

ESTTA Tracking number: **ESTTA777282**

Filing date: **10/17/2016**

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	JBR, Inc.
Granted to Date of previous extension	10/16/2016
Address	1731 Aviation Blvd. Lincoln, CA 95648 UNITED STATES

Attorney information	Rochelle D. Alpert Morgan, Lewis & Bockius LLP 1 Market, Spear Street Tower San Francisco, CA 94105 UNITED STATES ralpert@morganlewis.com, sftrademarks@morganlewis.com, kaltoff@morganlewis.com, ylolu@morganlewis.com Phone:415-442-1326
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Applicant Information

Application No	85115746	Publication date	04/19/2016
Opposition Filing Date	10/17/2016	Opposition Period Ends	10/16/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	THE EAST INDIA COMPANY HOLDINGS PTE. LTD 150 ORCHARD ROAD ORCHARD PLAZA SINGAPORE, 238841 SINGAPORE		

Goods/Services Affected by Opposition

<p>Class 021. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Household and kitchen utensils, namely, serving dishes, serving forks, serving spoons, serving tongs, spoons, spatulas, cups, mugs, saucers, plates, basins; baskets for domestic use not, not of metal; bowls; vegetable and fruit mashers, straining spoons, spaghetti spoons, ladles, whisks, utensil racks, garlic presses, graters, butter curlers, pastry brushes, corkscrews, sieves, zesters, non-electric juicers, ice cream scoops, and cutting boards; containers for household use; bakeware, namely, baking trays, oven trays, roasting pans; cookware, namely, saucepans, frying pans, milk pans, saute pans, skilletts, stockpots; casseroles; thalis, namely, metal serving trays; meal trays; tea sets; tea strainers; tea infusers; bone china, glassware, porcelain and earthenware, namely, candle rings and candle sticks not of precious metal; ceramic bowls, plates, mugs, cups, saucers, vases, pots and tissue box covers for household purposes; chamber pots; china ornaments; figurines of porcelain, terracotta or glass; flower pots and flower pot covers; glass receptacles, bowls and jars; jugs and pitchers; knobs of porcelain; menu card holders; napkin holders and rings not of precious metal; pepper mills and pots; salt cellars and shakers; earthenware saucepans; stew-pans; tea caddies; tea services and tea pots; vases; dishes;</p>
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works of art of porcelain, terracotta or glass; picnic baskets sold empty; pottery bowls, cups, mugs, saucers, vases and pots; glass cooking pots, cups and mugs not of precious metal; drinking vessels; decanters; dishes, butter dishes and dish covers; soap dishes; door handles of porcelain; decorative plates and bowls

Class 030. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Coffee, coffee substitutes; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; tea, tea bags, scented teas and flavoured teas; herbal teas; cocoa, hot chocolate; sugar, rice, tapioca, sago; flour, processed cereals made from wheat, oats, barley, rusk, durum and rice; breads; spiced bread, pastry; sweets (candy); vinegars, vinaigrettes, sauces, namely, hot sauces, ketchups; pepper; spices; mustard; honey mustard; honey; treacle; biscuits; cakes; pastry; puddings; chocolates; flavoured chocolates; petit fours; pancakes; fruits sauces excluding cranberry sauce and apple sauce; salad sauces and dressings; poppadoms; chutney; relish; salts, herb salts; curry powder; gift food hampers containing coffee, coffee substitutes, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, tea, tea bags, scented teas and flavoured teas, herbal teas; cocoa, hot chocolate, sugar, rice, tapioca, sago, flour, and preparations made from flour or cereals, breads, spiced bread, pastry and confectionery, vinegars, vinaigrettes, sauces, pepper, condiments, spices, mustard, honey mustard, honey, treacle, biscuits, cakes, pastry, puddings, chocolates, flavoured chocolates, petit fours, pancakes, fruit sauces, salad sauces and dressings, poppadoms, chutney, relish, salts, herb salts, curry powder, sold as a unit

Class 032. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Beers, ales and porters; sweet cider; syrups and concentrates for making beverages; non-alcoholic fruit cordials; mineral and aerated waters; soft drinks; fruit and vegetable drinks and fruit and vegetable juices; gift drinks hampers containing beers, ales and porters, sweet cider, syrups and concentrates for making beverages, non-alcoholic fruit cordials, mineral and aerated waters, soft drinks, fruit and vegetable drinks and fruit and vegetable juices

Class 043. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Services for providing food and drink; restaurant services; bar services; catering services; tea room services; providing temporary accommodation

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	Section 10 of the Lanham Act, 15 USC §1060.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EAST INDIA; EAST INDIA TEA; EAST INDIA TEA & COFFEE LTD		
Goods/Services	As specified in the attached Notice of Opposition.		

Attachments	Notice of Opposition and Exhibit A.pdf(226087 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	/KHA/
Name	Kristin H. Altoff
Date	10/17/2016

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

In the matter of Application Serial No. **85/115,746**
Filed August 25, 2010
For the mark **THE EAST INDIA COMPANY**
Published in the OFFICIAL GAZETTE on April 19, 2016

JBR, INC.,

Opposer,

v.

THE EAST INDIA COMPANY HOLDINGS
PTE. LTD.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

JBR, Inc. (“Opposer” or “JBR”), a California corporation, having its principal place of business at 1731 Aviation Boulevard, Lincoln, California 95648, believes that it will be damaged by registration of the designation THE EAST INDIA COMPANY shown in Application Serial No. 85/115,746 currently owned by The East India Company Holdings Pte. Ltd., a Singapore entity (“Applicant”) and hereby opposes same in Classes 21, 30, 32 and 43.

As grounds for the opposition, JBR alleges as follows:

JBR’s Trademark Rights

1. JBR is the brand-owning company for San Francisco Bay Gourmet Coffee, a Rogers Family Company (“San Francisco Bay”), which is a privately held, 100% family-owned and operated company offering coffee, tea and related goods and services. JBR through San

San Francisco Bay, and their predecessors, have offered coffee and tea related goods and services in the United States for over 35 years.

2. JBR through San Francisco Bay has used the mark EAST INDIA and marks containing EAST INDIA, including EAST INDIA TEA and EAST INDIA TEA & COFFEE LTD., for tea products and related products and services continuously since at least as early as April 1979 (“Opposer’s EAST INDIA Marks”).

3. Examples of tea products JBR through San Francisco Bay has offered using Opposer’s EAST INDIA Marks include the following:



4. In addition to tea products, JBR through San Francisco Bay offers and sells gift baskets, including teas, cups and tea infusers, using Opposer’s EAST INDIA Marks and Opposer offers and sells bag clips and tea infusers in connection with Opposer’s EAST INDIA Marks. Set forth below are examples of bag clips and gift baskets offered and sold using Opposer’s EAST INDIA Marks.



5. By virtue of its continuous use of Opposer's EAST INDIA Marks since at least as early as April 1979, Opposer has acquired significant common law rights in and to Opposer's EAST INDIA Marks.

6. JBR through San Francisco Bay markets and promotes its products offered and sold using its EAST INDIA Marks on and through websites, a blog and social media.

7. JBR through San Francisco Bay offers for sale and sells products bearing the EAST INDIA Marks directly to consumers. By way of example, at the website, www.gourmet-coffee.com, consumers can buy products bearing and sold in connection with Opposer's EAST INDIA Marks. JBR also has sold and sells to distributors and third-party retailers, who sell the products on their websites and/or at their retail facilities bearing the EAST INDIA Marks.

8. Through its substantial investment of time and effort, and continued use since at least as early as April 1979, JBR has built extensive good will and recognition for Opposer's EAST INDIA Marks. Opposer's EAST INDIA Marks have become associated substantially exclusively with JBR in the relevant marketplaces.

Applicant's Application

9. By way of the opposed intent-to-use application (App. Ser. No. 85/115,746), Applicant seeks to register the designation THE EAST INDIA COMPANY for goods and services in numerous classes, including the following, among other classes:

Class 21: Household and kitchen utensils, namely, serving dishes, serving forks, serving spoons, serving tongs, spoons, spatulas, cups, mugs, saucers, plates, basins; baskets for domestic use not, not of metal; bowls; vegetable and fruit mashers, straining spoons, spaghetti spoons, ladles, whisks, utensil racks, garlic presses, graters, butter curlers, pastry brushes, corkscrews, sieves, zesters, non-electric juicers, ice cream scoops, and cutting boards; containers for household use; bakeware, namely, baking trays, oven trays, roasting pans; cookware, namely, saucepans, frying pans, milk pans, saute pans, skillets, stockpots; casseroles; thalis, namely, metal serving trays; meal trays; tea sets; tea strainers; tea infusers; bone china, glassware, porcelain and earthenware, namely, candle rings and candle sticks not of precious metal; ceramic bowls, plates, mugs, cups, saucers, vases, pots and tissue box covers for household purposes; chamber pots; china ornaments; figurines of porcelain, terracotta or glass; flower pots and flower pot covers; glass receptacles, bowls and jars; jugs and pitchers; knobs of porcelain; menu card holders; napkin holders and rings not of precious metal; pepper mills and pots; salt cellars and shakers; earthenware saucepans; stew-pans; tea caddies; tea services and tea pots; vases; dishes; works of art of porcelain, terracotta or glass; picnic baskets sold empty; pottery bowls, cups, mugs, saucers, vases and pots; glass cooking pots, cups and mugs not of precious metal; drinking vessels; decanters; dishes, butter dishes and dish covers; soap dishes; door handles of porcelain; decorative plates and bowls;

Class 30: Coffee, coffee substitutes; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; tea, tea bags, scented teas and flavoured teas; herbal teas; cocoa, hot chocolate; sugar, rice, tapioca, sago; flour, processed cereals made from wheat, oats, barley, rusk, durum and rice; breads; spiced bread, pastry; sweets (candy); vinegars, vinaigrettes, sauces, namely, hot sauces, ketchups; pepper; spices; mustard; honey mustard; honey; treacle; biscuits; cakes; pastry; puddings; chocolates; flavoured chocolates; petit fours; pancakes; fruits sauces excluding cranberry sauce and apple sauce; salad sauces and dressings; poppadoms; chutney; relish; salts, herb salts; curry powder; gift food hampers containing coffee, coffee substitutes, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, tea, tea bags, scented teas and flavoured teas, herbal teas; cocoa, hot chocolate, sugar, rice, tapioca, sago, flour, and preparations made from flour or cereals, breads, spiced bread, pastry and confectionery, vinegars, vinaigrettes, sauces, pepper, condiments, spices, mustard, honey mustard, honey, treacle, biscuits, cakes, pastry, puddings, chocolates, flavoured chocolates, petit fours, pancakes, fruits sauces, salad sauces and dressings, poppadoms, chutney, relish, salts, herb salts, curry powder, sold as a unit;

Class 32: Beers, ales and porters; sweet cider; syrups and concentrates for making beverages; non-alcoholic fruit cordials; mineral and aerated waters; soft drinks; fruit and vegetable drinks and fruit and vegetable juices; gift drinks hampers containing beers, ales and porters, sweet cider, syrups and concentrates for making beverages, non-alcoholic fruit cordials, mineral and aerated waters, soft drinks, fruit and vegetable drinks and fruit and vegetable juices;

Class 43: Services for providing food and drink; restaurant services; bar services; catering services; tea room services; providing temporary accommodation

10. On information and belief, on or about March, 26, 2015, the opposed application was assigned from the entity that originally filed the application, the Honorable East India Company Ltd., a United Kingdom company, to current Applicant, a Singapore company. On information and belief, that assignment, however, did not include that portion of the business applicable to the opposed, intent-to-use application as of the effective date of the assignment — March 26, 2015. On information and belief, nearly a year after the effective date of the assignment, the current Applicant, the Singapore corporation, deleted the 1(b) basis for the filing of the opposed application, but at the time of the assignment, the application included a 1(b) basis for the filing of the application. A true and correct copy of the assignment recorded with the United States Patent and Trademark Office pertaining to the application is attached hereto as Exhibit A.

11. The opposed intent-to-use application was filed on August 25, 2010, nearly three decades after JBR commenced use of its EAST INDIA Marks. Thus, JBR's trademark rights for and in Opposer's EAST INDIA Marks predate Applicant's rights.

12. Applicant's application for the designation THE EAST INDIA COMPANY application was published for opposition in the *Official Gazette* on April 19, 2016.

13. The Trademark Trial and Appeal Board extended the opposition period for Applicant's THE EAST INDIA COMPANY application by granting Opposer's timely requests for an extension. The opposition period for Application, Serial No. 85/115,746 expired on October 16, 2016, which fell on a Sunday. Thus, JBR timely files this opposition on October 17, 2016, the following Monday.

FIRST CAUSE OF ACTION
Likelihood of Confusion

14. JBR re-alleges the allegations contained in paragraphs 1 through 13 of this Notice of Opposition as if fully set out herein.

15. The designation for which Applicant seeks registration — THE EAST INDIA COMPANY — is substantially similar in sight, sound and/or meaning, as well as commercial impression, to Opposer's EAST INDIA Marks.

16. The goods in Classes 21, 30 and 32, and the services in Class 43 for which Applicant seeks to register the opposed designation are competitive and/or overlapping with, related to, and/or complementary to those for which JBR through San Francisco Bay uses its EAST INDIA Marks.

17. On information and belief, JBR alleges that Applicant intends to direct its services under the confusingly similar designation, THE EAST INDIA COMPANY, to the same and/or overlapping consumers that use and purchase JBR's products and to whom JBR promotes its products bearing the EAST INDIA Marks.

18. Further, on information and belief, JBR alleges that Applicant and JBR use or will use the same or overlapping channels of trade to target the same or overlapping prospective customers.

19. Under these circumstances, Applicant's use of THE EAST INDIA COMPANY designation in connection with the covered goods in Classes 21, 30 and 32, and the services in Class 43, are likely to be confused with Opposer's EAST INDIA Marks used for competitive, related and/or complementary products.

20. Accordingly, JBR will be damaged if Applicant's THE EAST INDIA COMPANY designation as applied-for proceeds to registration for the goods in Class 21, 30 and 32, and the services in Class 43.

21. JBR believes it will be damaged by registration of Applicant's applied-for designation on the ground that, when used on or in connection with the goods and services identified in the application, the applied-for designation so resembles Opposer's EAST INDIA Marks as to be likely to cause confusion, mistake or deception, with consequent injury to JBR and to the relevant public, in violation of Section 2(d) of the Trademark Act.

22. Unless Applicant's application in Classes 21, 30, 32 and 43 is denied, Applicant will unjustifiably reap the benefits of the goodwill that JBR has created in the relevant marketplaces, and JBR will suffer irreparable damage and injury as a result of the confusion and mistake and false association that is likely to arise from the registration of the applied-for THE EAST INDIA COMPANY designation.

SECOND CAUSE OF ACTION
Invalid Assignment of Intent to Use Application

23. Opposer re-alleges the allegations contained in paragraphs 1 through 23 and paragraphs 15 through 22 of this Notice of Opposition as if fully set out herein.

24. On or about March, 26, 2015, the opposed application was assigned from the entity that originally filed the application, the Honorable East India Company Ltd., a UK Company, to Applicant, a Singapore Company, without also assigning that portion of the business to which the applied-for intent-to-use mark applies.

25. At the time of the assignment and at the time of the recording of the assignment of the opposed application on May 13, 2015 with the United States Patent and Trademark Office, the opposed application continued to include a claim of intent-to-use based on Section 1(b).

26. Under Section 10 of the Lanham Act, 15 USC §1060, given that the assignment did not properly include an assignment of that portion of the business to which the opposed application applied, the opposed application should be held invalid and be rejected on this basis alone.

WHEREFORE, JBR requests that Application Serial No. 85/115,746 be rejected in Classes 21, 30, 32 and 43 on the grounds of likelihood of confusion, or alternatively be deemed invalid based on an invalid assignment of the Application and that this opposition be sustained in favor of JBR, and that such other appropriate and proper relief be entered.

Dated: October 17, 2016

Respectfully submitted,

By: /s/ Kristin H. Altoff

Rochelle D. Alpert
Angela M. Gandhi
Morgan, Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105
Telephone: (415) 442-1326
Facsimile: (415) 442-1001
Email: rochelle.alpert@morganlewis.com

Kristin H. Altoff
Morgan, Lewis & Bockius LLP
1111 Pennsylvania Ave., NW
Washington, DC 20004
Telephone: (202) 739-5093
Facsimile: (202) 739-3001
Email: kristin.altoff@morganlewis.com

Attorneys for Opposer JBR, Inc.

EXHIBIT A

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM341137

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
The Honorable East India Company Ltd		03/26/2015	limited company: UNITED KINGDOM
RECEIVING PARTY DATA			
Name:	The East India Company Holdings Pte. Ltd		
Street Address:	150 Orchard Road Orchard Plaza		
City:	Singapore		
State/Country:	SINGAPORE		
Postal Code:	238841		
Entity Type:	limited company: SINGAPORE		
PROPERTY NUMBERS Total: 4			
Property Type	Number	Word Mark	
Serial Number:	85115527	4 EIC	
Registration Number:	4257838	4 EIC	
Serial Number:	85804010	THE EAST INDIA COMPANY	
Serial Number:	85115746	THE EAST INDIA COMPANY	
CORRESPONDENCE DATA			
Fax Number:	3124643111		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	312-464-3100		
Email:	chicagopto@loeb.com		
Correspondent Name:	Douglas N. Masters		
Address Line 1:	321 N. Clark St., Suite 2300		
Address Line 4:	Chicago, ILLINOIS 60654		
ATTORNEY DOCKET NUMBER:	218001-10001		
NAME OF SUBMITTER:	Douglas N. Masters		
SIGNATURE:	/Douglas N. Masters/		
DATE SIGNED:	05/13/2015		
Total Attachments: 2			
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CH \$115.00 85115527

TRADEMARK ASSIGNMENT

This Trademark Assignment (the "Assignment") is effective as of 26/03/2015 and between The Honorable East India Company Ltd ("Assignor"), a limited company (Ltd.) UNITED KINGDOM, having a place of business at 7-8 Conduit Street London, United Kingdom, W1S2XF and The East India Company Holdings Pte. Ltd ("Assignee"), a limited company (Ltd.) SINGAPORE, having a place of business at 150 Orchard Road Orchard Plaza, 238841, Singapore.

WHEREAS, Assignor owns all the right, title and interest in and to the trademark shown in the attached schedule ("Exhibit A"), and any common law rights related to the trademark ("Trademark"), together with the goodwill symbolized by and associated with the Trademark, including but not limited to the trademark registration listed in Exhibit A;

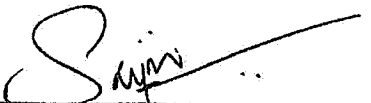
WHEREAS, Assignee desires to acquire all of Assignor's right, title and interest in and to the Trademark, and any common law rights related to the Trademark for the sum of £1 (pound sterling), together with the goodwill symbolized by and associated with the Trademark, including but not limited to the trademark registration listed in Exhibit A;

WHEREAS, Assignor desires to assign to Assignee all of its right, title and interest in and to the Trademark, and any common laws rights related to the Trademark, together with the goodwill symbolized by and associated with the Trademark, including but not limited to the trademark registration listed in Exhibit A.

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged, Assignor hereby assigns and transfers to Assignee all of Assignor's right, title and interest in and to the Trademark, and any common laws rights related to the Trademark, together with the goodwill symbolized by and associated with the Trademark, including but not limited to the trademark registration listed in Exhibit A.

ASSIGNOR:

The Honorable East India Company Ltd.

By: 

Print name: SANJIV MEHTA

Print Title: DIRECTOR

EXHIBIT A
TRADEMARKS

	Mark	Status	Country	App. No.	Reg. No.
1.	4 EIC LOGO	Pending	US	85115527	
2.	4 EIC LOGO	Registered	US	85977896	4257838
3.	THE EAST INDIA COMPANY	Pending	US	85804010	
4.	THE EAST INDIA COMPANY	Pending	US	85115746	




CH123642.1
218001-10001

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Notice of Opposition (Exhibit A)** has been sent via first class mail, postage pre-paid on this October 17, 2016 to:

**MELAINA JOBS, Esq.
LOEB & LOEB LLP
321 N. CLARK ST., SUITE 2300
CHICAGO, IL 60654**



Yelena Lolua