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UNITED STATES: Fender Hits Sour Note at Trademark Trial and Appeal Board

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In a 75-page precedential decision, the U.S. Trademark Trial and Appeal Board (TTAB) found that three guitar body shapes for which Fender Musical Instruments Corporation sought trademark registration were generic and that Fender failed to prove that the designs had acquired distinctiveness under Section 2(f) of the Trademark Act. *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, Opposition Nos. 91161403 et al. (TTAB Mar. 25, 2009).



Fender filed applications to register three design marks consisting of the configurations of the body portions of its STRATOCASTER, TELECASTER and PRECISION BASS guitars for “guitar bodies” in Class 15. The company alleged that the designs had acquired distinctiveness as a result of its extensive period of use of these designs. Sixteen guitar manufacturers and one instrument retailer opposed the applications on the ground that the configurations were generic or, alternatively, that Fender failed to prove acquired distinctiveness.

The record included evidence of extensive and unchallenged use by Fender competitors of the same or substantially similar guitar body designs since at least the mid-1970s. The TTAB found the guitar body shapes so common in the industry as to be generic and incapable of identifying a particular source.

In addressing the acquired distinctiveness claim, the TTAB noted that product configurations are not inherently distinctive and may be registered as trademarks only upon a showing of acquired distinctiveness. The burden of persuasion on the issue of acquired distinctiveness is on the applicant and is particularly heavy when use by the applicant has not been exclusive. The TTAB found that, in the face of extensive and unchallenged third-party use of these guitar designs over a period of at least 30 years, Fender failed to establish that its guitar body designs had acquired distinctiveness.

Each of the consolidated oppositions was sustained, and the applications were refused registration.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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