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

Proceeding	91218879
Party	Defendant Gibson Brands, Inc.
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Submission	Reply in Support of Motion
Filer's Name	Andrea E. Bates
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Signature	/Andrea E. Bates/
Date	04/24/2015
Attachments	Gibson's Reply in Support of Motion to Suspend Proceedings.pdf(168418 bytes) KS Declaration for Reply.pdf(237191 bytes) Exhibit A.pdf(3959888 bytes) Exhibit B.pdf(182002 bytes) Exhibit C.pdf(1228578 bytes) Exhibit D.pdf(1262126 bytes) Exhibit E.pdf(1262126 bytes)

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

In the Matter of Trademark Application Serial No: 86/168,793
Filed on January 17, 2014
Published on June 24, 2014

ARMADILLO ENTERPRISES, INC., COLLINGS GUITARS, INC., CORDOBA MUSIC GROUP, INC., ED ROMAN ENTERPRISES, INC., E.S.P. SHIBUYA ENTERPRISES, INC., JAMES TRUSSART GUITARS, INC., JOHN HORNBY SKEWES & CO., LTD, JS TECHNOLOGIES, INC., PEAVEY ELECTRONICS CORPORATION, PREMIER BUILDERS GUILD, LLC, SADOWSKY GUITARS, LTD., SCHECTER GUITAR RESEARCH, INC., U.S. MUSIC CORPORATION, WARWICK GMBH & CO. MUSIC EQUIPMENT KG, AND WESTHEIMER CORPORATION, *Opposers,* *v.* GIBSON BRANDS, INC., *Applicant*.	)	Opposition No.: 91218879 Application Serial No: 86/168,793

APPLICANT GIBSON BRANDS, INC.'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PENDING RESOLUTION OF A CIVIL ACTION

As the Board did in Cancellation Proceedings No. 92058944 involving Gibson's ES Body Design® Registration on the Supplemental Registry, the Board should suspend this proceeding pending resolution of the prior pending action between Gibson and Opposer John Hornby Skewes ("JHS"), civil action 2:14-cv-00609-DDP-SS, as that case involves the same mark and the same issues

presently before this Board. The granting of the Motion to Suspend Proceeding will reserve this Board's resources while avoiding a potential for conflicting rulings. Gibson cannot think of a better example of a Board proceeding that should be suspended pending resolution of a civil action.

In Opposers' Opposition to the Motion to Suspend Proceedings, they are wrong on two important fronts. First, whether the Prior Pending Action would be completely dispositive of the issues before the Board is not the test: "Suspension of a Board case is appropriate **even if the civil case may not be dispositive of the Board case**, so long as the ruling will have **a bearing on the rights** of the parties in the Board case." *See Kearns-Tribune, LLC*, OPPOSITION 151,843, 2003 WL 22134916 (Trademark Tr. & App. Bd. Sept. 11, 2003) (citing *Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971) [Emphasis added.] Second, the issue of secondary meaning **will be resolved** in the Prior Pending Action, as **Gibson bears the burden** of proving in the Prior Pending Action that its ES Body Design Registration on the Supplemental Registry (Reg. No. 2007277) has gained secondary meaning.

Thus, while Opposers accuse Gibson of being cavalier for filing an eight (8) paragraph Motion to Suspend, the truth is that Gibson's Motion was brief because the issue is straightforward: Gibson is simply asking that this Board stay this proceeding regarding Gibson's Application to register its ES Body Design on the Principal Registry while it litigates the threshold question of whether Gibson's ES Body Design® on the Supplemental Registry is not generic and has acquired

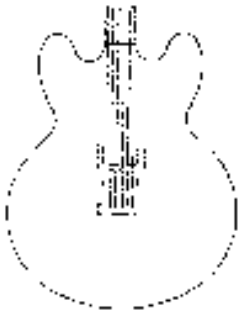
secondary meaning. In other words, why litigate whether a mark should be on the principal registry at the same time another tribunal is deciding if the mark should remain on the supplemental registry?

If the Board does not grant Gibson's Motion to Suspend (as Opposers urge), then two different tribunals will be deciding at the same time whether Gibson's ES Body Design is not generic and has acquired secondary meaning. The potential for conflicting decisions on those issues warrants the Board granting Gibson's Motion to Suspend this Proceeding.

I. Factual Background

Gibson filed the Prior Pending Action against JHS on January 27, 2014, based on JHS' unauthorized use of six Gibson Trademarks, including Gibson's ES Body Shape Design® on the Supplemental Registry. To prevail in the Prior Pending Action, Gibson must prove that the ES Body Shape Design has acquired secondary meaning. The firm of Bienstock & Michael, LLC represents JHS in the Prior Pending Action, wherein JHS has counterclaimed to cancel the ES Body Shape Design based on genericness and has denied liability based on the ES Body Shape Design lacking secondary meaning.

The ES Body Shape Design is the same as the ES Body Shape Design that Gibson presently seeks to register on the Principal Registry.

Gibson's ES BODY Design on the Supplemental Registry Reg. No. 2007277	Gibson's ES BODY Design Application on the Principal Registry 86/168,793
	

Not only are the marks the same, but the same attorneys that represent JHS in the Prior Pending Action represent all Opposers in this action: Beinstock & Michaels, LLC. Gibson is confident that the firm of Beinstock & Michaels, LLC, as experienced trademark attorneys, merely overlooked the issues in the Prior Pending Action when they *italicized* and **bolded** throughout their Opposition that secondary meaning is not an issue in the Prior Pending Action. Gibson is confident that it is merely oversight because Beinstock & Michaels, LLC have raised the issue of lack of secondary meaning numerous times in the Prior Pending Action:

> The claims made in the Complaint are barred, in whole or in part, on the basis that any marks and use of marks at issue are generic, or otherwise unprotectable as **said marks lack secondary meaning** and/ or do not serve as a source identifiers.

[*See* Exhibit **A** of the Declaration of Kurt Schuettinger] [Emphasis added.]

> One or more of the asserted trade dresses are invalid because the alleged designs are generic, and/or **have not acquired secondary meaning.**

[*See* Exhibit **A** of the Decl. of Kurt Schuettinger] [Emphasis added.]

When Gibson sought to strike these affirmative defenses as they were redundant to JHS' Answer to the Complaint, JHS, through Beinstock & Michael, LLC, argued these "affirmative defenses all deal with the asserted trademarks being generic, **lacking secondary meaning** and not serving as source identifiers . . . Clearly, this is relevant and material to a trademark infringement action." [*See* Exhibit "**C**" of the Decl. of Kurt Schuettinger] [Emphasis added.] The Court ultimately struck these affirmative defenses as redundant to JHS' denials in paragraphs 10-15 and 54-55 of its Answer. [*See* Exhibit "**D**" of the Decl. of Kurt Schuettinger]

Thus, not only have Opposers' attorneys successfully raised the issue of lack of secondary meaning in the Prior Pending Action, they were unnecessarily redundant in their efforts to do so. Consequently, when Opposers' attorneys represented to this Board in their Opposition to Gibson's Motion to Suspend Proceedings is that "*lack of secondary meaning is not at issue at all in the Prior Pending Action*," it was presumably a misstatement rather than an attempt to mislead this Board. [*See* Exhibit "**E**" of the Decl. of Kurt Schuettinger] [*Italicized* in the original.]

Given the Prior Pending Action involves the same body shape, the same core issues and the same attorneys, this Board should grant Gibson's Motion to Suspend this Proceeding.

II. Legal Standard

It is the Board's well-settled policy to suspend proceedings when one or both parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117 (a); *see also General Motors Corp. v. Cadillac Club Fashions Inc.,* 22 USPQ2d 1933 (TTAB 1992). "Suspension of a Board case is appropriate **even if the civil case may not be dispositive of the Board case**, so long as the ruling will have a bearing on the rights of the parties in the Board case." *See Kearns-Tribune, LLC*, OPPOSITION 151,843, 2003 WL 22134916 (Trademark Tr. & App. Bd. Sept. 11, 2003) (citing *Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971) [Emphasis added.]

As explained above, Opposers' primary argument in Opposition to the Motion to Suspend Proceedings – *i.e.*, "*lack of secondary meaning is not at issue at all in the Prior Pending Action*[1]," was obviously a misstatement, as Opposers' attorneys raised the issue so much in the Prior Pending Action that the Court ordered their efforts as redundant. Consequently, the Board need not concern itself with Opposers' misguided concern that "**the cause of action of lack of secondary meaning would still need to be adjudicated by the Board**" if the Board suspended this proceeding pending resolution of the Prior Pending Action. [*See* Exhibit "**E**" of the Decl. of Kurt Schuettinger] [Emphasis in the Original.]

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[1] [*See* Exhibit "**E**" of the Decl. of Kurt Schuettinger] [*Italicized* in the original.]
[2] *See Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570

In the same breath, the Board need not concern itself with Opposers' issue preclusion argument, which Gibson finds somewhat out-of-place in a trademark context. Specifically, Opposers argue that, if JHS fails in proving in the Prior Pending Action that Gibson's ES Body Shape Design is not generic, the other Opposers cannot be stopped from asserting that defense in another case or here. But isn't that how defenses to a valid trademark work in every case? A party can always assert a mark has become generic, even incontestable marks. More importantly, the Board suspends proceedings if resolution of the Civil Action will have "a bearing" on the rights of the parties in the Board case[2] rather than only when the Civil Action will resolve a legal issue forever and against all foreseeable parties.

Lastly, Opposers' argument that this Board should deny the Motion to Suspend Proceedings because some Opposers are being subpoenaed in the Prior Pending Action is without merit. Regardless of whether this proceeding continues, Gibson will continue to subpoena Opposers because their attorneys, Beinstock and Michaels, LLC, have claimed in the Prior Pending Action that their clients' guitar body shapes are substantially similar to **Gibson's guitar body shapes at issue in that case**. Notably, Opposers' attorneys have claimed in the Prior Pending Action that Opposers' guitars shapes are substantially similar to several of Gibson's trademarks that are not at issue in this Board proceeding. In

[2] *See Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971). USPQ 861 (TTAB 1973);

others words, Opposers' attorneys have made Opposers an issue in the Prior Pending Action for matters both related and unrelated to this Board Proceeding. It is disingenuous now for Opposers' attorneys to claim it is unfair that their clients are at issue in the Prior Pending Action based on their actions in the Prior Pending Action.

Furthermore, to the extent that Opposers object to receiving cease and desist letters, they should speak with their lawyers who represented in filings in the Prior Pending Action that their clients are using substantially similar trademarks in commerce without permission. The only party that will suffer prejudice is Gibson if it is forced to litigate the same issue before two different tribunals at the same.

Accordingly, in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, this Court should suspend proceedings pending final disposition of the civil action involving Gibson and Opposer JHS. *See Kearns-Tribune, LLC*, OPPOSITION 151,843, 2003 WL 22134916, at *4 (Sept. 11, 2003).

Respectfully submitted, this 24th day of April, 2015.

BATES & BATES, LLC

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ATTORNEY FOR APPLICANT

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the forgoing Gibson Brands, Inc.'s Reply Brief in Support of its Motion to Suspend Proceedings Pending Resolution of a Civil Action has been served, via U.S. Postal Service first class mail, certified, postage pre-paid, on the 24th day of April 2015 to:

Ronald S. Bienstock, Esq.
Bienstock & Michael, PC
411 Hackensack Avenue
Hackensack, NJ 07601
Ph: 201-525-0300

/ Andrea E. Bates /
ANDREA E. BATES

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 the 24th day of April 2015.

/ Andrea E. Bates /
ANDREA E. BATES

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

In the Matter of Trademark Application Serial No: 86/168,793
Filed on January 17, 2014
Published on June 24, 2014

ARMADILLO ENTERPRISES, INC., COLLINGS GUITARS, INC., CORDOBA MUSIC GROUP, INC., ED ROMAN ENTERPRISES, INC., E.S.P. SHIBUYA ENTERPRISES, INC., JAMES TRUSSART GUITARS, INC., JOHN HORNBY SKEWES & CO., LTD, JS TECHNOLOGIES, INC., PEAVEY ELECTRONICS CORPORATION, PREMIER BUILDERS GUILD, LLC, SADOWSKY GUITARS, LTD., SCHECTER GUITAR RESEARCH, INC., U.S. MUSIC CORPORATION, WARWICK GMBH & CO. MUSIC EQUIPMENT KG, AND WESTHEIMER CORPORATION, *Opposers,* *v.* GIBSON BRANDS, INC., *Applicant.*	Opposition No.: 91218879 Application Serial No: 86/168,793

KURT SCHUETTINGER'S DECLARATION IN SUPPORT OF APPLICANT GIBSON BRANDS, INC.'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO SUSPEND PROCEEDINGS PENDING RESOLUTION OF A CIVIL ACTION

I, Kurt W. Schuettinger, submit this Declaration in support of Applicant Gibson Brands, Inc.'s ("Gibson") Reply Brief in Support of its Motion to Suspend Proceedings Pending Resolution of a Civil Action.

1. My name is Kurt W. Schuettinger. I am over 21 years of age, have personal knowledge of the facts stated below, and am competent to make this Declaration.

2. I am an associate at the law office of Bates & Bates, LLC and Counsel for Gibson. I have personally overseen the information collected in support of this Reply.

3. Presently before the Board is Opposers Notice of Opposition to Gibson's application to register the ES Body Shape Design, Application No. 86/168,793, on the principal registry. Importantly, Gibson already owns a Supplemental Registration for the ES Body Shape Design®, Reg. No. 2007277.

4. Currently, Gibson and Opposer John Hornby Skewes & Co., Ltd. ("JHS") are involved in litigation before the Central District of California, civil action 2:14-cv-00609-DDP-SS, wherein Gibson has alleged that JHS is infringing on the ES Body Shape Design® and wherein JHS has counterclaimed to cancel that mark. Gibson filed that action before Opposers filed the present Notice of Opposition (the "Prior Pending Civil Action").

5. Attached collectively hereto as Exhibit "**A**" are the true and correct copies of the Complaint and Original Counterclaims filed in the Prior Pending Civil Action.

6. Notably, Gibson and Opposer JHS are also involved in another action before the Board where JHS seeks to Cancel Gibson's Supplemental Registration for the ES Body Design®, Cancellation No. 92058944.

7. On December 30, 2014, the Board granted Gibson's Motion to Suspend that proceeding pending disposition of the Prior Pending Civil Action.

8. Attached hereto as Exhibit "**B**" is a true and correct copy of the Board's December 30, 2014 Order Suspending the Proceedings Pending Resolution of the Prior Pending Civil Action.

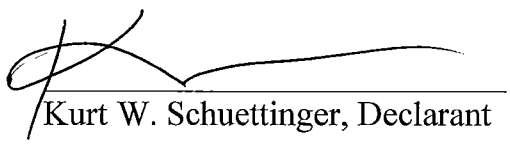
9. Attached hereto as Exhibit "**C**" is a true and correct copy of Defendant JHS' Brief in Opposition to Plaintiff's Motion to Strike/Dismiss filed in the Prior Pending Civil Action.

10. Attached hereto as Exhibit "**D**" is a true and correct copy of the Order Granting Plaintiff's Motion to Strike/Dismiss Defendant's Affirmative Defenses and Counterclaims in the Prior Pending Civil Action.

11. Attached hereto as Exhibit "**E**" is a true and correct copy of Opposers' Opposition to Gibson's Motion to Suspend Proceedings.

I declare under penalty of perjury under the laws of the United States of America that the foregoing statements are true and correct.

Executed on April 24, 2015 in Atlanta, Georgia.



Kurt W. Schuettinger, Declarant

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Attorneys for
Plaintiff GIBSON BRANDS, INC.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

GIBSON BRANDS, INC., a Delaware corporation,

Plaintiff,

vs.

JOHN HORNBY SKEWES & CO. LTD., a United Kingdom corporation and DOES 1 through 10,

Defendants.

Case No. CV14-00609-DDP (SSx)

COMPLAINT FOR:
(1) Trademark Infringement;
(2) Trademark Counterfeiting;
(3) False Designation of Origin and Unfair Competition Under the United States Trademark Act;
(4) False Description of Fact and Representations and False Advertising Under the United States Trademark Act;
(5) Trademark Dilution Under the United States Trademark Act;
(6) Trade Dress Infringement Under Federal Law; (7) Trademark Dilution Under California State Law;
(8) Common Law Trademark Infringement; (9) Unfair Competition; Infringement; and
(10) Accounting

JURY TRIAL DEMANDED

COMPLAINT

1. Plaintiff Gibson Brands, Inc. ("Gibson") for its Complaint against Defendant John Hornby Skewes & Co. Ltd. (hereinafter referred to as "JHS") alleges as follows:

Nature of Action

2. This is an action for trademark infringement, trade dress infringement, trademark counterfeiting, unfair competition, trademark dilution, and other related causes of action under federal, state and common law arising from Defendant JHS' unauthorized use of the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark in the United States.

The Parties

3. Gibson is a Delaware Corporation with a principal place of business at 309 Plus Park Boulevard, Nashville, Tennessee 37217. Furthermore, Gibson is registered with the Secretary of State of California and has an office in California.

4. Upon information and belief, Defendant JHS is a United Kingdom Corporation with a principal place of business at Salem House, Parkinson Approach, Garforth, Leeds LS25 2HR, United Kingdom.

5. Upon information and belief, Defendant JHS is engaged in the promotion and sale of various products containing Gibson's SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark in the United States, including in this District, through LPD Music International Corporation, a US-based wholesale distributor of guitars, and through its website www.lpdmusic.com, Aamp's Electric Guitar store located in California at www.aampselectricguitarstore.com, Sundae Times located in California at stores.ebay.com/sundae-times, Megatone Music located in Georgia at stores.ebay.com/megatone-music, Uncle Sam's Jamms located in Kentucky at http://vintageguitarsusa.com/vintageelectric.htm, as well as Jacks Music store in Michigan at www.jacksmusicstore.com.

6. Furthermore, upon information and belief, on January 23-27, 2014, representatives from JHS will be attending The National Association of Music Merchants ("NAMM") located in this district at Anaheim Convention Center, 800 West Katella Avenue, Anaheim, CA 92802, wherein, upon information and belief, JHS will advertise and offer for sale its infringing guitar products bearing JHS' unauthorized use of the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark.

7. The true names and capacities of Defendants DOES 1 through 10 are unknown to Plaintiff, who therefore sues said Defendants by such fictitious names. Plaintiff is informed and believes and thereon alleges that each of the Defendants designated herein as a fictitiously named Defendant is, in some manner, responsible for the events and happenings herein referred to, either contractually or tortuously, and caused damage to the Plaintiff as herein alleged. When Plaintiff ascertains the true names and capacities of DOES 1 through 10, it will ask leave of this Court to amend its Complaint by setting forth the same.

Jurisdiction and Venue

8. Jurisdiction of this Court is based on 28 U.S.C. § 1331 (federal question), 28 U.S.C. § 1332 (diversity jurisdiction), 28 U.S.C. §1338(a) and (b) (Acts of Congress relating to trademarks and related actions), Sections 39 and 43(a) and (c) of the United States Trademark Act of 1946 ("Lanham Act"), as amended (15 U.S.C. §1121 and 1125(a)(c)), and 28 U.S.C. §1367 (Supplemental Jurisdiction), as well as the principles of pendent jurisdiction.

9. This action arises out of wrongful acts including: advertising, offering for sale, selling and distributing infringing products by JHS within this judicial district. This Court has personal jurisdiction over Defendant JHS because it has purposefully availed itself of the opportunity to conduct commercial activities in this forum, and this Complaint arises out of those activities. Also, Defendant JHS maintains continuous and systematic contacts with the forum such that the exercise of jurisdiction over it would not offend traditional notions of fair play and substantial justice. Likewise, personal jurisdiction is proper under the California

Long-Arm Statute, Code Civ. Proc., § 410.10, because the exercise of jurisdiction is not inconsistent with the Constitution of this state or of the United States. Venue is proper in this district under 28 U.S.C. §1391(b) and (c), as Defendant is subject to personal jurisdiction in this District and a substantial part of the events giving rise to these claims occurred in this District.

Gibson's Use And Ownership Of Its Marks

10. Gibson is the sole owner of the distinctive design mark SG Body Shape Design®, U.S. Trademark Reg. No. 2215791. This Trademark was issued by the U.S. Patent and Trademark Office on January 5, 1999, and has been continuously and exclusively used in commerce by Gibson since 1961. A copy of the Trademark's registration is attached hereto as Exhibit A.

11. Gibson is the sole owner of the distinctive design mark Explorer Body Shape Design®, U.S. Trademark Reg. No. 2053805. This Trademark was issued by the U.S. Patent and Trademark Office on April 27, 1997, and has been continuously and exclusively used in commerce by Gibson since 1958. A copy of the Trademark's registration is attached hereto as Exhibit B.

12. Gibson is the sole owner of the distinctive design mark ES Body Shape Design®, U.S. Trademark Reg. No. 2007277. This Trademark was issued by the U.S. Patent and Trademark Office on the Supplemental Register on October 8, 1999, and has been continuously and exclusively used in commerce by Gibson since 1958. A copy of the Trademark's registration is attached hereto as Exhibit C.

13. Gibson is the sole owner of the distinctive design mark Flying V Body Shape Design®, U.S. Trademark Reg. No. 2051790. This Trademark was issued by the U.S. Patent and Trademark Office on November 3, 1989, and has been continuously and exclusively used in commerce by Gibson since 1958. A copy of the Trademark's registration is attached hereto as Exhibit D.

14. Gibson is the sole owner of the distinctive design mark Flying V Peghead Design®, U.S. Trademark Reg. No. 3976202. This Trademark was issued by the U.S. Patent

and Trademark Office on the Supplemental Register on June 7, 2011, and has been continuously and exclusively used in commerce by Gibson since 1958. A copy of the Trademark's registration is attached hereto as Exhibit E.

15. Gibson is the sole owner of the distinctive design mark Kramer Peghead Design®, U.S. Trademark Reg. No. 1567052. This Trademark was issued by the U.S. Patent and Trademark Office on November 3, 1989, and has been continuously and exclusively used in commerce by Gibson since 1958. A copy of the Trademark's registration is attached hereto as Exhibit F.

16. Gibson has spent millions of dollars in the advertising and promotion of the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark (hereinafter collectively referred to as the "Gibson Trademarks") which have been used in conjunction with various Gibson stringed instruments.

17. As a result of the quality of Gibson's products and the extensive sales, licensing and marketing, advertising and promotion of these products under the Gibson Trademarks, the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark have become famous trademarks that are widely and favorably known by consumers in the United States and elsewhere as designating high quality and dependable products originating exclusively from Gibson and its related companies. The ES Body Shape Design® Trademark and the Flying V Peghead Design® Trademark are distinctive designs owned exclusively by Gibson, achieving secondary meaning for over 45 years with Gibson spending millions of dollars on promotion of the Gibson Trademarks for over 50 years. Consumers are exposed to the Gibson's ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark through magazines, newspapers, television, and the Internet. As a result, Gibson's ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark have become widely known

and valuable trademark, possessing a strong secondary meaning among consumers. Gibson's ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark are valuable among consumer trademarks because they are constantly exposed to consumers. As a result, the Gibson's ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark have come to symbolize the enormous goodwill of Gibson's business in the United States, nationwide. No other manufacturer lawfully uses the Gibson's ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark or any other substantially similar marks for similar types of goods.

18. The Gibson Trademarks have been famous in the United States, nationwide, and elsewhere since long prior to the acts complained of herein. The Gibson trademarks have been used exclusively nationwide and have been used exclusively by Gibson.

19. The trademark registrations remain in full force and effect and are *prima facie* proof of Gibson's exclusive right to own and use the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, Flying V Body Shape Design® Trademark and the Kramer Peghead Design® Trademark. In addition, the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, Flying V Body Shape Design® Trademark and the Kramer Peghead Design® Trademark are incontestable pursuant to Section 15 of the Lanham Act (15 U.S.C. § 1065). Gibson has spent millions of dollars in its marketing and promotion of its products which exclusively bear Gibson Trademarks on its distinctive designs for over 50+ years.

Misuse By JHS Of The Gibson Trademarks

20. Upon information and belief, Defendant JHS offers for sale, sells and distributes in the United States products using the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark by and through its exclusive United States distributor LPD Music International Corporation as well as its related distributors and resellers. ("JHS Unauthorized Products"). [*See* Exhibit "G"].

21. Upon information and belief, notwithstanding the lack of authorization from Gibson and the fact that said JHS' Unauthorized Products otherwise are not authorized to be sold utilizing the Gibson Trademarks, JHS has made repeated unauthorized use of the Trademark in connection with said products, as described below, with the intent to mislead and confuse consumers into believing that said JHS' Unauthorized Products are made directly by Gibson pursuant to Gibson's strict quality control standards or that said JHS' Unauthorized Products are otherwise authorized or licensed by Gibson and with the intent of misappropriating, for their own benefit, the tremendous goodwill built up by Gibson in the Gibson Trademarks. [*See* Exhibit "H"].

22. In particular, JHS has improperly used the Gibson Trademarks in their advertising and promotional materials for said JHS' Unauthorized Products as well as on the Internet at www.lpdmusic.com, www.aampselectricguitarstore.com, stores.ebay.com/sundae-times, stores.ebay.com/megatone-music, http://vintageguitarsusa.com/vintageelectric.htm, and www.jacksmusicstore.com and has thus falsely stated or otherwise implied that said JHS' Unauthorized Products are made directly by Gibson pursuant to Gibson's strict quality control standards or that their use of the Gibson Trademarks is authorized or licensed by Gibson.

23. Plaintiff is informed and believes, and thereon alleges that, JHS is or has been directly and indirectly advertising and selling the JHS' Unauthorized Products bearing the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark through the US wholesale distributor of guitars LPD Music International Corporation, a Michigan corporation as well as its distributors and resellers.

24. Plaintiff is informed and believes, and thereon alleges that, JHS has shipped the JHS' Unauthorized Products to LPD Music International Corporation in the US and that LPD has sold JHS' Unauthorized Products to consumers in the United States. Notably, an agent for Gibson purchased two guitars from LPD and/or its authorized distributors bearing the JHS' Unauthorized Products.

25. Upon information and belief, the aforementioned misuse of the Gibson Trademarks by JHS was done with the intent of deceiving or misleading customers into mistakenly believing that said JHS' Unauthorized Products were authorized Gibson products originating from Gibson or its related companies and otherwise misappropriating the goodwill built up by Gibson in the Gibson Trademarks and otherwise attracting and misdirecting consumers looking for genuine or authorized Gibson goods to the JHS' Unauthorized Products.

26. Upon information and belief, JHS had constructive knowledge that JHS' Unauthorized Products were infringing the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, Flying V Body Shape Design® Trademark and the Kramer Peghead Design® Trademark. The Gibson Trademarks are all registered in the United States, one for over 30 years.

27. JHS has actual knowledge of the infringement of the Gibson Trademarks by JHS' Unauthorized Products. Gibson contacted Counsel for JHS on July 26, 2013, via a cease and desist letter describing the infringement of JHS' Unauthorized Products. Further, Gibson and JHS have been in ongoing discussions regarding the misuse of the Gibson Trademarks.

28. Despite its constructive and actual knowledge of the infringement of the Gibson Trademarks by JHS' Unauthorized Products, JHS has continued to provide JHS' Unauthorized Products to distributors whom then sell JHS' Unauthorized Products to the end consumer.

29. Prior to commencing this lawsuit, Gibson and its representatives communicated directly with JHS and their representatives in an attempt to resolve this matter without the necessity of bringing this lawsuit, but JHS has failed to cease all unauthorized use of the Gibson Trademarks as requested by Gibson and continues to deliberately and intentionally use the Gibson Trademarks without the consent of Gibson.

30. The misuse of the Gibson Trademarks by JHS was intended to cause, has caused, and is likely to continue to cause, consumer confusion, mistake or deception

including the misleading of consumers into mistakenly believing that the JHS' Unauthorized Products are made directly by Gibson pursuant to Gibson's strict quality control standards or Gibson has authorized or licensed the use by JHS of the Trademark for those products.

31. The aforementioned misuse of the Gibson Trademarks by JHS is damaging to the reputation and goodwill of Gibson and the Gibson Trademarks.

32. Upon information and belief, the aforesaid acts of JHS have caused and, unless enjoined, will continue to cause irreparable damage to Gibson and to the reputation of its valuable Gibson Trademarks.

33. Gibson has no adequate remedy at law.

COUNT I

Trademark Infringement Under The United States Trademark Act (15 U.S.C. 1114 (1))

34. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

35. JHS' use of a reproduction, counterfeit, copy, or colorable imitation of the famous Gibson Trademarks, without Gibson's consent, in commerce in connection with the sale, offering for sale, distribution, or advertising of their products or services is likely to cause confusion, or to cause mistake, or to deceive the public, and thus constitutes trademark infringement pursuant to 15 U.S.C.§ 1114.

36. The complained of acts constitute willful, deliberate and intentional infringement of Gibson's federally registered trademarks for the Gibson Trademarks in violation of §32(1) of the Lanham Act (15 U.S.C. §1114(1)).

37. JHS' intentional and willful infringement of the Gibson Trademarks has caused, and will continue to cause, damage to Gibson and is causing irreparable harm to Gibson for which there is no adequate remedy at law. JHS is directly liable for these actions.

COUNT II

Trademark Counterfeiting Under The United States Trademark Act (15 U.S.C. 1114(1))

38. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

39. Upon information and belief, JHS intentionally used, without Gibson's consent, a counterfeit version of the Gibson Trademarks in commerce, knowing that the marks were counterfeit. JHS used the counterfeit marks in connection with the sale, offering for sale, or distribution of their goods and services, which is likely to cause confusion, or cause mistake, or deceive the public.

40. The complained of acts constitute trademark counterfeiting in violation of Section 32(1) of the Lanham Act (15 U.S.C. §1114(1)).

COUNT III

False Designation of Origin and Unfair Competition Under The United States Trademark Act (15 U.S.C. 1125(a))

41. Gibson repeats the allegations set forth in paragraphs 1 through 33.

42. JHS' use of the Gibson Trademarks, without Gibson's consent, in commerce to promote, market, or sell their products or services in direct competition with Gibson's products and services constitutes False Designation of Origin and Unfair Competition pursuant to 15 U.S.C. § 1125(a). JHS' use of the Gibson Trademarks is a false designation of origin, a false or misleading description of fact, and/or a false or misleading representation of fact, which is likely to cause confusion, or cause mistake, or to deceive as to the affiliation, connection, or association of JHS with Gibson and/or as to the origin, sponsorship, or approval of JHS' productions and commercial activities with Gibson.

43. The complained of acts constitute willful, deliberate and intentional false designations of origin as to products made available by JHS and unfair competition in violation of §43(a) of the Lanham Act (15 U.S.C. §1125(a)).

44. JHS' wrongful activities have caused - and unless enjoined by this Court - will continue to cause irreparable injury and other damages to Gibson's business and reputation, and will continue to cause damage to the goodwill it has developed in its Gibson Trademarks. Gibson has no adequate remedy at law.

COUNT IV

False Descriptions of Fact and Representations and False Advertising Under The United States Trademark Act (15 U.S.C. 1125(a))

45. Gibson repeats the allegations set forth in paragraphs 1 through 33.

46. JHS' use of the Gibson Trademarks, without Gibson's consent, in commercial advertising or promotion to promote, market, or sell their products or services in direct competition with Gibson's products and services constitutes False Description of Fact and Representation and False Adverting pursuant to 15 U.S.C. § 1125(a). JHS' use of the Gibson Trademarks in commercial advertising or promotion misrepresents the nature, characteristics, qualities, or geographic origin of their goods, services, or activities.

47. The complained of acts constitute willful, deliberate and intentional false and misleading descriptions of fact, and false advertising in violation of §43(a) of the Lanham Act (15 U.S.C. §1125(a)).

48. JHS' wrongful activities have caused - and unless enjoined by this Court - will continue to cause irreparable injury and other damages to Gibson's business and reputation, and will continue to cause irreparable injury to the goodwill it has developed in its the Gibson Trademarks. Gibson has no adequate remedy at law.

COUNT V

Trademark Dilution Under The United States Trademark Act (15 U.S.C. 1125(c))

49. Gibson repeats the allegations set forth in paragraphs 1 through 33.

50. JHS' unauthorized use of the famous Gibson Trademarks is likely to dilute and blur the distinctive quality of these marks and to tarnish the Gibson Trademarks.

51. The complained of acts have diluted and damaged the distinctive quality of Gibson's famous Gibson Trademarks and constitute trademark dilution of the famous marks in violation of §43(c) of the Lanham Act (15 U.S.C. §1125(c)).

52. Upon information and belief, JHS willfully intended to trade on Gibson's reputation and/or cause dilution and tarnishment of Gibson's famous Gibson Trademarks.

COUNT VI

Trade Dress Infringement Under Federal Law

53. Gibson repeats the allegations set forth in paragraphs 1 through 33.

54. Gibson has used in interstate commerce the inherently distinctive product designs in connection with the sale and marketing of its guitars. The Gibson designs, namely: SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, Flying V Body Shape Design® Trademark and the Kramer Peghead Design® Trademark contain inherently distinctive, nonfunctional features that are protected under the Lanham Act §43(a) (15 U.S.C. 1125(a)). In addition, all of these design marks have acquired distinctiveness and signify Gibson as the manufacturer in the mind of the average consumer. The ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark are distinctive designs owned exclusively by Gibson, achieving secondary meaning for over 45 years with Gibson spending millions of dollars on promotion of the Gibson Trademarks for over 50 years and consumers recognizing the ES Body Shape Design® Trademark and Flying V Peghead Design® Trademark as having the quality and standards that only Gibson can provide.

55. JHS' use of the infringing trade dress has confused and is likely to continue to cause confusion, or cause mistake, or deceive the consuming public into believing that JHS' Unauthorized Products are authorized, sponsored or approved by Gibson.

COUNT VII

Trademark Dilution Under

California Business and Professions Code (Section 14330)

56. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

57. The complained of acts are likely to cause injury to the business reputation of, or otherwise dilute, the distinctive quality of the Gibson Trademarks in violation of §14330 of the California Business and Professions Code.

COUNT VIII

Common Law Trademark Infringement and Unfair Competition

58. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

59. The complained of acts constitute trademark infringement, palming off, and unfair competition in violation of the common law of the State of California.

COUNT IX

Unfair Competition Under

California Business and Professions Code (Section 17200)

60. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

61. The complained of acts constitute unlawful acts of unfair competition and unlawful, unfair and fraudulent business practices in violation of §17200, *et seq.* of the California Business and Professions Code.

COUNT X

Accounting

Common Law

62. Gibson repeats the allegations set forth in Paragraphs 1 through 33.

63. JHS' activities, as alleged above, have violated Plaintiff's rights in the Gibson Trademarks under common law.

64. As a direct result of the infringing activities, JHS has been unjustly enriched through fraudulent conversion of Plaintiff's goodwill and rights in its trademarks into their own profits through the sale of infringing products and has caused Plaintiff to lose sales of its genuine goods and services.

65. As a direct result of JHS' misconduct, JHS has received substantial profits, to which Plaintiff is entitled under common law.

66. The amount of said profits is unknown to Plaintiff and cannot be ascertained without an accounting.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Gibson Brands, Inc. prays for judgment as follows:

1. That judgment be entered in favor of Plaintiff on all causes of action set forth herein.

2. That in accordance with Section 35 of the Lanham Act (15 U.S.C. §1117), Plaintiff be awarded monetary damages sufficient to recover: (1) Defendants' profits on JHS' Unauthorized Products; (2) all damage suffered by Plaintiff; and (3) the costs of this action and that said amount be trebled or otherwise multiplied to the extent permitted by statute. In addition, Plaintiff reserves the right to elect statutory damages up to and including $1,000,000 per counterfeit mark pursuant to 15 U.S.C. §1117(c).

3. That Plaintiff be awarded such other monetary damages, recovery and awards as appropriate under the law.

4. That JHS' conduct violates the provisions of the California Business & Professions Code sections 17200-17210 and constitutes trademark infringement and unfair competition under the common law of the State of California.

5. That JHS, its officers, directors, principals, agents, servants, affiliates, employees, attorneys, representatives, successors and assigns, and all those in privy or acting in concert or participation with JHS, and each and all of them, be preliminarily and permanently enjoined and restricted from directly or indirectly:

(a) claiming or representing that any products and/or services sold by JHS are made directly by Gibson pursuant to Gibson's strict quality control standards or Gibson has authorized or licensed the use by JHS of the Gibson Trademarks for those products;

(b) using, in any manner, or holding itself out as having rights to use the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark or any other name, mark or design confusingly similar to the Gibson Trademarks to designate, describe or refer to themselves or in conjunction with any product or service, including any use in conjunction with any Internet activities conducted by it or on its behalf such as any use as a domain name or in the text, graphics and hypertext metatags of any Internet website;

(c) requesting or inducing Internet search engines to display links to the JHS' website or other websites displaying or promoting JHS' products or services when

potential customers using those search engines search for terms containing variations of the SG Body Shape Design® Trademark, Explorer Body Shape Design® Trademark, ES Body Shape Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark;

(d) selling, offering for sale, promoting, advertising, distributing or providing or offering to provide any goods or services in conjunction with the Gibson Trademarks or any other name, mark or design confusingly similar to the Gibson Trademarks in conjunction with any product or service; and

(e) engaging in any course of conduct likely to cause confusion, deception or mistake or injure Plaintiff's business reputation or dilute the Gibson Trademarks or appropriate the good will and reputation of said marks or lead to the passing off of JHS' products and services as Gibson products and services.

6. That the Court issue an Order directing JHS to file with the Court and serve on Plaintiff, within thirty (30) days after the service on JHS of such injunctions, a report in writing and under oath, setting forth in detail the manner and form in which JHS has complied with the injunction.

7. That the Court award judgment in favor of the Plaintiff in the amount of treble damages.

8. That the Court award to Plaintiff punitive damages sufficient to deter JHS from committing such willful acts of infringement in the future.

9. That the Court require a full and complete accounting of all monies received by JHS as a result of the infringement.

10. That JHS be required to deliver to Plaintiff all merchandise, packaging, labels, boxes, cartons, advertising, brochures, documents, advertising and promotional materials and other things, possessed, used or distributed by Defendant, or on its behalf, which use the Gibson Trademarks or any other name, mark or design confusingly similar to the Gibson Trademarks.

11. That Plaintiff be awarded the costs of this action and its disbursements, and reasonable attorneys' and investigatory fees incurred, and as otherwise appropriate herein, pursuant to 15 U.S.C. §1117 or other appropriate statute or law.

12. For interest on all amounts found to be due to Plaintiff from JHS, at the prevailing rate, from the date of said amounts or any part thereof became or becomes due.

13. That the Court require JHS to notify its commercial associates, dealers, master distributors, suppliers and customers of this Order.

14. That Plaintiff be granted such other monetary, equitable and further relief, as this Court may deem appropriate under federal, state and common law.

15. That the Court retain jurisdiction of this action for the purpose of enabling Plaintiff to apply to the Court, at any time, for such further orders and directions as may be necessary or appropriate for the interpretation or execution of any Order entered in this action, for the modification of any such Order, for the enforcement or compliance therewith and for the punishment of any violation thereof.

DEMAND FOR JURY TRIAL

Gibson hereby demands a jury trial on all issues.

Respectfully submitted, this 23rd of January 2014.

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
(WESTERN DIVISION – LOS ANGELES)

GIBSON BRANDS, INC., a Delaware corporation,

Plaintiff,

v.

JOHN HORNBY SKEWES & CO. LTD., a United Kingdom Corporation; and DOES 1 through 10,

Defendants.

Case No. CV 2:14-00609-DDP-SS

DEFENDANT JOHN HORNBY SKEWES & CO. LTD.'S ANSWER AND COUNTERCLAIMS

Complaint filed: January 27, 2014
Judge: Hon. Dean D. Pregerson

Defendant, John Hornby Skewes & Co. LTD. (hereinafter "Defendant" or "Counterclaimant" or "JHS"), by and through its attorneys Buche and Associates, P.C., and Bienstock & Michael, P.C., as and for its answer to the complaint filed on January 27, 2014 (the "Complaint") by plaintiff Gibson Guitar Corporation ("Gibson" or "Plaintiff"), in accordance with the numbered paragraphs therein, respectfully alleges as follows:

1. Paragraph 1 of the Complaint contains no allegations and no answer is required. To the extent a response is required, Defendant denies same.

2. Defendant admits that Plaintiff alleges trademark infringement, trade dress infringement, trademark counterfeiting, unfair competition, trademark dilution and other related causes of action under federal, state and common law in connection with Plaintiff's alleged SG Body Design® Trademark, Explorer Body Design® Trademark, ES Body Design® Trademark, Flying V Body Shape Design® Trademark, Flying V Peghead Design® Trademark and the Kramer Peghead Design® Trademark. Defendant denies these, and all remaining allegations in paragraph 2 of the Complaint.

3. Defendant is presently without knowledge or information sufficient to form a belief as to the allegations contained in paragraph 3 of the Complaint, and on that basis denies the same.

4. Defendant admits the allegations in paragraph 4 of the Complaint.

5. Defendant denies the allegations in paragraph 5 of the Complaint.

6. Defendant admits that representatives of JHS attended the 2014 Winter NAMM Show. Defendant denies the remaining allegations in paragraph 6 of the Complaint.

7. Defendant is presently without knowledge or information sufficient to form a belief as to the allegations contained in paragraph 7 of the Complaint, and on that basis denies the same.

8. Paragraph 8 of the Complaint contains conclusions of law to which no response is required. To the extent paragraph 8 contains factual allegations, Defendant denies.

9. Paragraph 9 of the Complaint contains conclusions of law to which no response is required. To the extent paragraph 9 contains factual allegations, Defendant denies.

10. Defendant denies that the SG Body Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant avers that the SG Body Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 10 of the Complaint.

11. Defendant denies that the Explorer Body Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant denies that Plaintiff has used the Explorer Body Design® Trademark continuously since 1958. Defendant avers that the

Explorer Body Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 11 of the Complaint.

12. Defendant denies that the ES Body Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant avers that the ES Body Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 12 of the Complaint.

13. Defendant denies that the Flying V Body Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant denies that Plaintiff has used the Flying V Body Design® Trademark continuously since 1958. Defendant avers that the Flying V Body Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 13 of the Complaint.

14. Defendant denies that the Flying V Peghead Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant denies that Plaintiff has used the Flying V Peghead Design® Trademark continuously since 1958. Defendant avers that the Flying V Peghead Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 14 of the Complaint.

15. Defendant denies that the Kramer Peghead Design® Trademark is distinctive and an indicator of source and that Plaintiff is the sole owner or has used it exclusively in commerce. Defendant denies that Plaintiff has used the Kramer Peghead Design® Trademark continuously since 1958. Defendant avers that the Kramer Peghead Design is a generic shape used throughout the industry. Defendant admits the remaining allegations contained in Paragraph 15 of the Complaint.

16. Defendant is presently without knowledge or information sufficient to form a belief as to the allegations contained in paragraph 16 of the Complaint, and on that basis denies the same.

17. Defendant denies the allegations contained in Paragraph 17 of the Complaint.

18. Defendant denies the allegations contained in Paragraph 18 of the Complaint.

19. Defendant denies that the Gibson Trademarks are used exclusively in commerce by Gibson. The remaining allegations of Paragraph 19 of the Complaint are conclusions of law to which no response is required. To the extent that the remaining allegations in Paragraph 19 are factual allegations, Defendant denies.

20. Defendant denies the allegations in Paragraph 20 of the Complaint.

21. Defendant denies the allegations in Paragraph 21 of the Complaint.

22. Defendant denies the allegations in Paragraph 22 of the Complaint.

23. Defendant denies the allegations in Paragraph 23 of the Complaint.

24. Defendant denies the allegations in Paragraph 24 of the Complaint.

25. Defendant denies the allegations in Paragraph 25 of the Complaint.

26. Defendant denies the allegations in Paragraph 26 of the Complaint.

27. Defendant admits that it received correspondence from Plaintiff's counsel. Defendant denies the remaining allegations in Paragraph 27 of the Complaint.

28. Defendant denies the allegations in Paragraph 28 of the Complaint.

29. Defendant admits that it exchanged correspondence with Plaintiff's counsel. Defendant denies the remaining allegations in Paragraph 29 of the Complaint.

30. Defendant denies the allegations in Paragraph 30 of the Complaint.

31. Defendant denies the allegations in Paragraph 31 of the Complaint.

32. Defendant denies the allegations in Paragraph 32 of the Complaint.

33. The allegations of Paragraph 33 of the Complaint are conclusions of law to which no response is required. To the extent that the remaining allegations in Paragraph 33 are factual allegations, Defendant denies.

34. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

35. Defendant denies the allegations in Paragraph 35 of the Complaint.

36. Defendant denies the allegations in Paragraph 36 of the Complaint.

37. Defendant denies the allegations in Paragraph 37 of the Complaint.

38. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

39. Defendant denies the allegations in Paragraph 39 of the Complaint.

40. Defendant denies the allegations in Paragraph 40 of the Complaint.

41. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

42. Defendant denies the allegations in Paragraph 42 of the Complaint.

43. Defendant denies the allegations in Paragraph 43 of the Complaint.

44. Defendant denies the allegations in Paragraph 44 of the Complaint.

45. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

46. Defendant denies the allegations in Paragraph 46 of the Complaint.

47. Defendant denies the allegations in Paragraph 47 of the Complaint.

48. Defendant denies the allegations in Paragraph 48 of the Complaint.

49. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

50. Defendant denies the allegations in Paragraph 50 of the Complaint.

51. Defendant denies the allegations in Paragraph 51of the Complaint.

52. Defendant denies the allegations in Paragraph 52 of the Complaint.

53. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

54. Defendant denies the allegations in Paragraph 54 of the Complaint.

55. Defendant denies the allegations in Paragraph 55 of the Complaint.

56. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

57. Defendant denies the allegations in Paragraph 57 of the Complaint.

58. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

59. Defendant denies the allegations in Paragraph 59 of the Complaint.

60. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

61. Defendant denies the allegations in Paragraph 61 of the Complaint.

62. Defendant repeats and re-alleges its prior responses as if fully set forth at length.

63. Defendant denies the allegations in Paragraph 63 of the Complaint.

64. Defendant denies the allegations in Paragraph 64 of the Complaint.

65. Defendant denies the allegations in Paragraph 65 of the Complaint.

66. Defendant denies the allegations in Paragraph 66 of the Complaint.

AFFIRMATIVE DEFENSES

Defendant reserves the right to supplement its affirmative defenses as the action proceeds.

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FIRST AFFIRMATIVE DEFENSE
(Failure to State a Claim)

67. The Complaint, on one or more counts set forth therein, fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE
(Fair Use)

68. The claims made in the Complaint are barred, in whole or in part, by the doctrines of fair use, nominative fair use and/or descriptive use.

THIRD AFFIRMATIVE DEFENSE
(Invalidity of Trademark)

69. One or more of the asserted trademark registrations is invalid, or otherwise unenforceable.

FOURTH AFFIRMATIVE DEFENSE
(Generic and/or Otherwise Unprotectable)

70. The claims made in the Complaint are barred, in whole or in part, on the basis that any marks and use of marks at issue are generic, or otherwise unprotectable as said marks lack secondary meaning and/or do not serve as source identifiers.

FIFTH AFFIRMATIVE DEFENSE
(Innocent Infringement)

71. The claims made in the Complaint are barred, in whole or in part, because any infringement, if any, was innocent.

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SIXTH AFFIRMATIVE DEFENSE
(Statutes of Limitations)

72. The claims made in the Complaint are barred, in whole or in part, by applicable statutes of limitations.

SEVENTH AFFIRMATIVE DEFENSE
(Laches)

73. The claims made in the Complaint are barred by laches, in that Plaintiff has unreasonably delayed efforts to enforce its rights, if any, despite its full awareness of Defendant's actions.

EIGHTH AFFIRMATIVE DEFENSE
(No Protectable Trade Dress)

74. One or more of the asserted trade dresses are invalid because the alleged designs are generic, and/or have not acquired secondary meaning.

NINTH AFFIRMATIVE DEFENSE
(Waiver, Acquiescence, and Estoppel)

75. Each of the purported claims set forth in this Complaint is barred by the doctrines of waiver, acquiescence, and estoppel.

TENTH AFFIRMATIVE DEFENSE
(Non-Infringement)

76. Defendant has not infringed any applicable trademarks under federal or state law.

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ELEVENTH AFFIRMATIVE DEFENSE
(No Causation)

77. Plaintiff's claims against Defendant are barred because Plaintiff's damages, if any, were not caused by Defendant.

TWELFTH AFFIRMATIVE DEFENSE
(No Damage/No Right to Accounting)

78. Without admitting that the Complaint states a claim, there has been no damage in any amount, manner or at all by reason of any act alleged against Defendant in the Complaint, and the relief prayed for in the Complaint therefore cannot be granted, and Plaintiff is not otherwise entitled to an accounting.

THIRTEENTH AFFIRMATIVE DEFENSE
(Unclean Hands)

79. Upon information and belief, Plaintiff's claims are barred by the doctrine of unclean hands.

FOURTEENTH AFFIRMATIVE DEFENSE
(Lack of Irreparable Harm)

80. Plaintiff's claims for injunctive relief are barred because Plaintiff cannot show that it will suffer any irreparable harm from Defendant's actions.

FIFTEENTH AFFIRMATIVE DEFENSE
(Adequacy of Remedy at Law)

81. The alleged injury or damage suffered by Plaintiff, if any, would be adequately compensated by damages. Accordingly, Plaintiff has a complete and adequate remedy at law and is not entitled to seek equitable relief.

SIXTEENTH AFFIRMATIVE DEFENSE
(Failure to Mitigate)

82. The claims made in the Complaint are barred, in whole or in part, because of a failure to mitigate damages, if such damages exist.

SEVENTEENTH AFFIRMATIVE DEFENSE
(Not a Famous Mark)

83. Defendant cannot be liable for dilution because one or more of the asserted marks is not a famous mark that is distinctive and widely recognized by the general consuming public of the United States as a designation solely of Plaintiff's goods.

EIGHTEENTH AFFIRMATIVE DEFENSE
(Duplicative Claims)

84. Without admitting that the Complaint states a claim, any remedies are limited to the extent that the Complaint seeks an overlapping or duplicative recovery pursuant to the various claims against Defendant or others for any alleged single wrong.

NINETEENTH AFFIRMATIVE DEFENSE
(Fraud)

85. Upon information and belief, the claims made in the Complaint are barred, in whole or in part, by Plaintiff's actions which amounted to a fraud on the United States Patent & Trademark Office during the prosecution of the applications that matured into the registrations of the asserted marks.

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TWENTIETH AFFIRMATIVE DEFENSE
(Third-Party Use)

86. The claims made in the Complaint are barred, in whole or in part, by reason of other parties' use of any marks at issue.

TWENTY-FIRST AFFIRMATIVE DEFENSE
(Actions of Others)

87. The claims made in the Complaint are barred, in whole or in part, because Defendant is not liable for the acts of others over whom it has no control.

TWENTY-SECOND AFFIRMATIVE DEFENSE
(No Unfair Competition)

88. Defendant's acts do not amount to unfair competition, under statutory or common law, because Defendant did not represent its products as originating from Plaintiff and in no other way unfairly competed with Plaintiff.

TWENTY-THIRD AFFIRMATIVE DEFENSE
(Trademark Misuse)

89. Upon information and belief, Plaintiff's claims amount to trademark misuse.

TWENTY-FOURTH AFFIRMATIVE DEFENSE
(No Punitive Damages)

90. Defendant alleges that no punitive or exemplary damages should be awarded arising out of the claims made in the Complaint under the law of the United States and California because: (i) an award of punitive or exemplary damages would be unconstitutional under the United States and California Constitutions; specifically,

the First Amendment to the United States Constitution and Article I, Section 2 of the California Constitution; (ii) any recovery of punitive or exemplary damages arising out of the claims made in the Complaint would constitute the imposition of a criminal fine or penalty without the substantive or procedural safeguards guaranteed by the Fifth and Fourteenth Amendments to the United States Constitution and by Article I, Section 7 of the California Constitution; (iii) the imposition of any punitive or exemplary damages in this lawsuit would constitute an excessive fine or penalty under Article I, Section 17 of the California Constitution; (iv) any such award is precluded or limited pursuant to Section 3294 of the California Civil Code or the United States Constitution and the due process clause; and (v) punitive damages would violate the United States and California Constitutions and common law because such an award is based from procedures that are vague, open-ended unbound in discretion, arbitrary and without sufficient constraints or protection against arbitrary and excessive awards.

ADDITIONAL DEFENSES

91. Defendant reserves the right to assert additional defenses based on information learned or obtained during discovery.

ANSWER TO PRAYER FOR RELIEF

Defendant denies that Plaintiff is entitled to any relief from Defendant and prays that this Court deny all relief demanded by Plaintiff in the Complaint.

COUNTERCLAIMS BY DEFENDANT/COUNTERCLAIMANT JOHN HORNBY SKEWES & CO. LTD.

For its Counterclaims against Plaintiff/Counterdefendant Gibson Corporation ("Gibson" or Plaintiff'), Defendant John Hornby Skewes & Co. LTD. (hereinafter "Defendant" or "Counterclaimant" or "JHS") alleges as follows:

FIRST COUNTERLCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,215,791

92. Plaintiff is owner of U.S. Trademark Registration No. 2,215,791 for the two-dimensional body shape for an electric guitar (the "'791 Body Shape").

93. For decades, countless other manufacturers have manufactured and sold in the United States electric guitars incorporating a body shape identical or substantially similar to the '791 Body Shape.

94. As a result of the foregoing, the '791 Body Shape is a generic electric guitar body shape and does not function as a source identifier.

95. Allowing Plaintiff trademark protection, and exclusive use, for the generic '791 Body Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

96. Allowing continued registration of the generic '791 Body Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

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SECOND COUNTERCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,053,805

97. Plaintiff is owner of U.S. Trademark Registration No. 2,053,805 for the two-dimensional body shape for an electric guitar (the "'805 Body Shape").

98. For decades, countless other manufacturers have manufactured and sold in the United States electric guitars incorporating a body shape identical or substantially similar to the '805 Body Shape.

99. As a result of the foregoing, the '805 Body Shape is a generic electric guitar body shape and does not function as a source identifier.

100. Allowing Plaintiff trademark protection, and exclusive use, for the generic '805 Body Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

101. Allowing continued registration of the generic '805 Body Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

THIRD COUNTERCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,007,277

102. Plaintiff is owner of U.S. Trademark Registration No. 2,007,277 on the Supplemental Register for the two-dimensional body shape for an electric guitar (the "'277 Body Shape").

103. For decades, countless other manufacturers have manufactured and sold in the United States electric guitars incorporating a body shape identical or

substantially similar to the '277 Body Shape.

104. As a result of the foregoing, the '277 Body Shape is a generic electric guitar body shape, does not function as a source identifier and has not acquired secondary meaning for Plaintiff.

105. Allowing Plaintiff trademark protection, and exclusive use, for the generic '277 Body Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

106. Allowing continued registration of the generic '277 Body Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

FOURTH COUNTERCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,051,790

107. Plaintiff is owner of U.S. Trademark Registration No. 2,051,790 for the two-dimensional body shape for an electric guitar (the "'790 Body Shape").

108. For decades, countless other manufacturers have manufactured and sold in the United States electric guitars incorporating a body shape identical or substantially similar to the '790 Body Shape.

109. As a result of the foregoing, the '790 Body Shape is a generic electric guitar body shape and does not function as a source identifier.

110. Allowing Plaintiff trademark protection, and exclusive use, for the generic '790 Body Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

111. Allowing continued registration of the generic '790 Body Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

FIFTH COUNTERCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 3,976,202

112. Plaintiff is owner of U.S. Trademark Registration No. 3,976,202 on the Supplemental Register for the two-dimensional shape for the headstock of a guitar (the "'202 Headstock Shape").

113. For decades, countless other manufacturers have manufactured and sold in the United States guitars incorporating a headstock identical or substantially similar to the '202 Headstock Shape.

114. As a result of the foregoing, the '202 Headstock Shape is a generic shape for the headstock of a guitar, does not function as a source identifier and has not acquired secondary meaning for Plaintiff.

115. Allowing Plaintiff trademark protection, and exclusive use, for the generic '202 Headstock Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

116. Allowing continued registration of the generic '202 Headstock Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

SIXTH COUNTERCLAIM

CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 1,567,052

117. Plaintiff is owner of U.S. Trademark Registration No. 1,567,052 for the

two-dimensional shape for the headstock of a guitar (the "'052 Headstock Shape").

118. For decades, countless other manufacturers have manufactured and sold in the United States guitars incorporating a headstock identical or substantially similar to the '052 Headstock Shape.

119. As a result of the foregoing, the '052 Headstock Shape is a generic shape for the headstock of a guitar and does not function as a source identifier.

120. Allowing Plaintiff trademark protection, and exclusive use, for the generic '052 Headstock Shape puts Counterclaimant, and all other guitar manufacturers, at a non-reputational disadvantage.

121. Allowing continued registration of the generic '502 Headstock Shape interferes with Counterclaimant's ability to advertise and creates unfair competition.

PRAYER FOR RELIEF

WHEREFORE, Defendant and Counterclaimant JOHN HORNBY SKEWES & CO. LTD. prays for judgment as follows:

A. That Plaintiff take nothing by way of the Complaint;

B. That the Complaint, and each and every purported claim for relief therein, be dismissed with prejudice;

C. Cancellation of U.S. Trademark Registration Nos. 2,215,791, 2,053,805, 2,007,277, 2,051,790, 3,976,202 and 1,567,052;

D. That Defendant/Counterclaimant be awarded costs of suit incurred herein, including attorneys' fees and expenses; and

E. For such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Defendant demands trial by jury on all issues so triable.

Dated: May 30, 2014

BUCHE AND ASSOCIATES, P.C.

By: */s/ John K. Buche*

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Attorneys for Defendant
JOHN HORNBY SKEWES & CO. LTD.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copies of **DEFENDANT JOHN HORNBY SKEWES & CO. LTD.'S ANSWER AND COUNTERCLAIMS** has been served on this date to all counsel of record, if any to date, who are deemed to have consented to electronic service via the Court's CM/ECF system pursuant to L.R. 5-3.2.2. Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery upon their appearance in this matter.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct. Executed this 30th day of May, 2014 at Beverly Hills, California.

Date: May 30, 2014

BUCHE AND ASSOCIATES, P.C.

By: */s/ Lindsay D. Molnar*
Lindsay D. Molnar (Bar No. 275156)

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

CME

Mailed: December 30, 2014

Cancellation No. 92058944

John Hornby Skewes & Co., Ltd

v.

Gibson Brands, Inc.

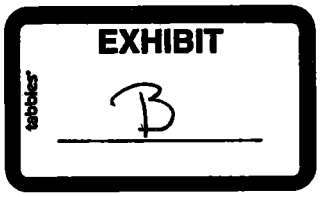
Christen M. English, Interlocutory Attorney:

This case now comes up for consideration of Respondent's motion, filed October 9, 2014, to suspend this proceeding in favor of a pending federal court action between the parties (*Gibson Brands, Inc. v. John Hornby Skewes & Co. Ltd.,* Case No. 2:14-cv-00609-DDP-SS, pending in the U.S. District Court for the Central District of California ("Federal Case").[1] Petitioner opposes the motion.

The Board has considered the parties' arguments and presumes the parties' familiarity with the factual basis for the motion, and does not recount the facts or arguments here, except as necessary to explain the decision.

The Board's well-settled policy is to suspend proceedings when one or both parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); *see also New*

[1] The Board notes Respondent's answer, filed November 3, 2014.



Orleans Louisiana Saints LLC v. Who Dat?, 99 USPQ2d 1550, 1552 (TTAB 2011) ("[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board."); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933, 1937 (TTAB 1992). After reviewing the pleadings in the Federal Case, the Board finds that a resolution of the issues raised in the Federal Case may have a bearing on this proceeding as some of the counterclaims that Petitioner has brought in the Federal Case are the same as the claims it has brought here, namely, that the registrations involved in this proceeding should be cancelled on the ground that the involved marks are generic product configurations.[2]

Because the Federal Case "may have a bearing" on this one, proceeding here prior to termination of the Federal Case would be inefficient and pose a risk of inconsistent judgments. Indeed, "[t]he decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding on the court." TBMP § 510.02(a) (2014); *see also The Other Telephone Co. v. Connecticut Nat'l Telephone Co., Inc.*, 181 USPOQ 779 (Comr. 1974); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

Accordingly, Respondent's motion to suspend is **GRANTED** and proceedings are suspended pending final disposition of the Federal Case. Within **TWENTY DAYS** after the final determination of the Federal Case,

[2] The district court denied Respondent's motion to dismiss these counterclaims. *See* Reply, Exhibit A.

the parties shall so notify the Board, including a copy of the court's final order, and call this case up for any appropriate action. During the suspension period, the Board shall be notified of any address changes for the parties or their attorneys.

***

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Attorneys for Defendant
JOHN HORNBY SKEWES & CO. LTD.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

WESTERN DIVISION

GIBSON BRANDS, INC., a Delaware corporation,

Plaintiff,

v.

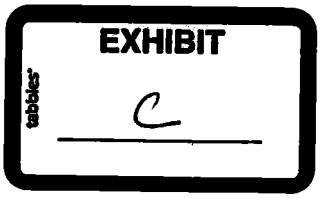
JOHN HORNBY SKEWES & CO. LTD., a United Kingdom Corporation; and DOES 1 through 10,

Defendants.

Case No. CV 2:14-00609-DDP-SS

DEFENDANT JOHN HORNBY SKEWES & CO. LTD.'S BRIEF IN OPPOSITION TO PLAINTIFF'S MOTION TO STRIKE/DISMISS

Judge: Hon. Dean D. Pregerson
Hearing Date: July 21, 2014
Time: 10:00 a.m.
Courtroom: 3



Defendant John Hornby Skewes & Co. Ltd. ("JHS") respectfully submits this memorandum of law in opposition to Plaintiff Gibson Brands, Inc.'s ("Gibson" or "Plaintiff") Motion to Strike JHS's Affirmative Defenses and Dismiss JHS's Counterclaims (the "Motion"). Even if Gibson's Motion to Strike JHS's Affirmative Defenses had merit, striking the affirmative defenses would not remove any issues in this case. At best, Gibson will have wasted the Court's time and resources for a meaningless procedural ruling.

Further, JHS has met its burden by pleading sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face. Accordingly, the Motion to Dismiss should be denied in its entirety.

ARGUMENT

A. Gibson's Objections to JHS's Affirmative Defenses Are Either Meritless or Would Have No Impact on Streamlining this Case.

> Federal Rule of Civil Procedure 12(f) provides that in its answer to the pleadings, the moving party may request that the court "order stricken from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." "Immaterial" means that the matter has no bearing on the controversy before the court. See Fantasy, Inc. v. Fogerty, 984 F.2d 1524, 1527 (9th Cir.1993) rev'd on other grounds, 510 U.S. 517, 534-35, 114 S.Ct. 1023, 127 L.Ed.2d 455 (1994). If there is any doubt as to whether the allegations might be an issue in the action, courts will deny the motion.

In re 2TheMart.com, Inc. Sec. Litig., 114 F. Supp. 2d 955, 965 (C.D. Cal. 2000).

"As a rule, motions to strike are regarded with disfavor because striking is such a drastic remedy; as a result, such motions are infrequently granted." Vogel v. OM

ABS, Inc., 2014 WL 340662 at *2 (C.D. Cal. Jan. 30, 2014). "If a claim is stricken, leave to amend should be freely given when doing so would not cause prejudice to the opposing party." Id.

Gibson states that this Motion will "save judicial resources." Motion at 6. This Motion is accomplishing the exact opposite. Even if it was meritorious and the defenses are stricken, it is requiring the Court to expend its resources on a Motion that will not streamline the case in the least. Further, many of Gibson's objections are without merit.

Gibson seeks to strike JHS's first affirmative defense on the basis that "failure to state a claim is not an affirmative defense[,]' but, rather, 'should be brought as a motion to dismiss." Motion at 7. A motion to dismiss for failure to state a claim needs to be filed before a responsive pleading. Fed. R. Civ. P. 12(b)(6). JHS has already filed an answer. Dkt. No.19 (the "Answer"). If Gibson's position is correct, striking the first affirmative defense will have no effect on the case as JHS can no longer file a motion to dismiss. Therefore, nothing is accomplished by striking the first affirmative defense.

Gibson seeks to strike JHS's fifth affirmative defense because "lack of willfulness is not an affirmative defense but rather a denial of liability by disputing the elements if the claim." Motion at 7. Gibson argues, in the alternative, that "for the claims that do not require willfulness, such as trademark infringement, this Court should strike this defense as immaterial." Id. JHS's affirmative defense of lack of

willfulness is not a denial of liability; it is a proper affirmative defense because if even all the allegations in the Complaint are true, a lack of willfulness would negate liability for JHS, especially on the counts of counterfeiting and the issue of this matter being an exceptional case pursuant to 15 U.S.C. §1117.

Gibson seeks to strike JHS's fifth, tenth, eleventh, twelfth, fourteenth, seventeenth, twenty-first and twenty-second affirmative defenses all as being denials of liability rather than affirmative defenses. Motion at 7–9. Even if this is true, striking the affirmative defenses will not remove these issues from the case. Nothing will be accomplished in terms of streamlining the case. Again, Gibson's Motion does nothing but wastes the Court's resources and delays the case.

Gibson objects to JHS's second, sixth, seventh, ninth, thirteen and twenty-third affirmative defense as they allegedly "fail to provide proper notice as to what the defense entails or failed to plead sufficient facts to make the defense plausible on its face." Id. at 9. Gibson then spends pages in an attempt to convince the Court to not follow binding 9th Circuit precedent. Id. at 9–11. The "fair notice" standard for affirmative defenses set forth in Wyshak v. City Nat. Bank, 607 F.2d 824, 827 (9th Cir. 1979), is the controlling law in this Circuit. JHS's affirmative defenses clearly give Gibson fair notice of the defenses and, therefore, the Motion should be denied.

Gibson's argument that it "cannot prepare a response" to the affirmative defenses is confusing. Id. at 11. Fed. R. Civ. P 7(a) states that "[o]nly these pleadings are allowed: (1) a complaint; (2) an answer to a complaint; (3) an answer to a

counterclaim designated as a counterclaim; (4) an answer to a crossclaim; (5) a third-party complaint; (6) an answer to a third-party complaint; and (7) if the court orders one, a reply to an answer." Since Gibson *cannot* file a response to the affirmative defenses, its argument fails.

Gibson's entire argument willfully ignores the existence of discovery. Having properly been put on notice to the defenses, Gibson can seek additional information on these defenses through any and/or all of the discovery methods available.

Gibson objects to JHS's third, fourth and eighth affirmative defenses as being "immaterial." Motion at 13. JHS's third, fourth and eighth affirmative defenses all deal with the asserted trademarks being generic, lacking secondary meaning and not serving as source identifiers. Answer at ¶¶ 69-70, 74. Clearly, this is relevant and material to a trademark infringement action. There is no doubt as to whether the allegations of genericism might be an issue in this action. See In re 2TheMart.com, Inc. Sec. Litig., 114 F. Supp. 2d at 965. Accordingly, Gibson's motion should be denied.

Gibson objects to JHS's twentieth affirmative defense regarding third party usage of the marks at issue. Motion at 14. Gibson then asks the court to draw inferences in its favor that the third parties are licensees of Gibson. In a motion to strike, "[j]ust as with a motion to dismiss for failure to state a claim, the Court must view the pleadings in a light most favorable to the pleading party." In re 2TheMart.com, Inc. Sec. Litig., 114 F. Supp. 2d 955, 965 (C.D. Cal. 2000).

Accordingly, Gibson's request for inferences to be drawn in its favor is improper and the Motion should be denied.

Gibson objects to paragraph 91 of the Answer, which states that JHS "reserves the right to assert additional defenses based on information learned or obtained during discovery." Answer at 91. Gibson relies on Figueroa v. Stater Bros. Markets, Inc., 2013 WL 4758231 (C.D. Cal. Sept. 3, 2013) as its only support for striking this paragraph. This Court clearly had no intention of Figueroa being used as any sort of precedent as it states that "**[t]his Order is not intended for publication. Nor is it intended to be included in or submitted to any online service such as Westlaw or Lexis.**" Id. at *4 (emphasis in original). Accordingly, the Motion should be denied.

Gibson objects to JHS's nineteenth affirmative defense because it fails to meet the heightened pleading standard for fraud. Motion at 14-15. Gibson provides no case law that supports its argument that Fed. R. Civ. P. 9(b) applies to affirmative defenses.

Fed. R. Civ. P 12(b) requires that "[e]very defense to a claim for relief in any pleading must be asserted in the responsive pleading if one is required." If a party files a "pleading to a preceding pleading" (usually an answer to a complaint), and does not include an affirmative defense therein, that defense will be considered waived." 5 Charles A. Wright & Arthur R. Miller, Federal Practice & Procedure § 1278, at 477. Gibson is asking the Court to strike affirmative defenses that JHS *must* plead, or waive, without giving JHS the opportunity to conduct discovery to substantiate these

defenses. Gibson's motion to strike are extremely premature. JHS has properly put Gibson on notice of the affirmative defenses. The Motion should be denied.

Finally, if the Court were to grant the Motion to Strike, JHS respectfully submits that it should be given leave to amend. "If a claim is stricken, leave to amend should be freely given when doing so would not cause prejudice to the opposing party." Vogel, 2014 WL 340662 at *2. Gibson has not alleged that amendment would be futile or that it would be prejudiced in any way by amendment. Accordingly, leave to amend should be granted.

B. Gibson's Arguments for Dismissal of JHS's Counterclaims Are Completely without Merit.

Gibson moves to strike all of JHS's counterclaims on the grounds that they "do not contain any factual allegations to demonstrate Viacom's [*sic*] registered trademarks are generic."[1] Id. at 17. Further, Gibson seems to confuse pleadings with proofs. For the reasons discussed below, these positions fail both legally and factually. Accordingly, the Motion should be denied.

"Under Federal Rule of Civil Procedure 8(a)(2), a [counterclaim] must contain a short and plain statement of the claim showing that the pleader is entitled to relief. Detailed factual allegations are not required." Ashcroft v. Iqbal, 556 U.S. 662, 663 (2009) (internal quotations omitted). A counterclaim will survive a motion to

[1] JHS assumes that Gibson is referring to Gibson's trademarks that are at issue in this case.

dismiss when it contains "sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." Iqbal at 678 (quoting Bell Atl. Corp. v. Twombly, 550 U.S. 544, 570 (2007)). When considering a Rule 12(b)(6) motion, a court must "accept as true all allegations of material fact and must construe those facts in the light most favorable to the plaintiff." Resnick v. Hayes, 213 F.3d 443, 447 (9th Cir.2000).

JHS's six counterclaims seek cancellation of the six trademark registrations asserted by Gibson on the grounds that they are generic. Answer at 15-19. The Lanham Act permits cancellation of the "registration of a mark..by any person who believes that he is or will be damaged,..by the registration of a mark." 15 U.S.C.A. § 1064. "The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration." Cunningham v. Laser Golf Corp., 222 F.3d 943, 945 (Fed. Cir. 2000).

JHS has established both prongs in its counterclaims. Gibson does not challenge JHS' standing, nor could it, as it cannot be denied that, as the defendant in a trademark infringement action, JHS is a party who is or will be damaged by the registration of Gibson's generic trademarks. Accordingly, JHS's counterclaims sufficiently plead standing, and the first requirement for bringing a cancellation proceeding is satisfied.

JHS seeks cancelation of Gibson's asserted trademarks on the grounds that the marks are generic. "It is axiomatic that generic product designs are not entitled to trade dress protection under the Lanham Act, and that even a showing of secondary

meaning is insufficient to protect product designs that are overbroad or generic." Stuart Spector Designs, Ltd., et. al. v. Fender Musical Instruments Corp., 2009 WL 1017284 at *5 (TTAB 2009)(internal quotations and citations omitted). "In the context of product design, genericness may be found where the design is, at a minimum, so common in the industry that it cannot be said to identify a particular source." Id. at *6.[2] "Cases addressing product design suggest that the term "genericness" covers three situations: (1) if the definition of a product design is overbroad or too generalized; (2) if a product design is the basic form of a type of product; or (3) if the product design is so common in the industry that it cannot be said to identify a particular source." Walker & Zanger, Inc. v. Paragon Indus., Inc., 549 F. Supp. 2d 1168, 1174 (N.D. Cal. 2007).

Here, JHS has pled sufficient factual matter to state a claim to relief that is plausible on its face as is required by Iqbal. For each of Gibson's six trademarks, JHS has pled that "[f]or decades, countless other manufacturers have manufactured and sold in the United States electric guitars incorporating" each of the Gibson trademarks and that "[a]s a result of the foregoing, the [Gibson trademarks are] generic..and do[ ]not function as a source identifier[s]." Answer at ¶¶ 93-94, 98-99, 103-104, 108-109, 113-114, 118-119. These allegations, if true, would prove that the product designs are so common in the industry that they cannot be said to identify a particular source.

[2] Stuart Spector Designs, Ltd. will be very instructive in this case as it specifically deals with genericism of product configuration marks for electric guitars and basses.

A naked assertion would simply be "the marks are generic." Here, JHS specifically pleads that use of these marks is so pervasive in the musical instrument industry as to render them generic. Accordingly, JHS sufficiently plead that there are valid grounds for cancellation of the asserted trademarks, and the second requirement for bringing a cancellation proceeding is satisfied.

Gibson points out that four of its trademarks are incontestable pursuant to 15 U.S.C. §§ 1064 and 1115(b). Motion at 17-18. However, as Gibson itself points out, "[a]n incontestable trademark is still subject to cancellation in some instances, including: if the mark becomes generic." Motion at 18; See 15 U.S.C. §§ 1064 and 1115(b). Accordingly, the incontestable status of some of the asserted trademarks is not relevant to a challenge on the grounds of genericism.

Gibson also confuses pleadings with proofs. Gibson argues that JHS pleadings "must rebut this strong presumption of validity" afforded registered marks and that "the examiner's determination" in granting the registrations "is entitled to some weight." Motion at 18, 19. While it may be true that, at trial, JHS will have to overcome certain presumptions, Gibson has not, and cannot, present any case law that places that burden on JHS at the pleading stage.

Gibson argues that JHS's counterclaims are deficient because JHS "has not provided the name of the manufacturers who allegedly use identical or substantially similar marks in the unidentified decades ago." Id. at 21. Gibson then argues that this lack of specific identification renders Gibson "unable to verify" the allegations and that

it cannot "prepare a defense." This is extremely disingenuous as Gibson does not identify in its Complaint which JHS products allegedly infringe the asserted trademarks. Further, Gibson again seems to ignore that it is entitled to discovery before trial and will have ample opportunity to verify and prepare for trial. In any event, this is irrelevant to the analysis of this Motion, because, as stated above, JHS has sufficiently pled factual matter to state a claim for relief that is plausible on its face.

Finally, Gibson does not make any argument that an attempt to amend the counterclaims would be futile or that it would suffer prejudice by amendment. In the event that the Court finds that JHS's counterclaims are procedurally lacking, JHS respectfully requests leave to amend.

CONCLUSION

For the reasons stated above, despite Gibson's claim that this Motion will save judicial resources, it accomplishes nothing but the opposite. Accordingly, the Motion should be denied in its entirety. In the event the Court was to grant a portion or the entirety of the Motion, JHS respectfully requests leave to amend.

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Dated: June 30, 2014

BUCHE AND ASSOCIATES, P.C.

By: */s/ John K. Buche*
John K. Buche (Bar No. 239477)

BIENSTOCK & MICHAEL, P.C.
Brent M. Davis (*Pro Hac Vice*)

Attorneys for Defendant
JOHN HORNBY SKEWES & CO. LTD.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copies of **DEFENDANT JOHN HORNBY SKEWES & CO. LTD.'S BRIEF IN OPPOSITION TO PLAINTIFF'S MOTION TO STRIKE/DISMISS,** documents have been served on this date to all counsel of record, if any to date, who are deemed to have consented to electronic service via the Court's CM/ECF system per CivLR 5.4(d). Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery upon their appearance in this matter.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct. Executed this 30th day of June, 2014 at La Jolla, California.

Date: June 30, 2014

BUCHE AND ASSOCIATES, P.C.

By: */s/ John K. Buche*
John K. Buche (Bar No. 239477)

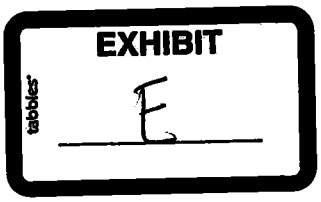
BIENSTOCK & MICHAEL, P.C.
Ronald S. Bienstock (*Pro Hac Vice forthcoming*)

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

In the Matter of Trademark Application Serial No. 86/168,793:
Filing Date: January 17, 2014
Published in the Trademark Official Gazette on June 24, 2014

ARMADILLO ENTERPRISES, INC.; COLLINGS GUITARS, INC.; CORDOBA MUSIC GROUP, INC.; ED ROMAN ENTERPRISES, INC.; E.S.P. SHIBUYA ENTERPRISES, INC.; JAMES TRUSSART GUITARS, INC.; JOHN HORNBY SKEWES & CO., LTD.; JS TECHNOLOGIES, INC.; PEAVEY ELECTRONICS CORPORATION; PREMIER BUILDERS GUILD, LLC; SADOWSKY GUITARS, LTD.; SCHECTER GUITAR RESEARCH, INC.; U.S. MUSIC CORPORATION; WARWICK GMBH & CO. MUSIC EQUIPMENT KG; AND WESTHEIMER CORPORATION, Opposers, v. GIBSON BRANDS, INC. Applicant.	Opposition No.: 91218879 Application Serial No.: 86/168,793

MEMORANDUM OF LAW IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND



Opposers Armadillo Distribution Enterprises, Inc. d/b/a Armadillo Enterprises; Collings Guitars, Inc.; Cordoba Music Group, Inc.; Ed Roman Enterprises, Inc.; E.S.P. Shibuya Enterprises, Inc.; James Trussart Guitars, Inc.; John Hornby Skewes & Co., Ltd.; JS Technologies, Inc.; Peavey Electronics Corporation; Premier Builders Guild, LLC; Sadowsky Guitars, Ltd.; Schecter Guitar Research, Inc.; U.S. Music Corporation; Warwick GmbH & Co. Music Equipment KG; and Westheimer Corporation (collectively, the "Opposers"), respectfully submit this Brief in Opposition to Applicant Gibson Brands, Inc.'s ("Applicant" or "Gibson") Motion to Suspend Proceedings Pending Resolution of a Civil Action (the "Motion"). Gibson's Motion should be denied because *any* resolution in the civil action at issue will not be dispositive to this opposition proceeding and any bearing the civil action may have is minimal at best. In its eight (8) paragraph Motion, Gibson presents nothing but conclusory statements that "resolution of the Prior Pending Civil Action will resolve the issues before the Board." Motion at ¶7. Gibson makes no attempt to explain *how* the civil action will impact this proceeding, especially given the fact that the civil action deals with *a registration that is not at issue in this proceeding*. More importantly, *the civil action is completely devoid of a cause of action regarding lack of secondary meaning*. Even if the issue of genericism is resolved, the 2(f) claim would still need to be adjudicated before the Board. For the reasons set forth fully below, Opposers respectfully request that the Board deny the Motion in its entirety.

I. FACTUAL AND PROCEDRUAL BACKGROUND

The civil action upon which Gibson bases its Motion, Gibson Brands, Inc. v. John Hornby Skewes & Co., Ltd. ("JHS"), Case No. CV 2:14-00609 (the "Prior Civil Action"), was filed in the United States District Court for the Central District California on January 27, 2014. Exhibit A to Kurt Schuettinger's Declaration in Support of Applicant Gibson Brands, Inc.'s

Motion to Suspend Proceedings Pending Resolution of a Civil Action ("Schuettinger Decl.") at 1. Gibson's complaint alleges that JHS has infringed on four of Gibson's trademarks registered on the Principal Register and two registrations on the Supplemental Register, including U.S. Reg. No. 2,007,277 (the "'277 Supp. Registration"). Id. at 1-16.

JHS filed a cancellation proceeding with the Board seeking cancellation of two supplemental registrations, including the '277 Supp. Registration on March 31, 2014 (the "'277 Cancellation"). Motion at ¶ 6; Declaration of Brent M. Davis (the "Davis Decl.") at ¶ 5.

JHS filed its Answer and Counterclaims in the Prior Civil Action on May 5, 2014, including seeking cancellation of the '277 Supp. Registration. Davis Decl. at ¶ 6.

On May 12, 2014, Gibson filed a Motion to Dismiss in the '277 Cancellation. Id. at ¶ 7.

On June 20, 2014, Gibson filed a Motion to Dismiss in the Prior Civil Action. Id. at ¶ 8.

As a result of Gibson's motion practice, JHS filed its First Amended Counterclaims and Third Party Complaint in the Prior Civil Action on September 5, 2014. Davis Decl. at ¶ 9; Exhibit B to the Schuettinger Decl. at 1. JHS' First Amended Counterclaims and Third Party Complaint in the Prior Civil Action also sought cancellation of the '277 Supp. Registration. Exhibit B to the Schuettinger Decl. at 9-14.

Gibson filed a second Motion to Dismiss in the Prior Civil Action on September 19, 2014, Davis Decl. at ¶ 10.

On October 1, 2014, the Board denied Gibson's Motion to Dismiss with regards to the '277 Cancellation. Id. at ¶ 11. On October 9, 2014, despite its second Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration pending in the Prior Civil Action, Gibson filed a Motion to Suspend Proceedings Pending Resolution of a Civil Action in the '277 Cancellation. Id. at ¶ 12.

Opposers filed their Opposition in the instant proceeding on October 16, 2014. Dkt. No. 1. Opposers disclosed both the '277 Cancellation and the Prior Civil Action in their Opposition. Id. at 2.

On October 23, 2014, Gibson's Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration in the Prior Civil Action was denied. Davis Decl. at ¶ 13.

On November 25, 2014, despite having full knowledge of the Prior Civil Action that Gibson now claims, without any explanation, will have such an impact on the instant proceeding, Gibson filed a Motion to Dismiss the instant Opposition. Dkt. No. 4.

On December 30, 2014, the Board suspended the '277 Cancellation because the two registrations at issue in the '277 Cancellation were both at issue in the Prior Civil Action.[1] Motion at ¶¶ 7-8.

On March 26, 2015, the Board denied Gibson's Motion to Dismiss the instant Opposition. Dkt. No. 9.

On April 1, 2015, almost sixth months after the filing of the Opposition and despite full knowledge that JHS seeks cancellation of the '277 Supp. Registration in the Prior Civil Action for almost a full year, Gibson filed the instant Motion.

II. LEGAL STANDARD

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board *may* be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a) (emphasis added).

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[1] The suspension of the '277 Cancellation makes complete sense. Both the '277 Cancellation and the Prior Civil Action are between the same two parties, and no others, and involve the exact same registrations with identical causes of action.

Simply because the parties in a Board proceeding are engaged in a civil action, the suspension of the Board proceeding is not automatic. Id.

> Moreover, the argument that the Trademark Trial and Appeal Board automatically suspends proceedings when civil litigation is pending between the parties involved in an inter partes proceeding is manifestly incorrect. Suspension under such circumstances is granted only after both parties have been heard on the question and the Board has carefully reviewed the pleadings in the civil suit to determine if the outcome thereof will have a bearing on the question of the rights of the parties in the Patent Office proceeding. Manifestly, this does not constitute a policy of automatically suspending a Patent Office proceeding when civil litigation is pending between the parties.

Martin Bev. Co., Inc. v. Colita Beverage Corp., 1971 WL 16475 (TTAB 1971) at *3.

"All motions to suspend, regardless of circumstances and even with the adverse party's consent, are subject to the 'good cause' standard. See Trademark Rule 2.117(c). In the absence of consent, the party seeking suspension is also expected to comply with its responsibilities." Natl. Football League, NFL Properties LLC v. DNH Management, LLC, 85 U.S.P.Q.2d 1852, 1855 Fn. 8 (TTAB 2008).

III. ARGUMENT

A. Gibson Has Failed to Establish that the Prior Civil Action Will Have a Bearing on the Outcome in this Proceeding.

Suspension of a Board proceeding due to civil litigation requires that the civil litigation would "have a bearing on the case." 37 C.F.R. § 2.117(a). Gibson, in its eight (8) paragraph Motion, offers only a conclusory statement that "resolution of the Prior Pending Civil Action will resolve the issues before the Board." Motion at ¶ 7. Gibson offers no explanation on how this bare assertion of counsel is true.

The Prior Civil Action involves, among other issues, cancellation of the '277 Supp. Registration on the grounds of genericism. Exhibit B to the Schuettinger Decl. at 9-14.

However, *the '277 Supp. Registration is not at issue in the instant proceeding*. This Opposition involves Application Serial No. 86/168,793 (the "'793 App."). Gibson fails to even include the registration certificate for the '277 Supp. Registration for comparison. Gibson also fails to provide a single citation to any source that the cancellation of a mark on the Supplemental Register has an effect on the pending application on the Principal Register. Gibson, as "the moving party, bears the burden of persuading the Board to exercise its considerable discretion." Honda Giken Kogyo Kabushiki Kaisha v. H-D Michigan Inc., 43 U.S.P.Q.2d 1526, 1997 WL 459675 at *2 (TTAB 1997). Gibson has made no attempt to meet that burden and the Motion should be denied.

Opposers anticipate that Gibson will attempt to rehabilitate its cavalier approach to the Motion and offer an actual explanation of how the Prior Civil Action would have a bearing on this proceeding. It is black letter law that a reply brief cannot contain arguments not raised in the initial brief. See Waddell v. Nicholson, 204 Fed. Appx. 882, 884, Fn. 1(Fed. Cir. 2006); Novosteel SA v. United States, 284 F.3d 1261, 1274 (Fed.Cir.2002).

In its Reply in Support of its Motion to Dismiss [Dkt. No. 8], Gibson argued that:

> In Board proceedings, "[l]itigation is run by rules designed to assure orderly conduct of the proceedings." Chesebrough-Pond's, 618 F.2d at 780.... The Patent and Trademark Office "has broad authority to govern the conduct of proceedings before it." Lacavera v. Dudas, 441 F.3d 1380, 1383, 77 U.S.P.Q.2d 1955 (Fed. Cir. 2006).

Dkt. No. 8 at 3-4.

By its own argument, Gibson cannot be given the opportunity to correct the deficiencies in its Motion by improperly raising new arguments in its reply brief, including those made under the guise of responding to Opposers' additional arguments made *infra*. As Gibson has failed to

meet its burden to show how the Prior Civil Action would have an impact on the instant proceeding, the Motion should be denied in its entirety.

B. Any Resolution of the Pending Civil Action Will Not Be Dispositive of the Instant Proceeding.

In addition to being simply conclusory, Gibson's statement that "resolution of the Prior Pending Civil Action will resolve the issues before the Board" is simply not true. Motion at ¶ 7.

There are three possible outcomes in the Prior Civil Action regarding the '277 Supp. Registration: 1) JHS is unsuccessful in cancellation of the '277 Supp. Registration due to genericism; or 2) JHS is successful in cancellation of the '277 Supp. Registration due to genericism; or 3) The issue of genericism of the '277 Supp. Registration is not adjudicated. In any outcome, the Instant Proceeding will still need to reach full resolution before the Board.

As a threshold matter, the issues at play in the Prior Civil Action and the instant proceeding are quite different, even if they appear to be similar at first look. The Prior Civil Action involves the '277 Supp. Registration. As a result, there is an admission by Gibson that, by applying for registration on the Supplemental Register, the '277 Supp. Registration is merely descriptive. See Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 1299 (Cust. & Pat. App. 1972). That admission is not at issue in the instant proceeding. Further, as Gibson itself pointed out in its Motion to Dismiss the instant proceeding, "[w]hen a mark is applied for under Section 2(f) is approved by the USPTO for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness by the applicant." Dkt. No. 4 at 5-6. This presumption is not at issue in the Prior Civil Action. Furthermore, *lack of secondary meaning is not at issue at all in the Prior Civil Action, but it is a cause of action in the instant proceeding*.

In the event that JHS is unsuccessful in cancellation of the '277 Supp. Registration due to genericism, that result will not fully resolve the instant proceeding as neither the doctrines of claim preclusion (res judicata) nor issue preclusion (collateral estoppel) will apply.

"Under the doctrine of claim preclusion, the entry of a final judgment "on the merits" of a claim (or cause of action) in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding involving the same parties or their privies." Perma Ceram Enterprises Inc. v. Preco Industries Limited, dba Fosroc-Preco, 23 U.S.P.Q.2d 1134, 1992 WL 156544 at *5 (TTAB 1992).

Cancellation of the '277 Supp. Registration is not the same claim as the claim that the '793 App. should not proceed to registration. Further, "cancellation of [a] current supplemental registration does not necessarily render [that mark] forever incapable of being registered on either the principal or supplemental registers." CreAgri, Inc. v. USANA Health Sciences, Inc., 474 F.3d 626, 634 Fn. 14 (9th Cir. 2007). Therefore, claim preclusion will not apply to the instant proceeding.

Further, even if JHS were somehow precluded from asserting its claim of genericism in the instant opposition, *there are fourteen (14) other Opposers* who would not be subject to claim preclusion because they were not parties or privies to parties in the Prior Civil Action. "[T]he doctrine [of *res judicata*] does not apply in this case because the parties in the prior civil action and in this cancellation proceeding are not the same." Pramil S.R.L. v. Michel Farah, 2007 WL 8241693, at *2 (TTAB 2007), citing Jet, Inc., v. Sewage Aeration Systems, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

> Under the doctrine of issue preclusion, issues which are actually and necessarily determined by a court of competent jurisdiction are normally conclusive in a subsequent suit involving the parties to the prior litigation. Restatement (Second) of Judgments § 27

> (1980); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed.Cir.1983); International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed.Cir.1984). It is not necessary that both the party asserting the preclusive effect of the prior judgment and the party against whom it is asserted be persons bound by the judgment. Uziel Gal, et al. v. Israel Military Industries of the Ministry of Defense of The State of Israel, 230 USPQ 669 (TTAB 1986), aff'd unpublished opinion, No. 87-1076 (Fed.Cir. June 24, 1987). A nonparty to the prior action may invoke the doctrine of issue preclusion against one who was a party to that action unless it appears that the party against whom the doctrine is asserted did not have a full and fair opportunity to litigate the issue or unless the Court finds that it is otherwise unfair to permit the use of estoppel. See: 1B Moore's Federal Practice § 0.441(2) (2d ed. 1984).

Perma Ceram Enterprises at *6.

In the event that JHS is unsuccessful in cancelling the '277 Supp. Registration on the grounds of genericism, the *fourteen (14) other Opposers* cannot be estopped from asserting the issue in the instant proceeding as they were not parties to the Prior Civil Action and did not have a full and fair opportunity to litigate the issue. Further, since the issue of lack of secondary meaning is not at issue at all in the Prior Civil Action, that claim would need to proceed before the Board.

Most importantly, if JHS is unsuccessful in cancelling the '277 Supp. Registration on the grounds of genericism in the Prior Civil Action, and, assuming, arguendo, that the Board precludes that claim from proceeding in the instant action, the cause of action of lack of secondary meaning would still need to be adjudicated by the Board.

In the event JHS is successful in cancelling the '277 Supp. Registration on the grounds of genericism, it is unclear whether JHS could assert either claim or issue preclusion against Gibson. As Courts have pointed out, "[j]udicial focus on the Supplemental Register has been sparse." In re Bush Bros. & Co., 884 F.2d 569, 570 (Fed. Cir. 1989). However, since

cancellation of a registration on the Supplemental Register does not exclude that mark from being registered on the Principal Register in the future, resolution of the Prior Civil Action in favor of JHS will not necessarily have a bearing on the instant proceeding.

Of course, the impact of the Prior Civil Action on the instant Opposition assumes that the issue of genericism of the '277 Supp. Registration reaches a full and final resolution on the merits. As is obvious from the pleadings, the Prior Civil Action involves many issues and possible resolutions. For example, a final resolution of the Prior Civil Action could be in the issue of laches, estoppel, waiver and/or acquiescence. See Exhibit 1 to the Davis Decl. at 9-10. Further, *JHS could simply not pursue its counterclaim to cancel the '277 Supp. Registration.* In those events, the issue of genericism of the '277 Supp. Registration could never be reached and the suspension of the Opposition would be pointless.

The impact of the Prior Civil Action is tenuous at best. Accordingly, suspension of the instant proceeding would likely be delaying the inevitable outcome of the Opposition reaching final disposition before the Board. Therefore, the Motion should be denied.

C. The Fourteen (14) Other Opposers Will Be Unduly Prejudiced by Suspension.

In the vast majority of motions to suspend proceedings pending resolution of a civil action before the Board, the civil action normally involves the parties involved in the Board proceeding and those parties alone. In this instance, there are *fourteen (14) other Opposers* who are not involved, in any way, with the Prior Civil Action. This is an important distinction. A suspension of this proceeding would force the fourteen (14) other Opposers to wait for the resolution of the Prior Civil Action, a case that is only in the early stages of discovery, despite

being filed in January 2014.[2] It would be patently unjust to require these companies to wait what could be years to just resume the instant proceeding.

The prejudice is even more pronounced because, well after the filing of the Opposition, Gibson has sent "cease and desist" correspondence to two of the Opposers, Peavey Electronics Corporation ("Peavey") and U.S. Music Corporation ("USM") regarding the very mark that is at issue in this Opposition. Davis Decl. at ¶ 16. Copies of this correspondence are attached to the Davis Decl. as Exhibits 2 and 3.[3] Despite being well aware that Peavey and USM had filed this Opposition *six months earlier*, Gibson sent this correspondence either as a meaningless attempt to create "policing" after the Opposition was initiated, or, worse, simply to harass the Opposers.

On April 13, 2015, Gibson served USM with a subpoena in the Prior Civil Action demanding, among other things, an accounting of products sold by USM that are identical or substantially similar to the mark at issue in this proceeding. Davis Decl. at ¶ 18. A copy of the subpoena is attached to the Davis Decl. as Exhibit 4.

Gibson is requesting that the Board suspend the instant proceeding and its behavior is surely indicating that it will continue to make demands on the Opposers, including, essentially, conducting discovery in the instant matter, but leave the Opposers with no ability to do the same. Suspension of the Opposition would only allow Gibson to continue this behavior which,

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[2] The Prior Civil Action has been plagued by motion practice and already has seventy-five docket entries, including three motions to dismiss by Gibson. Davis Decl. at ¶ 15.

[3] Opposers anticipate that Gibson will object to the submission of the "cease and desist" correspondence on the grounds that they are inadmissible pursuant to Fed. R. Evid. 408. This correspondence is not being offered to prove liability or an amount in controversy, but, rather, as evidence of Gibson's harassment of the Opposers. It is well settled that such communication is admissible. Carney v. Am. U., 151 F.3d 1090, 1095 (D.C. Cir. 1998) "settlement letters are inadmissible to prove liability or amount, they are admissible when the evidence is offered for another purpose").

regardless of intent, only increases Opposers' legal fees. Allowing this issue to be resolved efficiently through the Board's process would prevent this wasting of resources.

Simply put, it is patently unfair and prejudicial to the remaining fourteen (14) Opposers to have to wait, possibly for years, and incur legal further fees responding to correspondence from Gibson that threatens litigation on the very issue that is already before the Board and respond to subpoenas that amount to discovery in the instant proceeding, for the resolution of the Prior Civil Action that, as discussed fully above, is likely to have little or no impact on this Opposition. Accordingly, the Motion should be denied.

IV. CONCLUSION

For the reasons stated above, Gibson has failed to meet the burden required of its Motion. Moreover, the Prior Civil Action is not likely to have any impact on the instant proceeding. Finally, suspension of the Opposition will force fourteen (14) parties with no connection to the Prior Civil Action to feebly sit on the sidelines and have to wait years for a resolution to this issue, all while incurring legal fees having to respond to either meaningless or harassing correspondence with threats of additional litigation from Gibson and subpoenas in the Prior Civil Litigation. Accordingly, Opposers respectfully request that the Board deny the Motion in its entirety.

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Dated: Hackensack, New Jersey

April 15, 2015

Respectfully submitted,
BIENSTOCK & MICHAEL, LLC.

By: /Brent M. Davis/
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Ronald S. Bienstock, Esq.

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ATTORNEYS FOR OPPOSERS

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

In the Matter of Trademark Application Serial No. 86/168,793:
Filing Date: January 17, 2014
Published in the Trademark Official Gazette on June 24, 2014

ARMADILLO ENTERPRISES, INC.; COLLINGS GUITARS, INC.; CORDOBA MUSIC GROUP, INC.; ED ROMAN ENTERPRISES, INC.; E.S.P. SHIBUYA ENTERPRISES, INC.; JAMES TRUSSART GUITARS, INC.; JOHN HORNBY SKEWES & CO., LTD.; JS TECHNOLOGIES, INC.; EAVEY ELECTRONICS CORPORATION; PREMIER BUILDERS GUILD, LLC; SADOWSKY GUITARS, LTD.; SCHECTER GUITAR RESEARCH, INC.; U.S. MUSIC CORPORATION; WARWICK GMBH & CO. MUSIC EQUIPMENT KG; AND WESTHEIMER CORPORATION Opposer, v. GIBSON BRANDS, INC. Applicant.	Opposition No. 91218879 Application Serial No. 86/166,793

DECLARATION OF BRENT M. DAVIS, ESQ.

I, Brent M. Davis, Esq., declare that:

1. I am an attorney licensed to practice in the States of New York and New Jersey. I am in good standing with the State Bars of New York and New Jersey. I am in all respects competent to testify to the facts stated in this Declaration.

2. I am a Partner in the law firm of Bienstock & Michael, LLC (the "Firm").

3. The Firm represents all fifteen (15) opposers in the above-captioned proceeding pending in the United States Patent and Trademark Office ("USPTO") before the Trademark Trial and Appeal Board ("the Board").

4. The facts stated in this Declaration are based on my personal knowledge, and are true and correct. I understand that this Declaration will be submitted to the Board in connection with Opposers' Opposition to Gibson Brands, Inc.'s ("Gibson") Motion to Suspend Proceedings Pending Resolution of a Civil Action in the above-captioned opposition proceeding.

5. On March 31, 2014, opposer John Hornby Skewes & Co., Ltd. ("JHS") filed a cancellation proceeding with the Board seeking cancellation of two supplemental registrations including U.S. Reg. No. 2,007,277 (the "'277 Supp. Registration").

6. On May 5, 2014, JHS filed its Answer and Counterclaims in Gibson Brands, Inc. v. John Hornby Skewes & Co., Ltd., Case No. CV 2:14-00609 in the United States District Court for the Central District California (the "Prior Civil Action"), including seeking cancellation of the '277 Supp. Registration.

7. On May 12, 2014, Gibson filed a Motion to Dismiss in the '277 Cancellation.

8. On June 20, 2014, Gibson filed a Motion to Dismiss in the Prior Civil Action.

9. As a result of Gibson's motion practice, JHS filed its First Amended Counterclaims and Third Party Complaint on September 5, 2014.

10. Gibson filed a second Motion to Dismiss in the Prior Civil Action on September 19, 2014.

11. On October 1, 2014, the Board denied Gibson's Motion to Dismiss with regards to the '277 Cancellation.

12. On October 9, 2014, despite its second Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration pending in the Prior Civil Action, Gibson filed a Motion to Suspend Proceedings Pending Resolution of a Civil Action in the '277 Cancellation.

13. On October 23, 2014, Gibson's Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration in the Civil Action was denied.

14. A copy of JHS' Amended Answer in the Prior Civil Action is attached hereto as Exhibit 1.

15. The Prior Civil Action has been plagued by motion practice and already has seventy-five docket entries, including three motions to dismiss by Gibson

16. Gibson has sent "cease and desist" correspondence to two of the Opposers, Peavey Electronics Corporation ("Peavey") and U.S. Music Corporation ("USM") regarding the very mark that is at issue in this Opposition.

17. Copies of this correspondence are attached hereto as Exhibits 2 and 3.

18. On April 13, 2015, Gibson served USM with a subpoena in the Prior Civil Action demanding, among other things, an accounting of products sold by USM that are identical or substantially similar to the mark at issue in this proceeding.

19. A copy of the subpoena is attached to hereto as Exhibit 4.

I declare under penalty of perjury under the laws of the United States of America that the foregoing statements are true and correct.

Dated: April 15, 2015 in Hackensack, NJ

By: s/ Brent M. Davis
Brent M. Davis, Esq.

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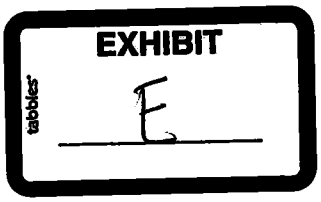

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II. LEGAL STANDARD

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board *may* be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117(a) (emphasis added).

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[1] The suspension of the '277 Cancellation makes complete sense. Both the '277 Cancellation and the Prior Civil Action are between the same two parties, and no others, and involve the exact same registrations with identical causes of action.

Simply because the parties in a Board proceeding are engaged in a civil action, the suspension of the Board proceeding is not automatic. Id.

> Moreover, the argument that the Trademark Trial and Appeal Board automatically suspends proceedings when civil litigation is pending between the parties involved in an inter partes proceeding is manifestly incorrect. Suspension under such circumstances is granted only after both parties have been heard on the question and the Board has carefully reviewed the pleadings in the civil suit to determine if the outcome thereof will have a bearing on the question of the rights of the parties in the Patent Office proceeding. Manifestly, this does not constitute a policy of automatically suspending a Patent Office proceeding when civil litigation is pending between the parties.

Martin Bev. Co., Inc. v. Colita Beverage Corp., 1971 WL 16475 (TTAB 1971) at *3.

"All motions to suspend, regardless of circumstances and even with the adverse party's consent, are subject to the 'good cause' standard. See Trademark Rule 2.117(c). In the absence of consent, the party seeking suspension is also expected to comply with its responsibilities." Natl. Football League, NFL Properties LLC v. DNH Management, LLC, 85 U.S.P.Q.2d 1852, 1855 Fn. 8 (TTAB 2008).

III. ARGUMENT

A. Gibson Has Failed to Establish that the Prior Civil Action Will Have a Bearing on the Outcome in this Proceeding.

Suspension of a Board proceeding due to civil litigation requires that the civil litigation would "have a bearing on the case." 37 C.F.R. § 2.117(a). Gibson, in its eight (8) paragraph Motion, offers only a conclusory statement that "resolution of the Prior Pending Civil Action will resolve the issues before the Board." Motion at ¶ 7. Gibson offers no explanation on how this bare assertion of counsel is true.

The Prior Civil Action involves, among other issues, cancellation of the '277 Supp. Registration on the grounds of genericism. Exhibit B to the Schuettinger Decl. at 9-14.

However, *the '277 Supp. Registration is not at issue in the instant proceeding*. This Opposition involves Application Serial No. 86/168,793 (the "'793 App."). Gibson fails to even include the registration certificate for the '277 Supp. Registration for comparison. Gibson also fails to provide a single citation to any source that the cancellation of a mark on the Supplemental Register has an effect on the pending application on the Principal Register. Gibson, as "the moving party, bears the burden of persuading the Board to exercise its considerable discretion." Honda Giken Kogyo Kabushiki Kaisha v. H-D Michigan Inc., 43 U.S.P.Q.2d 1526, 1997 WL 459675 at *2 (TTAB 1997). Gibson has made no attempt to meet that burden and the Motion should be denied.

Opposers anticipate that Gibson will attempt to rehabilitate its cavalier approach to the Motion and offer an actual explanation of how the Prior Civil Action would have a bearing on this proceeding. It is black letter law that a reply brief cannot contain arguments not raised in the initial brief. See Waddell v. Nicholson, 204 Fed. Appx. 882, 884, Fn. 1(Fed. Cir. 2006); Novosteel SA v. United States, 284 F.3d 1261, 1274 (Fed.Cir.2002).

In its Reply in Support of its Motion to Dismiss [Dkt. No. 8], Gibson argued that:

> In Board proceedings, "[l]itigation is run by rules designed to assure orderly conduct of the proceedings." Chesebrough-Pond's, 618 F.2d at 780.... The Patent and Trademark Office "has broad authority to govern the conduct of proceedings before it." Lacavera v. Dudas, 441 F.3d 1380, 1383, 77 U.S.P.Q.2d 1955 (Fed. Cir. 2006).

Dkt. No. 8 at 3-4.

By its own argument, Gibson cannot be given the opportunity to correct the deficiencies in its Motion by improperly raising new arguments in its reply brief, including those made under the guise of responding to Opposers' additional arguments made *infra*. As Gibson has failed to

meet its burden to show how the Prior Civil Action would have an impact on the instant proceeding, the Motion should be denied in its entirety.

B. Any Resolution of the Pending Civil Action Will Not Be Dispositive of the Instant Proceeding.

In addition to being simply conclusory, Gibson's statement that "resolution of the Prior Pending Civil Action will resolve the issues before the Board" is simply not true. Motion at ¶ 7.

There are three possible outcomes in the Prior Civil Action regarding the '277 Supp. Registration: 1) JHS is unsuccessful in cancellation of the '277 Supp. Registration due to genericism; or 2) JHS is successful in cancellation of the '277 Supp. Registration due to genericism; or 3) The issue of genericism of the '277 Supp. Registration is not adjudicated. In any outcome, the Instant Proceeding will still need to reach full resolution before the Board.

As a threshold matter, the issues at play in the Prior Civil Action and the instant proceeding are quite different, even if they appear to be similar at first look. The Prior Civil Action involves the '277 Supp. Registration. As a result, there is an admission by Gibson that, by applying for registration on the Supplemental Register, the '277 Supp. Registration is merely descriptive. See Quaker State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 1299 (Cust. & Pat. App. 1972). That admission is not at issue in the instant proceeding. Further, as Gibson itself pointed out in its Motion to Dismiss the instant proceeding, "[w]hen a mark is applied for under Section 2(f) is approved by the USPTO for publication, there is a presumption that the examining attorney found a prima facie case of acquired distinctiveness by the applicant." Dkt. No. 4 at 5-6. This presumption is not at issue in the Prior Civil Action. Furthermore, *lack of secondary meaning is not at issue at all in the Prior Civil Action, but it is a cause of action in the instant proceeding*.

In the event that JHS is unsuccessful in cancellation of the '277 Supp. Registration due to genericism, that result will not fully resolve the instant proceeding as neither the doctrines of claim preclusion (res judicata) nor issue preclusion (collateral estoppel) will apply.

"Under the doctrine of claim preclusion, the entry of a final judgment "on the merits" of a claim (or cause of action) in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding involving the same parties or their privies." Perma Ceram Enterprises Inc. v. Preco Industries Limited, dba Fosroc-Preco, 23 U.S.P.Q.2d 1134, 1992 WL 156544 at *5 (TTAB 1992).

Cancellation of the '277 Supp. Registration is not the same claim as the claim that the '793 App. should not proceed to registration. Further, "cancellation of [a] current supplemental registration does not necessarily render [that mark] forever incapable of being registered on either the principal or supplemental registers." CreAgri, Inc. v. USANA Health Sciences, Inc., 474 F.3d 626, 634 Fn. 14 (9th Cir. 2007). Therefore, claim preclusion will not apply to the instant proceeding.

Further, even if JHS were somehow precluded from asserting its claim of genericism in the instant opposition, *there are fourteen (14) other Opposers* who would not be subject to claim preclusion because they were not parties or privies to parties in the Prior Civil Action. "[T]he doctrine [of *res judicata*] does not apply in this case because the parties in the prior civil action and in this cancellation proceeding are not the same." Pramil S.R.L. v. Michel Farah, 2007 WL 8241693, at *2 (TTAB 2007), citing Jet, Inc., v. Sewage Aeration Systems, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

> Under the doctrine of issue preclusion, issues which are actually and necessarily determined by a court of competent jurisdiction are normally conclusive in a subsequent suit involving the parties to the prior litigation. Restatement (Second) of Judgments § 27

> (1980); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed.Cir.1983); International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed.Cir.1984). It is not necessary that both the party asserting the preclusive effect of the prior judgment and the party against whom it is asserted be persons bound by the judgment. Uziel Gal, et al. v. Israel Military Industries of the Ministry of Defense of The State of Israel, 230 USPQ 669 (TTAB 1986), aff'd unpublished opinion, No. 87-1076 (Fed.Cir. June 24, 1987). A nonparty to the prior action may invoke the doctrine of issue preclusion against one who was a party to that action unless it appears that the party against whom the doctrine is asserted did not have a full and fair opportunity to litigate the issue or unless the Court finds that it is otherwise unfair to permit the use of estoppel. See: 1B Moore's Federal Practice § 0.441(2) (2d ed. 1984).

Perma Ceram Enterprises at *6.

In the event that JHS is unsuccessful in cancelling the '277 Supp. Registration on the grounds of genericism, the *fourteen (14) other Opposers* cannot be estopped from asserting the issue in the instant proceeding as they were not parties to the Prior Civil Action and did not have a full and fair opportunity to litigate the issue. Further, since the issue of lack of secondary meaning is not at issue at all in the Prior Civil Action, that claim would need to proceed before the Board.

Most importantly, if JHS is unsuccessful in cancelling the '277 Supp. Registration on the grounds of genericism in the Prior Civil Action, and, assuming, arguendo, that the Board precludes that claim from proceeding in the instant action, the cause of action of lack of secondary meaning would still need to be adjudicated by the Board.

In the event JHS is successful in cancelling the '277 Supp. Registration on the grounds of genericism, it is unclear whether JHS could assert either claim or issue preclusion against Gibson. As Courts have pointed out, "[j]udicial focus on the Supplemental Register has been sparse." In re Bush Bros. & Co., 884 F.2d 569, 570 (Fed. Cir. 1989). However, since

cancellation of a registration on the Supplemental Register does not exclude that mark from being registered on the Principal Register in the future, resolution of the Prior Civil Action in favor of JHS will not necessarily have a bearing on the instant proceeding.

Of course, the impact of the Prior Civil Action on the instant Opposition assumes that the issue of genericism of the '277 Supp. Registration reaches a full and final resolution on the merits. As is obvious from the pleadings, the Prior Civil Action involves many issues and possible resolutions. For example, a final resolution of the Prior Civil Action could be in the issue of laches, estoppel, waiver and/or acquiescence. See Exhibit 1 to the Davis Decl. at 9-10. Further, *JHS could simply not pursue its counterclaim to cancel the '277 Supp. Registration.* In those events, the issue of genericism of the '277 Supp. Registration could never be reached and the suspension of the Opposition would be pointless.

The impact of the Prior Civil Action is tenuous at best. Accordingly, suspension of the instant proceeding would likely be delaying the inevitable outcome of the Opposition reaching final disposition before the Board. Therefore, the Motion should be denied.

C. The Fourteen (14) Other Opposers Will Be Unduly Prejudiced by Suspension.

In the vast majority of motions to suspend proceedings pending resolution of a civil action before the Board, the civil action normally involves the parties involved in the Board proceeding and those parties alone. In this instance, there are *fourteen (14) other Opposers* who are not involved, in any way, with the Prior Civil Action. This is an important distinction. A suspension of this proceeding would force the fourteen (14) other Opposers to wait for the resolution of the Prior Civil Action, a case that is only in the early stages of discovery, despite

being filed in January 2014.[2] It would be patently unjust to require these companies to wait what could be years to just resume the instant proceeding.

The prejudice is even more pronounced because, well after the filing of the Opposition, Gibson has sent "cease and desist" correspondence to two of the Opposers, Peavey Electronics Corporation ("Peavey") and U.S. Music Corporation ("USM") regarding the very mark that is at issue in this Opposition. Davis Decl. at ¶ 16. Copies of this correspondence are attached to the Davis Decl. as Exhibits 2 and 3.[3] Despite being well aware that Peavey and USM had filed this Opposition *six months earlier*, Gibson sent this correspondence either as a meaningless attempt to create "policing" after the Opposition was initiated, or, worse, simply to harass the Opposers.

On April 13, 2015, Gibson served USM with a subpoena in the Prior Civil Action demanding, among other things, an accounting of products sold by USM that are identical or substantially similar to the mark at issue in this proceeding. Davis Decl. at ¶ 18. A copy of the subpoena is attached to the Davis Decl. as Exhibit 4.

Gibson is requesting that the Board suspend the instant proceeding and its behavior is surely indicating that it will continue to make demands on the Opposers, including, essentially, conducting discovery in the instant matter, but leave the Opposers with no ability to do the same. Suspension of the Opposition would only allow Gibson to continue this behavior which,

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[2] The Prior Civil Action has been plagued by motion practice and already has seventy-five docket entries, including three motions to dismiss by Gibson. Davis Decl. at ¶ 15.

[3] Opposers anticipate that Gibson will object to the submission of the "cease and desist" correspondence on the grounds that they are inadmissible pursuant to Fed. R. Evid. 408. This correspondence is not being offered to prove liability or an amount in controversy, but, rather, as evidence of Gibson's harassment of the Opposers. It is well settled that such communication is admissible. Carney v. Am. U., 151 F.3d 1090, 1095 (D.C. Cir. 1998) "settlement letters are inadmissible to prove liability or amount, they are admissible when the evidence is offered for another purpose").

regardless of intent, only increases Opposers' legal fees. Allowing this issue to be resolved efficiently through the Board's process would prevent this wasting of resources.

Simply put, it is patently unfair and prejudicial to the remaining fourteen (14) Opposers to have to wait, possibly for years, and incur legal further fees responding to correspondence from Gibson that threatens litigation on the very issue that is already before the Board and respond to subpoenas that amount to discovery in the instant proceeding, for the resolution of the Prior Civil Action that, as discussed fully above, is likely to have little or no impact on this Opposition. Accordingly, the Motion should be denied.

IV. CONCLUSION

For the reasons stated above, Gibson has failed to meet the burden required of its Motion. Moreover, the Prior Civil Action is not likely to have any impact on the instant proceeding. Finally, suspension of the Opposition will force fourteen (14) parties with no connection to the Prior Civil Action to feebly sit on the sidelines and have to wait years for a resolution to this issue, all while incurring legal fees having to respond to either meaningless or harassing correspondence with threats of additional litigation from Gibson and subpoenas in the Prior Civil Litigation. Accordingly, Opposers respectfully request that the Board deny the Motion in its entirety.

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Dated: Hackensack, New Jersey

April 15, 2015

Respectfully submitted,
BIENSTOCK & MICHAEL, LLC.

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ATTORNEYS FOR OPPOSERS

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

In the Matter of Trademark Application Serial No. 86/168,793:
Filing Date: January 17, 2014
Published in the Trademark Official Gazette on June 24, 2014

ARMADILLO ENTERPRISES, INC.; COLLINGS GUITARS, INC.; CORDOBA MUSIC GROUP, INC.; ED ROMAN ENTERPRISES, INC.; E.S.P. SHIBUYA ENTERPRISES, INC.; JAMES TRUSSART GUITARS, INC.; JOHN HORNBY SKEWES & CO., LTD.; JS TECHNOLOGIES, INC.; EAVEY ELECTRONICS CORPORATION; PREMIER BUILDERS GUILD, LLC; SADOWSKY GUITARS, LTD.; SCHECTER GUITAR RESEARCH, INC.; U.S. MUSIC CORPORATION; WARWICK GMBH & CO. MUSIC EQUIPMENT KG; AND WESTHEIMER CORPORATION Opposer, v. GIBSON BRANDS, INC. Applicant.	Opposition No. 91218879 Application Serial No. 86/166,793

DECLARATION OF BRENT M. DAVIS, ESQ.

I, Brent M. Davis, Esq., declare that:

1. I am an attorney licensed to practice in the States of New York and New Jersey. I am in good standing with the State Bars of New York and New Jersey. I am in all respects competent to testify to the facts stated in this Declaration.

2. I am a Partner in the law firm of Bienstock & Michael, LLC (the "Firm").

3. The Firm represents all fifteen (15) opposers in the above-captioned proceeding pending in the United States Patent and Trademark Office ("USPTO") before the Trademark Trial and Appeal Board ("the Board").

4. The facts stated in this Declaration are based on my personal knowledge, and are true and correct. I understand that this Declaration will be submitted to the Board in connection with Opposers' Opposition to Gibson Brands, Inc.'s ("Gibson") Motion to Suspend Proceedings Pending Resolution of a Civil Action in the above-captioned opposition proceeding.

5. On March 31, 2014, opposer John Hornby Skewes & Co., Ltd. ("JHS") filed a cancellation proceeding with the Board seeking cancellation of two supplemental registrations including U.S. Reg. No. 2,007,277 (the "'277 Supp. Registration").

6. On May 5, 2014, JHS filed its Answer and Counterclaims in Gibson Brands, Inc. v. John Hornby Skewes & Co., Ltd., Case No. CV 2:14-00609 in the United States District Court for the Central District California (the "Prior Civil Action"), including seeking cancellation of the '277 Supp. Registration.

7. On May 12, 2014, Gibson filed a Motion to Dismiss in the '277 Cancellation.

8. On June 20, 2014, Gibson filed a Motion to Dismiss in the Prior Civil Action.

9. As a result of Gibson's motion practice, JHS filed its First Amended Counterclaims and Third Party Complaint on September 5, 2014.

10. Gibson filed a second Motion to Dismiss in the Prior Civil Action on September 19, 2014.

11. On October 1, 2014, the Board denied Gibson's Motion to Dismiss with regards to the '277 Cancellation.

12. On October 9, 2014, despite its second Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration pending in the Prior Civil Action, Gibson filed a Motion to Suspend Proceedings Pending Resolution of a Civil Action in the '277 Cancellation.

13. On October 23, 2014, Gibson's Motion to Dismiss the counterclaim seeking cancellation of the '277 Supp. Registration in the Civil Action was denied.

14. A copy of JHS' Amended Answer in the Prior Civil Action is attached hereto as Exhibit 1.

15. The Prior Civil Action has been plagued by motion practice and already has seventy-five docket entries, including three motions to dismiss by Gibson

16. Gibson has sent "cease and desist" correspondence to two of the Opposers, Peavey Electronics Corporation ("Peavey") and U.S. Music Corporation ("USM") regarding the very mark that is at issue in this Opposition.

17. Copies of this correspondence are attached hereto as Exhibits 2 and 3.

18. On April 13, 2015, Gibson served USM with a subpoena in the Prior Civil Action demanding, among other things, an accounting of products sold by USM that are identical or substantially similar to the mark at issue in this proceeding.

19. A copy of the subpoena is attached to hereto as Exhibit 4.

I declare under penalty of perjury under the laws of the United States of America that the foregoing statements are true and correct.

Dated: April 15, 2015 in Hackensack, NJ

By: s/ Brent M. Davis
Brent M. Davis, Esq.