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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. |
| Correspondence Address | STARBUZZ TOBACCO INC 10871 FORBES AVE GARDEN GROVE, CA 92843 UNITED STATES |
| Submission | Motion to Suspend for Civil Action |
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| Date | 03/23/2015 |
| Attachments | Motion to Consolidate and Suspend - 032315.pdf(1680191 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.,

Petitioner,

v.

STARBUZZ TOBACCO, INC.,

Registrant.

CANCELLATION NO: 92060895

**REGISTRANT STARBUZZ TOBACCO,
INC.'S MOTION TO CONSOLIDATE
AND SUSPEND PROCEEDINGS**

Petition Filed: February 17, 2015

[RELATED OPPOSITION NO. 91213286]

INTRODUCTION

Pursuant to 37 C.F.R. § 2.117(a), Fed. R. Civ. P. 42(a), and TBMP § 510.02(a) and 511, Registrant, Starbuzz Tobacco, Inc. (“Starbuzz”), through its undersigned counsel, hereby requests the Trademark Trial and Appeal Board (“Board”) to consolidate this case with Opposition No. 91213286 (the “Opposition”) and suspend this Cancellation No. 92060895 (the “Cancellation”) pending the final determination of *Starbuzz Tobacco, Inc. v. SIS Resources Ltd., et al.*, Case No. 8:15-cv-00176 (the “Civil Action”).

The Opposition was initiated by Registrant Starbuzz against Petitioner, SIS Resources Ltd. (“SIS”), and involves the exact same marks at issue, BLUE MIST (Reg. No. 3,619,407) and MOCHA MIST (Application Serial No. 85/846,992). Before SIS filed this Cancellation, the Opposition had been suspended pending disposition of the Civil Action. Since SIS has initiated this Cancellation to circumvent the suspension, this case should be consolidated with the Opposition and suspended.

FACTUAL BACKGROUND

Starbuzz initially filed the Opposition against SIS's trademark application for the mark MOCHA MIST (Application Serial No. 85/846,992), based upon its ownership of the BLUE MIST and CITRUS MIST trademarks (collectively, the "Starbuzz Marks").

On February 4, 2015, Starbuzz initiated the Civil Action against SIS in the District Court. *See **Exhibit I***. In the Civil Action, Starbuzz alleges that SIS, along with Nu Mark LLC, has infringed upon Starbuzz's rights because Starbuzz has priority to the Starbuzz Marks over the MOCHA MIST mark, and the marks are likely to be confused with each other. Starbuzz further requests for an order from the District Court directing SIS to withdraw and abandon the application to register the MOCHA MIST mark. SIS will have to assert any and all possible challenges it has to the validity and registration of the Starbuzz Marks, including the allegations made in this Cancellation, as **compulsory counterclaims** in the Civil Action. Therefore, in reaching a judgment in the Civil Action, the Court will necessarily need to resolve all of the issues that are currently before the Board with respect to the Opposition proceeding.

On February 9, 2015, Starbuzz filed a motion to suspend the Opposition, based upon the Civil Action. On February 12, 2015, the Board suspended the Opposition.

The petition for this Cancellation was not filed until February 17, 2015, a few days after the Board's suspension of the Opposition. Since SIS had the ability to assert the grounds for this Cancellation as counterclaims in the Opposition, it appears that SIS initiated this Cancellation **in order to circumvent** the suspension. Therefore, this Cancellation should be consolidated with the Opposition and suspended in view of the Civil Action.

ARGUMENT

I. THIS CANCELLATION SHOULD BE CONSOLIDATED WITH THE OPPOSITION BECAUSE THEY INVOLVE COMMON QUESTIONS OF LAW OR FACT

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. TBMP § 511. In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. *Id.* Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered, it is not always necessary. *Id.*

A. There are Common Questions of Law or Fact Since the Opposition Involves the Same Trademarks between the Same Parties.

There are common questions of law or fact because both the Cancellation and Opposition involve the same trademarks between the same parties. Indeed, SIS specifically included references to the Opposition and Civil Action in the petition for cancellation, alleging that it believed that it was likely to be injured by the continued registration of BLUE MIST. Docket No. 1 ¶¶ 4, 5. Instead of filing a separate petition to cancel, SIS should have filed counterclaims for cancellation of the BLUE MIST registration in the Opposition. *See* TBMP § 313.01 (“If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned.”). Since the parties and trademarks are identical, and the issues related, the proceedings should be consolidated. *See M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (proceeding involved identical parties, identical registrations and related issues).

B. Consolidating The Proceedings Will Save Time, Effort, and Expense.

There is little sense in having two separate TTAB proceedings involving the same trademarks and the same parties. Assuming *arguendo* that this Cancellation were to proceed, Starbuzz would have to bring the claims made in the Opposition as compulsory counterclaims to this Cancellation. This would result in unnecessary duplication of discovery and motion practice.

Furthermore, consolidating this Cancellation with the suspended Opposition would avoid unnecessary expenditure of resources since the Civil Action is still pending. Thus, it is possible for SIS to assert the allegations in this Cancellation as counterclaims there. There is little sense in litigating parallel proceedings involving the same issues.

II. THIS CANCELLATION SHOULD ALSO BE SUSPENDED IN VIEW OF THE CIVIL ACTION

Regardless of whether this Cancellation is consolidated with the Opposition, it should still be suspended based upon the pendency of the Civil Action. Where a party to a case pending before the Board is also involved in a civil action that may have a bearing on a matter before the Board, it may suspend the proceeding until the final determination of the civil action. 37 C.F.R. § 2.117(a); TBMP § 510.02(a). This is because a decision by the United States District Court would be binding on the Board, whereas a determination by the Board as to a party's right to registration would not be binding or *res judicata* with respect to the proceeding before the United States District Court. *See, e.g., J. Thomas McCarthy, 6 McCarthy on Trademarks and Unfair Competition* § 32:94 (4th Ed. 2009).

In the Civil Action, Starbuzz asserts legal claims against Applicant, which relate directly to the claims and defenses raised in the instant Opposition proceeding. As

binding precedent, the District Court's determinations in the Civil Action will directly affect the resolution of the issues currently before the Board.

For example, SIS alleges in the Cancellation that Starbuzz committed fraud upon the USPTO when filing its section 8 and 15 declaration for BLUE MIST. In the civil action, Starbuzz claims that SIS is infringing the Starbuzz Marks, which includes BLUE MIST. SIS will have to assert the allegations of this Cancellation as compulsory counterclaims in the Civil Action. Therefore, the District Court will have to determine whether Starbuzz committed fraud upon the USPTO when filing its Section 8 and 15 declaration for BLUE MIST. Thus, the District Court's determination on such matters will constitute binding precedent.

CONCLUSION

Based upon the foregoing, Starbuzz respectfully requests the Honorable Board to consolidate the Cancellation proceeding with the Opposition, and/or suspend the Cancellation proceeding pending the final determination of the Civil Action.

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

/natupatel/
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CERTIFICATE OF SERVICE

I certify that a copy of REGISTRANT STARBUZZ TOBACCO, INC.'S
MOTION TO CONSOLIDATE AND SUSPEND PROCEEDINGS is being served via
United States mail, postage prepaid, on this the 23rd day of March 2015, to the following:

Applicant's Attorney/Representative:

ANN K FORD
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Mark Uy

Exhibit I

1 Plaintiff, Starbuzz Tobacco, Inc. complains and alleges as follows:

2 **PARTIES**

3
4 1. Plaintiff, Starbuzz Tobacco, Inc. (“Starbuzz” or “Plaintiff”), is now,
5 and at all times relevant herein was, a corporation organized under the laws of the
6 State of California, with its principal place of business in the City of Garden
7 Grove, California.
8

9 2. Defendant, SIS Resources LTD. (“SIS Resources”), is now, and at all
10 times relevant herein was, a corporation organized under the laws of Israel, with its
11 principal place of business at 9/2 Nahal Arugot St., Ramat Beit Shemesh, Israel
12 99097. Starbuzz is informed and believes, and on that basis alleges, that SIS
13 Resources is the owner of the infringing MOCHA MIST trademark which it uses
14 and displays in this judicial district.
15
16
17

18 3. Defendant Nu Mark LLC (“Nu Mark”) is now, and at all times
19 relevant herein was, a limited liability company organized under the laws of the
20 State of Virginia, with its principal place of business at 6603 W. Broad Street,
21 Richmond, Virginia 23260. Defendant Nu Mark does business within this judicial
22 district through its website www.greensmoke.com which displays the infringing
23 MOCHA MIST trademark to consumers in this judicial district.
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1 4. Starbuzz is informed and believes, and on that basis alleges, that in
2 April 2014, Nu Mark acquired the original owner of the www.greensmoke.com
3 website, namely Green Smoke, LLC.
4

5 5. SIS Resources and Nu Mark are collectively referred to as
6 “Defendants.”
7

8 6. Starbuzz is informed and believes, and on that basis alleges, that
9 Defendants are responsible for each of their acts and for their conduct, which are
10 the true legal causes for the damages herein alleged.
11

12 JURISDICTION AND VENUE

13 7. This Court has original jurisdiction over this action pursuant to 15
14 U.S.C. §§1119 and 1121, and 28 U.S.C. §§1331 and 1338, in that this Complaint
15 raises federal questions under the United States Trademark Act (Lanham Act), 15
16 U.S.C. §1051 et seq. The Court has supplemental jurisdiction over the state law
17 claims pursuant to 28 U.S.C. §1367.
18
19

20 8. The Court has personal jurisdiction over Defendants because they
21 have purposefully engaged in using trademarks that are identical to, and
22 confusingly similar to, Starbuzz’s trademarks in connection with the sale and
23 distribution of electronic cigarettes and e-liquids. Since Starbuzz’s registered
24 trademarks provide constructive notice of Starbuzz’s intellectual property rights
25 and Starbuzz’s location, Defendants knew or should have known that their
26
27
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1 activities were directed towards California, and the effect of those activities would
2 be felt in California.

3
4 9. The Court also has personal jurisdiction over Defendants because
5 Defendants have engaged in business activities in and directed to California, and
6 have committed tortious acts within the State.

7
8 10. The Court also has personal jurisdiction over Defendants because they
9 have purposefully availed themselves of the opportunity to conduct commercial
10 activities in this forum. The Complaint arises out of those commercial activities.

11
12 11. Venue is proper in this district under 28 U.S.C. § 1391 (b) and (c) in
13 that substantial injury occurred and continues to occur in this district, a substantial
14 portion of the events that are the subject of this action took place in this district,
15 and Defendants are doing business within this judicial district and are subject to
16 personal jurisdiction in this district.
17

18
19 **AGENCY**

20
21 12. At all times herein mentioned, each Defendant was the agent, servant,
22 joint venturer, partner, or employee of the other Defendants, successor
23 corporations, successors in interest, or entities and, in doing the things herein
24 alleged, were acting within the purpose and scope of said agency or employment at
25 the time of the incident. All Defendants were acting within the scope and course
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27
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1 of that agency and employment and with the knowledge and implied and/or
2 express consent and permission of the other Defendants.

3 **INTRODUCTION**

4
5 13. This case alleges a straightforward yet egregious claim of trademark
6 infringement, and other violations of federal and state law. It is egregious because
7
8 Defendants have intentionally duplicated, adopted, and used trademarks that are
9 identical or substantially similar to Starbuzz's trademarks in their products with
10 blatant disregard to Starbuzz's intellectual property rights, in order to unfairly
11 compete with Starbuzz and to trade upon Starbuzz's goodwill.
12

13
14 14. As a manufacturer and supplier of premium hookah tobacco, as well
15 as a distributor of hookahs, electronic cigarettes, electronic vaporizers, e-liquids
16 and other products worldwide, Starbuzz has obtained over ninety (90) federally
17 registered trademarks in the United States and has sought to obtain worldwide
18 intellectual property protection in more than thirty-three (33) countries.
19

20
21 15. Over the past several years, Starbuzz has sold, and continues to sell,
22 tobacco products, electronic cigarettes, e-liquid, and electronic vaporizers bearing
23 one or more of the following trademarks: BLUE MIST and CITRUS MIST.
24 Starbuzz's aforementioned marks are collectively referred to as the "Starbuzz
25 Marks."
26
27
28

1 16. Starbuzz discovered that Defendants are using trademarks that are
2 identical or substantially similar to the Starbuzz Marks in connection with
3 Defendants' products.
4

5 17. Defendants are not affiliated with Starbuzz in any way, and do not
6 have Starbuzz's permission to use the Starbuzz Marks, or any mark that is
7 confusingly similar to the Starbuzz Marks.
8

9 18. Defendants intentionally adopted and use the confusingly similar
10 trademark MOCHA MIST in connection with electronic cigarettes, cartridges, and
11 vaporizers (the "Infringing Products"), to falsely convey to consumers, vendors,
12 and third parties an association with Starbuzz, and to unfairly trade and benefit
13 from the reputation and goodwill of Starbuzz's business and the Starbuzz Marks.
14

15 19. On February 12, 2013, Defendant SIS Resources filed a trademark
16 application, serial no. 85/846,992 for the MOCHA MIST trademark under Section
17 1(b) of the Lanham Act, 15 U.S.C. § 1051(a), alleging a date of first use of
18 September 19, 2010. The MOCHA MIST trademark is referred to herein as the
19 "Infringing Mark."
20
21

22 20. Defendants are aware that their actions are specifically prohibited and
23 are on notice that Starbuzz has not consented to their actions in any way.
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1 **STARBUZZ'S CONTINUOUS USE OF ITS MARKS**

2 26. Starbuzz manufactures, distributes, imports, and sells tobacco
3 products throughout the United States and internationally. Starbuzz also
4 distributes and sells tobacco alternative products, such as electronic cigarettes, e-
5 liquids, and other related products throughout the United States and internationally.
6 Starbuzz prides itself on its reputation for high-quality products. Starbuzz's
7 continued goal is to develop new and popular tobacco, tobacco alternatives, and
8 other related products while preserving the quality of its products and brand
9 identity.
10
11
12

13 27. Starbuzz sells its products to thousands of customers and clients,
14 including boutique stores, wholesalers, and suppliers. Starbuzz has used, created
15 and marketed the Starbuzz Marks continuously over the years. The Starbuzz
16 Marks have brought Starbuzz enormous success, and Starbuzz is now known for its
17 high quality products.
18
19

20 28. Starbuzz uses the Starbuzz Marks on advertising brochures,
21 advertising leaflets, on the Internet, and on the packaging of its products.
22

23 29. Starbuzz's intellectual property and brand identity have substantial
24 image recognition.
25

26 30. The Starbuzz Marks are important as they serve as easily-recognizable
27 identifiers of the high quality goods and services that Starbuzz offers. There is a
28

1 particularly close association among consumers between Starbuzz, the Starbuzz
2 Marks, and the quality of the products and services offered under the Starbuzz
3 Marks. For consumers, customers, vendors, and clients, the Starbuzz Marks are
4 associated with original, flavorful, and smooth smoking tobacco, tobacco
5 alternatives, and related products of the highest quality at an affordable price.
6
7

8 **DEFENDANT'S WRONGFUL ACTS**

9 Sales of Infringing Products

10 31. Starbuzz is informed and believes, and on that basis alleges, that
11 Defendants have sold and are currently selling, distributing, advertising and
12 promoting the Infringing Products on the website www.greensmoke.com. Plaintiff
13 is informed and believes, and thereon alleges, that Nu Mark distributes SIS
14 Resources' products throughout the United States, including California, through
15 that website. True and correct copies of printouts from various parts of the website
16 www.greensmoke.com are attached hereto as **Exhibit C**.
17
18
19

20 32. Starbuzz is informed and believes, and on that basis alleges, that
21 Defendants have continuously and systematically distributed the Infringing
22 Products throughout California and the United States, misled and confused
23 consumers, and negatively affected the publicity regarding the Starbuzz products.
24
25
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1 33. Starbuzz is informed and believes, and on that basis alleges, that
2 Defendants are using the Infringing Mark to market, promote, advertise and sell
3 the Infringing Products.
4

5 34. Starbuzz is informed and believes, and on that basis alleges, that
6 Defendants knew of Starbuzz's prior use of the Starbuzz Marks by virtue of
7 Starbuzz's trademark registrations and reputation in the tobacco market.
8

9 35. Nonetheless, Defendants adopted the Infringing Mark to market and
10 sell the Infringing Products, to deceive consumers into believing that the Infringing
11 Products are produced and manufactured by Starbuzz, and to trade upon Starbuzz's
12 goodwill.
13

14
15 Defendants' Use of the Infringing Mark is Likely to Cause Consumer Confusion

16 36. Defendants' distribution and sale of the Infringing Products bearing
17 the Infringing Mark is likely to cause consumer confusion.
18

19 37. To date, Defendants are continuing with their infringing activity.
20

21 38. Starbuzz is informed and believes, and on that basis alleges, that
22 Defendants began using the Infringing Mark after Starbuzz began using the
23 Starbuzz Marks for various products. Therefore, Starbuzz's rights in the Starbuzz
24 Marks have priority over Defendants' rights in the Infringing Mark.
25

26 39. Starbuzz is informed and believes, and on that basis alleges, that
27 Defendants knew of Starbuzz's prior use of the Starbuzz Marks. Nonetheless,
28

1 Defendants adopted and/or used the Infringing Mark to advertise their business and
2 products.

3
4 40. Starbuzz is informed and believes, and on that basis alleges, that given
5 the similar or related nature of Starbuzz's products and the Infringing Products,
6 and the similarity between the Infringing Mark and the Starbuzz Marks, consumers
7
8 are likely to be confused as to the source of Starbuzz's products and Defendants'
9 products.

10
11 41. Starbuzz is further informed and believes, and on that basis alleges,
12 that Defendants intentionally, and in bad faith, adopted and used the Infringing
13 Mark to trade upon the fame and goodwill associated with the Starbuzz Marks, to
14 deceive consumers, vendors and third parties, to attract new business in
15 competition to Starbuzz, and to derive an economic benefit therefrom.

16
17
18 42. Defendants knowingly used and continue to use the Infringing Mark
19 without Starbuzz's consent or authorization.

20
21 43. The products that Defendants offer under the Infringing Mark are in
22 the same category of products which Starbuzz offers under the Starbuzz Marks.
23 Therefore, Defendants' use of the Infringing Mark is likely to cause consumer
24 confusion.

25
26 44. Starbuzz and Defendants sell their products online. Starbuzz and
27 Defendants thus have convergent marketing channels.
28

1 45. Starbuzz is further informed and believes, and on that basis alleges,
2 that Starbuzz and Defendants have convergent marketing channels since they sell
3 and market products within the same geographic area.
4

5 46. Defendants' use of convergent marketing channels increases the
6 likelihood of consumer confusion.
7

8 47. Defendants' continued use of the Infringing Mark is thus likely to lead
9 consumers, retailers, wholesalers, and vendors to mistakenly conclude that
10 Defendants' products are affiliated, connected, or associated with Starbuzz.
11 Consumers are likely to be misled and confused as to the true source, sponsorship,
12 or affiliation of Defendants' products.
13
14

15 48. Starbuzz never consented, either orally or in writing, to allow
16 Defendants to use trademarks identical or similar to the Starbuzz Marks for any
17 reason, including the marketing and sale of Infringing Products.
18

19 49. Defendants knowingly used and continue to use the Infringing Mark
20 without Starbuzz's consent or authorization.
21

22 **FIRST CLAIM FOR RELIEF**
23 **[Trademark Infringement Under Lanham Act 15 U.S.C. §1114]**
24 **(Against All Defendants)**

25 50. Starbuzz re-alleges and incorporates by this reference paragraphs 1
26 through 49, inclusive, of this Complaint as if fully set forth herein.
27
28

1 51. Defendants' use of the Infringing Mark to promote, market, or sell
2 Infringing Products constitutes trademark infringement pursuant to 15 U.S.C.
3 §1114.
4

5 52. Defendants have promoted, sold, and marketed, and continue to
6 promote, sell, and market, Infringing Products using the Infringing Mark, which
7
8 are identical or confusingly similar to the Starbuzz Marks.

9 53. Starbuzz is informed and believes, and on that basis alleges, that its
10 use of the Starbuzz Marks in commerce predates Defendants' use of the Infringing
11 Mark in commerce.
12

13 54. The Starbuzz Marks are highly distinctive, arbitrary and/or fanciful,
14 and are entitled to strong trademark protection.
15

16 55. Defendants continue to promote, sell and market the Infringing
17 Products under the Infringing Mark, in direct competition with Starbuzz's
18 products, which Starbuzz promotes, sells, and markets under the Starbuzz Marks.
19 Defendants therefore use the Infringing Mark on the same, related, or
20 complementary category of goods as Starbuzz.
21

22 56. Defendants' Infringing Mark is so similar in appearance,
23
24 pronunciation, meaning, and commercial impression to the Starbuzz Marks that
25 consumers are likely to be confused as to the source of the parties' products.
26
27
28

1 57. Starbuzz is informed and believes, and on that basis alleges, that
2 Defendants market and sell their products throughout the United States through
3 various channels, including, but not limited to, the internet and retail stores and
4 shops. These are the same channels through which Starbuzz markets and sells its
5 goods. These are the same channels through which Starbuzz markets and sells its
6 goods.

7
8 58. Starbuzz is informed and believes, and on that basis alleges, that
9 Defendants intentionally and willfully adopted the Infringing Mark in an effort to
10 deceive or cause confusion with the consuming public.

11
12 59. Defendants' attempts to cause confusion, or to cause mistake, or to
13 deceive further indicate an intentional and willful infringement upon the Starbuzz
14 Marks.

15
16 60. Defendants' continued use of the Infringing Mark also demonstrates
17 Defendants' intentional and willful infringement of the Starbuzz Marks.

18
19 61. Defendants' intentional, continuing, and willful infringement of the
20 Starbuzz Marks has caused and will continue to cause damage to Starbuzz, and is
21 causing irreparable harm to Starbuzz for which there is no adequate remedy at law.

22 62. Defendants are directly, contributorily, and/or vicariously liable for
23 these actions.
24
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1 **SECOND CLAIM FOR RELIEF**
2 **[Trademark Infringement - False Designation of Origin Under**
3 **Lanham Act 15 U.S.C. §1125(a)(1)(A)]**
4 **(Against All Defendants)**

5 63. Starbuzz re-alleges and incorporates by this reference paragraphs 1
6 through 62, inclusive, of this Complaint as if fully set forth herein.

7 64. In connection with Infringing Products, Defendants knowingly and
8 willfully used in commerce, words, terms, names, symbols, or devices, or a
9 combination thereof, which are likely to cause confusion, or to cause mistake, or to
10 deceive as to the affiliation, connection, or association of Defendants with
11 Starbuzz, or as to the origin, sponsorship, or approval of Defendants' goods.
12

13 65. Starbuzz is informed and believes, and on that basis alleges, that
14 Defendants willfully and intentionally created a false or misleading affiliation,
15 connection, or association between Defendants' goods and Starbuzz's goods.
16
17

18 66. Starbuzz is informed and believes, and on that basis alleges, that
19 Defendants adopted words, terms, names, symbols, or devices, or a combination
20 thereof, which are similar to the Starbuzz Marks, or willfully and intentionally
21 marketed their goods and services with words, terms, names, symbols, or devices,
22 or a combination thereof, similar to the Starbuzz Marks.
23
24

25 67. Starbuzz is informed and believes, and on that basis alleges, that
26 Starbuzz's use of the Starbuzz Marks in commerce precedes Defendants' use of the
27 Infringing Marks in interstate commerce.
28

1 68. Starbuzz is informed and believes, and on that basis alleges, that
2 Defendants' aforesaid acts were done with knowledge of Starbuzz's trademarks,
3 and the knowledge that use of such words, terms, names, symbols, or devices, or a
4 combination thereof, was misleading.
5

6 69. Defendants' intentional and willful infringement of Starbuzz's
7 trademarks has caused and will continue to cause damage to Starbuzz and is
8 causing irreparable harm to Starbuzz for which there is no adequate remedy at law.
9
10

11 70. Starbuzz was damaged by these acts in an amount to be proven at
12 trial. Defendants' actions have caused and will continue to cause irreparable harm
13 to Starbuzz for which there is no adequate remedy at law. Thus, Starbuzz is also
14 entitled to injunctive and equitable relief against Defendants under the Lanham
15 Act.
16

17 71. Defendants are directly, contributorily, and/ or vicariously liable for
18 these actions.
19

20
21 **THIRD CLAIM FOR RELIEF**
22 **[Unfair Competition – Violation of California**
23 **Business and Professions Code §17200 et seq.]**
24 **(Against All Defendants)**

25 72. Starbuzz re-alleges and incorporates by this reference paragraphs 1
26 through 71 inclusive, of this Complaint as if fully set forth herein.

27 73. Starbuzz is informed and believes, and on that basis alleges, that
28 Defendants' aforesaid acts constitute actionable wrongs under California Business

1 and Professions Code §17200 *et seq.* in that Defendants' unlawful, unfair, or
2 fraudulent use of words, terms, names, symbols, or devices, or a combination
3 thereof, which are similar to the Starbuzz Marks, create a probability of confusion
4 or misunderstanding as to the source, sponsorship, approval, or certification of
5 Starbuzz's and Defendants' goods.
6

7
8 74. Starbuzz is informed and believes, and on that basis alleges, that
9 Defendants have offered and continue to market goods using words, terms, names,
10 symbols, or devices, or a combination thereof, which are similar to the Starbuzz
11 Marks, in an attempt to unfairly compete with Starbuzz.
12

13 75. Starbuzz is further informed and believes, and on that basis alleges,
14 that Defendants have also been attempting to unfairly compete with Starbuzz
15 through the use of deceptive and/or misleading advertising.
16

17
18 76. By reason of the foregoing unlawful acts, Defendants have caused,
19 and continue to cause, substantial and irreparable damage and injury to Starbuzz
20 and to the public. Defendants have benefited from such unlawful conduct, and will
21 continue to carry out such unlawful conduct and to be unjustly enriched thereby,
22 unless enjoined by this Court.
23

24
25 77. As a proximate and direct result of Defendants' acts as herein alleged,
26 Starbuzz has sustained damages in an amount to be proven at trial.
27
28

1 78. Defendants are directly, contributorily and/or vicariously liable for
2 these actions.

3 **FOURTH CLAIM FOR RELIEF**
4 **[Common Law Trademark Infringement and Unfair Competition]**
5 **(Against All Defendants)**

6 79. Starbuzz re-alleges and incorporates by this reference paragraphs 1
7 through 78, inclusive, of this Complaint as if fully set forth herein.

8
9 80. Starbuzz is informed and believes, and on that basis alleges, that
10 Defendants' aforesaid acts constitute actionable wrongs under the common law in
11 that Defendants' use of the Infringing Mark constitutes an infringement and
12 violation of Starbuzz's rights in its trademarks, and creates a likelihood that
13 Starbuzz's customers, potential customers, and the public generally will be
14 confused or misled as to the source of goods and services because they are likely to
15 believe that Defendants' products are identical to or affiliated with that of
16 Starbuzz.
17

18
19 81. By reason of the foregoing unlawful acts, Defendants have caused,
20 and continue to cause, substantial and irreparable damage and injury to Starbuzz
21 and to the public. Defendants have benefited from such unlawful conduct and will
22 continue to carry out such unlawful conduct and to be unjustly enriched thereby
23 unless enjoined by this Court.
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1 82. As a proximate and direct result of Defendants' acts as herein alleged,
2 Starbuzz has sustained damages in an amount to be proven at trial.

3 83. Defendants are directly, contributorily and/or vicariously liable for
4 these actions.
5

6 **PRAYER FOR RELIEF**
7

8 WHEREFORE, Starbuzz respectfully prays for judgment against Defendants
9 as follows:
10

11 **ON THE FIRST AND SECOND CLAIMS**

12 1. An Order finding that Defendants have infringed Starbuzz's
13 intellectual property rights;
14

15 2. An Order requiring Defendants to account for and disgorge any and
16 all profits received by the use of Starbuzz's intellectual property pursuant to 15
17 U.S.C. §1117(a)(1);
18

19 3. An award of the attorneys' fees and costs of this action, in an amount
20 to be determined at trial, pursuant to 15 U.S.C. §1117(a)(3) and other applicable
21 federal and state law;
22

23 4. An Order directing the recall from the marketplace and destruction of
24 unauthorized materials bearing Starbuzz's trademarks, or any confusingly similar
25 marks, including, but not limited to, the marks BLUE MIST, CITRUS MIST, and
26 MOCHA MIST in any manner, for purposes of advertising or selling, or soliciting
27
28

1 purchases of products or services, or products sold in the course of providing such
2 services, or any related activities, pursuant to 15 U.S.C. §1118;

3
4 5. A preliminary and permanent injunction, pursuant to 15 U.S.C. §1116,
5 enjoining and prohibiting Defendants and any of their officers, directors,
6 employees, agents, subsidiaries, distributors, dealers, and all persons in active
7
8 concert or participation with any of them from:

9 A. Using Starbuzz's trademarks, or any confusingly similar marks,
10 including, but not limited to, the marks BLUE MIST, CITRUS MIST, and
11 MOCHA MIST, in any manner, on or in products, merchandise, or goods, or for
12 purposes of advertising, selling, or soliciting purchases of, products or
13
14 merchandise;

15
16 B. Infringing on Starbuzz's trademarks;

17
18 C. Assisting, aiding, or abetting any other person or business entity in
19 engaging in or performing any of the activities referred to in subparagraphs (A)
20 and (B) above;

21
22 6. An Order requiring Defendants and their agents, servants, and
23 employees and all persons acting in concert with or for them to file with this Court
24 and serve on Starbuzz, within thirty (30) days after service of an injunction, a
25 report in writing, under oath, setting forth in detail the manner and form in which
26
27
28

1 Defendants have complied with the applicable injunction, pursuant to 15 U.S.C.
2 §1116;

3
4 7. An Order requiring Defendants to withdraw and abandon their
5 trademark application, serial no. 85/846,992, for the infringing MOCHA MIST
6 Trademark or cancelling Defendant's infringing MOCHA MIST Trademark
7 pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, if it proceeds to
8 registration;
9

10
11 8. Pre-judgment and post-judgment interest on any amounts awarded at
12 the maximum legal rate as permitted by law and equity; and

13
14 9. Any other or further relief that the Court deems appropriate, proper,
15 and just.

16 **ON THE THIRD AND FOURTH CLAIMS**

17
18 1. An Order finding that Defendants have infringed Starbuzz's
19 intellectual property rights and unfairly competed with Starbuzz;

20
21 2. Judgment for Starbuzz and against Defendants for actual, special, and
22 consequential damages, in an amount to be proven at trial and for costs incurred in
23 the litigation;

24
25 3. An Order requiring Defendants to account for and disgorge all gains,
26 profits, and advantages from the violations of California State, and common law;
27
28

1 4. A preliminary and permanent injunction, enjoining and prohibiting
2 Defendants and any of their officers, directors, employees, agents, subsidiaries,
3 distributors, dealers, and all persons in active concert or participation with any of
4 them from using the marks BLUE MIST, CITRUS MIST, and MOCHA MIST to
5 advertise, solicit business or otherwise compete with Starbuzz.
6

7
8 5. Pre-judgment and post-judgment interest on any amounts awarded at
9 the maximum legal rate as permitted by law and equity; and
10

11 6. Any other or further relief that the Court deems appropriate, proper,
12 and just.
13

14 DATED: February 4, 2015

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



15
16
17 Natu J. Patel,
18 Jason Chuan,
19 Daniel H. Ngai,
20 Attorneys for Plaintiff
21 Starbuzz Tobacco, Inc.
22
23
24
25
26
27
28

DEMAND FOR TRIAL BY JURY

1
2 Plaintiff Starbuzz Tobacco, Inc. hereby demands a trial by jury on all
3 issues raised in the Complaint.
4

5 DATED: February 4, 2015

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

7
8 

9 Natu J. Patel,
10 Jason Chuan,
11 Daniel H. Ngai,
12 Attorneys for Plaintiff
13 Starbuzz Tobacco, Inc.
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Exhibit A

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

United States Patent and Trademark Office

Reg. No. 3,619,407

Registered May 12, 2009

**TRADEMARK
PRINCIPAL REGISTER**

Blue Mist

STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)
UNIT #A
1889 W. COMMONWEALTH STREET
FULLERTON, CA 92833

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: PIPE TOBACCO, TOBACCO, SMOKING TOBACCO, FLAVORED TOBACCO, MOLASSES TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

SER. NO. 77-619,104, FILED 11-20-2008.

FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.

REGINA DRUMMOND, EXAMINING ATTORNEY

Exhibit B

United States of America

United States Patent and Trademark Office

Citrus Mist

Reg. No. 3,695,500 STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)
Registered Oct. 13, 2009 2116 W. LINCOLN AVENUE
ANAHEIM, CA 92801

Int. Cl.: 34 FOR: PIPE TOBACCO; MOLASSES TOBACCO; TOBACCO; SMOKING TOBACCO;
FLAVORED TOBACCO; HERBAL MOLASSES HERBS FOR SMOKING, TOBACCO AND
TOBACCO SUBSTITUTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

TRADEMARK
PRINCIPAL REGISTER FIRST USE 3-4-2008; IN COMMERCE 3-4-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,619,407.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CITRUS", APART FROM THE MARK AS SHOWN.

SER. NO. 77-699,076, FILED 3-25-2009.

DAVID YONTEF, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

Exhibit C

Flavored Cartridges



FLAVORMAX™ CARTRIDGES

Discover our FlavorMax Cartridges.™ Made with patented technology, these e-cig cartridges contain two main parts: a heating element and e-liquid. The heating element (aka “atomizer”) vaporizes the liquid into thick, realistic vapor, which contains nicotine and flavoring.

- ✓ Variety of 7 Flavors
- ✓ Choice of 5 Nicotine Levels
- ✓ Unbelievable Vapor Volume
- ✓ Flavor Shield™ Technology
- ✓ Smooth, Easy Draw
- ✓ Triple-Sealed for Freshness

(<http://www.greensmoke.com/e-cig->

| | | |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>RED LABEL TOBACCO™</p>  <p>Classic: Smooth and Mild</p> | <p>ABSOLUTE TOBACCO</p>  <p>Full-Bodied: Woody and Aromatic</p> | <p>TOBACCO GOLD™</p>  <p>Luxurious: Rich and Sweet</p> |
| <p>MENTHOL ICE™</p>  <p>Cool: A Refreshing Taste</p> | <p>MOCHA MIST™</p>  <p>Cultured: A Sophisticated Coffee Blend</p> | <p>SMOOTH CREAM™</p>  <p>Refined: A Gourmet and Creamy Blend</p> |
| <p>MOUNTAIN CLOVE™</p>  <p>Exotic: A Warm and Spicy Clove Blend</p> | <p>VARIETY PACK</p>  <p>Not Sure? Get A Variety Pack!</p> | |

Nicotine Levels

2.4%
NICOTINE

1.8%
NICOTINE

1.2%
NICOTINE

0.6%
NICOTINE

0%
NICOTINE

(<http://www.greensmoke.com/e-cig->



cartridges/)

Not all flavors are available in the state of California. If you live outside of California and are not able to order those flavors, please call our customer service and they'll be happy to assist you.

WARNING: This product contains nicotine which is a highly addictive substance. It is intended for use by existing smokers above legal age only. Do not use this product to treat any medical condition or habit. Do not use if pregnant, breast-feeding or suffering from any medical condition. Stop use if you show any sensitivity to this product. This product contains nicotine, a chemical known to the State of California to cause birth defects or other reproductive harm.

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