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

Proceeding	92060895
Party	Defendant Starbuzz Tobacco, Inc.
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Attachments	Opp to MTS - FINAL.pdf(380763 bytes)

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

In the Matter of Registration No. 3,619,407

Mark: BLUE MIST

Registered: May 12, 2009

SIS RESOURCES LTD.,)	CANCELLATION NO: 92060895
)	
Petitioner,)	REGISTRANT STARBUZZ TOBACCO,
)	INC.'S OPPOSITION TO PETITIONER'S
)	NOTICE TO THE UNITED STATES
)	TRADEMARK TRIAL AND APPEAL
v.)	BOARD OF REGISTRANT'S PETITION
)	TO DIRECTOR OF THE UNITED
)	STATES PATENT AND TRADEMARK
)	OFFICE, AND REQUEST FOR AN
STARBUZZ TOBACCO, INC.,)	ORDER ADMONISHING REGISTRANT
)	AND ORDERING THAT THE PETITION
Registrant.)	TO THE DIRECTOR BE STRICKEN,
)	REJECTED, OR WITHDRAWN
)	
)	Petition Filed: February 17, 2015
)	
)	[RELATED OPPOSITION NO. 91213286]

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INTRODUCTION

Petitioner, SIS Resources LTD. (“SIS Resources”), initiated this petition to cancel (the “Cancellation”) alleging that Respondent, Starbuzz Tobacco, Inc. (“Starbuzz”) had committed fraud upon the United States Patent and Trademark Office (“USPTO”) when filing its declaration to renew the BLUE MIST trademark (Reg. No. 3,619,407) under Section 8 and 15 of the Lanham Act. Though there was no false or fraudulent statement, it will still take some time to resolve the conflict, and the deadline to renew the BLUE MIST trademark will have passed by then. Since a registration must have a valid Section 8 declaration to maintain the registration, and the current declaration is being disputed, Starbuzz, out of an abundance of caution, wished to ensure that a Section 8 declaration was in place, regardless of the outcome of the Cancellation. Accordingly, Starbuzz filed a petition to the Director of the USPTO to withdraw the Section 15 designation from the Section 8 and 15 declaration, and/or enter a new Section 8 declaration (the “Petition”).

Throughout its request to strike the Petition, SIS Resources makes inflammatory accusations that Starbuzz’s Petition was made with the underlying motive to circumvent the Cancellation. By repeatedly accusing Starbuzz of taking “improper” and “fraudulent” actions and playing “fast and loose” with filings, SIS Resources attempts to distract the Trademark Trial and Appeal Board (the “Board”), rather than focus on substantive issues, because its arguments have no legal basis. Indeed, Starbuzz’s right to file the Petition is expressly authorized by TMEP §1605.03. SIS Resources, on the other hand, has failed to identify a single case, regulation, rule,

or section from the Trademark Manual of Examining Procedure (“TMEP”) or the Trademark Board Manual of Procedure (“TBMP”) expressly prohibiting Starbuzz from filing the Petition.

SIS Resources also has no grounds to claim that Starbuzz’s Petition was an attempt to amend the BLUE MIST trademark registration. Starbuzz’s request did not alter the mark, the description of goods, classification of goods, dates of use, or any other item of information that appears on the trademark registration certificate. Rather, Starbuzz’s Petition was simply a request to change the manner in which the BLUE MIST trademark registration is maintained.

ARGUMENT

I. THERE IS NOTHING IN THE TRADEMARK RULES THAT PROHIBITED STARBUZZ FROM FILING ITS REQUEST TO WITHDRAW THE SECTION 15 DECLARATION

SIS Resources claims that Starbuzz was required to file its petition to the director as part of the current *inter partes* Cancellation. However, there is nothing in the Code of Federal Regulations (“CFR”), TBMP, or the TMEP requiring Starbuzz’s petition to be filed as part of an *inter partes* proceeding.

SIS Resources first claims that Starbuzz should have served a copy of the Petition on SIS Resources and the Board, citing to 37 C.F.R. §2.119. That section, however, only governs service of papers in *inter partes* proceedings. Starbuzz’s request for withdrawal was not an *inter partes* request for the Board to review any order or decision in this Cancellation. Rather, it was a post-registration request for the Director to remove the Section 15 designation from the BLUE MIST registration and, if necessary, accept the section 8 declaration of use in lieu of the combined section 8 and 15 declaration of use. Therefore, there was no need to serve SIS Resources or the Board.

Next, SIS Resources claims that Starbuzz's Petition was improper pursuant to 37 C.F.R. §2.146 because petitions to the Director in *inter partes* proceedings are proper only when there is an order or decision of the Board. Again, however, Starbuzz's Petition was not an *inter partes* request for the Director to review any order by the Board. Rather, Starbuzz's Petition was made pursuant to 37 C.F.R. §2.146(a). Nothing in that section limits such petitions to *inter partes* proceedings. In fact, 37 C.F.R. §2.146(a)(1) specifies that petitions may be taken in ex parte prosecution of an application, evidencing that petitions to the Director under 37 C.F.R. §2.146 may be made outside of *inter partes* proceedings.

SIS Resources also cites to TBMP § 905 to support its position. TBMP § 905 addresses whether a party can petition the Director to review a decision of the Board in an *inter partes* proceeding. It does not discuss or prohibit a party from filing a petition to the Director regarding other matters. In fact, the section recites 37 C.F.R. §2.146(a), which provided the basis for Starbuzz's petition, but does not discuss that regulation at all.

Similarly, TMEP § 1704 fails to support SIS Resources' position. That section specifically allows a trademark owner to petition the Director ex parte to withdraw a section 15 declaration of incontestability. TMEP § 1704 says nothing about this request being related to review of an order or decision by the Board. The part of TMEP § 1704 that discusses the petition to withdraw is also under a separate heading from the portion concerning *inter partes* proceedings.

Since there is no legal support for SIS Resources' position, SIS Resources' entire request is meritless.

II. STARBUZZ'S PETITION TO THE DIRECTOR WAS NOT A REQUEST TO AMEND THE REGISTRATION.

SIS Resources also argues in a footnote that Starbuzz is trying to seek amendment of the BLUE MIST registration without the consent of SIS Resources. This is not true. The TMEP sets forth specific ways in which a registration may be amended. *See* TMEP §§1609.02(d)-1609.11. Starbuzz's Petition did not seek any change to the BLUE MIST mark, the registration's description of goods, or any other information that appears on the registration certificate. Further, the TMEP does not mention in those sections that a request to withdraw or substitute a Section 8 and 15 declaration constitutes an amendment to the registration. Moreover, the filing of a Section 8 and 15 declaration does not result in the issuance of a new registration certificate, further evidencing that such declarations, and their withdrawal, does not constitute an amendment to the registration.

Additionally, TMEP §§1609.02(d)-1609.11 repeatedly refer to amendments performed pursuant to Section 7 of the Lanham Act (15 U.S.C. §1057). Though Section 7 mentions amendment and corrections of registrations, it does not make any mention of Section 15, or declarations of incontestability. Thus, there is no support for the idea that a Section 15 declaration, or its withdrawal, constitutes an amendment to the registration.

III. STARBUZZ'S PETITION WAS NOT AN ATTEMPT TO CIRCUMVENT THE *INTER PARTES* PROCEEDINGS

SIS Resources is also incorrect in claiming that Starbuzz's Petition was an attempt to circumvent the current *inter partes* proceedings. By initiating the current Cancellation, SIS Resources put Starbuzz's Section 8 and 15 declaration into dispute. However, since there is a specific timeframe in which a Section 8 renewal must be filed and accepted to maintain a trademark registration, it would be best to ensure that some sort of declaration remained on file

regardless of any alleged issues with the original declaration. Therefore, in an abundance of caution, Starbuzz sought entry of a substitute Section 8 declaration to ensure the USPTO's renewal requirements were met, regardless of the outcome of this Cancellation.

Similarly, there is no support for SIS Resources' claim that Starbuzz is making incomplete or untruthful filings in an attempt to avoid having to defend against the claim of fraud. Starbuzz is defending against the claim through its motion to dismiss. That motion explains that the Cancellation is baseless because Starbuzz's right to use the BLUE MIST trademark for tobacco products was never at issue in the dispute between Starbuzz and Lorillard, Inc. Thus, Starbuzz's section 8 and 15 declaration did not contain any false statements.

Further, as explained, the Petition also was not a concession that Starbuzz's filing of the Section 8 and 15 was improper, but an attempt to ensure that the BLUE MIST trademark registration was properly maintained, regardless of any issues with the original Section 8 and 15 declaration. To that extent, there was also nothing incomplete or untruthful about Starbuzz's Petition.

Furthermore, Starbuzz's Petition did not need to address the truth or falsity of the Section 8 and 15 declaration. The fact of the matter is the lawsuit between Starbuzz and LOEC, Inc. did not involve a challenge to Starbuzz's right to own and register the BLUE MIST trademark for tobacco products. Thus, Starbuzz's Section 15 declaration was truthful.

IV. THE REQUEST TO STRIKE IS MOOT BECAUSE THE DIRECTOR HAS ALREADY GRANTED THE WITHDRAWAL OF THE SECTION 15 PORTION OF STARBUZZ'S BLUE MIST REGISTRATION

Finally, Starbuzz notes that the portion of SIS Resources' notice asking the Board to strike the Petition is moot, since the Director granted Starbuzz's petition on May 7, 2015.

CONCLUSION

Based on the foregoing, Registrant Starbuzz Tobacco, Inc. respectfully requests that the Trademark Trial and Appeal Board deny SIS Resources' requests.

Respectfully submitted,
THE PATEL LAW FIRM, P.C.

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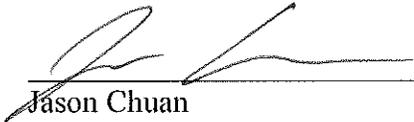
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CERTIFICATE OF SERVICE

I certify that a copy of REGISTRANT STARBUZZ TOBACCO, INC.'S OPPOSITION TO PETITIONER'S NOTICE TO THE UNITED STATES TRADEMARK TRIAL AND APPEAL BOARD OF REGISTRANT'S PETITION TO DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE, AND REQUEST FOR AN ORDER ADMONISHING REGISTRANT AND ORDERING THAT THE PETITION TO THE DIRECTOR BE STRICKEN, REJECTED, OR WITHDRAWN is being served via United States mail, postage prepaid, on this the 8th day of May 2015, to the following:

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