UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: March 26, 2015

Opposition No. 91218879

U.S. Music Corporation, ESP Shibuya Enterprises, Inc., Cordoba Music Group, Inc., Collings Guitars, Inc., Ed Roman Enterprises, Inc., Armadillo Enterprises, Inc., Schecter Guitar Research, Inc., Westheimer Corporation, Peavey Electronics Corporation

v.

Gibson Brands, Inc.

BY THE TRADEMARK TRIAL AND APPEAL BOARD:

This case now comes up for consideration of Applicant's motion (filed November 25, 2014) to dismiss the notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6) and to dismiss one of the party-plaintiffs.

Preliminary Matter

At the outset, the Board notes that Opposers' response to Applicant's motion is untimely. A responsive brief was due no later than December 15, 2015. *See* Trademark Rule 2.127(a). However, the response was not filed until December 18, 2015, three days late. In view thereof, the response shall not be considered. Nonetheless, insofar as Opposers obviously contest Applicant's

motion, the Board exercises its discretion to consider the motion on its merits. *See Id.*

For purposes of this order, the Board presumes the parties' familiarity with the notice of opposition and Applicant's arguments.

Motion to Dismiss Genericness and Section 2(f) Claims

Applicant requests that the Board dismiss the notice of opposition, arguing essentially that Opposers have failed to properly plead their genericness and Section 2(f) claims. Additionally, Applicant requests that Opposer Armadillo Enterprises, Inc. be dismissed from the proceeding because it is not a legal entity in good standing that is capable of filing the opposition.

To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff (here, Opposers) need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the registration. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012) (*citing Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995); and TBMP § 503.02 (2015). Specifically, a complaint "must contain 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) (*quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." *Iqbal*, 556 U.S. 662, *citing Twombly*, 550 U.S. at 555.

To sufficiently plead a claim that the mark at issue is the generic name or adjective for the identified goods or services, the plaintiff must allege that the mark at issue is widely used generically to identify the genus of goods or services identified in the opposed application or registration sought to be cancelled, and that consumers primarily understand the asserted mark to be the generic name or identifier of the genus of goods or services. *See H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). *See also Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (internal citation omitted) ("… a proper genericness inquiry focuses on the description of services [or goods] set forth in the [application or] certificate of registration"). "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." *Stuart Spector Designs, Ltd. v. Fender Musical Inst. Corp.*, 94 USPQ2d 1549, 1555 (TTAB 2009)).

Here, Opposers allege the following in relevant part:

17. Upon information and belief, Applicant manufactures, sells and distributes musical instruments, including, but not limited to, electric guitars and electric bass guitars.

18. Opposers are direct competitors of Applicant.

19. Application Serial No. 86/168,793 (the '793 App.' or the "Mark") seeks registration of a product configuration … for "stringed musical instruments."

. . .

28. In 1958, Applicant's predecessor-in-interest began manufacturing, advertising, marketing and selling electric guitars incorporating the '793 Body Shape under the model designation "ES-335."

29. Throughout Applicant's use of the '793 Body Shape, the dimensions have not been consistent and variations are common place [*sic*].

30. The '793 Body Shape was, and is, extremely similar to many other guitar body shapes.

31-34. From the 1960's [continuing through] …. the 1990's [over 100 specifically identified] companies were manufacturing, advertising, marketing and selling, in the United States, electric guitars and basses bearing body shapes that are identical, or substantially similar to, the '793 Body Shape, including, but not limited to [companies identified].

35. In the 2000's, even more companies were manufacturing, advertising, marketing and selling, in the United States, electric guitars and basses bearing body shapes that are identical, or substantially similar to, the '793 Body Shape, including, but not limited to [companies identified].

36. From 2010, and continuing through the date hereof, even more companies are manufacturing, advertising, marketing and selling, in the United States, electric guitars and basses bearing body shapes that are identical, or substantially similar to, the '793 Body Shape, including, but not limited to [companies identified].

37. Upon information and belief, none of these third parties are subsidiaries of Applicant nor did they license the '793 Body Shape from Applicant.

> 38. Upon information and belief, advertising and sales of third-party guitars bearing body shapes that are identical, or substantially similar to, the '793 Body Shape has been, and continues to equal or exceed the advertising and sales of Applicant's guitars bearing the '793 Body Shape.
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> 39. As a result of the foregoing rampant use by third parties, the '793 Body Shape is a generic electric body shape, does not function as a source identifier and has become a standard style of guitar.
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> . . .
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> 46. As a result of the foregoing rampant use by third parties for more than half a century, as well as Applicant's and its predecessor-in-interest's complete failure to treat the '793 Body Shape as a trademark, the '793 Body Shape is a generic electric guitar body shape and, therefore, cannot function as a source identifier.
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> 47. In the alternative, even if the '793 Body Shape has not become generic, the '793 App. for registration under 2(f) must be denied because stringed musical instruments consumers are confronted with numerous independent uses of body shapes substantially similar or identical to the '793 Body Shape. Accordingly, Applicant cannot have acquired distinctiveness in the '793 Body Shape.

Applicant's motion is not well taken. Turning first to standing, Opposers are identified as manufacturers and sellers of guitars and bass guitars (¶¶1-15) and have clearly alleged that they are competitors of Applicant (¶18). In view thereof, Opposers have set forth a sufficient allegation of standing. *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *De Walt, Inc. v. Magna Power Tool Corp.,* 289 F.2d 656, 129 USPQ 275, 280 (CCPA 1961) (damage presumed or inferred when the mark sought to be registered is descriptive of the goods and opposer is one who has a sufficient interest in using the descriptive term in its business); *Plyboo American, Inc. v. Smith & Fong Co.,* 51 USPQ2d 1633, 1634 (TTAB 1999) (competitor has

standing to oppose) (*cited in Stuart Spector Designs, Ltd.*, 94 USPQ2d at 1553).

Regarding the genericness claim itself, Opposers have alleged that "as a result of the foregoing rampant use by third parties, the '793 Body Shape is a generic electric body shape, does not function as a source identifier and has become a standard style of guitar" (¶39). Alleging that the applied-for mark is a rampantly used generic shape, has become a standard[1] style of guitar, *i.e.*, is commonly used, and does not function as a source identifier, is sufficient. *See Spector Designs*, 94 USPQ2d at 1555 ("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"). The Board finds that this allegation is sufficient to provide Applicant with notice of Opposers' genericness claim. To the extent Applicant argues that Opposers have not provided sufficient facts to support its allegations or to overcome the weight given to the examiner's determination that the mark is not generic, such arguments go to the merits of Opposers' claims and are premature. A

[1] The Board takes judicial notice of the meaning of the term "standard," *i.e.*, "Commonly used or supplied," from https://www.ahdictionary.com/word/search.html?q=standard, accessed on 3/26/2015, copyright 2015 Houghton Mifflin Harcourt.

The Board may take judicial notice of dictionary definitions, including online reference works which exist in print format or have regular fixed editions. *See, e.g., Boston Red Sox Baseball Club LP v. Sherman,* 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (judicial notice taken of definition from the Merriam-Webster Online Dictionary). *See also Syngenta Crop Protection, Inc. v. Bio-Chek LLC,* 90 USPQ2d 1112, 1117 (TTAB 2009); and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

motion to dismiss is a test solely of the legal sufficiency of a complaint, "not the sufficiency of any evidence that might be adduced." *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Likewise, Opposers have sufficiently set forth a claim that registration should not be allowed under Section 2(f) of the Trademark Act insofar as they allege that because of widespread, independent use of substantially similar or body shapes, Applicant's applied-for mark cannot have acquired distinctiveness (¶47). *See Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1358 (TTAB 2003) (finding the allegation "defendant's mark is not distinctive under Section 2(f) of the Trademark Act" to be sufficient). Accordingly, Applicant's motion to dismiss Opposer's genericness claim and claim that the applied-for mark cannot be registered under Section 2(f) of the Trademark Act is **denied**.

"Improper" Party Plaintiff

Applicant's motion to dismiss the opposition with respect to Opposer Armadillo Enterprises, Inc. is essentially a motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of jurisdiction. Applicant has submitted documents from the Florida Department of State Division of Corporations which indicate that "Armadillo Enterprises, Inc." was a dissolved entity, that is, it did not exist at the time the requests for extension of time to file the opposition and the notice of opposition were filed. Inasmuch as Opposers' untimely response

to Applicant's motion cannot be considered, yet it would highly unusual for a party to file an opposition if it did not exist, Opposers are allowed until **APRIL 10, 2015**, to file a response with the Board to show cause why the proceeding should not be dismissed with respect to Armadillo Enterprises, Inc., failing which the notice of opposition may be dismissed as to that opposer.[2] Consideration of Applicant's motion is thus **deferred**.

Proceeding Resumed; Trial Dates Reset

Inasmuch as the Board expects the issue related to Armadillo Enterprises, Inc. to be resolved promptly, this proceeding is resumed. Answer is due on **April 25, 2015**. Trial dates are reset as shown in the following schedule:

Time to Answer	**4/25/2015**
Deadline for Discovery Conference	**5/25/2015**
Discovery Opens	**5/25/2015**
Initial Disclosures Due	**6/24/2015**
Expert Disclosures Due	**10/22/2015**
Discovery Closes	**11/21/2015**
Plaintiff's Pretrial Disclosures Due	**1/5/2016**
Plaintiff's 30-day Trial Period Ends	**2/19/2016**
Defendant's Pretrial Disclosures Due	**3/5/2016**
Defendant's 30-day Trial Period Ends	**4/19/2016**
Plaintiff's Rebuttal Disclosures Due	**5/4/2016**
Plaintiff's 15-day Rebuttal Period Ends	**6/3/2016**

[2] The parties are referred to *U.S. Pioneer Elec. Corp. v. Evans Mktg., Inc.*, 183 USPQ 613 (Comm'r Pats. 1974) (holding that applicant's name may be corrected where the application was mistakenly filed in the name of a fictitious and non-existent party).

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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