

ESTTA Tracking number: **ESTTA11662**

Filing date: **07/14/2004**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Behringer USA, Inc.
Granted to Date of previous extension	07/14/2004
Address	Behringer USA, Inc. 190 West Dayton Avenue Suite 201 Edmonds, WA 98020 UNITED STATES

Attorney information	Jennifer J. Baumann Brinks Hofer Gilson & Lione 455 N Cityfront Plaza Dr NBC Tower - Suite 3600 Chicago, IL 60611 UNITED STATES officeactions@brinkshofer.com Phone:3123214200
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Applicant Information

Application No	76516127	Publication date	03/16/2004
Opposition Filing Date	07/14/2004	Opposition Period Ends	07/14/2004
Applicant	Fender Musical Instruments Corporation		

Goods/Services Affected by Opposition

Class 015. First Use: 19510000 First Use In Commerce: 19570000
All goods and services in the class are opposed, namely: Guitar bodies

Opposition to serial no. 76/515,928 and opposition to serial no. 76/516,126.

Attachments	12318-7 Notice of Opposition 071404.pdf (4 pages)
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Signature	/Jennifer J. Baumann/
Name	Jennifer J. Baumann
Date	07/14/2004

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

In The Matter of: Application Serial No. 76/516,127
Trademark: Miscellaneous Design
Goods: Guitar bodies
Published: March 16, 2004 (TM 247)

Behringer USA, Inc.,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
Fender Musical Instruments Corp.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Behringer USA, Inc., a Washington corporation, having its principal place of business in Edmonds, Washington ("Opposer"), believes that it will be damaged by the registration of Serial No. 76/516,127, applied for by Fender Musical Instruments Corporation, a Delaware corporation, with a place of business in Scottsdale, Arizona ("Applicant"), and hereby opposes said application for registration.

As grounds for the Opposition, Opposer states as follows:

1. Opposer, directly and through related companies, has been engaged in the business of marketing and selling musical instruments in interstate commerce, namely, guitars and related goods.
2. Upon information and belief, Applicant also is engaged in the business of marketing and selling musical instruments in interstate commerce, namely, guitars and related goods.
3. Opposer and Applicant are competitors with respect to the marketing and sale of guitars.
4. Applicant owns Application Serial No. 76/516,127, which covers the design of a guitar body ("Applicant's Design"). The application was published for opposition in the *Official Gazette* on March 16, 2004.
5. A number of other entities, including Opposer, have used and are using decorative and ornamental designs for guitar bodies. Like Applicant's Design, these other designs have been used and are used in a decorative manner defining the shape of the guitars. As a result of this widespread use of such decorative designs, the consuming public perceives Applicant's Design merely as a decorative or ornamental feature of the goods and not as an indicator of the source of the goods. Thus, Applicant's Design does not function as a mark as required under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127.
6. Moreover, even if Applicant's Design was capable of functioning as a trademark, Applicant's evidence submitted in support of its request for registration under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), is insufficient. Applicant's Design

has not been used substantially exclusively, and has not become distinctive of the Applicant's goods in commerce.

7. Applicant's course of conduct has caused Applicant's Design to become generic. Applicant has failed to adequately police third-party use of designs similar to, or identical to, Applicant's Design. Therefore, Applicant's Design is not recognized as an indication of source and cannot be registered as a trademark. Thus, Applicant's Design does not function as a mark as required under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 and 1127.

8. Even if Applicant's Design at one time functioned as a mark, Applicant's Design has become abandoned due to a course of conduct that has caused it to lose significance as an indication of source. Applicant has failed to adequately police third-party use of designs similar to, or identical to, Applicant's Design. Therefore, Applicant has abandoned its rights in Applicant's Design as defined in Section 45 of the Lanham Act, 15 U.S.C. § 1127.

9. Registration of Applicant's Design would provide Applicant with *prima facie* evidence of an exclusive right to use Applicant's Design in commerce on or in connection with the applied-for goods. Consequently, Opposer will be seriously damaged by registration of Applicant's Design because a registration could be used to inhibit and interfere with Opposer's right to use a similar guitar body shape in connection with guitars or other goods related to those identified in Application Serial No. 76/516,127.

WHEREFORE, Opposer, Behringer USA, Inc., prays that its Opposition be sustained and that Application Serial No. 76/516,127 be denied registration.

The filing fee for this Opposition, in the amount of three hundred dollars (\$300.00), is enclosed. This document is submitted in duplicate.

Respectfully submitted,

BEHRINGER USA, INC.,

Dated: July 14, 2004

By: Jennifer J. Baumann

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