

ESTTA Tracking number: **ESTTA277914**

Filing date: **04/14/2009**

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

Proceeding	91161954
Party	Plaintiff Pabst Brewing Company
Correspondence Address	WILLIAM B. NASH JACKSON WALKER L.L.P. 112 E. PECAN STREET, SUITE 2100 SAN ANTONIO, TX 78205 UNITED STATES bnash@jw.com
Submission	Plaintiff's Notice of Reliance
Filer's Name	William B. Nash
Filer's e-mail	bnash@jw.com, mfassold@jw.com, llapidario@jw.com, lstuder@jw.com
Signature	/s/ William B. Nash
Date	04/14/2009
Attachments	2009-04-14 Opposers Tenth Notice of Reliance.pdf ( 21 pages )(611188 bytes )

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

_____	X	
	)	
<b>Pabst Brewing Company</b>	)	<b>Opposition No. 91161954</b>
<b>Opposer,</b>	)	<b>Opposition No. 91161955</b>
	)	
<b>v.</b>	)	
	)	<b>Serial Nos.: 75/883,254 and 75/883,253</b>
<b>Lone Star Steakhouse &amp; Saloon</b>	)	<b>Mark: LONE STAR (and Design)</b>
<b>Applicant.</b>	)	
_____	X	

**OPPOSER'S TENTH NOTICE OF RELIANCE**

Opposer, Pabst Brewing Company ("Pabst"), by and through its attorney of record, submits this Tenth Notice of Reliance pursuant to 37 CFR § 2.122. Specifically, Opposer relies on the Declaration of William B. Nash, attached hereto as Exhibit A, and the attachments thereto, as proof of the use of the LONE STAR mark on clothing items, including licensing of the LONE STAR mark for use on clothing items.

Exhibit A: Declaration of William B. Nash.

Dated: April 14, 2009

Respectfully submitted,

/s/ William B. Nash  
William B. Nash, Reg. No. 33,743  
Jackson Walker, L.L.P.  
112 East Pecan St., Suite 2100  
San Antonio, Texas 78205  
(210) 978-7700  
(210) 978-7790 (Fax)

Attorneys For Opposer, Pabst Brewing  
Company



# Exhibit

A

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

_____	X	
	)	
<b>Pabst Brewing Company</b>	)	<b>Opposition No. 91161954</b>
<b>Opposer,</b>	)	<b>Opposition No. 91161955</b>
	)	
<b>v.</b>	)	
	)	
<b>Lone Star Steakhouse &amp; Saloon</b>	)	<b>Serial Nos.: 75/883,254 and 75/883,253</b>
<b>Applicant.</b>	)	<b>Mark: LONE STAR (and Design)</b>
_____	X	

**DECLARATION WILLIAM B. NASH**

1. My name is William B. Nash. I am competent to make this declaration. The facts stated in this declaration are within my personal knowledge.
2. I am the attorney of record representing Pabst Brewing Company in this Opposition. I am responsible for maintaining accurate and complete records of certain regularly conducted activities of Pabst Brewing Company.
3. Attached to this Declaration are fifteen (15) pages of records from Pabst Brewing Company.
4. These fifteen (15) pages are records of acts, events, conditions, or opinions made at or near the time by or from information transmitted by, a person with knowledge. The fifteen (15) pages were kept in the course of a regularly conducted business activity. It was the regular practice of that business activity to make the records represented by the fifteen (15) pages.
5. I declare under penalty of perjury that the foregoing statements are true and correct.

EXECUTED on April 14, 2009.

WILLIAM B. NASH  
JACKSON WALKER, L.L.P..

By:           /s/ William B. Nash            
William B. Nash  
Attorney for Pabst Brewing Company

# Exhibit

# 1



(1) Opposer is the owner of the trademark "LONE STAR" for use on beer and is the owner of the marks shown in the following U.S. Registrations appended hereto as correspondingly identified exhibits:

Ex. 1.	674,291	"LONE STAR" - Beer
Ex. 2.	676,429	"LONE STAR BEER AND DESIGN - Beer
Ex. 3.	715,533	"Certified Quality Lone Star Beer
	(Expired)	and Design" - Beer
Ex. 4.	715,534	Certified Quality Lone Star Beer and
	(Expired)	Design" - Beer

(2) As is shown in those registrations, the opposer, since prior to the date alleged by the applicant as the date of adoption of the trademark used by it, has adopted and used the trademark "LONE STAR" and has engaged in the sale and distribution of beverages in interstate commerce under such trademark "LONE STAR".

(3) The trademark "LONE STAR" was adopted by the predecessor of opposer, as a trademark for its beverage products in U.S. Class 48 (International Class 32) on or about February 1, 1940 and said trademark has been used on said products continuously ever since that time by being written or printed upon labels and/or on containers for the goods, and in other manners customary to the trade.

(4) On February 17, 1959, the trademark "LONE STAR" was registered in the United States Patent and Trademark Office under Registration No. 674,291 by opposer's predecessor for "beer" in Class 48. Such registration is owned by opposer and is in good standing in the U.S. Patent and Trademark Office and is entitled to the statutory incontestibility provision of Section 33 (B) 15 U.S.C. 1115(C). A copy of such registration is attached hereto and is identified as Exhibit 1.

(5) On March 31, 1959, the trademark "LONE STAR BEER AND DESIGN" was registered in the U.S. Patent and Trademark Office under Registration No. 676,42<sup>o</sup> by opposer's predecessor for beer in Class 48. Such registration is owned by opposer and is in good standing in the U.S. Patent and Trademark Office and is entitled to the statutory incontestibility provision of Section 33(B) 15 U.S.C. 1115(C). A copy of such registration is attached hereto and is identified as Exhibit 2.

(6) On May 16, 1961, the trademark "CERTIFIED QUALITY LONE STAR BEER AND DESIGN" was registered in the U.S. Patent and Trademark Office under Registration No. 715,533 by opposer's predecessor for beer in Class 48. Such registration was owned by opposer's predecessor and such registration expired on May 16, 1981. A copy of such registration is attached hereto and is identified as Exhibit 3.

(7) On May 16, 1961, the trademark "CERTIFIED QUALITY LONE STAR BEER AND DESIGN" was registered in the U.S. Patent and Trademark Office under Registration No. 715,534 by opposer's predecessor for beer in Class 48. Such registration was owned by opposer's predecessor and such registration expired on May 16, 1981. A copy of such registration is attached hereto and is

identified as Exhibit 4.

(8) Opposer's predecessor was Lone Star Brewing Co., Inc. and opposer continues to use the tradename "LONE STAR BREWING CO." in which the word feature "LONE STAR" is prominently featured and which tradename designation is owned and used by opposer in connection with the sale and distribution of its products.

(9a) By and through related companies, the opposer uses its registered trademarks including the mark "LONE STAR" on articles of clothing such as T-shirts and other related articles and products and such usage inures to the benefit of its opposer.

(9b) Opposer and its predecessor have licensed such the trademark "LONE STAR" on collateral products for example on clothing items such as T-shirts as well as other diverse products subject to control of the opposer as to the nature and quality of the goods bearing the marks and designations.

(9c) Opposer sells and distributes articles of clothing including T-shirts and the like as promotional merchandise for its other products and such articles of clothing prominently feature the marks and designations of the opposer.

(10a). The words "LONE STAR CAFE" and a design including a star constitute the trademark sought to be registered by the applicant.

(10b) The mark of the applicant uses the whole of the opposer's mark "LONE STAR".

(10c) Opposer's mark is "LONE STAR" and Reg. No. 676,429 also includes a star design. The respective marks are substantially identical and confusingly similar.

(11) The two marks "LONE STAR CAFE" of the applicant and "LONE STAR" of the opposer both look alike.

(12). The two marks "LONE STAR CAFE" of the applicant and "LONE STAR" of the opposer are phonetically similar.

(13) The two marks "LONE STAR CAFE" of the applicant and "LONE STAR" of the opposer have the same connotative significance.

(14) The two marks "LONE STAR CAFE" of the applicant and "LONE STAR" of the opposer are so similar in appearance that when each said trademark is applied to the respective goods of the opposer and the applicant, a likelihood of confusion is likely to arise in the minds of customers and potential customers in the relevant market.

(15) The goods of the applicant constitute clothing items which are sold and distributed in retail outlets in which the products of the opposer are sold.

(16) The products of the opposer constitute beverages as well as clothing and other sundry items distributed in retail outlets in which the products of the applicant are sold.

(17) The products of the applicant and the products of the opposer are such that use of such closely similar trademarks is apt to present a likelihood of confusion.

(18) Opposer, during the continuous use by it and its predecessor of its marks and designations including the trademark "LONE STAR" for over 44 years as a trademark and as applied to its products, has built up a very valuable good will in such marks and designations including the trademark "LONE STAR" and has spent considerable amounts of money and advertising popularizing its products under its said marks, designations and trademarks.

(19) As a consequence of such widespread usage and advertising and promotion, opposer's marks using or featuring "LONE STAR" have become celebrated trademarks and source indicators and which are widely recognized and perceived by the public as identifying products and wares originating with the opposer.

(20) On information and belief, it is alleged that the goods of the opposer and of the applicant move in the same channels of trade to the same class of purchasers who have come to recognize the products bearing the opposer's marks including the trademark and tradename "LONE STAR" as originating with this opposer and to employ said identifying trademark in referring to products originating with the opposer or those in privity with the opposer.

(21) If applicant were permitted to use and register its alleged trademark "LONE STAR CAFE" for its clothing products in International Classes 24 and 25, confusion in trade would result by reason of the similarity between said mark and the marks and designations including the trademark "LONE STAR" of this opposer. Any fault or defect found in applicant's "LONE STAR CAFE" brand products would reflect upon and seriously injure the reputation which opposer has established for its products sold under its marks and designations including the trademark, "LONE STAR", as in many instances, purchasers would buy or use applicant's products in the belief that they were purchasing or using opposer's products or products approved by or sponsored by opposer. This confusion would result in damage to opposer and would cause damage to its reputation.

(22) Upon information and belief, opposer alleges that the applicant has made no use of the trademark here sought to be registered "LONE STAR CAFE" on the goods of the herein opposed application prior to February, 1977, the date of first use sworn to in the application herein opposed.

(23) Upon information and belief, opposer alleges that the applicant had no application for registration on clothing items of any kind on file prior to June 12, 1981, the date of the application herein opposed.

(24) Upon information and belief, opposer alleges that at the time the applicant first adopted and used the trademark here sought to be registered and filed its application for registration, applicant either had full knowledge, or should have had full knowledge of the prior adoption, usage and registration of the trademark "LONE STAR" of this opposer, as applied to its products and as evidenced by Registration Nos. 674,291 and 676,429 which had already registered and issued as of February 17, 1959 and March 31, 1959 respectively, long prior to such date of first use and long prior to such date of filing of such application.

(25) If applicant were granted the registration herein opposed, it would be placed in a position to harass and cause annoyance to the opposer and to its customers.

WHEREFORE this opposer, G. Heileman Brewing Company, Inc. d/b/a Lone Star Brewing Co., prays that application Serial No. 314,529 be rejected and that the registration of the mark therein shown for the goods therein specified be refused and denied.

The opposer hereby appoints the firm of Hill, Van Santen, Steadman & Simpson, A Professional Corporation, 70th Floor Sears Tower, Chicago, Illinois 60606 consisting of Messrs. James Van Santen, Lewis T. Steadman, John D. Simpson, William C. Stueber, P. Phillips Connor, John F. Atkinson, Dennis A. Gross, James A. Moehling, Marvin Moody, Brett A. Valiquet, Steven H. Noll, Gerald Geren, Edward Lehman, James D. Hobart, Kevin W. Gynn, Thomas I. Ross, John H. Sherman, John W. Klooster, Cary J. Collins, Otto R. Krause, R. Dennis Claessens, James L. Siekmann,

John R. Nyweide, Marvin A. Henrickson, Anthony R. Chiara, J. Arthur Gross, Richard J. Schwarz, and Charles M. Lindrooth, to act as its attorneys in the matter of the above-identified opposition with full power of substitution and revocation to prosecute this opposition and to transact all business in the U.S. Patent and Trademark Office and in the U.S. Courts in connection with this opposition, to sign its name to all papers which may hereafter be filed in connection with said opposition, to receive all official communications related to same and further directs that all communications be forwarded to:

Hill, Van Santen, Steadman & Simpson  
A Professional Corporation  
70th Floor - Sears Tower  
Chicago, Illinois 60606

G. HEILEMAN BREWING COMPANY, INC.

By \_\_\_\_\_

*Darcy Hill*

STATE OF WISCONSIN )

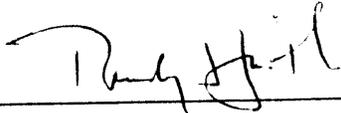
:SS

COUNTY OF LA CROSSE)

I, Randy J. Smith being duly sworn, depose and say:

That I am Assistant Secretary of G. Heileman Brewing Company, Inc., a corporation of Wisconsin, the aforementioned opposer;

That I have read the foregoing Notice of Opposition and signed the same and know the contents thereof to be true of my own knowledge, except as to matters stated therein to be alleged on information and belief and as to those matters I believe them to be true.

  
\_\_\_\_\_

SUBSCRIBED AND SWORN TO before me, a Notary Public this  
2nd day of November, 1984

  
\_\_\_\_\_  
NOTARY PUBLIC  
My Commission expires 11/23/86.

S E A L

G. HEILEMAN BREWING COMPANY, INC.

LONE STAR BRAND

LICENSE AGREEMENTS

CLOTHING AND APPRAEL

<u>Previous Licensees</u>	<u>Item(s)</u>
For Your Eyes Only P.O. Box 5005 Kingwood TX 77339	Sunglasses
Flash Graphic 3123 Oakcliff Ind. St. Atlanta GA 30340	T-shirt, jerseys
Fad Times 1025 South Hill Street Oceanside CA 92054	Jackets
Dallas Cap & Emblem Mfg. Co. 2924 Main Street Dallas TX 75226	Clothing emblems
DJS Promotions, Inc. Sixty Gramercy Park New York NY 10010	Lapel pins
Bergamot Brass Works P.O. Box 67 Darlen WI 53114	Belt buckles
James Avery Craftsman, Inc. P.O. Box 1367 Kerrville TX 78028	Jewelry
Texas Letters & Transfers 8950 Westpark #306 Houston TX 77063	Shirt transfers
Ace Screenprinting 1201 Upland Road Houston TX 77043	Clothing
Alamo Hat Company 1907 St. Marys San Antonio TX 78210	Caps
Shoreline Sportswear, Inc. P.O. Box 2548 Santa Barbara CA 93120	Clothing
Saddlemans, Inc. 606 Mills El Paso TX 79942	Shirts
Pangea P.O. Box 160 Penngrove CA 94951	Shirts
K Products, Inc. Industrial Air Park Orange City IA 51041	Hats

<u>Previous Licensees</u>	<u>Item(s)</u>
Logo 7, Inc. 3229 North Shadeland Avenue Indianapolis IN 46226	Clothing
Washington Mfg. 218-28 2nd Avenue North Nashville TX 37202	Shirts
Mallory Western & Leather Supply 4232 Wichita Street Fort Worth TX 76119	Belt buckles
Mexican American Hat Co. 710 North Tucker Blvd. St. Louis MO 63101	Hats
McDowell Enterprises Inc. 2709 Cherry Kansas City MO 64108	Sunglasses
National Embroidered Emblem, Inc. 1176 Sandhill Avenue Carson CA 90745	Clothing emblems
Rick's Industries P.O. Box 520646 Miami FL 33152	Shirts
Robertson Imports 1008 Holik College Station TX 77840	Hat pins, tie tacs
The Great American Buckle Co. 2108 North Major Ave. Chicago IL 60639	Belt buckle
Gulf Coast Sportswear P.O. Box 1498 Lake Jackson TX 77566	Clothing
Texas Sportswear, Inc. P.O. Box 17188 Austin TX 78760	Clothing
Texas Recreation Corporation P.O. Drawer 539 Wichita Falls TX 76307	Sunglasses
Velva Sheen Manufacturing Co. 3860 Virginia Avenue Cincinnati OH 45227	Shirts
World Wide Products Company 415 Main Street Royse City TX 75089	Leather goods
Southwest Buckle, Inc. P.O. Box 87068 Houston TX 77287	Belt buckles
H.T.S. & Associates 401 Main Street Humble TX 77338	Belt buckles
JHB Sales P.O. Box 953 Wimberley TX 78676	Clothing

Previous Licensees

Southport International Corp.  
10220 Giorgibelle  
Suite 200  
Houston TX 77043

Texas Lifestyles  
348 Garden Oaks Blvd.  
Houston TX 77018

T-Shirts Unlimited  
4100 Avenue B #709  
Austin TX

Item(s)

Shoes

Shirts

Shirts

Current Licensees

Velva Sheen Mfg. Co.  
3860 Virginia Avenue  
Cincinnati OH 45227

Vantage Custom Classics  
1600 West Blancke Street  
Linden NJ 07036

Unitog Company  
101 West 11th Street  
Kansas City MO 64105

The T-Shirtery, Inc.  
1200 Menlo Drive  
Atlanta GA 30318

Suntex Incorporated  
P.O. Box 17126  
8060-Q North Point Blvd.  
Winston-Salem NC 27106

St. Louis Hat Company  
1520 Washington Avenue  
St. Louis MO 63103

Profile Prints, Inc.  
300 120th Avenue N.E.  
Bellevue WA 98005

Pete's Leather Company  
R.R. #1  
Westby WI 54667

National Screenprint  
5325 WEst 74th Street  
Edina MN 55435

Melco Clothing Company  
200 South Water Street  
Milwaukee WI 53204

Maison Courette, Ltd.  
17-19 Stainer Street  
London, S.E. 1

Louisville Mfg. Co., Inc.  
P.O. Box 1436  
Louisville KY 40201

Clothing

Clothing

Uniforms

T-shirts

Caps

Caps

T-shirts

Belts

Clothing

Clothing

T-shirts

Jackets, caps

<u>Current Licensees</u>	<u>Item(s)</u>
Long Handle Shirts of Denver, Inc. 451 East 58th Avenue Denver CA 80216	Shirts
Logo 7, Inc. 3229 North Shadeland Avenue Indianapolis IN 46226	Clothing
Key Specialties, Inc. 7272 Pinemont Drive Houston TX 77040	Clothing
Indian Silk Screen, Inc. P.O. Box 1266 La Crosse WI 54601	Shirts, gloves
Holoubek Studios, Inc. 4712 North 125th Street Butler WI 53007	Clothing
Fun Wear, Inc. P.O. Box 09546 Columbus OH 43209	Shirts, jerseys
Freedom Industries, Inc. Rt. 2 Hwy. 41 North Manchester TN 37355	Caps
Flash Graphic 3123 Oakcliff Ind. St. Atlanta GA 30340	Clothing
Designer Products, Inc. 1915 Main Street Kansas City MO 64108	Caps
Dallas Novelty Arts, Inc. 3368 Garden Brook Dallas TX 75234	Shirts
DACO Industries 11702 West 85th Stret Lenexa KS 66214	Caps
Classic Impressions P.O. Box 10102 Portland OR 97218-0102	Clothing
Champion Awards 4925 West Hampton Milwaukee WI 53218	Shirts
Don Carlson Company 9819 Valley View Road Eden Prairie MN 55344	Clothing
Buffalo Shirts, Inc. P.O. Box 13365 Spokane WA 99213	Shirts
Artex Manufacturing Company, Inc. 7600 Wedd Overland Park KS 66204	Clothing
Alamo Hat Company 1907 South St. Mary's San Antonio TX 78210	Caps

Current Licensees

Item(s)

AJD Cap Corporation  
3301 Castlewood Road  
Richmond VA 23234

Caps

Advertisers Mfg. Co.  
P.O. Box 188  
Ripon WI 54971

Caps

Ace Screen Printing  
10909 Metronome  
Houston TX 77043

Shirts, jerseys

AAM Company  
P.O. Box 193  
Menomonie WI 54751

Headbands