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

CARACOLILLO COFFEE MILLS, INC.,

Opposer,

v.

PAN AMERICAN COFFEE CO., INC.,

Applicant.



01-14-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #67

Opposition No. 120,415

**OPPOSER'S MOTION IN OPPOSITION TO  
APPLICANT'S MOTION TO SUSPEND PROCEEDINGS**

Opposer, Caracolillo Coffee Mills, Inc. (hereinafter "Opposer"), by and through its undersigned counsel, hereby moves that the Trademark Trial and Appeal Board (the "Board") deny Applicant's Motion to Suspend ("Motion") the subject proceedings.

In the Motion, Applicant Pan American Coffee Company ("Applicant") requests suspension of the subject opposition proceeding in order to permit the Applicant to amend its application to one for concurrent registration. Applicant claims that it requires a suspension of the proceedings in order to prepare and file a concurrent use amendment. In the alternative, Applicant requests that the Trademark Trial and Appeal Board (the "Board") grant Applicant a 30 day extension of time to respond to Opposer's Motion for Summary Judgment. Opposer respectfully requests that the Board deny Applicant's Motion for Suspension and its request for extension of time.

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I. **Introduction**

Application Serial No. 75/691,467 was published for opposition in the Official Gazette on May 23, 2000 at Page TM 348. Opposer timely filed a Notice of Opposition to registration of the Applicant's **CAFE CARACOLILLO** mark, Application Serial No. 75/691,467, on June 8, 2000. The opposition is based upon, in pertinent part, Opposer's prior use of the mark **CAFE CARACOLILLO** in association with "coffee" in International Class 30, which is the subject of U.S. Application Serial No. 75/667,025. Opposer has continuously been using the **CAFE CARACOLILLO** mark since at least as early as 1936, and in U.S. commerce since at least as early as 1950, to date.

On or about December 26, 2000, Applicant filed its Answer to Opposer's Notice of Opposition, denying, in pertinent part, Opposer's allegation of a likelihood of confusion between Opposer's **CAFE CARACOLILLO** mark and the Applicant's **CAFE CARACOLILLO** mark. On February 8, 2001, Opposer served discovery requests upon the Applicant. Responses to said requests were due March 15, 2001. After not receiving Applicant's responses, Opposer contacted Applicant in a good faith effort to obtain the requisite responses. After failing to obtain the Applicant's responses, Opposer filed a Motion to Compel Applicant's responses on April 16, 2001. On June 1, 2001, Applicant served discovery request upon Opposer. Opposer's Motion to Compel was granted by the Trademark Trial and Appeal Board in Orders dated July 11 & July 20, 2001.

The parties proceeded to exchange discovery responses. On October 1, 2001, Opposer timely provided Applicant with evidence in support of its prior and continuous use of the

**CAFE CARACOLILLO** mark, including invoices evidencing its sale of products bearing the **CAFE CARACOLILLO** mark in eight States. On October 22, 2001, Opposer produced further evidence in support of its use of the mark **CAFE CARACOLILLO** mark, including invoices evidencing the occurrence of sales in a further thirty-three (33) states. On November 21, 2001, Opposer timely filed its Motion for Summary Judgment. A copy of the Motion for Summary Judgment was served upon Applicant's counsel, via first class mail. On December 26, 2001, thirty-five (35) days after the filing of Opposer's Motion for Summary Judgment, Applicant's Motion to Suspend was filed with the Board.

II. **Applicant's Motion to Suspend is Untimely**

Applicant has had ample opportunity to gather and prepare the necessary documentation and information necessary to support its request for an amendment of its application to concurrent use. Applicant has been aware of Opposer's claim of prior use since at least as early as the imposition of the subject opposition proceeding. Furthermore, evidence of Opposer's prior and extensive use in the form of invoices and other documentation was submitted to Applicant no less than three months ago.

Opposer's Motion for Summary Judgment was filed on November 21, 2001. Applicant, however, waited until December 26, 2001 to serve its Motion for Suspension. Even though 37 C.F.R. §2.127(e)(1) provides a party with 30 days from the date of service (plus an additional 5 days if service occurred via first class mail) to lodge a response to a motion for summary judgment, Applicant's Motion to Suspend cannot be considered to be a Paper in response to a motion for summary judgment. Under Rule 56(e) of the Federal Rules of Civil Procedure, a party opposing summary judgment "may not rest upon the mere

allegations or denials of his pleading, but his response by affidavit, or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial". *Skaggs Pay Less Drug Stores v. Plymouth Wholesale Corporation*, 168 U.S.P.Q. 799, 800 (TTAB 1971) quoting *Harco Laboratories, Inc. v. The Decca Navigator Company Limited*, 150 U.S.P.Q. 813 (TT&A Bd., 1966). Since petitioner has not put in issue a single material fact relied on by respondent in its motion for summary judgment, we find that there is no genuine dispute as to those facts. *Id.*

Applicant's Motion to Suspend clearly fails to set forth specific facts showing that there is a genuine issue for trial. Applicant's Motion to Suspend simply consisted of a request to suspend proceedings in order to permit Applicant to amend its application to concurrent use. This paper cannot be seen as a paper in response to a motion for summary judgment. In fact, Applicant's statement that it seeks to amend its application to claim concurrent use is effectively an admission that Opposer has superior rights to the **CAFE CARACOLILLO** mark. *See Corporate Document Services Inc. v. I.C.E.D. Management Inc.* 48 U.S.P.Q.2d 1477, 1479 (TTAB 1998)(Opposer acknowledged prior use by applicant, by its amendment of its pending application to one seeking concurrent use).

Opposer submits that the provisions of 37 C.F.R. §2.127(a) which specifically state "[E]xcept as provided in paragraph (e)(1) of this section, a brief in response to a motion shall be filed fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board or the time is extended by stipulation of the parties approved by the Board ..." are applicable to Applicant's Motion. As Applicant's Motion to Suspend failed to set forth specific facts showing that there is a genuine issue for trial,

Opposer submits that the Motion to Suspend filed within the time period provided for responding to a motion for summary judgment was untimely and improper, and that a Motion of the type submitted by the Applicant could only be deemed to be timely if filed within 15 days of the service of Opposer's Motion for Summary Judgment. In view of the foregoing, Opposer submits that Applicant's Motion to Suspend was untimely and should therefore not be granted.

**III. Applicant Should Not Be Granted an Extension of Time to Respond to Opposer's Motion for Summary Judgment.**

As an alternative to granting Applicant's Motion to Suspend, Applicant has requested a 30 day extension of time to respond to Opposer's Motion for Summary Judgment. Opposer respectfully requests that the Board deny this request as well.

Once again, Opposer submits that Applicant has had ample opportunity to gather and prepare the necessary documentation and information necessary to support a response to Opposer's Motion for Summary Judgment. Applicant has been aware of Opposer's claim of prior use since at least as early as the imposition of the subject opposition proceeding. Furthermore, evidence of Opposer's prior and extensive use in the form of invoices and other documentation was submitted to Applicant no less than three months ago.

As set forth above, Opposer served discovery requests upon the Applicant on February 8, 2001. After attempting in good faith to obtain Applicant's responses, Opposer was forced to file a motion to compel Applicant's responses. Although Opposer timely provided Applicant with evidence in support of its use of the **CAFE CARACOLILLO** mark on two separate occasions, Applicant failed to respond to many of the discovery requests propounded

by Opposer on the basis that Applicant's responses to the same consisted of information and/or documentation that was confidential or constituted a trade secret. Applicant merely provided 34 pages of documentation, the majority of which did not pertain to Applicant's alleged use of the CAFE CARACOLILLO mark. Upon entry of a Protective Order, Applicant provided Opposer with an additional 75 pages of confidential information which consisted of a client list for Aroma Coffee Roasters, Inc., and a joint financial statement for Aroma Coffee Roasters, Inc. and Applicant, Pan American Coffee Co., Inc. To date, Applicant has provided no evidence of its use of the **CAFE CARACOLILLO** mark in connection with the sale of goods claimed in its application.

Moreover, Applicant's request for an extension of time to respond to Opposer's Motion for Summary Judgment was defective as it did not include a showing of good cause in accordance with the provisions of TBMP §509. Applicant's Motion to Suspend merely mentioned that Applicant desired to amend its application to be based upon concurrent use, but failed to include an actual amendment to concurrent use and/or a request to amend its application to seek registration on the basis of concurrent use. Even if the Applicant could assert that good cause can be inferred from its intent to amend the application, such good cause was in fact absent due to the failure of Applicant to include such an amendment with its Motion. Therefore, Opposer submits that Applicant's alternative request for an extension of time is defective due to the absence of a showing of good cause.

Given the amount of time that has passed between the institution of the subject proceeding to the present, and the continued reluctance Applicant has shown for abiding by the rules of the Board, the granting of Applicant's Motion and alternative request for relief would

be prejudicial to the Opposer by rewarding the Applicant for its failure to follow the Rules of the Trademark Trial and Appeal Board. Therefore, Opposer respectfully requests that the Board deny Applicant's request for an extension of time to respond to Opposer's Motion for Summary Judgment.

IV. **Conclusion**

Applicant's Motion to Suspend should be denied as it cannot be found to be responsive to Opposer's Motion for Summary Judgment and was therefore untimely filed. Opposer further submits that Applicant's alternative request for an extension of time should be denied as being defective due to Applicant's failure to state good cause as to why such a motion should be granted; and as being prejudicial to the Opposer. In view of the forgoing, Opposer respectfully requests that the Board issue an order denying Applicant's Motion and alternative request for an extension of time to respond to Opposer's Motion for Summary Judgment.

Respectfully submitted,

**CARACOLILLO COFFEE MILLS, INC.**

Date: 14 January 2002

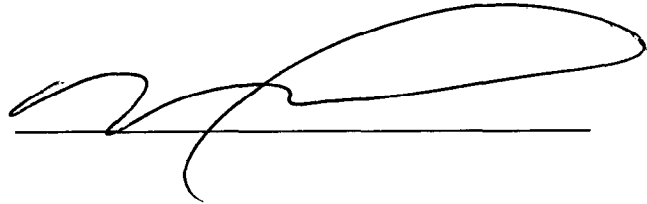
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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **OPPOSER'S MOTION IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND PROCEEDINGS** was served on counsel for Applicant, this 14<sup>th</sup> day of January 2002, by sending same via First Class Mail, postage prepaid, to:

Leo M. Loughlin  
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A handwritten signature in black ink, appearing to read "Leo M. Loughlin", is written over a horizontal line. The signature is stylized and cursive.