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

Proceeding	91223456
Party	Defendant t & beer, inc
Correspondence Address	GREGORY J WINSKY ARCHER & GREINER PC ONE CENTENNIAL SQUARE, PO BOX 3000 HADDONFIELD, NJ 08033 UNITED STATES trademarks@archerlaw.com, t.simone@prodigy.net
Submission	Opposition/Response to Motion
Filer's Name	Gregory Winsky
Filer's e-mail	gwinsky@archerlaw.com, kchewning@archerlaw.com
Signature	/s/ Gregory Winsky
Date	05/13/2016
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application No. 86/566,095

Brouwerij Nacional Balashi N.V.,	:	
	:	Opposition No. 91223456
	:	
Opposer,	:	Serial No. 86/566,095
	:	MARK: BALASHI SPIRITS
v.	:	
	:	I hereby certify that this submission and all marked
t & beer, inc.,	:	attachments, if any, are being electronically filed with
	:	the Trademark Trial and Appeal Board through its
	:	website located at http://esta.uspto.gov on May 13,
Applicant.	:	2016.
	:	
	:	<i>/s/ Gregory J. Winsky</i>
	:	_____
	:	GREGORY J. WINSKY, ESQUIRE

OPPOSITION TO OPPOSER’S COUNTER MOTION FOR SUMMARY JUDGMENT

Applicant, t & beer, inc. (“T & Beer” or “Applicant”), by and through its undersigned counsel, submits this Brief in Opposition to Opposer Brouwerij Nacional Balashi N.V.’s (“BNB” or “Opposer”) Counter Motion for Summary Judgment, and pursuant to Trademark Trial and Appeal Board Manual of Practice (TBMP) 528, the Trademark Rules of Practice, and Rule 56 of the Federal Rules of Civil Procedure, respectfully requests that the Board deny Opposer’s Motion for Summary Judgment.

INTRODUCTION

Opposer's motion for summary judgment must be denied because it proves Opposer lacks any standing to pursue this Opposition proceeding. Opposer's baseless priority argument rests entirely on *Int'l Bancorp, LLC v. Societe Des Bains De Mer Et Du Cercle Des Etrangers a Monaco*, 329 F.3d 359 (4th Cir. 2003)– a factually inapposite case which the Fourth Circuit has expressly limited to servicemarks.

More aptly, Opposer's motion confirms that Applicant's motion for judgment on the pleadings should be granted and this action dismissed. Specifically, Opposer's production and sale of beer in Aruba under Opposer's foreign Balashi mark does not provide it with priority in the United States over Applicant's mark. Absent appropriate standing to challenge the application at issue, Opposer's Motion for Summary Judgment must be denied and judgment must be entered in favor of Applicant.

Even if Opposer could establish that it has standing to oppose this application, which it cannot, there are material facts in dispute regarding Applicant's bona fide intent to use the mark and Opposer's submission fails to establish that Applicant lacked a bona fide intent to use the BALASHI SPIRITS mark on the identified good.

For these reasons, Opposer's Motion for Summary Judgment must be denied and judgment must be entered in favor of Applicant.

FACTS

A. Applicant's Counter-Statement of Material Facts

Applicant sets forth the following counter-statement of material facts in support of its Opposition to Opposer's Motion for Summary Judgment:

1. Opposer sells Balashi Beer only in Aruba. *See* Opposer's Motion Ex. P.

2. Opposer has not used the Balashi trademark in commerce in the United States.
See Opposer's Motion Ex. P, T, U, Z; Notice of Opp'n. ¶¶19-21
3. Opposer previously filed three separate applications for trademark registration for the mark Balashi and Balashi Beer, *See* Exs. 1-3 (attached hereto).
4. Application No. 78/304,942, Application No. 78/304,953, and Application No. 78/365,654 were filed with the USPTO.
5. Each of the applications for registration was abandoned by Opposer. *See* Ex. 1
6. Opposer filed Application No. '942 for Balashi Beer as an intent to use application on September 24, 2003. *See id.*
7. The USPTO issued an office action letter finding that Balashi was primarily geographically descriptive. *See* Ex. 1.
8. Opposer successfully appealed the refusal based on geographic descriptiveness and obtained a precedential opinion on August 2, 2006. *See* Ex. 8.
9. Opposer's proposed mark was published and ultimately a Notice of Allowance was sent. *See* Ex. 1.
10. On August 27, 2007, Opposer sought, and obtained, an extension of time to file the requisite Statement of Use for its '452 application. *See id.*
11. In its extension request, dated August 27, 2007, Opposer did not identify any use date and did not identify a use date in 2004. *See id.*

12. Opposer never submitted any Statement of Use and on February 28, 2008, Opposer's original application for trademark registration for the Balashi Beer mark was abandoned and closed. *See id.*

13. Opposer similarly allowed a companion application for the mark Balashi under Application No. 78/304,953, to become abandoned for failure to file a Statement of Use. *See Ex. 2.*

14. The '953 application was similarly refused because of geographic descriptiveness. *See id.*

15. Opposer successfully appealed that determination as well. *See Ex. 8.*

16. On July 23, 2007 and February 12, 2008, Opposer obtained two extensions of time to file the requisite Statement of Use on its '953 application.

17. On September 25, 2008, the '953 application was abandoned because Opposer failed to file the requisite Statement of Use.

18. In its extension requests regarding the '953 application, Opposer did not identify any use date and did not identify a use date in 2004. *See id.*

19. On February 23, 2004, Opposer filed Application No. 78/365,654 regarding a design trademark for Balashi. *See Ex. 3.*

20. Opposer obtained three extensions of time to file the requisite Statement of Use for the '654 application. *See id.*

21. Opposer never submitted the requisite Statement of Use for the '654 application and it was deemed abandoned as of June 26, 2008. *See id.*

22. In addition to its three prior abandoned applications, Opposer has multiple current applications for trademark registrations pending before the PTO. *See* Exs. 4-6 attached hereto.

23. Three of Opposer's applications were filed based upon Section 44(d) of the Lanham Act. *See* Notice of Opp'n. ¶¶11, 12; Exs. 4-6 (attached hereto).

24. Application No. 86/701,463, Application No. 86,701,470, and Application No. 86/701,475 were filed with the USPTO on July 25th, 22nd and 22nd of 2015 respectively. *See* Exs. 4-6.

25. Application Nos. '463, '470, and '475 are based upon a purported foreign trademark issued on **June 7, 2011**, more than four years before the Section 44(b) applications were filed. *See id.*

26. An additional application filed on behalf of Opposer, Application No. 86/734,984, filed pursuant to Section 1(a) of the Lanham Act claiming "use in commerce" as early as 2004. *See* Ex. 7

27. All of Opposer's claimed "use in commerce" occurred outside of the United States. *See* Notice of Opp'n. ¶¶19-21; Opposer's Motion for Summary Judgment Exs. P, T, U, Z.

28. Opposer has admitted that its sales of product to persons whom Opposer believes are U.S. citizens occurred in Aruba, not in the United States. *See id.* Exs. P, W, X.

B. Applicant's Response to Opposer's Statement of Material Facts

T & Beer responds to Opposer's "Undisputed Facts" below.

1. Admitted.
2. Applicant admits that on March 17, 2015, it filed Application No. 86,566,095 (the "095 Application"), the application that is subject of the instant Opposition.
3. Applicant admits that through the '095 Application, it is seeking to register the mark BALASHI SPIRITS for use in connection with "Distilled Spirits" in International Class 033.
4. Applicant admits that it filed the '095 Application under Section 1(b) of the Lanham Act on an intent-to-use basis.
5. Applicant admits that it has not yet converted the '095 Application to a Section 1(a) application because of the delay created by this proceeding.
6. Admitted that Opposer served written discovery requests, which speak for themselves.
7. Admitted that Applicant served its confidential responses (and objections) to those interrogatories on January 11, 2016 and a supplemental response to Rog. No. 3 on January 14, 2016, which speak for themselves.
8. Admitted that Opposer served written discovery requests, which speak for themselves.
9. Applicant admits that it served its responses (and objections) to those Requests for Production on January 22, 2016, which speak for themselves.
10. Applicant admits that it served documents in response to Opposer's discovery requests.

11. Admitted that the identified document was so labeled. The document speaks for itself.

12. Admitted that the identified document was labeled and served. The document speaks for itself.

13. Applicant is without sufficient information to admit or deny what internet searches were conducted by Opposer or its counsel.

14. Denied that the status of Applicant's COLA application is a material fact which supports Opposer's motion because a TTB application is not a requirement to show intent to use. Accordingly, no further response is required.

15. Denied. Applicant's prior applications and/or registrations and Opposer's characterization of same are not "material facts" relevant to the instant motion for summary judgment and no further response is required.

16. Denied as stated. Opposer's characterization of the proposed deposition scheduling is not a "material fact" relevant to the instant motion for summary judgment and no further response is required.

17. Denied. Opposer's characterization of Applicant's Motion for Judgment on the Pleadings is not a "material fact" relevant to the instant motion for summary judgment. Applicant further states that counsel for Opposer was notified of the intent to file a dispositive motion by way of phone call more than five days before the noticed depositions.

18. Admitted only that Ex. P provides irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of

the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

19. Admitted only that Ex. P provides irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

20. Admitted only that Ex. P provides irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Neither Opposer's reported foreign operations and sales that occur outside of the United States nor Opposer's purchase of materials from the United States for its foreign sales are material and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

21. Admitted only that the cited documents provide irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Neither Opposer's reported foreign operations and sales that occur outside of the United States nor Opposer's purchase of materials from the United States for its foreign sales are material and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

22. Admitted only that the cited documents provide irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Neither Opposer's reported foreign operations and sales that occur outside of the United States nor Opposer's purchase of materials from the United States for its foreign sales are material and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

23. Admitted only that the cited documents provide irrelevant information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Neither Opposer's reported foreign operations and sales that occur outside of the United States nor Opposer's purchase of materials from the United States for its foreign sales are material and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. Accordingly, no further response is required.

24. Applicant lacks sufficient knowledge regarding Aruba's tourist market to confirm or deny this statement. It is specifically denied that this is a material fact which supports Opposer's motion.

25. Admitted only that Ex. P provides irrelevant and hearsay information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. It is further admitted that Opposer does not identify in response to the purported

inquiries, any locations within the United States for purchasing Opposer's products and establish that no such sales have occurred within the United States.

26. Admitted only that Ex. P provides irrelevant and hearsay information regarding Opposer's business in Aruba but it is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. It is further admitted that Opposer does not identify in response to the purported inquiries, any locations within the United States for purchasing Opposer's products and establish that no such sales have occurred within the United States.

27. Denied that the exhibits referenced establish that Opposer made "export sales" but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action.

28. Applicant lacks sufficient knowledge regarding duty-free shops in Aruba to confirm or deny this statement. It is specifically denied that this is a material fact which supports Opposer's motion.

29. Denied that the exhibits referenced establish that Opposer made "export sales" but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish

any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action.

30. Denied that the exhibits referenced establish that Opposer made "export sales" but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. It is further denied that Exhibit W establishes through admissible evidence of sales to U.S. citizens.

31. Denied that the exhibits referenced establish that Opposer made "export sales" but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action. It is further denied that Exhibit W establishes through admissible evidence of sales to U.S. citizens.

32. Denied that the exhibits referenced establish that Opposer made "export sales" but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer's motion. Opposer's reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant's rights or its application at issue in this action.

33. Denied that the exhibits referenced establish that Opposer made “export sales” but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer’s motion. Opposer’s reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant’s rights or its application at issue in this action.

34. Denied that the exhibits referenced establish that Opposer made “export sales” but rather only that Opposer made sales of its goods at the airport in Aruba. It is specifically denied that this is a material fact which supports Opposer’s motion. Opposer’s reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant’s rights or its application at issue in this action.

35. Denied. Documents relied upon by Opposer demonstrate that passengers “smuggled” beer into the United States illegally, which demonstrates an effort to evade U.S. law on illegal importation of alcoholic beverages. *See* Opposer’s Exs. T, U.

36. Admitted only that the cited documents provide information regarding Opposer’s business and sales in Aruba but it specifically denied that this is a material fact which supports Opposer’s motion. Opposer’s reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant’s rights or its application at issue in this action. Accordingly, no further response is required.

37. Admitted only that documents relied upon by Opposer demonstrate that passengers “smuggled” beer into the United States illegally, which demonstrates an effort to evade U.S. law on illegal importation of alcoholic beverages. *See* Opposer’s Exs. T, U.

38. Admitted only that documents relied upon by Opposer demonstrate that passengers “smuggled” beer into the United States illegally, which demonstrates an effort to evade U.S. law on illegal importation of alcoholic beverages. *See* Opposer’s Exs. T, U.

39. Admitted that the cited documents demonstrate that persons visiting Aruba have purchased Opposer’s goods in Aruba and that Opposer has never identified any point of sale of its products in the United States.

40. Admitted only that the cited documents provide irrelevant information regarding Opposer’s business in Aruba but it specifically denied that this is a material fact which supports Opposer’s motion. Accordingly, no further response is required.

41. Admitted only that the cited documents provide irrelevant information regarding Opposer’s business in Aruba but it specifically denied that this is a material fact which supports Opposer’s motion. Accordingly, no further response is required.

42. Admitted only that Ex. P provides irrelevant and hearsay information regarding Opposer’s business in Aruba but it is specifically denied that this is a material fact which supports Opposer’s motion. Opposer’s reported foreign operations and sales that occur outside of the United States are immaterial and do not establish any priority for Opposer because foreign use of the Balashi trademark does not impact Applicant’s rights or its application at issue in this action. It is further admitted that Opposer does not identify in response to the purported inquiries, any locations within the United States for distributing Opposer’s products and establish that no such sales have occurred within the United States.

43. Applicant is without sufficient information to admit or deny the validity of the COLA application attached as identified. It is denied that the purported COLA application allows for the legal importation of Opposer's product into the United States for sales within the United States. It is specifically denied that this is a material fact which supports Opposer's motion.

44. Admitted only that Opposer's Application No. 86/734,984 seeks to register the standard character mark BALASHI in connection with beer pursuant to Section 1(a) of the Lanham Act based on alleged "use in U.S. commerce at least as early as November 2004." It is specifically denied that Opposer had valid grounds to file the '984 Application under Section 1(a) in light of its admitted exclusive foreign use of the mark and Opposer's prior, abandoned applications which did not cite a use date in 2004. *See* Applicant's Counter-statement of Material Facts ¶¶ 3-21. Applicant further admits that Opposer has filed the following applications Application No. 86/701,463 for the mark BALASHI (PREMIUM BEER and Design); Application No. 86/701,470 for the mark BALASHI (PREMIUM BEER and Design); and Application No. 86/701,475 for the mark BALASHI (PREMIUM BEER ARUBA'S BEER and DESIGN), all in connection with beer. *See id.*

45. Admitted.

46. Admitted that the identified document was so labeled. The document speaks for itself.

47. Admitted only that the word "Balashi" in the parties' respective marks is identically spelled; however, Applicant lacks sufficient knowledge regarding the pronunciation of the word "Balashi" in Aruba in order to confirm or deny Opposer's allegation that the word

sounds the same as used in both parties' respective marks. It is specifically denied that this is a material fact which supports Opposer's motion.

48. Admitted for purposes of this motion that distilled spirits and beer are both alcoholic beverages. It is specifically denied that this is a material fact which supports Opposer's motion.

49. Applicant admits that it intends to offer, without limitation, "rum and all styles of Caribbean spirits under the mark BALASHI SPIRITS.

50. Admitted.

ARGUMENT

I. LEGAL STANDARD FOR SUMMARY JUDGMENT

Summary judgment is properly granted when "there is no genuine issue as to any material fact and . . . the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). "The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party." See TBMP § 528 (citing *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993)).

A genuine dispute exists if "if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *Opryland USA v. Great American Music Show, Inc.*, 970 F.2d 847,850 (Fed. Cir. 1992) (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The evidence submitted by the non-movant, in opposition to a motion for summary judgment, 'is to be believed, and all justifiable inferences are to be drawn in [its] favor.'" *Id.*

A. Opposer's Motion Demonstrates Through Undisputed Facts that Opposer Cannot Establish Priority and Lacks Standing for this Action.

1. Opposer Cannot Establish Priority Based on Foreign Trademarks.

In responding to Applicant's Motion for Judgment on the Pleadings, Opposer does not refute that its applications for registration based on its foreign trademark registrations are out of time. Opposer makes no argument to rebut the lack of timeliness with respect to its Section 44(e) applications. *See* Opposer's Br. at 3-4 (addressing only Opposer's '984 Application). Thus, Opposer offers no explanation for '463, '470, and '475 Applications, which were not filed in accordance with the requirements imposed by Section 44(d). In any event, these foreign registrations do not provide Opposer with any basis for a challenge to Applicant's current application for the Balashi Spirits mark.

2. Opposer Cannot Establish Priority Based on Its Foreign Use.

Opposer cannot establish priority based on its admitted exclusively foreign use of the mark BALASHI. To be sure, Opposer's Motion for Summary Judgment does not allege that any of Opposer's production, packaging¹, marketing, and/or sale of beer occurred in the United States. *See* Opposer's Br. at ¶¶18-38. Rather, Opposer's brief and supporting evidence demonstrates that it has conducted business only outside of the United States with individuals it assumes are United States citizens. *See id.* ¶¶ 24-39. This fatal deficiency requires this Board to deny Opposer's Motion for Summary Judgment and grant Applicant's motion for judgment on the pleadings.

¹According to Opposer, BNB purchases its packaging from an American company; however, BNB receives shipment of the packaging materials in Aruba and produces the beer and packages it in Aruba. *See* Motion for Summary Judgment ¶20.

a. Exclusive Foreign Use Does Not Constitute “Use in Commerce” under the Lanham Act.

“The concept of territoriality is basic to trademark law.” *Person’s Co. v. Christman*, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990). Accordingly, United States law protects trademarks used in commerce in the United States. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 17.9 (4th ed. 2000) (“[F]or purposes of trademark rights in the United States, ‘use’ means use in the United States, not use in other nations”). “[F]oreign use has no effect on U.S. commerce and cannot form the basis for a holding that [Opposer] has priority here . . . trademark rights exist in each country solely according to the country’s statutory scheme.” *Person’s*, 900 F.2d at 1568-69; *see also ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 155 (2d Cir. 2007), cert. denied, 552 U.S. 827 (2007) (“The territoriality principle requires the use to be in the United States for the owner to assert priority rights to the mark under the Lanham Act.”).

Relying on *Int’l Bancorp, LLC v. Societe Des Bains De Mer Et Du Cercle Des Etrangers a Monaco*, 329 F.3d 359 (4th Cir. 2003), Opposer incorrectly argues that it possesses standing to challenge Applicant’s BALASHI MARK. Opposer takes a long journey on its argument for “use in commerce” arguing that because U.S. citizens consume its product abroad, which constitutes trade between a foreign entity and U.S. citizens, this foreign consumption establishes “use in commerce.”

Opposer’s reliance on *Int’l Bancorp*, however, is entirely misplaced and misleading. The court in *Int’l Bancorp* was clear that the holding was expressly limited to servicemarks. *Id.* at 375 n.8. The Court expressly rejected the theory Opposer asks this Board to adopt:

The statutory provision we apply today is directed solely and specifically to services and to evaluating what constitutes use in commerce for servicemarks. We would not apply our interpretation of the statutory provisions addressing services to a case involving goods.

Id. (emphasis in original). The Fourth Circuit’s limited holding is entirely consistent with the Lanham Act, which defines “use in commerce” differently for trademarks and service marks. While Section 1127 expressly contemplates services rendered in a “foreign country,” the provision governing trademarks does not include such language. Specifically, Section 1127 states:

a mark shall be deemed to be in use in commerce –

(1) on goods when – (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127. There is no contention, nor could there be, that beer served in a bottle or can bearing a Balashi label constitutes a service. Thus, *Int’l Bancorp* does not confer any standing on Opposer in this action.

Additionally, the facts in *Int’l Bancorp* are readily distinguishable from the facts at hand. While the Plaintiff in *Int’l Bancorp* rendered its services in Monaco, it used and displayed its service mark through a “massive advertising campaign in the United States, directed to United States consumers” in order to sell its services to United States consumers. 329 F.3d at 381 n.13 (emphasis added). The Fourth Circuit acknowledged that Plaintiff’s dual foreign and domestic “use” was key factor leading to their holding, distinguishing Plaintiff’s dual use from the exclusively foreign use in *Imperial Tobacco* [899 F.2d 1575 (Fed. Cir. 1990)] and *Person’s*, two cases involving the sale of goods overseas. *Id.* at 373-76 (noting that the issue in *Person’s* was “whether a Japanese manufacturer of clothes that had sold its clothes in Japan, and had never

used or displayed its mark to advertise or sell its products in the United States, could establish priority of use in the mark based on its Japanese operations”); *see also Person's*, 900 F.2d at 1567-69 (rejecting argument that goods sold in Japan by Japanese company to U.S. consumer could establish priority rights in the United States).

Even if the *Int'l Bancorp* holding were applicable to a case involving goods, which it is not, it would still be inapplicable here because Opposer does not advertise its product in the United States. Accordingly, Opposer's attempt to shoehorn its facts into the *Int'l Bancorp* framework must be rejected.

Opposer's brief plainly ignores the great weight of contrary precedent explicitly acknowledging the territoriality requirement that use of the mark must occur in the United States. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 155 (2d Cir. 2007) (“Precisely because a trademark has a separate legal existence under each country's laws, ownership of a mark in one country does not automatically confer upon the owner the exclusive right to use that mark in another country. Rather, a mark owner must take the proper steps to ensure that its rights to that mark are recognized in any country in which it seeks to assert them.”); *Buti v. Impresa Perosa, S.R.L.*, 139 F.3d 98, 103 (2d Cir. 1998) (noting that Defendant's registration and use of the “Fashion Café” name in Italy does not, “given the territorial nature of trademark rights, secure[] it any rights in the name under the Lanham Act”); *Person's Co.*, 900 F.2d at 1568-69 (Fed. Cir. 1990) (“T-shirt sales in Japan are not “use in United States commerce”); *La Societe Anonyme des Parfums Le Galion v. Jean Patou*, 495 F.2d 1265, 1270 n.4 (2d Cir. 1974) (“It is well settled that foreign use [of a trademark] is ineffectual to create trademark rights in the United States.”); *see also Le Blume Import Co. v. Coty*, 293 F. 344, 350 (2d Cir. 1923) (observing that “the protection of a trade-mark in the United States is not to be defeated by showing a prior use of a like trade-

mark in France, or in some other foreign country” so long as “the one claiming protection is able to show that he was first to use it in this country”); 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 29.02 (4th ed. 2005)(“[P]riority of trademark rights in the United States depends solely upon priority of use in the United States, not on priority of use anywhere in the world”).

In addition to the weight of judicial authority, the Board has long rejected the theory that any foreign trade regulated by Congress constitutes “use in commerce” under the Lanham Act. Thus, the full weight of authority before the Board has concluded that “priority of right in a trademark in the United States depends on priority of use in the United States and is not affected by priority of use in a foreign country.” *Sterling Drug Inc. v. Knoll A.-G. Chemische Fabriken*, 159 U.S.P.Q. 628, 630 (TTAB 1968) (emphasis added); *see also, Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998), *aff’g* 41 U.S.P.Q.2d 1731 (TTAB 1997); *Techex Ltd. v. Dvorkovitz*, 220 U.S.P.Q. 81, 83 (TTAB 1983); *Mother’s Restaurants Inc. v. Mother’s Other Kitchen, Inc.*, 218 U.S.P.Q. 1046, 1048 (TTAB 1983); *Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 U.S.P.Q. 341, 349 (TTAB 1978).

Opposer asks this Board to ignore the great weight of precedent set forth in prior decisions of this Board and instead to apply the critical and unsupported rule of the Fourth Circuit in *Int’l Bancorp*. Granting Opposer’s motion would undermine the right of priority and the territoriality principle, while also unnecessarily burdening trademark applicants. As Judge Motz noted in her dissent in *Int’l Bancorp*,

Such a rule threatens to wreak havoc over this country’s trademark law and would have a stifling effect on United States commercial interests generally. Before investing in a mark, firms and individuals would be forced to scour the globe to determine when and where American citizens had purchased goods or services from foreign subjects to determine whether there were trademarks

involved that might be used against them in a priority contest or in an infringement action in the United States. On the other hand, [BNB] and companies like it would, under the majority's rule, suddenly acquire a windfall of potential United States trademark rights for all of the goods and services advertised to and purchased by United States citizens while traveling in their countries. Like some sort of foreign influenza, these new entitlements would accompany American travelers on their return home, creating a vast array of new duties for individuals in the United States seeking to use the same or similar marks on goods or services sold in the United States.

329 F.3d. at 388-89. Finding for Opposer on this issue would go a step further than the Fourth Circuit in *Int'l Bancorp*. A finding that Opposer has standing because of its alleged use of the trademark in foreign jurisdiction would eviscerate territoriality and priority concepts that control trademark law and create new law that grants U.S. trademark rights to a foreign company that does not manufacture, sell, or advertise its products in the U.S., simply because a U.S. traveler brought a six-pack of beer back in their suitcase. This Board cannot create such a rule.

Opposer's telling admissions in its Motion for Summary Judgment regarding its lack of "use in commerce" within the United States, *see* Opposer's Br. ¶¶18-38, preclude any finding that Opposer will be able to establish priority.

Indeed, Opposer's motion and its supporting documents provide undisputed evidence to demonstrate that Opposer's claim of use beginning in 2004 in the context of its '984 Application does not reference any use in the United States. Further, Applicant's prior applications, in light of its admissions in its Motion for Summary Judgment and further demonstrate that Opposer has no evidence to present of any use in commerce beginning in, and continuing through 2004, in the United States. *See* Applicant's Counter-statement of Facts ¶¶ 3-21, Exs. 1-3. Opposer's prior applications, Application No. 78/304,942, Application No. 78/304,953, and Application No. 78/365,654 were filed with the USPTO and were subsequently abandoned when Opposer failed to present the requisite Statement of Use. *See id.* Notably, each of Opposer's prior applications

were abandoned in 2008, well after the claimed first use of 2004 that is alleged in '984 Application. Thus, the undisputed evidence, submitted and sworn to by Opposer, demonstrates its utter lack of standing to challenge Applicant's instant application as well as the unsustainability of Opposer's own '984 Application.²

For the reasons cogently expressed by the dissent in the *Int'l Bancorp* case, *see* 329 F.3d at 383-98, and in light of the substantial judicial and Board precedent, Opposer's claim of priority based on its admittedly exclusive foreign use of the mark BALASHI BEER must be rejected as a matter of law. Accordingly, the Board must deny Opposer's Motion for Summary Judgment and enter judgment in favor of Applicant.

B. Opposer's Motion for Summary Judgment Regarding Applicant's Bona Fide Intent and Confusion Must Be Denied Because Material Facts Are in Dispute.

As a matter of law, Opposer lacks standing to oppose Applicant's application due to its lack of priority. However, even if Opposer could establish priority, Opposer's Motion for Summary Judgment fails to establish by a preponderance of evidence that Applicant lacked a bona fide intent to use the mark BALASHI SPIRITS at the time it filed its 1(b) application. Opposer also argues in favor of a finding of confusion. If the Board is inclined to consider Opposer's motion on these grounds it is premature.

As this Board has previously noted, "as a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (TTAB 1993) (quoting *Copelands Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563 (Fed Cir. 1991)); *Giant Food Inc. v. Std. Terry Mills, Inc.*, 1986 TTAB LEXIS 96, *28, 229 U.S.P.Q. (BNA) 955, 962 (Trademark Trial & App. Bd. May 7, 1986) ("Summary judgment is notoriously inappropriate for determination of claims in which

² Applicant will oppose the competing applications filed by Opposer at the appropriate time.

issues of intent, good faith and other subjective feelings play dominant roles.”) (emphasis added).

“A determination of whether an applicant has a bona fide intention to use the mark in commerce is an objective determination based on all the circumstances.” *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994) (emphasis added). It is the Opposer’s initial burden to demonstrate “by a preponderance of the evidence that the Applicant lacked a bona fide intent to use the mark on the identified goods.” *Boston Red Sox Baseball Club Ltd., v. Sherman*, 2008 TTAB LEXIS 67, *16-17, 88 U.S.P.Q.2D 1581, 1587 (TTAB 2008). Once Opposer meets this burden, the burden shifts to the Applicant to produce either “1) objective documentary evidence of his intent to use the marks in commerce or 2) a valid explanation as to why no evidence has been produced under a totality of the circumstances analysis.” *City of Carlsbad v. Shah*, 666 F. Supp. 2d 1159, 1165 (S.D. Cal. 2009); *see also See Honda Motor Co. v. Winkelmann*, 90 U.S.P.Q.2d 1660 (TTAB 2009) (“The Board has held, however, that the absence of any documentary evidence regarding an applicant’s bona fide intention . . . is sufficient . . . , unless other facts are presented which adequately explain or outweigh applicant’s failure to provide such documentary evidence.”)

In support of its argument that Applicant lacked a bona-fide intent to use the BALASHI SPIRITS mark at the time it filed its application, Opposer cites to *Boston Red Sox Baseball Club*. See Opposer’s Br. At 21. However, in that case, the Applicant submitted no documentary evidence supporting its claim that it had a bona fide intention to use the mark. Instead, the Applicant argued in his brief that he conducted internet searches and investigations more than two years after filing his intent-to-use application. 2008 TTAB LEXIS 67, at *17-*18. Here, as Opposer acknowledges, Applicant has produced documents evidencing its bona fide intent to use

the BALASHI SPIRITS mark in commerce, including emails to a graphic designer regarding label designs featuring the mark, an invoice from the graphic designer, and a receipt for payment to the graphic designer. *See* Exs. G, H to Opposer’s Motion. These documents provide objective evidence of Applicant’s bona fide intent to use the mark in commerce which will always pre-date any use by Opposer in the United States.³

Opposer also argues that Applicant’s awareness of Balashi Beer “indicate[s] a bad faith intent by [T & Beer] to take advantage of [Opposer’s] established goodwill in its BALASHI mark.” Opposer’s Br. at 23-24. However, “knowledge of a foreign use does not preclude good faith adoption and use in the United States.” *Person’s*, 900 F.2d at 1570 (finding no evidence of bad faith where Appellee applied to register mark in U.S. despite prior knowledge of Japanese company selling goods in Japan under same name and logo). As the Federal Circuit noted in *Person’s*, “[t]rademark rights under the Lanham Act arise solely out of use of the mark in U.S. commerce or from ownership of a foreign registration thereon; ‘the law pertaining to registration of trademarks does not regulate all aspects of business morality.’” *Id.* (quoting *Selfway, Inc. v. Travelers Petroleum, Inc.*, 579 F.2d 75, 79 (CCPA 1978)).

Finally, it is important to note that discovery has not yet closed in this Opposition nor has the trial period commenced which provides for opportunity to record the deposition testimony at the appropriate time if this action should continue. Because genuine issues of material fact are still in dispute with regard to Applicant’s bona fide intent, if the Board is even inclined to consider this issue, Applicant respectfully requests that the Board deny Opposer’s motion for summary judgment on this issue.

³ Thus, even if Opposer had standing - which it does not - and even if Applicant’s application were dismissed - which it should not be - Applicant could simply re-file a new application which would still prevail over Opposer’s purported use because it has not occurred within the United States.

CONCLUSION

For all these reasons, Opposer's Motion for Summary Judgment should be denied and judgment should be entered in favor of Applicant.

Respectfully submitted,

ARCHER & GREINER
A Professional Corporation
Attorneys for Applicant, t & beer, inc.

By: /s/ Gregory J. Winsky Reg. No. 30,435
GREGORY J. WINSKY, ESQUIRE
KERRI E. CHEWNING, ESQUIRE

Dated: May 13, 2016

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Brief in Opposition to Opposer's Motion for Summary Judgment with accompanying exhibits** was served on counsel for the Opposer this 13th day of May, 2016, by sending the same via electronic and U.S. First Class mail, postage prepaid, and e-mail to

Jeffrey D. Feldman
Susan J. Latham
Ashley G. Kessler
Feldman Gale, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Blvd.
Miami, FL 33131

jfeldman@feldmangale.com
slatham@feldmangale.com
akessler@feldmangale.com

By: /s/ Gregory J. Winsky
GREGORY J. WINSKY, ESQUIRE

EXHIBIT 1

Generated on: This page was generated by TSDR on 2016-05-13 14:25:00 EDT

Mark: BALASHI BEER

US Serial Number: 78304942

Application Filing Date: Sep. 24, 2003

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



DEAD/APPLICATION/Refused/Dismissed or Invalidated

This trademark application was refused, dismissed, or invalidated by the Office and this application is no longer active.

Status:

Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Feb. 28, 2008

Publication Date: Dec. 05, 2006

Notice of Allowance Date: Feb. 27, 2007

Date Abandoned: Feb. 28, 2008

Mark Information

Mark Literal Elements: BALASHI BEER

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Disclaimer: "BEER"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Beer

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No
Filed No Basis: No

Currently 66A: No
Currently No Basis: No

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi NV
Owner Address: Balashi Z/N P.O. Box 145
ARUBA ARUBA
Legal Entity Type: CORPORATION
State or Country Where Organized: ARUBA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Leslie J. Lott

Docket Number: 02104-1-8020

Correspondent

Correspondent Name/Address: LESLIE J LOTT
LOTT & FRIEDLAND, PA
PO DRAWER 141098
CORAL GABLES, FLORIDA UNITED STATES 33114-1098

Phone: 305-448-7089

Fax: 305-446-6191

Domestic Representative

Domestic Representative Name: Lott & Friedland, P.A.

Phone: 305-448-7089

Fax: 305-446-6191

Prosecution History

Date	Description	Proceeding Number
Jul. 31, 2008	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Jul. 31, 2008	ABANDONMENT - NO USE STATEMENT FILED	47029
Aug. 27, 2007	EXTENSION 1 GRANTED	98765
Aug. 27, 2007	EXTENSION 1 FILED	98765
Aug. 27, 2007	TEAS EXTENSION RECEIVED	
Feb. 27, 2007	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Dec. 05, 2006	PUBLISHED FOR OPPOSITION	
Nov. 15, 2006	NOTICE OF PUBLICATION	
Oct. 11, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	77976
Sep. 22, 2006	ASSIGNED TO LIE	77976
Sep. 18, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 16, 2006	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Sep. 15, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Sep. 15, 2006	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 08, 2006	NON-FINAL ACTION MAILED	
Sep. 08, 2006	NON-FINAL ACTION WRITTEN	68356
Aug. 02, 2006	EXPARTE APPEAL TERMINATED	304942
Aug. 02, 2006	EX PARTE APPEAL-REFUSAL REVERSED	304942
Dec. 14, 2005	EXAMINERS STATEMENT MAILED	
Dec. 14, 2005	EXAMINERS STATEMENT - COMPLETED	68356
Dec. 06, 2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY	304942
Oct. 18, 2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY	304942
Jul. 20, 2005	ACTION DENYING REQ FOR RECON MAILED	
Jul. 20, 2005	ACTION CONTINUING FINAL - COMPLETED	68356
Jun. 21, 2005	EX PARTE APPEAL-INSTITUTED	304942
Jun. 21, 2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY	304942
Jun. 20, 2005	AMENDMENT FROM APPLICANT ENTERED	76539

Jun. 13, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	76539
Jun. 13, 2005	PAPER RECEIVED	
Dec. 14, 2004	FINAL REFUSAL MAILED	
Dec. 14, 2004	FINAL REFUSAL WRITTEN	68356
Nov. 10, 2004	AMENDMENT FROM APPLICANT ENTERED	68658
Oct. 21, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	68658
Oct. 21, 2004	PAPER RECEIVED	
Oct. 28, 2004	PAPER RECEIVED	
Oct. 21, 2004	PAPER RECEIVED	
Apr. 21, 2004	NON-FINAL ACTION MAILED	
Apr. 18, 2004	ASSIGNED TO EXAMINER	68356

TM Staff and Location Information

TM Staff Information

TM Attorney: VANSTON, KATHLEEN MARY

Law Office LAW OFFICE 103
Assigned:

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Feb. 27, 2007

Proceedings

Summary

Number of 1
Proceedings:

Type of Proceeding: Exparte Appeal

Proceeding 78304942
Number:

Filing Date: Jun 13, 2005

Status: Terminated

Status Date: Mar 17, 2006

Interlocutory
Attorney:

Plaintiff(s)

Name: Brouwerij Nacional Balashi NV

Correspondent Leslie J. Lott
Address: LOTT & FRIEDLAND, P.A.
P.O. Drawer 141098
Coral Gables FL UNITED STATES , 33114-1098

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI BEER	Abandoned - No Statement Of Use Filed	<u>78304942</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	APPEAL TO BOARD	Jun 13, 2005	
2	APPEAL ACKNOWLEDGED; CASE REMANDED	Jun 21, 2005	
3	PENDING, INSTITUTED	Jun 21, 2005	
4	REQUEST FOR RECONSIDERATION	Jun 13, 2005	
5	RECONSIDERATION DENIED	Jul 20, 2005	
6	PROCEEDINGS RESUMED	Jul 28, 2005	
7	D'S MOTION TO CONSOLIDATE	Aug 11, 2005	
8	BRIEF DUE: 60 DAYS.	Aug 18, 2005	
9	APPEAL BRIEF	Oct 13, 2005	
10	APPEAL FORWARDED TO EXAMINER FOR BRIEF	Oct 18, 2005	
11	APPEAL FORWARDED TO EXAMINER FOR BRIEF	Dec 06, 2005	
12	EXAMINER'S STATEMENT	Dec 14, 2005	
13	REPLY BRIEF	Jan 03, 2006	
14	MEMO FORWARDING REPLY BRIEF	Jan 20, 2006	

15 SUBMITTED ON BRIEF
16 BOARD'S DECISION: REVERSED
17 TERMINATED

Mar 17, 2006
Aug 02, 2006
Aug 02, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/304942; 78/304953

APPLICANT: Brouwerij Nacional Balashi NV

CORRESPONDENT ADDRESS:
Leslie J. Lott
LOTT & FRIEDLAND, P.A.
P.O. Drawer 141098
Coral Gables, FL 33114-1098

78304942

**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

MARKS: BALASHI BEER
BALASHI

CORRESPONDENT'S REFERENCE/DOCKET NO : 02104-1-8020

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S CONSOLIDATED
APPEAL BRIEF**

The applicant has appealed the trademark examining attorney's refusal to register the trademarks BALASHI BEER (Application Serial No. 78/304942) and BALASHI (78304953) because the marks are primarily geographically descriptive of the origin of applicant's goods. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2).

FACTS

The applicant filed applications under Section 1(b) of the Trademark Act to register BALASHI BEER and BALASHI for "beer" in Class 32. The examining attorney refused registration under Section 2(e)(2) of the Trademark Act because the marks are primarily geographically descriptive of the source of applicant's goods.

Applicant argued against this refusal. The examining attorney finally refused registration in each application on that basis.

The applicant filed a request for reconsideration which the examining attorney denied. The applicant has appealed that final refusal.¹

ARGUMENT

A three-part test is applied to determine whether a mark is primarily geographically descriptive of the goods within the meaning of Trademark Act Section 2(e)(2):

- (1) the primary significance of the mark must be geographic, i.e., the mark names a particular geographic place or location;
- (2) purchasers would be likely to make a goods-place association, i.e., purchasers are likely to believe the goods originate in the geographic location identified in the mark; and
- (3) the goods originate in the place identified in the mark.

TMEP §1210.01(a); *See In re MCO Properties, Inc.*, 38 USPQ2d 1154 (TTAB 1995); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989).

Geographic matter may be so obscure or remote that it would not be recognized as an indication of the geographic source of the goods. Remoteness or obscurity is determined from the perspective of the average American consumer. *See In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 824 F.2d 957 3 USPQ2d 1450 (Fed. Cir. 1987) However, the examining attorney does not have to show that the nationwide general public would associate the mark with the place. Rather, the significance of the term is determined not in the abstract, but from the point of view of the consumers of the particular goods or services identified in the application. *In re MCO Properties Inc.*, 38 USPQ2d 1154 (TTAB 1995) (FOUNTAIN HILLS held primarily geographically descriptive of real estate development services rendered in Fountain Hills, Arizona, where the record showed that Fountain Hills was the name of the town where the applicant was located and rendered its services, and that the purchasers who came in contact with the mark would associate that place with the services).

The addition of a generic or merely descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. *See In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998).

THE PRIMARY SIGNIFICANCE OF BALASHI IS GEOGRAPHIC.

Balashi identifies a geographic location in Aruba. Applicant has conceded this point. (Applicant's Brief at page 7). Informational material about Aruba makes reference to Balashi in both an historical and current context. Historically, Balashi was the center of the gold mining and gold smelting industry in Aruba. Presently, Balashi is the site a large desalination plant. For example, the following information is attached to the office action of December 14, 2004.

Less than a decade later, the first of Aruba's three economic booms took place when gold was discovered near Balashi.

See <http://www.lonelyplanet.com>

There is no need to buy bottled water in Aruba, the island's tap water is pure and refreshing, distilled in the world's second largest desalination plant...The plant is called the WEB, and there are many requests to tour the plant that is located in Balashi. www.aruba-tours.com.

Balashi is an area in Aruba that has historical significance because of its importance in the gold industry. It has present day significance, in part, because it is home to the world's second largest desalination plant. It is clear that the term identifies a significant geographic location in Aruba.

Applicant has argued that Balashi cannot be considered a geographic term because it identifies a small insignificant neighborhood. (Applicant's Brief at page 11). This is not persuasive. A term can be considered geographic even when it does not suggest exact geographic

boundaries, i.e., if it refers to a “subdivision of the earth – regions, nations, counties, town[s], rivers, lakes, and other natural and artificial geographic units.” *Burke-Parsons-Bowlby v. Appalachian Log Homes*, 871 F.2d 590, 594, 10 USPQ2d 1443, 1445 (6th Cir. 1989) (APPALACHIAN found to be a geographic term).

Applicant has argued that the term is not geographically descriptive because it identifies a cabbage and a remote location in Bangladesh. (Applicant’s Brief at page 16). The fact that a term may have other meanings in other contexts does not necessarily negate the basis for refusal as long as the most prominent meaning or significance is geographic for the identified goods. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986); TMEP §1210.02(b)(i). In this case, the primary significance of Balashi is geographic for the identified goods.

PURCHASERS ARE LIKELY TO MAKE A GOODS PLACE ASSOCIATION.

A *prima facie* showing that a public association exists between applicant’s goods and the geographic place named in the proposed mark is sufficient to support a refusal. The named geographic location need not be famous, but rather only likely to be associated with applicant’s goods. *See, e.g., In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

Applicant’s address of record indicates that it is located in Balashi. Several directories of record attached to the office action of July 20, 2005, demonstrate that applicant’s brewery is located in Balashi. Applicant has conceded that its beer production facility is located in Balashi. (Applicant’s Brief at page 7). In addition, the following is of record.

With the government’s decision to encourage all industries to move to **Balashi** and out of town, phase one was to get the brewery going, phase two, which will be completed in just three weeks, was to nix the old-fashioned bottling plant on the boulevard in favor of the new one. (See <http://www.visitaruba.com>. attached to the office action of 7/20/05).

Purchasers are likely to believe the goods will originate in that geographic location because applicant is located there. Thus there is a presumed goods place association in this case. *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982); TMEP §1210.04.

THE GOODS ORIGINATE IN BALASHI.

The beer is brewed in Balashi. For example, the following is of record attached to the office action of December 14, 2004.

In 1996, the news of the groundbreaking ceremony for a local brewery at **Balashi** surprised many who thought there cannot possibly be room on the already overexposed beer market here, for yet another brand...With an investment in excess of 20 million Aruban florins, **Meta Corp.** developers of the Seaport Village and the **Renaissance hotels** downtown collaborated with foreign German partners, on the proposed venture. They combined some of the best drinking water in the world with the latest German technology, to produce, you guessed, **Balashi**, a world class product for local consumption and export. (See <http://www.visitaruba.com>. attached to the office action of 7/20/05).

The evidence of record demonstrates that applicant’s beer originates in Balashi. Applicant has conceded this point. (Applicant’s Brief at page 7).

**THE ADDITION OF THE TERM BEER DOES NOT OBTAIN THE
GEOGRAPHIC DESCRIPTIVENESS.**

With respect to Application Serial Number 78/304942 for BALASHI BEER, it is important to note that the addition of a generic or merely descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. Applicant intends to use the mark on beer. Therefore, the addition of the generic term BEER does not change the geographic significance of Balashi.

THE TERM IS GEOGRAPHICALLY SIGNIFICANT TO BEER CONSUMERS.

Applicant has argued that Balashi is not geographic because it identifies a remote location. (Applicant's Brief at page 7). This is not persuasive. Remoteness or obscurity is determined from the perspective of the average American consumer. See *In re Societe Generale des Eaux Minerales de Vittel, S.A.*, 824 F.2d 957 3 USPQ2d 1450 (Fed. Cir. 1987). In this circumstance, the average American consumer would have ample reason to recognize Balashi as the geographic source for applicant's beer.

First, it is important to note that Aruba is an important travel destination for American tourists. The following, incorporated into the office action of July 20, 2005, is found at www.aruba.com under FAQ.

Where do tourists mainly come from? Aruba's largest tourism market is the US with 75% market share, followed by Latin America (Venezuela, Colombia) and Holland.

In addition, Aruba's airport facility is state-of-the-art and has special arrangements for visitors from the United States. For example, U.S. bound passengers have their own terminal building that houses a U.S. INS/Customs facility, allowing flights from Aruba to enter the U.S. as domestic flights. (See <http://www.aruba.com> attached to the office action of July 20, 2005). Accordingly, Aruba is a well-known and easily accessible destination to those in the United States.

Second, travel information for those visiting Aruba often makes reference to Balashi. For example, Balashi is listed as a worthwhile place to see. (See <http://www.odyssei.com/travel/aruba> attached to the office action of July 20, 2005). Those providing information about Aruba make reference to Balashi because of its historical significance to the gold industry. (See <http://www.lonelyplanet.com> attached to the office action of December 14, 2004). Those providing travel information also mention Balashi because the second largest desalination plant in the world is located in Balashi. (See <http://www.odyssei.com/travel-tips> attached to the office action of July 20, 2005). It has also been noted that there are many requests to tour this plant. (See <http://www.aruba-tours.com> attached to the office action of December 14, 2004). Therefore, those who travel to Aruba or are considering such travel will be exposed to information about Balashi.

In addition, readily available information about Balashi beer makes reference to the geographic origin of the name. For example, the following is of record.

Balashi National Brewery Inc. situated at Balashi, home of Aruba's largest gold smelting industry in the late nineteenth and early twentieth century, as well as for Aruba's world famous water production industry the WEB, is the newest addition to Aruba's broadening economic development... For many reasons and following beer tradition, the brewery was named after this well-known area. (See www.aruba-info.com attached to the office action of July 20, 2005).

...all of **Balashi** products will from now on be nicely stamped,
*Made in **Aruba***, bearing a little turquoise, yellow & red flag.
That should give the other importers a run for their money.

And you the consumer will be protected. You know where the stuff came from. www.visitaruba.com. attached to the office action of 7/25/05.

The following references an email communication between two apparently American beer consumers discussing the geographic origin of Balashi beer.

Author: **Bill Balaschi**

Recently had my first Balashi beer. Would like to know more about the name since it is so close to mine. What is the time frame for importing to the northeast?

Author: **Dee**

Well Jonathan, Keep us posted too. Great beer! The name Balashi, as we understand it, comes from a region of the island called Balashi. It is an Indian word from the original native settlers on the Island then going by the name (Ore Ruba). This is the info we received while in Aruba gained from reading and talking with the Islanders. (See <http://www.arubatravelinfo.com>. attached to the office action of July 20, 2005).

The following is also a reference to a web site clearly available to American beer consumers referencing Balashi beer and identifying it as brewed in Balashi, Aruba.

Join the #1 beer community in the world...Balashi – An adjunct lager brewed by Brower ij Nacional Balashi in Balashi, Aruba...(See <http://www.beeradvoocate.com>. attached to the office action of December 14, 2004).

All of this information demonstrates that Americans have easy access to Aruba, that Balashi is often mentioned in travel information for those visiting or reading about Aruba, that the geographic area named Balashi is known to be the source of the name for Balashi beer, and that Americans have reason to know this. Therefore, Balashi is not geographically remote or obscure from the perspective of the average American consumer of beer.

**A GEOGRAPHIC COMPONENT WITH SECONDARY MEANING
CAN BE REGISTERED UNDER SECTION 2(f).**

Applicant has made some confusing statements with regard to the examining attorney's advisory comments with respect to Section 2(f) of the Trademark Act. Applicant has stated that "[T]his is clear recognition of secondary meaning by the PTO. By definition, this means that the primary significance of the term BALASHI to American consumers is applicant's Balashi beer." (Applicant's Brief at pages 16-17). Therefore, applicant has argued that the term should be registered on the Principal Register with no reference to Section 2(f) of the Trademark Act.

A recognition that a term has secondary meaning means that a term may be registered on the Principal Register *under the provisions of Section 2(f) of the Trademark Act*. 15 U.S.C. Section 1052(f); TMEP section 1212. An applicant may claim that a geographic component of a mark has acquired distinctiveness under §2(f). Therefore, the applicant may seek to overcome the refusal under Trademark Act Section 2(e)(2) or a disclaimer requirement by submitting a showing that the geographic component has acquired distinctiveness under §2(f). If the applicant is able to establish to the satisfaction of the examining attorney that the geographic component has acquired distinctiveness, the examining attorney will approve the mark for publication with a notation that there is a claim of distinctiveness under §2(f) as to the geographic component, if appropriate. It does not mean, as applicant appears to be arguing, that a term that has acquired distinctiveness can then be registered without reference to Section 2(f) of the Trademark Act.

CONCLUSION

For the foregoing reasons, the examining attorney requests that the refusal to register the marks BALASHI and BALASHI BEER under Section 2(e)(2) of the Trademark Act because the marks are primarily geographically descriptive of the source of applicant's goods be affirmed.

Respectfully submitted,

/Kathleen M. Vanston/
Examining Attorney
Law Office 103
(571) 272-9235

Michael Hamilton
Managing Attorney
Law Office - 103

¹ If this refusal is reversed, the applicant will be required to enter a disclaimer of BEER apart from the mark as shown in Application Serial Number 78/304942, prior to the publication of the mark.

EXHIBIT 2

Generated on: This page was generated by TSDR on 2016-05-13 14:24:05 EDT

Mark: BALASHI

US Serial Number: 78304953

Application Filing Date: Sep. 24, 2003

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



DEAD/APPLICATION/Refused/Dismissed or Invalidated

This trademark application was refused, dismissed, or invalidated by the Office and this application is no longer active.

Status:

Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Jul. 24, 2008

Publication Date: Oct. 31, 2006

Notice of Allowance Date: Jan. 23, 2007

Date Abandoned: Jul. 24, 2008

Mark Information

Mark Literal Elements: BALASHI

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (...) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Beer

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No

Filed ITU: Yes

Filed 44D: No

Filed 44E: No

Filed 66A: No

Currently Use: No

Currently ITU: Yes

Currently 44D: No

Currently 44E: No

Currently 66A: No

Amended Use: No

Amended ITU: No

Amended 44D: No

Amended 44E: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi NV

Owner Address: Balashi Z/N
P.O. Box 145
Dutch West Indies ARUBA

Legal Entity Type: CORPORATION

State or Country ARUBA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Leslie J. Lott

Docket Number: 02104-1-8010

Correspondent

Correspondent Name/Address: LESLIE J LOTT
LOTT & FRIEDLAND, PA
PO DRAWER 141098
CORAL GABLES, FLORIDA UNITED STATES 33114-1098

Phone: 305-448-7089

Fax: 305-446-6191

Domestic Representative

Domestic Representative Name: Lott & Friedland, P.A.

Phone: 305-448-7089

Fax: 305-446-6191

Prosecution History

Date	Description	Proceeding Number
Sep. 25, 2008	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Sep. 25, 2008	ABANDONMENT - NO USE STATEMENT FILED	48500
Feb. 12, 2008	EXTENSION 2 GRANTED	76569
Jan. 23, 2008	EXTENSION 2 FILED	76569
Jan. 23, 2008	TEAS EXTENSION RECEIVED	
Jul. 23, 2007	EXTENSION 1 GRANTED	98765
Jul. 23, 2007	EXTENSION 1 FILED	98765
Jul. 23, 2007	TEAS EXTENSION RECEIVED	
Jan. 23, 2007	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 31, 2006	PUBLISHED FOR OPPOSITION	
Oct. 11, 2006	NOTICE OF PUBLICATION	
Sep. 15, 2006	LAW OFFICE PUBLICATION REVIEW COMPLETED	68552
Sep. 08, 2006	ASSIGNED TO LIE	68552
Sep. 06, 2006	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 06, 2006	ASSIGNED TO EXAMINER	68356
Aug. 02, 2006	EX PARTE APPEAL-REFUSAL REVERSED	304953
Dec. 14, 2005	EXAMINERS STATEMENT MAILED	
Dec. 14, 2005	EXAMINERS STATEMENT - COMPLETED	68356
Dec. 06, 2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY	304953
Jul. 20, 2005	ACTION DENYING REQ FOR RECON MAILED	
Jul. 20, 2005	ACTION CONTINUING FINAL - COMPLETED	68356
Jun. 21, 2005	EX PARTE APPEAL-INSTITUTED	304953
Jun. 21, 2005	JURISDICTION RESTORED TO EXAMINING ATTORNEY	304953
Jun. 20, 2005	AMENDMENT FROM APPLICANT ENTERED	76539
Jun. 14, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	76539
Jun. 14, 2005	PAPER RECEIVED	
Dec. 14, 2004	FINAL REFUSAL MAILED	
Dec. 14, 2004	FINAL REFUSAL WRITTEN	68356

Nov. 06, 2004	AMENDMENT FROM APPLICANT ENTERED	76539
Oct. 21, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	76539
Oct. 21, 2004	PAPER RECEIVED	
Apr. 21, 2004	NON-FINAL ACTION MAILED	
Apr. 18, 2004	ASSIGNED TO EXAMINER	68356

TM Staff and Location Information

TM Staff Information

TM Attorney: VANSTON, KATHLEEN MARY

Law Office Assigned: LAW OFFICE 103

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Feb. 08, 2008

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Exparte Appeal

Proceeding Number: 78304953

Filing Date: Jun 13, 2005

Status: Terminated

Status Date: Nov 06, 2006

Interlocutory Attorney:

Plaintiff(s)

Name: Brouwerij Nacional Balashi NV

Correspondent Address: Leslie J. Lott
LOTT & FRIEDLAND, P.A.
P.O. Drawer 141098
Coral Gables FL UNITED STATES , 33114-1098

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI	Abandoned - No Statement Of Use Filed	<u>78304953</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	APPEAL TO BOARD	Jun 13, 2005	
2	APPEAL ACKNOWLEDGED; CASE REMANDED	Jun 21, 2005	
3	PENDING, INSTITUTED	Jun 21, 2005	
4	RECONSIDERATION DENIED	Jul 20, 2005	
5	PROCEEDINGS RESUMED	Aug 03, 2005	
6	OTHER FILING	Aug 11, 2005	
7	BRIEF DUE: 60-DAYS.	Aug 18, 2005	
8	APPEAL BRIEF	Oct 13, 2005	
9	APPEAL FORWARDED TO EXAMINER FOR BRIEF	Dec 06, 2005	
10	REPLY BRIEF	Jan 03, 2006	
11	EXAMINER'S STATEMENT	Dec 14, 2005	
12	MEMO FORWARDING REPLY BRIEF	Jan 24, 2006	
13	SUBMITTED ON BRIEF	Mar 17, 2006	
14	BOARD'S DECISION: REVERSED	Aug 02, 2006	
15	TERMINATED	Oct 31, 2006	
16	TERMINATED	Nov 06, 2006	

EXHIBIT 3

Generated on: This page was generated by TSDR on 2016-05-13 14:26:03 EDT

Mark: BALASHI



US Serial Number: 78365654

Application Filing Date: Feb. 10, 2004

Register: Principal

Mark Type: Trademark

Status: Abandoned because no Statement of Use or Extension Request timely filed after Notice of Allowance was issued. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Apr. 21, 2008

Publication Date: Jan. 24, 2006

Notice of Allowance Date: Apr. 18, 2006

Date Abandoned: Apr. 21, 2008

Mark Information

Mark Literal Elements: BALASHI

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of an oval bisected by a ribbon containing the letters BALASHI, all superimposed over a square. The design of an island and a compass-point symbol appear in the center of the oval.

Color Drawing: Yes

Color(s) Claimed: The color(s) black, blue, red, white, green and gold is/are claimed as a feature of the mark.

Color Location: The mark consists of an oval bisected by a ribbon containing the letters BALASHI, all superimposed over a square. The design of an island and a compass-point symbol appear in the center of the oval. The color black appears in the oval design, shadows the letters BALASHI, shadows the island design, appears in the compass-point symbol, and appears in the letter N above the north compass point of the compass-point symbol. The color blue appears in the center of the oval. The color red appears on the front of the ribbon which bisects the oval and in the compass-point symbol. The color white appears in the letters BALASHI, on the back of the ribbon, and outlining the oval. The color green appears in the square upon which the oval design is superimposed. The color gold appears in the island design in the center of the oval and outlining the green square.

Disclaimer: "the representation of the island of Aruba, the compass and the directional letter "N"

Design Search Code(s): 01.17.09 - Maps of countries other than the United States

17.07.05 - Directional compasses, including mariner's compasses and compass points; Compasses (directional)

24.09.07 - Banners; Advertising, banners

26.03.11 - Ovals comprised of plants; Ovals comprised of letters or numerals; Ovals comprised of humans; Ovals comprised of geometric figures; Ovals comprised of animals; Ovals comprised of punctuation; Letters, numerals, punctuation, geometric figures, objects, humans, plants or animals comprising an oval

26.03.17 - Concentric ovals; Ovals, concentric; Ovals within ovals; Concentric ovals and ovals within ovals

26.03.21 - Ovals that are completely or partially shaded

26.09.03 - Incomplete squares; Squares, incomplete

26.09.08 - Squares comprised of letters, numerals or punctuation and letters, numerals or punctuation forming the perimeter of a square or bordering the perimeter of a square

26.09.09 - Squares made of geometric figures, objects, humans, plants or animals

26.09.20 - Squares inside one another

26.09.21 - Squares that are completely or partially shaded

26.11.08 - Rectangles comprised of letters, numerals or punctuation and letters, numerals or punctuation forming the perimeter of a rectangle or bordering the perimeter of a rectangle.

26.11.21 - Rectangles that are completely or partially shaded

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Beer

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi NV

Owner Address: Balashi Z/N P.O. Box 145
Aruba
ARUBA

Legal Entity Type: CORPORATION

State or Country Where Organized: ARUBA

Attorney/Correspondence Information

Attorney Name: Leslie J. Lott	Attorney of Record
	Docket Number: 02104-1-8030
	Correspondent
Correspondent Name/Address: LESLIE J LOTT LOTT & FRIEDLAND PA PO DRAWER 141098 CORAL GABLES, FLORIDA 33114-1098 UNITED STATES	
Phone: 305-448-7089	Fax: 305-446-6191
	Domestic Representative
Domestic Representative Name: Lott & Friedland, P.A.	Phone: 305-448-7089
Fax: 305-446-6191	

Prosecution History

Date	Description	Proceeding Number
Jun. 26, 2008	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Jun. 26, 2008	ABANDONMENT - NO USE STATEMENT FILED	48494
Nov. 03, 2007	EXTENSION 3 GRANTED	69302
Oct. 18, 2007	EXTENSION 3 FILED	69302
Oct. 19, 2007	PAPER RECEIVED	
Oct. 18, 2007	EXTENSION 2 GRANTED	61813
Apr. 17, 2007	EXTENSION 2 FILED	61813
Apr. 17, 2007	TEAS EXTENSION RECEIVED	
Jul. 21, 2006	EXTENSION 1 GRANTED	98765

Jul. 21, 2006	EXTENSION 1 FILED	98765
Jul. 21, 2006	TEAS EXTENSION RECEIVED	
May 31, 2006	ASSIGNED TO EXAMINER	76508
Apr. 18, 2006	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jan. 24, 2006	PUBLISHED FOR OPPOSITION	
Jan. 04, 2006	NOTICE OF PUBLICATION	
Dec. 14, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	73787
Dec. 05, 2005	ASSIGNED TO LIE	73787
Sep. 09, 2005	ASSIGNED TO LIE	73859
Aug. 29, 2005	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 19, 2005	TEAS/EMAIL CORRESPONDENCE ENTERED	73859
Aug. 15, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	73859
Aug. 15, 2005	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 09, 2005	FINAL REFUSAL MAILED	
May 06, 2005	FINAL REFUSAL WRITTEN	76468
Apr. 16, 2005	AMENDMENT FROM APPLICANT ENTERED	70217
Mar. 09, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	70217
Mar. 09, 2005	PAPER RECEIVED	
Sep. 08, 2004	NON-FINAL ACTION MAILED	
Sep. 07, 2004	NON-FINAL ACTION WRITTEN	76468
Sep. 01, 2004	ASSIGNED TO EXAMINER	76468
Mar. 12, 2004	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	
Mar. 12, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 12, 2004	TEAS VOLUNTARY AMENDMENT RECEIVED	
Feb. 23, 2004	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Attorney: MACIOL, GENE V J

TM Staff Information

Law Office LAW OFFICE 103
Assigned:

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Oct. 25, 2007

EXHIBIT 4

Generated on: This page was generated by TSDR on 2016-05-13 14:34:36 EDT

Mark: BALASHI PREMIUM BEER BREWED IN ARUBA



US Serial Number: 86701463

Application Filing Date: Jul. 22, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 03, 2015

Mark Information

Mark Literal Elements: BALASHI PREMIUM BEER BREWED IN ARUBA

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: 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.

Color Drawing: Yes

Color(s) Claimed: The color(s) Green, red, white, black is/are claimed as a feature of the mark.

Design Search Code(s): 24.09.07 - Advertising, banners; Banners

26.01.08 - Circles having letters or numerals as a border; Circles having punctuation as a border; Letters, numerals or punctuation forming or bordering the perimeter of a circle

26.17.01 - Bands, straight; Bars, straight; Straight line(s), band(s) or bar(s); Lines, straight

26.17.05 - Bands, horizontal; Horizontal line(s), band(s) or bar(s); Bars, horizontal; Lines, horizontal

Foreign Information

Foreign Registration Number: 29411

Foreign Registration Date: Jun. 07, 2011

Application/Registration Country: Foreign ARUBA

Foreign Expiration Date: Mar. 30, 2021

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Clothing, footwear, headgear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 44(e)

For: Beer
International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 44(e)

For: Advertising

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi N.V.

Owner Address: Balashi #62, St. Cruz
Santa Cruz
ARUBA

Legal Entity Type: naamloze vennootschap (nv)

State or Country Where Organized: ARUBA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ashley G. Kessler

Docket Number: 1918 - Balas

Attorney Primary Email Address: trademarks@feldmangale.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: ASHLEY G. KESSLER
Feldman Gale Pa
1 Biscayne Tower Fl 30
Miami, FLORIDA 33131-1806
UNITED STATES

Phone: 305.358.5001

Fax: 305.358.3309

Correspondent e-mail: trademarks@feldmangale.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 03, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 03, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION WRITTEN	81112
Nov. 02, 2015	ASSIGNED TO EXAMINER	81112
Jul. 30, 2015	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jul. 29, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 25, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: HUSSAIN, TASNEEM

Law Office LAW OFFICE 118
Assigned:

File Location

Current Location: TMO LAW OFFICE 118- EXAMINING
ATTORNEY ASSIGNED

Date in Location: Nov. 03, 2015

Proceedings

Summary

Number of 1
Proceedings:

Type of Proceeding: Opposition

Proceeding Number: 91223456

Filing Date: Aug 24, 2015

Status: Pending

Status Date: Aug 24, 2015

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: t & beer, inc

Correspondent Address: GREGORY J WINSKY
ARCHER & GREINER PC
ONE CENTENNIAL SQUARE, PO BOX 3000
HADDONFIELD NJ , 08033
UNITED STATES

Correspondent e-mail: trademarks@archerlaw.com , t.simone@prodigy.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI SPIRITS	Opposition Pending Plaintiff(s)	<u>86566095</u>	

Name: Brouwerij Nacional Balashi NV

Correspondent Address: SUSAN J LATHAM
FELDMAN GALE PA
2 SOUTH BISCAYNE BOULEVARD ONE BISCAYNE TOWER, 30TH FLOOR
MIAMI FL , 33131
UNITED STATES

Correspondent e-mail: trademarks@feldmangale.com, slatham@feldmangale.com, jfeldman@feldmangale.com, akessler@feldmangale.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI PREMIUM BEER 11.27 FL OZ (333.3ML)	Non-Final Action - Mailed	<u>86701463</u>	
BALASHI PREMIUM BEER 20CT. BOTTLE VOLUME CONTENTS 22 CL 5.0% ALC/VOL	Non-Final Action - Mailed	<u>86701470</u>	
BALASHI PREMIUM BEER ARUBA'S BEER	Non-Final Action - Mailed	<u>86701475</u>	
	Suspension Letter - Mailed	<u>86734984</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 24, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 24, 2015	Oct 03, 2015
3	PENDING, INSTITUTED	Aug 24, 2015	
4	ANSWER	Oct 02, 2015	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 05, 2016	
6	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 08, 2016	
7	P MOT FOR SUMMARY JUDGMENT	Mar 21, 2016	

8	Confidential Plaintiff's Summary Judgment	Mar 21, 2016
9	P NOTICE OF FILING EXHIBITS	Mar 21, 2016
10	D REPLY BRIEF IN FURTHER SUPPORT OF D MOT FOR JUDGMENT ON THE PLEADINGS	Apr 05, 2016
11	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 13, 2016

EXHIBIT 5

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Mark: BALASHI PREMIUM BEER BREWED IN ARUBA BROUWERIJ
NACIONAL BALASHI N.V.



US Serial Number: 86701470

Application Filing Date: Jul. 22, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 03, 2015

Mark Information

Mark Literal Elements: BALASHI PREMIUM BEER BREWED IN ARUBA BROUWERIJ NACIONAL BALASHI N.V.

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: 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.

Color Drawing: Yes

Color(s) Claimed: The color(s) blue, white, red, dark green, light green and yellow is/are claimed as a feature of the mark.

Design Search Code(s): 01.15.25 - Light rays; Dust; Spilling liquids; Sand; Pouring liquids; Liquids, spilling; Coal
05.01.25 - Willow tree; Cypress tree; Other trees or bushes
06.03.01 - Coastlines; Beaches; Shores
24.09.07 - Advertising, banners; Banners
26.03.17 - Concentric ovals; Ovals, concentric; Ovals within ovals; Concentric ovals and ovals within ovals
26.03.21 - Ovals that are completely or partially shaded
26.09.21 - Squares that are completely or partially shaded
26.09.25 - Squares with curved sides

Foreign Information

Foreign Registration Number: 29412

Foreign Registration Date: Jun. 07, 2011

Application/Registration Country: ARUBA

Foreign Expiration Date: Mar. 30, 2021

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Clothing, footwear, headgear

International 025 - Primary Class
Class(es):

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 44(e)

For: Beer

International 032 - Primary Class
Class(es):

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 44(e)

For: Advertising

International 035 - Primary Class
Class(es):

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: Yes

Currently 44E: Yes

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi N.V.

Owner Address: Balashi #62, St. Cruz
Santa Cruz
ARUBA

Legal Entity Type: naamloze vennootschap (nv)

State or Country ARUBA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ashley G. Kessler

Docket Number: 1918 - Balas

Attorney Primary Email Address: trademarks@feldmangale.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: ASHLEY G. KESSLER
Feldman Gale P A
1 Biscayne Tower Fl 30
Miami, FLORIDA 33131-1806
UNITED STATES

Phone: 305.358.5001

Fax: 305.358.3309

Correspondent e-mail: trademarks@feldmangale.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 03, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 03, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION WRITTEN	81112

Nov. 02, 2015 ASSIGNED TO EXAMINER
 Jul. 30, 2015 NOTICE OF DESIGN SEARCH CODE E-MAILED
 Jul. 29, 2015 NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM
 Jul. 25, 2015 NEW APPLICATION ENTERED IN TRAM

81112

TM Staff and Location Information

TM Staff Information

TM Attorney: HUSSAIN, TASNEEM

Law Office LAW OFFICE 118
 Assigned:

File Location

Current Location: TMO LAW OFFICE 118- EXAMINING
 ATTORNEY ASSIGNED

Date in Location: Nov. 03, 2015

Proceedings

Summary

Number of 1
 Proceedings:

Type of Proceeding: Opposition

Proceeding 91223456
 Number:

Filing Date: Aug 24, 2015

Status: Pending

Status Date: Aug 24, 2015

Interlocutory ELIZABETH A DUNN
 Attorney:

Defendant

Name: t & beer, inc

Correspondent GREGORY J WINSKY
 Address: ARCHER & GREINER PC
 ONE CENTENNIAL SQUARE, PO BOX 3000
 HADDONFIELD NJ , 08033
 UNITED STATES

Correspondent e-mail: trademarks@archerlaw.com , t.simone@prodigy.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI SPIRITS	Opposition Pending Plaintiff(s)	<u>86566095</u>	

Name: Brouwerij Nacional Balashi NV

Correspondent SUSAN J LATHAM
 Address: FELDMAN GALE PA
 2 SOUTH BISCAYNE BOULEVARD ONE BISCAYNE TOWER, 30TH FLOOR
 MIAMI FL , 33131
 UNITED STATES

Correspondent e-mail: trademarks@feldmangale.com, slatham@feldmangale.com, jfeldman@feldmangale.com, akessler@feldmangale.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI PREMIUM BEER 11.27 FL OZ (333.3ML)	Non-Final Action - Mailed	<u>86701463</u>	
BALASHI PREMIUM BEER 20CT. BOTTLE VOLUME CONTENTS 22 CL 5.0% ALC/VOL	Non-Final Action - Mailed	<u>86701470</u>	
BALASHI PREMIUM BEER ARUBA'S BEER	Non-Final Action - Mailed	<u>86701475</u>	
	Suspension Letter - Mailed	<u>86734984</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 24, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 24, 2015	Oct 03, 2015
3	PENDING, INSTITUTED	Aug 24, 2015	

4	ANSWER	Oct 02, 2015
5	D MOT TO DISMISS: FRCP 12(B)	Mar 05, 2016
6	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 08, 2016
7	P MOT FOR SUMMARY JUDGMENT	Mar 21, 2016
8	Confidential Plaintiff's Summary Judgment	Mar 21, 2016
9	P NOTICE OF FILING EXHIBITS	Mar 21, 2016
10	D REPLY BRIEF IN FURTHER SUPPORT OF D MOT FOR JUDGMENT ON THE PLEADINGS	Apr 05, 2016
11	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 13, 2016

EXHIBIT 6

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Mark: BALASHI PREMIUM BEER ARUBA'S BEER



US Serial Number: 86701475

Application Filing Date: Jul. 22, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Nov. 03, 2015

Mark Information

Mark Literal Elements: BALASHI PREMIUM BEER ARUBA'S BEER

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

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.

Color Drawing: Yes

Color(s) Claimed: The color(s) Red, white and black is/are claimed as a feature of the mark.

Design Search Code(s): 24.09.07 - Banners; Advertising, banners

Foreign Information

Foreign Registration Number: 29417

Foreign Registration Date: Jun. 07, 2011

Foreign Application/Registration Country: ARUBA

Foreign Expiration Date: Mar. 30, 2021

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (...) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Clothing, footwear, headgear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 44(e)

For: Beer

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class(es):
Class Status: ACTIVE
Basis: 44(e)
For: Advertising
International Class(es): 035 - Primary Class
Class Status: ACTIVE
Basis: 44(e)

U.S Class(es): 100, 101, 102

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi N.V.
Owner Address: Balashi #62, St. Cruz
Santa Cruz
ARUBA
Legal Entity Type: naamloze vennootschap (nv)
State or Country Where Organized: ARUBA

Attorney/Correspondence Information

Attorney Name: Ashley G. Kessler
Attorney Primary Email Address: trademarks@feldmangale.com
Attorney of Record Docket Number: 1918 - Balas
Attorney Email Authorized: Yes
Correspondent Name/Address: ASHLEY G. KESSLER
Feldman Gale P A
1 Biscayne Tower Fl 30
Miami, FLORIDA 33131-1806
UNITED STATES
Phone: 305.358.5001
Fax: 305.358.3309
Correspondent e-mail: trademarks@feldmangale.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 03, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 03, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION WRITTEN	81112
Nov. 02, 2015	ASSIGNED TO EXAMINER	81112
Jul. 30, 2015	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jul. 29, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jul. 25, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff information

TM Attorney: HUSSAIN, TASNEEM

Law Office LAW OFFICE 118
Assigned:**File Location**Current Location: TMO LAW OFFICE 118- EXAMINING
ATTORNEY ASSIGNED

Date in Location: Nov. 03, 2015

Proceedings**Summary**Number of 1
Proceedings:**Type of Proceeding: Opposition**

Proceeding Number: 91223456

Filing Date: Aug 24, 2015

Status: Pending

Status Date: Aug 24, 2015

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: t & beer, inc

Correspondent Address: GREGORY J WINSKY
ARCHER & GREINER PC
ONE CENTENNIAL SQUARE, PO BOX 3000
HADDONFIELD NJ , 08033
UNITED STATESCorrespondent e-mail: trademarks@archerlaw.com , t.simone@prodiqy.net**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BALASHI SPIRITS	Opposition Pending Plaintiff(s)	<u>86566095</u>	

Name: Brouwerij Nacional Balashi NV

Correspondent Address: SUSAN J LATHAM
FELDMAN GALE PA
2 SOUTH BISCAYNE BOULEVARD ONE BISCAYNE TOWER, 30TH FLOOR
MIAMI FL , 33131
UNITED STATESCorrespondent e-mail: trademarks@feldmangale.com, slatham@feldmangale.com, jfeldman@feldmangale.com, akessler@feldmangale.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BALASHI PREMIUM BEER 11.27 FL OZ (333.3ML)	Non-Final Action - Mailed	<u>86701463</u>	
BALASHI PREMIUM BEER 20CT. BOTTLE VOLUME CONTENTS 22 CL 5.0% ALC/VOL	Non-Final Action - Mailed	<u>86701470</u>	
BALASHI PREMIUM BEER ARUBA'S BEER	Non-Final Action - Mailed	<u>86701475</u>	
	Suspension Letter - Mailed	<u>86734984</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 24, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 24, 2015	Oct 03, 2015
3	PENDING, INSTITUTED	Aug 24, 2015	
4	ANSWER	Oct 02, 2015	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 05, 2016	
6	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 08, 2016	
7	P MOT FOR SUMMARY JUDGMENT	Mar 21, 2016	
8	Confidential Plaintiff's Summary Judgment	Mar 21, 2016	
9	P NOTICE OF FILING EXHIBITS	Mar 21, 2016	

10

D REPLY BRIEF IN FURTHER SUPPORT OF D MOT FOR JUDGMENT ON THE PLEADINGS

Apr 05, 2016

11

SUSP PEND DISP OF OUTSTNDNG MOT

Apr 13, 2016

EXHIBIT 7

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Mark: BALASHI

BALASHI

US Serial Number: 86734984

Application Filing Date: Aug. 24, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: May 05, 2016

Mark Information

Mark Literal: BALASHI

Elements:

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Translation: The wording BALASHI has no meaning in a foreign language.

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks * . * identify additional (new) wording in the goods/services.

For: Beer

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1999

Use in Commerce: Nov. 01, 2004

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Brouwerij Nacional Balashi, N.V.

Owner Address: Balashi #62 St. Cruz
Santa Cruz
ARUBA

Legal Entity Type: naamloze vennootschap (nv)

State or Country Where Organized: ARUBA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Susan J. Latham
Attorney Primary Email Address: trademarks@feldmangale.com

Docket Number: 1918 - Brouw

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: SUSAN J. LATHAM
Feldman Gale P A
1 Biscayne Tower Fl 30
Miami, FLORIDA 33131-1806
UNITED STATES

Phone: 305.358.5001

Fax: 305.358.3309

Correspondent e-mail: trademarks@feldmangale.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 05, 2016	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
May 05, 2016	LETTER OF SUSPENSION E-MAILED	6332
May 05, 2016	SUSPENSION LETTER WRITTEN	81112
May 03, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 03, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 03, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 03, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION E-MAILED	6325
Nov. 03, 2015	NON-FINAL ACTION WRITTEN	81112
Nov. 02, 2015	ASSIGNED TO EXAMINER	81112
Aug. 27, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 27, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: HUSSAIN, TASNEEM

Law Office Assigned: LAW OFFICE 118

File Location

Current Location: TMO LAW OFFICE 118- EXAMINING ATTORNEY ASSIGNED

Date in Location: May 05, 2016

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: 91223456

Filing Date: Aug 24, 2015

Status: Pending

Status Date: Aug 24, 2015

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: t & beer, inc

Correspondent Address: GREGORY J WINSKY
ARCHER & GREINER PC
ONE CENTENNIAL SQUARE, PO BOX 3000

HADDONFIELD NJ , 08033
UNITED STATES

Correspondent e-mail: trademarks@archerlaw.com , t.simone@prodigy.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI SPIRITS	Opposition Pending Plaintiff(s)	<u>86566095</u>	

Name: Brouwerij Nacional Balashi NV

Correspondent SUSAN J LATHAM
Address: FELDMAN GALE PA
2 SOUTH BISCAYNE BOULEVARD ONE BISCAYNE TOWER, 30TH FLOOR
MIAMI FL , 33131
UNITED STATES

Correspondent e-mail: trademarks@feldmangale.com, slatham@feldmangale.com, jfeldman@feldmangale.com, akesstler@feldmangale.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
BALASHI PREMIUM BEER 11.27 FL OZ (333.3ML)	Non-Final Action - Mailed	<u>86701463</u>	
BALASHI PREMIUM BEER 20CT. BOTTLE VOLUME CONTENTS 22 CL 5.0% ALC/VOL	Non-Final Action - Mailed	<u>86701470</u>	
BALASHI PREMIUM BEER ARUBA'S BEER	Non-Final Action - Mailed	<u>86701475</u>	
	Suspension Letter - Mailed	<u>86734984</u>	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 24, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 24, 2015	Oct 03, 2015
3	PENDING, INSTITUTED	Aug 24, 2015	
4	ANSWER	Oct 02, 2015	
5	D MOT TO DISMISS: FRCP 12(B)	Mar 05, 2016	
6	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 08, 2016	
7	P MOT FOR SUMMARY JUDGMENT	Mar 21, 2016	
8	Confidential Plaintiff's Summary Judgment	Mar 21, 2016	
9	P NOTICE OF FILING EXHIBITS	Mar 21, 2016	
10	D REPLY BRIEF IN FURTHER SUPPORT OF D MOT FOR JUDGMENT ON THE PLEADINGS	Apr 05, 2016	
11	SUSP PEND DISP OF OUTSTNDNG MOT	Apr 13, 2016	

EXHIBIT 8

Mailed:

**THIS DISPOSITION IS
CITABLE AS PRECEDENT
OF THE TTAB**

August 2, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brouwerij Nacional Balashi NV

Serial No. 78304942

Serial No. 78304953

Leslie J. Lott and Janet C. Moreira of Lott & Friedland, P.A. for
Brouwerij Nacional Balashi NV.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Hohein and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Brouwerij Nacional Balashi NV, a corporation of Aruba
located in the Balashi neighborhood of the Santa Cruz District of
Aruba, has filed applications to register, in standard character
form on the Principal Register, the marks "BALASHI BEER"¹ and
"BALASHI"² for, in each instance, "beer" in International Class
32.

Registration in each case has been finally refused
under Section 2(e)(2) of the Trademark Act, 15 U.S.C.

¹ Ser. No. 78304942, filed on September 24, 2003, which is based on an
allegation of a bona fide intention to use the mark in commerce. The
word "BEER" is disclaimed.

² Ser. No. 78304953, filed on September 24, 2003, which is based on an
allegation of a bona fide intention to use the mark in commerce.

Ser. Nos. 78304942 and 78304953

§1052(e)(2), on the ground that, as applied to applicant's goods, the marks "BALASHI BEER" and "BALASHI" are primarily geographically descriptive of beer.

Applicant, in each instance, has appealed and, at applicant's request, the appeals have been consolidated inasmuch as the issues presented are essentially identical. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register in each case.

As a general proposition, in order for registration of a mark to be properly refused on the ground that it is primarily geographically descriptive of an applicant's goods or services, it is necessary to establish (i) that the primary significance of the mark is that of the name of a place generally known to the public and (ii) that the public would make a goods/place or services/place association, that is, believe that the goods or services for which the mark is sought to be registered originate in that place. See, e.g., *In re JT Tobacconists*, 59 USPQ2d 1080, 1091-82 (TTAB 2001); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1402 (TTAB 1994); and *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1705 (TTAB 1988), *citing* *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987). Provided that these conditions are met, and the goods or services come from the place named by or in the mark, the mark is primarily geographically descriptive.

Moreover, where there is no genuine issue that the geographical significance of a term is its primary significance,

Ser. Nos. 78304942 and 78304953

and where the geographical place named by the term is neither obscure nor remote, a public association of the goods or services with the place may ordinarily be presumed from the fact that the applicant's goods or services come from the geographical place named by or in the mark. See, e.g., In re JT Tobacconists, supra at 1082; In re Carolina Apparel, 48 USPQ2d 1542, 1543 (TTAB 1998); In re California Pizza Kitchen Inc., supra; and In re Handler Fenton Westerns, Inc., 214 USPQ 848, 850 (TTAB 1982). In addition, the presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole. See, e.g., In re JT Tobacconists, supra at 1082; In re Carolina Apparel, supra; In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986); and In re BankAmerica Corp., 231 USPQ 873, 875 (TTAB 1986).

However, "if ... there exists a genuine issue raised that the place named [by or] in the mark is so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods [or services]," In re Societe Generale des Eaux Minerales de Vittel S.A., supra at 3 USPQ2d 1451, the Examining Attorney must furnish evidence sufficient to establish a public association of the goods or services with that place. Id. The determination of such a goods/place or services/place association is not made in the abstract, but rather in connection with the goods or services with which the mark is used and from the perspective of the relevant purchasing public for those goods or services. See,

Ser. Nos. 78304942 and 78304953

e.g., In re MCO Properties Inc., 38 USPQ2d 1154, 1156 (TTAB 1995). As our primary reviewing court noted in In re Societe Generale des Eaux Minerales de Vittel S.A., supra at 3 USPQ2d 1451, which involved an application to register the mark "VITTEL" and bottle design for, *inter alia*, cosmetic products and an evidentiary record "show[ing] that Vittel is the name of a town in northeastern France in the Department of Voges, in the Voges mountains, which, in about 1962, had a population of 5475, had cold mineral water springs, and was known as a watering place, spa and resort":

In dealing with all of these questions of the public's response to word symbols, we are dealing with the supposed reactions of a segment of the American public, in this case the mill-run of cosmetics purchasers, not with the unusually well-traveled, the aficionados of European watering places, or with computer operators checking out the meaning of strange words on NEXIS.

Id. at 3 USPQ2d 1452.

The Examining Attorney argues in her brief that, as applicant has conceded, the term "Balashi" identifies a geographic location in Aruba. Citing certain websites containing tourism information about Aruba, she accurately observes that the record shows that, "[h]istorically, Balashi was the center of the gold mining and gold smelting industry in Aruba" and that, "[p]resently, Balashi is the site [of] a large desalination plant." From such facts, she contends that:

Balashi is an area in Aruba that has historical significance because of its importance in the gold industry. It has present day significance, in part, because it is home to the world's second largest

desalination plant. It is clear that the term identifies a significant geographic location in Aruba.

Further, in response to applicant's argument that the primary significance of the term "Balashi" cannot be geographical because it identifies a small, insignificant neighborhood in Aruba which, except for applicant's brewery and the government operated desalination plant, is otherwise essentially devoid of any meaningful commercial activity, the Examining Attorney asserts that such argument "is not persuasive" for the reason that "[a] term can be considered geographic even when it does not suggest exact geographic boundaries, i.e., if it refers to a 'subdivision of the earth--regions, counties, town[s], rivers, lakes, and other artificial geographic units,'" citing *Burke-Parsons-Bowlby v. Appalachian Log Homes*, 871 F.2d 590, 10 USPQ2d 1443, 1445 (6th Cir. 1989).

As to applicant's argument that the term "Balashi" is not primarily geographically descriptive because the record shows that it has other meanings in that it also identifies a variety of cabbage and a location in Bangladesh, the Examining Attorney maintains that:³

³ The Examining Attorney, in her brief, accurately observes in addition that applicant, in its initial brief, "has made some confusing statements with regard to the examining attorney's advisory comments with respect to Section 2(f) of the Trademark Act," 15 U.S.C. 1052(f). Specifically, in her July 20, 2005 denials of applicant's requests for reconsideration of the final refusal in each of these appeals, the Examining Attorney in each instance stated, among other things, that:

Applicant's arguments seem to address the issue of acquired distinctiveness. If applicant were to file an allegation of use, applicant would be able to seek registration under Section 2(f) of the Trademark Act. Given the amount of evidence demonstrating that the term has

The fact that a term may have other meanings in other contexts does not necessarily negate the basis for refusal as long as the most prominent meaning or significance is geographic for the identified goods. *In re*

secondary meaning, applicant would be able to register the mark on that basis.

Seizing upon the latter statements, and noting that "[i]f a mark with a geographical meaning also has popular significance apart from the geographical meaning, it will not be **primarily** geographical" (emphasis in original), citing *In re International Taste Inc.*, 53 USPQ2d 1604, 1605-06 (TTAB 2000), applicant in its initial brief argues that (emphasis in original):

There is evidence of record to show that "Balashi" has alternative non-geographical meanings, i.e. that the term refers to a type of cabbage and also to a remote location in Bangladesh. However, applicant calls this Board's attention to the more compelling and overwhelming evidence of record which is that **U.S consumers of beer primarily identify "Balashi" with Applicant.**

Applicant has been in business since 1999. In the six (6) years Applicant has been in business, Applicant has not advertised, promoted, or shipped any **BALASHI** products to the United States. Nevertheless, the evidence supports a finding that the mark **BALASHI** has acquired secondary meaning to purchasers in the United States. **Even the Examiner agrees that if Applicant were to file an allegation of use, Applicant would be able to seek registration under Section 2(f).** July 20, 2004 [sic; 2005] Office Actions, p. 2. The Examiner states, "Given the amount of evidence demonstrating that the term has secondary meaning, applicant would be able to register the mark on that basis." *Id.* This is clear recognition of secondary meaning by the PTO. By definition, this means that the **primary significance** of the term "Balashi" to American consumers is Applicant's **BALASHI** beer.

Applicant insists in its reply brief, however, that "[t]he Examiner mischaracterizes Applicant's position with regard to registrability and Section 2(f) of the Trademark Act," asserting that "Applicant's arguments have made no reference to Section 2(f) whatsoever" notwithstanding that the gist of its further comments is to reiterate its argument concerning acquired distinctiveness, i.e., "secondary meaning." Applicant plainly is confusing marks which are not primarily geographical because of other prominent, significant meanings (e.g., in mark "HOLLYWOOD FRIES" and design for "french fries" and "fast food restaurants," term "HOLLYWOOD" also refers to the entertainment industry in general and not just to a geographical location, *id.* at 1604-05) with marks which have acquired secondary meaning. Nonetheless, to the extent that applicant insists that it is not alternatively claiming acquired distinctiveness, no further consideration will be given to its argument that another meaning for the term "BALASHI" is its identification by consumers with applicant.

Ser. Nos. 78304942 and 78304953

Opryland USA Inc., 1 USPQ2d 1409 (TTAB 1986);
In re Cookie Kitchen, Inc., 228 USPQ 873
(TTAB 1986); TMEP §1210.02(b)(i). In this
case, the primary significance of Balashi is
geographic for the identified goods.

Presumably, the Examining Attorney maintains that any other meaning for the term "Balashi" is outweighed by its significance as a location in Aruba, concluding that the primary significance of such term is therefore geographical.

As to her contention that the geographical location named by the term "Balashi" is neither obscure nor remote, and thus that a public association of applicant's beer with such place should be presumed from the fact that the its goods admittedly come from the geographical place named in or by, respectively, the marks "BALASHI BEER" and "BALASHI," the Examining Attorney asserts in her brief that "[t]he named geographic location need not be famous, but rather only likely to be associated with applicant's goods," *citing* *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985). The Examining Attorney argues, based upon, *inter alia*, the facts that applicant's "address of record indicates that it is located in Balashi"; that "[s]everal dictionaries of record attached to the office action[s] of July 20, 2005, demonstrate that applicant's brewery is located in Balashi"; and that applicant "has conceded that its beer production facility is located in Balashi," that "[p]urchasers are likely to believe the goods will originate in that geographic location because applicant is located there."

Furthermore, the Examining Attorney correctly notes in this regard that "[r]emoteness or obscurity is determined from the perspective of the average American consumer," *citing* In re Societe Generale des Eaux Minerales de Vittel S.A., supra at 3 USPQ2d 1452. She contends that "[i]n this circumstance, the average American consumer would have ample reason to recognize Balashi as the geographic source for applicant's beer" because:

First, it is important to note that Aruba is an important travel destination for American tourists. The following, incorporated into the office action[s] of July 20, 2005, is found at www.aruba.com under FAQ.

Where do tourists mainly come from?
Aruba's largest tourism market is the US with 75% market share, followed by Latin America (Venezuela, Colombia) and Holland.

In addition, Aruba's airport facility is state-of-the-art and has special arrangements for visitors from the United States. For example, U.S. bound passengers have their own terminal building that houses a U.S. INS/Customs facility, allowing flights from Aruba to enter the U.S. as domestic flights. Accordingly, Aruba is a well known and easily accessible destination to those in the United States.

Second, [readily available website] travel information for those visiting Aruba often makes reference to Balashi. For example, [the record shows that] Balashi is listed as a worthwhile place to see. Those providing [travel] information about Aruba make reference to Balashi because of its historical significance to the gold industry. Those providing travel information also mention Balashi because the second largest desalination plant in the world is located in Balashi. It has also been noted that there are many requests to tour this plant. Therefore, those who travel to Aruba or are considering such

travel will be exposed to information about Balashi.

In addition, readily available information about Balashi beer makes reference to the geographic origin of the name. For example, the following is of record:

Balashi National Brewery Inc. situated as [sic] Balashi, home of Aruba's largest gold smelting industry in the late nineteenth and early twentieth century, as well as for Aruba's world famous [fresh] water production industry the WEB, is the newest addition to Aruba's broadening economic development ...[.] For many reasons and following beer tradition, the brewery was named after this well known area. [and]

... all of **Balashi** products will from now on be nicely stamped, *Made in Aruba*, bearing a little turquoise, yellow and red flag.

Referring, in addition, to "an email communication between two apparently American beer consumers discussing the geographic origin of Balashi beer"⁴ and to "a reference to a web site clearly available to American beer consumers referencing Balashi beer and identifying it as brewed in Balashi, Aruba,"⁵ the Examining Attorney concludes in her brief that:

All of this information demonstrates that Americans have easy access to Aruba, that Balashi is often mentioned in travel

⁴ Such communication actually consists of an inquiry posted on the website "www.arubatravelinfo.com" by a "Bill Balaschi," who states that he "recently had my first Balashi beer" and "[w]ould like to know more about the name since it is so close to mine," and a reply from a "Dee," who indicates that "[t]he name Balashi ... comes from a region of the island [of Aruba] called Balashi" and notes that "[t]his is the info we received while in Aruba gained from reading and talking with the Islanders."

⁵ The reference, from "BeerAdvocate.com," describes "Balashi" as "[a]n Adjunct Lager brewed by Browerij Nacional Balashi in Balashi, Aruba."

information for those visiting or reading about Aruba, that the geographic area named Balashi is known to be the source of the name for Balashi beer, and that Americans have reason to know this. Therefore, Balashi is not geographically remote or obscure from the perspective of the average American consumer of beer.

We concur with applicant, however, that the primary significance of the term "Balashi" is not geographical to beer purchasers in the United States. Specifically, while we disagree with applicant that such consumers would be aware of alternative meanings of such term as a variety of cabbage and a place in Bangladesh, since the present record reflects that those meanings are even more obscure than the geographical significance thereof as a location in Aruba, we agree with applicant that "Balashi" is so obscure or remote that purchasers of beer in the United States would typically fail to recognize the term as indicating the geographical source of applicant's goods.

In particular, as the Examining Attorney has noted, applicant in its initial brief "concedes that there is a neighborhood referred to by locals in Aruba as 'Balashi' and that Applicant's beer production facility is located in that neighborhood." Applicant maintains, however, that the primary significance of such location to the relevant American public "is Applicant's beer, not a place," inasmuch as "[t]he geographical meaning of the term 'Balashi' is minor since the neighborhood is obscure and remote." While one excerpt, which the Examining Attorney made of record from the "Absolute Real Estate" website, would appear to support applicant's position in that it describes

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"Balashi" as a "[q]uiet area near Aruba's famous Beer brewery," another excerpt, which the Examining Attorney also made of record from the tourism website "aruba-info.com," would seem to suggest that the opposite is true of such locale since it states, as previously mentioned, that "the brewery was named after this well-known area." Applicant, as support for its position and to counter the latter, has submitted in each of its applications a declaration of its financial controller, Mr. Giovanni Kock, and a declaration of its managing director, Mr. Eduard I.J. DeVeer,⁶ as well as what applicant characterizes as "photographs of the area known as 'Balashi' in Santa Cruz, Aruba" and "exhibits such as dictionary references, encyclopedia references, and webpages evidencing the obscurity of 'Balashi'"

Specifically, Mr. Kock's declarations state in relevant part that he is an adult resident of Aruba; that he has been applicant's financial controller for three years; that applicant "is located in the area known as Balashi"; that it has been in business since 1999 and has exclusively used the marks "BALASHI BEER" and "BALASHI" in connection with its products since that time; that applicant does not export such products to the United States nor does it advertise in or target any advertising to the United States; that, instead, applicant advertises only in Aruba; that "Balashi is a locality or neighborhood in the Santa Cruz District of Aruba"; that "Balashi is not the name of a city in Aruba" nor is it "the name of a county or district in Aruba";

⁶ Mr. Kock's declarations, like those of Mr. DeVeer, are identical except for the references therein to "BALASHI BEER" and "BALASHI."

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that "Aruba's largest cities are Oranjestad, Aruba's largest and capital city, and Saint (Sint) Nicoles," which "cities are located in the western and southwestern areas of Aruba"; that "Oranjestad, Palm Beach, and Eagle Beach are the most popular tourist destinations"; that "[t]here are no hotels, motels, or visitor accommodations in Balashi" and there is only "a single seafood restaurant in Balashi, Aruba called Marina Pirata"; that "[t]here are two main roads passing through Balashi," one of which "is a two-lane paved road called Barcardera that runs along the southern coast of the island and [the other of which is] Main Road, a two-lane paved road, connecting Oranjestad and Sint Nicolas"; that "[t]here is no post office in Balashi"; that "[t]here are no public or private schools in Balashi"; that "[t]here are no churches in Balashi"; that "[t]here is no public transportation that originates in Balashi"; that, instead, "[t]here is a single bus stop in Balashi for public transportation passing through the area"; that "[t]here is no local government for the area known as Balashi"; that "Aruba is part of the Kingdom of the Netherlands" and has "a single administrative branch of government for the country ... located in Oranjestad, Aruba"; that, according to "the Central Bureau of Statistics, located in Oranjestad, Aruba," "[a]s of 2002, it is estimated that approximately 12,000 people live in the district of Santa Cruz, 10% of which is attributable to the area of Balashi"; and thus that "approximately 1,200 people, or 1% or

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[sic] of Aruba's population, live in Balashi, Aruba" as of 2002, the latest year for which population information is available.

Mr. DeVeer's declarations, in pertinent part, similarly state that he is an adult resident of Aruba; that he has been applicant's managing director for four years; that applicant "is located in the Santa Cruz District of Aruba"; that it has been in business since 1999 and has exclusively used the marks "BALASHI BEER" and "BALASHI" in connection with its products since that time; that applicant has not exported such products to the United States nor does it advertise in or target any advertising to the United States; that, instead, applicant "only advertises in print, radio, and television media in ... Aruba"; that "'Balashi' is the nickname of an area, akin to a neighborhood, in the Santa Cruz District of Aruba (hereinafter referred to as the 'Area')"; that "the Area has no definite boundaries"; that "the Area is not the name of a city, village, or other government-recognized municipal entity in Aruba" nor is it "the name of a county, district, or other political division in Aruba"; that "[t]here is no local government for or in the Area"; that "the Area is not a tourist destination" since "[t]here are no hotels, motels, or visitor accommodations in the Area" and there is only "a single seafood restaurant in the Area called Marina Pirata"; that "[t]here are two main roads passing through the Area," one of which is "Barcardera, a two-lane paved road that runs along the southern coast of the island and [the other of which is] Main Road, a two-lane paved road, connecting Oranjestad and Sint Nicolas"; that "[t]here is no post office in the Area"; that

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"[t]here are no public or private schools in the Area"; that "[t]here are no churches in the Area"; that "[t]here is no public transportation that originates in the Area"; that, instead, "[t]here is a single bus stop in the Area for public transportation"; and that, except for applicant, "[t]here is little commercial activity in the Area." In addition, Mr. DeVeer's declarations recite that "[a] report of the Aruba Tourism Authority indicates that in 2004, citizens from the United States represented 66% of the total number of visitors to Aruba"; that while "[t]here once was a gold mine located in the Area, ...the gold mine was never known as the 'Balashi Gold Mine'"; that "the immediate area surrounding the former gold mines solely consists of a few buildings which are badly maintained and run down"; that "copies of photographs of the signs directing travelers toward the 'Gold Mines' and the area of the former 'Gold Mines' are attached"; that, however, applicant's "beer production facility ... is a popular tourist destination"; that consumers from the United States "often contact" applicant "for personalized tours of its ... production facility"; that, since its opening in 1999, applicant has conducted "numerous tours of its ... production facility approximately three (3) times per week"; and that, "as our guestbook pages reflect, the majority of our tour guests are from the United States."

Based upon such declarations, and in view of other exhibits which it has introduced as evidence as to the primary significance of the term "Balashi," applicant persuasively argues in its initial brief that the "record establishes that the

geographical significance of 'Balashi' is minor, obscure, and remote." Applicant, among other things, specifically points out that Balashi" is not the name of a city, county or district within the island "country" of Aruba; that it "is a small and commercially insignificant neighborhood in the district of Santa Cruz with no boundaries and no official status"; and that there are no hotels, government offices, post offices, churches or schools in Balashi, which has only a single restaurant. In fact, as applicant observes, the record shows that (footnotes omitted; emphasis in original):⁷

"Balashi" is so insignificant, geographically, that it is ... [almost] impossible to find a geographic map identifying it as a place. The Examiner referenced a single map ... to support her argument that the primary significance of "Balashi" is geographical. In stark contrast, Applicant has submitted into evidence fourteen (14) maps which fail to identify "Balashi" as a geographical place.

The obscurity and remoteness of this "place" is further evidenced by its omission in other heavily-relied upon references[,], namely encyclopedias and dictionaries. Researching the term "Balashi" in any one of a number of reliable and popular online encyclopedias (i.e., Encyclopedia Britannica [sic], Encyclopedia.com, and Encarta) returns absolutely no results. The same is true for a search of Merriam-Webster's Dictionary. Clearly, this cumulative and reliable evidence supports the fact that the area is, at a minimum, comparatively unimportant, secluded, and unknown.

⁷ Applicant is incorrect, however, in asserting that the "Examiner's map inaccurately identifies 'Balashi' as an island off the coast of Aruba" since a careful review of such map reveals that it is indeed a map of Aruba which pinpoints only the location of the area of Balashi.

Applicant concedes that there is some limited evidence to show that the neighborhood of "Balashi" was known as an area where gold was discovered in the 1800's and is currently home of Aruba's water desalination plant. However, such limited evidence does not prove that "Balashi" is **immediately perceived** by **U.S. consumers** as a geographical place.

The Board need only examine recent photographs of the area to see how remote this neighborhood, for lack of a better word, is.

We consequently agree with applicant that "[t]his case is factually similar to" both *In re Bavaria St. Pauli Brauerei AG*, 222 USPQ 926, 927-28 (TTAB 1984), in which the Board found the term "JEVER," in an application to register the mark "JEVER" and design for "beer" which was produced in the German town of Jever, to have only an obscure geographical meaning and thus the mark was not primarily geographically descriptive,⁸ and *In re Societe Generale des Eaux Minerales de Vittel S.A.*, supra at 3 USPQ2d 1452, in which our primary reviewing court found that:

There can be no doubt that the PTO has established that Vittel is in fact the name of a small town in the Voges mountain region of France where there is a resort with mineral springs--a spa-- where the water is bottled and thence distributed somewhere, but how many people in this country know that?

⁸ The sole evidence presented therein consisted of "a listing from the 1952 edition of the Columbia Lippincott Gazetteer of the World, in which Jever is identified as a town of 10,342, ten miles from Wilhelmshaven in northwest Germany" which "features a 'rail junction; woolen milling, brewing, meat processing' and 'horse and cattle markets.'" *In re Bavaria St. Pauli Brauerei AG*, supra at 927. In particular, on the basis of such record, the Board stated that "a genuine issue was raised concerning the obscurity of the geographical meaning of 'JEVER', and the single entry from an outdated gazetteer is insufficient to establish, as a threshold matter, that purchasers would make a goods/place association upon encountering 'JEVER' beer." Id. at 928 n.2.

Certainly Vittel is remote and we deem the evidence produced by the PTO insufficient to show that it is not obscure. We think the evidence is inadequate to show that the bulk of cosmetics purchasers, or even a significant portion of them, would upon seeing the word Vittel on a bottle of skin lotion or the like, conclude that it is a place name and that the lotion came from there, rather than simply a trademark or trade name of a manufacturer like Chanel, Bourgois, or Vuitton.

We would add that this appeal is also like *In re Brauerei Aying Franz Inselkammer KG*, 217 USPQ 73, 75 (TTAB 1983), in which the Board held the term "AYINGER," in an application to register the mark "AYINGER BIER" ("BIER" disclaimed) for "beer" which was produced in the German town of Aying, to have only a minor, remote or obscure geographical significance and thus the mark was not primarily geographically descriptive.⁹ In so finding, the Board pointed out that:

The evidence relied upon here is inadequate The Examining Attorney has not provided any evidence which would refute the ... obscurity of Aying or establish that it is known ... as a beer producing area. Quoting Judge Nies in her concurring opinion in ... [*In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 897 (CCPA 1982)], "A geographic name is not unprotectible or unregistrable because it can be labeled a geographic name, but because it tells the public something about the product or the producer absent which his competitor also has a right to inform the public. Thus, the names of places devoid of commercial activity are arbitrary usage." We would add that where the geographic significance of a name is lost on

⁹ The applicant therein contended that Aying "is a tiny hamlet in Bavaria having only 500 inhabitants." *In re Brauerei Aying Franz Inselkammer KG*, supra at 74-75. The Board agreed, concluding from the record presented that "we are dealing with a tiny village unknown to the public as far as we can see." Id.

the public because of obscurity, there too,
the usage becomes arbitrary.

Id. at 75. Here, "Balashi" would be perceived as an arbitrary term which would serve to identify and distinguish applicant's goods because its geographical significance is essentially unknown to the relevant public, given that the record contains insufficient evidence to show that American beer consumers would in fact readily recognize "Balashi" as a geographical name.

We further agree with applicant that, as stated in its initial brief, "the evidence of record, at a minimum, creates a genuine issue regarding the primary significance of 'Balashi' in the minds of American beer consumers." Accordingly, a goods/place association cannot be presumed from the fact that applicant's goods come from Balashi and it is incumbent upon the Examining Attorney to have presented evidence sufficient to establish that American consumers of beer would in fact make such an association. We concur with applicant, however, that the Examining Attorney has failed to do so. Here, the travel and tourist information of record plainly shows that presently, the principal industry of Aruba is tourism rather than, for instance, gold smelting, oil refining, fresh water production or beer brewing. For example, as stated in the except furnished by the Examining Attorney from the "www.odyssey.com/travel/aruba.php" website:

Travel to Aruba - Discovered and claimed for Spain in 1499, Aruba was acquired by the Dutch in 1636. The island's economy has been dominated by three main industries. A 19th century gold rush was followed by prosperity brought on by the opening in 1924 of an oil

refinery. The last decades of the 20th century saw a boom in the tourism industry. Aruba seceded from the Netherlands Antilles in 1986 and became a separate, autonomous member of the Kingdom of the Netherlands. A flat, riverless island renowned for its white sand beaches; its tropical climate is moderated by constant trade winds from the Atlantic Ocean; the temperature is almost constant at about 27 degrees Celsius (81 degrees Fahrenheit).

To the same effect, an excerpt from the website "www.lonelyplanet.com/destinations/caribbean/aruba/history.htm," which was made of record by both the Examining Attorney and applicant, provides that:

.... The first European to stumble upon Aruba was Alonso de Ojeda, a compatriot of Columbus, who claimed the island for Spain in 1499. Conflict in Europe between Spain and Holland resulted in the Dutch seizing the island in 1636, and the Dutch began to colonise [sic] Aruba at the end of the 17th century.

.... The British arrived in 1805 ... but sailed into the sunset in 1816. Less than a decade later, the first of Aruba's three economic booms took place when gold was discovered near Balashi. A flood of gold hungry immigrants arrived from Europe and Venezuela, and mining continued right up until 1916.

When the mines became unproductive, Aruba turned to oil refining in a big way. In 1929, the world's largest refinery was built on the southeastern tip of the island. Things hummed along quite swimmingly until the 1940s, when Aruba began to resent playing second fiddle to Curacao in the federation known as the Netherlands Antilles Aruban calls for autonomy became increasingly strident over the next 40 years, and in 1986 Aruba finally got its way and became an autonomous state within the Kingdom of the Netherlands.

The new level of independence came close on the heels of a severe economic downturn, prompted largely by the closure of Aruba's oil refinery. Having exhausted the real gold and refined the black gold, the Arubians turned to tourism to bankroll their future. Despite the economic autonomy enabled by the tourist boom, plans for full independence in 1996 were shelved.

Investment in the island's tourist infrastructure has been little short of phenomenal, and Aruba now boasts more than 6000 hotel rooms and almost a million visitors each year. Tourism is now very much the mainstay of the island's economy.

Additionally, an excerpt made of record by the Examining Attorney from the website "www.aruba-tours.com/info/drinking.html" shows that Balashi, Aruba, is home to the world's second largest water desalination plant:

There is no need to buy bottled water in Aruba, the island's tap water is pure and refreshing, distilled in the world's second largest saltwater desalination plant. The plant is called the WEB, and there are many requests to tour the plant that is located in Balashi.

We agree with applicant that while Balashi, *inter alia*, has some historical significance as a gold mining and smelting area and is also the location of Aruba's desalination plant, it is nonetheless the case that, as stated in applicant's reply brief, the Examining Attorney's "conclusion that 'Balashi' is a 'significant geographic location in Aruba' does not follow from these two facts," much less that "American consumers perceive 'Balashi' as a 'significant geographic location in Aruba.'" In

fact, none of the evidence relied upon by the Examining Attorney¹⁰ serves, as applicant argues in its reply brief, to establish that beer drinkers in the United States would make a goods/place association between the name "Balashi" and beer.

In particular, applicant persuasively points out therein that (footnote omitted; emphasis in original):

[The] Examiner makes the unsubstantiated conclusion that the "average American consumer would have ample reason to recognize Balashi as the geographic source of applicant's beer." The Examiner concludes that a majority of Americans know the geographical significance of "Balashi" from the fact that 75% of Aruba's visitors come from the United States. This conclusion is mind-boggling. This says nothing about how many travelers from the U.S. travel to Aruba. Based on the Examiner's logic, if four visitors traveled to Aruba and three of them were from the U.S., this would mean a "majority of Americans" travel to Aruba. The conclusion does not logically follow the premise. Moreover, the Examiner concludes that Aruba is a "well-known and easily accessible destination to those in the United States" simply because U.S. ... passengers have a special terminal and enter Aruba as if traveling on [a] domestic flight. Flight arrangements from the U.S. to Aruba do not impact whether or not "Balashi" is geographically significant to American beer consumers. Whether the country of Aruba is known to Americans is not relevant to whether "Balashi" is recognizable to American beer consumers in the United States as a place

¹⁰ In a footnote to its reply brief, applicant notes that in denying its requests for reconsideration, "[t]he July 20, 2005 Office Actions reference www.aruba.com in their allegation that 'Aruba's largest tourism market is the US with 75% market share'" and accurately observes that "the Examiner fails to attach copies of the webpages as evidence." While not the preferred practice, we nevertheless consider such evidence as part of the record, notwithstanding applicant's belated objection thereto in its reply brief, since the Examining Attorney stated in her actions with respect thereto that "[t]he following is found at www.aruba.com. under FAQ," thereby giving applicant adequate notice of the source of her factual information.

name. That would be equivalent to saying that because Americans know the country of France, American cosmetic consumers would immediately recognize VITTEL as a place name. In re Societe General Des Eaux Minerales De Vittel, S.A., 824 F.2d 957 (Fed. Cir. 1987). This clearly unsound reasoning was rejected by the Federal Circuit.

The Examiner makes the unjustified leap that since "Balashi" is home to a water desalination plant, "those who travel to Aruba or are considering such travel will be exposed to such information about Balashi." Again, the conclusion does not follow the premise. The Examiner also suggests that because gold was discovered near "Balashi" in the late nineteenth century, the place name is significant to American beer purchasers today. There is no evidence that this obscure historical fact is known or recognized by Americans today. Americans intending to travel to Aruba might come across this information in their research, but that does not prove that American beer purchasers, in general, primarily associate "Balashi" with a place.

The Examiner references an excerpt from the website www.visitaruba.com discussing the fact that all of the "Balashi products will from now on be nicely stamped 'made in Aruba'" This proves that Applicant's **BALASHI** products are primarily identified with the country of Aruba[,] not with the unrecognized neighborhood in Santa Cruz, Aruba. This further proves that "Balashi" is remote and obscure.

One of the Examiner's citations, inaccurately described as an "email communication between two apparently American beer consumers," does not support the Examiner's position that the term is "geographically significant to beer consumers." The evidence referenced is actually an excerpt of postings from a web-board. The communication evidences just how remote and obscure this neighborhood of "Balashi" is. The person who purportedly wrote this posting investigated the name "Balashi" by reading, traveling to Aruba, and talking to native Arubans. If knowing

the origin of the term "Balashi" requires personal interviews in Aruba and reading Aruban history, it does not follow that American beer purchasers will immediately recognize it as a place name.

The Examiner erroneously concludes that Americans know the geographic significance of "Balashi" because "Americans have easy access to Aruba...Balashi is often mentioned in travel information for those *visiting* or *reading* about Aruba, [and]...the geographic area named is known to be the source of the name for Balashi beer." However, the only conclusion that can be drawn from these facts is that to know that "Balashi" has **any geographic significance at all** requires research -- traveling or reading about Aruba. That, in and of itself, defeats the refusal to register the **BALASHI** marks because to be **primarily geographically significant, the mark must immediately convey a geographical place**. In contrast, it is unlikely that Americans visit or read about "Nashville" or "Manhattan" to know the geographic significance of these metropolitan areas within the United States.

We concur that in dealing with the supposed reactions of a segment of the American public, in this case the average American beer consumer and not the unusually well-traveled tourist or even the aficionados of foreign beers, the isolated area or neighborhood of Balashi in the Caribbean island of Aruba is simply so minor, remote and obscure that its geographic significance would not be known or otherwise readily apparent to purchasers of applicant's beer. To be sure, the average American beer consumer, after perhaps quaffing a few "brews" while spending some time lying around on, or at least contemplating a vacation to, the white sand beaches of Aruba that serve as the island's principal tourist destinations, might have occasion to research and/or check out whatever other attractions, including

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gold mine ruins, a large desalination plant and applicant's brewery, would be of interest as a side trip to the locale of Balashi. The geographical significance, however, of the term "Balashi" would not be apparent without, at a minimum, consulting sources of tourism information. We consequently hold that, on this record, the Examining Attorney has failed to establish that the term "Balashi" is a place name which is generally known, that is, is not remote or obscure in its geographical significance, to American beer consumers and thus has not shown a reasonable basis for concluding that the marks "BALASHI BEER" and "BALASHI" are primarily geographically descriptive of applicant's goods within the meaning of the statute.

Decision: The refusals under Section 2(e)(2) are reversed as to each application.