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Filing date: **03/28/2011**

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

|                        |  |
|------------------------|--|
| Proceeding             | 91199109   |
| Party                  | Plaintiff<br>Calpis Co., Ltd.  |
| Correspondence Address | Robert B.G. Horowitz and Donna A. Tobin<br>Baker and Hostetler LLP<br>45 Rockefeller Plaza<br>New York, NY 10111<br>UNITED STATES<br>rhorowitz@bakerlaw.com, dtobin@bakerlaw.com, ejoyce@bakerlaw.com, trademarks@bakerlaw.com, jlozada@bakerlaw.com |
| Submission             | Motion to Amend Pleading/Amended Pleading  |
| Filer's Name           | Donna A. Tobin   |
| Filer's e-mail         | dtobin@bakerlaw.com  |
| Signature              | /Donna A. Tobin/   |
| Date                   | 03/28/2011   |
| Attachments            | AMENDED CALICO.pdf ( 13 pages )(345243 bytes )   |

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

In the Matter of:      Application Serial No. 85/077,274

Filed:                      July 2, 2010

Trademark:                CALICO and design

Published:                November 23, 2010

|                    |   |                 |
|--------------------|---|-----------------|
| _____              | ) |                 |
| CALPIS CO., LTD.   | ) |                 |
| Opposer,           | ) |                 |
|                    | ) | Opposition No.: |
|                    | ) |                 |
| v.                 | ) |                 |
|                    | ) |                 |
| CALICO JACK'S LLC. | ) |                 |
|                    | ) |                 |
| Applicant.         | ) |                 |
| _____              | ) |                 |

**AMENDED NOTICE OF OPPOSITION**

CALPIS CO., LTD., a corporation organized and existing under the laws of Japan, having a legal address at 4-1, Ebisu-Minami 2-chome, Shibuya-ku, Tokyo, Japan (hereafter "Opposer"), believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/077,274 for the trademark CALICO and design, filed in the name of CALICO JACKS, LLC, a Mississippi corporation whose address is 19 Autumn Lane, Carriere, Mississippi 39426, (hereafter "Applicant") and hereby opposes issuance of the registration.

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 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.

6. 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 B.

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

8. As a result of Opposer’s long use and extensive sales, the CALPICO Marks have become widely recognized by the public and the trade throughout the United States. The arbitrary and distinctive marks CALPICO 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 marks.

9. 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.

10. On or about January 20, 2010, long after adoption and registration by Opposer of its CALPICO 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:



11. 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**

12. 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 Marks in association with the sale, distribution and advertising of identical and similar types of goods.

13. By reason of Opposer’s use of the CALPICO 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.

14. 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 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**

15. Applicant's CALICO and design mark so closely resembles Opposer's CALPICO 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.

16. Applicant's CALICO and design mark so closely resembles Opposer's CALPICO Marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Lanham Act, because Opposer's CALPICO 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.

17. 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**

18. 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.

19. 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.

20. 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.

21. 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.

22. 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.

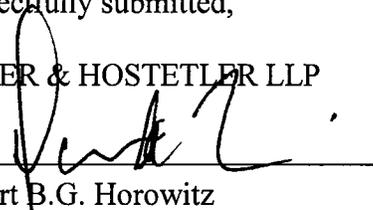
23. For the forgoing reasons, Opposer will suffer considerable harm to its CALPICO Marks if the '274 application is permitted to mature to registration.

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

Date: March 28, 2011

Respectfully submitted,

BAKER & HOSTETLER LLP

By 

Robert B.G. Horowitz

Donna A. Tobin

45 Rockefeller Plaza

New York, N.Y. 10111

212 589-4200 (tel.)

212 589-4201 (fax)

**CERTIFICATE OF SERVICE**

I hereby certify that on the 28<sup>th</sup> day of March, 2011, a true copy of the Amended 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  
Live/Dead Indicator LIVE

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# **Exhibit B**



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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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