

ESTTA Tracking number: **ESTTA390278**

Filing date: **01/26/2011**

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	The Republic of Tea, Inc.
Granted to Date of previous extension	01/26/2011
Address	#5 Hamilton Landing, Suite 100 Novato, CA 94949 UNITED STATES
Attorney information	ULRIKA E. MATTSSON McDERMOTT WILL & EMERY LLP 227 W. MONROE STREET, SUITE 4400 CHICAGO, IL 60606-5096 UNITED STATES Chicago_ip_docket@mwe.com, umattsson@mwe.com, mburke@mwe.com, cvicino@mwe.com Phone:312-372-2000

Applicant Information

Application No	79072740	Publication date	09/28/2010
Opposition Filing Date	01/26/2011	Opposition Period Ends	01/26/2011
International Registration No.	1012803	International Registration Date	08/21/2009
Applicant	KUSMI TEA 73 rue Sainte Anne PARIS, F75002 FRANCE		

Goods/Services Affected by Opposition

Class 030. All goods and services in the class are opposed, namely: Coffee, tea, cocoa, artificial coffee, pastry, cookies and biscuits, beverages made with cocoa, coffee, or tea

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.	3269578	Application Date	05/26/2005
Registration Date	07/24/2007	Foreign Priority Date	NONE

Word Mark	BE WELL RED
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2006/01/20 First Use In Commerce: 2006/01/20 Tea

U.S. Application No.	77863934	Application Date	11/03/2009
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	BE WELL GREEN
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: Tea

U.S. Application No.	77715327	Application Date	04/16/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BE ACTIVE		

Design Mark	BE ACTIVE
Description of Mark	NONE
Goods/Services	Class 005. First use: Herb teas for medicinal purposes

Attachments	78638379#TMSN.jpeg (1 page)(bytes) 77863934#TMSN.jpeg (1 page)(bytes) 77715327#TMSN.jpeg (1 page)(bytes) be cool opposition.pdf (4 pages)(14796 bytes) be well red exhibit.pdf (2 pages)(20203 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	/Ulrika E. Mattsson/
Name	ULRIKA E. MATTSSON
Date	01/26/2011

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

In the matter of trademark application Serial No. 79/072,740
For the mark BE COOL
Published in the Official Gazette on September 28, 2010

The Republic of Tea, Inc.,	
v.	Opposer,
Kusmi Tea,	Applicant.

NOTICE OF OPPOSITION

The Republic of Tea, Inc. is a California corporation, with its principal place of business at #5 Hamilton Landing, Suite 100, Novato, CA 94949 (“Opposer”); and through its counsel, McDermott Will & Emery LLP; 227 West Monroe Street; Chicago, Illinois 60606, hereby states that it will be damaged by registration of the mark BE COOL, covered by U.S. Application Serial Number 79/072,740, filed by Kusmi Tea (“Applicant”), and therefore files this Notice of Opposition to the application.

The grounds for this Opposition are as follows:

1. Kusmi Tea seeks to register BE COOL as a trademark for coffee, tea, cocoa, artificial coffee, pastry, cookies and biscuits, beverages made with cocoa, coffee, or tea in International Class 30.
2. Opposer owns a registration for BE WELL RED, Reg. No. 3,269,578, for tea, in International Class 30. In addition, the Opposer owns trademark applications for BE WELL GREEN, Appl. No. 77/863,934, for tea, in International Class 30, and BE ACTIVE, Appl. No. 77/715,327, for herb teas for medicinal purposes, in International Class 5.

3. Applicant filed a request for extension of protection under the Madrid Protocol for BE COOL on August 21, 2009, and has indicated in its application that its base application for BE COOL registered on August 21, 2009.

4. Opposer has been using its BE WELL RED mark in interstate commerce in connection with its goods since at least as early as January 20, 2006, and filed its application for the mark on May 26, 2005. The registration issued on July 24, 2007. *See* Exhibit 1.

5. Opposer has expended substantial sums and resources to advertise and promote its goods under the BE WELL RED mark.

6. By reason of Opposer's advertisement, promotion and sale of Opposer's goods under the BE WELL RED mark for so many years, the BE WELL RED mark has come to be recognized as identifying Opposer and the value of Opposer's goods throughout the United States, and Opposer has developed substantial goodwill in the BE WELL RED mark.

7. Notwithstanding Opposer's prior use of and rights in and to the BE WELL RED mark and its prior applications for BE WELL GREEN and BE ACTIVE, on August 21, 2009, Applicant filed U.S. Application Serial No. 79/072,740, for registration of the mark BE COOL for use in connection with coffee, tea, cocoa, artificial coffee, pastry, cookies and biscuits, beverages made with cocoa, coffee, or tea in International Class 30. That application was published in the Official Gazette (Trademarks) of the United States Patent and Trademark Office on September 28, 2010. Opposer obtained an extension of time to file this Notice of Opposition through January 26, 2010. Therefore, this Opposition is being timely filed.

8. Opposer's mark is registered for tea.

9. Applicant has stated in its application an intention to use its BE COOL mark for, among other things, tea, the same goods offered in connection with Opposer's BE WELL RED mark.

Therefore, Opposer's and Applicant's goods will share the same channels of trade in the United States and Applicant's mark is likely to be confused with Opposer's mark.

10. Applicant's BE COOL mark is confusingly similar to Opposer's BE WELL RED mark and the marks in its applications for BE WELL GREEN and BE ACTIVE because the meaning of the marks is closely related, namely urging people to "be something."

11. Applicant's BE COOL mark begins with the word "BE" and is followed by a modifier that describes a "state of being" desirable to purchasers of teas and other goods promoted as providing health and energy benefits. Applicant's BE COOL mark is confusingly similar to Opposer's BE WELL RED mark and the marks in its applications for BE WELL GREEN and BE ACTIVE because the meaning of the marks is closely related, namely urging people to "be something." Applicant's mark delivers a message to consumers similar to the message delivered by Opposer's "BE WELL RED" mark and its applications for BE WELL GREEN and BE ACTIVE, all of which begin with the word "BE" and are followed by modifiers that describe a desirable "state of being." Therefore, purchasers are likely to believe that Applicant's BE COOL products are extensions of Opposer's BE WELL RED mark and its applications for BE WELL GREEN and BE ACTIVE marks.

12. Opposer also owns a family of trademark registrations for marks starting with a verb that is followed by an adjective, such as GET RELAXED, Reg. No. 3,596,059, GET SOOTHED, Reg. No. 3,320,855, GET RELIEF, Reg. No. 3,320,851 and GET HAPPY, Reg. No. 3,596,055. All of these marks are registered for herb teas for medicinal purposes. Applicant's mark BE COOL is similar to those marks in that it starts with a verb that is followed by an adjective. Among the goods for which Applicant seeks to register its mark is tea, as well as other related goods. Therefore, Opposer's and Applicant's goods will share the same channels of trade in the United

States and Applicant's BE COL mark is likely to be confused with Opposer's family of GET marks.

13. Applicant's registration and use of the mark BE COOL interferes with Opposer's BE WELL RED, BE WELL GREEN, BE ACTIVE, and "GET" family of marks, and will seriously damage Opposer and its goodwill and reputation.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark and prays that it be denied.

Respectfully submitted,

The Republic of Tea, Inc.

Date: January 26, 2010

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EXHIBIT 1

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 3,269,578

Registered July 24, 2007

**TRADEMARK
PRINCIPAL REGISTER**

BE WELL RED

THE REPUBLIC OF TEA, INC. (CALIFORNIA
CORPORATION)
8 DIGITAL DRIVE
NOVATO, CA 94949

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

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

FIRST USE 1-20-2006; IN COMMERCE 1-20-2006.

SN 78-638,379, FILED 5-26-2005.

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

THEODORE MCBRIDE, EXAMINING ATTORNEY