

ESTTA Tracking number: **ESTTA8832**

Filing date: **05/17/2004**

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

Proceeding	92042614
Party	Defendant Prins, Lloyd A. Prins, Lloyd A. 2323 Via Saldivar Glendale, CA 91208
Correspondence Address	Lloyd A. Prins 2323 Via Saldivar Glendale, CA 91208
Submission	Answer
Filer's Name	Lloyd A. Prins
Filer's e-mail	lprins@sandimasguitars.com
Signature	/Lloyd A. Prins/
Date	05/17/2004
Attachments	SD_Answer.txt (4 pages)

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, Cancellation No. 92042614
INC.,

Petitioner,

v.
PRINS, LLOYD A.,

Registrant

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

ANSWER TO PETITION FOR CANCELLATION

Respondent, Lloyd A. Prins answers the Petition for Cancellation as follows:

1. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Petition for Cancellation and therefore denies the same.
2. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 of the Petition for Cancellation and therefore denies the same.
3. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of the Petition for Cancellation and therefore denies the same.
4. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Petition for Cancellation and therefore denies the same.
5. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 5 of the Petition for Cancellation and therefore denies the same.
6. Admitted
7. Admitted
8. Admitted
9. Respondent is without knowledge or information sufficient to form a belief as to the right of the Petitioner to grant such an authorization. Furthermore, on two occasions (July 21, 2003 and September 2, 2003), prior to the awarding of Respondent's registered mark, Respondent requested in writing to the Petitioner for all information that supported Petitioner's legal claim to a like mark (Exhibits I and II attached). Petitioner's sole reply was a set of photo copy images from a 1995 and 1996 product catalog that depicted guitars that had been discontinued and abandoned for over six years.
10. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 10 of the Petition for Cancellation and therefore denies the same.
11. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 11 of the Petition for Cancellation and therefore denies the same.
12. Respondent is without knowledge or information sufficient to form a

belief as to the truth of the allegations of Paragraph 12 of the Petition for Cancellation and therefore denies the same.

13. Agreed.

Wherefore, Respondent prays that the Petition for Cancellation be dismissed.

AFFIRMATIVE DEFENSES

First Affirmative Defense

The Petitioner's claims are barred by the Doctrine of Laches.

Second Affirmative Defense

The Petitioner's claims are barred by the Doctrine of Waiver.

Third Affirmative Defense

The Petitioner's claims are barred by the Doctrine of Estoppel.

Fourth Affirmative Defense

Affixation and Use

The Petitioner's claims are barred because its alleged trademark was no more than a token reference to a business mailing address and was not affixed to its products, product tags or packaging.

Fifth Affirmative Defense

Abandonment

The Petitioner's claims are barred because the Petitioner abandoned its alleged trademark.

Respectfully Submitted

Lloyd A. Prins

May 17, 2004

Certificate of Mailing and Notice of Service

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

I certify that a copy of this Answer to the Petition for Cancellation was mailed on May 17, 2004 via U.S. Mail, article number

_____. This item was deposited with sufficient postage and was addressed to:

Box TTAB No Fee

United States Patent and Trademark Office

2900 Crystal Drive

Arlington, Virginia 22202-3513

Notice of Service

I also certify that a copy of this Answer to the Petition for Cancellation was mailed to the Petitioner on May 17, 2004 via U.S.

Mail, article number _____. This item was deposited with sufficient postage on May 17, 2004 and addressed to:

Mr. Michael K. Hendershot

Goldberg Kohn

55 East Monroe Street

Suite 3700

Chicago, IL 60603-5802

Lloyd A. Prins

May 17, 2004

Exhibit I

Lloyd A. Prins

Prins

San Dimas Guitar Company

Lloyd A.

2323 Via Saldivar
P.O. Box 701321
Glendale, CA 91208
K 74170

Tulsa, O

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
Exhibit II

Lloyd A.

Lloyd A. Prins
Prins

San Dimas Guitar Company
2323 Via Saldivar
P.O. Box 701321
Glendale, CA 91208
K 74170

Tulsa, O

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

Exhibit II (continued)

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,

Lloyd A. Prins

San Dimas Guitar Company