

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

NOTICE OF OPPOSITION

In the Matter of Application
Serial No. 76/511,254 Published in
the Official Gazette of August 3, 2004

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REPUBLIC OF COLOMBIA :

- and - :

NATIONAL FEDERATION OF COFFEE :
GROWERS OF COLOMBIA, :
: Opposition No.
Opposers, :
v. :

LARSON PROMOTIONS INC., :
Applicant. :
-----X
08/31/2004 TMCANTS 00000039 76511254
01 FC:6402 300.00 DP

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Opposers, the REPUBLIC OF COLOMBIA (the "Republic"), the sovereign country of Colombia, and NATIONAL FEDERATION OF COFFEE GROWERS OF COLOMBIA (the "Federation"), a private, not-for-profit organization in Colombia, (collectively referred to as the "Opposers") believe that they will be damaged by registration of the mark shown in Serial No. 76/511,254 and hereby oppose the same.

On May 1, 2003, Applicant LARSON PROMOTIONS INC. ("Applicant") applied for the mark LA MISION CAFÉ & CULTURA LAS TIENDAS DEL CAFÉ COLOMBIANO & Design (which word portion translates in English to "The Mission

Coffee and Culture” and “The Colombian Coffee Stores”) in Class 43 for “cafes, restaurants and restaurant services,” on an intent-to-use basis.

As grounds of opposition, it is alleged that:

1. The Republic is the owner of the U.S. Certification Mark Registration No. 1,160,492 (the “Certification Mark”), for the mark COLOMBIAN for coffee, which was registered on the Principal Register on July 7, 1981 and renewed on July 9, 2001.¹ The Federation is authorized to enforce and protect the Republic’s rights in the Certification Mark as its agent, subject to the Republic’s ultimate control.

2. The Federation was created by the Republic in 1927 to protect the legal and economic interests of Colombia’s coffee growers. The Federation was established for the purposes, among others, of (a) internationally promoting, (b) controlling the quality and grading of, (c) conducting research concerning, and (d) providing sales strategies for the sale of coffee grown in Colombia.

3. The Federation is authorized by the Republic to collect and use coffee export fees in order to fund promotional efforts in the United States and elsewhere; conduct scientific research concerning coffee farming and production; assist rural Colombian coffee growers through health programs, education centers and financial assistance; and protect Colombian farmers by establishing markets for their products. The Federation, on behalf of the Republic, performs quality inspection and grades all coffee exported from Colombia, which includes barring from export any inferior grades of coffee. The Federation is also responsible for overseeing the advertising and marketing activities

¹ Two copies of the registration relied upon by the Opposers, prepared by the Patent and Trademark Office and showing the current status and title of the Certification Mark, are attached and should be received into evidence pursuant to 37 C.F.R. § 2.122(d)(1).

undertaken to promote, distribute and sell coffee grown in Colombia. Over the last two decades the Opposers have invested in excess of \$200 million worldwide in connection with such advertising and marketing activities, a large portion of which was spent in the United States.

4. The registration of the Certification Mark was based on an application filed in the U.S. Patent and Trademark Office on January 10, 1979. The Certification Mark has been in continuous use in interstate commerce in connection with coffee, as set forth in Registration No. 1,160,492, since September 1927. The Certification Mark has since achieved “incontestable” status.

5. During this time, the Certification Mark has been used by the Federation to certify that the coffee which bears such mark was grown in Colombia, that such coffee has been subject to standard inspection, and that such coffee has been approved for export to the United States as having passed recognized minimum quality standards required for such export as set and enforced by the Republic.

6. The Certification Mark embodies the extensive good will and consumer recognition built up by the Federation through substantial amounts of time, money and effort in advertising and promotion. As such, the Certification Mark is of significant value to the Opposers and the coffee growers of Colombia.

7. The Opposers believe that Applicant’s proposed mark would impermissibly infringe upon the Certification Mark. Specifically, the word – “COLOMBIANO” – in Applicant’s proposed mark is identical to the Certification Mark as the English translation is “Colombian.”

8. It is apparent that Applicant has attempted to register its marks in an effort to take advantage of the goodwill associated with the Republic's Certification Mark. As Application Serial No. 76/511,254 makes clear, Applicant's proposed mark is intended to be used in connection with coffee-related services. More specifically, the Application indicates that Applicant intends to use Applicant's proposed mark in connection with cafes, restaurant and restaurant services, presumably in connection with Colombian coffees.

9. Additionally, Applicant is seeking or has sought to register the following other marks which also incorporate the Certification Mark for coffee or coffee-related goods or services: (1) COLOMBIAN COFFEE STORES (Serial No. 76/507,234) for cafes, restaurants and restaurant services; (2) LA MISION CAFÉ & CULTURA LAS TIENDAS DEL CAFÉ COLOMBIANO & Design (Serial No. 76/511,253) for coffee and coffee-based beverages; (3) LAS TIENDAS DEL CAFÉ COLOMBIANO (Serial No. 76/507,243) for licensing intellectual property; and (4) LAS TIENDAS DEL CAFÉ COLOMBIANO (Serial No. 76/507,232) for cafes, restaurants and restaurant services. An opposition was filed on April 9, 2004 by the Republic and the Federation in connection with the application for LAS TIENDAS DEL CAFÉ COLOMBIANO (Serial No. 76/507,243). The Trademark Trial and Appeal Board has since entered a Notice of Default in that opposition.

10. Consequently, registration of Applicant's proposed mark is likely to cause confusion, or to cause mistake, or to deceive, as to the source, sponsorship or affiliation of Applicant or its goods or services.

11. Additionally, as a separate ground of opposition, the word “COLOMBIANO” when used in connection with the goods or services of Applicant will be primarily geographically descriptive in that (i) the primary significance of Applicant’s proposed mark is geographic; (ii) purchasers would be likely to make a goods or services/place association upon viewing the mark; and (iii) the mark identifies the geographic origin of the goods or services. In effect, Applicant seeks to register a certification mark although it has neither the right nor the power to do so.

12. Additionally, as a separate ground of opposition, if Applicant is selling coffee that is not from Colombia in connection with Applicant’s proposed mark, the wording “CAFÉ COLOMBIANO” when used in connection with the goods or services of Applicant will be primarily geographically deceptively misdescriptive.

13. Applicant’s proposed mark, as used by Applicant, would connote not only a certain quality of goods or services but also an implied representation as to the origin of those goods or services in a manner that would impair the Republic’s exclusive right and obligation to control use of the previously-registered Certification Mark for these same purposes.

14. The Republic’s prior ownership of the Certification Mark precludes Applicant from registering any mark containing a word or phrase – in this instance, the word “COLOMBIANO” – that so resembles the Certification Mark as to be likely to cause confusion, or to cause mistake, or to deceive, particularly since the mark also contains the word “CAFÉ,” which is the class of goods covered by the Certification Mark.

15. The additional wording included in Applicant’s proposed mark fails to diminish the obvious resemblance between Applicant’s proposed mark and the

Certification Mark so as to lessen the likelihood that Applicant's proposed mark causes confusion, or mistake, or deceives. Likewise, the additional wording fails to alter the nature of Applicant's proposed mark such that it does not disparage and/or falsely suggest a connection with the Republic, the Federation, or both. Similarly, the additional wording fails to alter the nature of Applicant's proposed mark such that it is no longer primarily geographically descriptive or, alternatively, primarily geographically deceptively misdescriptive.

16. Consequently, Applicant's proposed mark is likely, when applied to Applicant's goods or services, to cause confusion, to cause mistake or to deceive persons by creating the erroneous impression that Applicant's goods or services originate with or come from the Opposers, or that the Opposers otherwise authorize, endorse or sponsor Applicant's goods or services, with consequent injury to the consuming public and the Opposers. The additional wording included in Applicant's proposed mark fails to diminish the obvious resemblance between Applicant's proposed mark and the Certification Mark so as to lessen the likelihood that Applicant's proposed mark causes confusion, or mistake, or deceives.

17. Finally, as a separate ground for opposition, Applicant's proposed mark consists of and comprises matter that may disparage and/or falsely suggest a connection with the Opposers, and so closely resembles the Certification Mark as to be likely to dilute the distinctive quality of the Certification Mark which has become famous over time, with consequent injury to the Opposers and the consuming public. Likewise, the additional wording fails to alter the nature of Applicant's proposed mark such that it does not disparage and/or falsely suggests a connection with the Opposers.

18. Furthermore, Applicant has employed bad faith efforts in order to establish a likelihood of public confusion between the source of the goods sold bearing the Certification Mark and those goods or services rendered under the Applicant's proposed mark. Applicant's clear intent is to "blur" Applicant's proposed mark (for coffee-related services) with the Certification Mark in a manner that allows the Applicant to capitalize on the extensive use and goodwill associated with the Certification Mark. As a result, the Opposers' reputation is likely to be injured by the registration of Applicant's proposed mark (for coffee-related services).

WHEREFORE, the Opposers believe that they will be damaged by the registration of Applicant's proposed mark, the Opposers pray that said application Serial No. 76/511,254 be rejected, and no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Opposers.

Please recognize DEWEY BALLANTINE LLP as attorneys for the Opposers herein, with full power to prosecute said opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts, and to receive all official communications in connection with this opposition, to be directed to the attention of:

Cecil E. Key, Esq.
DEWEY BALLANTINE LLP
1775 Pennsylvania Avenue, N.W.
Washington, D.C. 20006-4605

Dated: Washington, D.C.
August 23, 2004

DEWEY BALLANTINE LLP

By: 
Cecil E. Key

A Counsel of the Firm

1775 Pennsylvania Avenue, N.W.
Washington, D.C. 20006-4605
(202) 862-4853

Attorneys for the Opposers
National Federation of
Coffee Growers of Colombia

Of counsel:

Stanton J. Lovenworth
Brian S. McGrath



Prior U.S. Cl.: A

United States Patent and Trademark Office

Reg. No. 1,160,492

Registered Jul. 7, 1981

CERTIFICATION MARK

Principal Register

COLOMBIAN

The Republic of Colombia (sovereign country)
Bogota, Colombia

For: COFFEE, in CLASS A.

First use Sep. 1927; in commerce Sep. 1927.

The mark certifies that the coffee was grown in the Republic of Colombia and that such coffee has been subjected to standard inspection authorized by applicant and such coffee has been approved for export to the United States as passing recognized current minimum quality standards required for such export as set and enforced by said Federacion as agent for and subject to the ultimate control of the applicant.

Ser. No. 199,563, filed Jan. 10, 1979.

MARK B. HARRISON, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
 Patent and Trademark Office
 OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
 2900 Crystal Drive
 Arlington, Virginia 22202-3513

REGISTRATION NO: 1160492 SERIAL NO: 73199563 MAILING DATE: 01/30/2002
 REGISTRATION DATE: 07/07/1981
 MARK: COLOMBIAN
 REGISTRATION OWNER: Republic of Colombia, The
 CORRESPONDENCE ADDRESS:

STANTON J LOVENWORTH ESQ
 DEWEY BALLANTINE LLP
 1301 AVENUE OF THE AMERICAS
 NEW YORK NY 10019-6022

NOTICE OF ACCEPTANCE
 15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL
 15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
 A .

CLINKSCALES, ARLENE L
 PARALEGAL SPECIALIST
 POST-REGISTRATION DIVISION
 (703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

Prior U.S. Cl.: A

United States Patent and Trademark Office

Reg. No. 1,160,492

Registered Jul. 7, 1981

CERTIFICATION MARK

Principal Register

COLOMBIAN

The Republic of Colombia (sovereign country)
Bogota, Colombia

For: COFFEE, in CLASS A.

First use Sep. 1927; in commerce Sep. 1927.

The mark certifies that the coffee was grown in the Republic of Colombia and that such coffee has been subjected to standard inspection authorized by applicant and such coffee has been approved for export to the United States as passing recognized current minimum quality standards required for such export as set and enforced by said Federacion as agent for and subject to the ultimate control of the applicant.

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MARK B. HARRISON, Primary Examiner



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 CORRESPONDENCE ADDRESS:

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 PARALEGAL SPECIALIST
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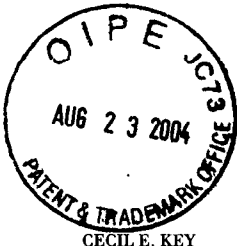
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August 23, 2004

Assistant Commissioner for Trademarks
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Arlington, VA 22202-3513



08-23-2004

U.S. Patent & TMO/TM Mail Rcpt. Dt. #40

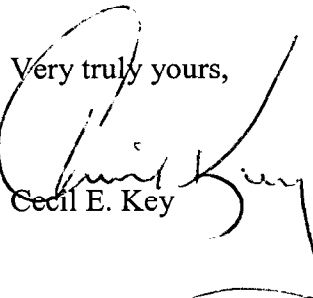
Re: Opposition to Application Serial No. 76/511,254
Opposer: The Republic of Columbia and National Federation
of Coffee Growers of Colombia - COLOMBIAN

Dear SIR:

On behalf of our clients, Republic of Colombia and National Federation of
Coffee of Colombia, enclosed for filing please find the following:

1. Notice of Opposition, dated August 23, 2004 in re: Opposition to
Application Serial No. 76/511,254;
2. Check for filing fees in the amount of \$300.00; and
3. A proof-of-receipt postcard.

Please stamp and return the enclosed postcard as evidence of your receipt
of these materials. Should you have any questions, please do not hesitate to contact me at
(202) 862-4583.

Very truly yours,

Cecil E. Key

CK:sra

Enclosures