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Filing date: **06/20/2011**

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

Proceeding	91196222
Party	Defendant Essential Sound Products Inc.
Correspondence Address	STEPHON E JOHNSON LAW OFFICES OF STEPHON E JOHNSON PLLC 535 GRISWOLD ST STE 1330 DETROIT, MI 48226 UNITED STATES sjlaw@earthlink.net
Submission	Opposition/Response to Motion
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Date	06/20/2011
Attachments	Essential Sound Products, Inc Response to Discovery Sanctions Motion.pdf (9 pages)(75062 bytes)

Applicant, Essential Sound Products, Inc. has used the following trademarks for some time:

- Essential Sounds Products, Inc., Reg. No. 2,077,049, Registered July 8, 1997
 - For: detachable A/C Power Cord for audio/video electronic equipment, in class 9 (U.S. CLS. 21, 23, 26, 36 and 38). First Use 3-13-1995; in commerce 4-28-1995. Ser. No. 74-608,796, filed 7-10-1995.
- The Essence, Reg. No. 1,995,187, Registered Aug. 20, 1996
 - For: A/C Power Cords, A/C multiple power outlet strips, A/C plugs and outlets, A/C power line conditioners, A/C power surge suppressers, male and female IEC electrical connections and jacks, and audio and video electrical cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market, in class 9 (U.S. CLS, 21, 23, 26, 36 and 38). First use 1-2-1993; in commerce 6012-1995. Ser. No. 75-047,746, filed 1-18-1996.

Subsequently, Applicant's trademarks were updated as follows:

- MusicCord, Reg. No. 3,474,745, Registered July 29, 2008
 - For: A/C Power Cords, A/C multiple power outlet strip, A/C plugs and outlets, A/C power line, conditioner, A/C power surge suppressor, male and female IEC electrical connections and jack, and audio and video cables used to transmit signals between electronic equipment, all for use by the audio video entertainment market; detachable A/C power cord for audio video equipment, in class 9 (U.S. CLS. 21, 23, 26, 36 and 38). First use 4-30-2007; in commerce 4-30-2007. Ser. No. 77-183,498, filed 5-17-2007.
- The Essence, Reg. No. 3,470,272, Registered July 22, 2008
 - For: Detachable A/C Power Cord for audio video electronic equipment, in class 9 (U.S. CLS, 21, 23, 26, 36 and 38). First use 1-2-1993; in commerce 6-12-1995. Ser. No. 77-127,870, filed 3-11-2007.

Application for the mark involved in the instant Opposition is amongst this series of marks which includes:

- Essential Sound Products, Inc., Ser. No. 77759567, First use in commerce: 6-12-1995, Filed 6-15-2009
 - For: A/C Power Cords, A/C multiple power outlet strip, A/C plugs and outlets, A/C power line, coinditioners, A/C power surge suppressers, male and female IEC electrical connections and jacks, and audio and video electrical cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market.
 - Consisting of the words “Essential Sound Products, Inc.” placed descending in the middle of field bars, similar to written sheet bars, with two large posts on either end. The letters “E”, “S” and “P” are larger than the remaining lettering.

Mark



- Current Status: Opposed and approval by the examining attorney for publication for opposition.
- “One Listen, and Nothing Else Will Do”, Ser. No. 77759828, First use in commerce: 6-12-1995, Filed: 6-15-2009
 - For: A/C Power Cords, A/C multiple power outlet strip, A/C plugs and outlets, A/C power line, coinditioners, A/C power surge suppressers, male and female IEC electrical connections and jacks, and audio and video electrical cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market
 - Current Status: Final review prior to publication has been completed, application will be published for opposition.
- ESP, Serial No. 77759785, First use in commerce: 6-12-1995, Filing date: 6-9-2005
 - 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 suppressers, male and female IEC electrical connections and jacks, and audio and video electrical cables used to transmit signals between electronic equipment; all for use by the audio video entertainment market.

- Consisting of the letters “ESP” in script lettering centered, descending on a set of 5 bars, similar to the bars on written music sheets.

Mark



- Current Status: Opposed, by the current Opposer, after approval by the examining attorney for publication for opposition.

ARGUMENT

As stated in Opposer’s Motion, Applicant has made a good-faith effort by both correspondence and telephonic conferences to resolve the issues presented in Opposer’s Motion. Applicant’s and Opposer’s counsel have been in constant contact concerning these and relevant issues in connection with Opposer’s opposition. Counsel have discussed the pending Initial Disclosures, timing, etc. and the substance of the Initial Disclosures. The Initial Disclosures have been filed with Opposer, no later than June 9, 2011 and June 10, 2011 and followed via facsimile transmission.

Opposer has not been prejudiced. As seen by the Initial Disclosures filed by Applicant, only one contact person is noted for information and documentation concerning the relevant issues – the owner of Applicant’s company. Opposer is well familiar with that person, having had telephonic, correspondent and indeed, in-person contact and communications with the Owner, Mr. Michael Griffin. *These*

communications clearly satisfy Applicant's duty to attempt to resolve the issues presented in Opposer's Motion.

Any inadvertent failure to file one of the Applicant's Initial Disclosures in these related matters did not prejudice Opposer. The Initial Disclosure is identical with that of the related matter, Opposition 91196221 that was filed pursuant to the Board's Order. Accordingly, Applicant requests that the Board continue proceedings in accordance with the dates set forth in Opposition No. 91196221:

Initial Disclosures from Applicant Due	6/10/2011 (filed)
Expert Disclosures Due	6/25/2011
Discovery Closes	7/25/2011
Plaintiff's Pretrial Disclosures	9/8/2011
Plaintiff's 30-day Trial Period Ends	10/23/2011
Defendant's Pretrial Disclosures Due	11/7/2011
Defendant's 30-day Trial Period Ends	12/22/2011
Plaintiff's Rebuttal Disclosures Due	1/6/2012
Plaintiff's 15-day Rebuttal Period Ends	2/5/2012

Applicant submits that the above schedule or a similar schedule, or combining the two oppositions, 91196221 and 91196222 would help provide for the efficient administration of the oppositions.

Additionally, Opposer has requested, and Applicant has agreed, to stipulate to an extension of discovery in the related matter, Opposition 91196221. That agreement would extend discovery in this matter for 150 days. As mentioned above, Opposition 91196221 and Opposition 91196222 are closely related. They involve the exact same parties, issues and relevant facts. The proposed trademarks that they involve differ only slightly. Applicant submits that Applicant and Opposer will rely on the same facts and arguments in both proceedings.

Accordingly, the two matters should be combined for administrative efficiency. Similarly, the stipulated discovery dates for Opposition 91196221 should be applied to Opposition 91196222.

Moreover, Opposer has filed a lawsuit for trademark infringement against Applicant, in the state of California, alleging facts identical to those of the instant two oppositions. Applicant is in the process of responding to the lawsuit. Opposer's ability to file and serve the lawsuit indicate that Opposer already possesses all of the information of the initial discovery disclosures. Given the identical nature of the lawsuit, there is a strong likelihood that the Oppositions will be stayed pending the outcome of the lawsuit.

The Board should also note the lack of likelihood that Opposer would win its opposition on the merits of the case. Opposer has filed two Notices of Opposition, against Trademark Application Serial No. 77/759567 (Opposition 91196222, the instant opposition), above and against Trademark Application Serial No. 77759785 (Opposition 91196221, the related opposition matter). It is really the latter application with which Opposer takes umbrage, an abbreviated version of the first. The latter application involves the use of the three letters, E, S & P only, which Opposer now claims harm its use of the same letters. The instant application uses the entire Applicant's company's name "Essential Sound Products, Inc.", but only highlights the letters E, S & P in a different color, in a highly distinguishable stylized manner. Applicant submits that Opposer's opposition to this mark (as well as the instant request for such extraordinary relief) is a tactic which seeks to get an unfair negotiating advantage by requesting relief to which it would otherwise clearly not be entitled.

REQUEST FOR RELIEF

Whereas the parties have been in constant contact concerning this matter, any failure to file initial discovery was a ministerial, inadvertent error caused by the similarity of the accompanying opposition (Oppositions 91196221 and 91196222); Opposer has now already received the initial discovery; Opposer already had the identical initial discovery in a related matter; the parties have already agreed to stipulate to an extension of discovery in the related opposition matter; and Opposer has filed a lawsuit that will likely cause both of the instant oppositions to be stayed, Applicant submits that there has been no prejudice to the Opposer. Accordingly, Applicant requests that the Board rule in favor of the Applicant, order no sanctions towards Applicant and order that the proceedings schedule for the instant matter, Opposition 91996222, run concurrently with those of Opposition 91196222. Alternatively, Applicant requests that the Board order that the two Oppositions be joined for administrative/judicial efficiency.

Dated: June 10, 2011

Respectfully submitted,

By: /s/Stephon E. Johnson
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 77/759567
For the Mark: "ESP"
Published in the Official Gazette: June 8, 2010

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ESP CO., LTD., a Japanese corporation,)
E.S.P. SHIBUYA ENTERPRISES, INC. d/b/a)
ESP GUITAR COMPANY, a California corporation,))
)
Opposers,) Opposition No. 91196222
)
)
vs.)
)
ESSENTIAL SOUND PRODUCTS, INC.,)
a Michigan corporation,)
)
Applicant.)
_____)

APPLICANT'S CERTIFICATE OF FILING

The undersigned indicates that the attached Response to Opposers' Motion for Discovery Sanctions, is being transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, via TTAB's ESTTA procedure on June 20, 2011.

Dated: June 20, 2011

Respectfully submitted,

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

In the Matter of Trademark Application Serial No. 77/759567
For the Mark: "ESP"
Published in the Official Gazette: May 4, 2010

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ESP CO., LTD., a Japanese corporation,)	
E.S.P. SHIBUYA ENTERPRISES, INC. d/b/a)	
ESP GUITAR COMPANY, a California corporation,)	
)	
Opposers,)	Opposition No. 91196222
)	
)	
vs.)	
)	
ESSENTIAL SOUND PRODUCTS, INC.,)	
a Michigan corporation,)	
)	
Applicant.)	
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**APPLICANT’S CERTIFICATE OF SERVICE OF
RESPONSE TO OPPOSERS’ MOTION FOR DISCOVERY SANCTIONS**

The undersigned indicates that the attached Response to Opposers’ Motion for Discovery Sanctions were served upon counsel of record for Opposer ESP Shibuya Enterprises, Inc., ESP Co., LTD. via 1st Class Mail on June 20, 2011, postage prepaid, at counsel’s address of record.

Dated: June 20, 2011

Respectfully submitted,

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