

ESTTA Tracking number: **ESTTA276620**

Filing date: **04/07/2009**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Fender Musical Instruments Corporation		
Entity	Corporation	Citizenship	Delaware
Address	8860 East Chaparral Road Suite 100 Scottsdale, AZ 85250 UNITED STATES		

Attorney information	Oscar L. Alcantara Goldberg Kohn 55 East Monroe Street Suite 3300 Chicago, IL 60603 UNITED STATES tmapps@goldbergkohn.com Phone:(312) 201-3977		
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Registration Subject to Cancellation

Registration No	3410905	Registration date	04/08/2008
Registrant	Pacella, Carmen #104 1764 East Commonwealth Avenue Fullerton, CA 92831 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2006/10/15 First Use In Commerce: 2006/10/15 All goods and services in the class are cancelled, namely: Clothes, namely, shirts, t-shirts, tank tops, sweatshirts, sweatpants, swim shorts, jackets, caps, hats, headbands, sun visors
Class 043. First Use: 2006/10/15 First Use In Commerce: 2006/10/15 All goods and services in the class are cancelled, namely: Restaurants; restaurant services

Grounds for Cancellation

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	805075	Application Date	08/06/1965
Registration Date	03/08/1966	Foreign Priority Date	NONE
Word Mark	FENDER		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class U021 (International Class 009). First use: First Use: 1945/00/00 First Use In Commerce: 1946/00/00</p> <p>ELECTRIC APPARATUS FOR USE WITH GUITARS AND FOR OTHER PURPOSES-NAMELY, AMPLIFIERS, LOUDSPEAKERS, [ECHO CHAMBERS, AND REVERBERATION UNITS;] AND COMPONENTS AND ACCESSORIES FOR SUCH ELECTRICAL APPARATUS-NAMELY, AMPLIFIER CORDS, [AMPLIFIER CARRIERS,] AMPLIFIER COVERS, FOOT PEDAL CONTROLS, [SWITCHES,] AMPLIFIER HANDLES, AMPLIFIER KNOBS, AMPLIFIER CORNERS, AMPLIFIER VOLUME AND TONE CONTROLS, SPEAKER CABINETS, [AMPLIFIER TUBE SHIELDS, AMPLIFIER THUMB-SCREWS,] AND AMPLIFIER LEGS [, AND TAPE CARTRIDGES] TRIDGES]</p> <p>Class U036 (International Class 015). First use: First Use: 1945/00/00 First Use In Commerce: 1946/00/00</p> <p>MUSICAL INSTRUMENTS-NAMELY, ELECTRIC SPANISH GUITARS, [ELECTRIC MANDOLINS,] ELECTRIC BASSES, ACOUSTIC GUITARS, [PEDAL STEEL GUITARS, AND STEEL GUITARS;] AND COMPONENTS AND ACCESSORIES FOR GUITARS AND THE LIKE-NAMELY, [LEGS,] CASES, BAGS, STRINGS, POLISH, [WAIST BELTS, STANDS,] PICKS, [STEELS,] NECKS, HEADS, PICKUPS, PICKUP COVERS, PICKGUARDS, BRIDGE COVERS, TREMOLO HANDLES, CONTROL KNOBS, AND STRAPS</p>

U.S. Registration No.	805510	Application Date	08/06/1965
Registration Date	03/15/1966	Foreign Priority Date	NONE

Word Mark	FENDER
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class U021 (International Class 009). First use: First Use: 1945/00/00 First Use In Commerce: 1946/00/00</p> <p>ELECTRICAL APPARATUS FOR USE WITH GUITARS AND FOR OTHER PURPOSES-NAMELY, AMPLIFIERS, LOUDSPEAKERS, [ECHO CHAMBERS, AND REVERBERATION UNITS,] AND COMPONENTS AND ACCESSORIES FOR SUCH ELECTRICAL APPARATUS-NAMELY, AMPLIFIER CORDS, [AMPLIFIER CARRIERS,] AMPLIFIER COVERS, FOOT PEDAL CONTROLS, [SWITCHES,] AMPLIFIER HANDLES, AMPLIFIER KNOBS, AMPLIFIER CORNERS, AMPLIFIER VOLUME AND TONE CONTROLS, SPEAKER CABINETS, [AMPLIFIER TUBE SHIELDS, AMPLIFIER THUMB SCREWS,] AND AMPLIFIER LEGS [, AND TAPE CARTRIDGES]</p> <p>Class U036 (International Class 015). First use: First Use: 1945/00/00 First Use</p>
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	In Commerce: 1946/00/00 MUSICAL INSTRUMENTS-NAMELY, ELECTRIC SPANISH GUITARS, [ELECTRIC MANDOLINS,] ELECTRIC BASSES, ACOUSTIC GUITARS, [PEDAL STEEL GUITARS, AND STEEL GUITARS,] AND COMPONENTS AND ACCESSORIES FOR GUITARS AND THE LIKE-NAMELY, [LEGS,] CASES, BAGS, STRINGS, POLISH, [WAIST BELTS, STANDS,] PICKS, [STEELS,] NECKS, HEADS, PICKUPS, PICKUP COVERS, PICKGUARDS, BRIDGE COVERS, TREMOLO HANDLES, CONTROL KNOBS, AND STRAPS
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U.S. Registration No.	3060024	Application Date	07/28/2004
Registration Date	02/21/2006	Foreign Priority Date	NONE

Word Mark	FENDER
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 Clothing, namely athletic footwear, [bandanas,] baseball caps, bathing suits, bathing trunks, [bathrobes,] beachwear, belts, [berets,] cloth bibs, blazers, blouses, [body suits,] bomber jackets, boots, [bow ties,] boxer shorts, [bras,] briefs, [bustiers, camisoles, capes,] capris, caps, cardigans, casual socks, [chemises,] chinos, coats, collars, coveralls, [cuffs, cummerbunds,] down-filled jackets, dresses, [ear muffs,] flannel shirts, footwear, suits and dresses, [gloves,] golf shirts, [gowns,] gym shorts, halter tops, hats, headbands, housecoats, infantwear, jackets, jeans, jerseys, jogging suits, jumpers, jumpsuits, [kerchiefs,] khaki pants, knit shirts, [leggings, leotards,] lingerie, mittens, [moccasins,] motorcycle boots, [neckerchiefs,] neckwear, night shirts, overalls, overcoats, pajamas, pants, [pantyhose,] polo shirts, [ponchos,] pullovers, rain wear, robes, [rugby shirts,] sandals, [scarves, shawls, Shells,] shirts, shorts, [ski wear,] skirts, slacks, sleepwear, slippers, [smocks,] smoking jackets, sneakers, socks, sport coats, sport shirts, sports jerseys, stockings, [suits,] sun dresses, [suspenders,] Swim wear, sweat pants, sweat shirts, sweat shorts, sweaters, tank tops, [ties, tights,] topcoats, tops, trousers, T-shirts, tube tops, [tunics,] turtlenecks, undergarments, vests, waistcoats, walking shorts, warm-up suits, [wraps,] and wristbands
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U.S. Registration No.	2237850	Application Date	01/18/1994
Registration Date	04/06/1999	Foreign Priority Date	NONE

Word Mark	FENDER
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 coats and shirts

U.S. Registration No.	1715905	Application Date	05/09/1991
Registration Date	09/15/1992	Foreign Priority Date	NONE
Word Mark	FENDER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1983/00/00 First Use In Commerce: 1983/00/00 men's and women's active clothing; namely, T-shirts, tank tops, sweat shirts, sweat suits, sweaters, fleece tops, jackets, polo shirts, baseball jerseys, shorts, hats, and suspenders		

Attachments	72225092#TMSN.gif (1 page)(bytes) 78458293#TMSN.jpeg (1 page)(bytes) 75977990#TMSN.gif (1 page)(bytes) 74165052#TMSN.gif (1 page)(bytes) Petition for Cancellation of Reg. No. 3410905.pdf (5 pages)(95507 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Oscar L. Alcantara/
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Name	Oscar L. Alcantara
Date	04/07/2009

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

In the Matter of)	
Trademark Registration No. 3410905)	
For the Mark FENDER AVENUE BAR & GRILL)	
)	
FENDER MUSICAL INSTRUMENTS)	Cancellation No.
CORPORATION,)	
Petitioner,)	
)	
v.)	
)	
Pacella, Carmen)	
Registrant.)	

PETITION FOR CANCELLATION

Petitioner, Fender Musical Instruments Corporation ("Fender Musical"), a corporation established under the laws of Delaware, having an address at 8860 E. Chaparral Road Suite 100, Scottsdale, Arizona 85250, believes that it is being or will be damaged by the registration of the mark shown in the above-identified application, and hereby petitions for cancellation of registration of the mark within that application. In support of its Petition for Cancellation, Petitioner states as follows:

1. Fender Musical manufactures, sells and distributes musical instruments, including electric guitars and amplifiers for electric guitars using various trademarks including the mark FENDER.

2. Fender Musical or its predecessors in interest have used the mark FENDER continuously since at least as early as 1945, to identify its electric guitars and amplifiers, including the source and quality of those goods.

3. Fender Musical has sold in the United States many millions of dollars worth of products using the FENDER trademark. Based upon, inter alia, Fender Musical's

exclusive and continuous use of and advertising related to the FENDER trademark, the FENDER trademark has tremendous value to Fender Musical.

4. The FENDER trademark has been registered on the Principal Register of Trademarks in the United States Patent and Trademark Office since March 8, 1966, U.S. Reg. No. 805075 (FENDER Word-mark) for use in connection with electric guitars and amplifiers and related goods. On March 15, 1966, Fender Musical also obtained registration for its distinctive FENDER stylized logo. U.S. Reg. No. 805510 electric guitars and amplifiers and related goods. In accordance with 15 U.S.C. § 1065, both of the foregoing registrations have become incontestable.

5. Fender Musical has also used the FENDER trademark in connection with the sale and distribution of clothing products throughout the United States since at least as early as 1983. Fender Musical has obtained several registrations on the Principal Register of Trademarks in the United States Patent and Trademark Office for its FENDER word-mark and logo in connection with clothing products including:

FENDER Word-mark, U.S. Reg. No. 3060024, February 21, 2006;
FENDER Stylized, U.S. Reg. No. 2237850, April 6, 1999;
FENDER Stylized, U.S. Reg. No. 1715905, September 15, 1992.

In accordance with 15 U.S.C. § 1065, Registration Nos. 1715905 and 2237850 have become incontestable.

6. Fender Musical has also used and/or licensed the use of the FENDER trademark in connection with various services, including restaurant services and entertainment services such as live musical concerts in restaurant and bar settings.

7. Because of Fender's widespread and continuous use and promotion of the FENDER trademark, the FENDER trademark has become famous.

8. On April 8 2008, Registrant obtained U.S. Reg. No. 3410905 for the mark FENDER AVENUE BAR & GRILL (the "Disputed Mark"), for use in connection with the following goods and services:

Class No. 25: Clothes, namely, shirts, t-shirts, tank tops, sweatshirts, sweatpants, swim shorts, jackets, caps, hats, headbands, sun visors

Class No. 43: Restaurants; restaurant services.

9. Petitioner has not authorized Registrant to incorporate the term FENDER into the Disputed Mark or to use the FENDER trademark in any manner whatsoever.

COUNT I – Likelihood of Confusion

10. Petitioner incorporates and restates the allegations of paragraphs 1-9 hereof as if fully stated herein.

11. The Disputed Mark is likely to cause confusion, or to cause mistake, or to deceive consumers with respect to Petitioner's FENDER trademarks.

12. Based upon the foregoing averments, the continued registration of the Disputed Mark has caused or will cause damage to Petitioner.

13. The Disputed Mark should be cancelled pursuant to 15 U.S.C. § 1064(1).

COUNT II -- Dilution

14. Petitioner incorporates and restates the allegations of paragraphs 1-9 hereof as if fully stated herein.

15. Registrant's mark causes dilution of Petitioner's famous FENDER trademark.

16. Based upon the foregoing averments, the continued registration of Registrant's mark has caused or will cause damage to Petitioner.

17. The Disputed Mark should be cancelled pursuant to 15 U.S.C. § 1064(1).

COUNT III -- Abandonment

18. Petitioner incorporates and restates the allegations of paragraphs 1-9 hereof as if fully stated herein.

19. At a time subsequent to the registration of the Disputed Mark, Registrant sold and assigned all right title and interest in the Disputed Mark to a third party, along with the good will of the business in connection with which the Disputed Mark was used. Registrant has ceased using the Disputed Mark and has an intention not to resume use of the Disputed Mark.

20. The third-party assignee of the Disputed Mark has ceased using the Disputed Mark and has an intention not to resume use of the Disputed Mark.

21. The Disputed Mark has been abandoned and should be cancelled pursuant to 15 U.S.C. § 1064(3).

COUNT IV -- Abandonment

22. Petitioner incorporates and restates the allegations of paragraphs 1-9 hereof as if fully stated herein.

23. At a time subsequent to the registration of the Disputed Mark, Registrant sold to a third-party all right title and interest in the business in connection with which the Disputed Mark was used, but maintained ownership of the Disputed Mark.

24. After registrant sold the business in connection with which the Disputed Mark was used, the third-party purchaser of the business continued to use the Disputed Mark for several months. During that period, Registrant exercised no control over the nature or quality of the use of the Disputed Mark by the third-party purchaser of the business.

25. As a result of Registrant's failure to exercise control over the nature or quality of the use of the Disputed Mark, the Disputed mark has lost its significance as a mark.

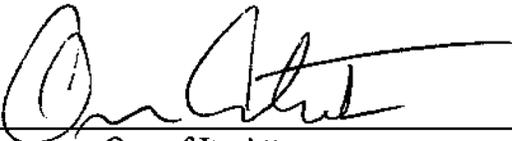
26. The Disputed Mark has been abandoned and should be cancelled pursuant to 15 U.S.C. § 1064(3).

WHEREFORE, Petitioner requests that Registration No. 3410905 be cancelled and that this Petition be sustained.

Petitioner hereby appoints Oscar L. Alcantara of the firm GOLDBERG, KOHN, BELL, BLACK, ROSENBLOOM & MORITZ, LTD. its Attorney of Record in the matter of the above captioned Petition for Cancellation to prosecute this Petition to transact all business with the United States Patent and Trademark Office and the United States Courts connected with this Petition, and to sign his name to all papers which may hereafter be filed in connection with this Petition for Cancellation and to receive the official communications relating to this Petition.

Respectfully Submitted,

FENDER MUSICAL INSTRUMENTS
CORPORATION

By  _____
One of Its Attorneys

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