

ESTTA Tracking number: **ESTTA216395**

Filing date: **06/09/2008**

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	F. Gavina & Sons, Inc.		
Entity	Corporation	Citizenship	California
Address	2700 Fruitland Avenue Vernon, CA 90058 UNITED STATES		

Attorney information	Jonathan Kirsch Law Offices of Jonathan Kirsch 1880 Century Park East Suite 515 Los Angeles, CA 90067 UNITED STATES jk@jonathankirsch.com Phone:310/785-1200		
----------------------	---	--	--

**Applicant Information**

Application No	77204578	Publication date	05/13/2008
Opposition Filing Date	06/09/2008	Opposition Period Ends	06/12/2008
Applicant	Quoc Viet Foods, Inc. 9353 Bolsa Avenue, Suite K #D60 Westminster, CA 92683 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 030. All goods and services in the class are opposed, namely: coffee, tea, prepared coffee-based beverages, coffee-based beverages containing milk, ready-to-drink coffee, ready-to-drink coffee based beverages, coffee beans, bakery products
Class 035. All goods and services in the class are opposed, namely: wholesale and retail store services featuring coffee, tea and bakery products
Class 043. All goods and services in the class are opposed, namely: coffee bar services, restaurant services, coffeehouse and snack bar services

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

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

U.S. Registration No.	1326237	Application Date	01/13/1984
-----------------------	---------	------------------	------------

Registration Date	03/19/1985	Foreign Priority Date	NONE
Word Mark	GAVINA SINCE 1870 GOURMET COFFEE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1983/09/07 First Use In Commerce: 1983/09/07 Coffee		

U.S. Registration No.	1334556	Application Date	01/13/1984
Registration Date	05/07/1985	Foreign Priority Date	NONE
Word Mark	GAVINA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1967/12/31 First Use In Commerce: 1967/12/31 Coffee		

U.S. Registration No.	2442024	Application Date	07/22/1999
Registration Date	04/10/2001	Foreign Priority Date	NONE
Word Mark	CAFE GAVINA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1967/00/00 First Use In Commerce: 1969/00/00 Coffee, seasonings and processed herbs		

U.S. Registration No.	2589211	Application Date	12/28/1999
Registration Date	07/02/2002	Foreign Priority Date	NONE
Word Mark	GAVINA GOURMET COFFEE SINCE 1870 OLD HAVANA ESPRESSO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 Coffee		

Attachments	73460811#TMSN.gif ( 1 page )( bytes ) 73460767#TMSN.gif ( 1 page )( bytes ) 75757959#TMSN.gif ( 1 page )( bytes ) 75882780#TMSN.gif ( 1 page )( bytes ) NOTICE OF OPPOSITION.pdf ( 12 pages )(5378884 bytes )
-------------	---

## 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	/Jonathan Kirsch/
Name	Jonathan Kirsch
Date	06/09/2008



In the Matter of Application Serial No. 77/204578  
F. Gaviña & Sons, Inc. v. Quoc Viet Foods, Inc.  
Notice of Opposition

for goods and services identified as follows: “coffee, tea, prepared coffee-based beverages, coffee-based beverages containing milk, ready-to-drink coffee, ready-to-drink coffee based beverages, coffee beans, bakery products” in International Class 30; “wholesale and retail store services featuring coffee, tea and bakery products” in International Class 35; and “coffee bar services, restaurant services, coffeehouse and snack bar services” in International Class 43. Applicant disclaimed the exclusive right to use “COFFEE TEA” apart from the mark as shown.

4. From a time long prior to the filing date of the Opposed Application, or any earlier date of actual use of the mark shown in the Opposed Application upon which Applicant can rely, and continuously to the present, Opposer has used the marks GAVIÑA, GAVIÑA SINCE 1870 GOURMET COFFEE, CAFÉ GAVIÑA, GAVIÑA GOURMET COFFEE SINCE 1870 OLD HAVANA ESPRESSO and related designs, (collectively, “Opposer’s Marks”), in connection with coffee, tea, and a variety of coffee and tea-related goods and services.

5. Opposer owns all right, title and interest in and to Opposer’s Marks, as well as the following United States registrations of Opposer’s Marks on the Principal Register:

- a) Registration No. 1,326,237 granted March 19, 1985, for the mark GAVIÑA SINCE 1870 GOURMET COFFEE and Design in International Class 30 for “coffee”;
- b) Registration No. 1,334,556 granted May 7, 1985 for the mark GAVIÑA and Design in International Class 30 for “coffee”;
- c) Registration No. 2,442,024 granted April 10, 2001, for the mark CAFÉ GAVIÑA granted April 10, 2001 (stylized) “coffee, seasonings and processed herbs”;

In the Matter of Application Serial No. 77/204578  
F. Gaviña & Sons, Inc. v. Quoc Viet Foods, Inc.  
Notice of Opposition

d) Registration No. 2,589,211 granted July 2, 2002, for the mark GAVIÑA GOURMET COFFEE SINCE 1870 OLD HAVANA ESPRESSO and Design for “coffee”.

All of these registrations are valid and subsisting, and have become incontestable. Copies of the certificates for these registrations are attached as Exhibit 1.

6. Opposer has expended significant amounts of money and resources in advertising and promoting Opposer’s Marks in commerce. By virtue of the advertising and promotion of Opposer’s Marks, and Opposer’s long use of its Marks in commerce, Opposer’s Marks have acquired substantial and valuable goodwill.

7. Applicant’s use of the mark shown in the Opposed Application is likely to cause consumers of the goods and services identified in the Opposed Application to believe mistakenly that those goods and services originate with, or are licensed, sponsored, or authorized by Opposer.

8. The mark shown in the Opposed Application so resembles Opposer’s Marks as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant’s mark is thus unregistrable under Section 2(d) of the United States Trademark Act., 15 U.S.C. § 1052(d).

9. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer’s previously-used and not-abandoned Marks.

In the Matter of Application Serial No. 77/204578  
F. Gaviña & Sons, Inc. v. Quoc Viet Foods, Inc.  
Notice of Opposition

WHEREFORE, Opposer prays for judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application.

Please direct all correspondence in connection with this opposition to the undersigned.

Respectfully submitted,

LAW OFFICES OF JONATHAN KIRSCH

By: 

Jonathan Kirsch  
Attorneys for Opposer  
F. GAVIÑA & SONS, INC.

DATE: June 9, 2008

1880 Century Park East, Suite 515  
Los Angeles, CA 90067  
Telephone: (310) 785-1200  
Facsimile: (310) 286-9573

# EXHIBIT 1

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,326,237

Registered Mar. 19, 1985

TRADEMARK  
Principal Register



F. Gavina & Sons, Inc. (California corporation)  
2369 E. 51st St.  
Vernon, Calif. 90058

For: COFFEE, in CLASS 30 (U.S. Cl. 46).

First use Sep. 7, 1983; in commerce Sep. 7, 1983.

No claim is made to the exclusive right to use "Since 1870" and "Gourmet Coffee", apart from the mark as shown.

The lining in the mark on the drawing represents the color brown.

Ser. No. 460,811, filed Jan. 13, 1984.

SHEILA ROBINSON, Examiner

REGISTRATION NO: 1326237 SERIAL NO: 73/460811  
REGISTRATION DATE: 03/19/1985  
MARK: GAVINA SINCE 1870 GOURMET COFFEE AND DES  
REGISTRATION OWNER: F. Gavina & Sons, Inc.

MAILING DATE: 05/27/2004

**CORRESPONDENCE ADDRESS:**

JONATHAN KIRSCH  
LAW OFFICES OF JONATHAN KIRSCH  
1875 CENTURY PARK, SUITE 1700  
LOS ANGELES, CALIFORNIA 90067

**NOTICE OF ACCEPTANCE**

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

**NOTICE OF RENEWAL**

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

\*\*\*\*\*

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):  
030.

LATHAM, DANA D  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
(703)308-9500

**PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION  
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION**

ORIGINAL

Int. Cl.: 30

Prior U.S. Cl.: 46

**United States Patent and Trademark Office**

**Reg. No. 1,334,556**

Registered May 7, 1985

**TRADEMARK  
PRINCIPAL REGISTER**



F. GAVINA & SONS, INC. (CALIFORNIA CORPORATION)  
2369 E. 51ST ST.  
VERNON, CA 90058

FIRST USE 12-31-1967; IN COMMERCE  
12-31-1967.  
SEC. 2(F).

SER. NO. 460,767, FILED 1-13-1984.

FOR: COFFEE, IN CLASS 30 (U.S. CL. 46).

JILL E. JOHNSON, EXAMINING ATTORNEY



REGISTRATION NO: 1334556 SERIAL NO: 73/460767 MAILING DATE: 06/28/2005  
REGISTRATION DATE: 05/07/1985  
MARK: GAVINA AND DESIGN  
REGISTRATION OWNER: F. Gavina & Sons, Inc.

**CORRESPONDENCE ADDRESS:**

Jonathan Kirsch  
Law Offices of Jonathan Kirsch  
Suite 515  
1880 Century Park East  
Los Angeles CA 90067

**NOTICE OF ACCEPTANCE**

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

\*\*\*\*\*

**NOTICE OF RENEWAL**

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1059.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

\*\*\*\*\*

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):  
030.

AUSTIN, DANA DIONNE  
PARALEGAL SPECIALIST  
POST-REGISTRATION DIVISION  
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL

**Int. Cl.: 30**

**Prior U.S. Cl.: 46**

**United States Patent and Trademark Office**

**Reg. No. 2,442,024**

**Registered Apr. 10, 2001**

**TRADEMARK  
PRINCIPAL REGISTER**

**CAFÉ GAVIÑA**

F. GAVINA & SONS, INC. (CALIFORNIA CORPORATION)  
2369 E. 51ST STREET  
VERNON, CA 90058

THE ENGLISH TRANSLATION OF "CAFE" IS  
"COFFEE".

FOR: COFFEE, SEASONINGS AND PROCESSED  
HERBS, IN CLASS 30 (U.S. CL. 46).

SEC. 2(F).

FIRST USE 0-0-1967; IN COMMERCE 0-0-1969.

SER. NO. 75-757,959, FILED 7-22-1999.

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

ANDY COREA, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 2,589,211

Registered July 2, 2002

TRADEMARK  
PRINCIPAL REGISTER



*Old Havana*  
**ESPRESSO**

F. GAVINA & SONS, INC. (CALIFORNIA CORPORATION)  
2369 EAST 51ST STREET  
VERNON, CA 90058

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SINCE 1870 GOURMET COFFEE" AND "ESPRESSO", APART FROM THE MARK AS SHOWN.

FOR: COFFEE, IN CLASS 30 (U.S. CL. 46).

SN 75-882,780, FILED 12-28-1999.

FIRST USE 9-1-2000; IN COMMERCE 9-1-2000.

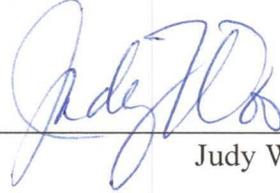
OWNER OF U.S. REG. NOS. 1,326,237, 1,334,556, AND 1,344,870.

PAULA MAHONEY, EXAMINING ATTORNEY

**CERTIFICATE OF SERVICE**

I hereby certify that on June 9, 2008, I served this Notice of Opposition on the Applicant by mailing a copy thereof by First Class Mail, postage prepaid, addressed to Applicant's correspondence address of record as follows:

Darren S. Rimer, Esq.  
Rimer & Mathewson LLP  
26440 La Alameda, Suite 370  
Mission Viejo CA 92691

A handwritten signature in blue ink, appearing to read 'Judy Woo', is written over a horizontal line.

Judy Woo