

ESTTA Tracking number: **ESTTA19385**

Filing date: **11/16/2004**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Rex Bell
Granted to Date of previous extension	11/20/2004
Address	413 20th Street Galveston, TX 77550 UNITED STATES

Attorney information	John S. Egbert Harrison & Egbert 412 Main St., 7th Floor Houston, TX 77002 UNITED STATES harrisonegbert@yahoo.com Phone:713-224-8080
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Applicant Information

Application No	78254886	Publication date	09/21/2004
Opposition Filing Date	11/16/2004	Opposition Period Ends	11/20/2004
Applicant	STARBUCKS U.S. BRANDS, LLC 2525 STARBUCKS WAY MINDEN, NV 89423		

UNITED STATES

Goods/Services Affected by Opposition

Class 033.

All goods and services in the class are opposed, namely: distilled spirits and liqueurs

**Related
Proceedings**

Opposition No: 91159504

Attachments

Opp2.pdf (9 pages)

Signature

/1990-3/

Name

John S. Egbert

Date

11/16/2004

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

In the Matter of Application Serial No. 78/254,886
Published in the Official Gazette on September 21, 2004

REX WAYNE BELL,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. _____
	§	
STARBUCKS U.S. BRANDS, LLC,	§	
	§	
Applicant.	§	

Box TTAB - Fee
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

The Opposer, Rex Wayne Bell, having an address of 413 20th Street, Galveston, Texas, hereby believes that he will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Applicant has applied to register the word mark for "STARBUCKS" used in connection with distilled spirits and liqueurs, in International Class 33, in Application No. 78/254,886, filed on May 27, 2003, and published for opposition on September 21, 2004.
2. The Opposer is the owner of a small bar and live music venue which sells a proprietary beer under the trademark "STAR BOCK BEER".
3. The Opposer is the owner of the trademark "STARBOCK BEER", used in connection with beer, in International Class 32, and the subject of U.S. Serial No. 78/220,579,

filed on March 1, 2003, and published for opposition on January 20, 2004.

4. The Opposer's filing date of March 1, 2003, for the "STARBOCK BEER" trademark, has priority over the filing date of Applicant's "STARBUCKS" mark, which was filed on May 27, 2003.

5. Applicant has filed an opposition to the Opposer's trademark application under Opposition No. 91159504, said opposition is currently suspended pending the outcome of a federal court case involving the same parties.

6. In the pleadings for Opposition No. 91159504, Applicant has admitted to a likelihood of confusion between the Applicant's "STARBUCKS" mark and the Opposer's "STARBOCK BEER" mark. *See Attached Notice of Opposition at Page 5.*

7. Since Applicant has admitted to a likelihood of confusion between the Applicant's "STARBUCKS" mark and the Opposer's "STARBOCK BEER" mark, and the Opposer possesses the priority filing date, Applicant's Application should be denied and this opposition should be sustained.

WHEREFORE, Opposer respectfully requests that the Trademark Trial and Appeal Board find and order that registration by Applicant of the mark "STARBUCKS" be denied as damaging to the Opposer and this opposition be sustained.

Opposer hereby submits the requisite filing fee of \$300.00 for opposing Applicant's registration in Class 33

Respectfully submitted,

Date

11-16-04



John S. Egbert
Reg. No. 30,627
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JSE:ljc
Our File: 1990-3

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.)

REX WAYNE BELL,)

Applicant.)

Opposition No. 159504

NOTICE OF OPPOSITION

Applicant Serial No.: 78/220,579
Filed: March 1, 2003
Published for Opposition: January 20, 2004
Mark: STARBOCK BEER

BOX TTAB FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

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 d/b/a Starbucks Coffee Company, a 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

STARBOCK BEER shown in Application Serial No. 78/220,579, and hereby oppose the same.

As grounds for opposition, Opposers allege as follows, upon actual knowledge with respect to themselves and their own acts, and upon information and belief as to other matters:

1. Applicant Rex Wayne Bell, an individual, with an address at 413 20th Street, Galveston, Texas 77550 is named as the current owner of Application Serial No. 78/220,579. That application was filed on March 1, 2003 under Section 1(b) as an intent-to-use application and seeks registration of the mark STARBOCK BEER for "beer" in Class 32.

2. For over a quarter century, Opposers have been in the business of offering cafe, restaurant, and coffee house services, and retail store services featuring coffee, tea, and coffee- and tea-based beverages and an ever-expanding range of beverages, bottled and canned beverages, and other products all under the STARBUCKS mark.

3. Sales of STARBUCKS beverages and other products have been immense, amounting to many millions of dollars of products sold worldwide in 2002 alone. Opposers currently operate at more than 6,294 locations worldwide.

4. Opposer Starbucks U.S. Brands Corporation is the owner of, among others, the following United States trademark registrations for the mark STARBUCKS and STARBUCKS-formative marks:

Mark	Reg. No./Reg. Date	Goods
STARBUCKS COFFEE TEA SPICES & Design	1,098,925 August 8, 1978	Coffee, tea, spices, and cocoa in Class 30
STARBUCKS & Design	1,417,602 November 18, 1986	Coffee, tea, spices, herb tea, chocolate and cocoa in Class 30; coffee bar services and coffee distribution services and retail store services in Class 42
STARBUCKS	1,452,359 August 11, 1987	Coffee, tea, spices, herb tea, chocolate and cocoa in Class 30
STARBUCKS COFFEE & Design	1,542,775 June 6, 1989	Coffee in Class 30; restaurant services featuring coffee and espresso beverages and also serving sandwiches and breakfasts in Class 42
STARBUCKS COFFEE & Design	1,815,937 January 11, 1994	Ground and whole bean coffee, cocoa, tea, powdered chocolate and powdered vanilla, etc. in Class 30; retail store services featuring all of the above goods . . . and restaurant and café services in Class 42
STARBUCKS COFFEE & Design	1,815,938 January 11, 1994	Ground and whole bean coffee, cocoa, tea, powdered chocolate and powdered vanilla, etc. . . in Class 30; retail store services featuring all of the above goods . . . and restaurant and café services in Class 42
STARBUCKS COFFEE & Design	1,943,361 December 26, 1995	Flavoring syrups for beverages in Class 30
STARBUCKS	2,086,615 August 5, 1997	Ready-to-drink coffee, ready-to-drink coffee based beverages, in Class 30; coffee flavored soft drinks and syrups and extracts for making flavored soft drinks and milk-based beverages in Class 32
STARBUCKS COFFEE & Design	2,120,653 December 9, 1997	Ready-to-drink coffee, ready-to-drink coffee based beverages in Class 30; coffee-flavored soft drink, flavored soft drinks and syrups and extracts for making the foregoing in Class 32
STARBUCKS COFFEE (stylized)	2,227,835 March 2, 1999	Wholesale distributorships, retail outlets, and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk. . . in Class 35
STARBUCKS COFFEE (stylized)	2,227,837 March 2, 1999	Wholesale distributorships, retail outlets and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk . . . in Class 35
STARBUCKS	2,266,351	Ground and whole bean coffee; cocoa; herbal

Mark	Reg. No./Reg. Date	Goods
COFFEE & Design		and non-herbal teas; coffee, tea, cocoa, and espresso beverages, and beverages made with a base of coffee and/or espresso; instant coffee and coffee substitutes; ready-to-drink coffee beverages . . . in Class 30
STARBUCKS COFFEE & Design	2,325,182 March 7, 2000	Wholesale distributorships, retail outlets, and mail order services featuring ground and whole bean coffee; tea; cocoa; coffee and espresso beverages and beverages made with a base of coffee, espresso, and/or milk, etc. . . . in Class 35
STARBUCKS	2,696,594 March 11, 2003	Milk and milk products, namely, pasteurized milk, skim milk, whole milk, flavored milk, vitaminized milk, flavoring syrups and liquid and powdered beverage mixes used to make milk-based food beverages; dairy-based food beverages; soy-based food beverage used as a milk substitute in Class 29
STARBUCKS COFFEE	2,102,737 October 7, 1997	Milk, flavored milk and milk-based food beverages in Class 29

5. The foregoing registrations are valid and subsisting and constitute *prima facie* evidence of the validity of the marks and registrations, of Opposers' ownership of and exclusive right to use the marks in commerce, and provide constructive notice of ownership thereof by Opposers

6. Opposers have continuously used the STARBUCKS marks in commerce since long prior to the filing date of the opposed application. Opposers' pleaded Registrations were also filed and issued well prior to the filing date of the opposed application

As a result of Opposers' promotional efforts and commercial success Opposers' STARBUCKS marks have achieved such widespread public recognition that these marks have become famous.

8. Opposers' STARBUCKS marks became famous well prior to the March 1, 2003 filing date of Application Serial No. 78/220,579.

COUNT I: LIKELIHOOD OF CONFUSION

9. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 8.

10. Applicant seeks to register the mark STARBOCK BEER in connection with goods that are closely-related to those of Opposers, and that fall within the same channels of trade of Opposer's goods, including retail stores, restaurants, convenience stores, and grocery stores that offer and sell Opposer's goods. Indeed, Opposer Starbucks U.S. Brands is the owner of two pending applications covering alcoholic beverages in Class 33, namely Serial Nos. 78/254,886 for the STARBUCKS mark and 78/254,552 for the STARBUCKS LOGO, both filed May 27, 2003.

11. Applicant's STARBOCK BEER mark so resembles Opposers' marks as to be likely, when applied to the goods, to cause confusion, or to cause mistake, or to deceive.

COUNT II: DILUTION

12. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 11.

13. In view of the similarities of the parties' marks and the fame of Opposers' STARBUCKS marks, Applicant's mark STARBOCK BEER so closely resembles Opposers' famous marks and name STARBUCKS that it is likely to dilute and will dilute the distinctive quality of Opposers' marks.

WHEREFORE, Opposers believe that they are being, and will be damaged by the registration of the mark shown in Application Serial No. 78/220,579 and request that the opposition be sustained, and that registration to Applicant be refused.

Respectfully Submitted,

Dated: February 19, 2004

By: *Julia Anne Matheson*
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CORPORATION and STARBUCKS
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COFFEE COMPANY