

ESTTA Tracking number: **ESTTA870183**

Filing date: **01/10/2018**

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 Colombia and Federacion Nacional de Cafeteros de Colombia
Granted to Date of previous extension	01/10/2018
Address	Calle 73, No. 8-13Torre B, Piso 11 Bogota, 0 COLOMBIA

Attorney information	PETER D RAYMOND REED SMITH LLP 599 LEXINGTON AVENUE NEW YORK, NY 10022 UNITED STATES Email: praymond@reedsmith.com, clackert@reedsmith.com, mpikser@reedsmith.com, jgoodwill@reedsmith.com, nycipdocketing@reedsmith.com, jbeifuss@reedsmith.com Phone: 212-521-5400
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Applicant Information

Application No	87344846	Publication date	09/12/2017
Opposition Filing Date	01/10/2018	Opposition Period Ends	01/10/2018
Applicant	Adriana MarÃ-a CastaÃ±o S. Calle 7B No. 27-095 Apto. 703 MedellÃ-n, Antioquia COLOMBIA		

Goods/Services Affected by Opposition

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Coffee; Roasted coffee beans

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Deceptiveness	Trademark Act Section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1160492	Application Date	01/10/1979
Registration Date	07/07/1981	Foreign Priority	NONE

		Date	
Word Mark	COLOMBIAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class A. First use: First Use: 1927/09/00 First Use In Commerce: 1927/09/00 Coffee.		

Attachments	Notice of Opposition 87344846.pdf(15856 bytes)
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Signature	/PETER D RAYMOND/
Name	PETER D RAYMOND
Date	01/10/2018

September 12, 2017, and having previously been granted an extension of time to oppose hereby opposes the same.

The grounds for opposition are as follows:

1. Republic is a sovereign state, whose capital is located in Bogota, Colombia, which enjoys diplomatic and trade ties with the United States.

2. One of the most valuable and well-known products exported from Republic to the United States is coffee.

3. Republic is the owner of U.S. Registration No. 1,160,492 which was issued by the United States Patent and Trademark Office on July 7, 1981, for the mark COLOMBIAN for coffee in Class A (the “COLOMBIAN Certification Mark”). Said registration is valid and subsisting, has not been revoked or cancelled, and is in full force and effect. The registration has become incontestable pursuant to 15 U.S.C. § 1065.

4. The Federacion is a non-profit association founded in 1927 and is the administrator of the Fondo Nacional del Café, which is also known as the National Coffee Fund.

5. The Federacion was created to protect the legal and economic interests of Colombia’s coffee growers. As such, the Federacion is the agent for and is subject to the ultimate control of Republic. In this regard, the Federacion is responsible for, *inter alia*, the following:

- A. Promoting the international sale of coffee grown in Colombia;
- B. Controlling the quality and grading of coffee grown in Colombia and exported to foreign countries;
- C. Conducting research concerning coffee grown in Colombia; and

D. Providing strategies for and coordinating the sale of coffee grown in Colombia.

6. The Federacion on behalf of Republic is authorized to enforce and protect Republic's rights to the COLOMBIAN Certification Mark. As such, the Federacion inspects and grades for quality all coffee intended for export from Colombia and is authorized to bar from export any inferior grades of coffee. The quality of the COLOMBIAN coffee to be exported must meet certain standards and is assigned certain classifications for export which are based upon factors including coffee bean size, shape, composition, and origin.

7. The COLOMBIAN Certification Mark symbolizes and personifies the goodwill of several hundred thousand hardworking and dedicated Colombian coffee farmers that depend on coffee for their livelihood. The mark has been in continuous use in commerce in the United States for more than 90 years. The mark certifies that coffee branded with the mark was grown in the Republic of Colombia and that such coffee has been subjected to standard inspection authorized by the Federacion 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 Republic.

8. As a result of such longstanding, widespread, extensive and continuous use, the COLOMBIAN Certification Mark symbolizes the goodwill of Republic and the Federacion and all of its members. Moreover, the COLOMBIAN Certification Mark is well-known, world famous, and of great value in connection with coffee and coffee-related goods.

9. By the application herein opposed, Applicant, a Colombian citizen, seeks to register the proposed mark SUPERBIA COFFEE COLOMBIA'S FINEST for coffee and roasted coffee beans in Class 30, based upon an intent to use the mark in United States commerce.

10. Applicant's Mark is confusingly similar to the COLOMBIAN Certification Mark registered by Republic, which mark has been used in the United States since 1927, long prior to the alleged date of first use of Applicant's Mark. The distinctive feature of Applicant's Mark SUPERBIA COFFEE COLOMBIA'S FINEST is the word COLOMBIA'S, not SUPERBIA, COFFEE nor FINEST.

11. Opposers will be damaged by the registration of Applicant's Mark as such registration would be likely to cause confusion, mistake or deception among the consuming public as to the source, origin, or affiliation of such goods in violation of Section 2(d) of the Lanham Act, and because such use suggests a false connection with Opposers, an approval by Opposers, and/or a false connection with Opposers' famous exports, coffee and coffee products. Lanham Act Section 2(d) applies to all forms of marks including trademarks and certification marks.

12. As certification marks may only be used by those authorized by the owner of the certification mark, Opposer's registration, use and/or intended use of an imitation of the COLOMBIAN Certification Mark violates the very purpose of and fundamental reason for Republic's acquisition of the COLOMBIAN Certification Mark.

13. Opposers will be damaged by the registration of Applicant's Mark because such registration would support and assist Applicant in deceiving and misleading

consumers through use of a mark similar to an existing mark in violation of Section 2(a) of the Lanham Act.

14. Opposers will be damaged by the registration of Applicant's Mark because such registration is likely to dilute the well-known and famous COLOMBIAN Certification Mark in violation of Section 43(c) of the Lanham Act.

WHEREFORE, Opposers respectfully request that Application Serial No. 87/344846 for SUPERBIA COFFEE COLOMBIA'S FINEST be refused, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposers.

Dated: New York, New York
January 10, 2018

REED SMITH LLP
Attorneys for Opposers
The Republic of Colombia and Federacion
Nacional de Cafeteros de Colombia, a/k/a
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