

ESTTA Tracking number: **ESTTA691361**

Filing date: **08/24/2015**

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	Brouwerij Nacional Balashi NV
Granted to Date of previous extension	08/22/2015
Address	Balashi #62St. Cruz Santa Cruz, ARUBA

Attorney information	Susan J. Latham Feldman Gale, P.A. 2 South Biscayne Boulevard One Biscayne Tower, 30th Floor Miami, FL 33131 UNITED STATES trade- marks@feldmangale.com,slatham@feldmangale.com,jfeldman@feldmangale.com,akessler@feldmangale.com Phone:3053585001
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Applicant Information

Application No	86566095	Publication date	06/23/2015
Opposition Filing Date	08/24/2015	Opposition Period Ends	08/22/2015
Applicant	t & beer, inc 136 willow drive old tappan, NJ 07675 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Distilled Spirits
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of bona fide intent to use the mark as required by Section 1(b) of the Lanham Act.

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	86701463	Application Date	07/22/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	BALASHI PREMIUM BEER 11.27 FL OZ (333.3ML)		
Design Mark			
Description of Mark	<p>The mark consists of a green horizontal stripe across the top of the mark. Just below the stripe are the words PREMIUM BEER in black curved up, below the words PREMIUM BEER is a red banner with the word BALASHI written in white across the banner. Under the banner the words Brewed in Aruba appear, but this is not part of the mark.</p>		
Goods/Services	<p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, footwear, headgear</p> <p>Class 032. First use: First Use: 0 First Use In Commerce: 0 Beer</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Advertising</p>		
U.S. Application No.	86701470	Application Date	07/22/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BALASHI PREMIUM BEER 20CT. BOTTLE VOLUME CONTENTS 22 CL 5.0% ALC/VOL		



Description of Mark	<p>The mark consists of a square with a rounded top outlined in yellow. Inside the square the background is light green and dark green, there is an oval outlined in yellow. The inside of the oval is dark green with the words PREMIUM BEER BREWED IN ARUBA written on top BREWED IN ARUBA is not part of the mark. Written on the bottom part of the oval are the words Brouwerij Nacional Balashi N.V., this is not part of the mark. Inside the middle of the oval is a picture of a beach with a tree depicted on the shore and the word BALASHI is written in a red banner across the lower half of the oval. This banner is on the foreground of the image.</p>
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Goods/Services	<p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, footwear, headgear</p> <p>Class 032. First use: First Use: 0 First Use In Commerce: 0 Beer</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Advertising</p>
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U.S. Application No.	86701475	Application Date	07/22/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BALASHI PREMIUM BEER ARUBA'S BEER		

Design Mark	
Description of Mark	The mark consists of a red horizontal banner with the word BALASHI written in white inside of the banner. Above the red banner are the words PREMIUM BEER curved up, under the banner are the word Brewed in Aruba curved down, but these are not part of the mark. At the very bottom of the design are the words ARUBA'S BEER written in a different font, these are part of the mark.
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, footwear, headgear Class 032. First use: First Use: 0 First Use In Commerce: 0 Beer Class 035. First use: First Use: 0 First Use In Commerce: 0 Advertising

U.S. Application No.	86734984	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

Attachments	86701463#TMSN.png(bytes) 86701470#TMSN.png(bytes) 86701475#TMSN.png(bytes) Notice of Opposition BALASHI SPIRITS - Final.pdf(270891 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Susan J. Latham/
Name	Susan J. Latham
Date	08/24/2015

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

Brouwerij Nacional Balashi N.V.

Opposer,

v.

t & beer, inc.,

Applicant.

Opposition No.:

Mark: BALASHI SPIRITS

Serial No.: 86/566,095

NOTICE OF OPPOSITION

Brouwerij Nacional Balashi N.V., (“Balashi” or “Opposer”), a citizen and subject of ARUBA, will be damaged by registration on the Principal Register of the mark BALASHI SPIRITS, shown in Application Serial No. 86/566,095 filed by t & beer, inc. (“t & beer” or “Applicant”). Application No. 86/566,095 has been published in the Official Gazette and Balashi hereby opposes same. As grounds for the opposition, Opposer alleges as follows:

Applicant’s Lack of Bona Fide Intent

1. Nearly three years ago, on December 6, 2012, Applicant filed U.S. Trademark Application No. 85/795,933 seeking to register the standard character mark BALASHI BEER for eventual use in connection with “Beer” in International Class 032 (the “’933 Application”). Applicant filed the ’933 Application under Section 1(b) of the Lanham Act by alleging an intent-to-use the mark in commerce. However, after two extensions of time, Applicant chose not to request any further extensions of time and failed to file a Statement of Use. Therefore, the ’933 Application was declared abandoned on February 23, 2015.

2. Less than a month later, on March 17, 2015, Applicant filed the application that is the subject of the instant Notice of Opposition: U.S. Trademark Application No. 86/566,095. Through Application No. 86/566,095, Applicant is seeking to register the standard character mark BALASHI SPIRITS for use in connection with “Distilled spirits” in International Class 033 (the “‘095 Application”).

3. Applicant filed the ‘095 Application under Section 1(b) of the Lanham Act by alleging an intent-to-use the BALASHI SPIRITS mark in commerce. The Applicant has not converted the ‘095 Application to a Section 1(a) (*i.e.*, actual use) basis or otherwise filed any allegation or statement of use in commerce of BALASHI SPIRITS in connection with distilled spirits (or any other type of alcohol beverage).

4. Upon information and belief, Applicant did not have a bona fide intent to use in commerce the BALASHI SPIRITS mark in connection with distilled spirits, or any other form of alcohol beverage, when it filed the ‘095 Application on March 17, 2015.

5. Upon information and belief, Applicant had not marketed, planned to use, or otherwise taken any concrete steps toward using the BALASHI SPIRITS mark in connection with distilled spirits prior to filing the ‘095 Application on March 17, 2015.

6. Upon information and belief, Applicant had not invested financial resources toward using the BALASHI SPIRITS mark in commerce in connection with distilled spirits prior to filing the ‘095 Application on March 17, 2015.

7. Applicant’s lack of action or meaningful investment in the BALASHI SPIRITS mark prior to filing the ‘095 Application on March 17, 2015, suggests that Applicant only intended to reserve the BALASHI SPIRITS mark and, therefore, lacked the requisite *bona fide* intent to use the BALASHI SPIRITS mark in commerce when it filed the ‘095 Application.

8. Applicant seems to have a habit of trying to reserve marks that consumers are likely to associate with others. For example, Applicant filed an application under Section 1(b) seeking to register SLIM SHADY in connection with spirits and liqueurs in International Class 033. The Examiner issued an Office Action refusing to register that mark due to its false suggestion of a connection with the famous rapper Eminem, and that application is now dead. Similarly, Applicant filed an application under Section 1(b) seeking to register TATOOU in connection with distilled spirits in International Class 033. That application is currently the subject of an Opposition proceeding brought by the owner of the mark TATOO (Registration No. 2,975,653) in connection with alcoholic beverages, namely distilled spirits, in International Class 033. However, Applicant failed to respond to that Opposition and the Board issued a Notice of Default on August 22, 2015.

9. In sum, because Applicant lacked the requisite *bona fide* intent to use the BALASHI SPIRITS mark in commerce when it filed the '095 Application, Section 1(b) of the Trademark Act requires that the '095 Application be rejected and that registration of the Applicant's BALASHI SPIRITS mark be denied.

Opposer's Longstanding Business and Marks

10. Opposer has been doing business since 1999, including through the production, offering and sale of beer to consumers, including but not limited to U.S. citizens.

11. Opposer owns U.S. Trademark Application No. 86/701,463 for the mark



(BALASHI PREMIUM BEER and Design) in connection with “Beer” in International Class 032, as well as in connection with “Clothing, footwear, headgear” in International Class 025, and “Advertising” in International Class 035 (the “‘463 Application”). The ‘463 Application was filed pursuant to Section 44(e) of the Lanham Act and is supported by Balashi’s Aruban Trademark Registration No. 29411.

12. Opposer owns U.S. Trademark Application No. 86/701,470 for the mark



(BALASHI PREMIUM BEER and Design) in connection with “Beer” in International Class 032, as well as in connection with “Clothing, footwear, headgear” in International Class 025, and “Advertising” in International Class 035 (the “‘470 Application”). The ‘470 Application was filed pursuant to Section 44(e) of the Lanham Act and is supported by Balashi’s Aruban Trademark Registration No. 29412.

13. Opposer owns U.S. Trademark Application No. 86/701,475 for the mark



(BALASHI PREMIUM BEER ARUBA'S BEER and DESIGN) in connection with "Beer" in International Class 032, as well as in connection with "Clothing, footwear, headgear" in International Class 025, and "Advertising" in International Class 035 (the "475 Application"). The '475 Application was filed pursuant to Section 44(e) of the Lanham Act and is supported by Balashi's Aruban Trademark Registration No. 29417.

14. Opposer owns U.S. Trademark Application No. 86/734,984 for the standard character mark BALASHI in connection with beer in International Class 032. (the "984 Application"). The '984 Application was filed pursuant to Section 1(a) of the Lanham Act and is supported by use in commerce at least as early as November 2004.

15. Opposer also owns the common law word mark BALASHI in connection with beer, which is also supported by use in commerce at least as early as November 2004.

16. The Opposer's common law BALASHI mark and the marks reflected in the '463 Application, the '470 Application, the '475 Application, and the '984 Application shall be collectively referred to as "Opposer's BALASHI marks."

17. Opposer's use in commerce of Opposer's BALASHI marks began many years before the Applicant filed the '933 Application and the subject '095 Application.

18. Opposer's BALASHI marks have been in continuous use in commerce since many years before the Applicant filed the '933 Application and the subject '095 Application.

19. Through use in commerce, including foreign trade with U.S. citizens, U.S. beer consumers have come to exclusively associate Opposer's BALASHI marks with the Opposer and

the beer it produces. As a result, Opposer's BALASHI marks have developed substantial and valuable goodwill among U.S. consumers.

20. Indeed, many U.S. citizens have toured Opposer's beer production facility in Aruba and purchased Opposer's beer marked with one or more of Opposer's BALASHI marks.

21. Moreover, many U.S. consumers have imported Opposer's BALASHI beer into the United States through U.S. Customs. Upon information and belief many of those U.S. consumers then distribute some of their BALASHI beer supply to friends and family within the United States.

22. Opposer has further engaged in commercial intercourse with U.S. citizens by receiving and responding to offers from U.S. citizens to more formally act as a U.S. distributor of Opposer's BALASHI beer.

23. Opposer has also engaged in commercial intercourse with U.S. citizens by receiving and responding to offers from U.S. citizens to assist Opposer with its online marketing efforts.

24. Opposer's BALASHI marks have not been abandoned and continue to be used in commerce, including foreign trade with U.S. citizens who continue to use the Opposer's BALASHI marks as a means of identifying and distinguishing Opposer's beer from other beer offered by Opposer's competitors.

25. Nevertheless, due to the frequency of inquiries from U.S. consumers over the years as to whether and where Opposer's BALASHI beer is sold inside of the United States, the Opposer has engaged in formal discussions with United States citizens who are experienced in alcohol beverage importation and distribution with respect to establishing a formal importation and distribution program for Opposer's BALASHI beer within the United States in order to make

it more convenient for U.S. citizens to obtain Opposer's BALASHI beer without having to travel to Aruba and import it into the United States themselves. As a result, Opposer is preparing to launch sales and distribution of its BALASHI beer inside the United States.

26. Consequently, Opposer will suffer substantial harm should the '095 Application be granted and the BALASHI SPIRITS mark be registered on the Principal Register.

**Likelihood of Confusion Between Applicant's Proposed Mark
and Opposer's BALASHI Marks**

27. Applicant has disclaimed the term "SPIRITS" within its proposed BALASHI SPIRITS mark and, thus, the dominant portion of Applicant's proposed mark is the term "BALASHI."

28. Applicant's proposed BALASHI SPIRITS mark is substantially similar in appearance, sound and commercial impression to Opposer's BALASHI marks.

29. Applicant's proposed BALASHI SPIRITS mark is confusingly similar to Opposer's BALASHI marks.

30. Consumers who encounter the Parties' respective marks would be likely to assume a connection between the Parties.

31. Applicant's proposed goods (distilled spirits) and Opposer's goods (beer) are related given that they are all alcoholic beverages.

32. Applicant's proposed goods (distilled spirits) and Opposer's goods (beer) are likely to be marketed in the same channels of trade.

33. Consumers who encounter the Parties' goods bearing their respective marks will be misled into believing that the Parties' respective goods share, emanate from, are affiliated with, and/or are sponsored by a common source.

34. In sum, the proposed mark set forth in the '095 Application, BALASHI SPIRITS, consists of or comprises a mark which so resembles the Opposer's BALASHI marks that potential consumers are likely to be confused, deceived and/or mistaken as to the source of the goods offered by Applicant and Opposer.

35. Thus, Section 2(d) of the Trademark Act requires that the '095 Application be rejected and that registration of the Applicant's BALASHI SPIRITS mark be denied.

WHEREFORE, Brouwerij Nacional Balashi N.V. respectfully requests, pursuant to Section 1(b) and Section 2(d) of the Lanham Act that the Trademark Trial and Appeal Board grant this Opposition and deny t & beer inc.'s Application Serial No. 86/566,095 to register the BALASHI SPIRITS mark.

Dated: August 24, 2015

Respectfully Submitted,
Brouwerij Nacional Balashi N.V.

By: /Susan J. Latham/
Susan J. Latham
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CERTIFICATE OF ELECTRONIC FILING
AND CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** is being submitted electronically via the Electronic Filing System for Trademark Trial and Appeals on this 24th day of August 2015.

I further hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant by U.S. mail and by transmitting a copy of same by electronic mail on this 24th day of August 2015 to:

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As attorney of record for Application Serial No. 86/566,095 on behalf of:
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/Susan Latham/

Susan J. Latham
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