

ESTTA Tracking number: **ESTTA356441**

Filing date: **07/06/2010**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Republic of Tea, Inc.
Granted to Date of previous extension	07/07/2010
Address	#5 Hamilton Landing, Suite 100 Novato, CA 94949 UNITED STATES

Attorney information	Michelle C. Burke McDermott Will & Emery LLP 227 W. Monroe Street, Suite 4400 Chicago, IL 60606-5096 UNITED STATES lbalsan@mwe.com, chicago_ip_docket@mwe.com, umattsson@mwe.com, mburke@mwe.com, cvicino@mwe.com Phone:312-372-2000
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Applicant Information

Application No	77566382	Publication date	03/09/2010
Opposition Filing Date	07/06/2010	Opposition Period Ends	07/07/2010
International Registration No.	NONE	International Registration Date	NONE
Applicant	Java Republic Limited Old Naas Road The Roastery, Citylink Business Park Dublin, 12 IRELAND		

Goods/Services Affected by Opposition

Class 030. Opposed goods and services in the class: tea
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1848818	Application Date	06/17/1991
Registration Date	08/09/1994	Foreign Priority Date	NONE
Word Mark	THE REPUBLIC OF TEA		


Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1992/05/01 First Use In Commerce: 1992/05/01 art prints, storage boxes and bags, adhesive decals and posters Class 025. First use: First Use: 1992/05/01 First Use In Commerce: 1992/05/01 clothing; namely, men's and women's shirts Class 030. First use: First Use: 1992/05/01 First Use In Commerce: 1992/05/01 tea

U.S. Registration No.	1797903	Application Date	06/01/1992
Registration Date	10/12/1993	Foreign Priority Date	NONE

Word Mark	THE REPUBLIC OF TEA		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1992/04/15 First Use In Commerce: 1992/04/15 clothing; namely, men's and women's shirts, sweat shirts, pants, slacks, shoes, jackets and coats Class 030. First use: First Use: 1992/01/22 First Use In Commerce: 1992/01/22 tea

U.S. Registration No.	1806157	Application Date	10/14/1992
Registration Date	11/23/1993	Foreign Priority Date	NONE

Word Mark	THE REPUBLIC OF TEA		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 021. First use: First Use: 1992/04/15 First Use In Commerce: 1992/04/15 tea pots, tea kettles, tea infusers, beverage cups and beverage glasses

U.S. Registration No.	2071181	Application Date	10/26/1995
Registration Date	06/17/1997	Foreign Priority Date	NONE
Word Mark	REPUBLIC CHAI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/15 tea Class 032. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/15 tea flavored soft drinks		

U.S. Registration No.	2502199	Application Date	12/22/2000
Registration Date	10/30/2001	Foreign Priority Date	NONE
Word Mark	IMPERIAL REPUBLIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1999/10/01 First Use In Commerce: 1999/10/01 Tea		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE REPUBLIC OF TEA		
Goods/Services	Trade Name		

Attachments	74280194#TMSN.gif (1 page)(bytes) 74322200#TMSN.gif (1 page)(bytes) Execution Copy of Notice of Opposition for Filing.pdf (5 pages)(249483 bytes) Exhibit 1.pdf (5 pages)(112093 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	//Michelle C. Burke//
Name	Michelle C. Burke
Date	07/06/2010

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

In the matter of trademark application Serial No. 77/566,382
For the mark JAVA REPUBLIC ROASTING COMPANY (and DESIGN)
Published in the Official Gazette on March 9, 2010

The Republic of Tea, Inc.,	
Opposer,	
v.	
Java Republic Limited,	
Applicant.	

NOTICE OF OPPOSITION

The Republic of Tea, Inc. is a California corporation, with its principal place of business at #5 Hamilton Landing, Suite 100, Novato, CA 94949 (“Opposer”); and through its counsel, McDermott Will & Emery LLP; 227 West Monroe Street; Chicago, Illinois 60606, hereby states that it will be damaged by registration of the mark JAVA REPUBLIC ROASTING COMPANY (and DESIGN), covered by U.S. Application Serial Number 77/566,382, filed by Java Republic Limited (“Applicant”), and therefore files this Notice of Opposition to the application.

The grounds for this Opposition are as follows:

1. Java Republic Limited seeks to register JAVA REPUBLIC ROASTING COMPANY



(and DESIGN), _____, as a trademark for “coffee, ground coffee, whole coffee beans, artificial coffee; tea; cocoa; bread; cakes; pastry; non-medicated confectionery, namely, fruit jellies, frozen, pastilles, fondants; cereals, namely, processed cereals, breakfast cereals;

preparations made from cereals, namely, cereal based snack foods; Italian ices, fruit ices and ice-cream; cereal-based, rice-based or wheat-based snack foods, and snack mix consisting primarily of crackers, pretzels, candied nuts, candied fruits, and/or popped corn,” in International Class 30 and for “treatment of coffee; coffee roasting and coffee grinding,” in International Class 40 (the “JAVA REPUBLIC Trademark”).

2. Applicant filed the application for the JAVA REPUBLIC Trademark on September 15, 2008, based on Sections 1(b) and 44(e). On information and belief, Applicant has not yet commenced use of its mark in the United States.

3. Opposer does business under the trade name “THE REPUBLIC OF TEA” and has been doing so since 1992. The Republic of Tea is a leading purveyor of premium tea in the United States, and is well-known and highly regarded by American consumers. The word “REPUBLIC” is the dominant element in Opposer’s trade name, and is the theme around which Opposer has built its entire marketing model. Following this theme, Opposer designates its employees Ministers, its sales representatives as Ambassadors, its customers as Citizens and its retail outlets as Embassies.

4. Opposer uses and has registered its trade name as a trademark, holding the following trademark registrations for or including THE REPUBLIC OF TEA: THE REPUBLIC OF TEA, Reg. No. 1,848,818, THE REPUBLIC OF TEA & Design, Reg. No. 1,797,903, THE REPUBLIC OF TEA & Design, Reg. No. 1,806,157, all registered in connection with tea, in International Class 30, and related goods.

5. Consistent with its emphasis on the concept of REPUBLIC in its business, Opposer has also adopted other marks based on or including the word REPUBLIC. In particular, Opposer owns a registration for the mark REPUBLIC CHAI, Reg. No. 2,071,181 for tea, in International Class 30 and for tea flavored soft drinks, in International Class 32 and for IMPERIAL REPUBLIC,

Reg. No. 2,502,199, for tea.

6. Opposer filed its first application for registration of the mark THE REPUBLIC OF TEA in connection with tea based upon its bona fide intention to use THE REPUBLIC OF TEA as a trademark on June 17, 1991. It began to offer goods in interstate commerce under the mark THE REPUBLIC OF TEA on May 1, 1992, and the registration issued from this application on August 9, 1994. *See* Exhibit 1.

7. Opposer has been developing its family of “REPUBLIC” marks for teas since 1992. The application date, the date of first use and the registration date of each member of its family of “REPUBLIC” marks are as follows:

Application Date	Mark	Date of First Use	Registration Date
June 17, 1991	THE REPUBLIC OF TEA	May 1, 1992	August 9, 1994
June 1, 1992	THE REPUBLIC OF TEA & Design	January 22, 1992 - Class 30 April 14, 1992 - Class 25	October 12, 1993
October 14, 1992	THE REPUBLIC OF TEA & Design	April 15, 1992	November 23, 1993
October 26, 1995	REPUBLIC CHAI	July 1, 1994	June 17, 1997
December 22, 2000	IMPERIAL REPUBLIC	October 1, 1999	October 30, 2001

8. Thus, Opposer used THE REPUBLIC OF TEA as its trade name and trademark in the United States almost twenty years before Applicant filed its application for the JAVA REPUBLIC Trademark in the U.S.

9. Opposer has expended substantial sums and resources to advertise and promote its goods under the trademark and trade name THE REPUBLIC OF TEA and its other “REPUBLIC” marks.

10. By reason of Opposer’s advertisement, promotion and sale of Opposer’s goods under the trademark and trade name THE REPUBLIC OF TEA and the other “REPUBLIC” marks for so many years, THE REPUBLIC OF TEA and the other “REPUBLIC” marks have come to be widely recognized as identifying Opposer and the value of Opposer’s goods throughout the United States, and Opposer has developed substantial goodwill in the trademark and trade name THE REPUBLIC

OF TEA and the other “REPUBLIC” marks.

11. Notwithstanding Opposer’s prior use of and rights in and to the trademark and trade name THE REPUBLIC OF TEA and the other members of its family of “REPUBLIC” marks, on September 10, 2008, Applicant filed U.S. Application Serial No. 77/566,382, for registration of the



mark for use in connection with, among other goods, tea in International Class

30. That application was published in the Official Gazette (Trademarks) of the United States Patent and Trademark Office on March 9, 2010. Opposer obtained an extension of time to file this Notice of Opposition through July 7, 2010. Therefore, this Opposition is being timely filed.

12. Upon information and belief, Applicant has not started using the JAVA REPUBLIC Trademark in connection with tea in the U.S.

13. Opposer’s marks are all registered for tea.

14. Applicant proposes to use its JAVA REPUBLIC Trademark for tea, the same goods offered in connection with Opposer’s THE REPUBLIC OF TEA and family of “REPUBLIC” marks. Therefore, the Opposer’s and Applicant’s goods will share the same channels of trade in the United States.

15. Applicant’s mark combines “JAVA” (a popular term for “coffee”) and the word “REPUBLIC” in the same way that Opposer’s mark combines “TEA” (another popular beverage) and “REPUBLIC.” Both “JAVA” and “TEA” indicate a type of beverage, which makes REPUBLIC the dominant element of both Applicant’s and Opposer’s marks. That this is the case is further evidenced by the fact that the words “JAVA,” “ROASTING,” and “COMPANY” have been disclaimed in the application for Applicant’s mark and “tea” has been disclaimed in Opposer’s

registered marks. Applicant's mark is therefore likely to be confused with Opposer's marks and purchasers are likely to believe that Applicant's JAVA REPUBLIC teas are extensions of or otherwise associated with Opposer's THE REPUBLIC OF TEA family of tea products.

16. In addition, Opposer's REPUBLIC CHAI mark combines "REPUBLIC" and "CHAI" (which means tea) in the same way that Applicant combines "JAVA" and the word "REPUBLIC". Again, both "JAVA" and "CHAI" indicate a type of beverage which makes REPUBLIC the dominant element of both marks. Additionally, the two words JAVA REPUBLIC are a dominant element in Applicant's mark, because they are displayed in a type font significantly larger than the other words in Applicant's mark. Thus the mark REPUBLIC CHAI and the JAVA REPUBLIC Trademark are particularly susceptible to confusion by consumers.

17. Applicant's registration and potential use of the mark JAVA REPUBLIC ROASTING COMPANY (and DESIGN) will interfere with Opposer's "REPUBLIC" marks and will seriously damage Opposer and its goodwill and reputation.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark and prays that it be denied.

Date: July 6, 2010

Respectfully submitted,
The Republic of Tea, Inc.

By: //Michelle C. Burke//
Attorney for Opposer
Michelle C. Burke
Ulrika E. Mattsson
McDERMOTT, WILL & EMERY
227 West Monroe Street
Chicago, Illinois 60606
312.372.2000 (telephone)
312.984.7700 (facsimile)
Chicago_IP_Docket@mwe.com

DM_US 25839118-2.038055.0027

EXHIBIT 1

Int. Cls.: 16, 25, and 30

Prior U.S. Cls.: 38, 39, and 46

United States Patent and Trademark Office

Reg. No. 1,848,818

Registered Aug. 9, 1994

**TRADEMARK
PRINCIPAL REGISTER**

THE REPUBLIC OF TEA

REPUBLIC OF TEA, INC. (CALIFORNIA CORPORATION)
P.O. BOX 1175
MILL VALLEY, CA 94942

FOR: ART PRINTS, STORAGE BOXES AND BAGS, ADHESIVE DECALS AND POSTERS, IN CLASS 16 (U.S. CL. 38).

FIRST USE 5-1-1992; IN COMMERCE 5-1-1992.

FOR: CLOTHING; NAMELY, MEN'S AND WOMEN'S SHIRTS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 5-1-1992; IN COMMERCE 5-1-1992.

FOR: TEA, IN CLASS 30 (U.S. CL. 46).

FIRST USE 5-1-1992; IN COMMERCE 5-1-1992.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TEA", APART FROM THE MARK AS SHOWN.

SN 74-176,405, FILED 6-17-1991.

HENRY S. ZAK, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

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Serial Number: 74176405 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1848818

Mark (words only): THE REPUBLIC OF TEA

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2004-09-17

Filing Date: 1991-06-17

Transformed into a National Application: No

Registration Date: 1994-08-09

Register: Principal

Law Office Assigned: LAW OFFICE 5

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-09-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. REPUBLIC OF TEA, INC., THE

Address:

REPUBLIC OF TEA, INC., THE
#5 Hamilton Landing, Suite 100
Novato, CA 94949
United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

Phone Number: 800-711-8768

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

art prints, storage boxes and bags, adhesive decals and posters

Basis: 1(a)**First Use Date:** 1992-05-01**First Use in Commerce Date:** 1992-05-01**International Class:** 025**Class Status:** Active

clothing; namely, men's and women's shirts

Basis: 1(a)**First Use Date:** 1992-05-01**First Use in Commerce Date:** 1992-05-01**International Class:** 030**Class Status:** Active

tea

Basis: 1(a)**First Use Date:** 1992-05-01**First Use in Commerce Date:** 1992-05-01

ADDITIONAL INFORMATION

Disclaimer: "TEA"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-08-18 - Applicant/Correspondence Changes (Non-Responsive) Entered

2008-08-18 - TEAS Change Of Owner Address Received

2004-09-17 - First renewal 10 year

2004-09-17 - Section 8 (10-year) accepted/ Section 9 granted

2004-08-09 - Combined Section 8 (10-year)/Section 9 filed

2004-08-09 - TEAS Section 8 & 9 Received

2000-10-28 - Section 8 (6-year) accepted & Section 15 acknowledged

2000-08-04 - Section 8 (6-year) and Section 15 Filed

1994-08-09 - Registered - Principal Register
1994-04-29 - Allowed for Registration - Principal Register (SOU accepted)
1994-04-29 - Previous Allowance Count Withdrawn
1994-04-29 - Allowed for Registration - Principal Register (SOU accepted)
1994-04-25 - Assigned To Examiner
1994-04-04 - Statement Of Use Processing Complete
1994-02-24 - Use Amendment Filed
1993-09-21 - Noa Mailed - SOU Required From Applicant
1993-06-29 - Published for opposition
1993-05-28 - Notice of publication
1993-01-25 - Approved For Pub - Principal Register
1992-08-21 - Letter of suspension mailed
1992-07-23 - Communication received from applicant
1992-06-23 - Letter of suspension mailed
1992-05-11 - Communication received from applicant
1991-11-27 - Non-final action mailed
1991-09-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

JEFFREY L. MICHELMAN

Correspondent

Jeffrey L. Michelman
Stinson Morrison Hecker LLP
168 North Meramec Avenue, Suite 400
St. Louis MO 63105-3758
Phone Number: 314-863-0800
Fax Number: 314-863-9388
