

Hearing:  
March 24, 2009

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
June 10, 2009  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gibson Guitar Corp.  
v.  
Concordia Investment Partners, Inc.

Opposition No. 91170847  
against Serial No. 76619498

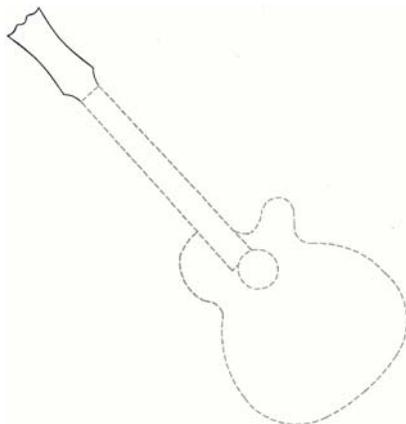
Robert P. Felber, Jr. and Heather J. Hubbard of Waller  
Lansden Dortch & Davis, LLP for Gibson Guitar Corp.

Arthur W. Fisher, III of A.W. Fisher, III P.A. for Concordia  
Investment Partners, Inc.

Before Bucher, Holtzman and Walsh, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

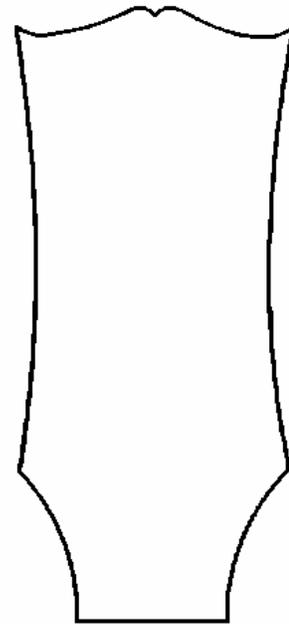
Concordia Investment Partners, Inc. seeks registration  
on the Principal Register of the following mark:



<sup>1</sup> Application Serial No. 76619498 was filed on November 5, 2004 based upon applicant's claims of first use anywhere and first use in commerce at least as early as 1997. The matter shown by the dotted lines is not a part of the mark and serves

for "guitars" in International Class 15.

Gibson Guitar Corp. alleges that for many years prior to any date that applicant can rely upon it has adopted and continuously used a similar headstock design as a trademark for its guitars. Opposer's design, known in the industry as the "Dove Wing Peg Head," has been used by opposer and its predecessors in interest since at least as early as 1922, and is the subject of an incontestable trademark registration.



Opposer alleges that applicant's mark, when used in connection with the identified goods so resembles its headstock design as to be likely to cause confusion, to cause mistake or to deceive, under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

In its answer, applicant denied all the essential allegations of the notice of opposition.

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only to show the position of the mark. Applicant claimed that the mark has become distinctive under Section 2(f) of the Act as applied to its goods by reason of substantially exclusive and continuous use thereof as a trademark by applicant in interstate commerce for five years before the date on which this claim of distinctiveness was made.

<sup>2</sup> Registration No. 1020485 issued for "string instruments" in International Class 15 on September 16, 1975, without resort to the provisions of Section 2(f) of the Trademark Act; second renewal. The mark represents a design for a peg head profile.

Although this proceeding was consolidated *sua sponte* by the board with Opposition Nos. 91156480 [Gibson's split headstock versus Concordia V-shaped headstock and ML guitar body] and 91156482 [Gibson's split headstock versus Concordia V-shaped headstock] on March 14, 2008, given the difference in the nature of opposer's claims, we have decided it will be clearer to issue two separate opinions.

***I. The Record***

In addition to the pleadings and the file of the involved application, the record also includes the trial transcript of David H. Berryman, president of Gibson Guitar, Corp., taken on March 15, 2007 ("2007 Berryman Test.") and again on April 8, 2008 ("2008 Berryman Test."), along with the related exhibits; opposer's notice of reliance, filed on April 14, 2008, making of record certain of applicant's responses to opposer's requests for admissions and responses to interrogatories. Applicant filed a notice of reliance on June 13, 2008, making of record certain of opposer's responses to requests for admissions and responses to interrogatories, a third-party registration, and a trademark assignment abstract from a third party to applicant. Although applicant indicated it would be filing a discovery deposition of applicant's witness, Elliot Rubinson, and specifically noticed the taking of his

testimony deposition, the record appears to contain transcripts of neither.

Both parties filed briefs, and opposer filed a reply brief. Only applicant was represented at a hearing before this panel of the Board on March 24, 2009.

## ***II. Factual Findings***

Opposer has been in business since 1894 making fretted instruments - namely, guitars, banjos, mandolins, etc.

2007 Berryman Test. at 6 - 7. The dove wing peg head or headstock is a shape

that opposer developed in 1922. Since 1952, this headstock shape has been a prominent component of Gibson's



guitars, including substantially all the popular Les Paul guitar models.

As noted above, applicant has been applying its headstock design to guitars since at least as early as 1997.

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<sup>3</sup> See 2007 Berryman test., Exhibit O-3.

### **III. Analysis**

#### **A. Opposer's Standing and Priority**

Opposer's standing is a threshold inquiry made by the Board in every *inter partes* case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be (is) damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Opposer has properly made its pleaded registration of record. We consider this sufficient to establish opposer's interest and, therefore, standing to oppose registration of applicant's mark, in this proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Moreover, because opposer has established that it owns a valid and subsisting registration of its pleaded mark, Section 2(d) priority is not an issue in this case as to the mark therefor and the goods covered thereby. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400,

182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Moreover, we note that nowhere does applicant contest either opposer's standing to bring this proceeding or its priority of use.

***B. Likelihood of Confusion***

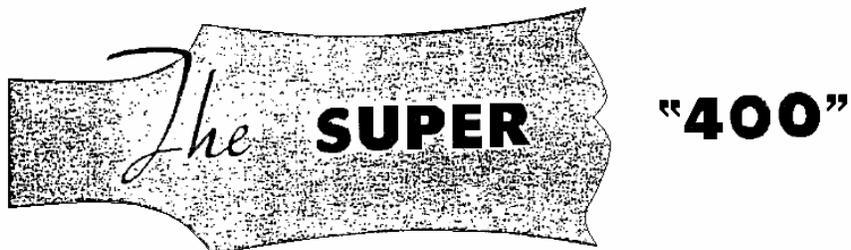
We turn, then, to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Our determination must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

***Renown of opposer's mark***

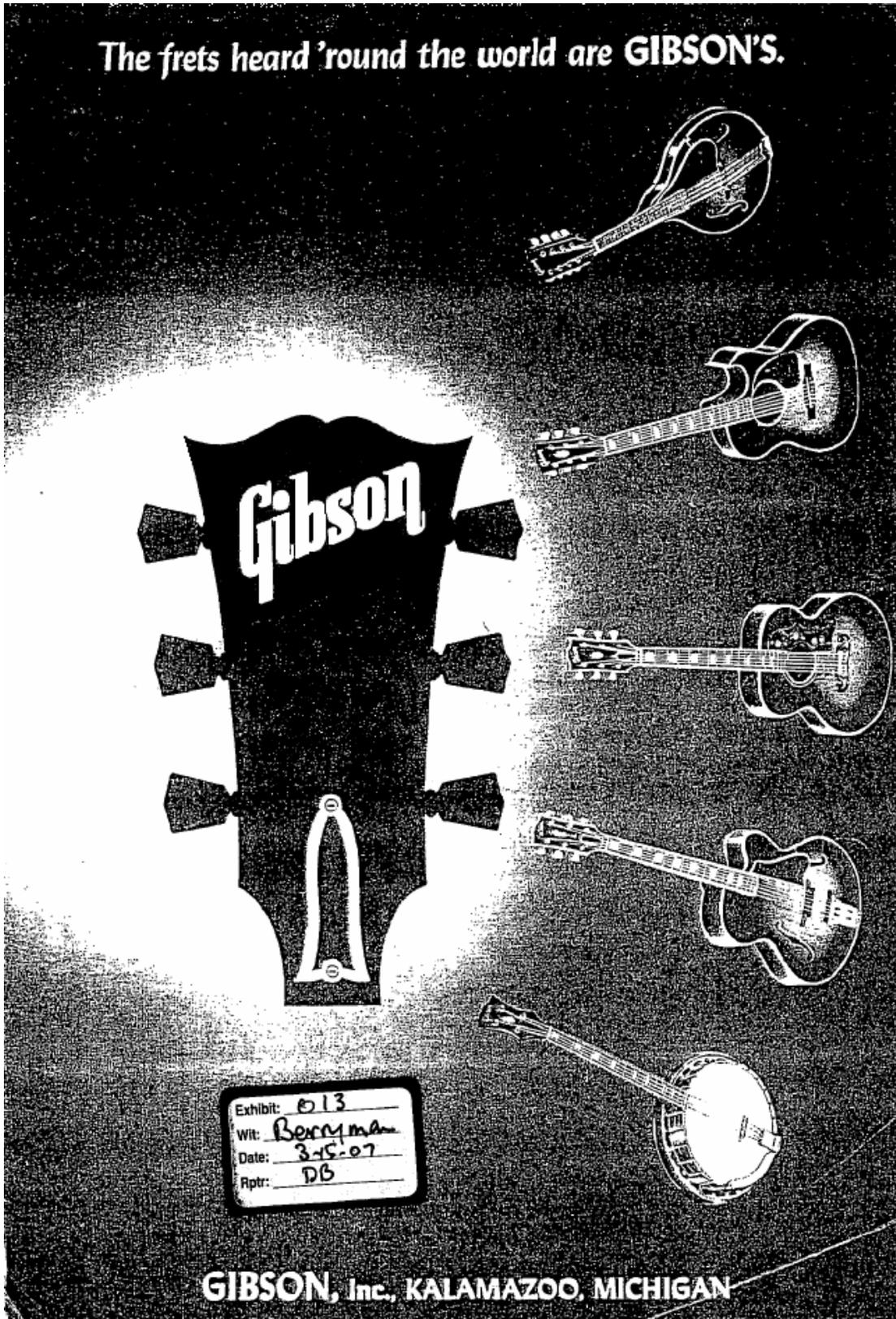
The first *du Pont* factor we consider is the factor of fame. The fame of the prior mark plays a dominant role in

likelihood of confusion cases featuring a famous mark. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Fame for likelihood of confusion purposes arises "as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

The record documents in detail opposer's long history and extensive sales of the dove wing headstock. For example, each year between 1997 and 2005, opposer sold between 45 and 90 thousand guitars having a dove wing headstock. Exhibit O-6. The record is replete with Gibson's prominent usage of the silhouette shape of the involved headstock shape over the years. Clearly, opposer has heavily promoted this shape, and features it as a mark.

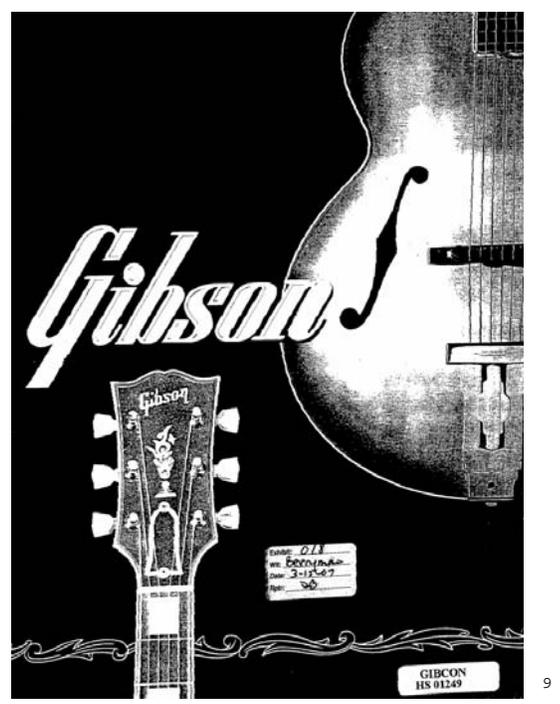
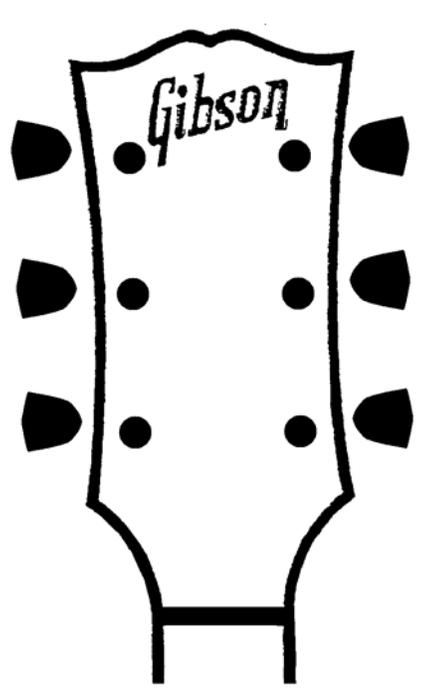


<sup>4</sup> Bates No. HS01137, Exhibit O-13, 1954.



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<sup>5</sup> Bates No. HS01134, Exhibit O-13, 1954/



6 Bates No. HS01138, Exhibit O-13, 1954.  
7 Bates No. HS01149-50, Exhibit O-13, 1954.

# GIBSON PRICE LIST

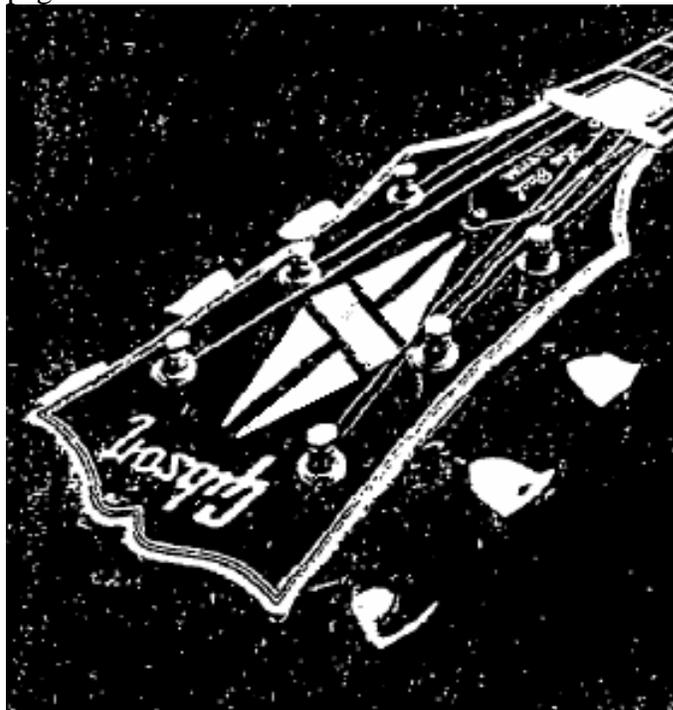
MAY 1, 1974

ZONE 1



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PEGHEAD – Beautifully designed mother-of-pearl inlays and gold plated machine heads add an air of distinction to the distinctive Les Paul Custom Guitar peghead.



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- <sup>8</sup> Bates No. HS00932, Exhibit O-39, 1971.  
<sup>9</sup> Bates No. HS01249, Exhibit O-18, 1956.  
<sup>10</sup> Bates No. HS01015, Exhibit O-45, 1974.  
<sup>11</sup> Bates No. HS00175, Exhibit O-45, 1974.

Accordingly, on this record, we find for purposes of our likelihood of confusion analysis, that this particular headstock design is both distinctive and famous in connection with guitars and has long been synonymous with the Gibson brand. *Bose*, 63 USPQ2d at 1305. The Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1456. Hence, we find that the *du Pont* factor focusing on fame weighs heavily in favor of finding a likelihood of confusion herein.

### *The Goods*

We now consider the relatedness of the parties' respective goods. Opposer's "stringed instruments" having the dove wing headstock design includes guitars, banjos, and mandolins. Inasmuch as applicant seeks registration of its mark for use in connection with "guitars," we have to assume applicant is in direct competition with opposer in the marketing of guitars. The fact that the goods are legally identical, in part, is also a strong factor in favor of finding a likelihood of confusion herein.

*Trade channels and conditions of purchase*

Inasmuch as there are no restrictions on applicant's or opposer's guitars, we have to assume they could both include the complete range of such stringed musical instruments, all the way down to the entry level instrument for the first-time guitar player. In fact, Mr. Berryman testified to the fact that opposer's own Epiphone brand instruments and applicant's least expensive guitars can be purchased at retail for prices as low as \$25 to \$100. While this may well be more expensive than many consumer items this Board is called upon to consider, we cannot assume that all purchasers will be sophisticated or exercise an extremely high degree of care in making a guitar purchase, and especially at the lower price points. We must presume that these guitars will be available at music stores to all classes of consumers, including ordinary purchasers of a first guitar. These related *du Pont* factors also favor the position of opposer that there is a likelihood of confusion.

*Actual Confusion*

The absence of any known examples of actual confusion, as reported by both parties, does not compel a different result in our likelihood of confusion analysis. Although neither party is aware of any actual confusion, evidence of

actual confusion is not essential to proving a case of likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Most importantly, the record contains no information about the volume of guitars that applicant has marketed since 1997 using this headstock design. At best for applicant, this is a neutral factor.

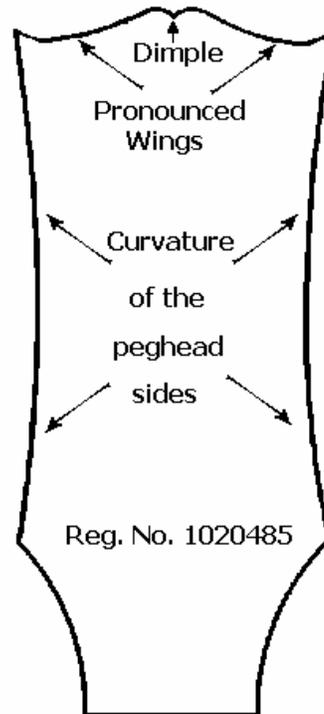
### *The marks*

We consider then the similarity or dissimilarity of the marks. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We begin our analysis of this factor mindful of the fact that as the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

On this critical factor, the parties have argued their opposite positions at length, using quite different verbal characterizations of these two headstock designs.

Mr. Berryman named three attributes of the Gibson headstock design that allegedly make it distinctive and readily recognizable in the industry: the dimple and the dove wings on the top, and the curvature of the sides, identified in the drawing created by the Board for illustration purposes (shown at right).



Applicant, in its brief and at oral hearing, contrasts the two designs in language that reads like patent claims:

... Applicant views Opposer's dove wing headstock as a boxy body including a pair of slightly concave side surfaces having a lower transitional portion including a pair of arcuate surfaces extending between the corresponding slightly concave side surfaces and the corresponding sides of the guitar neck and a contoured top surface including a pair of outer elongated concave surfaces extending inwardly from the corresponding slightly concave side surfaces with a slight or shallow inner depression or indentation at the intersection thereof that form an inner convex or raised surface extending inwardly from the opposite slightly concave side surfaces.

...

Applicant's headstock has an hourglass body including a pair of bow-like concave side surfaces having a lower transitional portion including a pair of arcuate surfaces extending inwardly from the corresponding bow-like concave side surfaces to join with the corresponding sides of the guitar neck and an undulating top surface defined by three (3) concave surfaces, deep center concave surface or recess disposed between two (2) side concave surfaces or recesses, joined or interrupted by two (2) convex surfaces or peaks with the deep center concave surface or recess disposed at the center of the undulating top surface.

...

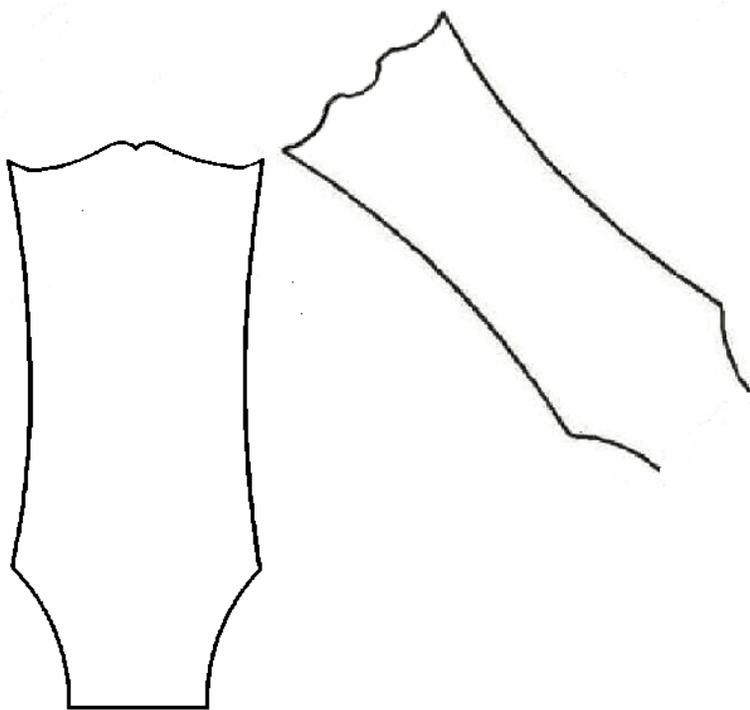
The Opposer's boxy profile and Applicant's contrasting hourglass profile is attributable to the comparable ratios of the length of the body to the overall length of the headstocks and the comparable ratios of width to overall length of the headstocks. The ratio of the length of the body to the overall length of Opposer's headstock is approximately 0.70; while, the ratio of the length of the body to the overall length of Applicant's headstock is approximately 0.85. The width to overall length of Opposer's and Applicant's headstocks are approximately 0.40 and 0.32 respectively. In other words, Applicant's headstock is longer and thinner in relative terms creating the hourglass profile of Applicant's headstock over the boxy profile of Opposer's headstock.

Equally significant is the shape or configuration of the undulating top surface of Applicant's headstock versus the slight or shallow center indentation of Opposer's headstock. In particular, the root or bottom of the deep center concave surface or recess extends below the two (2) concave side surfaces or recesses into the body resulting in a significant vertical distance between peaks or apexes of the pair of two (2) convex surfaces and the root or bottom of the deep center concave surface or recess.

Perhaps not surprisingly, in comparing the same two images, opposer concludes that they are quite similar:

The primary attributes of Gibson's dove wing headstock are the dimple at the top and center of the headstock with the curved and pronounced wings extending out from the center. Applicant is attempting to register a mark that prominently features these same "wings" but with a slightly different center dimple. The slight variation of the center cut does not negate the similarities between the two designs.

Of course, in the marketplace, consumers often do not have the luxury of side-by-side comparisons of these two designs, and so the test does not assume the same.



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And apart from all the verbiage above, this determination really turns on a visual, and arguably subjective, comparison of the two headstock designs. It is true that

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<sup>12</sup> We note that in applicant's drawing, the body and neck are depicted in dotted lines in order to show the position of the headstock in relation to the balance of the guitar. This graphic simply juxtaposes the two headstocks, having been sized at a similar scale, and without showing applicant's guitar neck and body.

applicant's headstock (on the right above) is thinner, although both could correctly be characterized as having an hourglass figure. On the other hand, contrary to applicant's characterization, opposer's image (on the left above) does not strike us as "boxy." Both have pronounced wings on the top surface, although applicant's larger and rounded, concave center "dimple" does create a series of roughly-equal peaks and valleys accurately described as "undulating."

Despite the fact that this is a fairly extensive record, it is not clear how varied are the cuts of guitar headstocks that are being offered in the marketplace. Nonetheless, we find that applicant, in designing the undulating curved top of its peg head, has simply approached too closely to the well-known source-indicator of a competitor.

### *The nature of other guitar headstock designs*

Applicant has focused substantially none of its evidence or arguments on the *du Pont* factor described as "the number and nature of similar marks in use on similar goods." As one of the major players in this industry, it seems that for almost a century now, opposer and its predecessors in interest have purposely configured many of its guitar headstocks with this unique cut to signify origin

with Gibson. Furthermore, this practice is consistent with the overall custom in the trade, respected by others such as Fender, Martin, Ovation, Hoshino and Guild,<sup>13</sup> each of whom also pursued distinct cuts of their respective headstocks as source indicators. Applicant adopted the curved top of its headstock aware of this industry practice and being fully apprised of opposer's famous dove wing peg head design.

### **Conclusion**

In balancing all the relevant *du Pont* factors, we find that inasmuch as opposer's registered headstock design is both distinctive and famous in connection with guitars, applicant has simply approached too closely to the well-known trademark of a competitor in designing the undulating curved top of its peg head.

*Decision:* The opposition is sustained and registration to applicant is hereby refused.

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<sup>13</sup> See 2007 Berryman test, at 8; "Tell Tchaikovsky the News: Trade Dress Rights in Musical Instruments," by Robert M. Kunststadt and Ilaria Maggioni, 94 TMR 1271, 1276-78 (2004); *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 231 USPQ 926, 933-34 (TTAB 1986); aff'd at 840 F.2d 1572, 6 USPQ2d 1001, 1010 (Fed. Cir. 1988).