

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
Published in the Official Gazette on March 16, 2004

TTAB

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HOSHINO GAKKI CO., LTD. and
HOSHINO USA INC.,

Opposers,

Opposition No.

v.

FENDER MUSICAL INSTRUMENTS CORPORATION,
Applicant.
-----X

NOTICE OF OPPOSITION

Opposer Hoshino Gakki Co., Ltd. (hereinafter referred to as "Hoshino Gakki"), a corporation organized and existing under the laws of Japan, with its principal place of business at No. 22, 3-Chome, Shumoku-Cho, Higashi-Ku, Nagoya, 461-8717 and Opposer Hoshino USA Inc. (hereinafter referred to as "Hoshino USA"), a corporation organized and existing under the laws of Pennsylvania, having a place of business at 1726 Winchester Road, Bensalem, Pennsylvania 19020 believe that they would be damaged by the issuance of a registration for the miscellaneous design mark as applied for in Application Serial No. 76/516,127, filed April 25, 2003, for "guitar bodies" in Class 15, and therefore oppose the same. As grounds for its opposition, Opposers, by their attorneys Ostrolenk, Faber, Gerb & Soffen, LLP, allege as follows:

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FACTS COMMON TO ALL COUNTS

1. Opposer Hoshino Gakki manufactures guitars and related musical goods sold around the world and in the United States under the well-known trademark IBANEZ.



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U.S. Patent & TMO/TM Mail Rpt Dt. #22

2. Opposer Hoshino USA, a company owned by Opposer Hoshino Gakki, is the U.S. importer and distributor of Hoshino Gakki's IBANEZ branded guitars and related musical goods.

3. Upon information and belief, Applicant Fender Musical Instruments Corporation (hereinafter referred to as "Applicant") manufactures and sells guitars and related musical goods in the U.S.

4. Upon information and belief, Opposers Hoshino Gakki and Hoshino USA (hereinafter collectively referred to as "Opposers") and Applicant are competitors in the guitar industry in the U.S.

5. Upon information and belief, the design sought to be registered in U.S. application serial number 76/516,127 (hereinafter referred to as the "Design") covers the appearance of the body of Applicant's "Precision" bass.

6. Opposers will be seriously damaged and injured by registration of the Design for guitar bodies.

COUNT I - FUNCTIONALITY

7. The Design is essential to the use and purpose of guitar bodies.

8. The Design affects the cost and quality of guitar bodies.

9. Exclusive use of the Design by Applicant would put competitors such as Opposers at a significant non-reputation-related disadvantage.

10. The Design is functional and unregistrable within the meaning of 15 U.S.C. § 1052(e)(5).

COUNT II - LACK OF ACQUIRED DISTINCTIVENESS

11. Consumers would not regard the Design as a source identifying feature.

12. The Design does not function as a trademark to designate Applicant as the exclusive source of origin of the guitar bodies bearing or incorporating the Design.

13. The Design lacks acquired distinctiveness within the meaning of 15 U.S.C. § 1052(f).

COUNT III - GENERICNESS

14. The primary significance of the Design to the relevant public is to designate a style of a guitar body, not Applicant.

15. Opposers, and others in the industry, commonly use designs similar to the Design for bodies for guitars.

16. The Design does not identify Applicant as the source of origin for the guitar bodies set forth in the application.

17. Applicant does not have the right to foreclose Opposers, or others in the relevant trade, from using the Design or similar designs in connection with the manufacture and sale of guitars and/or guitar bodies.

18. The Design is generic in connection with the goods set forth in the application in violation of 15 U.S.C. § 1064(3) and, as such, is unprotectable and unregistrable as a trademark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by application S.N. 76/516,127 be denied.

The opposition fee in the amount of \$600.00 for one class for two opposers is filed herewith. If for any reason this amount is insufficient, it is requested that Opposers' attorneys' deposit account No. 15-0700 be charged with any deficiency. This paper is filed in duplicate.

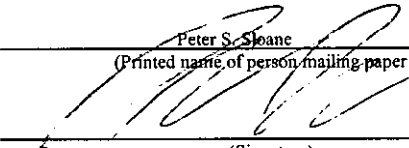
Date: New York, New York
September 13, 2004

"Express Mail" mailing label No. EV325557549US

Date of Deposit: September 13, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

Peter S. Sloane
(Printed name of person mailing paper or fee)


(Signature)

Respectfully submitted,


Douglas A. Miro
Peter S. Sloane

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Attorneys for Opposers

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COUNT II - LACK OF ACQUIRED DISTINCTIVENESS

11. Consumers would not regard the Design as a source identifying feature.
12. The Design does not function as a trademark to designate Applicant as the exclusive source of origin of the guitar bodies bearing or incorporating the Design.
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17. Applicant does not have the right to foreclose Opposers, or others in the relevant trade, from using the Design or similar designs in connection with the manufacture and sale of guitars and/or guitar bodies.
18. The Design is generic in connection with the goods set forth in the application in violation of 15 U.S.C. § 1064(3) and, as such, is unprotectable and unregistrable as a trademark.

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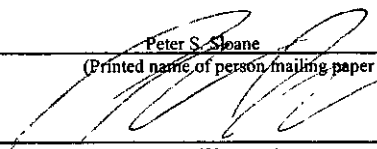
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