

TELL TCHAIKOVSKY THE NEWS: TRADE DRESS RIGHTS IN MUSICAL INSTRUMENTS

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I. INTRODUCTION

Does the design of a musical instrument connote source, or is it just functional? This article considers the historical development of instrument design in the classical tradition, the emergence of source-indicators as design elements of modern pop instruments, and the U.S. Trademark Office's recent willingness to register—and judicial recognition of—an electric guitar's shape as a trademark and as trade dress. The tests applicable to musical instruments will be compared to those applied to other products in the controlling trade dress caselaw, and guidelines for discerning source-indicators and functional features of instrument design will be suggested.¹

Section II is an overview of the principal parts of the violin and guitar configurations, their function and historical development, which will aid the later consideration of the modern legal cases concerning the guitar.

Section III will introduce the transition to mass-produced pop instruments through innovation (as in the case of the saxophone) and imitation.

Section IV will trace the emergence of source indicators for modern musical instruments in the marketplace and in the early case law (for example, guitar headstock configurations as source indicators of guitar makers' output).

Section V will provide a critical analysis of the U.S. Trademark Office's recent willingness to register the shape and overall configuration of Gibson's LES PAUL guitar as a trademark and as trade dress. The tests applicable to musical instruments

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1. Implementation of such guidelines by trademark examining authorities may facilitate discernment of the protectable features of an instrument's design that might properly work to signify its maker as the genuine source without impeding competition.

will be compared to the tests for functionality and descriptiveness as applied to other products in the controlling caselaw.

Section VI will outline the authors' conclusion and suggestions for discerning source-indicators and functional features of instrument design.

II. CLASSICAL ORCHESTRAL INSTRUMENT DESIGN

Western classical music depends heavily upon two instrument designs, the strings—exemplified by the violin—and the piano. The violin took its characteristic form in about 1700, with the classic designs of Stradivarius and Guarneri. An understanding of the principal parts of a violin will aid the later consideration of the modern legal cases concerning the guitar. The shape of the guitar and the violin are congruent. They likely derived from a common ancient predecessor. Both instruments historically were crafted by the same makers (luthiers). For example, Stradivarius made both violins and guitars.²

The violin is configured as a body having a neck with a fingerboard that terminates in a headstock, which in the violin generally takes the shape of a scroll. The violin body has upper and lower bouts that are separated by a narrowed waist (the “C bouts”). The upper bouts are narrower than the lower bouts. The strings are tuned by tuning pegs in the headstock. The strings rest upon a bridge, which in turn stands on the body in the region of the C bouts, as illustrated:



Overall violin quality is a subjective matter, depending upon timbre, volume of sound and ease of playing. The range of quality is huge, ranging from a mass-produced \$99 instrument to a genuine Stradivarius valued at \$2,000,000. One thing is clear: the difference in value is not attributable to trade dress rights. The design configuration of the \$99 copy is, from an audience's perspective, essentially indistinguishable from a genuine

2. A reproduction of a Stradivarius guitar from the Ashmolean Museum collection can be seen at http://www.lkbrownviolins.com/stradivari_baroque_guitar.htm.

Stradivarius. Over the years, the Stradivarius and Guarneri patterns have been copied repeatedly by master luthiers as well as by assembly-line factories. Forgers attempt to pass off their Stradivarius and Guarneri copies as having been made by the masters, but the great majority of the legitimate industry, including master luthiers, make copies, as well; the difference is only that they also affix their own name or trademark.³

As a result, in the violin trade the opinion of an expert is essential to establish the true value of an instrument. Without a “certificate” from a recognized expert, the marketplace is ruled by the *caveat emptor* principle. Even with such a certificate one is not always better off, as the experts may not speak with one voice.⁴ Trade dress plays no role in this marketplace since almost all violins are made to look, play and sound the same as an antique Stradivarius or Guarneri, and their value depends upon the extent to which the imitation has succeeded.

The situation is much the same when one considers the other mainstay of Western classical music, the piano. The piano developed from the harpsichord, a wooden frame with strings arrayed over a soundboard and plucked not by hand like a harp, but by key activation. The main advance in the piano has been the massive frame, which permits longer and thicker strings, greater string tension and louder sound volume. The Steinway piano dominates this market and is the “gold standard” for concert pianos. Other brands of piano emulate the Steinway in terms of timbre, playing action and sound volume, but in overall configuration, a grand piano by Mason & Hamlin, Baldwin or Yamaha can hardly be distinguished from a Steinway. All pianos need the same massive housing to contain the strings. The name affixed to the fallboard, prominently seen in concert footage, is the main indicator of the piano’s source. Hence, small differences in the names of pianos—STEINWAY versus GROTRIAN-

3. See, e.g., Sidney Bowden, *Gand-Pajeot A Letter of Instruction* (Morel & Gradoux-Matt, New York, 2000) (reproducing 1836 correspondence in which prominent dealer Gand orders violin bows to be made by Pajeot with the characteristic Tourte pattern and fittings, which Bowden concludes Gand sold as genuine Tourte bows that may still be misattributed as the work of Tourte to this very day, due to Pajeot’s expertise as a copyist and Gand’s authority). See also *Musical Instruments of the World* 313 (1976) (providing a profile of François Tourte (1747-1835)).

4. Controversy currently surrounds the New Jersey Symphony Orchestra’s \$17,000,000 purchase of a collection of antique string instruments from a “donor,” supposedly at a favorable charitable-discount price. Many of the instruments are thought to have been misattributed and wildly overvalued by the donor’s expert. The donor has been arrested for other frauds. M. Muller, *False Notes*, Newark Star-Ledger, August 1, 2004, (reprinted at <http://www.nj.com/search/index.ssf?base/news-16/1091337224184670.xml?starledger?ntop>). See also D. Schoenbaum, *Dealing in the Instruments of Their Own Demise*, New York Times, Sunday, August 29, 2004, 21.

STEINWEG—can lead to important legal consequences.⁵ Trade dress again plays little, if any, role in distinguishing these instruments.

III. EARLY POP MUSIC INSTRUMENT DESIGN

An early pop musical instrument innovator was Adolphe Sax, the inventor of the saxophone. The saxophone was patented in France on May 17, 1846.⁶ The distinctive tone of the saxophone stems from its combination of a previously-known instrument body material—the brass used in trumpets—with the vibrating reed method of tone-production previously used in clarinets and oboes. The saxophone may be considered to be a good example of a novel combination of known features.

The French patent on the basic saxophone design has, of course, long-since expired (in 1866). As a result, many makers compete to produce instruments using Adolphe Sax's basic configuration, just as luthiers emulate Stradivarius violins and piano manufacturers emulate Steinway pianos. Here too, trade dress plays little role in distinguishing one maker's instrument from another's.

Hence, the situation with respect to trade dress protection for musical instrument designs prior to more modern times could well be characterized by the song title, "The Sounds of Silence." The prevailing principle would have been that well-expressed principle in the famous U.S. Supreme Court decision *Sears v. Stiffel*.⁷ Once a musical instrument design (like a lamp design) has lost its patent protection, or if it never had any, it is fair game for anyone to imitate it provided the imitation is not passed off to the public as being the work of the master. Under this principle, an exact imitation of a Stradivarius violin is perfectly lawful, provided it is labeled as such.

5. *Grotian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 186 U.S.P.Q. 436 (2d Cir. 1975) (infringement found, based upon survey evidence, due to initial interest confusion).

6. <http://encyclopedia.thefreedictionary.com/saxophone>. See also *Musical Instruments of the World* 310 (1976) (providing a profile of "Adolphe" (Antoine Joseph) Sax (1814-1894)).

7. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964).

IV. EMERGENCE OF TRADE DRESS PROTECTION FOR MUSICAL INSTRUMENTS

Perhaps the definitive modern case on the protection of a musical instrument design as trade dress is *Yamaha Int'l Corp. v. Hoshino Gakki Co.*⁸

The *Yamaha v. Hoshino* case involved an opposition proceeding before the U.S. Trademark Trial & Appeal Board (TTAB) against an application to register the headstock shape of the IBANEZ brand electric guitar as a trademark. The shape looked like this:



The opposer argued that the shape should be refused registration on the ground that the applicant had not presented sufficient evidence that its headstock had acquired distinctiveness (secondary meaning). The opposer introduced testimony and documentary evidence before the TTAB that it and at least three other guitar manufacturers had previously utilized guitar heads “like” or “similar” to those used by applicant Hoshino.⁹ On appeal of the TTAB’s dismissal of the opposition, the reviewing court explained that in the *ex parte* prosecution, the applicant must make a *prima facie* showing of acquired distinctiveness. Then the mark is published for opposition. An opposer must come forward with evidence sufficient to rebut the applicant’s showing already of record; if so, the applicant must then bear the ultimate burden of demonstrating acquired distinctiveness, based upon the entire record.¹⁰ Here, the record included evidence of sales and advertising for eight years, and expert testimony from notable jazz guitarist John Scofield and guitar maker Roger Sadowsky.¹¹ Scofield and Sadowsky testified that the IBANEZ headstock shape was unique among guitars, and that as a result an IBANEZ guitar could be identified even from the back of a concert hall, simply by reference to the shape of its headstock. The court accepted this as proof that the shape had acquired secondary meaning and so

8. 840 F.2d 1572 (Fed. Cir. 1988), *aff’g* 231 U.S.P.Q. 926 (T.T.A.B. 1986), *discussed in* “The 40th Year (The Annual Review),” 77 TMR 558-59 (1987), *and in* A. L. Fletcher & R. M. Kunstadt, 1988-89 *Trademark Law Handbook, Annual Review of Developments in Trademark Law and Practice* 68 (1989).

9. *Yamaha v. Hoshino*, 840 F.2d at 1581-82.

10. Fletcher & Kunstadt, *supra* note 8, at 68.

11. *Yamaha v. Hoshino*, 840 F.2d at 1583.

functioned as a trademark and as such was entitled to be registered.¹²

Scofield's and Sadowsky's testimony was well-grounded in fact, since unlike violins, whose headstocks almost without exception are carved into the same generic scroll, the custom and practice in the guitar trade was to differentiate makers' output by the cut of their headstocks, as will be seen from the following discussion.¹³

Like Stradivarius and Guarneri in the violin trade, two dominant electric guitar brands emerged on the market in the 1950s: Gibson and Fender. These guitar brands were each made upon the same basic form that had originated hundreds of years before in the violin and other precursor stringed instruments: a body with bouts, a neck with a fingerboard and a scroll with tuning pegs. By enlarging the historic pattern and adapting it to be plucked rather than bowed, the generic acoustic-guitar shape (the so-called "Spanish guitar" illustrated below) had emerged by about 1900:¹⁴



To meet the need for more sound volume to accompany 20th century jazz and dance bands, the Spanish guitar was electrified, which meant that its large, hollow resonant body chamber could be replaced by a solid wood body. The basic shape of the body with upper, lower and C bouts was retained, since it is easy to hold in both a sitting and standing position. Illustrated below is a typical Fender brand electric guitar design, with an enlarged detail of the headstock shape (the STRATOCASTER model):

12. *Id.*

13. Some older violin-family instruments had headstocks in the shape of human or animal heads, but violinmakers largely standardized on the floral-design scroll. *Musical Instruments of the World* 198-201 (1976).

14. Spanish luthier Antonio de Torres Jurado (1817-1892) is credited as responsible for the modern guitar. *Musical Instruments of the World* 312 (1976).



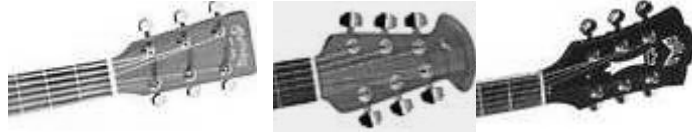
Below is a typical Gibson brand design with an enlarged detail of its headstock shape (the LES PAUL model):



Hoshino's business at the time of the Federal Circuit's decision in *Yamaha v. Hoshino* was largely the production of inexpensive copies of Fender STRATOCASTER guitars, which at that time was considered lawful for reasons discussed above in connection with the *Sears v. Stiffel* case. However, as testified by Hoshino's expert witnesses, the headstocks on Hoshino guitars did not imitate the Fender headstock, but in contrast were purposefully configured in a unique cut to signify origin with Hoshino rather than Fender. This strategy was consistent with the overall custom in the trade

at that time. The two major players, Fender and Gibson, each used headstock designs that differed from each other, which permitted their products to be recognized by reference thereto.

Other makers followed the same custom. Martin, Ovation and Guild brand guitars each used the respective headstocks, below:



Hence, until recently, the guitar market followed the historical custom and practice of the guitar trade—consistent with the expert testimony in the *Yamaha v. Hoshino* case—that it was an ethical practice to copy instruments, provided the headstock configuration of the copy was distinguishable from the headstock configuration of the copied brand. The marketplace was filled with third-party variations on the basic Fender and Gibson body shapes, for example, the Ibanez (on the left) and Guild (on the right) models below:



Also present in the market from the 1960s to the 1990s were outright copies, replicating even the headstocks, but usually bearing different word trademarks. There was also a flourishing trade in “replacement” necks, which generally included replications of the Fender headstock configuration. While such necks were sold as replacements for repair purposes, anyone could buy a new body (copying the Fender body as well) from the same sources and so assemble a do-it-yourself “Fender” guitar—missing

only a Fender label—that had never seen the inside of a Fender factory.¹⁵ One of the authors of this article purchased a “replacement” Fender STRATOCASTER neck in the late 1980s to use in guitar R&D experiments. He cut the headstock off and used the headless neck in a prototype for the BORN TO ROCK guitar.¹⁶

There were no design patents on the patterns of either the Fender or Gibson early 1950s guitars, even though both Fender and Gibson had active patent programs on guitar parts. This suggests that both companies considered their basic designs unpatentable over prior art guitar shapes, or else that the U.S. Patent Office did. Maybe design patent applications were filed and rejected, since at that time abandoned patent applications were never published. Fender did obtain a utility patent (U.S. Patent No. 2,960,900) in 1960 on the functional, form-fitting contours of its STRATOCASTER body, based on an application filed in 1958. The validity of that patent might have been questioned, since the basic STRATOCASTER outline had been first used in 1954.¹⁷ In any event, the patent expired in 1977.

Given that Gibson had stopped making LES PAUL models for a number of years in the 1960s,¹⁸ it is no surprise that third-party LES PAUL copies proliferated. Any source-identifying trade dress rights that could have existed may well have been abandoned by Gibson’s nonuse. Many such copies are still available on the used

15. On the question of replacement parts, see C. E. Miller, *Trademark Owners’ Legal Interests in Rebuilt Musical Instruments*, *Musical Merchandise Review*, August 1996, at 142; C. R. Clark, *Trademark infringement: A no-name instrument by any other brand sounds as sour*, *New England Printer and Publisher*, January 1997, at 46. See also *Nitro Leisure Products LLC v. Acushnet Co.*, 341 F.3d 1356, 67 U.S.P.Q.2d 1814 (Fed. Cir. 2003) (refurbishment of TITLEIST brand golf balls permitted).

16. The Fender headstock itself reportedly is a copy of an earlier Merle Travis design for a Bigsby electric guitar. Tom Wheeler, *American Guitars* 11 (1982). (hereinafter “Wheeler”). The Travis headstock in turn resembled an earlier Stauffer pattern. Wheeler at 250. The bulbous protrusion on this family of headstocks relates back to the side view of a generic violin scroll, illustrated below:



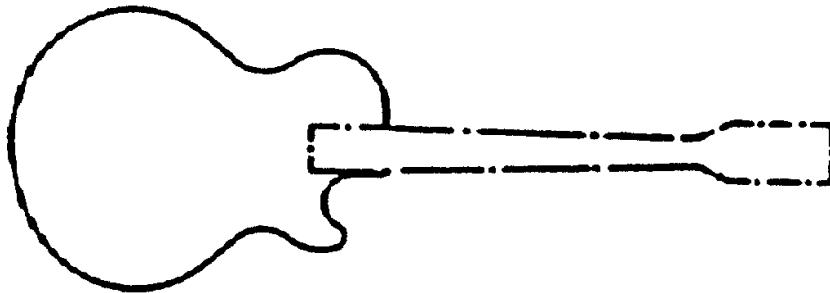
17. Wheeler at 72, 76.

18. *Gibson Guitar Corp. v. Paul Reed Smith Guitars, LP*, 311 F. Supp. 2d 690, 693-94, 70 U.S.P.Q.2d 1911 (M.D. Tenn. 2004) (hereinafter “*Gibson v. PRS*”).

guitar market since, with proper care, the life of a guitar is virtually unlimited.¹⁹

**V. TRADE DRESS IN BODY SHAPE—
*GIBSON v. PRS***

Against this background, the recent decision in *Gibson v. PRS*²⁰ can be seen as a substantial extension of the scope of trade dress protection for musical instruments. The predicate for that case was Gibson's U.S. Trademark Registration No. 1,782,606 obtained in 1993 and the exclusive right to use the mark that had become incontestable prior to commencement of suit. The registered mark is a design mark depicting nothing more than the two-dimensional outline of the LES PAUL body, illustrated below:



An actual LES PAUL body is shown in a photo reproduced in Section IV, above. Since the guitar neck and headstock are shown in dotted lines in the registered mark, they are for spatial reference only and do not form part of the mark. The description of the mark expressly states:

THE MARK CONSISTS OF A UNIQUELY SHAPED CONFIGURATION FOR THE *BODY PORTION* OF THE GUITAR AS ILLUSTRATED IN THE DRAWING BY THE SOLID LINES [emphasis added].

The goods identified in the registration are simply “guitars”—not electric guitars. The Registration issued in 1993, and the exclusive right to use the mark thereof became incontestable upon the filing of a combined Section 8 and 15 declaration in 1999.

The Registration was issued under Section 2(f), which provides in pertinent part:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent

19. One author possessed a Gibson LES PAUL lookalike in the 1980s. It had no brand name at all, though since it was a used guitar, it might have had one that a prior owner removed.

20. 311 F. Supp. 2d 690 (M.D. Tenn. 2004).

the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.²¹

Gibson submitted evidence that its body shape had become distinctive under Section 2(f), in the form of "several declarations and historical materials on the distinctiveness of the Les Paul guitar shape."²²

The court in *Gibson v. PRS* seems to have felt constrained to enforce Gibson's trademark rights according to their terms, given the incontestable status of Gibson's exclusive right to use the mark. The court noted that anyone in the industry could have petitioned to cancel the Registration under Section 14 as having been improvidently granted at any time before the fifth anniversary of the Registration.²³

Since the exclusive right to use the mark was incontestable, the court correctly reasoned that it may only be challenged now on the basis of one of the enumerated defenses in Section 33(b) of the statute, 15 U.S.C. § 1115(b)(1)-(9).²⁴ Specifically, the court explained that "descriptiveness" of the registered design is foreclosed as a defense; only genericness of the design would suffice as a defense.²⁵

It is difficult to comprehend how "merely descriptive" could even be applied to a design mark as distinguished from a word mark. The usual case of descriptiveness is, for example, the word MELLOW as applied to the sound of a guitar. MELLOW GUITARS would function poorly (if at all) as a guitar trademark, since the alleged mark describes the sound of a desirable guitar (except to heavy-metal fans). Hence, the U.S. Trademark Office would properly reject an application to register it as a mark, except perhaps upon a satisfactory showing of secondary meaning.

If a trademark design consisting of a guitar shape is the actual shape of the guitar, then perhaps the drawing could be said to be

21. 15 U.S.C. § 1052(f).

22. *Gibson v. PRS*, 311 F. Supp. 2d at 695, 697-701.

23. *Id.* at 716. Given that many luthiers operate as mom and pop shops, it is not likely that they read the Official Gazette or that they would have had the financial resources to petition to cancel, even if they had read it. PRS—not a mom and pop shop by any means—specifically denied knowing of the registration, although the court did not credit the denial. *Id.* at 724.

24. *Gibson v. PRS*, 311 F. Supp. 2d at 716-17.

25. *Id.* at 718.

“descriptive” of the guitar in the sense that on seeing the drawing, one would immediately know what the guitar looks like. However, this would cut too broadly as a test for descriptiveness of body designs, since it is easy to envision a drawing of a guitar in which, for example, the headstock is carved as a cameo of George Washington.²⁶ A drawing of such a guitar would “describe” the guitar, but it would hardly be viewed as a “descriptive mark,” since George Washington’s profile applied to guitar headstocks is surely arbitrary and indeed inherently distinctive. It might be derogated as “mere ornamentation” if it were applied, for example, as part of a two-dimensional graphic on the guitar body—along with other presidents’ images—on a guitar intended as a presentation piece to guitar-playing 2004 presidential candidate John Kerry.

Hence, trying to shoehorn musical instrument body configurations into the categories “descriptive” and “non-descriptive” applicable to word marks seems largely a fool’s errand. Where the rubber really meets the road would be the test for *functionality* of these configurations. As the court in *Gibson v. PRS* acknowledged, functionality remains a defense even after the exclusive right to use a trademark becomes incontestable.²⁷

Considering the case of the George Washington headstock, the accepted legal test for functionality is not hard to apply. The test has most recently been stated in the Supreme Court decisions in *Wal-Mart v. Samara*²⁸ and *TrafFix v. Marketing Displays*.²⁹ The Supreme Court has stated:

... [a] test for functionality is ‘whether the particular product configuration is a competitive necessity.’

* * *

... a feature is also functional when it is essential to the use or purpose of the device or when it affects the cost or quality of the device.³⁰

Applying that test, a Washington profile cameo is neither essential to the function of an electric guitar, nor is it a feature that substantially affects its cost or quality, or that a luthier must have to compete in the guitar market. Hence, such a headstock profile does not run afoul of the functionality bar to trademark and

26. The example of a George Washington carving originated with the late Prof. Melville B. Nimmer, who used it in his copyright class at UCLA School of Law to illustrate the difference between copyrightable works of applied art and uncopyrightable works of industrial design under 17 U.S.C. § 101. A representational “carving on the back of a chair” is copyrightable. H.R. Rep. No. 94-1476, 94th Congress, 2d Sess., 55 (Sept. 3, 1976).

27. *Gibson v. PRS*, 311 F. Supp. 2d at 717.

28. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000).

29. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001).

30. *Id.* at 32-33 (internal citations omitted).

trade dress protection and it could not be refused registration as a trademark for guitars on that ground.

Similarly, the Prince “Symbol guitar” would be distinctive and not properly categorized as a “descriptive mark.” In *Pickett v. Prince*, Pickett created a guitar in the shape of the unpronounceable symbol adopted by the “artist formerly known as Prince” to replace his name.³¹ The symbol looked like this:



Pickett claimed that he owned a copyright on the guitar as a derivative (albeit unauthorized) work based on Prince’s symbol. He accused the musician of copyright infringement by procuring another guitar also embodying the symbol. The *Pickett* decision did not decide trade dress issues. However, in *dictum*, the court did observe that the symbol in suit (embodied in the guitar shape as well as other objects) is the musician’s trademark.³² Interestingly, the court addressed functionality in the context of musical instruments, reaching much the same conclusion for copyrights as would have been reached *mutatis mutandis* in the case of trade dress configurations:

... the difference in appearance [between plaintiff’s guitar and the accused guitar] may well be due to nothing more than the functional difference between a two-dimensional symbol and a guitar in the shape of the symbol. In that event Prince could not have copyrighted the guitar version of the symbol. *A guitar won’t work without strings, frets, etc. arranged in a pattern dictated by musical considerations, and to the extent that the pattern is what it is because otherwise the guitar won’t sound right, it is not copyrightable as a work of visual art.*³³

Much like the Washington profile cameo, the peculiar symbol embodied in the Prince guitar would not be essential to the function of the guitar, nor is it a feature that affects its cost or quality, or that is necessary to compete in the market. However, to

31. *Pickett v. Prince*, 207 F.3d 402 (7th Cir. 2000).

32. *Id.* at 403.

33. *Id.* at 405 (emphasis added).

the extent that the guitar pattern is dictated by musical considerations and is what it is because otherwise the guitar would not sound right, or will just sound different, that pattern is functional and should be refused registration as a trademark and protection under the Lanham Act as trade dress.

Surprisingly, the court in *Gibson v. PRS* reached the opposite conclusion. The court discounted defendant Paul Smith's testimony (testimony consistent with Judge Posner's observations in *Pickett*):

For an electric guitar, the knobs and switches, in terms of their number and their arrangement on the face of the guitar, are *functional* elements that allow the player to easily modify the volume and tone of the sound created from the vibration of the strings by the guitar's pickups, and select between the bridge and the neck pickups while playing.³⁴

The court considered PRS's functionality defense, but dismissed it on summary judgment. In doing so, the court gave short shrift to the evidence submitted by PRS and the witness' testimony (including that of Gibson's CEO), and indeed may have misunderstood how an electric guitar is used, as will be detailed in the following discussion.

The Gibson LES PAUL registered mark is nothing more than a body outline. The overall outline is essentially the same as that of the traditional Spanish guitar. As discussed above, the features of the narrow upper bouts, wider lower bouts and intermediate C bouts are completely nondistinctive shapes that have been seen even on the violin for hundreds of years. They may properly be considered to be part of the generic string instrument shape that is common to both violins and guitars.³⁵

34. *Gibson v. PRS*, 311 F. Supp. 2d at 702-03 (emphasis added).

35. Many of Gibson's early models were designated "ES," standing for "Electric Spanish," e.g., the ES-175 illustrated below:



S. Cherne, *Blue Book of Guitars* 77 (3d ed. 1996); Wheeler, *supra* note 16, at 131, 335. Note the resemblance in body shape between ES-175 and LES PAUL models. Since the ES-175 was introduced previously in the late 1940s (Wheeler at 134), it is no wonder that the LES PAUL body shape was unpatentable in the 1950s. The U.S. Patent Office would not have considered filling in a hollow guitar body with solid wood to be a patentable ornamental design feature, since the interior of the body is not externally visible. Indeed, a solid body is a functional feature, since it substantially affects the tone, much like knocking on a solid core wood door produces a denser sound than knocking on a hollow core wood door, which makes a resonant echo. It was precisely to meet the need for more sound volume to

Hence, the only part of Gibson's registered trademark that differs substantially from the centuries-old generic string instrument shape is the so-called "horn." As explained in the court's opinion, the horn is formed by cutting away the portion of the upper right bout where it attaches to the neck.³⁶ The result is a "cutaway" guitar style. If only the right bout is cut, it is a single cutaway. If both right and left bouts are cut, it is a double cutaway.

Gibson CEO Henry Juszkiewicz's testimony contained a crucial admission that was not properly evaluated by the court. He testified that a cutaway is functional, since it permits the player to more easily access the upper register of the neck and to play the high notes located there.³⁷

PRS's accused SINGLECUT guitar utilized a single cutaway at its neck-to-body joint, as illustrated below:



PRS's prior line of guitars, in contrast, was characterized by a *double* cutaway design, as illustrated below:³⁸

accompany 20th century jazz and dance bands, that the acoustic Spanish guitar was electrified and its large, hollow resonant body chamber was replaced by a solid wood body. Les Paul himself describes the transition to solid bodies and their functional advantages:

Mary's guitar served as the test model for Gibson. They wanted me to endorse them, and so I told them that they had to match that sound. I wanted a low action, high output, and a lot of treble, and they could only get it with a *complete solid body*.

Wheeler, *supra* note 16, Foreword (emphasis added).

36. *Gibson v. PRS*, 311 F. Supp. 2d at 694-95.

37. *Id.* at 695. Interestingly, the same body outline, including a single cutaway, had been employed by third parties for solid body electric guitars even before its adoption by Gibson in its LES PAUL model. Bigsby made a solid body single cutaway guitar in 1948, and Appleton made the same pattern as early as 1941. Appleton used a stock Gibson neck, while Bigsby used a Travis design headstock (a precursor to Fender, as discussed in note 16, *supra*). Wheeler, *supra* note 16, at 8, 11-12.

38. *Gibson v. PRS*, 311 F. Supp. 2d at 700-01. See also *Gibson v. PRS*, No. 3:00-1079, PRS's Answer and Counterclaim to Gibson's Amended Complaint, filed June 16, 2004 (App. 83-104 to Appellant's Motion for Stay Pending Appeal and An Order Suspending Injunction), at 5, ¶15 (PRS admitting it traditionally made double-cutaway guitars).



Indeed, PRS's prior marketing pitch was that a double cutaway design was superior to a single cutaway design.³⁹ PRS even went so far as to trademark its own double cutaway design (U.S. Reg. No. 1,509,200),⁴⁰ an inconsistent move that PRS may now regret since trademarking its own functional shape contradicted its contention that Gibson's shape should not be registered because it is functional. The *Gibson* court was able to hoist PRS on its own registered-trademark-petard:

Although PRS claims a lack of knowledge of Gibson's trademark registration, *as a sophisticated manufacturer with several trademarks*, with Gibson's Les Paul widespread recognition in the marketplace and given Smith's statement of recognizing Gibson's Les Paul by its shape, the Court concludes that PRS knew that the Les Paul would be subject to trademark protection.⁴¹

It appears that the controversy between Gibson and PRS arose when PRS became influenced by a major guitar retailing chain, Guitar Center, to add an imitation LES PAUL guitar to its line. Apparently Guitar Center and Gibson were having a dispute that led Guitar Center to want to replace Gibson with a competitive brand:

Paul Smith commented that this Singlecut was intended to fill a void in the market created by Gibson's dispute with guitar distributors and retail dealers. *Paul Smith: Guitar Center has requested a single cutaway.*⁴²

PRS's internal meeting notes show that they agonized over fulfilling Guitar Center's request, since to do so would run contrary to their entire prior guitar design philosophy and marketing message of double-cutaway superiority over Gibson. In effect, it could be interpreted as an admission of marketplace defeat by PRS.⁴³

39. *Id.* at 705-07.

40. *Id.* at 703.

41. *Id.* at 724 (emphasis added).

42. *Id.* at 705 (emphasis in original).

43. *Id.* at 706.

The same meeting notes show why the number of cutaways is important in a functional sense. Having only a single cutaway permits a more rigid connection of the neck to the body. Since the neck and body act as a resonant unit, weakening the connection with a second cutaway reduces the punch of the guitar.⁴⁴ The LES PAUL model is well-known for, and desired because of, its ability to punch through the sound of a loud rock band due to its full sound as distinguished from the earpiercing soprano-like timbre of the lighter-weight Fender models, which accomplish the purpose in a different way. For Guitar Center to be able to replace the LES PAUL model in its line with another comparable guitar, it needed to have a single cutaway,⁴⁵ not PRS's prior model double cutaway, which had the sweet, mellow sound effectively popularized by guitarist Carlos Santana, a famous PRS artist-endorser.

Had the court in *Gibson v. PRS* properly evaluated the very evidence recited in its own opinion, it would not have rendered summary judgment against PRS. Given the generic nature of the overall LES PAUL outline, and the admitted functional nature of the single cutaway horn, Gibson's trademark registration is nothing more than a combination of a generic outline with a functional feature. As such it should not be shielded from cancellation.

That would not be the end of the matter, however, for Gibson also relied upon unregistered trademark rights in its overall LES PAUL model configuration above and beyond the minimalist features shown in the registered trademark. The court specifically credited Gibson with trade dress rights in the following features of its LES PAUL model:

- overall outline of the body;
- single-cutaway horn;
- the number of control knobs (4);
- arrangement of the knobs in a diamond pattern;
- a three-position pickup selector switch positioned on the left upper bout; and

44. Resonant frequencies of body, neck and other instrument parts are well-known to affect instrument performance substantially. See, e.g., C. M. Hutchins & D. Voskuil, *Mode Tuning for the Violin Maker*, CAS Journal v.2, n.4 (Series II), Nov. 1993, at 5; see also <http://www.catgutacoustical.org/research/articles/modetune/index.html>. PRS's answer alleged that "the single cutaway design is functional also in that the connection between the neck and the part of the body that is not cut away creates a neck joint providing a tone particular to a single cutaway guitar and not replicable by differently shaped guitars." *Gibson v. PRS*, No. 3:00-1079, PRS's Answer and Counterclaim to Gibson's Amended Complaint, filed June 16, 2004 (App. 83-104 to Appellant's Motion for Stay Pending Appeal and An Order Suspending Injunction), at 10, ¶9; and at 17, ¶27.

45. *Gibson v. PRS*, 311 F. Supp. 2d at 705.

- a large diameter washer on the selector switch.⁴⁶

The court correctly observed that many competitive guitars, including PRS's own prior guitar models, do not possess this precise combination of features. Hence, the court reasoned that these features are not essential to the performance of a guitar, as their combination is arbitrary—not functional—and they were adopted by PRS for the illegitimate purpose of capitalizing unfairly on Gibson's extensive proven goodwill, for competitive benefit at the instigation of Guitar Center.⁴⁷ The court might well have modeled its reasoning in this respect upon the leading trade dress decision *AmBrit v. Kraft*,⁴⁸ which held that Kraft's use of a combination of features to package an ice cream square with a polar bear design in silver and blue foil in an english-muffin tray, was done with bad intent and so infringed AmBrit's trade dress rights regardless of the fact that almost all those features had previously been used by others (including Kraft) in other combinations.⁴⁹

The functionality of the overall outline and the single cutaway has already been discussed. The court similarly failed to appreciate that while the number of knobs on a guitar can vary from model to model, the choice of number and their arrangement is not arbitrary. The court discounted Paul Smith's testimony that:

For an electric guitar, the knobs and switches, in terms of their number and their arrangement on the face of the guitar, are *functional* elements that allow the player to easily modify the volume and tone of the sound created from the vibration of the strings by the guitar's pickups, and select between the bridge and the neck pickups while playing.⁵⁰

In principle, there are two commonly-used arrangements for guitar pickups: three pickups as on the Fender STRATOCASTER model,

46. *Id.* at 720. While the sunburst color scheme (and other colors) of the LES PAUL guitar body is mentioned in the recital of facts (*id.* at 697-98, 722), a sunburst color scheme is an industry-standard decoration used extensively on Fender (see STRATOCASTER photo above) and other brands of guitar. It does not merit serious consideration as a potential trade dress feature. While arbitrary *packaging* color schemes routinely qualify as trade dress, colors of *the product itself* that appeal to the consumer's taste for decoration, routinely fail. See, e.g., *Keystone Camera Prods. Corp. v. Ansco Photo-Optical Products Corp.*, 667 F. Supp. 1221, 1226, 1229, 3 U.S.P.Q.2d 1797 (N.D. Ill. 1987) (attractive colors of plastic camera bodies comprise ornamental decoration, not trade dress).

47. *Id.* at 720, 722, 724.

48. *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1 U.S.P.Q.2d 1161 (11th Cir. 1986), *aff'g* 619 F. Supp. 983, 226 U.S.P.Q. 801 (M.D. Fla. 1985), *cert. denied*, 481 U.S. 1041 (1987), *discussed in* "The 40th Year (The Annual Review)," 77 TMR 574 (1987), *and in* A. L. Fletcher & R. M. Kunstadt, 1988-89 *Trademark Law Handbook, Annual Review of Developments in Trademark Law and Practice* 69 (1989).

49. *Id.* at 1537, 1541, 1 U.S.P.Q.2d at 1166, 1170-71.

50. *Gibson v. PRS*, 311 F. Supp. 2d at 702-03 (emphasis added).

and two pickups as on the Gibson LES PAUL model. On a guitar with three pickups, it is not practical (for space reasons) or economic to provide both a volume and tone control for each pickup: that would require six knobs. Hence, the customary solution is two or three knobs.

On a two-pickup guitar like the LES PAUL model, one could use just two knobs: a volume knob and a tone knob that serve for both pickups the same. However, it is also feasible to provide a dedicated set of knobs for each pickup.⁵¹ Then the knobs can be “set and forgotten” and a toggle switch used to vary between the preset knobs. Players prefer such an arrangement since in the heat of performance it is hard to adjust knobs precisely; one becomes familiar with the knob and switch locations so as to be able to find them even while playing in a dark orchestra pit.⁵² The position of the switch on the upper bout caters to these players, since they do not have to reach down for the switch.⁵³

A large washer made of rubber can better isolate the switch acoustically from the guitar body, so that the click of the switch is not heard by the audience or on recordings. A large washer, even if plastic rather than rubber, also provides space to label the switch positions and protects the finish of the guitar top from being marred by the player’s fingernails when operating the switch hastily; or worse, being cracked or dented by excessive force applied to the switch handle (which projects substantially from the plane of the body surface and so acts like a long lever, tending to crack the guitar top if overstressed).

Putting the four control knobs in a diamond position staggers them and so permits a player to adjust one knob by reaching around it with the right pinky, while the forefinger and thumb hold a guitar pick, without disturbing the other three knobs’ settings.

Hence, had the court properly appreciated how to play a LES PAUL guitar, the court would not have granted summary judgment for Gibson. At a minimum, the functionality of the alleged Gibson trade dress features presents fact issues for trial.

The court placed great emphasis upon the fame of the LES PAUL model, its recognition in the market as a successful and desirable product, and the widespread identification of its shape as such.⁵⁴ However, recognizing a particular guitar as having a LES PAUL pattern is not the same thing as recognizing it as being a guitar that originated with Gibson as the source of origin. To

51. *Id.* at 703.

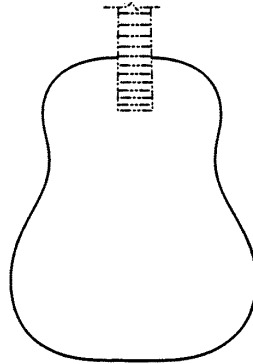
52. *See* Paul Smith’s testimony in *Gibson v. PRS*, *id.*

53. *Id.*

54. *Id.* at 722.

equate the two would be a logical fallacy similar to saying that because a violin has a Stradivarius pattern, it must have been made by Stradivarius. Similarly, and using an analogy from the case law, it would be like saying that because a lamp has a Stiffel shape, it must have been made by Stiffel. Such reasoning leads to the question whether competitors are entitled, for functional or other purposes, to copy a shape originated by another while labeling it with their own word and design trademarks.⁵⁵

The *Gibson* result contrasts sharply with the decision of the TTAB in the *ex parte* case *In re Gibson Guitar Corp.*⁵⁶ In that case, Gibson sought to register the rounded shape of the upper bouts of its jumbo model acoustic guitar as a trademark:



Gibson's application was rejected since promotional literature by Gibson and a competitor showed that the shape of the bouts contributed to a deep, rich bass and sweet, strong treble tone.⁵⁷

It is also interesting to speculate whether Harley-Davidson took the wrong road by attempting to trademark the *sound* of its famous V-twin motorcycles, in addition to their shapes. Harley-Davidson's application to register its characteristic sound caused a notorious uproar, since it was viewed as an attempt to expand unduly the scope of trademark rights.⁵⁸ Harley-Davidson was

55. In the violin-collecting market, such fallacious reasoning would lead to immediate and massive financial losses from mistaking \$99 modern copies for a real \$2,000,000 Stradivari, due to their identical configurations.

56. 61 U.S.P.Q.2d 1948 (T.T.A.B. 2002).

57. *Id.* at 1951. Gibson also asserted acquired distinctiveness, submitting a promotional calendar showing a nude woman from the rear, posing with this guitar. Gibson asserted that the calendar emphasized the rounded shape of the guitar's shoulders by juxtaposition with a curvaceous model. The Board roundly rejected this argument, noting that the nude model's shoulders were not even visible, being covered by her long hair.

58. U.S. Trademark App. Ser. No. 74485223. See J. Diamante & D. Saunders, If Harley-Davidson Has Its Way, The Resounding Roar That Its Motorcycles Make Could Become A Registered, Protected Sound Under The Trademark Act, *National Law Journal*, Nov. 6, 1995, at B5, reprinted in *Pro Sound News*, January 17, 1996, at 1.

opposed by at least nine parties.⁵⁹ Harley-Davidson eventually gave up the fight and abandoned its trademark applications for both the sound and the shape of its motorcycles.⁶⁰ One ground for objection was that the alleged Harley-Davidson trademark sound was inevitably produced by an engine having a V-twin cylinder configuration (as distinguished from side-by-side, opposed or inline cylinders). Hence, giving Harley-Davidson a monopoly in that sound would have prevented competitors from using the technology of the V-twin power plant.

Had Gibson attempted to register the *sound* of the LES PAUL model as a trademark for guitars, one would have expected the same uproar: the application would have been rejected since Gibson has no right permanently to monopolize—through trademark law—a particular guitar timbre that is musically desirable. Indeed, the case against registering a guitar sound as a trademark is even stronger than a motorcycle sound, since the sound of a motorcycle contributes to its sizzle but the sound of a guitar is the steak itself. Instead of raising an uproar as Harley-Davidson did by trying to register as a trademark a product's *sound*, Gibson was able to accomplish essentially the same result—*sub silentio*—by registering as a trademark the guitar body shape that contributes to the guitar's sound.

VI. SUGGESTED GUIDELINES TO EVALUATE MUSICAL INSTRUMENT CONFIGURATIONS AS PROTECTABLE TRADE DRESS

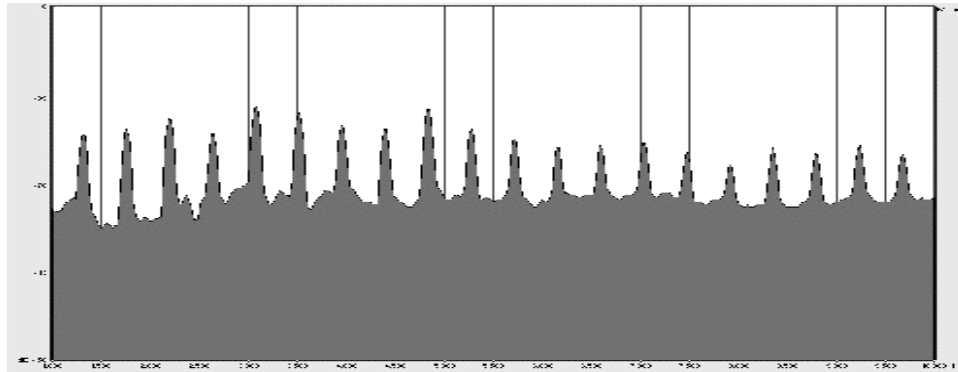
Several factors need to be evaluated by a trademark examiner or a court faced with deciding whether a musical instrument configuration is protectable trade dress, or unprotectably functional.

A musical instrument can be judged by (1) its sound and (2) its playability. Sound is defined by timbre (tone), pitch and loudness.⁶¹ Hence, factors of a configuration that affect timbre, pitch or loudness of the instrument should be considered unprotectably functional. To a large extent, these criteria are objectively and scientifically measurable. For example, a bowed A note on a violin can be recorded, and its frequency spectrum analyzed, to study the timbre, as illustrated below:

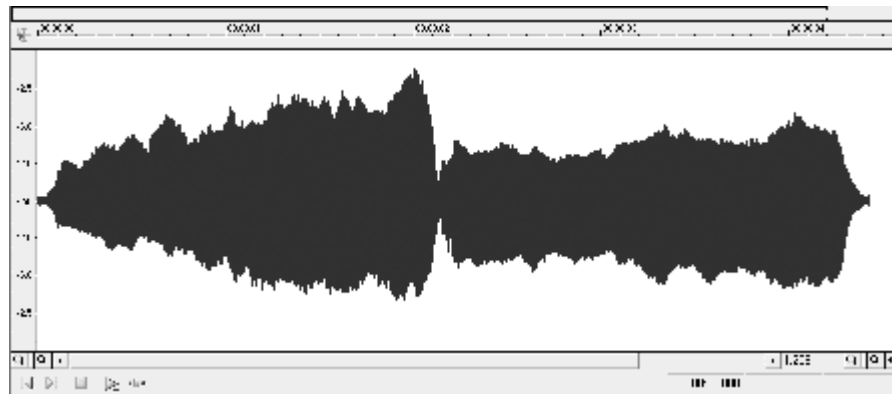
59. Opposition Nos. 91097519, 91097520, 91097891, 91097929, 91098152, 91098153, 91098827, 91098828 and 91098829.

60. INTA Bulletin, July 15, 2000, Vol. 55, No. 13 (abandonment by Harley-Davidson reported).

61. Department of Physics and Astronomy, Georgia State University, <http://hyperphysics.phy-astr.gsu.edu/hbase/sound/timbre.html>.



Similarly, loudness can be recorded, measured and graphed in the form of an attack curve. In the bowed violin, for example, the sound volume builds slowly and is relatively smooth through the downbow; then the bow change creates a brief pause and another attack is followed by a smooth upbow, as illustrated below:



Given the ready availability of such scientific measures, trademark applicants could demonstrate that the musical instrument configurations they desire to register as trademarks do not, in fact, affect the acoustic function of the instrument. Indeed, it would make sense for the U.S. Trademark Office to compel them to do so.

Playability of an instrument is a more subjective matter. A guitar that one player finds intolerably heavy (a LES PAUL model, perhaps) will readily be employed by another musician more interested in punchy tone at any cost (even at the risk of shoulder pain). A musical instrument's size, shape, weight and positioning of parts might presumptively be considered to affect its playability, subject to a factual showing that they have no effect in a particular

case (such as the Washington cameo headstock) and so could qualify as protectable trade dress features.

Trademark examining authorities in the United States and elsewhere might act to protect the public and the music trade by demanding rigorous proof from trademark applicants seeking to register instrument shapes. To demand factual information from applicants is within the current power of examiners. For example, they routinely request to see samples of the applicant's promotional brochures in order to learn about the goods and to see whether the applicant claims functional advantages.⁶² Demanding scientific proof of applicant's claim of non-functionality would be an additional step in this direction.

Heightened attention to the sound and playability functional analysis suggested here will help guard against erosion of the functionality bar to trademark registration in the case of musical instruments, preserve for the public domain free use of unpatented functional designs, and facilitate discernment of the protectable features of an instrument's design that might properly work to signify its maker as the genuine source without impeding competition.

62. See TMEP § 1202.02(a)(v)(A):

The applicant's own advertising touting the utilitarian aspects of its design is often strong evidence supporting a functionality refusal. *See, e.g., In re Gibson Guitar Corp.*, 61 U.S.P.Q.2d 1948 (T.T.A.B. 2001). . . .

[T]he Board found the design of a guitar body to be functional, noting that applicant's literature clearly indicated that the shape of applicant's guitar produced a better musical sound. Applicant's advertisements stated that "This unique body shape creates a sound which is much more balanced and less 'muddy' than other ordinary dreadnought acoustics." 61 U.S.P.Q.2d at 1951.

[T]he record included an advertisement obtained from the website of a competitor whose guitar appeared to be identical in shape to applicant's configuration, touting the acoustical advantages of the shape of the guitar.