

ESTTA Tracking number: **ESTTA365004**

Filing date: **08/25/2010**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	ESP Shibuya Enterprises, Inc.
Granted to Date of previous extension	09/01/2010
Address	10913 Vanowen Street Hollywood, CA 91605 UNITED STATES

Name	ESP CO., LTD.		
Entity	Corporation	Citizenship	JAPAN
Address	1-14-2, Kanda Nishikico Chiyoda-ku Tokyo, JAPAN		

Attorney information	Ronald S. Bienstock Bienstock & Michael 411 Hackensack Avenue7th Floor Hackensack, NJ 07601 UNITED STATES ip@musicesq.com
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**Applicant Information**

Application No	77759785	Publication date	05/04/2010
Opposition Filing Date	08/25/2010	Opposition Period Ends	09/01/2010
Applicant	Essential Sound Products, Inc. P.O. Box 81998 Rochester, MI 483081998 UNITED STATES		


**Goods/Services Affected by Opposition**

Class 009. First Use: 1993/01/02 First Use In Commerce: 1995/06/12 All goods and services in the class are opposed, namely: A/C power cords, A/C multiple power outlet strip, A/C plugs and outlets, A/C power line conditioners, A/C power surge suppressors, male and female IEC electrical connections and jacks, and audio and video electronic cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market
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**Grounds for Opposition**

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

## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1205405	Application Date	11/07/1980
Registration Date	08/17/1982	Foreign Priority Date	NONE
Word Mark	ESP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 015. First use: First Use: 1975/02/15 First Use In Commerce: 1976/03/21 Electric Guitars and Structural Parts Thereof		

Attachments	73285121#TMSN.gif ( 1 page )( bytes ) ESP Not of Opp - 785.pdf ( 8 pages )(824837 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	/thesuit/
Name	Ronald S. Bienstock
Date	08/25/2010



As grounds for its opposition, Opposers hereby allege as follows:

1. Upon information and belief, Applicant is a corporation established under the laws of Michigan and having an address at P.O. Box 81998 Rochester, Michigan 48308.

**APPLICANT'S TRADEMARK APPLICATION  
FOR ITS PROPOSED MARK**

2. Applicant seeks to register the Proposed Mark as a trademark in International Class 9 for "A/C power cords, A/C multiple power outlet strip, A/C plugs and outlets, A/C power line conditioners, A/C power surge suppressors, male and female IEC electrical connections and jacks, and audio and video electronic cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market."

3. Applicant filed Trademark Application Serial No. 77/759785 (the "Application") for registration of the Proposed Mark in the United States Patent and Trademark Office ("USPTO") on June 15, 2009.

4. According to the Application, the Proposed Mark was first used on January 2, 1993 and first used in commerce in connection with International Class 09 goods on June 12, 1995.

5. The Proposed Mark contains literal and design elements that are strikingly similar, if not the legal equivalent, to Opposers' Trademark Registration No. 1,205,405 (the "ESP Mark").

6. On May 4, 2010, the Application was published for opposition.

7. On May 28, 2010, Opposers were granted a 30 day extension of time to oppose the registration of the Proposed Mark.

8. On June 29, 2010, Opposers were granted a further 60 day extension of time for good cause to oppose the registration of the Proposed Mark.

#### **OPPOSERS AND THEIR REGISTERED TRADEMARK**

9. Since at least 1976, ESP Co. has engaged in world-wide business as a manufacturer of high quality guitars and bass guitars bearing the ESP Mark.

10. Since at least 1984, ESP Shibuya has engaged in business both as a manufacturer and distributor of guitars and bass guitars and does business throughout the United States and internationally.

11. Since 1984, ESP Shibuya has been the exclusive distributor of ESP Co.'s products in the United States.

12. Since August 17, 1982, the ESP Mark, which was first used in commerce on March 21, 1976, has been registered with the USPTO in International Class 15 for use on guitars and structural parts thereof in accordance with the provisions of the Lanham Act. The ESP Mark is now an incontestable trademark.

13. The ESP Mark has priority rights over the Proposed Mark.

14. Since approximately 1984, ESP Shibuya has been and continues to be the exclusive licensee of the ESP Mark in the United States.

15. For more than thirty years, Opposers have invested significant amounts of money and effort in promoting and advertising the ESP Mark. As a result of such promotion, Opposers have achieved substantial commercial success and the ESP Mark is now well known and generates substantial goodwill among the consuming public.

16. Due to Opposers' use, promotion, and advertising, the ESP Mark has become well known to consumers encountering the mark, and has accordingly acquired substantial goodwill.

17. The ESP Mark identifies and distinguishes Opposers' goods and services from the goods and services of others, and identifies the source and origin thereof to the consuming public.

**COUNT ONE:  
LIKELIHOOD OF CONFUSION  
SECTION 2(D) OF THE LANHAM ACT, 15 U.S.C. § 1052(D)**

18. Opposers hereby incorporate by reference the allegations in Paragraphs 1 through 17 hereof as if fully set forth herein.

19. Applicant's Proposed Mark is substantially similar in sight, sound, connotation, and commercial impression to the ESP Mark.

20. Applicant's Proposed Mark so resembles the ESP Mark as used in commerce worldwide, that it is likely to cause confusion and/or mistake when applied to Applicant's goods or services.

21. Applicant's goods and services are sold in the same channels of trade as Opposers' goods and services.

22. Applicant's goods and services are marketed in the same catalogs that feature Opposers' goods and services.

23. Applicant's goods and services are marketed online at the same websites that feature Opposers' goods and services.

24. Applicant's goods and services are marketed and sold in the same physical locations as Opposers' goods and services.

25. Applicant and Opposers market their goods and services at the same musical instrument and equipment industry conventions.

26. Applicant's goods and services are complementary and related to Opposers' goods and services. Consumers purchasing Opposers' goods such as guitars and bass guitars are likely to need accompanying accessories which are marketed by Applicant, including, but not limited to, A/C power cords, A/C plugs, IEC electrical connections and jacks.

27. Due to their relatedness, Applicant's goods and services target the same consumers as Opposers' goods and services.

28. Applicant's registration and use of the Proposed Mark, which is effectively identical to the ESP Mark, is likely to cause consumer confusion. As a result, consumers are likely to associate Applicant's goods and/or services with Opposers', whereas, in fact, they are not.

29. Applicant's use of the Proposed Mark is an attempt to deceive the public, and to benefit from the reputation and goodwill developed by Opposers.

30. Opposers will be injured and damaged by the registration of Applicant's Proposed Mark, because such mark, when applied to Applicant's goods and services:

- a. is likely to cause confusion, or to cause mistake, or to deceive; and/or
- b. falsely suggests a connection with Opposers.

**COUNT TWO:  
TRADEMARK DILUTION  
SECTION 43(C) OF THE LANHAM ACT, 15 U.S.C. § 1125(C)**

31. Opposers hereby incorporate by reference the allegations in Paragraphs 1 through 30 hereof as if fully set forth herein.

32. The ESP Mark is famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) due to the duration and extent of use, the duration and extent of advertising and publicity, the geographical extent of the trading area, and the degree of recognition.

33. The fame of the ESP Mark continues to grow; ESP Shibuya has sold clothing in the United States bearing the ESP Mark as an indicator of source since 2002. Accordingly, ESP Shibuya has common law rights in the ESP Mark on clothing.

34. Additionally, on July 28, 2008, ESP Shibuya filed Trademark Application Serial No. 77/532860 in the USPTO to register the ESP Mark for use with goods and services in International Class 25.

35. Due to the fame of the ESP Mark, it has become so distinctive that the public associates the ESP Mark with Opposers even when they encounter the ESP Mark apart from Opposers' goods and/or services.

36. Opposers have promoted the ESP Mark in interstate and intrastate commerce for 19 years prior to any use of the Proposed Mark by Applicant.

37. Opposers will be injured and damaged by the registration of Applicant's Proposed Mark because such mark lessens the capacity of the ESP Mark to identify Opposers' goods and services from the Applicant's goods and services.



38. By reason of the foregoing, Applicant is not entitled to the registration of the mark as shown in the Application.

WHEREFORE, Opposers respectfully request that this Opposition be sustained and the registration of Trademark Application Serial No. 77/759785 be denied.

The required fee of \$600.00 is submitted herewith.

Dated: August 25, 2010  
Hackensack, New Jersey

Respectfully submitted,

By: \_\_\_\_\_

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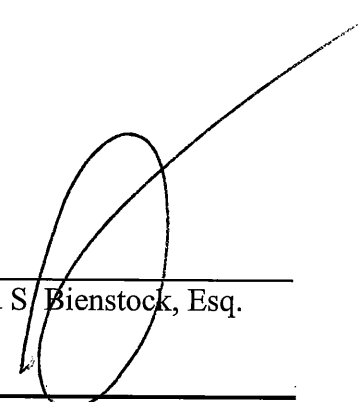
*Attorneys for Opposers ESP Co., Ltd.  
and ESP Shibuya Enterprises, Inc.  
d/b/a ESP Guitar Company*

**CERTIFICATE OF SERVICE**

The undersigned attorney hereby certifies that a true and complete copy of the foregoing Notice of Opposition has been served, via United States Postal Service first-class mail, certified, postage pre-paid, on this 25<sup>th</sup> day of August, 2010, on:

Stephon E. Johnson, Esq.  
Law Offices of Stephon E. Johnson, PLLC  
19785 West 12 Mile Road, #381  
Southfield, MI 48076-2584

*ATTORNEY FOR APPLICANT*



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Ronald S. Bienstock, Esq.

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**CERTIFICATE OF FILING**

I hereby certify that this correspondence, including all enclosures and attachments, is being transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, via the TTAB's ESTTA procedure on August 25, 2010.



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Bradley S. Rothschild, Esq.