ESTTA Tracking number: **ESTTA647993**

Filing date: **01/02/2015**

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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Date	01/02/2015
Attachments	Reply to MTD.pdf(202903 bytes) KS Dec for Reply to MTD.pdf(156635 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 7, 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 MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS OPPOSITION

Applicant Gibson Brands, Inc. ("Gibson") respectfully submits this Reply Brief in Support of its Motion to Dismiss Notice of Opposition, 91218879. For the reasons set forth below, Gibson respectfully requests that the Board grant the Motion to Dismiss in its entirety.

ARGUMENT

Initially, Opposers' Memorandum of Law in Opposition to Applicant's Motion to Dismiss is untimely. This Board must protect the integrity of the TTAB rules and grant the Motion to Dismiss, with prejudice, as conceded for failure to file a timely opposition.

Secondarily, the Opposer Armadillo Enterprises, Inc. must be dismissed as it is not a legal entity capable of suing and being sued in a court of law. In its untimely filed Opposition to the Motion to Dismiss, the Opposers do not request the Board amend its Notice of Opposition and allow the opposition extension under the allegedly correct legal entity.

Lastly, if the Board chooses to accept the potentially fatal procedural flaws, Opposers' Notice of Opposition fails to state a claim on which relief may be granted. Opposers fail to allege a valid ground for refusal. Specifically, Opposers fail to allege sufficient facts, taken as true, to state a claim that is plausible on its face that Gibson's trademark is generic or lacks a secondary meaning.

A. Opposers' Opposition Brief to Motion to Dismiss was Untimely and Should Not be Considered

Opposers' Opposition Brief is untimely and should not be considered by the Board. Gibson filed its Motion to Dismiss on November 25, 2014. The opposition brief "shall be filed within fifteen days from the date of service of the motion . . ." 37 C.F.R. § 2.127(a). Gibson executed service on November 25, 2014, by first class mail. [*See* Motion to Dismiss Opposition.] "When service is made by first-class mail . . . the date of mailing or delivery to the overnight courier will be considered the date of service . . . . Whenever a party is required to take some action within a prescribed period after the service of a paper . . . 5 days shall be added to the prescribed period."

37 C.F.R. § 2.119(c). A response to the Motion to Dismiss was thus to be filed on or before **December 15, 2014.**

Opposers' Opposition Brief was filed on **December 18, 2014**, with no explanation for the delay. If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the Board, in its discretion, may grant the motion as conceded. *See* TBMP § 502.04; *see also Boston Chicken, Inc. v. Boston Pizza Int'l Inc.*, 53 U.S.P.Q.2d 1053 (TTAB 1999) (motion for summary judgment dismissed with prejudice for failure to file opposition brief); *Chesebrough-Pond's Inc. v. Faberge, Inc.*, 618 F.2d 776, 205 U.S.P.Q. 888 (CCPA 1980) (affirming motion for summary judgment as conceded for failure to file a brief in opposition); *Cent. Mfg. Inc. v. Third Millennium Tech., Inc.*, 61 U.S.P.Q.2d 1210, 1211 (TTAB 2001) (treating motion to dismiss as conceded for failure to submit opposition brief); *Cent. Mfg. v. Surgical Navigation Techs.*, 92 Fed.Appx. 789 (Fed. Cir. 2004) (finding allegations and arguments conceded for failure to respond to motion for summary judgment); *Sadeh v. Biggs*, 374 Fed.Appx. 996 (Fed. Cir. 2010) (dismissing an opposition, with prejudice, for failure to file a brief in opposition to a motion to dismiss). The Board has declined to consider untimely filed opposition briefs. *See Boyds Collection Ltd v. Herrington & Co.*, 65 U.S.P.Q.2d 2017 (TTAB 2003) ("Respondent's opposition to the motion to suspend . . . is untimely, and will not be considered").

In this case, Opposers provide no explanation for the untimely filing of the opposition brief. 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. This includes the rule "that a party must submit a timely response to a motion from an

opposing party." *Sadeh*, 374 Fed.Appx. at 997 (quoting *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). This broad authority includes the express power to treat the motion as conceded when a party fails to file a timely brief in response to a motion. 37 C.F.R. § 2.127(a). Because Opposers failed to timely response to the motion to dismiss and proffered no explanation for this failure to do so, the Board should treat the motion to dismiss as conceded.

B. Opposers did not Establish Armadillo Enterprises, Inc. as Misidentified Through Mistake in the 30 Day Request for Extension of Time to Oppose

Gibson established in its Motion to Dismiss that Armadillo Enterprises, Inc. is not a legal entity in good standing recognized by the Florida Department of State. Opposers argue that this was a "clear clerical error" and the "disingenuousness of Gibson's argument" should lead to the Motion being denied. [*See Opposition* at 10.] Opposers provide no authority in support that a clear clerical error should override a motion to dismiss a non-legal entity incapable of suing and being sued in a court of law.

In addition to no authority, Opposers refer to Gibson's argument as disingenuous and seem to imply that it is Gibson's burden to identify the potential opposers to Gibson's own published trademark. *See Id*. ("Exhibit A to the Declaration of Kurt Schuettinger clearly shows that Armadillo Distribution Enterprises, Inc. is listed as an active corporation a mere five lines above where Armadillo Enterprises, Inc. is listed as inactive.") What Opposers fail to mention is that there are 106 legal entities that have been registered in the State of Florida that include "Armadillo" in the entity name (including the 19 others in Exhibit A). [*See* Declaration of Kurt Schuettinger, Esq. in

Support of Gibson's Reply Brief at ¶ 4.] Over 200 entities have been registered in the State of Florida with "Distribution" in the entity name, with even more entities containing "Enterprises." [*Id*. ¶ 5.] In addition to the State of Florida, the State of Delaware, one of the most common states of incorporation, has 40 entities registered containing the term "Armadillo" including "Armadillo Enterprises, Inc.," "Armadillo Enterprises, LLC," and "Armadillo Enterprises LLC." [*Id*. ¶ 7.] Neither the State of Florida nor the State of Delaware search engines allow the user to look up an entity by its address. [*Id*. ¶ 8.] Certainly the Board would not impose the burden to identify the opposer of its own published trademark on the applicant.

Gibson concedes that the Board **may** accept an opposition "if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time." TBMP § 201; 37 C.F.R § 2.102(b). There is obviously no privity with a non-existent entity so Opposers would need to rely on misidentification through mistake to withstand the motion to dismiss Armadillo Enterprises, Inc.

The TTAB has defined "mistake" within the context of 37 C.F.R § 2.102(b) as meaning "a mistake in the form of the potential opposer's name or its entity type . . . 'mistake' does not encompass the recitation of a different existing legal entity that is not in privity with the party that should have been named." *Cass Logistics Inc. v. McKesson Corp*., 27 U.S.P.Q.2d 1075, 1077 (TTAB 1993). Opposers claim just such a mistake occurred when counsel erroneously used "Armadillo Enterprises, Inc." in the 30 Day Request for Extension of Time to Oppose instead of "Armadillo Distribution Enterprises, Inc. d/b/a Armadillo Enterprises." *Declaration of Arrielle S. Millstein, ESQ*. This

"inadvertent error" was replicated by the TTAB website filing of the 60 Day Request for Extension of Time to Oppose. *Id*.

The opposition period of Gibson's trademark ended on July 24, 2014. The non-legal entity, Armadillo Enterprises, Inc., was granted a 30 day and a 60 day extension to file an opposition. The good causes claimed for the 60 day extension were "[t]he potential opposer needs additional time to investigate the claim" and "[t]he potential opposer needs additional time to confer with counsel." [*See 60 Day Request for Extension of Time to Oppose for Good Cause*.] On October 16, 2014, the Notice of Opposition was finally filed. Apparently, in no time during the nearly three months while Opposers were supposedly investigating the claim and conferring with counsel did Opposers notice that Armadillo Enterprises, Inc. was not a legal entity capable of bringing an opposition. Yet, when Gibson brought the non-legal entity to notice in its Motion to Dismiss, Opposers' counsel referred to the argument as disingenuous as Opposers seemingly believe it is the trademark owner's responsibility to ensure the correct entity is named in a Request for Extension of Time to Oppose.

In Opposers' untimely Opposition to the Motion to Dismiss, Opposers do not request the TTAB change the name to "Armadillo Distribution Enterprises, Inc. d/b/a Armadillo Enterprises" and allow the opposition extension under that name. Opposers have failed to file a Motion to Amend the Notice of Opposition. In its untimely Opposition, Opposers simply ask that the Motion to Dismiss Armadillo Enterprises, Inc. be denied with a footnote that states "[o]nce the suspension is lifted in this proceeding, Opposers will take the necessary procedural steps to correct the typographical error in the caption." [*See Opposition* at 10.] Without any request to amend, Armadillo Enterprises,

Inc. remains a non-legal entity incapable of bringing an opposition and must be dismissed.

C. The Board should grant the Motion to Dismiss for Opposers' failure to allege a valid ground for refusal.

If the Board decides to accept the untimely filed brief in opposition to the Motion to Dismiss, the Motion to Dismiss should still be granted for Opposers' failure to allege a valid ground for refusal. To withstand a motion to dismiss, an opposer must allege facts, if proved, that would establish: (1) opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998); *see also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *see also* TBMP § 503.02. Gibson did not argue that Opposers do not have standing in its Motion to Dismiss and is unclear as to why Opposers spent over a page establishing standing in its untimely filed brief in opposition. [*See Opposition* at 3-5.] Gibson concedes that Opposers, with the exception of Armadillo Enterprises, Inc. as detailed above, have standing to oppose Gibson's trademark.

Gibson contends, however, that Opposers have not alleged a valid ground for refusal as the Notice of Opposition failed to allege or provide "sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal,* 556 U.S. 662, 678 (2009), 129 S. Ct. 1937, 1949 (2009), *quoting Bell Atlantic Corp. v. Twombly,* 550 U.S. 544, 570 (2007). Opposers attempt to allege that Gibson's trademark is generic or, in the alternative, has not achieved a secondary meaning. Both allegations fail to withstand a Motion to Dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6).

First, Opposers plead the Board to rewrite trademark law and the Lanham Act to find that the Opposers adequately plead Gibson's trademark is generic. The Opposers attempt to differentiate a product configuration from the requirement for the test for determining whether a term is generic is its primary significance to the relevant public, that is, whether the term is used or understood, by purchasers or potential purchasers of the goods or services at issue, primarily to refer to the class of such goods or services. *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra*; and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). Opposers claim public perception "cannot be readily applied to the instant opposition as the involved mark is a product configuration, not a 'term' that can be 'used or understood' by the 'purchasers or potential purchasers.'"

Opposers do not mention the public perception of the Gibson trademark in the Notice of Opposition and base this outrageous alteration of trademark law on easily distinguishable authority, *Stuart Spector Designs Ltd. v. Fender Musical Instruments*, 94 U.S.P.Q.2d 1549, 2009 WL 1017284 (TTAB 2009) (hereinafter "*Fender*"). Opposers, however, fail to reference that *Fender* incorporates the public perception into its secondary meaning analysis; "[a]n applicant must show that the primary significance of the product configuration in the minds of the consumers is not the product but the source of that product . . ." *Fender*, 2009 WL 1017284 at *5. Such a dismissal of the primary significance test is directly contrary to the Lanham Act. *See* 15 U.S.C. § 1064(3) ("The primary significance of the registered mark to the relevant public rather than purchaser

motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.").

Opposers' reliance on *Fender* is unfounded. *Fender* involved guitar body designs (product configurations) which had not been protected before the application for the trademarks. *See Fender*, 94 U.S.P.Q.2d 1549, 2009 WL 1017284. On the contrary, Gibson has had a registration on the Supplemental Register for the trademark in question since 1996. The examiner found, in 1996, that Gibson's trademark was not generic and could function as a source identifier upon a showing of a secondary meaning. Opposers allegations of manufacturers producing the same or similar body shape designs before this time are irrelevant and do not state a claim that Gibson's trademark is generic today.

Opposers' argument that Gibson's trademark has not achieved a secondary meaning must fail for similar reasons. When 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. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). The substantially exclusive use requirement makes allowance for use by others that may by inconsequential or infringing. *Id.* at 1010. For the manufacturers alleged after 1996, Opposers do not allege that the guitar manufacturers use of similar body shapes is consequential or infringing on Gibson's trademark.

Opposers fail to allege in their Notice of Opposition that the public perception of Gibson's trademark is not that Gibson is the source of the product configuration. If the Board allows this opposition to continue, Gibson will prove that the product configuration of Gibson's guitar body signifying Gibson as the source **is** the primary

significance to the relevant public. In addition, Opposers fail to allege that Gibson's trademark, registered on the Supplemental Register since 1996, has not acquired distinctiveness as the manufacturers allegedly producing a similar body shape have not been identified as not merely inconsequential or infringing.

CONCLUSION

Opposers have submitted two substantive filings with the Board with substantial defects in both. First, the Notice of Opposition fails to state a claim upon which relief may be granted and names a non-legal entity as an opposer. Next, the opposition brief to this Motion to Dismiss is untimely, filed after the express TTAB rules deadline. To enforce the integrity of the TTAB rules, this Board should disregard the opposition brief as untimely and treat the Motion to Dismiss as conceded, granting it, with prejudice, in its entirety. If the Board should choose to ignore the fatal procedural error, Armadillo Enterprises, Inc. must be dismissed as an opposer as a non-legal entity incapable of bringing an opposition. In addition, if the Board disregards Opposers' failure to file a timely opposition to this Motion to Dismiss, the Board should dismiss the Notice of Opposition, with prejudice, for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6).

Respectfully submitted, this 2nd day of January 2015.

BATES & BATES, LLC

/ Andrea E. Bates /

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ATTORNEY FOR APPLICANT

CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the foregoing Gibson Brands, Inc.'s Reply Memorandum in Support of its Motion to Dismiss Opposition has been served, via US Postal Service first class mail, certified, postage pre-paid, on the 2nd day of January 2015 to:

Ronald S. Bienstock, Esq.
Bienstock & Michael, LLC
411 Hackensack Avenue
7th Floor
Hackensack, NJ 07601
Tel: 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 2nd day of January 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
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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

DECLARATION OF KURT SCHUETTINGER IN SUPPORT OF GIBSON BRANDS, INC.'S REPLY MEMORANDUM IN SUPPORT OF ITS MOTION TO DISMISS OPPOSITION

I, Kurt W. Schuettinger, submit this Declaration in support of Applicant Gibson Brands, Inc.'s ("Gibson") Reply Memorandum in support of its Motion to Dismiss Opposition ("Motion to Dismiss").

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 Brief.

3. On January 2, 2015, I accessed the Florida Secretary of State's website available at sunbiz.org.

4. According to the Florida Secretary of State's website, there are 106 legal entities that have been registered in the State of Florida that include "Armadillo" in the entity name.

5. Over 200 entities have been registered in the State of Florida with "Distribution" in the entity name, with even more entities containing "Enterprises."

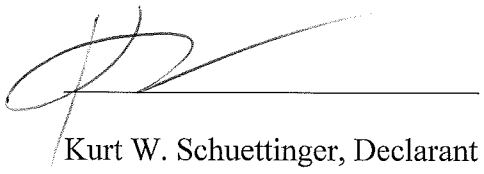
6. Furthermore, on January 2, 2015, I accessed the Delaware Secretary of State's website available at delecorp.delaware.gov.

7. According to the Delaware Secretary of State, approximately 40 entities have registered the term "Armadillo" including "Armadillo Enterprises, Inc.," "Armadillo Enterprises, LLC," and "Armadillo Enterprises LLC."

8. Neither the State of Florida nor the State of Delaware search engines allow the user to look up an entity by its address.

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 January 2nd, 2015 in Atlanta, Georgia.



Kurt W. Schuettinger, Declarant