson/Charvel further objects that the phrase "Registrant's activities related to the San Dimas mark" is vague, ambiguous, and

undefined. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel answers that its employees or agents reviewed Prins' website, as well as communications by and/or correspondence from Prins regarding his use of the SAN DIMAS mark. Jackson/Charvel's in-house counsel, Mark Van Vleet, also sent Prins correspondence concerning his infringing use of the SAN DIMAS mark without authorization from Jackson/Charvel.

6. Set forth in narrative form any investigations, internal or otherwise, conducted by Petitioner, where the Registrant was either directly or indirectly the focus of such investigation(s).
  - A) State what type of investigation was conducted including dates, times and places;
  - B) Identify any person who participated in such investigations and/or interviews and indicate whether the person was the interviewer, interviewee, observer or served any other role;
  - C) Identify all documents that were generated in the course of such investigation. Include hand-written notes, minutes, follow-up memos, and employee discipline reports; and
  - D) Summarize the findings of such investigation.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that the term "investigations" is vague and undefined. Jackson/Charvel further objects that this Interrogatory is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than Prins' unauthorized use of the SAN DIMAS trademark. In addition, Jackson/Charvel objects to this Interrogatory to the extent it seeks information covered by the attorney-client or attorney work product privileges. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 5. Jackson/Charvel further answers

that, in investigating Prins' unauthorized use of the SAN DIMAS trademark, its in-house counsel, Mark Van Vleet, sent letters to Prins. These letters are in Prins' possession.

7. Set forth in narrative form, any and all documentary evidence, photographs or testimony Petitioner intends to rely on that disputes the accuracy or facts of Registrants claim to the use of the San Dimas trademark.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome. Jackson/Charvel further objects to "setting forth in narrative form" "documentary evidence" or "photographs" as nonsensical and unduly burdensome. In addition, "the accuracy or facts of Registrants [sic] claim to the use of the San Dimas trademark" is undefined, and any such "claim" does not appear in any pleadings in this proceedings. Therefore, Jackson/Charvel is not required to offer testimony to "dispute" any such "claim." Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, Jackson/Charvel will offer testimony to support the allegations in its Petition for Cancellation, the allegations of which are clearly contain in such Petition. Answering further, see answer to Interrogatory No. 2.

8. Completely list and describe all documents and other tangible things (including but not limited to tapes, photographs, diaries, logs, schedules, data files, etc) that Petitioner intends to use in the preparation the above referenced proceeding.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome.

9. Set forth in narrative form the facts and circumstances relate to the Petitioner's purchase of the Jackson/Charvel Division from Akai Musical Instruments Corporation. Include the purchase price, the date of purchase, a complete list of all assets purchased, all trademarks purchased and the value of good will included in the purchase.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than the purchase of the SAN DIMAS trademark. Jackson/Charvel further objects that this Interrogatory requests confidential information. Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, Jackson/Charvel answers that on October 25, 2002, Jackson/Charvel purchased specific assets of the Jackson/Charvel Division of Akai, which included, among other things, rights to the SAN DIMAS trademark.

10. Set forth in detail all trademarks, registered or unregistered, for which the Petitioner claims ownership. For registered trademarks provide registration. For non-registered marks, provide a description of mark, date of first use, the geographic locations where product(s) is/was sold using the non-registered mark, and date of last use.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than Jackson/Charvel's SAN DIMAS trademark. Jackson/Charvel further objects that this Interrogatory assumes facts not in evidence, in that it assumes a "date of last use." Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, see answer to Interrogatory No. 12. Answering further, Jackson/Charvel states that it is selling

and has sold SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries. Jackson/Charvel continues to use the trademark SAN DIMAS.

11. Set forth in narrative form the facts and circumstances related to all trademark for which the Petitioner is not currently using but plans to use in the future. Identify all persons who have knowledge of such plans and Identify all documents and tangible things that support this answer.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections.

Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence.

12. Set forth in detail the facts and circumstances that resulted in Petitioner's first use of the San Dimas mark. Include in the answer:
  - A) The date of first use of the San Dimas trademark;
  - B) The physical address of each manufacturing plant where San Dimas trademarked products were produced;
  - C) A specimen of the San Dimas mark and how it was used in association with the sale of product;
  - D) A listing of all employees (present and past) who were involved in the design, manufacturing, marketing and selling;
  - E) Each product's serial numbers;
  - F) Each product's date of manufacturing;
  - G) Each product's work order or production control number;
  - H) The geographic location where San Dimas trademarked items were sold; and
  - I) Any and all persons credited with originating the San Dimas trademark concept.

ANSWER: Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad and unduly burdensome to the extent it requests "a listing of all employees (past and present) who were involved in the design, manufacturing, marketing and selling" of SAN DIMAS brand guitars. Jackson/Charvel further objects that this Interrogatory is overly broad and unduly burdensome to the extent it requests (i) "[e]ach product's serial numbers;" (ii) "[e]ach product's date of manufacturing;" and (iii) and "[e]ach product's work order or production control number." In addition, Jackson/Charvel objects to this Interrogatory to the extent it requests inclusion of "[a] specimen of the San Dimas mark." (Examples of the SAN DIMAS trademark are included in documents produced in response to Prins' Document Requests.) Furthermore, Jackson/Charvel objects that the phrase "credited with originating the San Dimas trademark concept" is vague, ambiguous, and undefined.

Without waiving Jackson/Charvel's specific objections or its General Responses and Objections, the first use of Jackson/Charvel's SAN DIMAS trademark was on or about June 22, 1993. Answering further, Jackson/Charvel states that the physical addresses where SAN DIMAS brand products were and/or are produced are: (i) 4452 E. Airpark Drive, Ontario, California, 91761 and (ii) 311 Cessna Cir., Corona, California, 92880. Current or former Jackson/Charvel employees involved in the production of SAN DIMAS brand products were and/or are: Tommy Moore, Tommy Moore II, Todd Taliafaro, Mike Johnson, Steve Kaufman, and Tim Wilson. (See also answer to Interrogatory No. 2.) Jackson/Charvel marketed, sold, and continues to market and sell SAN DIMAS brand guitars in interstate commerce throughout the United States and in foreign countries. Jackson/Charvel used and/or continues to use its SAN DIMAS mark, *inter alia*, in advertising for its products, in catalogs, on materials associated with

the products, and on point-of-sale displays for its products. In addition, both Jackson/Charvel sales staff and customers use the SAN DIMAS trademark as a source identifier for its products.

13. Set forth in detail the method by which Petitioner used the San Dimas mark to distinguish products sold under this mark from Petitioner's non-San Dimas products. Limit answer to products manufactured prior to October 2002.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory vague and ambiguous. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that it used the SAN DIMAS trademark in both word and logo form in connection with the marketing and sale of certain Jackson/Charvel products. For ways in which the SAN DIMAS trademark was used, see answer for Interrogatory No. 12. The use of the SAN DIMAS trademark in connection with certain products and not others itself could be said to distinguish the different Jackson/Charvel products. However, Jackson/Charvel's use of the SAN DIMAS trademark was as an indicator of source for Jackson/Charvel, therefore acting as a way for consumers to distinguish Jackson/Charvel products from those of *other companies*, not necessarily as a way to distinguish between different Jackson/Charvel products. Jackson/Charvel's and its customers' use of the SAN DIMAS trademark therefore facilitated inter-brand competition between Jackson/Charvel and other companies by allowing consumers to identify Jackson/Charvel products through association with the SAN DIMAS trademark.

14. Set forth in individual year summaries, the year-end total dollar sales for all Jackson/Charvel guitars and basses for each year 1993 to present.
  - A) For each year's total dollar sales, identify how many total dollars came through the sale of San Dimas trademarked product.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not

reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than SAN DIMAS brand products. Jackson/Charvel further objects that this Interrogatory seeks confidential information. Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

15. Set forth in individual year summaries, the year-end total number of Jackson/Charvel guitars and basses sold for each year 1993 to present.

A) For each year's total number identify how many total dollars came through the sale of San Dimas trademarked product.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, irrelevant, and not reasonably calculated to lead to the discovery of admissible evidence to the extent it concerns anything other than SAN DIMAS brand products. Jackson/Charvel further objects that this Interrogatory seeks confidential information. Jackson/Charvel may, subject to its other objections, provide such information but only upon entry of and pursuant to an appropriate Confidentiality Agreement and Protective Order.

16. Set for in specific detail the legal argument on which Petitioner claims ownership and rights to exclusive use of the San Dimas mark.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory assumes facts not in evidence; Jackson/Charvel is seeking cancellation of Registration No. 2,772,766. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that its legal theory concerning why Registration No. 2,722,766 should be cancelled is described in its Petition for Cancellation. Under Section 2(d) of the Lanham Act, a mark should not be

registered if it "consists of or comprises a mark which so resembles a . . . mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . ." Jackson/Charvel's prior and continuous use of the SAN DIMAS mark, therefore, compels cancellation of Prins' Registration No. 2,722,766.

17. Specific to the Charvel products promoted in a 1995 catalog and again in a 1996 catalog, set forth in detail the facts and circumstances surrounding the introduction and cessation of these products. Include in the answer a description of the specimen trademark; describe how this trademark was used in association with the sale of these products; and state whether these products were replicas of an earlier era product and if not, how they differed.

A) Identify any and all persons who originated this concept, those who were responsible for its introduction, and those who were responsible for its cessation.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome, vague, ambiguous, and assumes facts not in evidence (e.g., "cessation"). Jackson/Charvel further objects to the term "specimen trademark" and the phrase "products promoted in a 1995 catalog and again in a 1996 catalog" as vague, ambiguous, and undefined. In addition, Jackson/Charvel objects that the term "this concept" is vague, ambiguous, and undefined. Furthermore, Jackson/Charvel objects that "whether these products were replicas of an earlier era product and if not, how they differed" is irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel states that products in connection with its SAN DIMAS trademark were first conceived and produced in 1993; displayed and sold at, *inter alia*, the NAMM tradeshow in 1994; and advertised in catalogs and sold in 1995 and 1996. After 1996,

Jackson/Charvel continued to sell SAN DIMAS brand products through 2002. In 2003, Jackson/Charvel displayed and sold at the NAMM tradeshow the 25th Anniversary SAN DIMAS brand guitar. See answers to Interrogatory Nos. 12 and 13 concerning use of the SAN DIMAS trademark and answer to Interrogatory No. 12 concerning individuals involved in the introduction of the SAN DIMAS mark. Because Jackson/Charvel has continuously used the SAN DIMAS mark since 1993, there are no individuals involved in the marks "cessation."

18. Set forth in narrative form the facts and circumstances that led to Petitioner's first knowledge of Registrant's use of the San Dimas trademark.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Without waiving its General Responses and Objections, Jackson/Charvel discovered Prins' trademark application (Serial No. 78190509) when a Jackson/Charvel employee reviewed the U.S. Patent and Trademark Office website. Upon learning of Prins' application, Jackson/Charvel sent a cease and desist letter to Prins. This letter is in Prins' possession.

19. Set forth in narrative form the facts and circumstances related to the Petitioner's use of the San Dimas trademark commencing with the twenty-fifth anniversary Charvel guitar.
  - A) Include the dates and times for all meetings;
  - B) Identify all persons who participated in these meetings;
  - C) Identify any product prototypes built, where they were built and identify all persons involved in building them; and
  - D) Identify the location of the manufacturing plant where any and all products are built.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is overly broad, unduly burdensome,

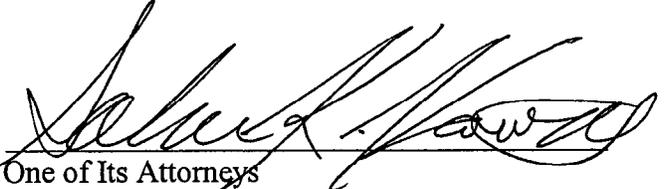
and irrelevant, as the introduction of the 25th Anniversary SAN DIMAS brand guitar occurred after the filing date of Prins' use-based application.

20. Is it Petitioner's response to each request for admission served with these interrogatories an unqualified admission? If not, for each response that is not an unqualified admission:
- A) State the number of the request;
  - B) State the facts on which Petitioner bases its response; and
  - C) State the names, addresses and telephone numbers of all persons who have knowledge of those facts.

**ANSWER:** Jackson/Charvel incorporates by reference its General Responses and Objections. Jackson/Charvel specifically objects that this Interrogatory is vague, ambiguous, and confusing. Without waiving its specific objections or its General Responses and Objections, Jackson/Charvel's Interrogatory answers are answers pursuant to Rule 33 of the Federal Rules of Civil Procedure; they are not unqualified admissions.

DATED: October 28, 2004

**JACKSON/CHARVEL MANUFACTURING, INC.**

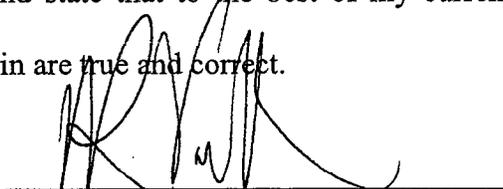
By:   
One of Its Attorneys

Oscar L. Alcantara  
Salvador K. Karottki  
GOLDBERG, KOHN, BELL, BLACK,  
ROSENBLUM & MORITZ, LTD.  
55 East Monroe Street, Suite 3700  
Chicago, Illinois 60603  
(312) 201-4000  
Attorneys for Jackson/Charvel Manufacturing, Inc.

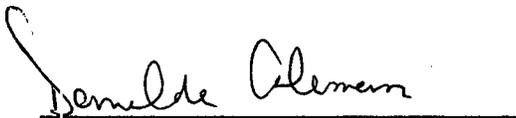
**VERIFICATION OF INTERROGATORY ANSWERS**

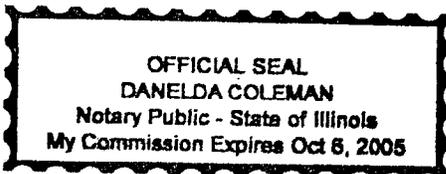
I, Mark Van Vleet, Vice President and General Counsel for Fender Musical Instruments Corporation, hereby declare that I have read the foregoing Petitioner's Answers to Respondent's First Set of Interrogatories, and state that to the best of my current knowledge, information, and belief, the facts stated therein are true and correct.

DATED: October 28, 2004

  
\_\_\_\_\_  
Mark Van Vleet

SWORN TO BEFORE ME this  
21<sup>st</sup> day of October, 2004

  
\_\_\_\_\_  
NOTARY PUBLIC



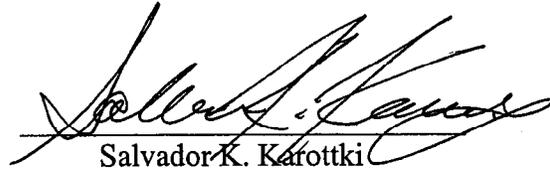
**CERTIFICATE OF SERVICE**

I, Salvador K. Karottki, an attorney, hereby certify that I caused **Petitioner's**

**Answers to Respondent's First Set of Interrogatories** to be served upon:

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, California 91208

by causing a copy of same to be sent via Federal Express (overnight courier) on October 28,  
2004.

  
Salvador K. Karottki

# Exhibit B

Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, CA 91208

November 13, 2004

Mr. Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

Re: Petitioner's Answers to Registrant's Request for Discovery  
Cancellation No. 92042614

Dear Mr. Karottki,

This letter is in response to the discovery responses served by your client Jackson/Charvel Manufacturing, Inc., on November 28, 2004. I find these responses incomplete and request that complete responses be served on or before Friday, November 19, 2004. Should I fail to receive complete responses at that time, I shall file a motion to compel discovery. This letter will serve to satisfy the requirements that the parties "meet and confer" about discovery disputes before filing a motion to compel discovery to the United States trademark Trial and Appeal Board ("TTAB").

In response to your general objections, let me first stress that no information subject to the attorney-client privilege is sought.

Regarding your general objection that my interrogatories and discovery requests seek competitively sensitive information or information of a confidential nature, I am willing to enter into a standard TTAB protective order for the protection of your confidential information. In this regard, please find enclosed a protective order for your client's signature. I look forward to receiving confirmation that this document has been filed with the TTAB.

Regarding your general objection that my use of the term "Petitioner" or "Petitioner's" is vague, ambiguous, and undefined in that it does not include predecessors-in-interest, I disagree with your attempt to modify your Petition for Cancellation by naming Akai and IMC as Joint Petitioners. I recognize that previous owners of Jackson/Charvel may be predecessors-in-interest, however assignment of that term to Akai, IMC or any other entity relies on facts not in evidence. Additionally, a person, company or entity whose status is "predecessor-in-interest" does not in of itself qualify this person, company or entity as a Joint Petitioner.

I also stress that I have made no discovery requests that are contrary to any provision of the Federal Rules of Civil Procedure. All requests are for information within the scope of permissible discovery, and no single request is unreasonably duplicative of other discovery sought. Annoyance or oppression, if any, caused by these discovery requests will not be unwarranted nor will the burden and expense be undue given the importance of the information sought. These requests are “reasonably calculated to lead to the discovery of admissible information” and are relevant to the claims and defenses in this dispute, as outlined below. See *Fed. R. Civ. Proc. 26(b)(1)*.

The discovery requests that I have made are sufficiently described so as to be deemed “reasonable”. Requests are not barred for being overly broad when the circumstances dictate that the requests be framed broadly. See *Data-Link Sys., Inc. v. Data Line Serv. Co.*, 148 F.R.D. 225, 228 (N.D. Ill. 1992). The lack of public available information regarding the claims made in Jackson/Charvel’s Petition for Cancellation necessitates that discovery be broad so that the dispute may be speedily resolved. Therefore, any burden imposed by these requests is outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence, and that requests are not unduly burdensome in light of the needs of the case and the amount in controversy.

Referring to the instructions and definitions that I made a part of Registrant’s First Interrogatories to Petitioner, specific and detailed requests were made upon Petitioner to attach as exhibits “all documents which have been prepared in connection with this proceeding or upon which Petitioner may rely or expect testimony to rely or such other documents as may be requested” and “For each answer to an Interrogatory, identify each and every document and tangible thing used in the preparation of that answer”. In response to the twenty (20) interrogatories, Petitioner completely ignored this request and provided no documents in support of its replies. My request for documents and tangible things is supported by, and within the scope of the rules that govern this proceeding (see, *Fed. R. Civ. Proc. 26(a)(1)(B)(C)* and *26(b)(1), (3) and (5)*; C.F.R. 37 §2.120; and TTAB §402.01). Accordingly, Petitioner’s full and strict compliance with these instructions and requests is warranted.

The legal bases for each discovery request follow. This is not an exhaustive list, but should serve to inform you of legitimacy of my discovery efforts.

#### Your Response to Interrogatory No.1

This interrogatory seeks to discover information regarding individuals who Petitioner may call upon to offer expert testimony in support of their pleadings. See *Fed. R. Civ. Proc. 26(a)(2)*. The fact that Petitioner’s may elect not to call upon such expert testimony does not prevent Petitioner from disclosing the identity of individuals, companies or entities that may offer expert testimony. Registrant believes that this disclosure is likely to lead to admissible evidence and therefore warrants a thorough response.

#### Your Response to Interrogatory Nos. 2, 3, 11

These interrogatories seek to discover information regarding individuals who Petitioner may call upon to offer factual testimony in support of their pleadings. The response offered by Petitioner falls short in that the instructions that accompanied these interrogatories requested detailed information that was omitted in Petitioner's response. For example, Petitioner has provided no mention of job title, contact information, or where appropriate, last known whereabouts. The information sought in these interrogatories is within the scope and provision of the Federal Rules of Civil Procedure (see *Fed. R. Civ. Proc. 26(a)(1) and (3)*) and warrant thorough and comprehensive answers.

#### Your Response to Interrogatory Nos. 4,8

These interrogatories seek to discover documents and tangible things that Petitioner claims support the facts in its pleadings. Referencing the opening paragraph numbers 5 and 6, these requests, although potentially lengthy in their reply, are within the scope and provisions of discovery (see *Fed. R. Civ. Proc. 26(b)(1)*) and any burden imposed by these requests are outweighed by the likelihood that the information sought will lead to the discovery of admissible evidence.

#### Your Response to Interrogatory Nos. 5, 6, 18

These interrogatories seek detailed information regarding Petitioner's conduct to obtain information related to Registrant's activities associated with Registrant's San Dimas mark.

These discovery requests do not seek to obtain information that is protected by attorney-client or attorney work product privileges. Registrant respects these doctrines and explicitly excludes such information in its requests.

Regarding Petitioner's specific objection that the term "investigation" is vague, and undefined, Petitioner merely needs to reference a commonly used dictionary for guidance. For such an objection to stand, one could conclude that every word used in a discovery request be either specifically defined or captured under a general definition statement. Additionally, Petitioner's objection is counter-productive to the discovery process and sets up an endless cycle of objections and counter-objections while word meanings are debated.

Interrogatory No. 6 seeks to discover information specific to the Petitioner's activities to track, study, search, collect, or interview for (collectively and commonly referred to as "investigate") information where the Registrant was the focus of such activities. This interrogatory is neither vague in its request, nor is it outside the scope and provisions of the Federal Rules of Civil Procedures.

Lastly, Interrogatories Nos. 5, 6 and 18 seek information regarding when and under what circumstances Petitioner first became aware of Registrant's mark. This information is relevant to both the likelihood of confusion between the Petitioner's alleged mark and Registrant's mark (as pleaded by Petitioner), as well as a determination of good faith on the part of the Petitioner in its Petition for Cancellation. As such, Interrogatories Nos. 5, 6 and 18 are proper and warrants complete and thorough responses.

#### Your Response to Interrogatory No. 9

This interrogatory seeks information pertaining to the facts, circumstances and specific terms of Petitioner's purchase of Jackson/Charvel from Akai. In its Petition for Cancellation, Petitioner alleges that it purchased all trademarks and intellectual property including the San Dimas trademark. This claim has not been supported by any testimony or documentary evidence. Furthermore, Interrogatory No. 9 seeks information that may indicate a potential dispute of ownership of Petitioner's alleged trademarks. If Petitioner does not own the trademarks claimed in the Petition for Cancellation, or acquired them improperly, this is certainly information crucial to the current dispute.

#### Your Response to Interrogatory No. 10

In response to Petitioner's objection that Interrogatory No. 10 assumes facts not in evidence in that "it assumes a 'date of last use'", Petitioner errors in interpreting this as applying only to marks no longer in use. Trademarks currently in use (i.e. those not terminated) could have a date of last use of "today".

Petitioner alleges in its Petition for Cancellation that it purchased various trademarks including the San Dimas trademark. A detailed listing of these trademarks and the circumstances surrounding the use and/or non-use of these trademarks is likely to lead to admissible evidence.

Interrogatory No. 10 also seeks information that characterizes the practices by which Petitioner obtains and maintains trademark protections and rights claimed in its Petition for Cancellation.

Given the reasons stated above, Registrant believes that a thorough and complete answer to Interrogatory No. 10 will likely lead to admissible evidence.

#### Your Response to Interrogatory No. 12

This interrogatory seeks information specific to the date of first use of Petitioner's San Dimas mark. This is relevant to establishing Petitioner's claim that Petitioner's alleged mark is senior to and has priority over Registrant's mark.

Interrogatory No. 12, parts A through I request that the Petitioner delineate the facts and circumstances that resulted in the launch of a newly trademarked product in June of 1993 (i.e. Petitioner's San Dimas mark).

Additionally, Registrant's requests for product serial numbers, dates of manufacturing and workorder numbers are relevant in that this information will likely lead to admissible evidence relative to the strength of Petitioner's mark. Registrant will accept disclosure of representative samples for each year 1993 through 2002 on the condition and stipulation that if requested, a full listing is made available to Registrant for inspection at a later date.

Lastly, Registrant's request that Petitioner identify the person or persons credited with originating Petitioner's San Dimas trademark concept (a concept that allegedly has resulted in the "sale of tens of hundreds of thousand of dollars worth" of product). This request is clear and unambiguous. It is relevant in that it seeks to identify an individual or individuals who may offer testimony key to these proceedings and will likely lead to admissible evidence.

Given the reasons stated above, a thorough and complete answer to this interrogatory is warranted.

#### Your Response to Interrogatory No. 13

This interrogatory asks Petitioner to describe in detail the differences, if any, that exist between Petitioner's products that carry the San Dimas trademark and Petitioner's products that do not carry the San Dimas trademark. This request is neither vague nor ambiguous. If Petitioner alleges that each and every electric guitar manufactured for sale by Petitioner carries the San Dimas trademark, then state as such. If Petitioner alleges that only some of electric guitar manufactured by Petitioner carry the San Dimas trademark, Registrant propounds Petitioner to delineate in detail the method by which Petitioner used the San Dimas mark to distinguish Petitioner's San Dimas trademarked products from Petitioner's non San Dimas trademarked products. A thorough and complete answer to this interrogatory is warranted in that it seeks to produce evidence that Petitioner's use of the term "San Dimas" constitutes a trademark (*See §45 (15 U.S.C. §1127)*) and if so, produce evidence that supports Petitioner's claims in its Petition for Cancellation.

#### Your Response to Interrogatories Nos. 14, 15

These interrogatories seek to discover information that supports Petitioner's claim of the financial contribution that comes to Petitioner through the use of Petitioner's San Dimas mark. They also seek to discover the strength of Petitioner's San Dimas mark to identify and distinguish its goods from other goods and as a source identifier. They also seek to discover if and/or how Petitioner will be damaged by Registrant's use of the San Dimas trademark. These requests are neither overly broad nor irrelevant in that thorough and complete responses are likely to result in admissible evidence. As stated in opening

paragraph 3, Registrant is willing to enter into a standard TTAB protective order for the protection of Petitioner's confidential information.

Your Response to Interrogatory No. 16

This interrogatory seeks information regarding the facts and legal arguments upon which Petitioner bases the allegations and pleadings contained in each and every paragraph numbers 1 through 12 of its Petition for Cancellation. These facts and arguments are the central issues of this proceeding and therefore warrant a thorough and comprehensive reply. General objections raised are address in opening paragraphs 2-6.

Your Response to Interrogatory No. 17

Similar to Interrogatory No. 12, this interrogatory seeks to understand how Petitioner made use of the San Dimas trademark on specific products built in 1995 and 1996 so as to evaluate this use against the standards set forth in 37 C.F.R. §45 (15 U.S.C. §1127). This request also seeks to understand the strength of Petitioners San Dimas mark, the mark's effectiveness to identify and distinguish its goods from other goods, and the mark's ability to serve as a source identifier.

Jackson/Charvel has provided Registrant with photocopies of a 1995 and a 1996 Charvel Guitar catalog that Petitioner claims to establish Petitioner's use of the San Dimas trademark. Registrant's reference to these publications is not for the purpose of entering facts not yet in evidence, but rather to aid Petitioner in identifying the products and time period referenced in this interrogatory. Absent catalogs beyond the year 1996, the inference exists that Petitioner ceased the production of these products.

The discovery sought in Interrogatory No. 17 is clear and unambiguous and if answered thoroughly would resolve any disputes in the accuracy of the facts. For this reason, full disclosure to this interrogatory is warranted.

Your Response to Interrogatory No. 19

In its Petition for Cancellation, Petitioner claims continuous use of the San Dimas trademark since 1993. Because Petitioner's introduction of the 25<sup>th</sup> Anniversary Charvel pre-dates Petitioner's cancellation filing by three months, and because Petitioner affixed the words "San Dimas" to this product, the facts and circumstances related to this product launch are relevant to this proceeding. Accordingly, Interrogatory No. 19 seeks information regarding when and under what circumstances Petitioner introduced the 25<sup>th</sup> Anniversary Charvel guitar. Because this information is not available through public means, Registrant must rely on Petitioner to provide the facts and circumstances sought in this discovery request. This information is relevant, as it is likely to lead to admissible evidence in determining, among other things, good faith on the part of the Petitioner in its introduction of this product. For these reasons, Interrogatory No. 19 warrants a thorough and comprehensive reply.

Your Response to Interrogatory No. 20

Interrogatory No. 20 is neither vague, unambiguous nor confusing in that it merely seeks to understand the facts upon which Petitioner relies in its answers to Registrant's requests for admissions. If Petitioner is able to deny an admission, Petitioner must be able to state facts on which such denial based. Registrant firmly believes that facts derived from this interrogatory will lead to admissible evidence and further believes that a thorough and comprehensive reply is warranted.

Your Response to Request for Production of Documents Nos. 1-18

Petitioner has objected to each and every request for the production of documents. In the few occurrences where documents were offered, Petitioner qualifies these occurrences with additional objections and restrictions. Petitioner's position with respect to its responds to the Registrant's request for production of documents is counter-productive to the discovery process. The basis for each and every document request made by Registrant is clear, unambiguous and within the scope of the rules that govern this proceeding. Registrant believes that Requests for Production of Documents numbers 1-18 will likely lead to admissible evidence and therefore warrants Petitioner's full and complete compliance with these requests.

Notwithstanding Petitioner's numerous objections, in the few occurrences where Petitioner has disclosed anything of substance, the information offered are overly generalized statements and fall short of the detailed information sought. Registrant emphasizes that what has been requested are merely the factual bases for Petitioner's own pleadings and allegations. As enumerated by the Petition for Cancellation, these are the central issues of this dispute. Thus it is inconsistent to claim, as Petitioner has, that the facts upon which these allegations are based are not relevant to the claims or defenses on file in this proceeding, nor admissible, nor reasonably calculated to lead to the discovery of admissible evidence. On the contrary, nothing could be more relevant to this dispute. Accordingly, these discovery requests are proper and responses to each are warranted.

Thank you for your time and attention.

Sincerely,



Lloyd A. Prins

**Certificate of Mailing (37 C.F.R. 1.10)**

**Notice of Service**

I, Lloyd A. Prins certify that an original copy of:

Registrant's November 13, 2004 Letter regarding "Petitioner's Answers to Registrant's Request for Discovery" was mailed to the Petitioner on November 13, 2004 via USPS Express Overnight, article

number EO 328224165 US. This item was deposited with sufficient postage on November 13, 2004 and addressed to:

Mr. Salvador K. Karottki  
Goldberg Kohn  
55 East Monroe Street  
Suite 3700  
Chicago, IL 60603-5802

  
Lloyd A. Prins      11/13/04  
Date

# Exhibit C

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

In the Matter of  
Trademark Registration No. 2,772,766  
For the Mark SAN DIMAS GUITARS THE  
CALIFORNIA GUITAR COMPANY  
Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,  
INC.,

Cancellation No. 92042614

Petitioner,

v.

PRINS, LLOYD A.,

Registrant

To: Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

**STIPULATION AND PROTECTIVE ORDER**

Each party and each Counsel of Record stipulate and move the TTAB (Board) for the following Protective Order pursuant to Rule 26(c) of the Federal Rules of Civil Procedure concerning the treatment of Confidential Information (as hereinafter defined), and, as grounds therefor, state as follows:

1. In this action, at least one of the Parties has sought and/or is seeking Confidential Information (as defined in paragraph 2 below). The Parties also anticipate seeking additional Confidential Information during discovery and that there will be questioning concerning Confidential Information in the course of depositions. The Parties assert the disclosure of certain of such information outside the scope of this proceeding could result in significant harm to the interests of both Parties. The Parties have entered into this Stipulation and request that the

Board enter the within Protective Order for the purpose of preventing the disclosure and use of certain Confidential Information, as set forth herein.

2. "Confidential Information" means any document, file, portions of files, transcribed testimony, or response to a discovery request, including any extract, abstract, chart, summary, note, or copy made therefrom ("Document") (a) not made available to the public; (b) not disclosed to a "Third Party Recipient," defined as an individual or entity other than (i) the custodian of the Document (including the custodian's employees, agents, and contractors) or (ii) the subject of any Document who has expressly directed in writing that the Document not be made public, except for disclosures exclusively made pursuant to paragraph 4 of this protective order or any disclosure that must be treated as confidential under statute, regulation, or case law; and (c) designated by one of the Parties in the manner provided in paragraph 3 below as containing (i) the personnel files of any of the Parties and/or any representative of any Party, (ii) any Document that must be treated as confidential by statute, regulation, or case law. This protective order shall no longer apply to any Document upon disclosure of such Document to a Third Party Recipient, except for disclosures exclusively made pursuant to paragraph 4 of this protective order or any disclosure that must be treated as confidential under statute, regulation, or case law.

3. Where Confidential Information is produced, provided, or otherwise disclosed by a Party in response to any discovery request, it will be designated in the following manner:

- a. By imprinting the word "Confidential -- Subject to Protective Order" on the first page or cover of any document produced, such that none of the text or other content of the Document is covered by such imprinting;

- b. By imprinting the word “Confidential -- Subject to Protective Order” next to or above any response to a discovery request, such that none of the text or other content of the discovery request is covered by such imprinting; and
- c. With respect to transcribed testimony, by giving written notice to opposing counsel designating such portions as “Confidential -- Subject to Protective Order” no later than ten calendar days after receipt of the transcribed testimony.

4. All Confidential Information may only be disclosed to the following persons, and only for the purpose of this proceeding:

- a. This Board, including Board personnel, and persons operating recording equipment at depositions in this proceeding;
- b. Counsel who have appeared of record for a party in this action and partners, associates, legal assistants, or other employees of such counsel assisting in the prosecution or defense of this action;
- c. Persons retained by the parties or their attorneys to assist in the prosecution or defense of this action (including consultants or expert witnesses, and third-party vendors, and their employees, retained by the parties or counsel who are involved in one or more aspects of copying, microfilming, reorganizing, filing, coding, converting, storing, or retrieving data);
- d. Witnesses or potential witnesses; and
- e. The Parties, which, for purposes of this Order, includes officers, directors, and employees.

5. Prior to a Party’s counsel disclosing Confidential Information to persons described in subparagraphs 4(c) or (d) above, the disclosing Party shall deliver a copy of this Order to

such person(s) and obtain the affidavit in the form attached as Exhibit A, signed and dated by such persons.

6. Individuals authorized to review Confidential Information pursuant to this Protective Order including, but not limited to, the Parties to this action and their undersigned counsel, shall hold Confidential Information in confidence and shall not divulge the Confidential Information, either orally or in writing, to any other person, entity or government agency unless authorized to do so by this Protective Order or other court order.

7. The Party's counsel who discloses Confidential Information shall take all steps reasonable and appropriate to assure compliance with the terms of this Protective Order with respect to persons to whom such Confidential Information is disclosed and shall obtain and retain the original affidavits signed by qualified recipients of Confidential Information, and shall maintain a list of all persons to whom any Confidential Information is disclosed.

8. During the pendency of this action, opposing counsel may, upon order of the Board or an agreement of the Parties, inspect the list maintained by counsel pursuant to paragraph 7 above upon showing of substantial need in order to establish the source of an unauthorized disclosure of Confidential Information and that opposing counsel are unable otherwise to identify the source of the disclosure. If counsel disagrees with opposing counsel's showing of substantial need, then counsel may seek an order requiring inspection under terms and conditions deemed appropriate by the Board.

9. No copies of Confidential Information shall be made except by or on behalf of counsel in this proceeding for work product purposes or for review by experts in this case. Any such copies shall be made and used solely for purposes of this proceeding.

10. During pendency of this proceeding, counsel shall retain custody of Confidential

Information, and copies made therefrom pursuant to paragraph 9 above.

11. A Party may object to the designation of particular Confidential Information by giving written notice to the party designating the disputed information. The written notice shall identify the information to which the objection is made. If the parties cannot resolve the objection within ten (10) business days after the time the notice is received, it shall be the obligation of the party designating the information as confidential to file an appropriate motion requesting that the Board determine whether the disputed information should be subject to the terms of this Protective Order. If such a motion is timely filed, the disputed information shall be treated as confidential under the terms of this Protective Order until the Board rules on the motion. If the designating party fails to file such a motion within the prescribed time, the disputed information shall lose its designation as confidential and shall not thereafter be treated as confidential in accordance with this Protective Order. The fact that information may technically come within the definition of Confidential Information set forth in paragraph 2 above shall not preclude the Board from determining that the information shall not be made subject to this Protective Order. In connection with a motion filed under this provision, the party designating the information as confidential shall bear the burden of proving by a preponderance of the evidence that disclosure of the subject information outside the scope of this Board would result in significant harm to that Party.

12. In the event it is necessary for the Parties to file Confidential Information with the Board in connection with any proceeding or motion, the Confidential Information shall be filed in a sealed envelop and clearly marked as confidential following rules set forth by the Board. (See *TBMP §412.02(d)(12)*). Any pleadings or briefs filed by the Parties that either quote or

discuss the contents of information designated as Confidential Information shall also be filed in sealed form.

13. The termination of this action shall not relieve counsel or other persons obligated hereunder from their responsibility to maintain the confidentiality of Confidential Information pursuant to this Protective Order, and the Board shall retain continuing jurisdiction to enforce the terms of this Protective Order.

14. By agreeing to the entry of this Protective Order, the Parties adopt no position as to the authenticity or admissibility of documents produced subject to it. Neither the taking of any action in accordance with the provisions of this Protective Order, nor the failure to object thereto, shall be construed as a waiver of any claim or defense in this action.

15. Upon termination of this proceeding, including any appeals, each Party's counsel shall immediately either return to the producing party or ensure the destruction of all Confidential Information provided subject to this Protective Order, including all copies thereof. If the Confidential Information is destroyed, the party's counsel shall provide the producing party with a certificate identifying the Confidential Information so destroyed, without disclosing its contents. At that time, counsel shall also file under seal with this Board the list of individuals who have received Confidential Information which counsel shall have maintained pursuant to paragraph 7 herein.

16. Nothing in this Protective Order shall preclude any Party from filing a motion seeking further or different protection from the Board under Rule 26(c) of the Federal Rules of Civil Procedure, or from filing a motion with respect to the manner in which Confidential Information shall be treated at trial.

DATED this \_\_\_\_\_ day of \_\_\_\_\_, 2004.

**BY THE BOARD:**

\_\_\_\_\_  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board

**STIPULATED AND AGREED TO:**

By \_\_\_\_\_  
Salvador K. Karottki  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603

*Attorney for Petitioner*

By  \_\_\_\_\_ 11/13/04  
Lloyd A. Prins  
San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, CA 91208

*Registrant*

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

JACKSON/CHARVEL	)	
MANUFACTURING,	)	
INC.,	)	
Petitioner,	)	
	)	Cancellation No. 92042614
v.	)	
	)	
PRINS, LLOYD A.,	)	
Registrant	)	

**AFFIDAVIT**

STATE OF \_\_\_\_\_ )  
 )  
 COUNTY OF \_\_\_\_\_ )

I, \_\_\_\_\_, being duly sworn states under penalty of Perjury:

1. I have read the Protective Order in \_\_\_\_\_, a copy of which is attached to this Affidavit.

2. I have been informed by \_\_\_\_\_, counsel for \_\_\_\_\_ that the materials described in the list attached to this Affidavit have been designated as "Confidential Information" as defined in the Protective Order.

3. I promise that I have not and will not divulge, or undertake to divulge to any person or recording device any Confidential Information shown or told to me except as authorized in the Protective Order, so long as such Confidential Information is subject to the Protective Order. I will not use the Confidential Information for any purpose other than this proceeding, so long as such Confidential Information is subject to the Protective Order.

4. For the purpose of enforcing the terms of the Protective Order, I hereby submit myself to the jurisdiction of the Board in the action referenced above.

5. I will abide by the terms of the Protective Order.

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Print or Type Name)

Address:

\_\_\_\_\_  
\_\_\_\_\_  
Telephone  
ne No.: (\_\_\_\_) \_\_\_\_\_

***SUBSCRIBED AND SWORN*** to before me this \_\_\_\_\_ day of \_\_\_\_\_, 2004 by \_\_\_\_\_.

WITNESS my hand and official seal.

\_\_\_\_\_  
Notary Public

My commission expires: \_\_\_\_\_

[SEAL]

Certificate of Mailing (37 C.F.R. 1.10)

Notice of Service

I, Lloyd A. Prins certify that an original copy of:

Registrant's November 13, 2004 proposed "STIPULATION AND PROTECTIVE ORDER" was mailed to the Petitioner on November 16, 2004 via USPS Express Overnight, article

number ED 327897390 US. This item was deposited with sufficient postage on November 16, 2004 and addressed to:

Mr. Salvador K. Karottki  
Goldberg Kohn  
55 East Monroe Street  
Suite 3700  
Chicago, IL 60603-5802

  
\_\_\_\_\_  
Lloyd A. Prins Date