

ESTTA Tracking number: **ESTTA595525**

Filing date: **03/31/2014**

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

Proceeding	91215169
Party	Defendant Denali Co., LLC
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Attachments	G0848491.PDF(155415 bytes)

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

In the matter of Application Ser. No.: 85/878,883

Filed: February 27, 2014

For the mark: CHOCOLATE CARAMEL CARIBOU & Design

Published in the Official Gazette (Trademarks) on September 3, 2013

**ARABICA FUNDING, INC. and
CARIBOU COFFEE COMPANY, INC.**
Opposers

v.

DENALI CO., LLC
Applicant

Opposition No. 91215169

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION
AND AFFIRMATIVE DEFENSES**

Applicant, Denali Co., LLC, by and through its attorneys, McGarry Bair PC, hereby answers the Notice of Opposition dated February 27, 2014, filed by Opposers Arabica Funding, Inc. and Caribou Coffee Company, Inc. (“Opposers”) as follows:

Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth regarding each Opposer’s address and location.

Opposers allege that they will be damaged by the registration of Applicant’s Trademark Application Serial No. 85/878,883 for the mark CHOCOLATE CARAMEL CARIBOU & Design for “Milk” in International Class 29. Applicant denies that Opposers will be damaged by registration of Applicant’s Trademark Application Serial No. 85/878,883 for the mark CHOCOLATE CARAMEL CARIBOU & Design (the “CHOCOLATE CARAMEL CARIBOU Mark”).

Applicant now responds to each allegation of the Notice of Opposition below:

1. The trademark application for the mark CHOCOLATE CARAMEL CARIBOU & Design herein opposed, U.S. Application Serial No. 85/878,883, was filed on March 18, 2013, for “Milk,” in International Class 29 (the “Opposed Application”).

Applicant’s Answer: Admitted.

Count 1: Likelihood of Confusion (Lanham Act § 2(d))

2. Arabica is the owner and Caribou the exclusive licensee of a large portfolio of trademark applications and registrations and common-law trademark rights of CARIBOU-variant marks for a variety of goods and services (“Opposers’ Marks”).

Applicant’s Answer: Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and leaves Opposer to its proofs.

3. Arabica is the owner of the following applications and registrations of Opposers’ Marks (“Opposers’ Registrations”),¹ among others:

Mark	Ser./Reg. No.	Filing Date / Reg. Date	Class: Goods/Services, First Use Dates
CARIBOU	3,533,290	Oct 22, 2007 / Nov 18, 2008	30: Ground and Whole Bean Coffee; Coffee and Coffee-Based Beverages; Ready-to-Drink Coffee; Espresso, Herbal Tea, and Tea Beverages; Sandwiches First Use: Dec 14, 1992; First Use in Commerce: Sept 4, 1994

¹ The goods/services included in the chart reflect Opposers’ proposed or planned deletions from the goods/services descriptions in Opposers’ Registrations, regardless of whether the proposed deletions have become effective as of the date of this filing.

CARIBOU	4,313,121	Sept 7, 2012 / Apr 2, 2013	32: Beverage Smoothies; Fruit Juices; Non-Alcoholic Beverages, Namely, Carbonated Beverages; Soft Drinks Flavored with Tea; Fruit Flavored Soft Drinks; Soft Drinks, Namely, Sodas First Use: Jan 20, 1997; First Use in Commerce: Jan 20, 1997.
CARIBOU COFFEE	3,931,382	Feb 1, 2008 / Mar 15, 2011	29: Dried Fruit First Use: Mar 31, 2003; First Use in Commerce: Mar 31, 2003
CARIBOU COFFEE	2,609,319	Apr 16, 2001 / Aug 20, 2002	30: Ground and Whole Bean Coffee; Hot and Frozen Coffee, Espresso, Herbal Tea, and Tea Beverages; Baked Goods, Namely, Biscotti, Bread, Brownies, Cakes, Cookies, Muffins, Pastries, and Scones; Chocolate; Candy First Use: Dec 14, 1992; First Use In Commerce: Sept 4, 1994. 32: Beverage Smoothies First Use: Jan 2, 199; First Use in Commerce: Jan 20, 1997.
CARIBOU COFFEE	3,401,155	Jul 3, 2007 / Mar 25, 2008	Class 30: Sandwiches First Use: May 1, 1996; First Use in Commerce: May 1, 1996.
CARIBOU COFFEE	4,299,376	Feb 24, 2012 / Oct 23, 2012	30: Breakfast Cereals and Beverages with a Chocolate Base First Use: Sept 30, 2009; First Use in Commerce: Sept 30, 2009.

CARIBOU COFFEE	4,374,989	Sept 7, 2012 / Jul 30, 2013	32: Beverage Smoothies; Fruit Juices; Non-Alcoholic Beverages, Namely, Carbonated Beverages; Soft Drinks Flavored with Tea; Fruit Flavored Soft Drinks, Soft Drinks, Namely Sodas First Use: Jan 20, 1997; First Use in Commerce: Jan 20, 1997.
CARIBOU COFFEE	2,703,741	Apr 16, 2001 / Apr 8, 2003	Class 35: Retail Store Services, On-Line Retailing and Ordering Services Featuring Coffee; Coffee Brewing Accessories; Food and Beverageware First Use: Apr 1, 1997; First Use in Commerce: Apr 1, 1997.
CARIBOU COFFEE	1,839,091	Dec 4, 1992 / Jun 7, 1994	Class 42: Restaurant Services and Retail Store Services in the Field of Coffee First Use: Sept 1, 1992; First Use in Commerce: Sept 1, 1992.
 CARIBOU COFFEE & Leaping Caribou and Shield Design	4,264,888	Dec 23, 2009 / Dec 25, 2102	Class 29: Milk-Based Beverage Containing Coffee; Dried Fruit; Fruit Salads and Vegetable Salads; Yogurt First Use: Nov 1, 2009; First Use in Commerce: Nov 1, 2009.
 CARIBOU COFFEE & Leaping Caribou and Shield Design	3,935,459	Dec 21, 2009 / Mar 22, 2011	Class 30: Ground and Whole Bean Coffee; Coffee and Coffee-Based Beverages; Espresso, Herbal Tea, and Tea Beverages; Baked Goods, Namely, Biscotti, Bread, Brownies, Cakes, Cookies, Muffins, Pastries, and Scones; Chocolate; Candy; Sandwiches First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010

 CARIBOU COFFEE & Leaping Caribou and Shield Design	3,945,509	Dec 22, 2009 / Apr 12, 2011	<p>Class 35: Retail Store Services, and On-Line Retail Stores Services Featuring Coffee, Tea, Coffee and Tea brewing Accessories, Food, and Beverageware; Retail Store Services in the Field of Coffee, Tea, Coffee and Tea Brewing Accessories, Food, and Beverageware, Feature a Bonus Incentive Program for Customers</p> <p>First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010.</p>
 CARIBOU COFFEE & Leaping Caribou and Shield Design	3,878,886	Dec 21, 2009 / Nov 23, 2010	<p>Class 43: Restaurant Services; Office Coffee Supply Services; Providing News and Information in the Field of Drinks, Specialty Coffee</p> <p>First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010</p>
 CARIBOU COFFEE & Leaping Caribou and Shield Design (in Color)	3,935,455	Dec 21, 2009 / Mar 22, 2011	<p>Class 30: Ground and Whole Bean Coffee; Coffee and Coffee-Based Beverages; Espresso, Herbal Tea, and Tea Beverages; Baked Goods, Namely, Biscotti, Bread, Brownies, Cakes, Cookies, Muffins, Pastries, and Scones; Chocolate; Candy; Sandwiches</p> <p>First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010.</p>
 CARIBOU COFFEE & Leaping Caribou and Shield Design (in Color)	3,941,677	Dec 21, 2009 / Apr 5, 2011	<p>Class 35: Retail Store Services, and On-Line Retail Store Services Featuring Coffee, Tea, Coffee and Tea Brewing Accessories, Food, and Beverageware; Retail Store Services in the Field of Coffee, Tea, Coffee and Tea Brewing Accessories, Food, and Beverageware, Featuring a Bonus Incentive Program for Customers</p> <p>First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010.</p>

 <p>CARIBOU COFFEE & Leaping Caribou and Shield Design (in Color)</p>	3,878,884	Dec 21, 2009 / Nov 23, 2010	<p>Class 43: Restaurant Services; Office Coffee Supply Services; Providing News and Information in the Field of Drinks, Namely Coffee</p> <p>First Use: Mar 1, 2010; First Use in Commerce: Mar 1, 2010.</p>
 <p>CARIBOU COFFEE & Leaping Caribou and Shield Design</p>	2,703,747	Apr 17, 2001 / Apr 8, 2003	<p>Class 35: Retail Store Services Featuring Coffee, Coffee Brewing Accessories, Food and Beverageware</p> <p>First Use: Apr 1, 1997; First Use in Commerce: Apr 1, 1997.</p>
 <p>CARIBOU COFFEE & Leaping Caribou and Shield Design²</p>	1,841,047	Jul 26, 1993 / Jun 21, 1994	<p>Class 42: Restaurant and Café Services and General Retail Store Services in the Field of Coffee</p> <p>First Use: Sept 1, 1992; First Use in Commerce: Sept 1, 1992.</p>
 <p>CARIBOU COFFEE DRIVE THRU & Leaping Caribou Design (in Color)</p>	3,295,338	Nov 23, 2005 / Sept 18, 2007	<p>Class 43: Restaurant Services</p> <p>First Use: Dec 19, 2005; First Use in Commerce: Dec 19, 2005.</p>
<p>CARIBOU COFFEE IS THE OFFICIAL COFFEE OF DAYLIGHT SAVINGS TIME</p>	4,217,935	Apr 4, 2012 / Oct 2, 2012	<p>Class 35: Retail Store Services Featuring Coffee</p> <p>First Use: Mar 10, 2012; First Use in Commerce: Mar 10, 2012.</p>
<p>CARBIUO COFFEE IS THE OFFICIAL COFFEE OF DAYLIGHT SAVINGS TIME</p>	4,217,936	Apr 4, 2012 / Oct 2, 2012	<p>Class 43: Restaurant Services</p> <p>First Use: Mar 10, 2012; First Use in Commerce: Mar 10, 2012.</p>

² Opposers have a pending Section 7 amendment to move “Caribou” and “Coffee” in this mark to either side of the design portion of the mark. The amendment has not yet been accepted.

CARIBOU COOLER	85/792,657	Dec 3, 2012 / n/a	Class 32: Beverage Smoothies First Use: Oct 1, 2012; First Use in Commerce: Oct 1, 2013
CARIBOU PERKS	4,465,259	May 2, 2013 / Jan 14, 2014	Class 35: Retail Store Services in the Field of Coffee, Tea, Coffee and Tea Brewing Accessories, Food, Candy, and Beverageware Featuring a Bonus Incentive Program for Customers First Use: Apr 23, 2013; First Use in Commerce: Apr 23, 2013.
 DRIVE THRU CARIBOU COFFEE & Leaping Caribou and Shield Design	4,094,172	Dec 23, 2009 / Jan 31, 2012	Class 43: Restaurant Services First Use: Oct 14, 2011; First Use in Commerce: Oct 14, 2011.

Applicant's Answer: Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Notice of Opposition and leaves Opposer to its proofs.

4. Attached as Exhibit A are current printouts of information from the electronic database records of the U.S. Patent and Trademark Office showing the current status and title of Opposers' Registrations.

Applicant's Answer: Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Notice of Opposition and leaves Opposer to its proofs. In further answer, Applicant states that it is the owner of prior U.S. Registration No. 2,202,289 for CAMEL CARIBOU, in International Class 30 for "ice cream," which is a dairy product, first used in commerce *June 25, 1997*, and registered on *November 30, 1998*.

5. Caribou is the exclusive licensee of all of Opposers' Marks.

Applicant's Answer: Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 5 of the Notice of Opposition and leaves Opposer to its proofs.

6. Opposers' rights in Opposers' Marks were established well prior to the filing date of the Opposed Application. Opposers' Marks have not been abandoned.

Applicant's Answer: Denied.

7. Applicant has not been licensed or in any way authorized by Opposers to use the mark CHOCOLATE CARAMEL CARIBOU & Design, or any mark containing the term "CARIBOU," for any goods or services.

Applicant's Answer: Denied. In further answer, Applicant states that it is the owner of prior U.S. Registration No. 2,202,289 for CAMEL CARIBOU, which Applicant has licensed to multiple licensees throughout the United States for dairy products.

8. Applicant's CHOCOLATE CARAMEL CARIBOU & Design mark would be likely to cause confusion, to cause mistake, or to deceive, if it were used or registered for use on the goods identified in the Opposed Application. It is likely that consumers would mistakenly believe that those goods were offered by Opposers or were in some way sponsored by or connected with Opposers. As such, Applicant's CHOCOLATE CARAMEL CARIBOU & Design mark should be denied registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Applicant's Answer: Denied. In further answer, Applicant states that the Examining Attorney who reviewed Applicant's CAMEL CARIBOU & Design application did not refuse to register Applicant's mark on the basis of a likelihood of confusion with any of Opposer's claimed registrations. Similarly, following a Letter of Protest based on four of Opposer's registrations, the Examining Attorney decided, again, against issuing a refusal on the basis of a

likelihood of confusion with Opposer's claimed registrations, allowing Applicant's CAMEL CARIBOU & Design application to proceed to publication.

AFFIRMATIVE DEFENSES

1. Opposer's action is barred by the doctrines of acquiescence, abandonment, laches, and/or estoppel.

2. Opposer's action cannot be sustained because there is no likelihood of confusion in this case.

3. Opposer's action cannot be sustained because Opposer does not have priority to the subject mark in relevant territories or throughout the United States.

4. Opposer's action cannot be sustained because Applicant has priority: Applicant is the owner of prior U.S. Registration No. 2,202,289 for CAMEL CARIBOU, in International Class 30 for "ice cream," which is a dairy product, first used in commerce June 25, 1997, and registered on November 30, 1998.

5. Opposer is estopped from asserting that a likelihood of confusion exists based on the respective marks.

6. Applicant reserves the right to add additional affirmative defenses as they may become known during the course of this proceeding.

PRAYER FOR RELIEF

WHEREFORE, Applicant respectfully requests that Opposer's Notice of Opposition be dismissed in its entirety and that Application Serial No. 85/878,883 for the mark CHOCOLATE CAMEL CARIBOU & Design be permitted to proceed to registration.

Applicant respectfully requests that the Trademark Trial and Appeal Board direct all future correspondence in this matter to the undersigned attorneys of record.

Respectfully submitted,

Dated: March 31, 2014

By: /s/ G. Thomas Williams

G. Thomas Williams

Mary C. Bonnema

MCGARRY BAIR PC

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CERTIFICATE OF SERVICE

This is to certify that a true and complete copy of the foregoing *Applicant's Answer and Affirmative Defenses* was served by first-class mail, postage prepaid on Applicant's counsel at the following address:

Elizabeth C. Buckingham
Heather D. Redmond
Matthew C. Mlsna
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Dated: March 31, 2014

By: /s/ G. Thomas Williams

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