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

Ex Parte Appeal - Serial No.	97448285
Appellant	Cala Coffee Company LLC
Applied for mark	CALA
Correspondence address	JACE WILLIAMS GATEHOUSE LAW 3108 BLUE LAKE DRIVE, SUITE 200 VESTAVIA HILLS, AL 35243 UNITED STATES Primary email: jace@gatehouse.law Secondary email(s): trademarks@gatehouse.law 205-208-9595
Submission	Appeal brief
Attachments	2024-02-23- Filing - appeal brief - cala.pdf(711464 bytes ) Exhibit A - Phonetics.pdf(3608416 bytes )
Appealed class	Class 030. First Use: Feb 17, 2021 First Use In Commerce: Feb 24, 2021 All goods and services in the class are appealed, namely: Coffee; Coffee beans; Coffee-based beverages; Beverages made of coffee; Beverages with coffee base; Ground coffee; Ground coffee beans; Roasted coffee beans
Filer's name	Jace Williams
Filer's email	jace@gatehouse.law, trademarks@gatehouse.law
Signature	/Jace Williams/
Date	02/23/2024

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

Serial #: 97448285

Ex Parte Appeal: 97448285

Mark: Cala

Applicant: Cala Coffee Company LLC

Examining Attorney: Joseph Becker (Law Office 117)

**APPLICANT'S APPEAL BRIEF**

Applicant, Cala Coffee Company, LLC (the "Applicant"), by and through its counsel identified below, submits the following appeal brief pursuant to Trademark Rules 2.131(a) from a final refusal dated June 27, 2023, and following a denial for request for reconsideration dated December 08, 2023. By submission of this brief, the Applicant respectfully appeals the Examining Attorney's refusal to register the Mark due to a likelihood of confusion. As evidence, Applicant submits the following:

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**DESCRIPTION OF THE RECORD**

**On June 08, 2022**, Applicant, through counsel, filed an application for registration on the principal registry for “Cala” (the “Mark”) in International Class 030. The identification categories are as follows: Coffee; Coffee beans; Coffee-based beverages; Beverages made of coffee; Beverages with coffee base; Ground coffee; Ground coffee beans; Roasted coffee beans.

**On March 23, 2023**, the Examining Attorney refused registration of the Mark on the basis of a likelihood of confusion with the mark KALA BRAND in U.S. Registration No(s). 1564866 and 4944056. The office action primarily relies on two factors: (1) The marks are phonetically similar and (2) the goods/services of each mark are commercially related, or travel in the same trade channels.

**On June 14, 2023**, Applicant, through counsel, submitted a response to the above referenced office action.

**On June 27, 2023**, the Examining Attorney maintained his refusal and submitted a final office action refusing registration on the basis of a likelihood of confusion as stated above.

**On November 28, 2023**, Applicant, through counsel, filed a Request for Reconsideration after Final Action. Applicant’s request relied on additional research into the proper pronunciation of each mark and additional case law distinguishing varying channels of trades.

**On December 08, 2023**, the Examining Attorney denied Applicant’s Request for Reconsideration. In a noticeable shift from previous office actions, the Examining Attorney failed to address or provide a response to the issue of commercially related goods/services and instead only addressed the phonetically similar state of the two marks.

On December 26, 2023, Applicant timely noticed this to the Trademark Trial and Appeal Board.

### STATEMENT OF THE ISSUES

**Issue #1:** Under an analysis of the *du Pont* factors, are the marks similar enough to cause a likelihood of confusion barring registration?

**Issue #1(a):** Are the marks in question phonetic equivalents?

**Issue #1(b):** Are the goods/services of each mark commercially related, or do they travel in the same trade channels?

### EVIDENCE OF THE EXAMINING ATTORNEY

#### **June 27, 2023, Final Office Action:**

In support of the Examining Attorney's claim that the marks are phonetically similar and thus barred from registration, the Examining Attorney fails to provide any evidence regarding the actual pronunciation of each mark.

In support of the Examining Attorney's claim that the goods/services of each mark are commercially related or travel in the same trade channels, the Examining Attorney provides a number of websites where the compared goods/services are made and sold by the same sources.

See below:

- **Decoty** makes and sells:
  - coffee and coffee rub spices: <https://www.decoty.com/index.php>
  - **curry** spice: <https://www.decoty.com/catalogItems/view/curry-powder>
- **Essential Everyday** makes and sells:
  - coffee: <https://www.essentialeveryday.com/products/beverages.html>
  - spices: <https://www.essentialeveryday.com/products/baking.html> (Same.)
- **GOYA** makes and sells:
  - spices: <https://www.goya.com/en/search?q=spice&ContentType=product>
  - coffee: <https://www.goya.com/en/search?q=coffee&ContentType=product> (Same.)
- **Stonewall Kitchen** makes and sells:
  - coffee: <https://www.stonewallkitchen.com/coastal-morning-ground-coffee-M550605.html>
  - spices: <https://www.stonewallkitchen.com/chicken-pork-rub-210326.html>
  - **curry**: <https://www.stonewallkitchen.com/coconut-curry-simmering-sauce-251804.html>
- **Williams Sonoma** makes and sells:
  - Coffee: <https://www.williams-sonoma.com/products/williams-sonoma-espresso-powder/?>
  - Spices: <https://www.williams-sonoma.com/products/williams-sonoma-cinnamon-powder-2022/?>

**Also:**

- <https://www.biltmoreshop.com/> (This brand makes and sells coffee and spices.)
- <https://www.margaritavillefoods.com/products.html> (Same.)
- <https://marketspice.com/> (Same.)

Additionally, the Examining Attorney provides the below evidence that spices and coffee are often used together:

- <https://perfectdailygrind.com/2020/11/exploring-the-relationship-between-coffee-spices/> ("From Turkish coffee brewed with cardamom to the pumpkin spice latte, coffee and spices have been paired for almost as long as people have enjoyed coffee. Today, coffee consumers enjoy beverages made with dozens of different spices, including cinnamon, turmeric, and ginger.")
- <https://www.pereg-gourmet.com/products/mixed-spices-coffee?variant=22086813505> (Spice company Pereg makes and sells spices for coffee.)
- <https://www.coffeeam.com/blogs/blog/add-a-spicy-kick-to-your-coffee-heres-how> ("If you're finding your coffee a little flat, spice things up a little with ingredients from your spice cabinet.")
- <https://thecoffeeanatics.com/best-spices-and-toppings-you-can-add-to-your-coffee> ("Best spices and toppings you can add to your coffee. Here you will find spices and toppings that will make your coffee tastier and healthier.")
- [https://www.amazon.com/Upouria-Coffee-Topping-Variety-Pack/dp/B07HLCG2HC/ref=asc\\_df\\_B07HLCG2HC/?](https://www.amazon.com/Upouria-Coffee-Topping-Variety-Pack/dp/B07HLCG2HC/ref=asc_df_B07HLCG2HC/?) (Listing for "Upouria Coffee Topping Variety Pack - Chocolate, Cookies N Cream, French Vanilla and Cinnamon with Brown Sugar")
- <https://www.walmart.com/ip/Larissa-Veronica-Curry-Medium-Roast-Coffee-Curry-Medium-Roast-Whole-Coffee-Beans-8-oz-2-Pack-Zin-550869/588319375> (Listing for "Curry Medium Roast Coffee, (Curry, Medium Roast, Whole Coffee Beans)")

- 
- <https://www.bonappetit.com/story/how-to-add-spices-to-coffee> ("You Should Add Spices to Your Coffee Grounds")

## **EVIDENCE OF THE APPLICANT**

### **November 28, 2023, Request for Reconsideration After Final Office Action:**

In support of Applicant's registration and in response to the phonetically similar claim, Applicant has submitted evidence showing both marks have actual phonetic pronunciations that vary from each other. See Exhibit A.

In support of Applicant's registration and in response to the claim that the goods/services are commercially related or travel in the same trade channels, Applicant has submitted evidence showing the goods are clearly separate from one another in commerce and common trade channels, as well as additional case law in support of its argument.

## ARGUMENT

### Legal Standard

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. See 15 U.S.C. §1052(d). The question of whether a mark should be refused registration because of a likelihood of confusion with an already existing mark is determined on a case-by-case basis by applying the factors set forth *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973) (called the “*du Pont* factors”). Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. See *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322-23 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65 (Fed. Cir. 2002).

### Analysis

The two marks at issue in this case are “Cala” and KALA BRAND in U.S. Registration No(s). 1564866 and 4944056. The Examining Attorney has improperly refused registration under Section 2(d) for two primary reasons under his analysis. Those reasons are (1) the marks are phonetic equivalents and (2) the goods under each mark are considered related for likelihood of confusion purposes. Applicant has addressed both issues in subsequent office action responses, as well as a request for reconsideration. On reconsideration, the Examining Attorney failed to address evidence submitted by Applicant regarding the correct pronunciation of each mark. Additionally, the Examining Attorney failed to address provided case law regarding the goods of



each mark. As such, the Examining Attorney's decision barring registration should be reversed, and the Cala Mark should be allowed registration on the principal register.

### **I. Du Pont Analysis**

While a single *du Pont* factor may be dispositive in a likelihood of confusion analysis, the Examining Attorney in this case has failed to properly balance all relevant factors. *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998). Without addressing all thirteen *du Pont* factors, a number of factors weigh in favor of the Applicant when viewed in their entirety. In addition to the specific factors addressed below, the following *du Pont* factors weigh in favor of the Applicant as follows:

#### **(4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing**

Cala is a premium brand of coffee ranging in price from \$18 (12oz bag) to \$83 (5lb bag). Ordering is available via the Cala Coffee website and can be found in local grocery stores in the coffee aisle. In the alternative, Kala Brand's Indian spices are available wholesale or in various grocery stores in the spice/international aisle. Buyers of either good are careful purchasers who when taking the time to purchase each product would not be confused by the competing marks. Even in the event a purchaser makes a purchase on impulse, the goods are not located in the same area of a store or in the same section of a website. When viewed in the overall appearance of each good and mark, the possibility that a consumer would be confused is minimal at best.

**(7) The nature and extent of any actual confusion.**

No actual confusion between the marks exists or in the alternative no evidence has been provided of actual confusion. Upon publication of the mark for opposition, Kala Brand may file an opposition and make a showing of any actual confusion should it exist.

**(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.**

Kala Brand has been used in commerce since March 07, 1974. Cala has been used in commerce since February 24, 2021. In the three year time span of concurrent use, there has been no evidence of actual confusion or alleged confusion by either mark holder.

Under an analysis of all du Pont factors (additional examination below), the evidence is clearly in favor of the Applicant and no likelihood of confusion exists or can be established by the Examining Attorney. As such, the Examining Attorney's decision should be reversed, and the Mark should be allowed registration.

**II. Phonetic Equivalents**

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371 (Fed. Cir. 2005)). While the two marks at issue in this appeal may on their face have similar connotations or appearances, when combined with an analysis of the other du Pont factors, weight must be given to the overall appearance of the mark. The Kala Brand mark utilizes Sanskrit below the English name emphasizing the type of

consumer they are marketing to. **Kala** (Sanskrit: काल, romanized: *Kālā/Kālam*,<sup>1</sup> IPA: [kaːˈlɑ]) is a Sanskrit term that means 'time' or 'death'.<sup>2</sup> Kala is a god of death, and often used as one of the epithets of Yama. Cala, in the alternative, is a fanciful term because it is a made-up word that is derived from the combination of California and Alabama (Cal-a). A fanciful mark is one that is a made-up word. Coined or fanciful marks should be given a broader degree of protection than words in common use. *Kautenberg Co. v. Ekco Prods. Co.*, 251 F.2d 628 (C.C.P.A. 1958). As stated on Cala Coffee's website, "Founded by Josh and Mel Cosio in 2021, the couple embarked on a mission to learn the art of coffee roasting and build a portable coffee cart. Drawing inspiration from their origins, California and Alabama, they aptly named their venture Cala Coffee." Because each mark has a definitive pronunciation that would be known to consumers of either good, the Examining Attorney's contention that each mark is phonetically similar is patently incorrect.



\*Comparison of the Marks in Commerce

<sup>1</sup> www.wisdomlib.org (14 September 2019). "Kalam: 6 definitions". www.wisdomlib.org. Retrieved 4 November 2022.

<sup>2</sup> Monier-Williams, Monier (1899). "Sanskrit Dictionary". Retrieved 4 October 2023

“The proper test *is not a side-by-side comparison of the marks*, but instead whether the marks are sufficiently similar in terms of their commercial impression such that consumer who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012)); TMEP § 1207.01(b) (emphasis added). While the marks may have similar connotations, there is also a clear distinction. Long standing precedent establishes that similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014). The Examining Attorney concedes “marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression” but later relied on the “greater weight of the word portion of the mark” in a composite mark. The word portion itself may “normally” be afforded greater weight but that should also take into account the entire mark, in this case *Kala Brand v Cala*. If the ultimate assessment to determine likelihood of confusion is to view the marks in their entirety, the marks should be assessed in their entirety. When comparing the marks in their totality and in conjunction with all *du Pont* factors, no likelihood of confusion exists, and the Mark should be permitted registration on the principal register.

### **III. Relationship of the Goods/Services**

While the Examining Attorney has failed to address the issue of whether goods/services of each mark are commercially related in his final denial, the issue still remains and is dispositive to registration of the Mark. The Examining Attorney states that the goods of each mark are considered related for likelihood of confusion purposes but fails to acknowledge established case law in direct opposition this point. In *Cai v. Diamond Hong*, the Federal Circuit reiterates the rule that similar goods and services are presumed to travel in the same channel of trade. *See Cai*,

901 F.3d at 1372 (Quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012)). However, this presumption is rebuttable. Applicant and Registrant's goods are not identical. There is a clear distinction between "Spices namely curry powder" and coffee.

Registrant lists its goods as spices, namely, meat tenderizer, onion salt, garlic salt, monosodium glutamate, celery salt, paprika, chili powder, curry powder, black pepper, white pepper, cinnamon. However, the (3) design plus words, letters, and/or numbers indicates the deletion of all goods other than spices, namely, curry powder for the Kala Brand mark. The Applicant's description of goods is coffee; coffee beans; coffee-based beverages; beverages made of coffee; beverages with coffee base; ground coffee; ground coffee beans; roasted coffee beans. This shows that there is not *any* good listed by the applicant that would be touched by the Registrant's goods. Rather, the Applicant is providing coffee-based goods which are vastly different than that of the Registrant's spices, which is namely, curry powder.

The Examining Attorney provides a number of websites where the compared goods/services are made and sold by the same sources but fails to observe those goods are sold in completely different sections of the webpage or completely different channels of trade. The separation of spices and coffee as shown in the internet evidence shows that both products may be provided by the same entity, but they are never displayed together in the same channel of trade. Thus, the internet evidence provided by the Examining Attorney does not show how the goods would be considered related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 US.P.Q.2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 US.P.Q.2d 1266, 1268-69,71-72 (TTAB 2009). In *Shell Oil*, the court recognized that "[t]he degree of 'relatedness' must be viewed in the context of all factors, in determining whether the services are sufficiently related that a reasonable consumer would be confused as to source or

sponsorship. Relatedness should be analyzed on a sliding scale. *In re Shell Oil*, 992 F.2d 1204, 1207 (Fed. Cir. 1993); *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1328 (Fed. Cir. 2017).

“A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. **The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed.**” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1102-03 (C.C.P.A. 1976); *See also Recot, Inc. v. Becton*, 214 F.3d 1322, 1329-30 (Fed. Cir. 2000) (**absent some evidence that the products are sold in close proximity to one another, the fact that the involved products are sold in supermarkets did not weigh in favor of confusion being likely**); *Morgan Creek Prods. Inc. v. Foria Int'l Inc.*, 91 US.P.Q.2d 1134, 1142 (TTAB 2009) (**“It has long been held that the mere fact that two different items can be found in a supermarket, department store, drugstore or mass merchandiser store is not a sufficient basis for a finding that the goods are related.”**). *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 U.S.P.Q.2D 1464, 1472 (TTAB 2016) [Bolted for emphasis]. The fact that products appear on the same site or in the same store is insufficient to show that there is a likelihood of confusion between those products. To establish a precedent utilizing this standard would demolish trademark protection for almost all small businesses at the benefit of large conglomerates who sell multiple products, and such standard would be in direct opposition of established case law.

To associate Cala’s coffee and Kala Brand’s curry together only because the same sort of goods are sold in online store fronts BUT in different sections would be an incorrect application

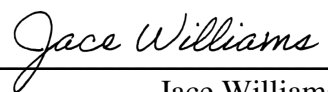
of the factors established by *Du Pont & Mini Melts, Inc.* Because the actual goods AND the registered for goods, curry powder/spices and coffee, are not the same, the Examining Attorney's decision barring registration should be reversed, and the Cala Mark should be allowed registration on the principal register.

### SUMMARY

Applicant respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision barring registration under §2(d) of the Lanham Act because the marks are not similar in connotation, appearance, or commercial impression. Additionally, the goods are not similar, nor do they travel in the same channels of trade. Under a total *du Pont* analysis, no likelihood of confusion exists, and the Mark should register. Each factor may play a dominant role. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d at 1361-62. The facts in this case as stated in this brief and the applicable record show that registration is warranted.

The Examining Attorney has made unsubstantiated claims that the marks are phonetically similar and misapplied case law in determining that the goods of each mark travel in the same channels of trade. No evidence of confusion exists, and the case law is in clear favor of Applicant's mark in regard to the relationship of goods/services. In light of the information provided above, Applicant respectfully requests that the Board grant this Ex Parte Appeal and allow for registration of the Cala mark.

Dated this 23<sup>rd</sup> day of February 2024.



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Jace Williams  
Gatehouse Law, LLC  
3108 Blue Lake Drive  
Suite 200

Vestavia Hills, AL 35243  
P) 205-208-9595  
Email: Jace@gatehouse.law  
Attorney for Applicant



Search for headword: **kala**

4 results

Highlight Devanagari and press "t" to transliterate.

1) कल काल (p. 64)

कल काल

कल काल *a.* dumb; indistinct; inarticulate; choked *with tears* (—); low, soft (*note*); uttering a soft sound: **-m, ad.**; **-kanthikā, f.** female cuckoo; **-kala, m.** confused noise or cry: **-rava, -ārava, m. id., -vat, a.** tinkling.

2) कला काला (p. 64)

कला काला

कला काला *f.* small part, *esp.* one-sixteenth; sixteenth part of the moon's disc; interest on *capital*; small division of *time* (*ranging between 8 seconds and about 2 ½ minutes according to different statements*); artistic skill; art (*of which there are 64*); **-keli, a.** practising an art as an amusement; **-gñā, a.** understanding an art or the arts; *m.* artist; **-dhara, a.** possessing an art or the arts; *m.* moon; **-nātha, m.** moon; **-nidhī, m. id.**

3) काल काला (p. 67)

काल काला

काल 1. काला *a.* (i) dark blue, black; *m.* the black in the eye; *ep. of Siva.*

4) काल काला (p. 67)

काल काला

काल 2. काला *m.* due season, appointed or right time (*for, d., g., lc., inf., —°*); time; opportunity; season; meal-time (*of which there are two a day*); half a day; hour; age, era; measure, prosody; Time, fate; death, god of death; —°, at the right time; in time, gradually; **paraḥ kālāḥ**, high time (*w. inf.*); **kālam kri**, fix a time for (*lc.*); **kālam āsādyā**, according to circumstances; *in. kālena*, in due season; in course of time: — **gakkhatā**, as time goes on, in course of time; **dirghena —, mahatā — or bahunā —**, after a long time; **kenakit —**, after some time; **tena —**, at that time; *ab. kālāt*, in the long run, in course of time; **kālatas, id.**; with regard to time; *g. dirghasya or mahataḥ kālasya*, after a long time; **kasya kit —**, after some time; *lc. kālē*, at the right or appointed time, opportunely; in time=gradually; — **prāpte**, when the time has come; — **gakkhati**, in course of time; — **yāte**, after the lapse of some time; **kasmims kit —**, one day; **kāle kāle**, always at the right time; **shashthe —**, at the end of the third day: — — **zhnaḥ**, at the sixth hour of the day, *i. e. at noon*; **pañ- kasate —**, =after 250 days; **ubhau kālau**, morning and evening.

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**cala**  
COFFEE



Our mission at Cala Coffee is to help others Create Good Days. For us, that means starting the day off drinking good coffee – we'd like to think the same for you! We strive to give you, our customer, the best experience we can, so that you leave our shop better than how you came in. We do this by roasting our own coffee, hiring friendly staff, opening our doors to community events, and delivering a product that is delicious and carefully crafted.

Founded by Josh and Mel Cosio in 2021, the couple embarked on a mission to learn the art of coffee roasting and build a portable coffee cart. Drawing inspiration from their origins, California and Alabama, they aptly named their venture Cala Coffee.

During the initial two years, Cala operated primarily as a micro roaster and coffee cart. They honed their skills in coffee roasting, ensuring exceptional quality and flavor profiles in their beans. The mobile coffee cart became a

familiar sight at private events such as weddings and corporate celebrations, delivering a delightful coffee experience on-the-go. Cala Coffee also ventured into local farmers markets, attracting coffee enthusiasts with their freshly roasted beans. Additionally, their roasted coffee gained popularity through online sales and select Piggly Wiggly stores across Birmingham.

In January 2023, Cala Coffee reached a significant milestone by opening its first brick-and-mortar coffee shop. Equipped with a team of skilled baristas, the shop quickly became a local favorite. With a blend of exceptional coffee, delicious breakfast tacos and pastries from partnered restaurants, and a welcoming atmosphere, the coffee shop attracted a loyal customer base.

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