

ESTTA Tracking number: **ESTTA287893**

Filing date: **06/04/2009**

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	PEABERRY COFFEE, INC.
Granted to Date of previous extension	06/07/2009
Address	1299 E. 58TH AVENUE DENVER, CO 80216 UNITED STATES

Attorney information	Jamie B. Bischoff Ballard Spahr Andrews & Ingersoll, LLP 1735 Market Street, 51st Floor Philadelphia, PA 19103-7599 UNITED STATES bischoff@ballardspahr.com, militelloc@ballardspahr.com Phone:215.864.8207
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Applicant Information

Application No	77370201	Publication date	12/09/2008
Opposition Filing Date	06/04/2009	Opposition Period Ends	06/07/2009
Applicant	GoCoffeeGo LLC 2027 Fillmore Street San Francisco, CA 94115 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. All goods and services in the class are opposed, namely: Computerized on-line ordering and retail store services in the field of coffee, coffee based products, ground roasted coffee and espresso beans, whole roasted coffee and espresso beans, snack foods, prepared foods, baked goods, coffee-based beverages, clothing, shirts, t-shirts, caps, hats, ceramic mugs, travel mugs, coffee makers, espresso machines, French presses, coffee grinders, coffee accessories, and small electric appliances; providing consumer product information over a global computer network in the field of coffee and coffee-related products; online buyers guide service providing information in the field of coffee, coffee accessories and coffee-related products; providing consumer coffee product information reviews via the Internet; providing information about the coffee and coffee-related consumer products of others by providing a product rating system that rates the quality of coffee and coffee-related products; Electronic processing of orders between buyers and sellers via a global computer network in the field of coffee</p>
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1665981	Application Date	10/09/1990
Registration Date	11/26/1991	Foreign Priority Date	NONE
Word Mark	PEABERRY COFFEE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1990/08/28 First Use In Commerce: 1990/08/28 gourmet whole bean and ground coffees, including blended coffees		

U.S. Registration No.	2816386	Application Date	10/21/2002
Registration Date	02/24/2004	Foreign Priority Date	NONE
Word Mark	PEABERRY COFFEE		
Design Mark	<p style="text-align: center;">PEABERRY COFFEE</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 030. First use: First Use: 1990/10/15 First Use In Commerce: 1990/10/15 gourmet whole bean and ground coffees; blended coffees</p> <p>Class 035. First use: First Use: 1990/10/15 First Use In Commerce: 1990/10/15 mail order catalog services featuring gourmet coffees</p> <p>Class 043. First use: First Use: 1990/10/15 First Use In Commerce: 1990/10/15 cafe and carry out restaurant</p>		

U.S. Registration No.	1952461	Application Date	07/14/1994
Registration Date	01/30/1996	Foreign Priority Date	NONE
Word Mark	PEABERRY COFFEE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1990/10/00 First Use In Commerce: 1990/10/00 cafe and carry-out restaurant services		

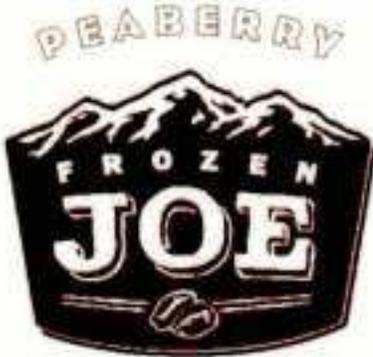
U.S. Registration No.	1954170	Application Date	05/27/1994
Registration Date	02/06/1996	Foreign Priority Date	NONE
Word Mark	PEABERRY COFFEE GROUNDS CREW		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1994/04/00 First Use In Commerce: 1994/04/00 clothing, namely T-shirts Class 042. First use: First Use: 1994/04/00 First Use In Commerce: 1994/04/00 cafe and carry-out restaurant services		

U.S. Registration No.	2999941	Application Date	03/01/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	THE PEABERRY BEAR		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2003/04/15 First Use In Commerce: 2003/04/15 Frozen milk-based drinks, excluding milk shakes Class 032. First use: First Use: 2003/04/15 First Use In Commerce: 2003/04/15 Frozen coffee-based drinks

U.S. Registration No.	3000086	Application Date	05/24/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE

Word Mark	PEABERRY FROZEN JOE
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Design Mark	
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Description of Mark	The mark consists of a snow-capped mountain range with two coffee beans and white stripes below the words FROZEN JOE in white, white snow-capped mountain tops and the word PEABERRY written above the image in white.
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Goods/Services	Class 030. First use: First Use: 2004/04/05 First Use In Commerce: 2004/04/05 frozen nonalcoholic beverages
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Attachments	74104411#TMSN.gif (1 page)(bytes) 76460504#TMSN.gif (1 page)(bytes) 74549554#TMSN.gif (1 page)(bytes) 74530676#TMSN.gif (1 page)(bytes) 76578476#TMSN.gif (1 page)(bytes) 76593609#TMSN.jpeg (1 page)(bytes) GoCoffeeGo Notice of Opposition.pdf (14 pages)(214099 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	/Jamie B. Bischoff/
Name	Jamie B. Bischoff
Date	06/04/2009

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

Peaberry Coffee, Inc.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. _____
	:	
GoCoffeeGo, LLC	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

In the matter of the Application of GoCoffeeGo, LLC (“Applicant”) for registration of the mark PROFESSOR PEABERRY, Application Serial No. 77/370,201 (the “Application”), filed January 12, 2008 and published for opposition in the *Official Gazette* on December 9, 2008.

Peaberry Coffee, Inc., a Colorado corporation, having a place of business at 1299 E. 58th Avenue, Denver, Colorado 80216 (“Opposer”), believes that it will be damaged by the registration of the above-identified Application and hereby opposes the same. The grounds for opposition are as follows:

1. Opposer is, and has been continuously since 1990, engaged in the coffee business.
2. In connection with Opposer’s business, Opposer owns and uses six federally registered marks that feature the word “PEABERRY.” Opposer’s federal registrations are collectively referred to herein as the “PEABERRY® Marks.” (Copies of Opposer’s federal registrations are attached hereto as Exhibit A.)

3. **PEABERRY COFFEE & design®**, Reg. No. 1,665,981, is registered to Opposer for “gourmet whole bean and ground coffees, including blended coffees” in Class 30. This registration was issued on November 26, 1991, on the basis of use in commerce beginning August 28, 1990. The registration is valid, subsisting, and incontestable.

4. **PEABERRY COFFEE®**, Reg. No. 2,816,386, is registered to Opposer for “gourmet whole bean and ground coffees, blended coffees” in Class 30; “mail order catalog services featuring gourmet coffees” in Class 35; and “café and carry out restaurant” in Class 42. This registration was issued on February 24, 2004, on the basis of use in commerce beginning October 15, 1990. The registration is valid, subsisting, and incontestable.

5. **PEABERRY COFFEE & design®**, Reg. 1,952,461, is registered to Opposer for “café and carry-out restaurant services.” This registration was issued on January 30, 1996 on the basis of use in commerce beginning October 1990. The registration is valid, subsisting, and incontestable.

6. **PEABERRY COFFEE GROUNDS CREW & design®**, Reg. No. 1,954,170, is registered to Opposer for “clothing, namely T-shirts” in Class 25; and “café and carry-out restaurant services” in Class 42. This registration was issued on February 6, 1996, on the basis of use in commerce beginning April 1994. The registration is valid, subsisting, and incontestable.

7. **PEABERRY BEAR & design®**, Reg. No. 2,999,941, is registered to Opposer for “frozen milk-based drinks, excluding milk shakes” in Class 29; and “frozen coffee-based drinks” in Class 32. This registration was issued on September 27, 2005, on the basis of use in commerce beginning April 15, 2003. The registration is valid, subsisting, and in full force and effect.

8. **PEABERRY COFFEE FROZEN JOE & design®**, Reg. No. 3,000,086, is registered to Opposer for “frozen nonalcoholic beverages” in Class 30. This registration was issued on September 27, 2005, on the basis of use in commerce beginning April 5, 2004. The registration is valid, subsisting, and in full force and effect.

9. In addition to the foregoing registered marks, the trade name Peaberry Coffee has been used by Opposer in interstate commerce continuously since 1990 in connection with all aspects of Opposer’s coffee business.

10. Opposer offers a broad range of coffee products and coffee-related services under its PEABERRY® Marks, including without limitation: whole bean and ground coffees; online and retail sales of whole bean and ground coffees; café services featuring coffee, coffee drinks and other coffee-related products. Under the PEABERRY® Marks, Opposer also provides information relevant to consumers’ purchase and appreciation of whole bean and ground coffees (such as information regarding coffee taste, quality, roasting and brewing), on Opposer’s Internet website at www.peaberrycoffee.com.

11. Opposer’s use of the PEABERRY® Marks has been continuous and commercially significant for many years in connection with its broad range of coffee products and coffee-related services.

12. Applicant seeks to register PROFESSOR PEABERRY as a trademark for

Computerized on-line ordering and retail store services in the field of coffee, coffee based products, ground roasted coffee and espresso beans, whole roasted coffee and espresso beans, snack foods, prepared foods, baked goods, coffee-based beverages, clothing, shirts, t-shirts, caps, hats, ceramic mugs, travel mugs, coffee makers, espresso machines, French presses, coffee grinders, coffee accessories, and small electric appliances; providing consumer product information over a global computer network in the field of coffee and coffee-related products; online buyers guide service providing information in the field of coffee, coffee accessories and coffee-related products; providing consumer coffee product

information reviews via the Internet; providing information about the coffee and coffee-related consumer products of others by providing a product rating system that rates the quality of coffee and coffee-related products; Electronic processing of orders between buyers and sellers via a global computer network in the field of coffee, in Class 35,

as evidenced by the publication of said mark in the *Official Gazette* on December 9, 2008.

13. The Application was filed as an intent-to-use application on January 12, 2008.

Applicant claims no date earlier than the date of filing, for the purpose of claiming priority.

14. Opposer's rights to its PEABERRY® Marks are senior to any rights that Applicant may claim in its alleged mark PROFESSOR PEABERRY.

15. Because of Opposer's substantial investment of time and resources nationally to promote, advertise, and enforce its PEABERRY® Marks, consumers have come to associate the PEABERRY® Marks exclusively with Opposer's coffee-related goods and services.

16. By virtue of Opposer's continuous use in commerce of its PEABERRY® Marks in connection with its whole bean and ground coffees, coffee products and coffee-related services, such products and business have become favorably and prominently known to the relevant trade and public under such marks.

17. Opposer's PEABERRY® Marks have been valid and in continuous use since the dates of first use and have not been abandoned.

18. Opposer uses its PEABERRY® Marks, the Peaberry Coffee trade name, and "PEABERRY" as the dominant element of its marks for whole bean and ground coffees, coffee products and coffee-related services including coffee sales and café services, and providing information about coffee to consumers on Opposer's Internet website.

19. In the Application, there are no restrictions on trade channels, so it must be presumed that the services identified in the Application will travel through all the trade channels appropriate for services of that type.

20. On information and belief, Applicant's coffee-related services and Opposer's coffee products and coffee-related services are marketed through overlapping channels of trade and are intended to be sold to overlapping classes of purchasers.

21. Applicant's PROFESSOR PEABERRY mark—as used in association with online ordering and retail store services featuring coffee and coffee-related products (such as coffee mugs, coffee makers and machines, and coffee accessories), and information services relating to coffee, coffee accessories and coffee-related consumer products—is confusingly similar to Opposer's PEABERRY® Marks because the marks are similar in appearance, sound, and overall commercial impression. Each of Opposer's marks and names, and Applicant's mark, employ the identical term—"PEABERRY"—as the dominant element. Applicant has only added the word PROFESSOR, which does not adequately change the overall commercial impression or dispel confusion. Indeed, because Opposer has a family of PEABERRY marks, including as noted above PEABERRY BEAR® and PEABERRY COFFEE GROUNDS CREW®, it is likely that someone encountering advertising for PROFESSOR PEABERRY will assume that this is another fanciful mark for a new product or service coming from Opposer.

22. The goods and services of Opposer and the services of Applicant are closely related. Opposer offers whole bean and ground coffees; online and retail store sales of whole bean and ground coffees; café services featuring prepared coffee and coffee-based drinks; and information for consumers relating to the purchase and appreciation of coffee. Applicant offers or intends to offer online ordering and retail services featuring coffee and coffee-related products and accessories, as well as information for consumers including reviews of coffee and coffee-related products.

23. On seeing Applicant's PROFESSOR PEABERRY mark used in connection with Applicant's services, purchasers and potential purchasers are likely to believe in error that the

services are Opposer's services, or that the services are offered in association with or under license from Opposer or that Opposer and Applicant are affiliated.

24. Any defect, objection to, or fault found with Applicant's services under the PROFESSOR PEABERRY mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its services and business.

25. If Applicant is permitted to register the mark PROFESSOR PEABERRY for the services set forth in the application, confusion of the relevant trade and public is likely to result, which will damage and injure Opposer.

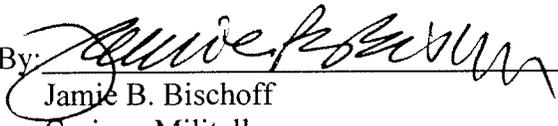
26. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer Peaberry Coffee, Inc. prays that registration of the mark of Application Serial No. 77/370,201 be refused and that this opposition be sustained.

The required \$300.00 filing fee for this Opposition may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Respectfully submitted,

Dated: June 4, 2009

By: 
Jamie B. Bischoff
Corinne Militello
BALLARD SPAHR ANDREWS &
INGERSOLL, LLP
1735 Market Street, 51st Floor
Philadelphia, Pennsylvania 19103-7599
(215) 665-8500

ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the attached Notice of Opposition relating to Application Serial No. 77/370,201 was served on the Applicant on the date listed below via U.S. mail, postage prepaid.

Darren S. Rimer
Rimer & Mathewson LLP
1 Embarcadero Center, Suite 500
San Francisco, CA 94111-3610

Dated: June 4, 2009



Michael Shore

EXHIBIT A

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 1,665,981

United States Patent and Trademark Office Registered Nov. 26, 1991

TRADEMARK
PRINCIPAL REGISTER



COFFEE CONSULTANTS, INC. (COLORADO CORPORATION), DBA PEABERRY COFFEE LTD.
9195 WADSWORTH PARKWAY
WESTMINSTER, CO 80020

FOR: GOURMET WHOLE BEAN AND GROUND COFFEES, INCLUDING BLENDED COFFEES, IN CLASS 30 (U.S. CL. 46).

FIRST USE 8-28-1990; IN COMMERCE 8-28-1990.

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

THE LINING IN THE MARK IS A FEATURE OF THE MARK AND IS NOT INTENDED TO REPRESENT COLOR.

SER. NO. 74-104,411, FILED 10-9-1990.

PATRICIA MALESARDI, EXAMINING ATTORNEY

Int. Cls.: 30, 35 and 43

Prior U.S. Cls.: 46, 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,816,386

Registered Feb. 24, 2004

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

PEABERRY COFFEE

COFFEE CONSULTANTS, INC. (COLORADO
CORPORATION), DBA PEABERRY COFFEE
LTD.
1299 E. 58TH AVENUE
DENVER, CO 80216

FOR: GOURMET WHOLE BEAN AND GROUND
COFFEES; BLENDED COFFEES, IN CLASS 30 (U.S.
CL. 46).

FIRST USE 10-15-1990; IN COMMERCE 10-15-1990.

FOR: MAIL ORDER CATALOG SERVICES FEA-
TURING GOURMET COFFEES, IN CLASS 35 (U.S.
CLS. 100, 101 AND 102).

FIRST USE 10-15-1990; IN COMMERCE 10-15-1990.

FOR: CAFE AND CARRY OUT RESTAURANT,
IN CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 10-15-1990; IN COMMERCE 10-15-1990.

OWNER OF U.S. REG. NOS. 1,665,951, 1,952,461,
AND 1,954,170.

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

SER. NO. 76-460,504, FILED 10-21-2002.

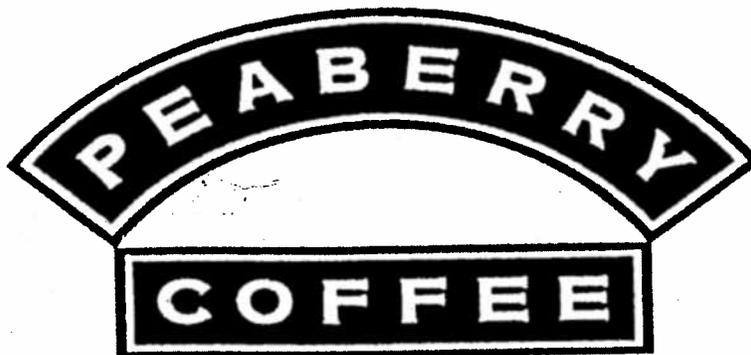
TANYA AMOS, EXAMINING ATTORNEY

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office **Reg. No. 1,952,461**
Registered Jan. 30, 1996

**SERVICE MARK
PRINCIPAL REGISTER**



COFFEE CONSULTANTS, INC. (COLORADO CORPORATION), DBA PEABERRY COFFEE LTD.
4785 ELATI STREET
DENVER, CO 80216

FOR: CAFE AND CARRY-OUT RESTAURANT SERVICES, IN CLASS 42 (U.S. CL. 100).
FIRST USE 10-0-1990; IN COMMERCE 10-0-1990.

OWNER OF U.S. REG. NOS. 1,665,981 AND 1,840,752.

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

SER. NO. 74-549,554, FILED 7-14-1994.

ANGELA BISHOP WILSON, EXAMINING ATTORNEY

Int. Cls.: 25 and 42

Prior U.S. Cls.: 22, 39, 100 and 101

United States Patent and Trademark Office

Reg. No. 1,954,170

Registered Feb. 6, 1996

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



COFFEE CONSULTANTS, INC. (COLORADO CORPORATION)
4785 ELATI STREET
DENVER, CO 80216

FOR: CLOTHING, NAMELY T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 4-0-1994; IN COMMERCE 4-0-1994.

FOR: CAFE AND CARRY-OUT RESTAURANT SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 4-0-1994; IN COMMERCE 4-0-1994.

OWNER OF U.S. REG. NOS. 1,665,981 AND 1,840,752.

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

SER. NO. 74-530,676, FILED 5-27-1994.

ANGELA BISHOP WILSON, EXAMINING ATTORNEY

Int. Cls.: 29 and 32

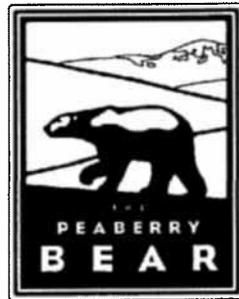
Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 2,999,941

Registered Sep. 27, 2005

**TRADEMARK
PRINCIPAL REGISTER**



PEABERRY COFFEE, INC. (COLORADO CORPORATION)
1299 E. 58TH AVENUE
DENVER, CO 80216

FOR: FROZEN MILK-BASED DRINKS, EXCLUDING MILK SHAKES, IN CLASS 29 (U.S. CL. 46).

FIRST USE 4-15-2003; IN COMMERCE 4-15-2003.

FOR: FROZEN COFFEE-BASED DRINKS , IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 4-15-2003; IN COMMERCE 4-15-2003.

SER. NO. 76-578,476, FILED 3-1-2004.

JOHN DWYER, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 3,000,086

United States Patent and Trademark Office

Registered Sep. 27, 2005

TRADEMARK
PRINCIPAL REGISTER



PEABERRY COFFEE, INC. (COLORADO CORPORATION)

1299 E. 58TH AVENUE
DENVER, CO 80216

FOR: FROZEN NONALCOHOLIC BEVERAGES,
IN CLASS 30 (U.S. CL. 46).

FIRST USE 4-5-2004; IN COMMERCE 4-5-2004.

OWNER OF U.S. REG. NOS. 1,665,981, 2,816,386
AND OTHERS.

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

THE COLOR(S) BROWN AND WHITE IS/ARE
CLAIMED AS A FEATURE OF THE MARK.

THE COLOR BROWN APPEARS IN BODY OF
MOUNTAIN IMAGE OF THE MARK. THE BROWN
OUTLINING OF THE WORD PEABERRY IS NOT A
FEATURE OF THE MARK. THE COLOR WHITE
APPEARS IN THE WORDS PEABERRY, FROZEN
AND JOE AND APPEARS AT THE TOP AND THE
BOTTOM OF THE IMAGE.

THE MARK CONSISTS OF A SNOW-CAPPED
MOUNTAIN RANGE WITH TWO COFFEE BEANS
AND WHITE STRIPES BELOW THE WORDS FRO-
ZEN JOE IN WHITE, WHITE SNOW-CAPPED
MOUNTAIN TOPS AND THE WORD PEABERRY
WRITTEN ABOVE THE IMAGE IN WHITE.

SER. NO. 76-593,609, FILED 5-24-2004.

JACQUELINE A. LAVINE, EXAMINING ATTOR-
NEY