

ESTTA Tracking number: **ESTTA1047462**

Filing date: **04/07/2020**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Pacific Foods of Oregon, LLC		
Granted to Date of previous extension	04/08/2020		
Address	19480 SW 97TH AVENUE TUALATIN, OR 97062 UNITED STATES		

Name	CSC Brands LP		
Entity	Limited Partnership	Citizenship	Delaware
Address	One Campbell Place Camden, NJ 08103 UNITED STATES		

Attorney information	ARIC S. JACOVER JACOVER LAW LLC 990 GROVE ST., SUITE 402 EVANSTON, IL 60201 UNITED STATES aric@jacoverlaw.com 312-569-0434		
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Applicant Information

Application No	79265606	Publication date	12/10/2019
Opposition Filing Date	04/07/2020	Opposition Period Ends	04/08/2020
International Registration No.	1483403	International Registration Date	06/18/2019
Applicant	Oatly AB Stora Varvsgatan 6 A SE-211 19 MalmÅ¶ SWEDEN		

Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Dairy substitutes, namely, artificial cream, hazelnut milk, soy milk, oat-based cream, almond milk, almond milk-based beverages, coconut milk, coconut milk-based beverages, hemp milk used as milk substitute, peanut milk, peanut milk-based beverages, rice milk, rice milk for use as milk substitute, functional milk substitute beverages, fruit-flavored milk substitutes based on oats, oat-based yoghurt substitute, oat-based yoghurt and drinking

yoghurt free of milk and lactose, fruit-flavored yoghurt substitutes containing oats, cream substitutes, cream substitutes containing oat; milk substitutes; oat-based drinks for use as milk substitute; milk substitutes containing oats

Applicant Information

Application No	79265596	Publication date	12/10/2019
Opposition Filing Date	04/07/2020	Opposition Period Ends	
International Registration No.	1483390	International Registration Date	06/18/2019
Applicant	Oatly AB Stora Varvsgatan 6 A SE-211 19 MalmÅ¶ SWEDEN		


Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Dairy substitutes, namely, artificial cream, hazelnut milk, soy milk, oat-based cream, almond milk, almond milk-based beverages, coconut milk, coconut milk-based beverages, hemp milk used as milk substitute, peanut milk, peanut milk-based beverages, rice milk, rice milk for use as milk substitute, functional milk substitute beverages, fruit-flavored milk substitutes based on oats, oat-based yoghurt substitute, oat-based yoghurt and drinking yoghurt free of milk and lactose, fruit-flavored yoghurt substitutes containing oats, cream substitutes, cream substitutes containing oat, non-dairy creamer; milk substitutes; oat-based drinks for use as milk substitute; milk substitutes containing oats

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.	5068977	Application Date	07/30/2013
Registration Date	10/25/2016	Foreign Priority Date	NONE
Word Mark	BARISTA INSPIRED BARISTA APPROVED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2014/03/07 First Use In Commerce: 2014/03/25 Soy milk; non-dairy creamer; non-dairy beverages, namely, soy-based food beverages used as a milk substitute Class 032. First use: First Use: 2014/08/16 First Use In Commerce: 2014/09/08		

	Concentrates for making tea; chai tea concentrates
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BARISTA		
Goods/Services	Soy milk; non-dairy creamer; non-dairy beverages, namely, soy-based food beverages used as a milk substitute; Concentrates for making tea; chai tea concentrates		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BARISTA SERIES		
Goods/Services	Soy milk; non-dairy creamer; non-dairy beverages, namely, soy-based food beverages used as a milk substitute; Concentrates for making tea; chai tea concentrates		

Attachments	86023115#TMSN.png(bytes) Consolidated Notice of Opposition Oatly Barista and Barista Edition.pdf(90762 bytes) Exhibit A.pdf(57876 bytes)
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Signature	/Aric S. Jacover/
Name	ARIC S. JACOVER
Date	04/07/2020

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

CSC Brands LP and)	
Pacific Foods of Oregon, LLC)	
)	Opposition No. _____
Opposers,)	
)	Serial Nos.: 79/265,596
)	(BARISTA EDITION)
v.)	79/265,606
)	(BARISTA)
Oatly AB,)	
)	
Applicant.)	
_____)	

CONSOLIDATED NOTICE OF OPPOSITION

Opposers, CSC Brands LP, a Delaware limited partnership having its principal place of business at One Campbell Place Camden, New Jersey 08103 (“CSC”), and Pacific Foods of Oregon, LLC, a limited liability company having its principal place of business at 19480 SW 97th Avenue, Tualatin, Oregon 97062 (“Pacific Foods”) will be damaged by the registration of the trademarks shown in Application Serial Nos. 79/265,596 and 79/265,606, owned by Applicant, Oatly AB, a Swedish limited liability company with an address at Stora Varvsgatan 6 A, SE-211 19 Malmö, Sweden. Opposer hereby opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1063(a). As grounds for opposition, Opposers allege as follows:

1. Pacific Foods, a wholly-owned subsidiary of CSC, is a well-known producer and seller of high-quality organic food products that are enjoyed by consumers throughout the United States. Among its products is a line of non-dairy beverages, creamers and milk substitutes that are

sold directly to consumers and to foodservice distributors. These products include various plant-based beverages made from almonds, cashews, coconuts, hazelnuts, oats, soy and hemp.

2. Since at least as early as April 21, 2008, Pacific Foods has continuously used in commerce the word marks BARISTA and BARISTA SERIES in connection with its line of non-dairy beverages, creamers and milk substitutes.

3. Since at least as early as March 7, 2014, Pacific Foods has continuously used in commerce the word mark BARISTA INSPIRED BARISTA APPROVED in connection with its line of non-dairy beverages, creamers and milk substitutes.

4. Pacific Foods has used the above-referenced “Barista” marks prominently on its product packaging and in advertising for the Barista product line, including on its website, located at <https://www.pacificfoodservice.com/barista-series-plant-based-beverages/> (last visited April 7, 2020) and its Instagram page, located at <https://www.instagram.com/baristaseries/> (last visited April 7, 2020).

5. As a result of its long-standing and continuous use in commerce, Pacific Foods obtained enforceable common law rights in the marks BARISTA, BARISTA SERIES and BARISTA INSPIRED BARISTA APPROVED in connection with non-dairy beverages, creamers, milk substitutes and related goods.

6. Pacific Foods filed and obtained a registration in the United States Patent and Trademark Office for the mark BARISTA INSPIRED BARISTA APPROVED for use with “Soy milk; non-dairy creamer; non-dairy beverages, namely, soy-based food beverages used as a milk substitute” in Class 29 and “Concentrates for making tea; chai tea concentrates” in Class 32, Federal Registration No. 5,068,977 (the “977 Registration”). Attached as Exhibit A is a printout from the TSDR database for the ‘977 Registration.

7. The '977 Registration is valid and subsisting and therefore constitutes *prima facie* evidence of the validity of the mark and registration, and of the owner's exclusive right to use the mark in connection with the goods set forth in the registration.

8. The registration for BARISTA INSPIRED BARISTA APPROVED, together with the common law rights described above with respect to the marks BARISTA and BARISTA EDITION, are hereafter referred to collectively as the "Barista Marks".

9. On or about January 27, 2020, Pacific Foods assigned to CSC all rights, title, interest and goodwill in and to the Barista Marks, including the '977 Registration, which short-form assignment was recorded in the USPTO on or about February 20, 2020. As the successor and assignee of the Barista Marks, CSC is in privity to Pacific Foods and is a proper party to this opposition pursuant to TBMP §§ 206.02, 303.05(b).

10. CSC's Barista Marks are distinctive to both the consuming public and CSC's and Pacific Foods' trade.

11. Pacific Foods has sold millions of dollars' worth of goods in connection with the Barista Marks and has spent significant sums advertising and promoting its Barista Marks throughout the United States, which use has inured to the benefit of CSC.

12. By virtue of the popularity of the goods sold and advertised under the Barista Marks, CSC now owns an extremely valuable goodwill which is symbolized by its Barista Marks.

13. On or about June 18, 2019, Applicant filed pursuant to Section 66(a) of the Lanham Act, Application Serial No. 79/265,596 to register the standard character mark BARISTA EDITION and Application Serial No. 79/265,606 to register the standard character mark BARISTA (collectively, "Applicant's Marks").

14. Applicant seeks to register Applicant's Marks in Class 29 for "Dairy substitutes, namely, artificial cream, hazelnut milk, soy milk, oat-based cream, almond milk, almond milk-based beverages, coconut milk, coconut milk-based beverages, hemp milk used as milk substitute, peanut milk, peanut milk-based beverages, rice milk, rice milk for use as milk substitute, functional milk substitute beverages, fruit-flavored milk substitutes based on oats, oat-based yoghurt substitute, oat-based yoghurt and drinking yoghurt free of milk and lactose, fruit-flavored yoghurt substitutes containing oats, cream substitutes, cream substitutes containing oat; milk substitutes; oat-based drinks for use as milk substitute; milk substitutes containing oats" ("Applicant's Goods").

15. Applicant's applications were published for opposition on December 10, 2019. Pacific Foods filed a 90-day extension of time to oppose Applicant's applications, which extended the opposition deadline to April 8, 2020. During the extension period, on January 10, 2020, jurisdiction over Applicant's applications was restored to the Trademark Examining Attorney pursuant to a Letter of Protest (filed by another party). On January 15, 2020, the Examining Attorney issued non-final office actions with respect to Applicant's applications, refusing registration of Applicant's Marks on descriptiveness grounds. As of the date of this Notice of Opposition, no response to the office actions have been filed. Pursuant to a subsequent order from the TTAB, the opposition deadline remains April 8, 2020 and Opposers are timely filing this Consolidated Notice of Opposition.

16. CSC has priority of use by virtue of the continuous use of the Barista Marks by its wholly-owned subsidiary Pacific Foods and/or the filing date of the '977 Registration, both of which are prior to the filing date of Applicant's Marks and, upon information and belief, prior to any other date upon which Applicant may rely.

17. Opposers will be damaged by the registration of Applicant's Marks in connection with Applicant's Goods because Applicant's Marks so closely resemble the Barista Marks as to be likely to cause confusion, mistake, or deception in the minds of consumers as to the origin or source of Applicant's Goods or the affiliation between Applicant and Opposers, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposers respectfully request that this Notice of Opposition be sustained, and that the registration of Application Serial Nos. 79/265,596 and 79/265,606 be denied.

WHEREFORE, pursuant to TBMP § 215, Opposers further request that due to jurisdiction being restored to the examining attorney, the present opposition be suspended until the registrability of Application Serial Nos. 79/265,596 and 79/265,606 has been finally determined by the examining attorney (Opposers will file a separate motion, if necessary).

Dated: April 7, 2020

Respectfully submitted,

/Aric S. Jacover/
Aric S. Jacover
JACOVER LAW LLC
990 Grove St., Suite 402
Evanston, IL 60201
(312) 569-0434
Counsel for Opposers

Exhibit A

Generated on: This page was generated by TSDR on 2020-03-31 17:24:49 EDT

Mark: BARISTA INSPIRED BARISTA APPROVED

BARISTA INSPIRED BARISTA
APPROVED

US Serial Number: 86023115

Application Filing Date: Jul. 30, 2013

US Registration Number: 5068977

Registration Date: Oct. 25, 2016

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Oct. 25, 2016

Publication Date: Jul. 01, 2014

Notice of Allowance Date: Aug. 26, 2014

Mark Information

Mark Literal Elements: BARISTA INSPIRED BARISTA APPROVED

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Concentrates for making tea; chai tea concentrates

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 16, 2014

Use in Commerce: Sep. 08, 2014

For: Soy milk; non-dairy creamer; non-dairy beverages, namely, soy-based food beverages used as a milk substitute

International Class(es): 029 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 07, 2014

Use in Commerce: Mar. 25, 2014

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: CSC BRANDS LP

Owner Address: ONE CAMPBELL PLACE
CAMDEN, NEW JERSEY UNITED STATES 08103

Legal Entity Type: LIMITED PARTNERSHIP

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer C. Debrow

Docket Number: 425551us006

Attorney Primary Email Address: ipmail@gpmlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Jennifer C. Debrow
Gray Plant Mooty Mooty & Bennett PA
80 South Eighth Street
500 IDS Center
Minneapolis, MINNESOTA UNITED STATES 55402

Phone: 612-632-3357

Fax: 612-632-4444

Correspondent e-mail: ipmail@gpmlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 26, 2020	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Oct. 12, 2018	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Oct. 12, 2018	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 06, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Oct. 25, 2016	REGISTERED-PRINCIPAL REGISTER	
Sep. 20, 2016	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Sep. 19, 2016	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Sep. 17, 2016	STATEMENT OF USE PROCESSING COMPLETE	75298
Aug. 15, 2016	USE AMENDMENT FILED	75298
Aug. 15, 2016	TEAS STATEMENT OF USE RECEIVED	
Apr. 01, 2016	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Mar. 31, 2016	EXTENSION 3 GRANTED	75298
Feb. 26, 2016	EXTENSION 3 FILED	75298
Mar. 28, 2016	CASE ASSIGNED TO INTENT TO USE PARALEGAL	75298
Feb. 26, 2016	TEAS EXTENSION RECEIVED	
Sep. 03, 2015	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Sep. 02, 2015	EXTENSION 2 GRANTED	71906
Aug. 25, 2015	EXTENSION 2 FILED	71906
Sep. 02, 2015	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71906
Aug. 25, 2015	TEAS EXTENSION RECEIVED	
Feb. 28, 2015	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Feb. 26, 2015	EXTENSION 1 GRANTED	98765
Feb. 26, 2015	EXTENSION 1 FILED	98765
Feb. 26, 2015	TEAS EXTENSION RECEIVED	
Aug. 26, 2014	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	

Jul. 01, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 01, 2014	PUBLISHED FOR OPPOSITION	
Jun. 11, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 23, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
May 22, 2014	ASSIGNED TO LIE	77312
May 10, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 10, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 09, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 09, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 29, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 13, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 13, 2013	NON-FINAL ACTION E-MAILED	6325
Nov. 13, 2013	NON-FINAL ACTION WRITTEN	72508
Nov. 13, 2013	ASSIGNED TO EXAMINER	72508
Aug. 05, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 02, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Sep. 19, 2016

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: Pacific Foods of Oregon, Inc.

Assignment 1 of 2

Conveyance: ENTITY CONVERSION

Reel/Frame: [6191/0954](#)

Pages: 6

Date Recorded: Oct. 27, 2017

Supporting Documents: [assignment-tm-6191-0954.pdf](#)

Assignor

Name: [PACIFIC FOODS OF OREGON, INC.](#)

Execution Date: Aug. 24, 2017

Legal Entity Type: CORPORATION

State or Country Where Organized: OREGON

Assignee

Name: [PACIFIC FOODS OF OREGON, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: OREGON

Address: 19480 SW 97TH AVENUE
TUALATIN, OREGON 97062

Correspondent

Correspondent Name: TONKON TORP LLP

Correspondent Address: 888 SW FIFTH AVE.
1600 PIONEER TOWER
PORTLAND, OR 97204

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [6868/0045](#)

Pages: 5

Date Recorded: Feb. 20, 2020

Supporting Documents: [assignment-tm-6868-0045.pdf](#)

Documents: _____

Assignor

Name: [PACIFIC FOODS OF OREGON, LLC](#)
Legal Entity Type: LIMITED LIABILITY COMPANY

Execution Date: Jan. 27, 2020
State or Country Where Organized: OREGON

Assignee

Name: [CSC BRANDS LP](#)
Legal Entity Type: LIMITED PARTNERSHIP

State or Country Where Organized: DELAWARE

Address: ONE CAMPBELL PLACE
CAMDEN, NEW JERSEY 08103

Correspondent

Correspondent Name: JENNIFER DEBROW - LATHROP GPM LLP

Correspondent Address: 80 S EIGHTH STREET
500 IDS CENTER
MINNEAPOLIS, MN 55402

Domestic Representative - Not Found