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

| | |
|---|---|
| Proceeding | 92042614 |
| Party | Plaintiff<br>Jackson/Charvel Manufacturing, Inc.<br><br>, |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
**TRADEMARK TRIAL AND APPEAL BOARD**

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

**MEMORANDUM IN SUPPORT OF**
**CANCELLATION OF REGISTRANT'S MARK**

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## TABLE OF CONTENTS


**I. INTRODUCTION** ..... 1

**II. STATEMENT OF FACTS** ..... 2

**A. Petitioner's Prior Use of Mark** ..... 2

**B. Registrant and Its Infringing Mark** ..... 4

**III. ARGUMENT** ..... 4

**A. Jackson/Charvel Owns The Mark SAN DIMAS In Connection With Electric Guitars And Electric Guitar Parts** ..... 4

1. *Jackson/Charvel Began Using the SAN DIMAS Trademark At Least As Early As 1993.* ..... 4
2. *Jackson/Charvel has used the SAN DIMAS trademark continuously in commerce* ..... 6
3. *JCMI is currently using the SAN DIMAS mark* ..... 11
4. *Jackson/Charvel has not abandoned the SAN DIMAS mark* ..... 12

**B. Jackson/Charvel has Priority of Use of the SAN DIMAS mark** ..... 14

**C. The Distinctiveness of Petitioner's Mark** ..... 14

1. *JCMI Is Not Required to Prove Secondary Meaning* ..... 14
2. *JCMI Has Established Secondary Meaning* ..... 15

**D. Likelihood of Confusion** ..... 17

1. *The Parties' Marks are Similar* ..... 18
2. *The Parties' Marks are used on directly competitive goods* ..... 20
3. *Intent* ..... 20
4. *Strength of Plaintiff's Mark* ..... 21

**IV. CONCLUSION** ..... 22

## TABLE OF AUTHORITIES

### Cases

*Bishop v. Equinox Int'l Corp.*,
47 U.S.P.Q.2d 1949, 154 F.3d 1220, (10th Cir. 1998) ..... 12, 13

*Books on Tape, Inc. v. Booktape Corp.*,
5 U.S.P.Q.2d 1301, 836 F.2d 519 (Fed. Cir. 1987) ..... 14, 15

*Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,
50 U.S.P.Q.2d 1545, 174 F.3d 1036 (9th Cir. 1999) ..... 18

*Calgon Corp. v. John H. Breck, Inc.*,
160 U.S.P.Q. 343 (T.T.A.B. 1968) ..... 8, 9

*Carter-Wallace, Inc. v. Procter & Gamble Co.*,
167 U.S.P.Q. 713, 434 F.2d 794 (9th Cir. 1970) ..... 13

*Cumulus Media, Inc. v. Clear Channel Commc'ns, Inc.*,
64 U.S.P.Q.2d 1353, 304 F.3d 1167 (11th Cir. 2002) ..... 12, 13

*Cunningham v. Laser Gold Corp.*,
55 U.S.P.Q.2d 1842, 222 F.3d 943 (Fed. Cir. 2000) ..... 17

*Diebold, Inc. v. Multra-Guard, Inc.*,
189 U.S.P.Q. 119 (T.T.A.B. 1975) ..... 7, 8

*Doeblers' Pa. Hybrids, Inc. v. Doebler*,
78 U.S.P.Q.2d 1509, 442 F.3d 812 (3rd Cir. 2006) ..... 12

*Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*,
42 U.S.P.Q.2d 1184, 109 F.3d 1394 (9th Cir. 1997) ..... 18

*Echo Travel, Inc. v. Travel Associates, Inc.*,
10 U.S.P.Q.2d 1368 (7th Cir. 1989) ..... 15

*Electro Source, LLC v. Brandess-Kalt-Aetna Group*,
80 U.S.P.Q.2d 1161, 458 F.3d 931, (9th Cir. 2006) ..... 13

*Exxon Corp. v. Humble Exploration Co.*,
217 U.S.P.Q. 1200, 695 F.2d 96 (5th Cir. 1983) ..... 12

*Exxon Corp. v. Texas Motor Exchange of Houston, Inc.*,
208 U.S.P.Q. 384, 628 F.2d 500 (5th Cir. 1980) ..... 19

*Fossil, Inc. v. The Fossil Group*,
49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) ..... 20

*Hans Beauty, Inc. v. Alberto-Culver Co.*,
57 U.S.P.Q.2d 1557, 236 F.3d 1333 (Fed. Cir. 2001) ..... 17

*Hard Rock Café International (USA), Inc. v. Elsea*,
56 U.S.P.Q.2d 1504 (T.T.A.B. 2000) ..... 20

*In re Azteca Restaurant Enterprises, Inc.*,
50 U.S.P.Q.2d 1209 (T.T.A.B. 1999) ..... 17

*In re E. I. DuPont DeNemours & Co.*,
177 U.S.P.Q. 563, 476 F.2d 1357 (C.C.P.A. 1973) ..... 17

*In re Marriott Corp.*,
173 U.S.P.Q. 799, 459 F.2d 525 (C.C.P.A. 1972) ..... 5, 6

*Interstate Brands West Corp. v. McKee Foods Corp.*,
54 U.S.P.Q.2d 1910 (T.T.A.B. 2000) ..... 18

*Int'l. Telephone and Telegraph Corp. v. General Instrument Corp.*,
152 U.S.P.Q. 821 (T.T.A.B. 1967) ..... 8

*Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*,
175 U.S.P.Q. 417, 467 F.2d 501 (C.C.P.A. 1972) ..... 8

*Krim-Ko Corp. v. Coca-Cola Co.*,
156 U.S.P.Q. 523, 390 F.2d 728 (C.C.P.A. 1968) ..... 18

*La Societe Anonyme Des Parfums Le Galion v. Jean Patou, Inc.*,
181 U.S.P.Q. 545, 495 F.2d 1265 (2d Cir. 1974) ..... 6

*Lever Bros. Co. v. Nobio Products, Inc.*,
41 U.S.P.Q. 677, 103 F.2d 917 (C.C.P.A. 1939) ..... 8

*Malcolm Nicor & Co. v. Witco Corp.*,
11 U.S.P.Q.2d 1638, 881 F.2d 1063 (Fed. Cir. 1989) ..... 8

*Sears, Roebuck & Co. v. Mannington Mills, Inc.*,
138 U.S.P.Q. 261 (T.T.A.B. 1963) ..... 8

*Sengoku Works, Ltd. v. RMC Intern., Ltd.*,
40 U.S.P.Q.2d 1149, 96 F.3d 1217 (9th Cir. 1996) ..... 4, 5

*Shalom Children's Wear, Inc. v. In-Wear A/S*,
26 U.S.P.Q.2d 1516 (T.T.A.B. 1993) ..... 8

*Vision Sports, Inc. v. Melville Corp.*,
12 U.S.P.Q.2d 1740, 888 F.2d 609 (9th Cir. 1989) ..... 17

*Washington Speakers Bureau, Inc. v. Leading Authorities, Inc.*,
49 U.S.P.Q.2d 1893, 33 F.Supp.2d 488 (E.D.Va. 1999) ..... 18

*Wella Corp. v. California Concept Corp.*,
194 U.S.P.Q. 419, 558 F.2d 1019 (C.C.P.A. 1977) ..... 19

*Yamaha International Corp. v. Hoshino Gakki Co.*,
6 U.S.P.Q.2d 1001, 840 F.2d 1572 (Fed. Cir. 1988) ..... 15, 16

**Statutes**

15 U.S.C. § 1052(d) ..... 1, 4, 14

15 U.S.C. § 1127 ..... 12

**Treatises**

MCCARTHY § 15:30 ..... 16

MCCARTHY § 16:1 ..... 5

MCCARTHY § 17:12 ..... 13

MCCARTHY § 19:37 ..... 14

MCCARTHY § 23:25 ..... 19

*Restatement (Third) of Unfair Competition*, § 18, comment d (1995) ..... 5

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
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| JACKSON/CHARVEL MANUFACTURING, INC.,<br>Petitioner, | ) | Cancellation No. 92042614 |
| v. | ) | |
| PRINS, LLOYD A.,<br>Registrant-Respondent. | ) | |

**MEMORANDUM IN SUPPORT OF**
**CANCELLATION OF REGISTRANT'S MARK**

## I. INTRODUCTION

Petitioner Jackson/Charvel Manufacturing, Inc. submits this Memorandum in Support of its Petition to Cancel Registration No. 2,772,766, SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY, based upon Petitioner's prior use of the mark SAN DIMAS in connection with the sale of electric guitars, and related parts and accessories. Petitioner or its predecessors in interest began using its SAN DIMAS trademark in connection with the sale of electric guitars and parts and accessories in 1993, and has been using the mark continuously since that time. Now, Registrant Lloyd A. Prins – one of Petitioner's former retailers – has registered a nearly identical trademark on the Supplemental Register for use in connection with directly competitive goods. Registrant's Mark is likely to cause confusion among the relevant consumers and will cause harm to Petitioner and its trademark rights. The Petition should, therefore, be granted and the Registration cancelled pursuant to Section 2(d) of the Lanham Act. 15 U.S.C. § 1052(d).

## II. STATEMENT OF FACTS

### A. Petitioner's Prior Use of Mark

In June 1993, the Jackson/Charvel division of International Music Company, ("IMC"), a predecessor in interest of Jackson/Charvel Manufacturing, Inc. ("JCMI"), began using the mark SAN DIMAS in connection with the sale of electric guitars and related parts and accessories.[1] Deposition of Donald Wade dated May 5, 2006 ("Wade Dep. I"), 12:20. Jackson/Charvel's introduction of the SAN DIMAS branded guitar was one of the largest rollouts of a new brand that Jackson/Charvel had ever executed. Wade Dep. I, 15:6. Jackson/Charvel rolled out a series of five new guitars all under the trademark SAN DIMAS. Wade Dep. I, 12:20, Exh. P3; Exh. P4; Exh. P5; Exh. P6; and Exh. P7. Jackson/Charvel used the mark on product hang-tags and point of sale displays, Wade Dep. I, 27:11-19, and heavily promoted its new brand through catalogues, advertising, trade show exhibitions, retailer support clinics, banners, neon signs, and the use of complementary guitars by prominent artists. Wade Dep. I, 14:4-13, 21: 8-12.

Specifically, Jackson/Charvel placed advertisements in popular guitar enthusiast magazines promoting the SAN DIMAS line. Wade Dep. I, 16:3-21:5. SAN DIMAS brand electric guitars and parts were featured in Jackson/Charvel's catalogs, several thousand of which were printed and distributed. Wade Dep. I, 15:10-19, 21:21-24:14, 24:18-21. The SAN DIMAS mark was later included on the Jackson/Charvel website.

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[1] In approximately 1997, Akai Musical Instruments Corporation ("AMIC") purchased IMC and its Jackson/Charvel division. Wade Dep. I, 9:20-23. In October 2002, JCMI purchased assets of the Jackson/Charvel division of AMIC, including its electric guitar product lines and all associated trademarks. Wade Dep. I, 10:7; Exhibit P1; Deposition of Mark D. Van Vleet dated May 4, 2006 ("Van Vleet Dep."), 8:10-9:16, Exhibit P2. Accordingly, JCMI is the successor in interest to AMIC's Jackson/Charvel division and owns all of the intellectual property rights associated with Jackson/Charvel's guitar products. Indeed, obtaining these intellectual property rights was a "critical" factor in JCMI's decision to enter into the Purchase Agreement with AMIC. Van Vleet Dep., 9:4-12. JCMI and all of its predecessors in interest are referred to herein as "Jackson/Charvel" for ease of reference. Referenced sections of the Wade Dep. I, along with Exhibits thereto, are attached as group Exhibit A. Referenced sections of the Van Vleet Dep., along with Exhibits thereto, are attached as group Exhibit B.

Wade Dep. I, 33:20-34:10. Jackson/Charvel produced "cut sheets" featuring the SAN DIMAS models for distribution to its sales staff and customers, Wade Dep. I, 25:1-25; 26:14-27:4, as well as custom shop price lists for its higher end and exclusive guitar productions. Wade Dep. I, 36:1-38:4.

Petitioner and its predecessors in interest sold SAN DIMAS guitars and guitar parts in every year from Jackson/Charvel's launch of the mark in 1993 to present. Wade Dep. I, 30:4-33:10; 54:22-57:2; 57:10-58:7; 58:19-23. During the 1990's, Jackson/Charvel's sales of SAN DIMAS guitars were approximately $750,000. Wade Dep. I 30:4-14. Jackson/Charvel's customers would request SAN DIMAS guitar and guitar parts by name when ordering product from Jackson/Charvel's custom shop. Wade Dep. I, 34:18-35:1; 41:16-42:15. Noteworthy guitarists, such as Mitch Watkins, the guitarist for the performer Lyle Lovett, and Phil Collen of the rock band Def Leppard, specifically requested SAN DIMAS guitars and parts in dealings with the custom shop. Wade Dep. I, 44:2-23.

In order to build upon the success of the SAN DIMAS mark, in late 2002, Jackson/Charvel planned and designed a special 25th Anniversary Edition of the SAN DIMAS guitar. Wade Dep. I, 44:24-45:4. In response to dealers and consumers, the 25th Anniversary Edition SAN DIMAS was created and launched in 2003. Wade Dep. I, 45:21-25. Jackson/Charvel has sold hundreds of thousands of dollars of SAN DIMAS guitars—more than $250,000—since July of 2003, and the SAN DIMAS guitars remain one of Jackson/Charvel's most successful products. Deposition of John Walker ("Walker Dep.") 8:14-15, 8:19-9:3.[2]

[2] Referenced sections of the Walker Dep. along with exhibits thereto are attached as group Exhibit C.

### B. Registrant and Its Infringing Mark

Prior to JCMI's purchase of the SAN DIMAS guitar product lines and intellectual property from AMIC's Jackson/Charvel division in October 2002, Respondent, Lloyd Prins, attempted to purchase the Jackson/Charvel line from AMIC. Wade Dep. I, 46:24-47:16. At the time, Respondent was also a retailer carrying Jackson/Charvel product and received Jackson/Charvel's price lists and catalogs. Wade Dep. I, 46:15-17.

On October 24, 2002, Respondent purports to have began using the term SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY on a line of electric guitars, based upon the claims made in Respondent's Application and reflected in the Registration. On December 3, 2002, Respondent filed its application to register the term SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY and on June 19, 2003, Respondent's application was registered on the Supplemental Register.

## III. ARGUMENT

Marks on the Supplemental Register are subject to cancellation if a senior user of the mark establishes priority of use and a likelihood of confusion. 15 U.S.C. § 1052(d). In these proceedings, Petitioner has proven that it is the senior user of the mark SAN DIMAS in connection with electric guitars and that the likelihood of confusion resulting from Respondent's Mark entitles Jackson/Charvel to cancellation of Respondent's registration.

### A. Jackson/Charvel Owns The Mark SAN DIMAS In Connection With Electric Guitars And Electric Guitar Parts

#### 1. *Jackson/Charvel Began Using the SAN DIMAS Trademark At Least As Early As 1993.*

Actual use of a trademark in commerce creates rights and priority over other subsequent users. *Sengoku Works, Ltd. v. RMC Intern., Ltd.*, 40 U.S.P.Q.2d 1149, 96 F.3d 1217, 1219 (9th Cir. 1996) ("To acquire ownership of a trademark . . . the party claiming

ownership must have been the first to actually use the mark in the sale of goods or services."); MCCARTHY § 16:1. A broad range of potential actions constitute "use" of a mark, including, not only "traditional" uses of a mark on labels, hang-tags, containers or other packing, but also use in point of purchase displays. *See e.g. In re Marriott Corp.*, 173 U.S.P.Q. 799, 459 F.2d 525, 527 (C.C.P.A. 1972) (use of free–standing menu, similar to point-of-sale window and counter displays, is sufficient to constitute use); *Restatement (Third) of Unfair Competition*, § 18, comment d (1995) ("[U]se of a mark on point of sale displays, price lists, menus, or mail solicitations can also constitute use as a trademark, as can other advertising calculated to inform prospective purchasers of the association between the designation and the user or the user's goods or services.").

Jackson/Charvel obtained trademark rights in the SAN DIMAS brand name when it began using the mark in connection with the sale of its guitars in 1993. At that time, Jackson/Charvel introduced a series of five models of guitars all bearing the trademark SAN DIMAS. Wade Dep. I, 12:20, Exh. P3; Exh. P4; Exh. P5; Exh. P6; Exh. P7. Jackson/Charvel used the SAN DIMAS brand name on hang-tags and point-of-sale displays. Wade Dep. I, 27:11-19. Such point-of-sale displays constitute trademark use. *See, In re Marriott Corp.*, 173 U.S.P.Q. 799, 459 F.2d at 527. Specifically, Jackson/Charvel introduced a number of point-of-sale displays promoting SAN DIMAS guitars including laminated displays, banners, posters, neon signs, catalogs, and "cut sheets" (one page flyers detailing an individual SAN DIMAS model). Wade Dep. I, 27:11-19. Jackson/Charvel's laminated point-of-purchase displays were originally designed as magazine advertisements. Wade Dep. I, Exh. P11. However, after having initially run in print publications, these advertisements were modified into laminated point-of-purchase displays that were used by

retailers in direct association with the sale of Jackson/Charvel electric guitars. Wade Dep. I, 28:14-22. Customers at guitar shops could view the laminated displays near the retail counter (as a free-standing display) or in close proximity to a SAN DIMAS guitar hanging on the wall at a Jackson/Charvel dealer's music store. Wade Dep. I, 27:12-17, 28:14-22, 29:1-13. These point-of-sale displays featured color images of various SAN DIMAS guitars, and bore the SAN DIMAS brand name. Wade Dep. I, 27:11-17; Exh. P3; Exh. P4; Exh. P5. Jackson/Charvel's use of the SAN DIMAS brand name was clearly sufficient to support ownership of trademark rights. *In re Marriott Corp.,* 173 U.S.P.Q. 799, 459 F.2d at 527.

2. *Jackson/Charvel has used the SAN DIMAS trademark continuously in commerce*

To prove ownership of a trademark, the proponent must demonstrate that his use of the mark has been deliberate and continuous. *La Societe Anonyme Des Parfums Le Galion v. Jean Patou, Inc.,* 181 U.S.P.Q. 545, 495 F.2d 1265, 1272 (2d Cir. 1974). Jackson/Charvel's use of the SAN DIMAS trademark throughout the years meets this requirement of continuous use.

Petitioner and its predecessors in interest have been continuously selling and offering for sale SAN DIMAS guitars and guitar parts in connection with the SAN DIMAS mark from 1993 to the present. Wade Dep. I, 12:18-13:2. After Jackson/Charvel introduced SAN DIMAS guitars in 1993, Jackson/Charvel sold SAN DIMAS guitars in every year between 1993 and the present. Wade Dep. I, 30:15-32:16; 124:22-24. See also, Deposition of Donald Wade, August 4, 2006 ("Wade Dep. II")[3] 43:4-14 (evidencing the number of SAN DIMAS production models manufactured and sold in 1994); 44:20 - 45:11 (1995);

[3] Respondent represented to Petitioner on October 13, 2006 that he filed with the Board the Deposition of Donald Wade, August 4, 2006. However, it is our understanding that the Board has not received this transcript. Therefore, Petitioner attaches Wade Dep. II, along with Exhibit R1, as group Exhibit D.

45:20-46:15 and 49:1-4 (1996); 49:7-12 (1997); 49:13-20 (1998); 49:21--50:01 (1999); 50:2-4 (2000); 50:5-6 (2001); and 50:7-9 (2002).[4] Invoices evidencing sales of SAN DIMAS guitar and parts from Petitioner or its predecessors in interest to customers, i.e., retailers, show that Jackson/Charvel manufactured SAN DIMAS guitars and guitar parts throughout the 1990's and into the 2000's. Wade Dep. I, 12:8-13:6; 30:4-14; 30:15-33:10; 50:18-58:23; Exh. P16; Exh. P17; Exh. P18; Exh. P19; Exh. P20; Exh. P21. Jackson/Charvel has continued to offer SAN DIMAS guitars up to and after the 2003 introduction of the 25th Anniversary SAN DIMAS guitars. Thus, from 1993 through the present, not only have consumers been able to buy a SAN DIMAS guitar from Jackson/Charvel, but Jackson/Charvel has actually sold such SAN DIMAS guitars and guitar parts each year from 1993 through the present. Wade Dep. I, 12:24-13:6, 55:9-25, 56:5-57:2, 57:10-58:7, 58:19-23; Wade Dep. II, 43:4-14, 44:20-45:11, 45:20-46:15, 49:1-4, 49:7-12, 49:13-20, 49:21-50:01, 50:2-4, 50:5-6, 50:79; Exh. P16, Exh. P17, Exh. P18, Exh. P19, Exh. P20, Exh. P21.

Beyond "direct" uses of a mark on hang tags and point-of-sale displays, it is well established that the use of a mark in advertising or promotional materials—referred to as "use analogous to trademark use"—is also sufficient use to establish and maintain rights in a trademark. *Diebold, Inc. v. Multra-Guard, Inc.,* 189 U.S.P.Q. 119, 123-4 (T.T.A.B. 1975). As this court has previously held:

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[4] The documents referred to in the foregoing sequence of questions detail the number of production model San Dimas electric guitars manufactured in each model year. It is clear from the transcript that these figures are for the San Dimas factory production and do not account for San Dimas electric guitars or parts sold through the Jackson/Charvel Custom Shop. See, e.g., Wade Dep. II, 42:13-14 ("Q. Mr. Prins: What is [R1]? A. Witness: This appears to be part of our serial number logs that's *generated at the factory.*"); 43:4-7, 14 ("Q. Mr. Prins: Judging from [R1], how many San Dimas *production* – Jackson/Charvel San Dimas *production model guitars* were built in 1994?"); 44:20-23, 45:10-11 (referring to R1) ("Q. Mr. Prins: Can you arrive at the quantity of units produced in 1995 of the Jackson/Charvel San Dimas *production model guitar* . . . ?"); 50:15-17, 20-23 ("Q. Mr. Prins: Judging from [R1], every serial number in this document is a Jackson/Charvel San Dimas *production series guitar*? A. Witness: In this document, sir, it appears that every one of these models are a San Dimas model. To the best of my knowledge and based on this document, yes, sir, they all appear to be San Dimas modeled guitars.") (emphasis added). Mr. Wade also testified that each one of the electric guitars manufactured by Jackson/Charvel was in fact sold to a retailer for re-sale to the public. Wade Dep. I, 39:16-20; 49:15-20.

> It is well settled that prior use of a notation in a manner analogous to trademark use, i.e. use as the salient feature of a trade name in connection with the sale or advertising of goods, or use of a notation in advertising or other promotional activities connected with the publicizing and offering for sale of goods is sufficient to vest rights to a designation in the user or owner which are superior to any rights that a subsequent user may acquire in the same or a confusingly similar notation, notwithstanding that the later party's use has been as a trademark, providing that such use was of such nature and extent as to create an association by the purchasing public of the goods with the user.

*Int'l. Telephone and Telegraph Corp. v. General Instrument Corp.*, 152 U.S.P.Q. 821 (T.T.A.B. 1967). *See also*, *Malcolm Nicor & Co. v. Witco Corp.*, 11 U.S.P.Q.2d 1638, 881 F.2d 1063, 1065 (Fed. Cir. 1989) (use in advertising can be sufficient to create an association with the designation for purposes of cancelling another's registration); *Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*, 175 U.S.P.Q. 417, 467 F.2d 501, 508 (C.C.P.A. 1972) (petitioner "may rely on advertising and promotional use of a term or slogan and grade-or-model-mark use of a word to establish superior rights over a subsequent trademark user of the term, slogan, or word" (citations omitted)); *Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 U.S.P.Q.2d 1516, 1519 (T.T.A.B. 1993) ("[use analogous to trademark use] use has consistently been held sufficient use to establish priority of rights as against subsequent users of the same or similar marks."); *Diebold*, 189 U.S.P.Q. at 123-4 ("It is an established rule that rights can accrue from use 'analogous to trademark use.'"); *Sears, Roebuck & Co. v. Mannington Mills, Inc.*, 138 U.S.P.Q. 261, 262 (T.T.A.B. 1963) ("Sears' prior and continuous use of 'VINYLTHRIFT' in its catalogs and newspaper advertisements constitutes use at least analogous to trademark use serving to indicate origin thereof in Sears and creates rights therein sufficient to preclude the registration by a subsequent user of the same or a similar mark for like or closely related goods."); *Lever Bros. Co. v. Nobio Products, Inc.*, 41 U.S.P.Q. 677, 103 F.2d 917, 919 (C.C.P.A. 1939); *Calgon Corp. v. John H. Breck, Inc.*,

160 U.S.P.Q. 343, 344 (T.T.A.B. 1968) ("[I]t is well established that an advertising use, which is analogous to a trademark use, can create superior rights in a term over a subsequent trademark use of the same or a confusingly similar term.").

Jackson/Charvel's use of SAN DIMAS in advertising and promotional materials qualifies as "use analogous to trademark use" and thus further establishes Petitioner's continuous use of the mark. Jackson/Charvel used the term "SAN DIMAS" in connection with promotional advertising, on its website, in product catalogs available to Jackson/Charvel's customers, through trade show exhibitions, dealer support clinics, banners, neon signs, and the use of complementary guitars by prominent artists. Wade Dep. I, 14:4-13; 21:8-22:6; 33:23-34:10. After the initial rollout of SAN DIMAS guitars and guitar parts in 1993, Jackson/Charvel continued to promote the brand through price lists, catalogs, flyers, and print advertising published in "Guitar Player," "Guitar World," "Guitar For The Practicing Musician," spending approximately $40,000 to $50,000 for advertising, marketing support, and samples for product reviews and artists. Wade Dep. I, 14:7-14:20, 88:13-89:6. In the October 1994 issue of "Guitar World," Jackson/Charvel ran a full-page color advertisement promoting seven models of SAN DIMAS brand guitars. Wade Dep. I, Exh. P4. Jackson/Charvel placed identical ads in both the November 1994 issue and the January 1995 issue of "Guitar World." Wade Dep. I, Exh. P4; Exh. P5. Additionally, in 1995 Jackson/Charvel placed the same ad in the January and February issues of "Guitar" magazine. Wade Dep. I, Exh. P6; Exh. P7. "Guitar World" and "Guitar" are widely read, primary sources of information for guitar players. Wade Dep. I, 20:19-21. "Guitar World" is the largest selling magazine in the guitar industry. Wade Dep. I, 21:4-5.

In 1995 and 1996, Jackson/Charvel produced detailed, full-color catalogs advertising the available SAN DIMAS guitars, catalogs were given to dealers and were made available to consumers upon request. Ex P8; Exh. P9; Wade Dep. I, 21:23-22:6. Jackson/Charvel distributed approximately 8,000-10,000 of these catalogs each year. Wade Dep. I, 24:21. Jackson/Charvel also produced a variety of "cut sheets"—one page ads detailing individual SAN DIMAS models — thousands of which were made available to consumers and dealers between 1995 and 1997. Exh. P10; Wade Dep. I, 26:19-27:2. Retailers and customers could and did order guitars with SAN DIMAS guitar necks by using the order forms in the back of these catalogs. Wade Dep. I, Exh. P20.

Moreover, from 2000-2002, Jackson/Charvel promoted its SAN DIMAS guitars and guitar parts through its price lists and order forms. Wade Dep. I, 33:15-33:19. From 2000 to 2002, Jackson/Charvel promoted the sale of SAN DIMAS necks on the custom order form that was included with all Jackson/Charvel price lists. Wade Dep. I, 35:4-6; Exh. P12; Exh. P13; Exh. P14. Jackson/Charvel sent between 16,000 and 30,000 of these price lists to retailers and customers worldwide. Wade Dep. I, 35:8-17. In addition, during that time Jackson/Charvel began to advertise the availability of SAN DIMAS guitars and guitar parts over the World Wide Web. Wade Dep. I, 33:23-34:5. The website included photos of recently completed SAN DIMAS guitars as well as pictures of historical versions of SAN DIMAS guitars. Wade Dep. I, 33:2-5.

Jackson/Charvel has continuously used the SAN DIMAS trademark beginning in 1993 and continuing up through the present day, in connection with its electric guitars and parts, in advertising, in catalogs, on invoice sheets, in custom order forms and the receipt of numerous written and oral orders referencing SAN DIMAS guitars and guitar parts.

### 3. *JCMI is currently using the SAN DIMAS mark*

JCMI purchased assets (including all intellectual property) of the Jackson-Charvel guitar division from Akai Musical Instrument Corporation on October 25, 2002. Van Vleet Dep., Exh. P1 at 3. This purchase included an assignment by AMIC to JCMI of all the entire right, title, and interest in the common law rights, goodwill, or other rights to trademarks and trade names used by AMIC in its Jackson/Charvel guitar division. Van Vleet Dep., Exh. P2. JCMI thus owns common law trademark rights in the "SAN DIMAS" mark which has been in continuous use since 1993. Since 2003, it has specifically used the "SAN DIMAS" mark on its 25th Anniversary SAN DIMAS guitar model. Walker Dep. 7:14-15.

In late 2002, Donald Wade, who was then Marketing Manager for Jackson/Charvel, proposed marketing and selling a "25th Anniversary" SAN DIMAS guitar. Wade Dep. I, 45:5-22. The marketing strategy behind using the SAN DIMAS mark with the 25th Anniversary guitar was to capitalize on the end customers' and the retailers' expressed association of the SAN DIMAS mark with Charvel guitars. Walker Dep., 7:25-8:2. The guitar went into production and was offered for sale at an industry trade show in Nashville, Tennessee in July 2003. Wade Dep. I, 45:21-22; Walker Dep., 7:14-15. Jackson/Charvel sold hundreds of thousands of dollars of SAN DIMAS guitars—more than $250,000—in the first 18 months since the July 2003 trade show. Walker Dep., 8:14-15. During this time period, the SAN DIMAS line of guitars has been one of Jackson/Charvel's most successful products. Walker Dep., 8:19-9:3. Jackson/Charvel continues to sell the SAN DIMAS guitar and produce custom-model SAN DIMAS guitars up through the present day. Wade Dep. I, 12:18-13:11.

4. *Jackson/Charvel has not abandoned the SAN DIMAS mark*

Respondent has argued that Jackson/Charvel abandoned use of the SAN DIMAS trademark and, therefore, that Jackson/Charvel owned no rights in the mark at the time of Prins' registration. The facts clearly show that Jackson/Charvel never abandoned the SAN DIMAS mark, for it never discontinued use of the SAN DIMAS mark.

The party asserting abandonment is required to strictly prove its claim. *Doeblers' Pa. Hybrids, Inc. v. Doebler*, 78 U.S.P.Q.2d 1509, 442 F.3d 812, 822 (3rd Cir. 2006) ("A party arguing for abandonment has a high burden of proof: . . . 'abandonment', being in the nature of a forfeiture, must be strictly proved."); *Cumulus Media, Inc. v. Clear Channel Commc'ns, Inc.*, 64 U.S.P.Q.2d 1353, 304 F.3d 1167, 1175 (11th Cir. 2002) ("Because a finding of abandonment works an involuntary forfeiture of rights, federal courts uniformly agree that defendants asserting an abandonment defense face a 'stringent,' 'heave,' or 'strict burden of proof.'"). The asserting party must prove by clear and convincing evidence that the trademark has been abandoned. *Exxon Corp. v. Humble Exploration Co.*, 217 U.S.P.Q. 1200, 695 F.2d 96, 100 (5th Cir. 1983). "Use" of a mark is defined as "the bona fide use of such mark made in the ordinary course of trade . . . ." 15 U.S.C. § 1127. As demonstrated above, Jackson/Charvel has continually used the SAN DIMAS mark from its launch of the brand in 1993 to present. See pp. 6-11, *supra*.

Respondent will undoubtedly argue that Petitioner stopped using and abandoned the SAN DIMAS trademark because Petitioner's sales of SAN DIMAS guitars and parts decreased over time. However, low sales are not evidence of abandonment. *See, e.g., Bishop v. Equinox Int'l Corp.*, 47 U.S.P.Q.2d 1949, 154 F.3d 1220, 1222 (10th Cir. 1998) (mark holder did not abandon mark, even though sales were as low as 98 bottles from

1990 until 1996); *Cumulus Media*, 64 U.S.P.Q.2d 1353, 304 F.3d at 1175 (low level use of mark on business cards and an office sign constituted sufficient "use" to prevent finding of abandonment); MCCARTHY § 17:12 ("Even though sales of a branded product may decrease to a mere trickle, a court is likely to refuse to find that the mark has been abandoned"). In order to establish abandonment, the asserting party must prove "*complete* cessation or discontinuance of use." *Electro Source, LLC v. Brandess-Kalt-Aetna Group*, 80 U.S.P.Q.2d 1161, 458 F.3d 931, 938 (9th Cir. 2006) (emphasis in original). There is no such evidence in the record. Instead, the evidence clearly shows sales of SAN DIMAS guitars and guitar parts for every year from 1993 to the present. Wade Dep. I, 12:18-13:11; 30:4-14; 30:15-33:10; 50:18-58:23; Exh. P16; Exh. P17; Exh. P18; Exh. P19; Exh. P20; Exh. P21.

Courts have found that "[e]ven a *single instance of use* [of the mark] is sufficient against a claim of abandonment of a mark if such use is made in good faith." *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 167 U.S.P.Q. 713, 434 F.2d 794, 804 (9th Cir. 1970) ; *see also, Electro Source*, 80 U.S.P.Q.2d 1161, 458 F.3d at 938 (held that the *Carter-Wallace* "single use" test is an enforceable bright-line rule). In *Carter-Wallace,* the trademark holder made nominal sales over a period of four years, and did not promote or advertise its product except for listing it in trade directories. 434 F.2d at 798. Here, Jackson/Charvel has engaged in sales of SAN DIMAS guitars and guitar parts continuously over the years with documented sales of SAN DIMAS brand product each year. Wade Dep. I, 12:18-13:11; 30:4-14; 30:15-33:10; 50:18-58:23; Exh. P16; Exh. P17; Exh. P18; Exh. P19; Exh. P20; Exh. P21. Jackson/Charvel has at no time stopped using the SAN DIMAS mark and has, therefore, not abandoned its rights in the mark.

### B. Jackson/Charvel has Priority of Use of the SAN DIMAS mark

Marks on the Supplemental Registry are subject to cancellation if a senior user of the mark establishes priority of use. 15 U.S.C. § 1052(d). Here, Jackson/Charvel has established priority of the use of SAN DIMAS in connection with guitars and guitar parts.

As the above demonstrates, Jackson/Charvel has used the mark continuously since June of 1993. *Supra*, pp. 6-11. Based upon Respondent's own application and resulting registration, Respondent began using the term SAN DIMAS in connection with his electric guitars on October 24, 2002. Thus, Jackson/Charvel has established priority of use over Respondent and, by extension, superior rights in the mark.

### C. The Distinctiveness of Petitioner's Mark

#### *1. JCMI Is Not Required to Prove Secondary Meaning*

Although Jackson/Charvel has pled and adduced evidence substantiating the distinctiveness of its SAN DIMAS mark, distinctiveness is *not* required to cancel a supplemental registration, such as Respondent's. *See, Books on Tape, Inc. v. Booktape Corp.*, 5 U.S.P.Q.2d 1301, 836 F.2d 519, 520 (Fed. Cir. 1987); McCarthy § 19:37 ("Because registration on the Supplemental Register implies that secondary meaning cannot be shown, a prior user can cancel a Supplemental Registration."). Consequently, JCMI posits that evidence of the distinctiveness of its SAN DIMAS mark is irrelevant to this proceeding. In *Books on Tape*, The Federal Circuit held that, for a petitioner to cancel a supplemental registration, the distinctiveness of the petitioner's mark is not required:

> The statute does not require the anomalous result that a junior user is entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a *prior* user cannot show secondary meaning in that term either.

*Books on Tape*, 5 U.S.P.Q.2d 1301, 836 F.2d at 520. Since the owner of a supplemental registration has not shown distinctiveness of its putative mark in order to gain its registration, a prior user of the same or similar term need not show distinctiveness in order to prevail in a cancellation proceeding. *Id.* In this case, Respondent acquired his supplemental registration after he received a refusal from the trademark examining attorney based on the geographic descriptiveness of the mark and agreed to move his designation to the Supplemental Register. Through that designation, Respondent obtained his Registration without ever having proved the distinctiveness of his putative mark. Accordingly, Jackson/Charvel need not show distinctiveness to cancel Respondent' mark—it need only show prior and continuous trademark use. *Id.*

2. *JCMI Has Established Secondary Meaning*

While proof of secondary meaning in Jackson/Charvel's use of SAN DIMAS is unnecessary, the evidence nevertheless establishes that SAN DIMAS has acquired secondary meaning. Unlike Respondent's recently adopted designation, Jackson/Charvel's SAN DIMAS mark is distinctive and well-known based, *inter alia*, on its length of use in the marketplace, Jackson/Charvel's advertising and promotion of the mark, Jackson/Charvel's sales of SAN DIMAS guitars, and the widespread public use of the mark by Jackson/Charvel's customers and the guitar industry. *Echo Travel, Inc. v. Travel Associates, Inc.*, 10 U.S.P.Q.2d 1368, 1371 (7th Cir. 1989) (exclusivity, length and manner of use, amount and manner of advertising, and amount of sales are factors in determining secondary meaning); *Yamaha International Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 840 F.2d 1572 (Fed. Cir. 1988) ("Proof based essentially on use in advertising and promotion in conjunction with other circumstantial factors has been deemed sufficient to establish

secondary meaning."); MCCARTHY § 15:30 (duration of use, amount of sales, and amount and manner of advertising among the factors evidencing acquired distinctiveness).

Jackson/Charvel has used the SAN DIMAS mark in connection with electric guitars and guitar parts for over a decade. Wade Dep. I, 12:18-13:2. During that time, Jackson/Charvel has devoted a significant amount of advertising resources to its SAN DIMAS mark. Jackson/Charvel advertised its SAN DIMAS guitars in popular guitar magazines, such as *Guitar World* and *Guitar*, which are widely distributed to consumers of electric guitars across the nation. Wade Dep. I, Exh. P3; Exh. P4; Exh. P5; Exh. P6; Exh. P7. Indeed, one of Jackson/Charvel's biggest product roll-outs and advertising campaign was the introduction of Jackson/Charvel's SAN DIMAS guitars. Wade Dep. I, 15:6. Based in part on its advertising and promotion of the SAN DIMAS mark, Jackson/Charvel sold approximately $750,000 of SAN DIMAS guitars during the 1990's and continues to sell SAN DIMAS guitars to this day. Wade Dep. I, 30:4-14. The extensiveness of this advertising helps to indicate the secondary meaning that SAN DIMAS has acquired in the eyes of consumers.

The distinctiveness of Jackson/Charvel's SAN DIMAS mark is further evidenced by its consumer recognition in the guitar marketplace. Because of Jackson/Charvel's extensive use of the SAN DIMAS mark in a variety of media—point of sale displays, catalogs, order forms, advertising—it is not surprising that customers, artists, and guitar industry participants have referred to Jackson/Charvel guitars as "SAN DIMAS guitars" or "CHARVEL SAN DIMAS guitars" throughout the 1990's and 2000's. Wade Dep. I, 41:6-8; 42:3-15; 44:9. Consumers would call or write to Jackson/Charvel during this period and specify, "I want a SAN DIMAS guitar," or "I want a SAN DIMAS neck." Wade

Dep. I, 41:6-42:22. Jackson/Charvel would receive hundreds of such calls and letters annually. Wade Dep. I, 41:9-15. In some instances, these inquiries would come from prominent musicians. For example, Donald Wade, Jackson/Charvel's former Vice President and Marketing Manager, testified to having had a conversation with Phil Collen, who is a founding member of the rock band Def Leppard, prior to 2002 where Wade and Collen discussed Collen's potential purchase of a SAN DIMAS guitar. Wade Dep. I, 44:17-19.

Moreover, the fact that Respondent, a former retailer of Jackson/Charvel's SAN DIMAS guitars and guitar parts, imitated the SAN DIMAS mark is evidence of its distinctiveness. *Vision Sports, Inc. v. Melville Corp.*, 12 U.S.P.Q.2d 1740, 888 F.2d 609 (9th Cir. 1989) ("[P]roof of copying strongly supports an inference of secondary meaning.").

**D. Likelihood of Confusion**

The Board examines numerous factors in determining whether two marks are likely to cause confusion. *In re E. I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *Cunningham v. Laser Gold Corp.*, 55 U.S.P.Q.2d 1842, 222 F.3d 943, 946-47 (Fed. Cir. 2000) (court does not have to examine every single *DuPont* factor in its analysis to find likelihood of confusion). Of those factors, the most important factors are the similarity of the marks and the similarity of the goods. *In re Azteca Restaurant Enterprises, Inc.*, 50 U.S.P.Q.2d 1209, 1210 (T.T.A.B. 1999) ("In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services."); *Hans Beauty, Inc. v. Alberto-Culver Co.*, 57 U.S.P.Q.2d 1557, 236 F.3d 1333, 1336 (Fed. Cir. 2001) (likelihood of confusion established based upon similarity in marks and in goods). If there is doubt as to whether there is likelihood of confusion, the court should find in favor of the senior user of the mark.

*Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 42 U.S.P.Q.2d 1184, 109 F.3d 1394, 1406 (9th Cir. 1997). Here, the facts show that there is a likelihood of confusion because Jackson/Charvel's SAN DIMAS trademark and Respondent's mark are virtually identical and are used in connection with directly competitive goods. In addition, the evidence shows that Respondent intended to trade upon Jackson Charvel's longstanding goodwill, and that Petitioner's SAN DIMAS mark has significant strength in the marketplace.

*1. The Parties' Marks are Similar*

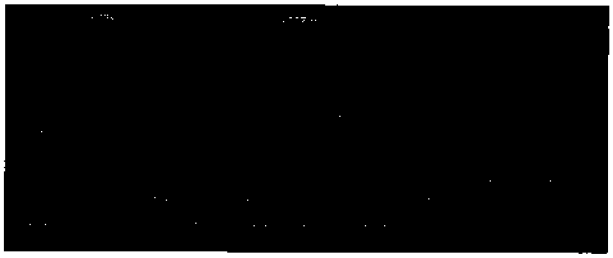
In determining the similarity between marks, "absolute identity is not necessary for infringement; all that is necessary is enough similarity between the marks to confuse consumers." *Washington Speakers Bureau, Inc. v. Leading Authorities, Inc.*, 49 U.S.P.Q.2d 1893, 33 F.Supp.2d 488, 497 (E.D.Va. 1999) (court finds similarity in marks, and likelihood of confusion, between "Washington Speakers Bureau" and "www.washingtonspeakers.com"). The more similar the marks are in terms of appearance, sound, and meaning, the greater the likelihood of confusion. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 50 U.S.P.Q.2d 1545, 174 F.3d 1036, 1054 (9th Cir. 1999) (holding likelihood of confusion between "Movie Buff" software and "www.moviebuff.com" for video rental chain of stores). "Similarity in either form, spelling or sound alone may be sufficient to support a finding of likelihood of confusion." *Interstate Brands Corp. and Interstate Brands West Corp. v. McKee Foods Corp.*, 54 U.S.P.Q.2d 1910 (T.T.A.B. 2000), citing *Krim-Ko Corp. v. Coca-Cola Co.*, 156 U.S.P.Q. 523, 390 F.2d 728 (C.C.P.A. 1968) (finding likelihood of confusion between "HoHo's" and "Yo-Yo's").

The dominant terms in the two marks in question feature the identical words: SAN DIMAS. Respondent has added the descriptive words, "The California Guitar

Company," but such descriptive words are not sufficient to avoid confusion. *Wella Corp. v. California Concept Corp.*, 194 U.S.P.Q. 419, 558 F.2d 1019, 1022 (C.C.P.A. 1977) (addition of a word to make the mark "California Concept" was only suggestive and was still similar enough to "Concept" to cause confusion).

Moreover, Petitioner and Respondent have presented their marks to consumers using similar design elements and graphics. "The similarity of design is determined by considering the overall impression created by the mark as a whole rather than simply comparing individual features of the marks." *Exxon Corp. v. Texas Motor Exchange of Houston, Inc.*, 208 U.S.P.Q. 384, 628 F.2d 500, 505 (5th Cir. 1980) (holding likelihood of confusion between "EXXON" and "TEXON"). "Similarity of appearance between marks is really nothing more than a subjective 'eyeball' test." McCarthy § 23:25. Below is a representation of the Jackson/Charvel SAN DIMAS mark as it appeared during the initial launch of the mark along with reproduction of Respondent's registered mark:

Wade Dep. I, Exh. P11.



See, U.S. Reg. No. 2,772,766. As seen by the font, script, and lay-out, the similarity in appearance between the two marks is striking.

2. *The Parties' Marks are used on directly competitive goods*

The goods that both Jackson/Charvel and Respondent are selling in the marketplace under the mark SAN DIMAS are exactly the same: electric guitars. Jackson/Charvel has sold electric guitars and guitar parts under the SAN DIMAS mark since 1993. Wade Dep. I, 12:20. As shown in the Registration, Respondent has been advertising his guitars under the SAN DIMAS mark since late 2002.

When marks appear on virtually identical goods, the degree of similarity necessary to support a conclusion of likelihood of confusion declines. *Hard Rock Café International (USA), Inc. v. Elsea*, 56 U.S.P.Q.2d 1504 (T.T.A.B. 2000) (likelihood of confusion between "Hard Rock Café" restaurant and "Country Rock Café" restaurant and club); *Fossil, Inc. v. The Fossil Group*, 49 U.S.P.Q.2d 1451 (T.T.A.B. 1998) (likelihood of confusion between "Fossil" watches and "The Fossil Group" clocks). Because Jackson/Charvel and Respondent are selling directly competitive goods under identical marks, the use of the SAN DIMAS mark by Respondent will cause confusion in the marketplace.

3. *Intent*

Prior to JCMI's purchase of the guitar product lines and intellectual property from AMIC's Jackson/Charvel division in October 2002, Respondent had attempted to buy the Jackson/Charvel line from AMIC. Wade Dep. I, 46:24-47:16. At the time, Respondent was also a retailer of the Jackson/Charvel product line and received Jackson/Charvel's price lists/catalogs. Wade Dep. I, 46:15-17. Accordingly, Petitioner posits that Respondent was aware of Jackson/Charvel's SAN DIMAS mark at the time he adopted the registered Mark and intended to trade upon the goodwill associated with Petitioner's mark.

4. *Strength of Plaintiff's Mark*

The SAN DIMAS mark as used by Jackson/Charvel has strong recognition in the marketplace. Customers specifically request SAN DIMAS guitars and guitar parts by name, e.g. "I want a SAN DIMAS neck." Wade Dep. I, 34:18-35:1; 41:16-42:15. Prominent musicians and performers, such as Mitch Watkins and Phil Collen, have specifically requested SAN DIMAS guitars. Wade Dep. I, 44:2-23.

The strength of the SAN DIMAS mark is also reflected in the continuing sales of SAN DIMAS guitars and guitar parts over the years. These sales have continued with the launch of the special 25th Anniversary Edition of the SAN DIMAS guitar, with more than a quarter of a million dollars in sales since mid-2003. Walker Dep. 8:14-15, 8:19-9:3. While the level of sales of SAN DIMAS guitars and guitar parts has fluctuated over the years, there have been sales of SAN DIMAS guitars and parts in every year since 1993. Wade Dep. I, 30:4-33:10; 54:22-57:2; 57:10-58:7; 58:19-23.

Jackson/Charvel has also continued to advertise and promote the SAN DIMAS line of guitars and guitar parts over the years. From one of the most significant roll-outs in the company's history when SAN DIMAS was launched in 1993, to the most recent marketing connected to the 25th Anniversary SAN DIMAS, Jackson/Charvel has invested significant resources into the promotion of the SAN DIMAS mark, and has done so continuously through catalogs, point-of-purchase displays, and price lists. Wade Dep. I, 14:4-14:20; 15:10-15:19; 21:8-12; 27:5-29:23; 33:20-34:10; 36:1-38:4; 44:24-46:1. Therefore, the Jackson/Charvel SAN DIMAS mark has considerable strength.

## IV. CONCLUSION

Petitioner is the owner of valid and prior trademark rights in a mark that is virtually identical to the registered mark, for use in connection with goods that are directly competitive. For all the foregoing reasons, Respondent's Registration No. 2,772,766 should be cancelled.

DATED: October 27, 2006

Respectfully submitted,

JACKSON/CHARVEL MANUFACTURING, INC.

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