

ESTTA Tracking number: **ESTTA174289**

Filing date: **11/13/2007**

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	Pabst Brewing Company
Granted to Date of previous extension	11/14/2007
Address	100 Shoreline Highway Building B Suite 395 Mill Valley, CA 94941 UNITED STATES
Attorney information	Wendy Brasunas Jones Day 222 E 41st St. New York, NY 10017 UNITED STATES wlbrasunas@jonesday.com, blovejoy@jonesday.com, nytef@jonesday.com Phone:212-326-3939

**Applicant Information**

Application No	78869062	Publication date	07/17/2007
Opposition Filing Date	11/13/2007	Opposition Period Ends	11/14/2007
Applicant	MR. HAWAII, INC. 16817 S. Western Avenue Gardena, CA 90247 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 1996/03/11 First Use In Commerce: 1996/03/11 All goods and services in the class are opposed, namely: Caps; Shorts; Sport shirts; Sweat shirts; Swimming trunks; T-shirts; Tank tops
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1477038	Application Date	08/01/1986
Registration Date	02/16/1988	Foreign Priority Date	NONE
Word Mark	PRIMO BEER		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 1985/12/00 First Use In Commerce: 1985/12/00 BEER

U.S. Registration No.	1477037	Application Date	08/01/1986
Registration Date	02/16/1988	Foreign Priority Date	NONE
Word Mark	PRIMO BEER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1985/12/00 First Use In Commerce: 1985/12/00 BEER		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PRIMO; PRIMO BEER		
Goods/Services	articles of clothing, namely t-shirts, shorts, dresses, hats, sweatshirts, jackets, and Hawaiian Apparel		

Attachments	73612443#TMSN.gif ( 1 page )( bytes ) 73612421#TMSN.gif ( 1 page )( bytes ) Pabst Notice of Opposition.PDF ( 7 pages )(313137 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	/Wendy L. Brasunas/
Name	Wendy L. Brasunas
Date	11/13/2007

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

In the matter of Trademark Application No.: 78/869062  
For the mark: PRIMO HAWAIIAN BEER  
Date Filed: April 25, 2006  
Published in the Official Gazette on: July 17, 2007

PABST BREWING COMPANY,

Opposer,

v.

MR. HAWAII, INC.,

Applicant.

Opposition No.: \_\_\_\_\_

COMMISSIONER FOR TRADEMARKS  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**NOTICE OF OPPOSITION**

1. Opposer Pabst Brewing Company ("Pabst"), a Delaware corporation, having a business address at 100 Shoreline Highway, Building B, Suite 395, Mill Valley, California 94941, believes that it is being and will be damaged by the registration of Application No. 78/869062 for the mark PRIMO HAWAIIAN BEER and hereby opposes the same. Pabst opposes this trademark pursuant to 15 U.S.C. § 1063(a), by and through its attorneys, based on likelihood of consumer confusion and dilution.

## OPPOSER AND ITS MARKS

2. Pabst is the owner, marketer and distributor of an international beer brand called Primo Beer. Through its predecessors in interest it has used the trademark PRIMO to identify its beer since as early as 1905.

3. PRIMO BEER originated in the state of Hawaii and has always been recognized by and associated with its Hawaiian heritage. For some time around World War II, PRIMO BEER may have been the only beer available for purchase in the state of Hawaii.

4. Pabst owns two federal trademark registrations for PRIMO brand beer: U.S. Registration No. 1477038 for “PRIMO BEER” & Design in International Class 032 for “beer” registered on February 16, 1988 and U.S. Registration No. 1477037 for “PRIMO BEER” & Design in International Class 032 for “beer” registered on February 16, 1988 (collectively, the “Primo Marks”).

5. The foregoing registrations constitute prima facie evidence of the validity of Pabst’s ownership and exclusive right to use PRIMO BEER in commerce and provide constructive notice of ownership thereof. The Primo Marks have not been abandoned by Opposer, and have become incontestable.

6. Pabst also has common law rights in the use of the trademark PRIMO on clothing, such as t-shirts, hats, sweatshirts, jackets, and Hawaiian Apparel. These articles of clothing are collateral goods to the Primo Marks for beer. As such, Pabst has the right to exclusive use of the Primo Marks on clothing.

7. Beginning at least as early as 1964, Pabst, through its predecessors in interest, began selling clothing emblazoned with the Primo Beer name and logo. Pabst, through its predecessors in interest and licensees, has continued to use the PRIMO trademark in connection with the manufacture, promotion and sale of a wide variety of clothing and related items since at least as early as 1964.

8. Pabst's common law rights to use of the trademark PRIMO on clothing are strongest when the use is affiliated with beer or brew or affiliated with the state of Hawaii or a Hawaiian theme such as on "Hawaiian shirts."

9. For over a century, Pabst's PRIMO brand has earned tremendous recognition for its distinct beer and related merchandise. It has achieved such notoriety that it has become famous.

10. Pabst's continuous and commercially successful use of its Primo Marks, both registered and acquired through common law, is symbolic of extensive good will and consumer recognition built up by Pabst through substantial amounts of time and effort in advertising and promoting the Primo Marks. These trademarks have come to serve as unique identifiers of Pabst's goods.

#### APPLICANT

11. The applicant of Application No. 78/869062 for PRIMO HAWAIIAN BEER is Mr. Hawaii, Inc. ("Mr. Hawaii" or "Applicant") with a last known address of 16817 South Western Avenue, P.O. Box F, Gardena, California 90247. Mr. Hawaii filed a use-based application for the mark PRIMO HAWAIIAN BEER, Application No. 78/869062, on April 25, 2006 for "Caps; Shorts; Sport shirts; Sweat shirts; Swimming trunks; T-shirts; Tank tops" in International Class 025. Applicant alleges first use of the mark as March 11, 1996.

12. Mr. Hawaii's choice to produce and sell shirts with the words "Primo Hawaiian Beer" on them was because these words refer to Pabst's widely recognized PRIMO BEER.

13. Mr. Hawaii sells "Hawaiian shirts" with the PRIMO BEER logo and trademark on them and, upon information and belief, intends to continue to sell such "Hawaiian shirts."

14. Mr. Hawaii trades on Pabst's goodwill by selling articles of clothing with Pabst's Marks on them to consumers familiar with PRIMO BEER.

#### LIKELIHOOD OF CONFUSION

15. Pabst repeats and re-alleges each and every allegation set forth in Paragraphs 1 through 14.

16. Since well prior to the filing date of Application No. 78/869062, and the date of first use alleged by Applicant, Pabst, through its predecessors in interest and licensees, has used the trademark PRIMO in commerce in the United States in connection with the advertising, promoting and sale of clothing and other goods.

17. Pabst's registrations and common law rights precede the filing date of Application No. 78/869062 and March 11, 1996, the date of first use alleged by Mr. Hawaii.

18. Pabst has exclusive rights to use the trademark PRIMO BEER on clothing.

19. Applicant's mark PRIMO HAWAIIAN BEER is confusing similar to Pabst's PRIMO BEER mark.

20. Purchasers who encounter items of clothing bearing the mark PRIMO HAWAIIAN BEER are likely to believe that, or at least wonder whether, the items originate from, or are

approved by, or are in some way associated with Pabst. Consumers who view Applicant's clothing are likely to incorrectly believe that the goods emanate from Pabst.

21. The application should not be granted registration because Mr. Hawaii's use of PRIMO HAWAIIAN BEER is likely to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

#### DILUTION

22. Pabst repeats and re-alleges each and every allegation set forth in Paragraphs 1 through 21.

23. Pabst's marks became famous well before the filing date of Application No. 78/869062 and March 11, 1996, the date of first use alleged by Mr. Hawaii.

24. Applicant's mark uses Pabst's goodwill and the fame of Pabst's PRIMO BEER to bolster recognition of its line of goods.

25. The application should not be granted registration because Applicant's mark so closely imitates Pabst's Primo Marks as to dilute or be likely to dilute the distinctive quality of the trademarks in violation of 15 U.S.C. § 1125(c)(1).

#### DAMAGES AND RELIEF REQUESTED

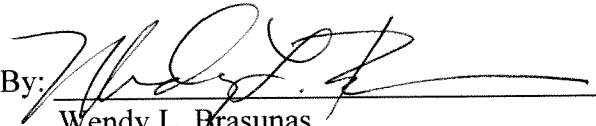
26. Pabst is being and will be damaged by the registration of the mark shown in Application No. 78/869062. Accordingly, and for the above cited reasons, Pabst respectfully requests that registration be refused and that this opposition be sustained.

27. The Commissioner is hereby authorized to charge Jones Day's Deposit Account Number 503013, in the amount of \$300 to account number 423980-999013. If any other fees are required, please also charge these to the Jones Day Deposit Account.

WHEREFORE, Opposer prays that Application No. 78/869062 be denied registration and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: November 13, 2007

By: 

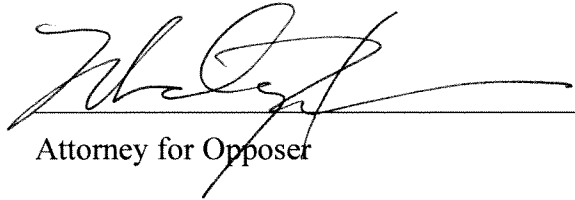
Wendy L. Brasunas  
Brett A. Lovejoy  
Roderick A. McLeod  
JONES DAY  
222 East 41st Street  
New York, NY 10017  
Telephone: (212) 326-3939  
Facsimile: (212) 755-7306



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document entitled NOTICE OF OPPOSITION was served on this 13th day of November, 2007 via regular mail upon:

Perry J. Viscounty  
LATHAM & WATKINS LLP  
650 Town Center Drive  
20th Floor  
Costa Mesa, California 92626-1925  
Telephone (714) 755-8288



Attorney for Opposer