

12-16-2002

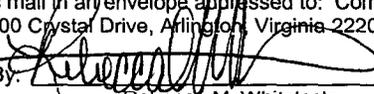
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #11

TTAB

Attorney Docket: 08984-0164

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Trademarks, **BOX TTAB FEE**, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on this day December 12, 2002.

By: 
Rebecca M. Whitelock

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

STARBUCKS U.S. BRANDS CORPORATION)
and STARBUCKS CORPORATION DBA)
STARBUCKS COFFEE COMPANY)

Opposers,)

v.)

CAPPUCCINO AMERICANA CORPORATION)

Applicant.)

Opposition No. 08984-0164

NOTICE OF OPPOSITION

Applicant Serial No.: 78/105,136
Filed: January 28, 2002
Published for Opposition: September 17, 2002
Mark: BARISTA PERSONALE

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

12/26/2002 MPETTY 00000034 060916 78105136
01 FC:6402 300.00 CH

Dear Sir:

Starbucks U.S. Brands Corporation, a corporation of the State of California,
having a principal place of business at 533 Airport Boulevard, Suite 400, Burlingame,
California 94010, and Starbucks Corporation dba Starbucks Coffee Company, a

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
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www.finnegan.com

corporation of the State of Washington, having a principal place of business at 2401 Utah Avenue South, Seattle, Washington 98134 (collectively referred to as "Opposers"), believe that they are being, and will be damaged by the registration of the mark BARISTA PERSONALE shown in Application Serial No. 78/105,136, and hereby oppose the same.

As grounds for opposition, Opposers allege that:

1. Opposers are informed and believe that Applicant Cappuccino Americana Corporation, a corporation of Delaware with an address of 765 Route 83, Suite 119, Bensenville, Illinois 60106, is the current owner of intent-to-use Application Serial No. 78/105,136. That application was filed on January 28, 2002, for the mark BARISTA PERSONALE for hot beverage maker/hot beverage dispensing unit for commercial use in the food service industry.

2. Opposers are now and have been for many years in the business of producing, marketing, and selling, among other things, a wide variety of coffee makers, espresso makers, and coffee grinders for both domestic and/or commercial use.

3. Since at least as early as May 15, 1996, Opposers have continuously used the BARISTA marks in commerce in connection with a wide variety of coffee makers, espresso makers, and coffee grinders for both domestic and/or commercial use.

4. Opposer Starbucks U.S. Brands Corporation owns U.S. Registration No. 2,027,870, issued December 31, 1996, for the mark PROTÈO BARISTA covering electrical appliances, namely, espresso makers and coffee markers for domestic and/or

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commercial use in International Class 11. The registration is valid and subsisting. A copy of the registration details from the PTO website is attached as Exhibit A.

5. Opposer Starbucks U.S. Brands Corporation owns U.S. Registration No. 2,177,000, issued July 28, 1998, for the mark STARBUCKS BARISTA covering electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use in International Class 11. The registration is valid and subsisting. A copy of the registration details from the PTO website is attached as Exhibit B.

6. Opposer Starbucks U.S. Brands Corporation owns U.S. Registration No. 2,282,913, issued October 5, 1999, for the mark STARBUCKS BARISTA ZIA covering electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use in International Class 11. The registration is valid and subsisting. A copy of the registration details from the PTO website is attached as Exhibit C.

7. Opposer Starbucks U.S. Brands Corporation owns U.S. Registration No. 2,475,540, issued August 7, 2001, for the mark STARBUCKS BARISTA covering electric coffee grinders for domestic or commercial use in International Class 7. The registration is valid and subsisting. A copy of the registration details from the PTO website is attached as Exhibit D.

8. Opposers have continuously used the foregoing STARBUCKS BARISTA, STARBUCKS BARISTA ZIA, and PROTÈO BARISTA marks in commerce for a wide variety of coffee makers, espresso makers, and coffee grinders for both domestic and/or commercial use since long prior to the filing date of the opposed application. Opposer's pleaded Registrations were also filed and issued well prior to the filing date of the opposed application.

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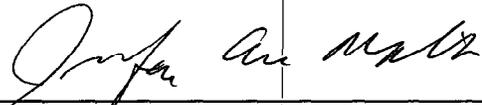
9. Applicant seeks to register the mark BARISTA PERSONALE in connection with goods that are identical to or closely related to the goods of Opposers.

10. Applicant's BARISTA PERSONALE mark so resembles Opposers' marks as to be likely, when applied to the goods, to cause confusion, or to cause mistake, or to deceive.

WHEREFORE, Opposers believe that they are being, and will be damaged by the registration of the mark shown in Application Serial No. 78/105,136, and request that the opposition be sustained, and that registration to Applicant be refused.

Respectfully Submitted,

Dated: December 12, 2002

By: 

Julia Anne Matheson
Linda K. McLeod
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
700 Hansen Way
Palo Alto, California 94304
Telephone: (650) 849-6600
Facsimile: (650) 849-6666

Attorneys for Opposers
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CORPORATION and STARBUCKS
CORPORATION DBA STARBUCKS
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trade Mark Electronic Search System (TESS)

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Start List At: OR **Jump** to record: **Record 4 out of 4**

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

PROTEO BARISTA

Word Mark PROTEO BARISTA

Translations The English translation of the word "BARISTA" in the mark is "barman" or "barmaid".

Goods and Services IC 011, US 013 021 023 031 034. G & S: electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use. FIRST USE: 19960515. FIRST USE IN COMMERCE: 19960515

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 74681663

Filing Date May 30, 1995

Filed ITU FILED AS ITU

Published for Opposition February 6, 1996

Registration Number 2027870

Registration Date December 31, 1996

Owner (REGISTRANT) Starbucks Corporation DBA Starbucks Coffee Company CORPORATION
WASHINGTON P.O. Box 34067 2401 Utah Avenue South Seattle WASHINGTON 981241067

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record David M. Landau

Type of Mark TRADEMARK

Register PRINCIPAL

**Live/Dead
Indicator** **LIVE**

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Serial Number: 74681663

Registration Number: 2027870

Mark

PROTEO BARISTA

(words only): PROTEO BARISTA

Current Status: Registered.

Date of Status: 1996-12-31

Filing Date: 1995-05-30

Registration Date: 1996-12-31

Law Office Assigned: TMEG Law Office 104

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1997-01-07

CURRENT APPLICANT(S)/OWNER(S)

1. Starbucks Corporation

Address:

Starbucks Corporation
P.O. Box 34067 2401 Utah Avenue South
Seattle, WA 981241067
United States

State or Country of Incorporation: Washington

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use

International Class: 011

First Use Date: 19960515

First Use in Commerce Date: 19960515

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The English translation of the word "BARISTA" in the mark is "barman" or "barmaid".

PROSECUTION HISTORY

1996-12-31 - Registered - Principal Register
1996-10-10 - Allowed for Registration - Principal Register (SOU accepted)
1996-10-10 - Case file assigned to examining attorney
1996-10-07 - Statement of use processing complete
1996-07-17 - Amendment to Use filed
1996-04-30 - Notice of allowance - mailed
1996-02-06 - Published for opposition
1996-01-05 - Notice of publication
1995-11-28 - Approved for Pub - Principal Register (Initial exam)
1995-11-16 - Examiner's amendment mailed
1995-11-14 - Case file assigned to examining attorney
1995-11-13 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
David M. Landau (Attorney of record)

DAVID M. LANDAU
STARBUCKS CORPORATION
P.O. BOX 34067
SEATTLE, WA 98124
United States



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Typed Drawing

Word Mark STARBUCKS BARISTA

Translations The English translation of the word "BARISTA" in the mark is "barman" or "barmaid".

Goods and Services IC 011. US 013 021 023 031 034. G & S: electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use. FIRST USE: 19971029. FIRST USE IN COMMERCE: 19971029

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75372701

Filing Date October 14, 1997

Filed ITU FILED AS ITU

Published for Opposition May 5, 1998

Registration Number 2177000

Registration Date July 28, 1998

Owner (REGISTRANT) Starbucks U.S. Brands Corporation, CORPORATION CALIFORNIA 533 Airport Boulevard, Suite 400 Burlingame CALIFORNIA 94010

Attorney of Record SHIRLEY J SU

Prior Registrations 1098925;1372630;1417602;1444549;1452359;1542775;1758589;1793782;1815937;1815938;1821547;1891561;1893602;1943361;2024105;2027870;2028943;2030878;2035005;2039849;2047491;2073104;2086615;2091940;2091941;AND OTHERS

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Serial Number: 75372701

Registration Number: 2177000

Mark (words only): STARBUCKS BARISTA

Current Status: Registered.

Date of Status: 1998-07-28

Filing Date: 1997-10-14

Registration Date: 1998-07-28

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1998-07-31

CURRENT APPLICANT(S)/OWNER(S)

1. Starbucks U.S. Brands Corporation,

Address:

Starbucks U.S. Brands Corporation,
533 Airport Boulevard, Suite 400
Burlingame, CA 94010
United States
State or Country of Incorporation: California
Legal Entity Type: Corporation

GOODS AND/OR SERVICES

electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use

International Class: 011

First Use Date: 19971029

First Use in Commerce Date: 19971029

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The English translation of the word "BARISTA" in the mark is "barman" or "barmaid".

Prior Registration Number(s):

1098925

1372630

1417602

1444549

1452359
 1542775
 1758589
 1793782
 1815937
 1815938
 1821547
 1891561
 1893602
 1943361
 2024105
 2027870
 2028943
 2030878
 2035005
 2039849
 2047491
 2073104
 2086615
 2091940
 2091941

PROSECUTION HISTORY

1998-07-28 - Registered - Principal Register
 1998-05-05 - Published for opposition
 1998-04-03 - Notice of publication
 1998-03-04 - Approved for Pub - Principal Register (Initial exam)
 1998-03-04 - Amendment to Use approved
 1998-03-04 - Case file assigned to examining attorney
 1998-01-05 - Communication received from applicant
 1998-01-25 - Amendment to use processing complete
 1998-01-05 - Amendment to Use filed

CONTACT INFORMATION

Correspondent (Owner)
 SHIRLEY J SU (Attorney of record)

 SHIRLEY J SU
 HOWARD RICE NEMEROVSKI CANADY ET AL
 3 EMBARCADERO CTR 7TH FL
 SAN FRANCISCO CA 94111
 United States



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Typed Drawing

Word Mark STARBUCKS BARISTA ZIA

Translations The English translation of "BARISTA" in the mark is "barran" or "barmaid". The word "ZIA" is a coined word.

Goods and Services IC 011. US 013 021 023 031 034. G & S: electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use. FIRST USE: 19980210. FIRST USE IN COMMERCE: 19980210

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75469366

Filing Date April 17, 1998

Published for Opposition July 13, 1999

Registration Number 2282913

Registration Date October 5, 1999

Owner (REGISTRANT) Starbucks U.S. Brands Corporation CORPORATION CALIFORNIA 533 Airport Boulevard, Suite 400 Burlingame CALIFORNIA 94010

Attorney of Record SHIRLEY J SU

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Serial Number: 75469366

Registration Number: 2282913

Mark (words only): STARBUCKS BARISTA ZIA

Current Status: Registered.

Date of Status: 1999-10-05

Filing Date: 1998-04-17

Registration Date: 1999-10-05

Law Office Assigned: TMEG Law Office 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 1999-10-08

CURRENT APPLICANT(S)/OWNER(S)

1. Starbucks U.S. Brands Corporation

Address:

Starbucks U.S. Brands Corporation
533 Airport Boulevard, Suite 400
Burlingame, CA 94010
United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

electrical appliances, namely, espresso makers and coffee makers for domestic and/or commercial use

International Class: 011

First Use Date: 19980210

First Use in Commerce Date: 19980210

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The English translation of "BARISTA" in the mark is "barran" or "barmaid". The word "ZIA" is a coined word.

PROSECUTION HISTORY

1999-10-05 - Registered - Principal Register

- 1999-07-13 - Published for opposition
- 1999-06-11 - Notice of publication
- 1999-03-29 - Approved for Pub - Principal Register (Initial exam)
- 1999-03-24 - Examiner's amendment mailed
- 1999-02-03 - Non-final action mailed
- 1999-01-28 - Case file assigned to examining attorney
- 1999-01-11 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

SHIRLEY J SU (Attorney of record)

SHIRLEY J SU
HOWARD RICE NEMEROVSKI CANADY
FALK & RABKIN PC
3 EMBARCADERO CTR 7TH FL
SAN FRANCISCO CA 94111
United States



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Typed Drawing

Word Mark STARBUCKS BARISTA

Translations The English translation of the word "BARISTA" in the mark is "BARMAN" or "BARMAID".

Goods and Services IC 007. US 013 019 021 023 031 034 035. G & S: electric coffee grinders for domestic or commercial. FIRST USE: 19981031. FIRST USE IN COMMERCE: 19981031

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76036089

Filing Date April 27, 2000

Published for Opposition May 15, 2001

Registration Number 2475540

Registration Date August 7, 2001

Owner (REGISTRANT) Starbucks U.S. Brands Corporation CORPORATION CALIFORNIA 533 Airport Boulevard, Suite 400 Burlingame CALIFORNIA 94010

Attorney of Record Susan L. Heller

Prior Registrations 2177000;2282913

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Serial Number: 76036089

Registration Number: 2475540

Mark (words only): STARBUCKS BARISTA

Current Status: Registered.

Date of Status: 2001-08-07

Filing Date: 2000-04-27

Registration Date: 2001-08-07

Law Office Assigned: TMO Law Office 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2001-08-27

CURRENT APPLICANT(S)/OWNER(S)

1. Starbucks U.S. Brands Corporation

Address:

Starbucks U.S. Brands Corporation
533 Airport Boulevard, Suite 400
Burlingame, CA 94010
United States

State or Country of Incorporation: California

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

electric coffee grinders for domestic or commercial

International Class: 007

First Use Date: 19981031

First Use in Commerce Date: 19981031

Basis: 1(a)

ADDITIONAL INFORMATION

Translation: The English translation of the word "BARISTA" in the mark is "BARMAN" or "BARMAID".

Prior Registration Number(s):

2177000

2282913

PROSECUTION HISTORY

2001-08-07 - Registered - Principal Register
2001-05-15 - Published for opposition
2001-05-02 - Notice of publication
2001-01-23 - Published for opposition
2000-12-22 - Notice of publication
2000-11-03 - Approved for Pub - Principal Register (Initial exam)
2000-10-31 - Examiner's amendment mailed
2000-10-26 - Case file assigned to examining attorney

CONTACT INFORMATION**Correspondent (Owner)**

Susan L. Heller (Attorney of record)

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FALK & RABKIN
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United States