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

Proceeding	91227886
Party	Defendant Starbuzz Tobacco, Inc.
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Date	06/24/2016
Attachments	Answer to Notice of Opposition.pdf(265588 bytes)

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

In the Matter of Application Serial No. 86/780,054

Mark: IRISH MIST
Filed: October 6, 2015
Published: February 2, 2016

T.J. CAROLAN & SON LIMITED,	}	OPPOSITION NO: 91227886
Opposer,	}	APPLICANT STARBUZZ TOBACCO, INC.'S ANSWER TO TJ CAROLAN & SON LIMITED'S NOTICE OF OPPOSITION
vs.	}	
STARBUZZ TOBACCO, INC.,	}	Opposition Filed: May 16, 2016
Applicant.	}	

APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION

Applicant, Starbuzz Tobacco, Inc. ("Applicant"), a corporation organized and existing under the laws of the State of California, hereby answers the allegations set forth in Opposer, T.J. Carolan & Son Limited's ("Opposer") Opposition to the application to register U.S. Trademark Application Serial No. 86/780,054 (the "Opposition").

1. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Opposition, and therefore denies those allegations.
2. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Opposition, and therefore denies those allegations.
3. Applicant admits the allegations in Paragraph 3 of the Opposition.

4. Applicant admits that it was established in 2005 in California and is a manufacturer and seller of various tobacco and related products. Applicant further admits that it applied for U.S. Application Serial No. 86/780,054 on October 6, 2015, under Section 1(b) of the U.S. Trademark Act for the mark IRISH MIST in connection with “pipe tobacco; molasses tobacco; tobacco; smoking tobacco; flavored tobacco; tobacco substitute, namely herbal molasses.” Applicant denies the remaining allegations of Paragraph 4 of the Opposition.

5. Applicant denies the allegations of Paragraph 5 of the Opposition.

COUNT I
Likelihood of Confusion

6. Paragraph 6 of the Opposition incorporates the allegations of Paragraphs 1 through 5 of the Opposition. As such, Applicant incorporates its answers to Paragraphs 1 through 5 of this Answer, as asserted above.

7. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 of the Opposition, and therefore denies those allegations.

8. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Opposition, and therefore denies those allegations.

9. Applicant denies the allegations of Paragraph 9 of the Opposition.

10. Applicant denies the allegations of Paragraph 10 of the Opposition.

COUNT II
Dilution

11. Paragraph 11 of the Opposition incorporates the allegations of Paragraphs 1 through 10 of the Opposition. As such, Applicant incorporates its answers to Paragraphs 1 through 10 of this Answer, as asserted above.

12. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Opposition, and therefore denies those allegations.

13. Applicant denies the allegations of Paragraph 13 of the Opposition.

PRAYER FOR RELIEF

14. Applicant denies that Opposer is entitled to any of the relief sought in its prayer for relief.

AFFIRMATIVE DEFENSES

Without admitting any allegations in the Opposition not otherwise admitted, Applicant avers and asserts affirmative defenses as follows:

FIRST AFFIRMATIVE DEFENSE
(Trademark Misuse)

Opposer's claims are barred in whole or in part, because Opposer is misusing its trademark to prevent the legitimate use and registration of other trademarks that are used in connection with unrelated goods.

SECOND AFFIRMATIVE DEFENSE
(Lack of Priority)

Opposer's claims are barred in whole or in part, because there is no factual basis to support a claim of priority over Applicant's Mark.

**THIRD AFFIRMATIVE DEFENSE
(Failure to State a Claim)**

The Opposition, in whole or in part, fails to state a claim upon which relief may be granted, and therefore should be dismissed.

**FOURTH AFFIRMATIVE DEFENSE
(Unclean Hands)**

Opposer's claims are barred, in whole or in part, by the doctrine of unclean hands.

**FIFTH AFFIRMATIVE DEFENSE
(Fraud Upon the USPTO)**

Opposer's claims are barred, in whole or in part, since it fraudulently obtained its federal trademark registration.

**SIXTH AFFIRMATIVE DEFENSE
(No Injury)**

Opposer's claims are barred since it is not likely to suffer injury nor is there a likelihood of injury.

**SEVENTH AFFIRMATIVE DEFENSE
(No Likelihood of Confusion)**

Opposer's claims are barred since consumers are not likely to be confused as to the source of Opposer's and Applicant's products based on: 1) the strength of the marks; 2) Applicant's intended use of its mark; 3) similarity of the marks; 4) actual or likelihood of confusion in the marketplace; 5) Applicant's intent; 6) marketing/advertising channels; 7) consumer's degree of care; 8) product line expansion; and 9) the unrelated nature of Opposer's and Applicant's goods (*i.e.* Irish Liqueur v. Hookah Tobacco).

**EIGHTH AFFIRMATIVE DEFENSE
(Non-Dilution of Trademark)**

Opposer's claims are barred since the alleged famous mark is not famous, the alleged diluting mark does not impair the distinctiveness of the alleged famous mark, and the alleged diluting mark does not harm the reputation of the alleged famous mark.

**NINTH AFFIRMATIVE DEFENSE
(No False Connection)**

Opposer's claims are barred since Applicant has not falsely suggested a connection between Applicant's Mark and Opposer's Mark.

**TENTH AFFIRMATIVE DEFENSE
(No Tarnishment)**

Opposer's claims are barred since Applicant has not caused tarnishment of Opposer's mark in the minds of consumers.

**ELEVENTH AFFIRMATIVE DEFENSE
(Estoppel)**

Opposer's claims are barred by the doctrine of estoppel.

**TWELFTH AFFIRMATIVE DEFENSE
(Justification and Privilege)**

Applicant's actions, statements, or conduct were justified and privileged.

**THIRTEENTH AFFIRMATIVE DEFENSE
(Trademark Unenforceability)**

Opposer's trademark is unenforceable because among other things, it is primarily geographically descriptive and/or lacks secondary meaning.

**FOURTEENTH AFFIRMATIVE DEFENSE
(Trademark Abandonment Through Non-Use)**

Opposer's trademark is unenforceable because among other things, Opposer has abandoned use of its mark in commerce pursuant to Trademark Act 15 U.S.C. § 1127.

**FIFTEENTH AFFIRMATIVE DEFENSE
(Reservation)**

Applicant currently has insufficient knowledge or information on which to form a belief as to whether it may have additional, as yet unstated, affirmative defenses available. Applicant reserves the right to assert additional affirmative defenses in the event that the discovery indicates it would be appropriate.

Dated: June 24, 2016

Respectfully Submitted,
The Patel Law Firm, P.C.



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CERTIFICATE OF SERVICE

I certify that a copy of this **APPLICANT STARBUZZ TOBACCO, INC.'S ANSWER TO TJ CAROLAN & SON LIMITED'S NOTICE OF OPPOSITION** is being served via United States mail, postage prepaid, on this the 24th day of June, 2016 to the following:

Opposer's Attorney/Representative:

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