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

Proceeding	92075431
Party	Defendant Hui Chuan Liao
Correspondence Address	HUI CHUAN LIAO 5925 MAZUELA DRIVE OAKLAND, CA 94611 UNITED STATES No email provided. No phone number provided.
Submission	Answer
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Date	11/12/2020
Attachments	Answer - 92075431.pdf(136451 bytes )

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

In re Registration No. 6,002,988	)	
For: BLUE BREW	)	
Registered: March 3, 2020	)	
	)	
BLUE BOTTLE COFFEE, LLC,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92075431
	)	
	)	
LIAO, HUI CHUAN,	)	
	)	
Respondent.	)	

**ANSWERS AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION**

Box TTAB  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir:

Respondent, LIAO, HUI CHUAN (“Respondent”), by and through its undersigned counsel hereby answers the Petition for Cancellation of Registrant’s U.S. Trademark Registration No. 6,002,988 filed by BLUE BOTTLE COFFEE, LLC (“Petitioner”) by addressing each allegation.

**ANSWERS**

1. Petitioner is a California limited liability company with its headquarters and principal place of business at 476 9th Street, Oakland, CA 94607. Respondent is, upon information and belief, a citizen of Taiwan, who resides at 5925 Mazuela Drive Oakland, California, United States 94611. Blue Bottle Coffee alleges the following as grounds for cancellation.


**RESPONSE:** Respondent admits that Respondent is a citizen of Taiwan who resides at 5925 Mazuela Drive Oakland, California, United States 94611. Petitioner has insufficient

knowledge or information as to the truth of the remaining allegations set forth in Paragraph 2 of the Petition for Cancellation and, therefore, denies said allegations.

2. As reflected in the electronic records of the Patent and Trademark Office, Respondent’s mark (Registration No. 6,002,988) registered on the Principal Register on March 3, 2020, in International Class 7 for “power operated machines, namely, coffee grinders, agitators for circulating liquid media, mixing machines, electric mixers, salt and pepper mills for household purposes other than hand operated,” Class 11 for “electrical cooking apparatus, namely, kettles, coffee machines, coffee percolators, coffee roasters,” Class 21 for “hand-operated household or kitchen apparatus, namely, non-electric coffee drippers for brewing coffee, coffee grinders, coffee services in the nature of tableware, non-electric coffee percolators, kettles, bottles sold empty, pots, teapots; household cooking utensils, namely, turners, tongs, bottle openers, graters,” and Class 30 for “coffee; unroasted coffee; all of the foregoing sold only online” (the “Registration”).

**RESPONSE:** Respondent admits the allegations set forth in Paragraph 2 of the Petition for Cancellation.

3. Since 2002, Blue Bottle Coffee has continuously used the trademark BLUE BOTTLE COFFEE in interstate commerce in the United States in connection with its goods and services. Reflecting its trademark rights, Blue Bottle Coffee owns U.S. registrations for its BLUE BOTTLE COFFEE, BLUE BOTTLE COFFEE-formative, and Bottle Design marks, including the following:

<u>Trademark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>First Use Date</u>
BLUE BOTTLE COFFEE CO	4435134	November 19, 2013	August 15, 2002
	4268406	January 1, 2013	August 15, 2002

BLUE BOTTLE COFFEE	6125843	August 11, 2020	August 2002
BLUE BOTTLE COFFEE	6125844	August 11, 2020	August 15, 2002
BLUE BOTTLE COFFEE	6137432	August 25, 2020	September 2009
BLUE BOTTLE COFFEE	6137429	August 25, 2020	November 2009
BLUE BOTTLE COFFEE	4470362	January 21, 2014	July 6, 2010
BLUE BOTTLE COFFEE	6137423	August 25, 2020	October 9, 2012
BLUE BOTTLE COFFEE	6125840	August 11, 2020	January 2014
BLUE BOTTLE COFFEE	4678758	January 27, 2015	February 25, 2014
BLUE BOTTLE COFFEE	5716136	April 2, 2019	February 2017

Copies of TSDR Records for the above-referenced marks are attached as Exhibit A.

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 3 of the Petition for Cancellation and, therefore, denies said allegations.

4. Petitioner also owns common law rights in the BLUE BOTTLE COFFEE mark in connection with various goods and services, including goods in International Classes 7, 11, 21, and 30, at least as early as December 2008 for goods in Classes 7, 11, and 21 and August 15, 2002 for goods in Class 30.

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 4 of the Petition for Cancellation and, therefore, denies said allegations.

5. All of Blue Bottle Coffee’s marks that feature the term BLUE BOTTLE COFFEE are referred to herein as the “BLUE BOTTLE COFFEE Marks.”

**RESPONSE:** Paragraph 5 provides a definition and does not require a response.

6. The BLUE BOTTLE COFFEE Marks are highly distinctive with regard to all of Blue Bottle Coffee's goods and services.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 6 of the Petition for Cancellation.

7. Blue Bottle Coffee's BLUE BOTTLE COFFEE Marks have priority over Respondent, which claims first use dates and first use in commerce dates for BLUE BREW on January 1, 2019 for its Class 7 goods, December 2, 2019 for its Class 11 goods, January 22, 2019 for its Class 21 goods, and December 2, 2019 for its Class 30 goods.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 7 of the Petition for Cancellation.

8. Blue Bottle Coffee owns United States Trademark Application Serial No. 88/471,854 to register the mark BLUE BOTTLE COFFEE in International Class 21 for "mugs; glass mugs; travel mugs; insulated containers for food or beverages; tumblers for use as drinking glasses; non-electric coffee dripper for brewing coffee; coffee filters not of paper being part of non-electric coffee makers; carafes; non-electric kettles" (the "Blue Bottle Coffee Application").

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 8 of the Petition for Cancellation and, therefore, denies said allegations.

9. The Trademark Examiner has refused to approve the Blue Bottle Coffee Application on the grounds that a likelihood of confusion exists between Petitioner's BLUE BOTTLE COFFEE mark and Respondent's BLUE BREW mark as registered.

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 9 of the Petition for Cancellation and, therefore, denies said allegations.

10. Blue Bottle Coffee's priority over Respondent extends to and encompasses mugs, containers, tumblers, coffee drippers, coffee filters, carafes, and coffee kettles, among other goods.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 7 of the Petition for Cancellation.

11. On information and belief, and in accordance with the Examiner's determination that a likelihood of confusion exists between the parties' respective marks, Respondent's BLUE BREW mark creates a similar commercial impression as the BLUE BOTTLE COFFEE Marks.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 11 of the Petition for Cancellation.

12. On information and belief, and in accordance with the fact that the parties' respective filings contain no limitations on trade channels, the parties' respective goods specified in the Registration and in the Blue Bottle Coffee Application are offered in overlapping or similar trade channels.

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 12 of the Petition for Cancellation and, therefore, denies said allegations.

13. On information and belief, and in accordance with the fact that the parties' respective filings contain no limitations on consumers or marketing channels, the parties' respective goods specified in the Registration and in the Blue Bottle Coffee Application are

intended to be marketed or will be marketed to overlapping classes of consumers and potential consumers and through overlapping or related marketing channels.

**RESPONSE:** Petitioner has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 13 of the Petition for Cancellation and, therefore, denies said allegations.

14. On information and belief, and in accordance with the Examiner's determination that a likelihood of confusion exists between the parties' respective marks, Respondent's goods claimed in the Registration are related to the goods and services specified in the Blue Bottle Coffee Application.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 14 of the Petition for Cancellation.

15. On information and belief, and in accordance with the Examiner's determination that a likelihood of confusion exists between the parties' respective marks, Respondent's mark is likely to cause confusion, or to cause mistake or to deceive the public as to the origin of Respondent's goods offered under the mark. Specifically, the continued registration of Respondent's mark will lead the public to conclude incorrectly that Respondent is or has been affiliated or connected with Blue Bottle Coffee, and/or that Respondent's goods provided under the mark are or have been, authorized, sponsored, endorsed, or licensed by Blue Bottle Coffee. The continued registration of the BLUE BREW mark will result in damage to Blue Bottle Coffee and the public. Therefore, the continued registration of Respondent's mark is prohibited by 15 U.S.C. § 1052(d).

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 15 of the Petition for Cancellation.

16. Through Blue Bottle Coffee's widespread use of the BLUE BOTTLE COFFEE Marks, extensive and continuous media coverage, the high degree of consumer recognition of the BLUE BOTTLE COFFEE Marks, Blue Bottle Coffee's enormous and loyal consumer base, its multiple trademark registrations and pending applications, and other factors, the BLUE BOTTLE COFFEE Marks are strong, enjoy widespread recognition among consumers, and have become famous within the meaning of 15 U.S.C. § 1125(c).

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 16 of the Petition for Cancellation.

17. The BLUE BOTTLE COFFEE Marks were famous before Respondent filed its application to register BLUE BREW and before Respondent began its use of BLUE BREW.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 17 of the Petition for Cancellation.

18. Respondent's mark has caused or is likely to cause dilution of the distinctive quality of the BLUE BOTTLE COFFEE Marks and/or harm the reputation of the BLUE BOTTLE COFFEE Marks in violation of 15 U.S.C. § 1125(c), to the harm and damage of Blue Bottle Coffee and the public.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 18 of the Petition for Cancellation.

19. Therefore, continued registration of Respondent's mark is prohibited by 15 U.S.C. §§ 1052.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 19 of the Petition for Cancellation.



20. Registration of Respondent's mark constitutes *prima facie* evidence of the validity of such registration, Respondent's ownership of the mark, and Respondent's exclusive right to use the mark pursuant to the provisions of 15 U.S.C. § 1057(b). Continued registration of the BLUE BREW mark would be a source of damage and injury to Blue Bottle Coffee and the public, and would be contrary to the principles of registration set out in 15 U.S.C. §§ 1051 *et seq.*

**RESPONSE:** Respondent admits the allegation that "Registration of Respondent's mark constitutes *prima facie* evidence of the validity of such registration, Respondent's ownership of the mark, and Respondent's exclusive right to use the mark pursuant to the provisions of 15 U.S.C. § 1057(b)." Respondent denies the remaining allegations set forth in Paragraph 20 of the Petition for Cancellation.

21. Therefore, the Registration should be cancelled under 15 U.S.C. §§ 1052 and 1064.

**RESPONSE:** Respondent denies the allegations set forth in Paragraph 21 of the Petition for Cancellation and further submits that Petitioner's request to cancel the Registration under 15 U.S.C. §§ 1052 and 1064 should be denied.

### **AFFIRMATIVE DEFENSES**

1. The Petition for Cancellation fails to state a claim upon which relief can be granted.
2. On information and belief, Petitioner's claims are barred under the doctrine of laches.
3. Respondent reserves the right to assert additional affirmative defenses which may emerge up to and including the time of trial.

WHEREFORE, Registrant prays that the subject Petition for Cancellation be dismissed.



