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Filing date: **07/17/2006**

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

| | |
|---------------------------|---|
| Proceeding | 91170996 |
| Party | Plaintiff REPUBLIC OF COLUMBIA AND NATIONAL FEDERATION OF COFFEE GROWERS OF COLUMBIFEDERATION OF COFFEE GROWERS OF COLUMBI |
| Correspondence Address | STANTON J. LOVENWORTH DEWEY BALLANTINE LLP 1775 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20006-4605 |
| Submission | Opposition/Response to Motion |
| Filer's Name | Cecil E. Key |
| Filer's e-mail | ckey@dbllp.com, sgans@dbllp.com |
| Signature | /CEK/ |
| Date | 07/17/2006 |
| Attachments | 7-17-06 Opposition to Motion to Extend Time for Applicant to File Answer.pdf (16 pages)(457141 bytes) |

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

| | | |
|-----------------------------------|---|----------------|
| -----X | | |
| REPUBLIC OF COLOMBIA and NATIONAL | : | |
| FEDERATION OF COFFEE GROWERS OF | : | |
| COLOMBIA, | : | |
| | : | Opposition No. |
| Opposers, | : | 91/170,996 |
| v. | : | |
| | : | Serial No. |
| C.I. COPRUCOL LTDA, | : | 76/595,818 |
| | : | |
| Applicant. | : | |
| -----X | | |

**OPPOSITION TO MOTION TO EXTEND TIME
FOR APPLICANT TO FILE ITS ANSWER AND TO EXTEND DISCOVERY
AND TESTIMONY PERIODS**

Republic of Colombia and National Federation of Coffee Growers of Colombia (“Opposers”) hereby oppose the motion to extend time pursuant to 37 CFR § 2.116(a) and TBMP § 502.02(b). A motion for enlargement of time requires a showing of good cause. *See* TBMP § 509. In the pending motion, the only basis for the requisite showing of good cause is the statement of Applicant’s counsel that Applicant is a resident of Colombia and, therefore, all work must be coordinated through Colombian counsel. Motion at 1. Applicant asserted that, as a result, additional time is required in order to prepare a meaningful response. *Id.* For the following reasons, Opposers respectfully submit that Applicant’s grounds are insufficient to meet the requirements for a showing of good cause.

On August 12, 2004, the Opposers initiated contact with Applicant’s counsel in an effort to resolve the dispute that is the subject of this opposition in an amicable and expeditious manner. *See* Exhibit 1. On November 4, 2004, the Opposers sent another

letter to Applicant's counsel further explaining their position in hopes of resolving the matter. *See* Exhibit 2. On April 19, 2005, Opposers sent another follow-up letter to Applicant's counsel. *See* Exhibit 3. The Opposers did not receive a response from Applicant's counsel until April 26, 2005 and that response noted only that Applicant's attorney was awaiting substantive input from Applicant.

Thereafter the parties exchanged correspondence in which substantive issues were addressed. When the issues were not resolved, the Opposers filed their Notice of Opposition. Applicant's answer was due on June 28, 2006, the same day that Applicant filed its motion.

As required by the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), a motion to extend must set forth the detailed facts relied upon to meet the requirements of a showing of good cause. *See* TBMP § 509. Unexplained delay in initiating action in an affected time period does not constitute good cause. *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987). Moreover, the requisite showing of good cause is not satisfied if the moving party demonstrates a lack of diligence by waiting until the end of an open period before contacting opposing counsel and the Trademark Trial and Appeal Board ("TTAB") to request an extension. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1851 (TTAB 2000) ("The circumstances of Ms. Wolfshuk's extended leave thus being known to applicant's attorney at least a month prior to receipt of the Board's order, it was incumbent upon applicant's attorney...to notify opposer's attorney immediately that applicant would have difficulty complying with the Board's order. Then, if an extension

of time could not be agreed to, applicant promptly should have notified the Board that applicant could not comply with the order....”).

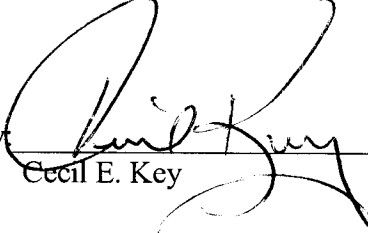
Applicant’s diminutive explanation lacks sufficient detail to constitute good cause. The issues identified in the Notice of Opposition have been known to Applicant for almost two years. The motion provides no explanation as to why, given the length of time that these issues have been outstanding, it could not prepare its answer.

Moreover, Applicant did not contact counsel for Opposers regarding the motion prior to filing it, but instead waited until the very day the answer was due to file its motion for extension of time. This delay further suggests that this motion should be denied. *See Baron Philippe*, 55 USPQ2d at 1851.

WHEREFORE, Opposers respectfully submit that under these circumstances, Applicant’s motion should be denied.

Dated: Washington, D.C.
July 17, 2006

DEWEY BALLANTINE LLP

By 
Cecil E. Key

1775 Pennsylvania Avenue, N.W.
Washington, D.C. 20006-4605
(202) 862-4583

Attorneys for the Opposers
Republic of Colombian and
National Federation of Coffee
Growers of Colombia

Of counsel:
Brian S. McGrath
Jason D. Clark

EXHIBIT 1

DEWEY BALLANTINE LLP

1301 AVENUE OF THE AMERICAS
NEW YORK 10019-6092
TEL 212 259-8000 FAX 212 259-6333

August 12, 2004

BY FEDERAL EXPRESS;
RETURN RECEIPT REQUESTED

Donald L. Dennison, Esq.
Dennison, Schultz, Dougherty & MacDonald
1727 King Street, Suite 105
Arlington, Virginia 22314

Re: PRE COLOMBINO and Design U.S. Trademark Application

Dear Mr. Dennison:

We are counsel for the Republic of Colombia (the "Republic") and The National Federation of Coffee Growers of Colombia (the "Federation"), which acts on the Republic's behalf with respect to the enforcement of certain intellectual property rights. The Federation's United States subsidiary is the Colombian Coffee Federation ("CCF"). As you may be aware, the Republic owns the United States federally registered certification mark COLOMBIAN (Registration No. 1,160,492) for coffee (the "Certification Mark"), which the Republic has used for many years to certify the source and quality of Colombian coffee sold in the United States by various roasters, wholesalers and retailers.

The Certification Mark is a valuable asset that provides, on behalf of the Republic and Colombia's coffee growers, reassurance to consumers that when they buy coffee marked COLOMBIAN, they are getting coffee from Colombia that meets with the standards set forth in the registration. The Republic, through the Federation and CCF, is obliged to, and does take such action as is necessary to protect the integrity of the Certification Mark when apprised of its infringement or misuse.

It has come to our attention that your client C.I. Coprucol LTDA ("Coprucol") has filed an application for U.S. federal registration of the trademark PRE COLOMBINO and Design in connection with coffee which has been assigned Serial No. 76/595,818 (the "Proposed Trademark"). It is our consistent position that under applicable legal rules, the Certification Mark may not be used as, or incorporated within, a trademark, domain name, brand name or corporate name for any products or services relating to coffee. The trademark laws of the United States place an obligation on the Republic to control use of the Certification Mark to prevent the public from being misled as to the nature of the certified goods or services, including ensuring that the Certification

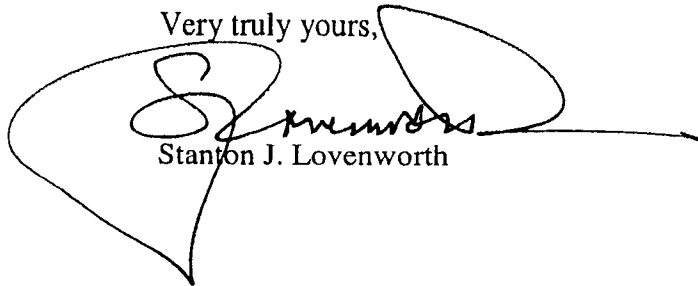
Letter to Donald L. Dennison, Esq.
August 12, 2004
Page 2

Mark is used only to describe applicable goods accurately and not as part of a trademark or a corporate or brand name. For these reasons, we demand that Coprucol expressly withdraw the application for the Proposed Trademark and refrain from all use of the Certification Mark (*i.e.*, the word "Colombian" or any other confusingly similar word such as "Colombino") as a part of any trademark or corporate or brand name in connection with the sale, marketing or promotion of coffee or coffee-related goods or services, such as coffee substitutes, in the United States.

Please understand that our clients -- the Republic, the Federation and CCF -- are not seeking to prevent Coprucol from selling Colombian coffees, or referring to coffees as "Colombian," where such coffee complies with applicable Certification Mark standards. To the contrary, the Federation's objective, as mandated by U.S. law, is to deter the inappropriate and unlawful use of the valuable mark "Colombian" to identify a particular brand as a trademark, or to sell non-Colombian or below grade coffees. Should Coprucol wish to sell certified Colombian coffee, representatives of CCF would be pleased to advise Coprucol of the proper means and methods for doing so, and of course, would encourage Coprucol to do so.

We trust that you will recognize the importance of this matter, and we anticipate your prompt response to this letter by letter, telephone or email to Devon Goldberg of this office (212-259-6705; dgoldberg@dbllp.com) within 30 days after the date of this letter. This letter is sent without prejudice to any and all other rights and remedies which the Federation have concerning the referenced matters.

Very truly yours,

A large, stylized handwritten signature in black ink, appearing to read "Stanton J. Lovenworth". The signature is written over the typed name below it.

Stanton J. Lovenworth

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.

EXHIBIT 2

DEWEY BALLANTINE LLP

1775 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, D.C. 20006-4605
TEL 202 862-1000 FAX 202 862-1093

CECIL E. KEY
COUNSEL
TEL 202 862-4583
ckey@deweyballantine.com

November 4, 2004

BY FEDERAL EXPRESS

Donald L. Dennison, Esq.
Dennison, Schultz, Dougherty & MacDonald
1727 King Street, Suite 105
Arlington, Virginia 22314

Re: PRE COLOMBINO and Design U.S. Trademark Application

Dear Mr. Dennison:

Thank you for your letter of September 17, 2004 to Stan Lovenworth. We appreciate your frank response to the concerns of our clients, the Republic of Colombia (the "Republic") and The National Federation of Coffee Growers of Colombia (the "Federation"). We acknowledge that C.I. Coprucol Ltda. ("Coprucol") has a license to export coffee from Colombia, but Coprucol must also be a party to the Federation's Trademark License Agreement ("TLA") in order to use "Café de Colombia" along with the traditional JUAN VALDEZ logo on its packaging. We are unaware of a TLA executed by Coprucol, or any other similar brand use approval by the Federation, and Coprucol's use is therefore unauthorized and in violation of the Republic's and the Federation's intellectual property rights.

Moreover, a TLA licensee is not permitted to file a trademark application for a mark which is confusingly similar to the Republic or Federation's marks. Thus, regardless of whether the word "Pre-Colombino" translates to mean "prior to October 12, 1492," it remains confusingly similar to "Colombian" (or even more so to "Colombiano," the Spanish translation for "Colombian") when applied to coffee or related products, particularly in light of the well-established prior use of the COLOMBIAN certification mark. This could lead consumers to believe, erroneously, that the Republic of Colombia in some way endorses or is associated with your client's coffee and coffee-related goods.

For these reasons, we must reiterate our demands that Coprucol expressly withdraws the U.S. trademark application for PRE COLOMBINO and Design, Serial No. 76/595,818 (the "Proposed Trademark"), ceases any use of the Proposed Trademark and the traditional Juan Valdez logo (absent entry by Coprucol into a TLA license) on its packaging or other promotional materials, and refrains from all use of the Certification Mark (*i.e.*, the word "Colombian" or any other confusingly similar word such as

Donald L. Dennison, Esq.
November 4, 2004
Page 2

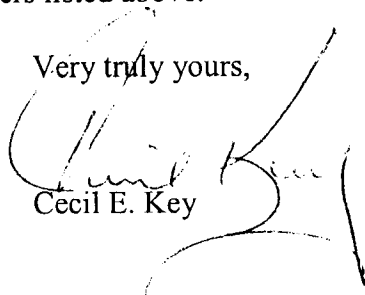
“Colombino”) or the traditional Juan Valdez logo as a part of any trademark or corporate or brand name in connection with the sale, marketing or promotion of coffee or coffee-related goods or services in the United States.

Please understand that should Coprucol wish to sell certified Colombian coffee in connection with the trademarks registered to the Federation (such as the traditional Juan Valdez Design), representatives of the Federation would be pleased to discuss with Coprucol the proper means and methods for doing so, and of course, would encourage Coprucol’s participation in the TLA program. Coprucol must, however, immediately abandon its application for the Proposed Trademark.

We thank you in advance for you anticipated cooperation in this matter, and look forward to receiving confirmation that the Proposed Trademark will be abandoned. This letter is sent without prejudice to any and all other rights and remedies which the Republic or the Federation has concerning the referenced matters.

If you would like to discuss this matter further, please do not hesitate to contact me at the address and phone numbers listed above.

Very truly yours,



Cecil E. Key

EXHIBIT 3

DEWEY BALLANTINE LLP

1775 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, D.C. 20006-4605
TEL 202 862-1000 FAX 202 862-1093

CECIL E. KEY
202 862 4583
ckey@deweyballantine.com

April 19, 2005

VIA FACSIMILE AND U.S. MAIL

Donald L. Dennison, Esq.
Dennison, Schultz, Dougherty & MacDonald
1727 King Street, Suite 105
Arlington, Virginia 22314

Re: PRE COLOMBINO and Design U.S. Trademark Application

Dear Mr. Dennison:

I write to follow-up on my letter to you dated November 4, 2004 to which I have to date received no response. As I advised you in my letter, our clients, the Republic of Colombia (the "Republic") and the National Federation of Coffee Growers of Colombia (the "Federation"), object to C.I. Coprucol Ltda.'s ("Coprucol") unauthorized use of "Café de Colombia" and the traditional JUAN VALDEZ logo on its packaging. Furthermore, I reiterated our demand that Coprucol expressly withdraw the U.S. trademark application for PRE COLOMBINO (Serial No. 76/595,818) which is confusingly similar to COLOMBIAN when applied to coffee or related products.

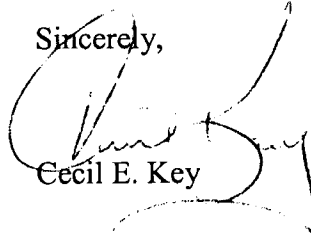
Please understand that should Coprucol wish to sell certified COLOMBIAN coffee in connection with the trademarks registered to the Federation (such as the JUAN VALDEZ design), representatives of the Federation would be pleased to discuss the proper means for doing so with Coprucol. However, as you know, participation in the Trademark License Agreement ("TLA") program prohibits unauthorized use of the Federation's marks and registration of marks which are confusingly similar to those of the Republic or the Federation. Thus, the unauthorized uses of our clients' intellectual property must cease and the PRE COLOMBINO trademark application abandoned immediately.

Donald L. Dennison, Esq.
April 19, 2005
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We ask that you please provide us with a written response by no later than April 29, 2005. Please understand that if we are not able to resolve this matter quickly and amicably, as we had hoped to do, our clients may be left with no choice but to take necessary and appropriate measures to protect their valuable intellectual property rights.

I look forward to receiving your response.

Sincerely,

A handwritten signature in black ink, appearing to read "Cecil E. Key", is written over the printed name. The signature is fluid and cursive, with a large initial "C" and "E".

Cecil E. Key

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing *OPPOSITION TO MOTION TO EXTEND TIME FOR APPLICANT TO FILE ITS ANSWER AND TO EXTEND DISCOVERY AND TESTIMONY PERIODS* was served on this 17th day of July, 2006, to counsel of record as follows:

First Class Mail

Donald L. Dennison, Esq.
Dennison, Schultz & MacDonald
1727 King Street
Suite 105
Alexandria, VA 22314-2700

A handwritten signature in cursive script, reading "Sarah J. Gans", written over a horizontal line.

Sarah J. Gans, Legal Assistant