

ESTTA Tracking number: **ESTTA746525**

Filing date: **05/16/2016**

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

Notice of Opposition

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

Opposer Information

Name	T.J. CAROLAN & SON LIMITED
Granted to Date of previous extension	06/01/2016
Address	1 Stokes Place, Saint Stephen#s Green Dublin, 2 IRELAND

Attorney information	Susan Neuberger Weller Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. 701 Pennsylvania Avenue, N.W. Suite 900 Washington, DC 20004 UNITED STATES snweller@mintz.com, jddib@mintz.com Phone:2025853510
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Applicant Information

Application No	86780054	Publication date	02/02/2016
Opposition Filing Date	05/16/2016	Opposition Period Ends	06/01/2016
Applicant	Starbuzz Tobacco, Inc. 10871 Forbes Ave Garden Grove, CA 92843 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Pipe Tobacco; Molasses Tobacco; Tobacco; Smoking Tobacco; Flavored Tobacco; Tobacco Substitute, namely, Herbal Molasses
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	615941	Application Date	08/26/1954
Registration Date	11/08/1955	Foreign Priority Date	NONE
Word Mark	IRISH MIST		

Design Mark	Irish Mist
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 1949/04/28 First Use In Commerce: 1950/10/10 IRISH LIQUEUR

Attachments	71672293#TMSN.png(bytes) Notice of Opposition - IRISH MIST.pdf(313572 bytes)
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Certificate of Service

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

Signature	/Susan Neuberger Weller/
Name	Susan Neuberger Weller
Date	05/16/2016

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

In the matter of Application No. 86780054 for IRISH MIST

Published in the Official Gazette February 2, 2016

_____)	
T.J. CAROLAN & SON LIMITED,)	
)	
Opposer,)	
)	
vs.)	
)	Opposition No. _____
Starbuzz Tobacco, Inc.)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

T.J. Carolan & Son Limited (“Opposer”), an Irish limited partnership with a business address at 1 Stokes Place, Saint Stephen’s Green, Dublin, Ireland 2, believes that it will be damaged by registration of U.S. Application Serial No. 86780054 for the mark **IRISH MIST** for “pipe tobacco; molasses tobacco; tobacco; smoking tobacco; flavored tobacco; tobacco substitute, namely, herbal molasses” in Class 34 and hereby opposes the same.

Pursuant to 15 U.S.C. §§ 1052, 1125, 1063, and 1141 of the Lanham Act, and 37 C.F.R. §§ 2.101 and 2.104, and predicated upon the following grounds, Opposer alleges the following:

1. Opposer is part of the internationally renowned Campari Group which manufactures and distributes distilled spirits, wines, and other beverage products worldwide, including in the U.S. Opposer owns U.S. Registration No. **0615941**, for the incontestable mark **IRISH MIST** for “irish liqueur” in Class 33. A copy of the US Certificate of Registration and Sections 8 & 9 acceptance documents are attached hereto and incorporated herein by reference as Exhibit A. (“Opposer’s Mark” or “IRISH MIST Mark”).

2. The **IRISH MIST** Mark has been used since 1955 on liqueur products sold and distributed in the U.S. and throughout the world. As a result of over sixty years of use, and millions spent advertising and promoting the **IRISH MIST** Mark, Opposer's Mark has achieved a high level of fame and notoriety in the markets in which it is sold and distributed, including the U.S.

3. Upon information and belief, Starbuzz Tobacco, Inc. ("Applicant") is a California corporation with an address at 10871 Forbes Ave, Garden Grove, CA 92843.

4. According to its web site at <http://www.shopstarbuzz.com/>, Applicant is a manufacturer and seller of various tobacco and related products located in California which was established in 2005. It seeks to register the mark **IRISH MIST** for "pipe tobacco; molasses tobacco; tobacco; smoking tobacco; flavored tobacco; tobacco substitute, namely, herbal molasses" pursuant to U.S. Application Serial No. 86780054 filed on October 6, 2015, under Section 1(b) of the U.S. Trademark Act ("Applicant's Mark" or "Applicant's Application").

5. Opposer will be damaged by registration of Applicant's Mark and, thus, opposes Applicant's Application to register its **IRISH MIST** Mark in the U.S. on the grounds set forth below.

COUNT I
Likelihood of Confusion
15 U.S.C. §1052(d)

6. Applicant re-alleges and incorporates herein by reference Paragraphs 1-5 above as if fully set forth herein.

7. Opposer's dates of date of first use of its **IRISH MIST** Mark in the U.S. are prior to any use by Applicant of its **IRISH MIST** Mark in the US.

8. Opposer has used its **IRISH MIST** Marks for over sixty years throughout the world and in the U.S. Since Opposer's Marks are used on goods sold and advertised in the same markets in which and to the same customers to which Applicant does or will market and sell its Class 34 goods, it is highly likely that confusion will occur between the two marks at issue.

9. Applicant's Mark **IRISH MIST** is identical to Opposer's prior existing **IRISH MIST** Mark that it is likely to cause confusion with Opposer's Marks when used for the goods in Class 34 as set forth

in Applicant's Application, and is likely to deceive purchasers and potential purchasers of Applicant's goods and Opposer's goods into erroneously believing that there is some relationship between Opposer and Applicant, or that Opposer has authorized, sponsored, or licensed Applicant's use of the mark **IRISH MIST** in violation of 15 U.S.C. § 1052(d).

10. Registration of Applicant's Mark will damage Opposer since such registration will give color of exclusive statutory rights to Applicant in the mark **IRISH MIST** in derogation and violation of the prior and superior federal rights of Opposer

COUNT II
Dilution
15 U.S.C. § 1125 (c)

11. Applicant re-alleges and incorporates herein by reference Paragraphs 1-10 above as if fully set forth herein.

12. Opposer has used its **IRISH MIST** Mark for over sixty years throughout the world and in the U.S. As a result of its long term use and millions of dollars spent in advertising and promotion, Opposer's Mark has become and is distinctive and famous worldwide and in the U.S.

13. Registration of Applicant's **IRISH MIST** Mark for the noted goods is likely to cause dilution of Opposer's famous **IRISH MIST** Mark by blurring under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

WHEREFORE, Opposer T.J. Carolan & Son Limited believes that it will be damaged by the registration of U.S. Application Serial No. 86780054 for the mark **IRISH MIST** in Class 34 and, therefore, respectfully requests that the Trademark Trial and Appeal Board sustain the opposition and refuse registration of Applicant's Mark under 15 U.S.C. §§1052(d) and 1125(c).

Respectfully submitted,

T.J. CAROLAN & SON LIMITED

By: /Susan Neuberger Weller/
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Attorney for Opposer
T.J. Carolan & Son Limited

Dated: May 16, 2016

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served by U.S. first class mail, postage prepaid, on this 16th day of May, 2016 on the following:

NATU J. PATEL
THE PATEL LAW FIRM, P.C.
22952 MILL CREEK DRIVE
LAGUNA HILLS, CALIFORNIA UNITED STATES 92653

Starbuzz Tobacco, Inc.
10871 Forbes Ave Garden Grove CALIFORNIA 92843
Applicant

_____/Shelly Gause/_____
Shelly Gause

43425435v.1

47650323v.1

EXHIBIT A

Int. Cl.: 33

Prior U.S. Cl.: 49

Reg. No. 615,941

United States Patent and Trademark Office

Registered Nov. 8, 1955

Amended

OG Date Feb. 26, 2008

TRADEMARK
PRINCIPAL REGISTER

Irish Mist

IRISH MIST LIQUEUR CO. LTD. (IRE-
LAND CORPORATION)
DUBLIN 10
KYLEMORE PARK WEST, IRELAND

FOR: IRISH LIQUEUR, IN CLASS 49
(INT. CL. 33).
FIRST USE 4-28-1949; IN COMMERCE
10-10-1950.
SER. NO. 71-672,293, FILED 8-26-1954.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Feb. 26, 2008.*

DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE

From: TMOfficialNotices@USPTO.GOV
Sent: Tuesday, January 12, 2016 11:00 PM
To: snweller@mintz.com
Cc: jddib@mintz.com
Subject: Official USPTO Notice of Acceptance and Renewal Sections 8 and 9: U.S. Trademark RN 0615941: IRISH MIST (Stylized/Design): Docket/Reference No. 19685-014

Serial Number: 71672293
Registration Number: 0615941
Registration Date: Nov 8, 1955
Mark: IRISH MIST (Stylized/Design)
Owner: T.J. CAROLAN & SON LIMITED

Jan 12, 2016

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF REGISTRATION RENEWAL UNDER SECTION 9

The renewal application filed for the above-identified registration meets the requirements of Section 9 of the Trademark Act, 15 U.S.C. §1059. **The registration is renewed.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
049

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION IN SUCCESSIVE TEN-YEAR PERIODS

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=71672293>. NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.