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

Proceeding	91246161
Party	Defendant Gibson Brands, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

THE EXECUTORS OF THE)	
ESTATE OF LES PAUL)	
)	
<i>Opposer-Counterclaim Defendant,</i>)	Opposition No.: 91246161
)	App No.: 87/978,388
)	
v.)	
)	
GIBSON BRANDS, INC.,)	
)	
<i>Applicant-Counterclaim Plaintiff.</i>)	
)	

**MOTION FOR A MORE DEFINITE STATEMENT, AND IN THE
ALTERNATIVE, ANSWER TO AMENDED NOTICE OF OPPOSITION**

Applicant Gibson Brands, Inc. (“Gibson”), by its undersigned counsel, moves the Board for a more definite statement of Opposer the Executors of the Estate of Les Paul’s (“Estate”) Amended Notice of Opposition (the “Opposition”), or, in the alternative, Applicant’s answers the Amended Notice of Opposition.

I. Opposer’s definition of the “Application” is indefinite.

The Estate’s use of the defined term “Application” is indefinite, and Gibson cannot reasonably prepare a response. Pursuant to TBMP § 505, Gibson requests the Board order a more definite statement with regard to this defined term.

In paragraph 2 of the Opposition, the Estate defines the Application as “application Serial No. 87/786,126 for LES PAUL (the “Alleged Mark”) for “organizing and conducting charity auctions for charitable fundraising purpose” in Class 35 and “entertainment services in the nature of live musical performance” in Class 41 (the

“Application”).” Dkt. 12, paragraph 2. In paragraph 9 of the Opposition, the Estate defines the Application as “child application Serial No. 87/978,388 for LES PAUL contained the services “organizing and conducting charity auctions for charitable fundraising purposes” in Class 35 (“Applicant’s Services”) (the “Application”).” Dkt 12, paragraph 9. Paragraphs 10 -13, 26, 32, 33, 47, 51, 54, 58, 62, 63, 68, 69, 71, 73, 80, and 82 of the Opposition all contain references to “the Application” that are unclear as to whether such references indicate Application No. 87/786,126 or Application No. 87/978,388. These references are vague and ambiguous such that Applicant cannot reasonably prepare a response. Thus, Applicant requests the Board instruct Opposer to provide a more definite statement with respect to Opposer’s use of the defined term “Application.”

II. In the alternative, Gibson answers the Opposition.

Gibson answers the Opposition as follows:

1. Gibson admits the allegation in paragraph 1 that it is a corporation of the laws of Delaware. Gibson denies the allegation in paragraph 1 that its principal place of business is at 309 Plus Park Boulevard, Nashville, Tennessee, 37127.
2. Gibson admits the allegation in paragraph 2.
3. Gibson admits the allegation in paragraph 3.
4. Gibson admits the allegation in paragraph 4.
5. Gibson admits the allegation in paragraph 5.
6. Gibson denies the allegation in paragraph 6.
7. Gibson denies the allegation in paragraph 7.
8. Gibson admits the allegation in paragraph 8.
9. Gibson admits the allegation in paragraph 9.

10. Gibson admits the allegation in paragraph 10.
11. Gibson admits the allegation in paragraph 11.
12. Gibson admits the allegation in paragraph 12.
13. Gibson admits the allegation in paragraph 13.
14. Gibson admits the allegation in paragraph 14.
15. Gibson admits the allegation in paragraph 15.
16. Gibson admits the allegations in paragraph 16.
17. Gibson admits the allegations in paragraph 17.
18. Gibson admits the allegations in paragraph 18.
19. Gibson denies the allegations in paragraph 19.
20. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 20.
21. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 21.
22. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 22.
23. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 23.
24. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 24.
25. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 25.

26. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 26.

27. Gibson denies the allegations in paragraph 27.

28. Gibson denies the allegations in paragraph 28.

29. Gibson denies the allegations in paragraph 29.

30. Gibson denies the allegation in paragraph 30.

Claim I: Non-Use

31. Gibson incorporates by reference paragraphs 1-30 of this Answer as if more fully set forth herein.

32. Gibson denies the allegations in paragraph 32.

33. Gibson admits the allegation in paragraph 33.

34. Gibson admits the allegation in paragraph 34.

35. Gibson admits the allegation in paragraph 35.

36. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 36.

37. Gibson admits the allegation in paragraph 37.

38. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 38.

39. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 39.

40. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 40.

41. Gibson admits the allegation in paragraph 41.

42. Gibson admits the allegation in paragraph 42.

43. Gibson admits the allegation in paragraph 43.

44. Gibson lacks knowledge or information sufficient to form a belief about the truth of the allegation in paragraph 44.

45. Gibson denies the allegation in paragraph 45.
46. Gibson denies the allegation in paragraph 46.
47. Gibson denies the allegation in paragraph 47.
48. Gibson denies the allegation in paragraph 48.
49. Paragraph 49 does not contain an allegation.

Claim II: Non-Ownership

50. Gibson incorporates by reference paragraphs 1-49 of this Answer as if more fully set forth herein.

51. Gibson admits the allegation in paragraph 51.
52. Gibson denies the allegation in paragraph 52.
53. Gibson admits the allegation in paragraph 53.
54. Gibson denies the allegation in paragraph 54.

Claim III: Abandonment

55. Gibson incorporates by reference paragraphs 1-54 of this Answer as if more fully set forth herein.

56. Gibson denies the allegation in paragraph 56.
57. Gibson denies the allegation in paragraph 57.
58. Gibson denies the allegation in paragraph 58.

Claim IV: Likelihood of Confusion

59. Gibson incorporates by reference paragraphs 1-58 of this Answer as if more fully set forth herein.

60. Gibson admits the allegation in paragraph 60.

61. Gibson admits the allegation in paragraph 61.

62. Gibson admits the allegation in paragraph 62.

63. Gibson admits the allegation in paragraph 63.

64. Gibson admits the allegation in paragraph 64.

65. Gibson admits the allegation in paragraph 65.

66. Gibson denies the allegation in paragraph 66.

Claim V: Fraud

67. Gibson incorporates by reference paragraphs 1-66 of this Answer as if more fully set forth herein.

68. Gibson denies the allegation in paragraph 68.

69. Gibson denies the allegation in paragraph 69.

70. Gibson denies the allegation in paragraph 70.

71. Gibson admits the allegation in paragraph 71.

72. Gibson admits the allegation in paragraph 72.

73. Gibson admits the allegation in paragraph 73.

74. Gibson admits the allegation in paragraph 74.

75. Gibson denies the allegation in paragraph 75.

76. Gibson denies the allegation in paragraph 76.

77. Gibson denies the allegation in paragraph 77.

78. Gibson denies the allegation in paragraph 78.
79. Gibson denies the allegation in paragraph 79.
80. Gibson denies the allegation in paragraph 80.
81. Gibson denies the allegation in paragraph 81.
82. Gibson denies the allegation in paragraph 82.
83. Paragraph 83 does not contain an allegation.

COUNTERCLAIMS

Background Facts

84. On August 26, 2015, the Estate filed Application No. 86/737,890 (the “890 Application”) for LES PAUL to be used with: “[a]dvertising and marketing in the fields of community educational and municipal events of others regarding historic figures; promoting public awareness of the importance of particular historic figures” in Class 35; “[p]roviding information, news and commentary in the field of current events relating to historical figures; organizing music education programs, namely, conducting classes and seminars in the field of music; organizing exhibitions and live music concerts for entertainment purposes; providing a website featuring information on historic figures” in Class 41; and “[l]icensing of use of images of historical figures in connection with public exhibitions, music education programs and music concerts” in Class 45 (“890 Application Services”).

85. On August 26, 2015, the Estate filed Application No. 86/737,896 which matured into Registration No. 5,193,825 (the “825 Registration”) for LES PAUL to be used with: “[a]dvertising and marketing in the fields of community educational and municipal events of others regarding historic figures; promoting public awareness of the importance

of particular historic figures” in Class 35; “[p]roviding information, news and commentary in the field of current events relating to historical figures; organizing music education programs, namely, conducting classes and seminars in the field of music; organizing exhibitions and live music concerts for entertainment purposes; providing a website featuring information on historic figures” in Class 41; and “[l]icensing of use of images of historical figures in connection with public exhibitions, music education programs and music concerts” in Class 45 (“825 Registration Services”).

86. Gibson is the owner of all right, title and interest in and to a family of marks that include the word LES PAUL, including the following registrations, applications, and common law uses (collectively “Gibson’s Marks”):

- a. LES PAUL (and Design) (Reg. No. 918,934) registered on August 24, 1971 used with “guitars” in Class 15;
- b. LES PAUL (Reg. No. 1,539,282) registered on May 16, 1989 used with “stringed instruments, namely guitars and basses” in Class 15;
- c. LES PAUL (Reg. No. 4,914,920) registered on March 8, 2016 used with “audio speakers, loudspeakers” in Class 9;
- d. LES PAUL (App. No. 87/510,675) filed on June 29, 2017 to be used with “Belts; Hats; Shirts; Socks; Sweatshirts; T-shirts; Graphic T-shirts” in Class 25;
- e. LES PAUL (App. No. 87/978,388) filed on February 6, 2018 used with “organizing and conducting charity auctions for charitable fundraising purposes” in Class 35;

f. LES PAUL (App. No. 87/786,126) filed on February 6, 2018 used with “Entertainment services in the nature of live musical performances” in Class 41; and

g. LES PAUL ARTISAN (App. No. 88/943,707) filed on June 2, 2020 to be used with “guitars; electric guitars” in Class 15.

The goods used with Gibson’s Marks as set forth herein are referred to as “Gibson’s Goods.”

Counterclaim I: Priority

87. Gibson incorporates by reference paragraphs 84-86 of this Answer as if more fully set forth herein.

88. Gibson has adopted and continuously used since at least as early as 2004 LES PAUL substantially exclusively for and in connection with community educational and municipal events regarding historical figures, promoting public awareness of the importance of particular historical figures, providing information, news and commentary in the field of current events relating to historical figures, organizing music education programs, and conducting classes and seminars in the field of music.

89. Gibson has adopted and continuously used since at least as early as 2005 LES PAUL substantially exclusively for and in connection with organizing exhibitions and live music concerts for entertainment purposes.

90. Gibson has adopted and continuously used since at least as early as 1996 LES PAUL substantially exclusively for and in connection with a website featuring information on historical figures. For example, since Gibson created its website in 1996, Gibson has featured articles providing information on Les Paul (the person), the Les Paul guitar, and Les Paul’s (the person) connection to the guitar and other musical inventions.

91. Upon information and belief, Gibson owns the LES PAUL mark for community educational and municipal events regarding historical figures, promoting public awareness of the importance of particular historical figures, providing information, news and commentary in the field of current events relating to historical figures, organizing music education programs, and conducting classes and seminars in the field of music; organizing exhibitions and live music concerts for entertainment purposes; and in connection with a website featuring information on historical figures through substantially exclusive use prior to any use by the Estate.

92. Upon information and belief, the Estate is unable to establish, with respect to Gibson's use of Gibson's Marks, priority of use and/or priority of rights in the United States in connection with the 890 Application and the 825 Registration.

Counterclaim II: Likelihood of Confusion

93. Gibson incorporates by reference paragraphs 87-92 of this Answer as if more fully set forth herein.

94. Upon information and belief, the 890 Application Services and 825 Registration Services and Opposer's Goods are of similar types, are offered or may be offered through the same, substantially the same, and/or related channels of trade, to the same, substantially the same, and/or related classes of purchasers and are or may be advertised, marketed and promoted through the same media channels.

95. Upon information and belief, the 890 Application and the 825 Registration, when used in connection with the 890 Application Services and 825 Registration Services, so resemble Gibson's Marks as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of the 890 Application Services and 825

Registration Services, with respect to Gibson's sponsorship thereof or connection or affiliation therewith, and/or in other ways.

96. Upon information and belief, the 890 Application and the 825 Registration so closely resemble Gibson's Marks that potential purchasers of the services intended to be offered under the 890 Application and the 825 Registration would be likely to believe that Gibson is the source of such services, or that Gibson has authorized, sponsored, approved of, or in some other manner associated itself with the 890 Application Services and 825 Registration Services, thereby creating a likelihood of confusion, deception or mistake, all to the damage of Gibson.

97. Gibson would be further damaged by the 890 Application and the 825 Registration as their continued existence is inconsistent with and detrimental to Gibson's established and superior rights in Gibson's Marks and the registrations of the same.

98. Accordingly, Gibson hereby requests the 890 Application be denied registration and the 825 Registration be cancelled.

Counterclaim III: Non-Ownership

99. Gibson incorporates by reference paragraphs 93-98 of this Answer as if more fully set forth herein.

100. The Estate filed Application Nos. 86/737,890 and 86/737,896 claiming to be the lawful owner of the "LES PAUL" trademark for the 890 Application Services and 825 Registration Services.

101. Upon information and belief, the Estate is not, and was not at the time of filing Application Nos. 86/737,890 and 86/737,896, the owner of the LES PAUL trademark in connection with the 890 Application Services and 825 Registration Services.

102. Under 15 USC § 1051(a)(1), only the owner of a trademark may seek registration of the trademark on the federal Principal Register.

103. Since the Estate was not the owner of Application Nos. 86/737,890 and 86/737,896 as of their respective filing dates, the 890 Application and the 825 Registration should be declared *void ab initio*.

104. Accordingly, Gibson hereby requests the 890 Application be denied registration and the 825 Registration be cancelled.

Counterclaim IV: Fraud

105. Gibson incorporates by reference paragraphs 99 – 104 of this Answer as if more fully set forth herein.

106. As of the filing dates for Application Nos. 86/737,890 and 86/737,896, the Estate did not own the trademark “LES PAUL” for use with the 890 Application Services and 825 Registration Services.

107. Further, the Estate filed Application Nos. 86/737,890 and 86/737,896 claiming to be the lawful owner of the trademark “LES PAUL” for use with the 890 Application Services and 825 Registration Services.

108. The Estate is not, and was not at the time of alleged first use, the owner of the trademark “LES PAUL” for use with the 890 Application Services and 825 Registration Services.

109. In filing Application Nos. 86/737,890 and 86/737,896, the Estate represented its belief that no other party has a right to use the trademark “LES PAUL” or a similar mark in a manner that is likely to cause confusion.

110. When filing Application Nos. 86/737,890 and 86/737,896, the Estate knew of Gibson's use of the confusingly similar Gibson Marks and actually believed that Gibson had a right to use the Gibson Marks.

111. The Estate made a false statement that it had owned and/or had exclusive rights to the trademark "LES PAUL" for use with the 890 Application Services and 825 Registration Services and made such false statement with the intent to deceive the examiner and procure registrations for which the Estate was not entitled.

112. Accordingly, Gibson hereby requests the 890 Application be denied registration and the 825 Registration be cancelled.

Respectfully submitted, this 22nd day of June 2020.

BATES & BATES, LLC

/ Andrea E. Bates /

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ATTORNEYS FOR GIBSON
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CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the foregoing Gibson Brands, Inc.'s Motion For A More Definite Statement, And In The Alternative, Answer To Amended Notice Of Opposition, has been served, via email, on the 22nd day of June 2020 to:

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