

July 28, 2006

henry.gonzales@goldbergkohn.com  
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VIA FEDERAL EXPRESS

TTAB

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22313

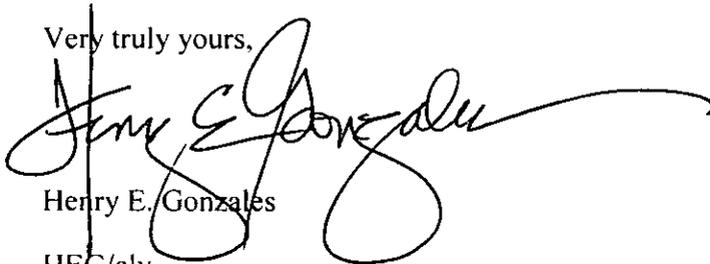
Re: **Jackson/Charvel Manufacturing, Inc. v. Prins, Lloyd A. —  
Cancellation No. 92042614**

Dear Sir or Madam:

Please find enclosed for filing Petitioner's and Registrant's Stipulation to Submit Testimony in form of Affidavit, Joint Stipulation to Extend Registrant's Testimony Period, and Stipulation Authenticity of Specified Documents. Please acknowledge receipt by stamping the enclosed index card and returning in the self-addressed stamped envelope.

Please contact me if you have any questions.

Very truly yours,



Henry E. Gonzales

HEG/clv  
Enclosures

cc: Lloyd A. Prins (w/encl.)  
Oscar L. Alcantara, Esq. (w/out encl.)

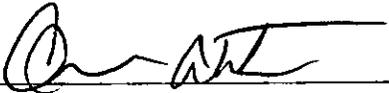
07-31-2006

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

*Oscar L. Alcantara* PURSUANT TO 37 C.F.R. §1.8

I, \_\_\_\_\_, hereby certify that this Stipulation To Rely on Specified Documents, pursuant to 37 C.F.R. §1.8, is being deposited with Federal Express as overnight delivery in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22313, on:

Date: 7-28-06

By: 

.....

**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.,

Petitioner,

Cancellation No. 92042614

v.

PRINS, LLOYD A.,

Registrant

To: Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**STIPULATION AUTHENTICITY OF SPECIFIED DOCUMENTS**

Pursuant to C.F.R. §1.123(b) and TBMP §705, in lieu of an oral testimony deposition, Petitioner and Registrant jointly agree and stipulate that attached documents are true and correct, authentic copies of the following original documents, and hereby stipulate to their admission into evidence in this

Cancellation:

1. Letter dated June 13, 2003 from Mark Van Vleet, General Counsel for Fender Musical Instruments Corporation, to San Dimas Guitar Company. (Attachment 1)

2. Letter dated July 21, 2003 from Lloyd A. Prins, San Dimas Guitar Company to Mark Van Vleet. (Attachment 2)
3. Letter dated July 24, 2003 from Mark Van Vleet to Lloyd Prins' July 21, 2003. (Attachment 3)
4. Letter dated September 2, 2003 from Lloyd Prins to Mark Van Vleet. (Attachment 4)  
Letter dated October 3, 2003 from Mark Van Vleet to Lloyd Prins. (Attachment 5)

Respectfully submitted,

Date: July 23, 2006

By:   
Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

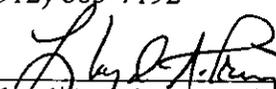
Date: July 11, 2006

By:   
Lloyd A. Prins  
San Dimas Guitar Company  
6138 S. 39<sup>th</sup> West Avenue  
Tulsa, OK 74132  
(909) 241-7997

**CERTIFICATE OF SERVICE**

I, Lloyd A. Prins, hereby certify that a true copy of the foregoing Stipulation Authenticity Of Specified Documents was served on July 11, 2006 by first class mail, postage prepaid, on attorney for Petitioner:

Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

  
Lloyd A. Prins - Registrant

# ATTACHMENT 1

Mark D. Van Vleet  
General Counsel  
Direct Line: 480-596-7127  
E-mail: [mvanvleet@fenderusa.com](mailto:mvanvleet@fenderusa.com)

June 13, 2003

**Certified Mail – Return Receipt Requested**

San Dimas Guitar Company  
2323 Via Saldivar  
Glendale, California 91208

To Whom It May Concern:

As you may know, Jackson/Charvel Manufacturing, Inc. ("JCMI"), manufactures, markets, distributes, and sells electric guitars, basses, parts, accessories, and other products in interstate and foreign commerce. JCMI owns a variety of registered and common law trademarks including, but not limited to, SAN DIMAS™. JCMI has extensively used and promoted its trademarks and, as a result, these trademarks have acquired valuable goodwill and have come to be recognized as identifying the quality products sold by JCMI and its authorized licensees.

I discovered that you submitted an application for trademark registration to the U.S. Patent and Trademark Office for the mark "SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY." Your application reveals that this mark is for "musical instruments, namely electric guitars and electric basses." The application further reveals that your alleged date of first use of this mark is October 24, 2002. Such date is ironic and suspicious in that it is the day after JCMI acquired specific assets of the Jackson/Charvel Division of Akai Musical Instrument Corporation, including, but not limited to all of its registered and common law trademarks.

The purpose of this letter is to advise you that your unauthorized use of JCMI's common law trademark, SAN DIMAS, for the designated goods, violates JCMI's legal rights. In fact, your actions constitute trademark infringement, trademark dilution, false advertising, unfair trade practices, commercial deception, and unfair competition, and they will inevitably damage JCMI's trademark and cause a likelihood of confusion among the trade and the purchasing public.

JCMI cannot and will not allow others to infringe upon its valuable trademarks. Quite frankly, JCMI could have initiated costly litigation against you for trademark infringement and other causes of action. However, we prefer to attempt to resolve such disputes amicably and without having you spend significant time and money defending a legal action. Therefore, you have two options: (1) you can immediately withdraw your application for the above-referenced trademark with the U.S.P.T.O. and immediately and permanently cease and desist from any and

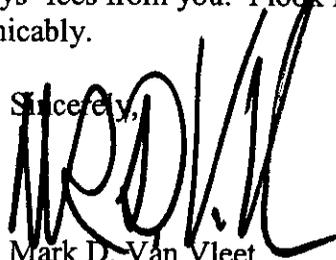
San Dimas Guitar Company  
June 13, 2003  
Page 2

all use of the SAN DIMAS mark on or relating to musical instruments, including, but not limited to, the production, advertisement, marketing, sale and distribution of any musical instruments containing this mark; or (2) you can choose to continue your unauthorized use of SAN DIMAS on or relating to musical instruments, which will result in forcing JCMI to promptly initiate legal action against you. In such an event, JCMI will further investigate the motivation and intent behind the timing of your alleged date of first use of the mark to determine if you have engaged in bad faith. In such an event, you would be exposed to significantly more damages.

This letter further advises you that in the event you use any other trademark, registered or common law, of JCMI or its affiliates, including, but not limited to, its trademarked guitar headstock designs, in violation of its legal rights, JCMI will initiate legal action against you.

Given the urgency of this matter, I ask that you contact me to resolve JCMI's concerns within seven (7) days from your receipt of this letter. In the unlikely event you do not respond by this deadline and agree to comply with our demands, JCMI will have no choice but to initiate legal action against you and it will seek, and undoubtedly obtain, a permanent injunction, damages, treble damages, interest, costs and attorneys' fees from you. I look forward to hearing from you and resolving this matter promptly and amicably.

Sincerely,



Mark D. Van Vleet  
General Counsel

Jackson/Charvel Manufacturing, Inc.

MVV:rao

## ATTACHMENT 2

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

Lloyd A. Prins

P.O. Box 701321  
Tulsa, OK 74170

July 21, 2003

Mr. Mark Van Vleet  
General Counsel  
Fender Musical Instruments  
8860 E. Chaparral Road  
Scottsdale, AZ 85250

Dear Mark,

It was a pleasure seeing and visiting with you at the Summer NAMM Show in Nashville this weekend. I continue to be impressed with the changes made by FMIC to the Jackson/Charvel line and look forward to another successful year representing these fine guitars.

The purpose of this letter is to reply to your June 13, 2003 letter in which you request that I immediately withdraw my application to the USPTO for the trademark "San Dimas Guitars The California Guitar Company". Through all of my research, I must tell you that I can find no evidence that supports your claim to the exclusive right to the use of the name San Dimas as it applies to guitars. If however such evidence does exist, I request that you provide it to me immediately so that it can be evaluated and acted upon. Without this information, I have no reason to depart from my current business plan.

Like you, I am hopeful that this matter will be resolved in an amicable fashion. As I am currently sharing time between Glendale, CA and Tulsa, OK, you may wish to duplicate future mailings to the two addresses shown above. By doing so, I can be more prompt in responding to matters that require a written reply.

Sincerely,



Lloyd A. Prins  
San Dimas Guitar Company

# ATTACHMENT 3

July 24, 2003

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

Mr. Lloyd A. Prins  
P.O. Box 701321  
Tulsa, Oklahoma 74170

Re: Your July 21, 2003 letter

Dear Lloyd:

It was nice seeing you at the NAMM show as well. I hope it was productive for you.

In response to your July 21, 2003 letter, I must admit I am surprised to see you are responding on behalf of "San Dimas Guitar Company" to my June 13, 2003 cease and desist letter. I am also perplexed by your statement, "[t]hrough all of my research, I must tell you that I can find no evidence that supports your claim to the exclusive right to the use of the name San Dimas as it applies to guitars." I am not quite sure what aspect of my June 13, 2003 letter you do not understand, but I will do my best to clarify Jackson/Charvel Manufacturing, Inc.'s legal rights.

As you presumably know, Fender Musical Instruments Corporation ("FMIC") created a subsidiary named Jackson/Charvel Manufacturing, Inc. ("JCMI") that purchased specific assets of the Jackson/Charvel Division of Akai Manufacturing Instrument Corporation ("AMIC") in October 2002. The specific assets JCMI purchased from AMIC included trademarks of and relating to various Jackson and Charvel products. As you know, the SAN DIMAS guitar is one of many Jackson/Charvel products. As a result, JCMI obtained the legal rights to the SAN DIMAS trademark in the October 2002 acquisition.

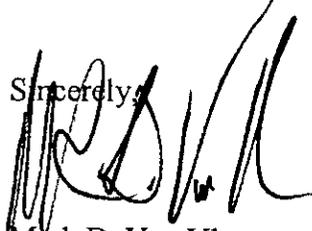
In the unlikely event you are asserting or implying that SAN DIMAS is not Jackson/Charvel product, the legal rights to which JCMI purchased from AMIC in October 2002, I have attached copies of marketing materials evidencing the use of this trademark on and relating to guitars. You also saw the 25th Anniversary SAN DIMAS guitar (by Charvel) at the NAMM show last week. Furthermore, there are a number of individuals who will gladly provide JCMI with sworn affidavits in support of JCMI's position that it is the owner of the SAN DIMAS trademark for musical instruments.

I trust this letter and the attached information answers your questions. We at JCMI and FMIC, like you, are hopeful this matter will be resolved amicably. However, please understand

Mr. Lloyd A. Prins  
July 24, 2003  
Page 2

that if you, or anyone else for that matter, use the SAN DIMAS trademark, or any other trademark owned by JCMI, without JCMI's advance, written consent, we will have no choice but to initiate legal action to protect the company's legal rights. Please let me know how you would like to proceed.

Sincerely,

A handwritten signature in black ink, appearing to read 'MDV', with a large, sweeping flourish extending upwards and to the right.

Mark D. Van Vleet  
General Counsel  
Jackson/Charvel Manufacturing, Inc.

MDVV:rao  
Enclosures

## ATTACHMENT 4

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

Lloyd A. Prins  
P.O. Box 701321  
Tulsa, OK 74170

September 2, 2003

Mr. Mark Van Vleet  
General Counsel  
Fender Musical Instruments  
8860 E. Chaparral Road  
Scottsdale, AZ 85250

Dear Mark,

I am responding to your July 21, 2003 letter in which you provided IMC's 1995 and 1996 Charvel Guitar Company catalog featuring San Dimas Series guitars. Helpful as this is, I am still unclear as to the basis of your claim that FMIC has an exclusive right to a common law trademark that was abandoned more than six years ago by a previous owner.

As you know better than I do, rights to a trademark are sustained through deliberate, continuous use or through creation and maintenance of clear evidence of intent to resume use. Although IMC (later AMIC) marketed products under the San Dimas name, these products and their San Dimas trademark were abandoned years ago after less than two years production and poor market reception.

On June 13, 2003, you asked me to stop using the San Dimas name in my new business. I have honored your request to date. I am holding my public use of "San Dimas Guitars" in abeyance pending receipt of more complete information from FMIC supporting your assertion that FMIC has an exclusive right to the San Dimas trademark. I am doing so, in large part, to preserve my good standing as FMIC's largest private Jackson Guitar Dealer. I must say, though, that I cannot hold indefinitely. Absent additional information, I must conclude, based on substantial research, that the San Dimas trademark had no legitimate claims when I filed with the USPTO.

Regarding FMIC's Twenty-fifth anniversary Charvel, I am surprised that FMIC is marketing this guitar under the San Dimas name. I respectfully ask that FMIC not do so, extending to my business and me the same good faith and courtesies I am extending to FMIC, until the controversy we are discussing is finally resolved.

Mark, I fully understand that you are FMIC's lawyer. However, I am confident that you and your client will agree that legal processes, while sometimes necessary, are generally not the best way to resolve business problems. I look forward to working with you to resolve these matters amicably based on dialogue and common understandings.

Sincerely,

A handwritten signature in black ink, appearing to read "Lloyd A. Prins". The signature is fluid and cursive, with the first name being the most prominent.

Lloyd A. Prins  
San Dimas Guitar Company

October 3, 2003

Certified Mail – Return Receipt Requested

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

Mr. Lloyd A. Prins  
P.O. Box 701321  
Tulsa, Oklahoma 74170

Dear Lloyd:

Thank you for your letter dated September 2, 2003, which responded to my letter dated July 24, 2003. I apologize for the delay in replying; I was out of the country for a couple weeks.

In your letter you state, "I am still unclear as to the basis of your claim that FMIC has an exclusive right to a common law trademark that was abandoned more than six years ago by a previous owner." Let me clarify our position so there is no misunderstanding. As I stated in my July 24, 2003 letter, in October 2002, FMIC's subsidiary Jackson/Charvel Manufacturing, Inc. ("JCMI") purchased all trademarks, common law and registered, relating to the JACKSON® and CHARVEL® brands from AMIC, and its predecessors. One of the aforementioned trademarks JCMI acquired is SAN DIMAS™. JCMI strongly disagrees with your contention that AMIC, and/or its predecessors, "abandoned" its legal rights to the SAN DIMAS™ trademark "more than six years ago." In fact, it is JCMI's firm contention, which is supported by the testimony of relevant witnesses and corroborated by applicable documentation, that JCMI and its legal predecessors have complied with the applicable legal requirements to obtain and maintain exclusive legal rights in and to the SAN DIMAS™ trademark for many years before your company's alleged date of first use, i.e., October 24, 2002. While you are certainly entitled to disagree, please understand that JCMI takes its intellectual property rights very seriously and it will take any and all appropriate actions to protect such legal rights.

You next state in your September 2<sup>nd</sup> letter that you are "holding [your] public use of 'San Dimas Guitars' in abeyance pending receipt of more complete information from FMIC. . . [but you] cannot hold indefinitely." Please be advised that for the reasons stated above, JCMI will have no choice but to take appropriate legal action against you, or anyone else, for infringing upon JCMI's legal rights in and to the SAN DIMAS™ trademark if you decide to use such trademark relating to musical instruments in the future.

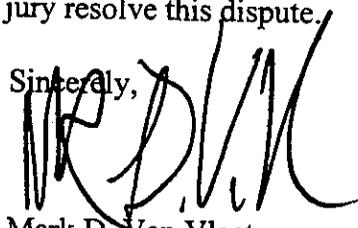
In your letter, you next request that FMIC discontinue its marketing of the SAN DIMAS™ guitar until this matter "is finally resolved." FMIC will not agree to that request.

Mr. Lloyd A. Prins  
October 3, 2003  
Page 2

JCMI is the rightful owner of the SAN DIMAS™ trademark in international class 15 and JCMI has authorized FMIC to market and sell products containing such trademark. As a result, there is no reason for either JCMI or FMIC to discontinue its use of this trademark.

I trust this resolves this matter once and for all. If you continue to disagree with JCMI's position, we will undoubtedly have to let a judge or jury resolve this dispute.

Sincerely,



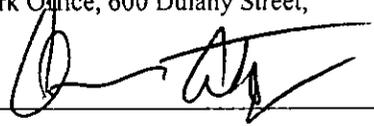
Mark D. Van Vleet  
General Counsel  
Jackson/Charvel Manufacturing, Inc.

MDVV:rao

PURSUANT TO 37 C.F.R. §1.8

I, Oscar L. Alcantara, hereby certify that this Joint Stipulation to Extend Registrant's Testimony Period, pursuant to 37 C.F.R. §1.8, is being deposited with Federal Express as overnight delivery in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22313, on:

Date: 7-28-06

By: 

.....

**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.,  
Petitioner,

Cancellation No. 92042614

v.

PRINS, LLOYD A.,  
Registrant

To: Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**JOINT STIPULATION TO EXTEND  
REGISTRANT'S TESTIMONY PERIOD**

On June 29, 2006, Registrant served Petitioner with REGISTRANT'S NOTICE OF DEPOSITION for the depositions of Mr. Donald Wade and Mr. Edel Diaz, both employees of Petitioner to be held on July 13 and 14, 2006 (the "Depositions"). On June 30, 2006 Petitioner, through its attorney Oscar Alcantara, requested that, because of scheduling conflicts, Registrant reschedule the Depositions for August 4, 2006, a date that falls outside Registrant's Testimony Period. Registrant agrees with this

request, and Petitioner has no objection to the scheduling of the depositions outside of Registrant's Testimony Period.

Pursuant to C.F.R. §2121(d), the parties stipulate and agree to schedule the Depositions on August 4, 2006, and seek no other alteration of the existing schedule in this Cancellation.

Respectfully submitted,

Date: Aug 23, 2006

By:   
Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

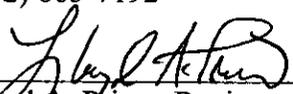
Date: July 11, 2006

By:   
Lloyd A. Prins  
San Dimas Guitar Company  
6138 S. 39<sup>th</sup> West Avenue  
Tulsa, OK 74132  
(909) 241-7997

**CERTIFICATE OF SERVICE**

I, Lloyd A. Prins, hereby certify that a true copy of the foregoing Joint Stipulation To Extend Registrant's Testimony Period was served on July 11, 2006 by first class mail, postage prepaid, on attorney for Petitioner:

Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

  
Lloyd A. Prins - Registrant

PURSUANT TO 37 C.F.R. §1.8

I, Oscar Alcantara hereby certify that this Stipulation to Submit Testimonies In Form Of Affidavit, pursuant to 37 C.F.R. §1.8, is being deposited with Federal Express as overnight delivery in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22313, on:

Date: 7-28-06

By: 

.....

**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  
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Registration Date: October 7, 2003

JACKSON/CHARVEL MANUFACTURING,  
INC.,  
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Cancellation No. 92042614

v.

PRINS, LLOYD A.,  
Registrant

To: Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**STIPULATION TO SUBMIT TESTIMONY  
IN FORM OF AFFIDAVIT**

Pursuant to C.F.R. §1.123(b), in lieu of oral testimony depositions, Petitioner and Registrant jointly agree and stipulate that Registrant may submit the Affidavit of Lloyd Prins dated July 11, 2006

(the "Prins Affidavit") as evidence in these proceedings in lieu of taking oral testimony. The Prins Affidavit is attached hereto as Exhibit A and is submitted herewith.

Respectfully submitted,

Date: July 23, 2006

By:   
Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

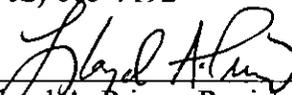
Date: July 11, 2006

By:   
Lloyd A. Prins  
San Dimas Guitar Company  
6138 S. 39<sup>th</sup> West Avenue  
Tulsa, OK 74132  
(909) 241-7997

**CERTIFICATE OF SERVICE**

I, Lloyd A. Prins, hereby certify that a true copy of the foregoing Stipulation To Submit Testimony In Form Of Affidavit was served on July 11, 2006 by first class mail, postage prepaid, on attorney for Petitioner:

Oscar Alcantara  
Goldberg, Kohn  
55 East Monroe Street, Suite 3700  
Chicago, IL 60603  
(312) 863-7192

  
Lloyd A. Prins - Registrant

**EXHIBIT A**

**AFFIDAVIT OF LLOYD PRINS**

**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-Respondent

**AFFIDAVIT OF LLOYD A. PRINS**

I, Lloyd A. Prins of 6138 S. 39<sup>th</sup> West Avenue, Tulsa, OK 74132 am the owner of the San Dimas Guitar Company, a privately held. I make this testimony on my own personal knowledge and submit the following:

1. On October 19, 2002 during a telephone conversation with a retail customer, I offered for sale my first San Dimas guitar for sale. The guitar was a double-cutaway model, metallic silver in color with the name "San Dimas" embossed across the front of the headstock.
2. After considering my offer, my customer contacted me on October 24, 2002, and agreed to purchase this first San Dimas guitar. The sale was recorded and documented on a retail sales invoice.
3. Upon receiving payment in full, on November 9, 2002 I personally packaged and shipped the first San Dimas guitar to my customer in North Dakota. Across the box's top flap and

front panel I applied an adhesive label that read "San Dimas Guitars The California  
Guitar Company

The undersigned, being warned that willful false statements and the like are punishable  
by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false  
statements and the like may jeopardize the validity of the document resulting therefrom,  
declares that all statements made of his/her knowledge are true; and all statements made  
on information and belief are believed to be true.

Date: July 11, 2006

By:   
Lloyd A. Prins  
San Dimas Guitar Company  
6138 S. 39<sup>th</sup> West Avenue  
Tulsa, OK 74132  
(909) 241-7997