

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: November 29, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Jackson/Charvel Manufacturing, Inc.  
v.  
Lloyd A. Prins  
\_\_\_\_\_

Cancellation No. 92042614  
to Registration No. 2772766  
issued on October 7, 2003  
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Oscar Alcantara and Mary E. Anderson of Goldberg, Kohn,  
Bell, Black, Rosenbloom, Moritz for Jackson/Charvel  
Manufacturing, Inc.

Lloyd A. Prins, Pro Se.  
\_\_\_\_\_

Before Quinn, Walters and Walsh, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Jackson/Charvel Manufacturing, Inc. filed its petition  
to cancel the Supplemental Register registration of Lloyd A.  
Prins for the mark shown below for "musical instruments,  
namely, electric guitars and electric basses," in  
International Class 15.<sup>1</sup> The registration includes a

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<sup>1</sup> Registration No. 2772766, issued October 7, 2003, from an application  
filed December 3, 2002.

disclaimer of "GUITARS" and "GUITAR COMPANY" apart from the mark as a whole.

*San Dimas*  
Guitars  
*The California Guitar Company*

As grounds for the petition, petitioner asserts that respondent's mark, when applied to respondent's goods, so resembles petitioner's previously used mark SAN DIMAS for electric guitars and electric guitar products as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Respondent, in his answer, denied the salient allegations of the claim and asserted abandonment as an affirmative defense.<sup>2</sup>

*The Record*

The record consists of the pleadings; the file of the involved registration; copies of letters, submitted by stipulation of the parties; the affidavit of respondent, submitted by stipulation of the parties; and various publications made of record by respondent's notice of reliance. Petitioner made of record its testimony

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<sup>2</sup> Respondent also asserted as affirmative defenses laches, waiver, and estoppel; and that petitioner's use of its mark for at least the prior six years was mere token use. However, these claims were not raised again and we consider them to have been abandoned.

depositions of Mark D. Van Vleet, petitioner's general counsel and corporate secretary; John Walker, petitioner's marketing manager; and Donald Wade, petitioner's former marketing manager. Respondent also made of record his testimony deposition of Donald Wade, petitioner's former marketing manager. All depositions were submitted with accompanying exhibits. Both parties filed briefs on the case.

*Factual Findings*

Petitioner's predecessors-in-interest include Jackson/Charvel Company, which sold all of its assets and trademarks to Akai Musical Instrument Corporation (AMIC) in 1997. AMIC maintained a division called Jackson/Charvel Guitars, which it sold, along with all assets and trademarks, to Fender Musical Instruments Corporation (FMIC) in October 2002. FMIC created a wholly owned subsidiary, Jackson/Charvel Manufacturing, Inc., the petitioner herein. San Dimas is a location in California where at least one of petitioner's predecessors-in-interest was located, although the SAN DIMAS guitars have been manufactured in Ontario, California. (See Walker Dep.)

The record establishes that, through its predecessors-in-interest, petitioner began manufacturing and selling SAN DIMAS electric guitars and electric guitar necks at least as early as 1993 (Wade, May 2006 Dep., p. 12); that the mark

CHARVEL has also been used in connection with all SAN DIMAS model electric guitars and custom shop guitars; and that SAN DIMAS has been used in connection with electric guitars and/or, through its custom model shop, electric guitar necks continuously by petitioner from 1993 to the time of trial (id., p. 13, 39).

Petitioner's advertising in connection with the original rollout of its SAN DIMAS production model electric guitar was between \$20,000 and \$25,000 each year in 1994 through 1996. The product was released at NAMM, the industry trade show put on by manufacturers and attended by dealers and customers. Petitioner sells its guitars through dealers and advertises its guitars in catalogs, industry and consumer guitar magazines, point of purchase displays for dealers, and gifts to celebrities, who use the guitars in concert (e.g., both Phil Collen of Def Leopard and Mitch Watkins, guitarist for Lyle Lovett, have used SAN DIMAS guitars).

Each year, petitioner distributes between 8,000 and 10,000 catalogs and between 16,000 and 20,000 price lists. During the years of their production, petitioner's SAN DIMAS production guitars have been included in these catalogs or on cut sheets providing information about, and price sheets referring to, the SAN DIMAS guitar. SAN DIMAS guitar necks have continuously been listed on petitioner's custom shop

model order forms and price sheets. Sales of SAN DIMAS guitars, both custom shop models and production models, totaled approximately \$750,000 during the 1990's.

Petitioner is not a large production shop and even its production guitars are made to dealers' orders rather than kept in inventory. (Wade, May 2006 Dep., p. 39.)

Mr. Wade described the guitar manufacturing business as "a fashion industry," noting that different styles have peaks and valleys and, as a company, petitioner regularly changes its marketing strategy to stay sufficiently diversified for level sales over time. (Wade, May 2006 Dep., p. 91.) For example, in 1997 petitioner's marketing strategy focused on through-body guitar necks and imported product and, therefore, advertising for the SAN DIMAS production guitar did not appear on catalog pages and could not be broken out from all advertising expenses. (Wade, May 2006 Dep., p. 90.)

In late 1998 or early 1999, petitioner ceased manufacturing a production formatted Jackson/Charvel SAN DIMAS guitar. Small numbers of remaining SAN DIMAS production guitars were sold in 1999 and 2000; however, by 2000, petitioner had begun using SAN DIMAS solely to identify the distinctive neck of the guitar, which could be chosen by a customer designing and ordering a custom guitar from petitioner through a dealer. (Wade, August 2006 Dep.,

p. 59.) Mr. Wade described the SAN DIMAS guitar and neck as follows:

Charvel and Jackson guitars are the original hot rod guitar made in the United States in that we're the longest continuous operating custom shop. So as with the SAN DIMAS, you had your choice of body materials, colors, pick-ups, yet the common thread was the SAN DIMAS neck shape.

This is a bolt-on neck that is similar to other bolt-on necks available in the market yet is the first company to have an extra fret added, a compound radius finger board, rolled-over edges, and a very particular back shape.  
(Wade, May 2006 Dep., p. 13.)

Mr. Wade stated that customers and dealers know the SAN DIMAS guitar neck, noting that it is how they identify Charvel guitars and that customers and dealers ask for the SAN DIMAS neck by name. (Wade, May 2006 Dep., pp. 34-35, 42.)

In 2002, petitioner conceived and developed a limited edition 25<sup>th</sup> anniversary SAN DIMAS production guitar, which it began selling in 2003, in addition to offering the SAN DIMAS neck through its custom model shop. Mr. Walker stated that Charvel has long been associated with custom shop instruments; that SAN DIMAS has always been associated with a custom shop type of instrument; that this association enhanced the introduction of the 25<sup>th</sup> anniversary production model; that this model's dealer price runs between \$1,000 and \$2,000, with a retail price between \$1,700 and \$4,000; and that this model's sales totaled \$250,000 in the first

eighteen months, which made it petitioner's most successful model to date. (Walker Dep., pp. 8-10.) Petitioner's use of SAN DIMAS in connection with electric guitars and/or electric guitar necks has been continuous from 1994 to the time of trial.

Prior to October 2002, respondent, Llyod Prins, was a guitar dealer for petitioner's predecessor-in-interest, AMIC. In fact, in October 2002, respondent was in discussions with AMIC about purchasing the Jackson/Charvel business, which was purchased ultimately by FMIC, petitioner's parent. (Wade, May 2006 Dep., pp. 46-47.)

Mr. Prins testified that, on October 19, 2002, he had a telephone conversation with a potential customer and offered for sale a guitar; that, on October 24, 2002, the customer agreed to purchase a guitar from Mr. Prins; and that, on November 9, 2002, Mr. Prins received payment and shipped a guitar to the customer in North Dakota. Mr. Prins stated that SAN DIMAS GUITARS and design was affixed to the headstock of the guitar and to the shipping box. Mr. Prins' Supplemental Registration for SAN DIMAS GUITARS and design issued on October 7, 2003.<sup>3</sup> Other than the specimen submitted in connection with the application, the record

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<sup>3</sup> A Supplemental Register registration is not entitled to constructive use as of the filing date, which is available to marks registered on the Principal Register. 15 U.S.C. 1057.

contains no other evidence of use of SAN DIMAS GUITARS and design by respondent in connection with guitars.

*Analysis*

1. *Standing.*

Because petitioner has properly submitted evidence of its use of the mark SAN DIMAS in connection with guitars and guitar necks, and because petitioner's likelihood of confusion claim is not frivolous, we find that petitioner has established its standing in this cancellation proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

2. *Priority.*

We turn, next, to the question of whether petitioner has established its priority of use and we consider respondent's affirmative defense of abandonment in this context.

Petitioner states that it has established its use of SAN DIMAS in connection with guitars and guitar parts by itself and by its predecessors-in-interest from at least 1993 continuously to the time of trial; and contends that it is not required to establish the distinctiveness of its mark to cancel a Supplemental Register registration, citing in support thereof *Books on Tape Inc. v. The Booktape Corp.*,

836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987). Petitioner's argument that it is not required to establish distinctiveness is not well taken. In *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (1990), aff'g 17 USPQ2d 1471 (TTAB 1989), the Court concluded that, notwithstanding the seemingly contradictory holdings in *Books on Tape, supra*, and *In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337 (CCPA 1978),<sup>4</sup> the clear rule in this regard is enunciated in *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). The Court in *Towers, supra*, made the following statement:

*Otto Roth* is clear in its holding. Section 2(d) bars registration, or serves as a basis for cancellation, if there is a likelihood of confusion as to source. As to an unregistered term, such a likelihood of confusion results when there are trade identity rights in the prior user's term. Those trade identity rights arise when the term is distinctive, either inherently or through the acquisition of secondary meaning.

. . .

The Board did not err in requiring *Towers* to show that his descriptive term had acquired secondary meaning before *Advent* adopted its mark.

[16 USPQ2d at 1042]

See also *Cicena Ltd. v. Columbia Telecommunications Group*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990); and *Perma Ceram Enterprises, Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992).

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<sup>4</sup> The Court stated that these cases are procedurally distinguishable.

Therefore, in order to establish its priority, petitioner must first establish that its mark is inherently distinctive or that it has acquired distinctiveness. If the latter, our determination of priority is based on the date petitioner's pleaded mark acquired distinctiveness. Petitioner must establish its priority by a preponderance of the evidence. See *Otto Roth & Co. v. Universal Foods Corp.*, *supra*.

Petitioner does not contend that SAN DIMAS is inherently distinctive and, because it denotes the historical place of origin of the SAN DIMAS guitar by petitioner's predecessor-in-interest, we agree. Petitioner states that, should it be required to prove distinctiveness, it has established that SAN DIMAS has acquired distinctiveness as petitioner's mark in connection with electric guitars and guitar necks through evidence of its long use, revenues, advertising and promotional expenditures, and consumer and industry recognition. The evidence establishes that petitioner has been using SAN DIMAS in connection with electric guitars and/or guitar necks for over a decade; that its sales have been substantial; that its promotional expenditures and the breadth of its advertising have been significant; and that its SAN DIMAS guitars have been promoted widely through use by celebrity musicians. We find this evidence sufficient to

conclude that petitioner has demonstrated acquired distinctiveness of SAN DIMAS in connection with electric guitars and guitar necks. While it is not possible on this record to point to a specific date that SAN DIMAS acquired distinctiveness as petitioner's mark, we find that it certainly had done so by the five-year anniversary of its first use in 1993, if not earlier.

Respondent seeks to defend his registration by affirmatively asserting that petitioner has abandoned its mark because it cannot establish continuous use of its mark on guitars. Respondent alleges that the record fails to establish use of the mark by petitioner on guitars for a period of more than three years, between 1997 and 2003, which is when petitioner recommenced use of the mark in connection with the 25<sup>th</sup> anniversary production guitars. Respondent also contends that the record shows that during the alleged period of non-use, petitioner did not have an intent to resume use. Finally, respondent contends that petitioner did not resume use of its mark until after respondent's date of registration, October 7, 2003, and that, therefore, respondent has priority herein.

Under Section 1127 of the Trademark Act, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use"; "intent not to resume may be inferred from circumstances"; and "nonuse for 3

consecutive years shall be prima facie evidence of abandonment." See 15 U.S.C. Section 1127. The party seeking to establish abandonment bears the burden of proof to establish the case by a preponderance of the evidence. See *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).<sup>5</sup>

A party claiming that a mark has been abandoned must show "non-use of the name by the legal owner and no intent by that person or entity to resume use in the reasonably foreseeable future." See *Stetson v. Howard D. Wolf & Associates*, 955 F.2d 847, 850, 21 USPQ2d 1783 (2d Cir 1992). Non-use for three consecutive years alone, however, constitutes prima facie evidence of abandonment. See *supra*, 15 U.S.C. Section 1127. See also *Emergency One, Inc. v. American FireEagle, Ltd.*, 228 F.3d 531, 56 USPQ2d 1343 (4<sup>th</sup> Cir. 2000). Such a showing may be rebutted by petitioner herein by establishing that its mark was in use during the years challenged or by providing evidence of an intent to resume use to disprove the presumed fact of no intent to resume use.

First, petitioner has established that it and its predecessors-in-interest used SAN DIMAS in connection with

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<sup>5</sup> While the cited case pertains to cancellation of a registration, its rule regarding burden of proof is equally applicable in this case involving respondent's allegation that petitioner abandoned its common law mark through non-use with no intention to resume use.

guitar necks as either replacements for the necks of SAN DIMAS production guitars or as part of a custom model guitar continuously from 1993 to the time of trial. Therefore, in the absence of any period of nonuse of SAN DIMAS in connection with guitar necks, respondent's defense of abandonment must fail with respect thereto.

The facts are less straightforward with respect to petitioner's use of SAN DIMAS in connection with electric guitars. However, the result is ultimately the same. While manufacture of a production formatted Jackson/Charvel SAN DIMAS guitar ceased in late 1998 or early 1999, petitioner sold a small number of its remaining SAN DIMAS production guitars in 1999 and 2000, indicating that SAN DIMAS production guitars were available to consumers during 1999 and 2000 and were, once again, available to consumers in 2003 with the roll-out of petitioner's 25<sup>th</sup> anniversary edition. It is immaterial that sales of petitioner's guitars were minimal during certain years.

Thus, the record does not establish the three-year period of non-use of the mark in connection with guitars that would trigger the statutory presumption of no intent to resume use. Further, even if we had found non-use for a three-year period, we conclude that the facts established by petitioner disprove any presumption of no intent to resume use. Petitioner established that during 2002 its

predecessor-in-interest was courting potential buyers for the business and did in fact sell the business; and that, as early as 2002, petitioner and its predecessor had an intent to resume use of the mark on the anniversary edition production guitar. Moreover, while respondent's claim of abandonment focused entirely on petitioner's use or lack of use of SAN DIMAS in connection with electric guitars, respondent fails to account for petitioner's continuous use of SAN DIMAS in connection with guitar necks. This use, in combination with the facts regarding minimal sales of production guitars during 1999 and 2000, plans to recommence sales of SAN DIMAS guitars, and the launch of the anniversary edition guitars, points to a continuing intent by petitioner to use SAN DIMAS in connection with electric guitars. Thus, respondent's claim of abandonment of the mark with respect to electric guitars also fails.

To summarize, neither party's mark is inherently distinctive, although petitioner has established that its mark acquired distinctiveness prior to any date upon which respondent can rely; and respondent has not established the abandonment of petitioner's mark SAN DIMAS in connection with either electric guitars or guitar necks. Therefore, petitioner has established its priority.

3. *Likelihood of Confusion.*

Neither party disagrees that the marks are substantially similar and that the goods are essentially identical or closely related. While respondent has not explicitly conceded likelihood of confusion, he does not dispute the similarities between the parties' marks and goods<sup>6</sup>; and, further, respondent focuses his entire argument in his brief on the issue of priority.

Regarding the marks, petitioner's SAN DIMAS mark is identical to the dominant portion of the registered subject matter and substantially similar in overall commercial impression. In the registration, the apparent geographic term SAN DIMAS appears larger, in bolder print, and above the generic and/or geographically descriptive terminology "GUITARS" and "THE CALIFORNIA GUITAR COMPANY."

Respondent's identified electric guitars are identical to petitioner's electric guitars and closely related to petitioner's guitar necks, a major and defining component of a guitar. Similarly, respondent's electric basses are also closely related to electric guitars, if not subsumed within the category of electric guitars, and to guitar necks.

Further, neither respondent's identification of goods in the subject registration nor petitioner's established use of SAN

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<sup>6</sup> Respondent makes statements such as "I intend to show why I have a superior right in the San Dimas trademark ..." (brief, p. 2); "After registrant had begun using the San Dimas trademark, petitioner attempts to reintroduce the San Dimas mark" (brief, p. 11); and "The facts in this case establish that I have a superior [right] to the San Dimas trademark ..." (brief, p. 19).

DIMAS is limited to any specific channels of trade; therefore, we presume an overlap and that the goods would be offered in all ordinary trade channels for these goods and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

Finally, we look at respondent's intent in registering its mark and we note that respondent is far from an innocent user and registrant of a descriptive term in connection with guitars. Not only was respondent a recognized dealer of petitioner's SAN DIMAS guitars, but he competed unsuccessfully with petitioner's parent to purchase the business from AMIC and, immediately thereafter, sold his own SAN DIMAS guitar and applied to register the subject matter herein. In determining likelihood of confusion, this factor weighs against respondent.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of petitioner's mark, SAN DIMAS, and registrant's stylized subject matter, SAN DIMAS GUITARS THE CALIFORNIA GUITAR COMPANY, their contemporaneous use on the same and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

*Decision:* The petition to cancel is granted. Registration No. 2772766 will be cancelled in due course.