

ESTTA Tracking number: **ESTTA399450**

Filing date: **03/23/2011**

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	Calpis Co., Ltd.
Granted to Date of previous extension	03/23/2011
Address	4-1, Ebisu-Minami 2-chome, Shibuya-ku Tokyo, JAPAN

Correspondence information	Robert B.G. Horowitz and Donna A. Tobin Baker and Hostetler LLP 45 Rockefeller Plaza New York, NY 10111 UNITED STATES rhorowitz@bakerlaw.com, dtobin@bakerlaw.com, ejoyce@bakerlaw.com, trademarks@bakerlaw.com, jlozada@bakerlaw.com
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Applicant Information

Application No	85077274	Publication date	11/23/2010
Opposition Filing Date	03/23/2011	Opposition Period Ends	03/23/2011
Applicant	Calico Jack's llc. 19 Autumn lane carriere, MS 39426 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. First Use: 2010/01/20 First Use In Commerce: 2010/01/20 All goods and services in the class are opposed, namely: Energy drinks; Fruit drinks and fruit juices; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Guarana drinks; Isotonic drinks; Pop; Powders used in the preparation of isotonic sports drinks and sports beverages; Soft drinks; Sports drinks; Sports drinks, namely, energy drinks; Syrups for making soft drinks

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration	1000780	Application Date	03/22/1971
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No.			
Registration Date	12/31/1974	Foreign Priority Date	NONE
Word Mark	CALPICO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U045 (International Class 032). First use: CONCENTRATES FOR MAKING SOFT DRINKS Class U046 (International Class 029, 032). First use: FERMENTED MILK, FERMENTED MILK BEVERAGE, FRUIT JUICE [, YOGURT, CREAM AND BUTTER]		

U.S. Registration No.	2893343	Application Date	06/24/2003
Registration Date	10/12/2004	Foreign Priority Date	NONE
Word Mark	CALPICO WATER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1992/04/00 First Use In Commerce: 1992/04/00 Soft drinks		

U.S. Registration No.	2874702	Application Date	06/25/2003
Registration Date	08/17/2004	Foreign Priority Date	NONE
Word Mark	CALPICO SODA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1996/03/00 First Use In Commerce: 1996/03/00 soft drinks, fruit juices, [vegetable juice beverages]		

Attachments	CALICO.pdf (17 pages)(426658 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	/Donna A. Tobin/
Name	Donna A. Tobin
Date	03/23/2011

As grounds for this opposition, Opposer states as follows:

1. Opposer is engaged in the development, production, sale, advertising and distribution of soft drinks, fruit juice, nutritional drinks, concentrates for making soft drinks, fermented milk and fermented milk beverages in many countries throughout the world, including Japan and the United States.

2. Long before the filing date of the opposed application and Applicant's claimed dates of first use therein, Opposer has been engaged in the sale, distribution and advertising of beverages and beverage products in the United States in connection with the arbitrary and distinctive mark CALPICO and has continuously used the CALPICO mark since then in connection with such products.

3. Long before the filing date of the opposed application and Applicant's claimed dates of first use therein, Opposer adopted and began using the arbitrary and distinctive mark CALPICO for the sale in interstate commerce of concentrates for making soft drinks, fruit juice, fermented milk and fermented milk beverage. Upon information and belief, since the time of its first adoption of CALPICO, the public and the trade identified the source of such goods by the CALPICO mark.

4. On March 22, 1971 Opposer filed Application Serial No. 72/386,926 with the United States Patent and Trademark Office to register the mark CALPICO for "concentrates for making soft drinks" and "fermented milk, fermented milk beverage, fruit juice", The resulting U.S. Reg. No. 1,000,780 ("the '780 Registration") issued December 31, 1974 and is in full force and effect. A copy of the '780 Registration and a printout from the United States Patent Office TARR database showing the current status and title thereof is attached hereto as Exhibit A.

5. At least as early as April, 1992, Opposer adopted and began using the arbitrary and distinctive mark CALPICO WATER in connection with the sale of soft drinks in interstate commerce and has continuously used the CALPICO WATER mark since then in connection with such products. Upon

information and belief, from that date, the public and the trade identified the source of such goods by the CALPICO WATER mark.

6. On June 24, 2003, Opposer filed Application Serial No. 78/266,179 for CALPICO WATER for “soft drinks”. The resulting U.S. Reg. No. 2,893,343 (“the ‘343 Registration”) issued on October 12, 2004 and is in full force and effect. A copy of the ‘343 Registration and a printout from the United States Patent Office TARR database showing the current status and title thereof is attached hereto as Exhibit B.

7. At least as early as March,1996, Opposer adopted and began using the arbitrary and distinctive mark CALPICO SODA in connection with the sale of soft drinks and fruit juices in interstate commerce and has continuously used the CALPICO SODA mark since then in connection with such products. Upon information and belief, from that date, the public and the trade identified the source of such goods by the CALPICO SODA mark.

8. On June 25, 2003, Opposer filed Application Serial No. 78/267,041 for CALPICO SODA for “soft drinks, fruit juices.” The resulting U.S. Reg. No. 2,874,702 (“the ‘702 Registration”) issued August 17, 2004 and is incontestable and in full force and effect. A copy of the ‘702 Registration and a printout from the United States Patent Office TARR database showing the status and title thereof is attached hereto as Exhibit C.

9. Opposer has sold and distributed, and continues to sell and distribute, substantial amounts of goods in connection with its CALPICO, CALPICO WATER and CALPICO SODA marks (collectively the “CALPICO family of marks”), during the many years that it has used its CALPICO family of marks.

10. As a result of Opposer’s long use and extensive sales, the CALPICO family of marks has become widely recognized by the public and the trade throughout the United States. The arbitrary and distinctive marks CALPICO, CALPICO WATER and CALPICO SODA identify Opposer as the source or

origin of goods, bearing, sold under, distributed and advertised in association with the marks. Opposer enjoys substantial and valuable goodwill in its CALPICO family of marks.

11. Upon information and belief, Applicant is engaged in the development, production, sale, advertisement and distribution of soft drinks, fruit juices, energy drinks, concentrates, powders and syrups for making such drinks.

12. On or about January 20, 2010, long after adoption and registration by Opposer of its CALPICO family of marks, Applicant allegedly adopted and began using the mark CALICO and design, shown below, for Energy drinks; Fruit drinks and fruit juices; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Guarana drinks; Isotonic drinks; Pop; Powders used in the preparation of isotonic sports drinks and sports beverages; Soft drinks; Sports drinks; Sports drinks, namely, energy drinks; Syrups for making soft drinks:



13. On or about July 2, 2010 Applicant filed application serial number 85/077,274 (“the ‘274 application”) to register the confusingly similar mark CALICO and design, for identical or similar goods, namely “Energy drinks; Fruit drinks and fruit juices; Fruit flavored soft drinks; Fruit-based soft drinks flavored with tea; Guarana drinks; Isotonic drinks; Pop; Powders used in the preparation of isotonic sports drinks and sports beverages; Soft drinks; Sports drinks; Sports drinks, namely, energy drinks; Syrups for making soft drinks.”

Count 1 Likelihood of Confusion – Section 2(d) of the Lanham Act

14. Applicant's use of the CALICO and design mark is likely to cause confusion, or to cause mistake, or to deceive, in view of Opposer's long prior use of the arbitrary and distinctive CALPICO family of marks in association with the sale, distribution and advertising of identical and similar types of goods.

15. By reason of Opposer's use of the CALPICO family of marks from a date long prior to Applicant's use of, or filing of its application to register, a confusingly similar trademark in connection with the same or related goods, Opposer has rights superior to any rights of applicant.

16. The registration of Applicant's CALICO and design mark on the Principal register will interfere with Opposer's enjoyment of its rights in its CALPICO family of marks, to the substantial detriment of Opposer, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).

Count II Deception/ False Suggestion of Origin – Section 2(a) of the Lanham Act

17. Applicant's CALICO and design mark so closely resembles Opposer's CALPICO family of marks that it is likely to cause deception in violation of Section 2(a) of the Lanham Act, 15 U.S.C. Section 1052(a) in that Applicant's mark misdescribes the nature or origin of the goods and purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchaser's decisions to acquire Applicant's goods.

18. Applicant's CALICO and design mark so closely resembles Opposer's CALPICO family of marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Lanham Act, because Opposer's CALPICO family of marks points uniquely to Opposer and purchasers will assume that the goods sold under Applicant's CALICO and design mark are connected or affiliated with Opposer.

19. Applicant's registration of the CALICO and design mark will damage Opposer within the meaning of Section 2(a) of the Lanham Act, 15 U.S.C. Section 1052 (a).

Count III Fraud

20. Upon information and belief, Applicant fraudulently misrepresented that its CALICO and design mark was in use in commerce when it filed the '274 application under oath pursuant to Title 18 USC § 1001. The specimen submitted by Applicant to support its allegation of use is clearly fabricated – a paper label apparently taped or glued to a can-- is obviously not a commercially used label, and thus is false.

21. Upon information and belief, the specimen relied on to support Applicant's alleged use indicates that the product on which it is used contains alcohol. However, Applicant's goods, as described in the '274 application do not contain alcohol. Thus, the specimen label submitted is false and was not actually used in connection with the goods in the application.

22. Upon information and belief, said false statement was made, and specimen submitted, by an authorized agent of Applicant with the knowledge and belief that such statement and specimen were false.

23. Upon information and belief, said false statement was made, and specimen submitted, with the intent to induce authorized agents of the United States Patent and Trademark Office to grant a registration on the '274 application to Applicant.

24. Upon information and belief, the United States Patent and Trademark Office relied on this false statement and specimen in approving the application for registration and but for these false statements, the application would not have been approved for publication.

25. For the forgoing reasons, Opposer will suffer considerable harm to its CALPICO family of marks if the '274 application is permitted to mature to registration.

WHEREFORE, Opposer prays that its opposition be sustained and that the registration sought by Applicant be refused.

Date: March 23, 2011

Respectfully submitted,

BAKER & HOSTETLER LLP

By 
Robert B.G. Horowitz

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212 589-4201 (fax)

CERTIFICATE OF SERVICE

I hereby certify that on the 23rd day of March, 2011, a true copy of the Notice of Opposition was served on Applicant via U.S. first-class mail, postage prepaid to:

Sidney J. Martin
Owner
Calico Jacks, LLC
19 Autumn Lane
Carriere, Mississippi 39426

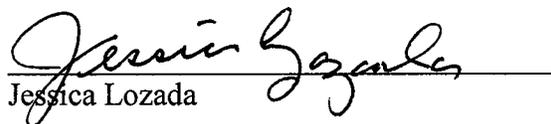

Jessica Lozada

Exhibit A



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Typed Drawing

Word Mark	CALPICO
Goods and Services	IC 032. US 045. G & S: CONCENTRATES FOR MAKING SOFT DRINKS
	IC 029 032. US 046. G & S: FERMENTED MILK, FERMENTED MILK BEVERAGE, FRUIT JUICE [, YOGURT, CREAM AND BUTTER]
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	72386926
Filing Date	March 22, 1971
Current Filing Basis	44E
Original Filing Basis	44E
Registration Number	1000780
Registration Date	December 31, 1974
Owner	(REGISTRANT) CALPIS FOOD INDUSTRY CO., LTD., THE CORPORATION JAPAN 20-3, 2-CHOME, EBISU-NISHI SHIBUYA-KU, TOKYO JAPAN
	(LAST LISTED OWNER) CALPIS CO., LTD. CORPORATION JAPAN 4-1, 2-CHOME, EBISU-MINAMI, SHIBUYA-KU TOKYO JAPAN
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	DAVID TOREN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR). SECTION 8(10-YR) 20050222.

Renewal 3RD RENEWAL 20050222
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Typed Drawing

Word Mark CALPICO WATER
Goods and Services IC 032. US 045 046 048. G & S: Soft drinks. FIRST USE: 19920400. FIRST USE IN COMMERCE: 19920400
Mark Drawing Code (1) TYPED DRAWING
Serial Number 78266179
Filing Date June 24, 2003
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition July 20, 2004
Registration Number 2893343
Registration Date October 12, 2004
Owner (REGISTRANT) Calpis Co., Ltd. CORPORATION JAPAN 20-3, 2-chome, Ebisu-Nishi, Shibuya-ku Tokyo JAPAN
Attorney of Record Edmund J. Sease
Prior Registrations 1000780
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WATER" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark CALPICO SODA
Goods and Services IC 032. US 045 046 048. G & S: soft drinks, fruit juices, [vegetable juice beverages]. FIRST USE: 19960300. FIRST USE IN COMMERCE: 19960300
Mark Drawing Code (1) TYPED DRAWING
Serial Number 78267041
Filing Date June 25, 2003
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition May 25, 2004
Registration Number 2874702
Registration Date August 17, 2004
Owner (REGISTRANT) CALPIS CO., LTD. JOINT STOCK COMPANY JAPAN 4-1, Ebisu-Minami 2-chome, Shibuya-ku, Tokyo JAPAN
Attorney of Record David Toren
Prior Registrations 1000780;1774588
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SODA" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

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