

ESTTA Tracking number: **ESTTA773822**

Filing date: **09/29/2016**

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

|                           |   |
|---------------------------|---|
| Proceeding                | 92064181  |
| Party                     | Plaintiff<br>Andrew R Flanders  |
| Correspondence<br>Address | ANDREW R FLANDERS<br>4406 S 189TH ST<br>SEATAC, WA 98188<br>UNITED STATES<br>andrewflanders@gmail.com |
| Submission                | Other Motions/Papers  |
| Filer's Name              | Jeffrey A. Nelson   |
| Filer's e-mail            | jnelson@cairncross.com  |
| Signature                 | /Jeffrey A. Nelson/   |
| Date                      | 09/29/2016  |
| Attachments               | Motion to Amend Petition for Cancellation 92064181.pdf(62197 bytes )                                  |

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

Andrew R. Flanders

Petitioner,

v.

DiMarzio, Inc.,

Registrant.

Cancellation No. 92064181

Registration No. 1,169,205

**MOTION TO AMEND PETITION FOR CANCELLATION**

Pursuant to Federal Rule of Civil Procedure 15(a)(1)(B) and 37 C.F.R. §2.115, Petitioner, Andrew R. Flanders, through its counsel, hereby moves the Board for leave to amend its Petition for Cancellation (the “**Petition**”). The grounds for Petitioner’s motion are as follows:

Petitioner filed its original Petition against US Registration No. 1,169,205 (the “**Registration**”) on August 3, 2016. On September 9, 2016, in lieu of filing an Answer, Registrant, DiMarzio, Inc., filed a Motion to Dismiss the Petition, alleging that Petitioner does not have standing to seek cancellation of the Registration. However, Petitioner has standing, as demonstrated by the Amended Petition for Cancellation, attached as Exhibit A.

The Federal Rules of Civil Procedure provide that a party may amend its pleadings as a matter of course when a motion under Rule 12(b) has been filed in response to such pleading. Fed. R. Civ. P. 15(a)(1)(B). Rule 15 of the Federal Rules of Civil Procedure further provides that leave to amend pleadings must be freely given when justice requires. Fed. R. Civ. P. 15(a). Moreover, the Board liberally grants leave to amend pleadings, unless it would violate settled law or prejudice the non-moving party. *Zanella Ltd. v. Nordstrom, Inc.*, 90 U.S.P.Q.2d 1758 (TTAB 2008).

Here, leave to amend the Petition to more clearly set forth Petitioner's standing would neither violate settled law nor prejudice Registrant. Petitioner's proposed Amended Petition for Cancellation is made in direct response to Registrant's Motion to Dismiss made pursuant to Rule 12(b)(6). This Cancellation was only recently instituted by Petitioner and Registrant has not yet filed an Answer to the Petition. Further, the mark that is the subject of the Registration is presently in use by Registrant, without encumbrance from Petitioner. Thus, accepting Petitioner's amended Petition does not present any prejudice to Registrant or violate settled law.

Based on the foregoing, Petitioner respectfully requests that the Board grant this Motion and accept the Amended Petition for Cancellation filed herewith.

Dated: September 29, 2016

Respectfully submitted,



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Jeffrey A. Nelson  
Cairncross & Hempelmann  
524 2<sup>nd</sup> Avenue, Suite 500  
Seattle, Washington 98104

Attorney for Petitioner

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing document is being served upon Registrant's counsel, Brent M. Davis, Esq., 1100 Valley Brook Ave., Lyndhurst, NJ 07071, this 29<sup>th</sup> day of September, 2016, by First Class Mail, postage prepaid.



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Jeffrey A. Nelson

## **EXHIBIT A**

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

Andrew R. Flanders

Petitioner,

v.

DiMarzio, Inc.,

Registrant.

Cancellation No. 92064181

Registration No. 1,169,205

**AMENDED PETITION FOR CANCELLATION**

Petitioner, Andrew R. Flanders, an individual located at 4406 S. 189<sup>th</sup> St., Seatac, WA 98188, believes he is damaged by registration of the design mark that is the subject of US Registration No. 1,169,205 (the “**Registration**”), owned by DiMarzio, Inc. (“**Registration**”), a New York corporation with its principal place of business located at 1338 Richmond Terrace, Staten Island, New York 10310, and hereby files this Amended Petition to Cancel the Registration.

As grounds for cancellation, Petitioner alleges that:

**I. INTRODUCTION**

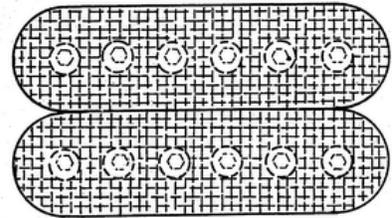
1. A “humbucker” is a type of electric guitar pickup that is used to cancel out the interference, or “hum,” created when a musician strums the metal strings on an electric guitar.
2. Humbucker pickups are typically mounted onto an electric guitar with metal or plastic mounting rings, the most common colors of which are black and cream.

3. Cream-colored components are frequently used on electric guitars, and are highly sought after by guitar owners who, for example, are attempting to create a particular chromatic aesthetic, have the need to restore, or recreate the aesthetic of vintage classic electric guitars, such as the 1959 Gibson Les Paul.
4. Further, it is common for guitar owners to seek to match the colors of the various components on their electric guitars, including matching the colors of their humbucker pickups and mounting rings.
5. Various manufacturers offer aftermarket humbucker pickups in a variety of colors in order to allow guitar owners to select pickups that are aesthetically pleasing and that match the mounting rings and other components of the guitar. However, one manufacturer – Registrant – allegedly holds the exclusive right to offer cream-colored humbucker pickups due to the Registration that is the subject of this proceeding.

## II. THE 205 MARK

6. Registrant owns the Registration for the design mark shown at right and described in the Registration thusly:

“The mark comprises the double design representation of an electronic sound pickup for guitars, which is



disclaimed apart from the mark as shown, and is lined for the color yellow which resembles the distinctive shade of cream” (the “**205 Mark**”).

7. The goods identified in the Registration are “electronic sound pickup for guitars” in Class 15 (hereafter “**Registrant’s Goods**”).
8. In the market, based on the Registration for the 205 Mark, Registrant asserts exclusive rights to use and offer for sale of pickups which consist solely of the color cream.

### **III. PETITIONER**

9. Petitioner is a musician who owns and regularly purchases electric guitars and guitar parts, including cream-colored mounting rings, pickups, and other components.
10. Petitioner has a particular desired aesthetic for such guitars which necessitates humbucker pickups consisting of only the color cream to match certain mounting rings. Humbucker pickups that are not solely cream do not blend with the guitars, causing the pickup to stand out, visually.
11. However, due to the 205 Mark and the Registration, by which Registrant asserts exclusive rights to use and offer for sale pickups featuring only the color cream, Petitioner is limited to purchasing humbucker pickups from Registrant to achieve his desired aesthetic.
12. Not only is Petitioner unable to purchase his preferred brand of humbucker pickups in the desired cream color, but Petitioner is unable to have his preferred brand of humbuckers pickups custom manufactured in the color cream due to Registrant's assertions of exclusive rights to pickups featuring only the color cream arising from the Registration.
13. This limitation harms Petitioner because he is not able to achieve his desired aesthetic by means of a fair market, and is forced to either compromise his aesthetic by purchasing non-matching pickups from another vendor, or else sacrifice the quality and price he desires in order to achieve desired aesthetic of the cream-colored pickup.
14. Petitioner is a member of a community of musicians and purchasers of guitar parts who are similarly hindered in seeking cream-colored humbucker pickups due to Registrant's assertion of exclusive rights arising from the Registration.

**IV. THE 205 MARK IS FUNCTIONAL**

15. *15 USC §1052(e)(5)* states that “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . comprises any matter that, as a whole, is functional.”
16. The color cream, as described in the Registration, is aesthetically functional for pickups because guitar owners desire components of their electric guitars, including, without limitation, the mounting rings and pickups, that match in color.
17. Registrant’s exclusive hold on guitar pickups consisting solely of the color cream hinders competition in the market of guitar accessory manufacturers which in turn harms Petitioner and other guitar owners who are thereby effectively limited to purchasing Registrant’s cream-colored guitar pickups or having a pickup that does not meet their desired aesthetic.

WHEREFORE, Petitioner respectfully requests that the Registration be cancelled and that this Petition to Cancel be sustained.

Dated: September 29, 2016

Respectfully submitted,



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Jeffrey A. Nelson  
Cairncross & Hempelmann  
524 2<sup>nd</sup> Avenue, Suite 500  
Seattle, Washington 98104

Attorney for Petitioner

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing document is being served upon Registrant's counsel, Brent M. Davis, Esq., 1100 Valley Brook Ave., Lyndhurst, NJ 07071, this 29<sup>th</sup> day of September, 2016, by First Class Mail, postage prepaid.



Jeffrey A. Nelson