

ESTTA Tracking number: **ESTTA20644**

Filing date: **12/06/2004**

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

Proceeding	91162995
Party	Defendant STARBUCKS U.S. BRANDS, LLC STARBUCKS U.S. BRANDS, LLC 2525 STARBUCKS WAY MINDEN, NV 89423
Correspondence Address	Julia Anne Matheson Finnegan, Henderson, Farabow, Garrett & 1300 I Street, N.W. Washington, D, 20005-3315
Submission	Motion to Suspend for Civil Action
Filer's Name	Linda K. McLeod
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Signature	/Linda K. McLeod/
Date	12/06/2004
Attachments	Motion to Suspend.pdf (14 pages)

Accordingly, Applicant requests that all proceedings, including Applicant's time to file an Answer to the Notice of Opposition be suspended pending final determination of the civil action. TBMP § 510.

Applicant respectfully requests that, upon resumption of proceedings (if any), Applicant be granted thirty (30) days from the mailing date of the Board's resumption order in which to Answer the Notice of Opposition.

Dated: December 6, 2004

Respectfully submitted,



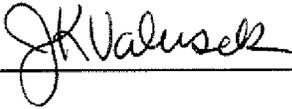
Julia Anne Matheson
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FINNEGAN, HENDERSON, FARABOW,
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1300 I Street, N.W.
Washington, D.C. 20005-3315
(202) 408-4000

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S MOTION TO SUSPEND PROCEEDINGS was served on December 6, 2004 by first class mail, postage prepaid, on the following attorney for Opposer:

John S. Egbert
L. Jeremy Craft
Harrison & Egbert
412 Main St., 7th Floor
Houston, TX 77002



Rex Wayne Bell v. Starbucks U.S. Brands, LLC
Opposition No. 91162995

Exhibit to Applicant's Motion to Suspend Proceedings

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
GALVESTON DIVISION

U.S. District Court
-A District of Texas
FILED
MAR 17 2004
Michael N. Muby, Clerk of Court

REX WAYNE BELL,

Plaintiff,

v.

STARBUCKS U.S. BRANDS CORPORATION
And STARBUCKS CORPORATION d/b/a
STARBUCKS COFFEE COMPANY,

Defendants.

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G-04-109

Civil Action No. _____

G-04-109

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff, REX WAYNE BELL, by and through his attorneys, hereby moves the court for Declaratory Judgment against Defendants, STARBUCKS U.S. BRANDS CORPORATION and STARBUCKS CORPORATION d/b/a STARBUCKS COFFEE COMPANY (hereinafter "Starbucks").

NATURE OF THE ACTION

1. This is an action for Declaratory Judgment under the Declaratory Judgment Act, 28 U.S.C. § 2201. The claims for relief are covered by the Lanham Federal Trademark Act, 15 U.S.C. §§ 1051-1127.

JURISDICTION AND VENUE

2. Jurisdiction herein is based upon the Federal Trademark Act, 15 U.S.C. §§ 1051-1127, and on 28 U.S.C. §§ 1331, 1338 and §§ 2201-02, as a declaratory judgment action arising under the Lanham Act, Title 15 of the United States Code.

3. Venue is proper in this district pursuant to 28 U.S.C. § 1391, in that Defendants are doing business in this judicial district, and a substantial part of the events giving rise to the claims

occurred in this judicial district, and Plaintiff resides and is doing business within this judicial district.

PARTIES

4. Plaintiff Rex Wayne Bell is an individual and resident of the State of Texas.
5. Plaintiff owns and operates a live music club located in Galveston, Texas, which serves various alcoholic beverages.
6. Upon information and belief, Defendant Starbucks U.S. Brands Corporation is incorporated under the laws of the State of California, and has its principal place of business at 533 Airport Boulevard #400, Burlingame, California 94010.
7. Upon information and belief, Defendant Starbucks Corporation d/b/a Starbucks Coffee Company is incorporated under the laws of the State of Washington, and has its principal place of business at 2401 Utah Avenue South, Seattle, Washington 98134.

BACKGROUND

8. Since as least as early as July 2003, Plaintiff has used the trademark "STAR BOCK BEER" in association with alcoholic beverages, namely, beer. Plaintiff has created a beer which offers a unique blend of flavors. Plaintiff has expended considerable sums in advertising said trademark, has exerted every effort to maintain the highest standards of quality for said products, and has created good will under said trademark among its purchasing public. By virtue of said good will, and because Plaintiff's trademark "STAR BOCK BEER" is so well known among the purchasing public, sales of Plaintiff's products are substantial, are increasing, and are of great value to the Plaintiff.

9. Upon information and belief, Defendants operate in interstate commerce in the business of manufacturing and selling coffee and operating retail coffee store franchises under the trademark "STARBUCKS", and have federally registered said mark under registration Nos. 1,098,925, 1,417,602, 1,452,359, 1,542,775, 1,815,937, 1,815,938, 1,943,361, 2,086,615, 2,120,653, 2,227,835, 2,227,837, 2,266,351, 2,325,182, 2,696,594, 2,102,737, all of which are for use with either coffee, coffee based beverages, milk, or distributorships for coffee. None of the aforementioned registered marks of the Defendants are for use in connection with alcoholic beverages of any type.

10. After Plaintiff started using its trademark "STAR BOCK BEER", and after Plaintiff had built its business under said mark to substantial sales, Defendants accused Plaintiff of violating its trademark rights through the use of the trademark "STAR BOCK BEER", as evidenced in the attached letters. Defendants have further stated in writing that Plaintiff's trademark is confusingly similar to Defendants' trademark, that its use is injurious to Defendants, and that Plaintiff has no right to use "STAR BOCK BEER" as a trademark. Defendants have also made multiple demands that Plaintiff cease and desist from using the trademark "STAR BOCK BEER". *See Appendix "A"*.

11. Defendants also filed a Notice of Opposition in the United States Patent and Trademark Office initiating Opposition No. 91159504 on February 19, 2004. This Opposition has not been resolved and is currently pending before the Trademark Office.

12. Said accusations and demands have given rise to a case of actual controversy within the jurisdiction of this Court, pursuant to 28 U.S.C. §§ 2201-02.

13. Plaintiff categorically denies that its use of the trademark "STAR BOCK BEER" violates

whatever federal or state rights Defendants might have in their name and mark, and specifically denies that any trademark rights Defendants might have in association with coffee products extend to the field of alcoholic beverages. Said fields are so remote in terms of trade channels, purchasing public, and methods of selection, that confusion of the public is highly unlikely.

14. Defendants' assertions that Plaintiff is violating its legal rights irreparably injures and adversely affects Plaintiff. Unless prevented by this Court, Defendants' assertions will continue to so affect Plaintiff's business and the investment Plaintiff has made in the trademark "STAR BOCK BEER" along with the attendant good will. To resolve the legal and factual questions raised by Defendants and to afford relief from the uncertainty and controversy which Defendants' assertion has precipitated, Plaintiff is entitled to a Declaratory Judgment of its rights under 28 U.S.C. §§ 2201-02.

COUNT I

15. Paragraphs 1-14 above are incorporated herein by reference.

16. An actual controversy exists as to whether the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is a violation of the rights Defendants might have in their registered trademarks.

17. Plaintiff hereby alleges that the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is not in violation of any rights Defendants might have under the federal law of trademark infringement as set forth in 15 U.S.C. §1114.

COUNT II

18. Paragraphs 1-17 above are incorporated herein by reference.

19. An actual controversy exists as to whether the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is a violation of the rights Defendants might have in their registered trademarks.

20. Plaintiff hereby alleges that the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is not in violation of any rights Defendants might have under the federal law of unfair competition as set forth in 15 U.S.C. §1125.

COUNT III

21. Paragraphs 1-20 above are incorporated herein by reference.

22. An actual controversy exists as to whether the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is a violation of the rights Defendants might have in their registered trademarks.

23. Plaintiff hereby alleges that the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is not in violation of any rights Defendants might have pursuant to the common law of unfair competition.

COUNT IV

24. Paragraphs 1-23 above are incorporated herein by reference.

25. An actual controversy exists as to whether the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is a violation of the rights Defendants might have in their registered trademarks.

26. Plaintiff hereby alleges that the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is not in violation of any rights Defendants might have pursuant to the Federal Trademark Dilution Act as set forth in 15 U.S.C. §1125.

COUNT V

27. Paragraphs 1-26 above are incorporated herein by reference.

28. An actual controversy exists as to whether the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is a violation of the rights Defendants might have in their registered trademarks.

29. Plaintiff hereby alleges that the use by Plaintiff of its trademark "STAR BOCK BEER" in connection with alcoholic beverages is not in violation of any rights Defendants might have pursuant to the Texas Anti-dilution Statute as set forth in Tex. Bus. & Comm. Code. § 16.29.

WHEREFORE, Plaintiff prays that the Court declare and a judgment be entered that:

- (a) Plaintiff's trademark "STAR BOCK BEER" does not violate Defendants' rights under the trademark laws of the United States or any other laws;
- (b) Plaintiff's trademark "STAR BOCK BEER" as used in connection with alcoholic beverages is not confusingly similar to or in conflict with Defendants' trademark "STARBUCKS" as used in their respective businesses;
- (c) Plaintiff has the right to use, in connection with alcoholic beverages, the trademark "STAR BOCK BEER" free from interference by Defendants, their officers, agents, servants, employees, attorneys, privies, representatives, successors, and assigns, and any and all persons acting by, through, or under authority from Defendants, either separately or jointly, in the United States or in any foreign country where the activities of Plaintiff or Defendants have a substantial effect on interstate or foreign commerce;

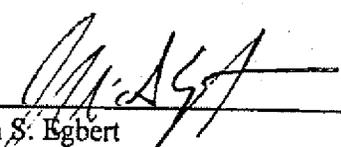
(d) Defendants, their officers, agents, servants, employees, attorneys, privies, representatives, successors, and assigns, and any and all persons in active concert or participation with or under authority from Defendants, either separately or jointly, be enjoined permanently from:

- i. interfering with, or threatening to interfere with, use of the trademark "STAR BOCK BEER" by Plaintiff, its successors or assigns, in connection with its or their business;
 - ii. instituting or prosecuting any suit or other proceeding placing in issue the rights of Plaintiff, or its successors or assigns, to register or use the mark "STAR BOCK BEER" in connection with alcoholic beverages;
- (e) the full extent of Plaintiff's attorney fees and costs be paid by the Defendants;
- (f) Plaintiff have such other, further, and general relief as the Court may deem just.

Respectfully submitted,

Date

3-17-04


John S. Egbert
TBA No. 06479550

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APPENDIX "A"



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JULIA ANNE MATHESON
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June 12, 2003

VIA CERTIFIED MAIL – RETURN RECEIPT REQUESTED
SENT VIA FEDERAL EXPRESS on May 22, 2003

Mr. Rex Wayne Bell
413 20th Street
Galveston, Texas 77550

Infringement and Dilution of STARBUCKS Mark
Mark: STARBOCK BEER
Trademark Application Serial No. 78/220,579

Dear Mr. Bell:

We represent Starbucks Coffee Company and its subsidiaries ("Starbucks") in connection with trademark and unfair competition matters.

As you are no doubt aware, Starbucks is the owner of numerous trademark registrations in the United States and worldwide for the marks STARBUCKS, STARBUCKS COFFEE, its STARBUCKS Logo, and various related marks (collectively, the "Starbucks Marks"). These registrations cover a wide variety of goods and services, ranging from retail store services, restaurant, café, coffee bar, coffee house, and snack bar services, to a variety of products including coffee-flavored soft drinks and syrups and extracts, carbonated and non-carbonated soft drinks, etc. Indeed, Starbucks owns several registrations for goods falling within International Class 32 including Reg. No. 2,086,615 for the mark STARBUCKS issued August 5, 1997, and Reg. No. 2,120,653 for the STARBUCKS Logo issued December 9, 1997.

Starbucks has used its STARBUCKS mark for more than a quarter century, and has invested considerable resources over the years in establishing and promoting its valuable marks. As a result of these efforts, the Starbucks Marks have become famous marks and assets of incalculable value. Indeed, the STARBUCKS mark was recently named to *Business Week's* 2002 list of the top 100 brands in the world.

It has come to our client's attention that you recently filed an application (Serial No. 78/220,579) to register the strikingly similar looking and sounding mark STARBOCK BEER for beer in International Class 32 claiming a date of first use of December 25, 2002. Given the undeniable similarity in the appearance and pronunciation of the

Mr. Rex Wayne Bell
Page 2

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STARBOCK and STARBUCKS marks, and their application to related products falling in the identical Class 32, Starbucks is understandably concerned that your use of the STARBOCK BEER mark will generate confusion in the marketplace as to the origin of the parties' respective products, misappropriate the goodwill in the STARBUCKS Marks that our client has labored long and hard to establish, and result in a lessening and/or blurring of the distinctiveness of the STARBUCKS Marks in violation of federal, state, and common law infringement and dilution principles.

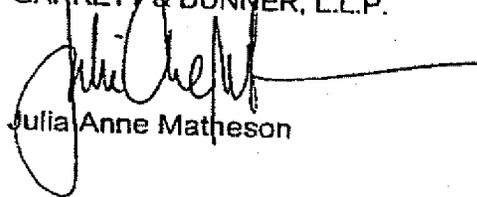
Accordingly, Starbucks requests that you immediately (1) cease any and all use of the STARBOCK BEER and/or STARBOCK mark; (2) destroy any signage, menus or other materials bearing the STARBOCK BEER and/or STARBOCK mark; and (3) abandon Application Serial No. 78/220,579 with prejudice.

Starbucks prefers to resolve this matter amicably. To that end, we ask that you provide us with written assurances that you will meet these demands by **June 27, 2003**. Absent receipt of such confirmation, Starbucks is prepared to oppose this application if and when it publishes for opposition and reserves the right to take any other necessary legal action to protect its valuable trademark rights.

We look forward to your prompt reply.

Very truly yours,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.


Julia Anne Matheson

JAM/ae



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JULIA ANNE MATHESON
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July 18, 2003

Mr. Rex Wayne Bell
413 20th Street
Galveston, Texas 77550

VIA REGULAR MAIL

Infringement and Dilution of STARBUCKS Mark
Mark: STARBOCK BEER
Trademark Application Serial No. 78/220,579

Dear Mr. Bell:

We represent Starbucks Coffee Company and its subsidiaries ("Starbucks") in connection with trademark and unfair competition matters.

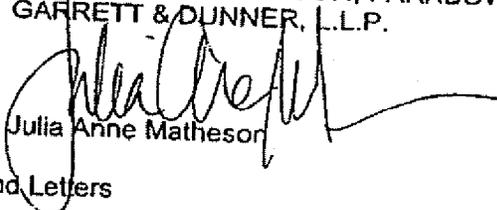
On May 22, 2003 we sent you the attached demand letter objecting to your use of, and application to register, the mark STARBOCK BEER on infringement and dilution grounds via Federal Express. Federal Express made three attempts to deliver the demand letter. You refused delivery. On June 12, 2003, we resent our demand letter to you via Certified Mail, Return Receipt Requested. You refused delivery of that letter as well.

We enclose copies of both letter for your information and review. In doing so, we reiterate our demands that you **Immediately** cease any and all use of the STARBOCK BEER and/or STARBOCK mark; destroy any signage, menus or other materials bearing the STARBOCK BEER and/or STARBOCK mark; and expressly abandon Application Serial No. 78/220,579 with prejudice.

While Starbucks would prefer to resolve this matter amicably, it is prepared to oppose your application if and when it publishes for opposition and to take any other necessary legal action to protect its valuable trademark rights. Please note that your attempts to avoid receipt of our demand letter will not shield you from future legal action.

Very truly yours,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Julia Anne Matheson

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Enclosures: May 22, 2003 & June 12, 2003 Demand Letters