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Paper No. 26
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Coffee Express Co.
v.
Janelco Global, Inc.

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Cancellation No. 28,360

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William M. Hanlon of Young & Basile, P.C. for Coffee Express Co.

Kenneth L. Tolar, Esq., for Janelco Global, Inc.

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Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 4, 1998, Coffee Express Co. filed a Petition to Cancel Registration No. 2,081,278, which issued on the Principal Register to Janelco Global, Inc. on July 22, 1997 for the mark shown below

for “shelf-stable liquid coffee concentrate and powdered coffee,” in Class 30. The registration is based on registrant’s claim of use of the mark in commerce in connection with these goods since October 1, 1995. The descriptive word “coffee” is disclaimed apart from the mark as shown in the registration.

As grounds for cancellation, petitioner alleged that it is in the business of roasting and selling specialty coffee beans, coffees and associated goods; that since at least as early as March 31, 1980, petitioner and its predecessor have been using the marks “COFFEE EXPRESS,” “COFFEE EXPRESS” and design, “COFFEE EXPRESS COMPANY” and other marks with “COFFEE EXPRESS” as the dominant feature in connection with petitioner’s coffee and coffee beans; that on April 13, 1987, petitioner’s predecessor applied to register the mark shown below

for “coffee,” but that registration was refused under Section 2(d) of the Lanham Act based on Registration No. 1,395,742 for the mark “COFFEE EXPRESS” for “non-electric coffee pots,” in Class 21, which had been issued to Dante Bedini on June 3, 1986; that petitioner continued to use

its mark in connection with its coffee products, as well as on related items; that petitioner purchased the registration cited as a bar to its application when the owner thereof died in 1997; and that petitioner again applied to register its mark after securing the previously-cited registration, only to have the registration here sought to be canceled cited as a bar under Section 2(d) of the Act. The Petition to Cancel alleges priority and likelihood of confusion as grounds for cancellation of respondent's registration.

Respondent denied the allegations of petitioner and asserted laches as an affirmative defense. Additionally, respondent counterclaimed to cancel Registration No. 1,395,742, the registration referred to above, which petitioner had acquired from the estate of Dante Bedini in 1997. As grounds for cancellation, respondent asserted that the mark "COFFEE EXPRESS" has become generic. Petitioner answered the counterclaim by denying that the mark is generic for the goods specified in the registration, "non-electric coffee pots."

A trial was conducted in accordance with the Trademark Rules of Practice. Testimony and evidence were introduced by both parties. The record before us in this proceeding includes the testimony, with exhibits, of

Thomas Isiah, petitioner's president, and of Eduardo Gautier, Jr., respondent's president, as well as responses to discovery requests and a number of other exhibits made of record by notices of reliance. Both parties filed briefs, but no oral hearing before the Board was requested.

Based on careful consideration of this record, the arguments presented in the briefs and the relevant legal precedents, we hold that the petition for cancellation of Reg. No. 2,081,278 must be granted, and that the counterclaim for cancellation of Reg. No. 1,395,742 must be denied.

In view of the refusal to register petitioner's mark based on likelihood of confusion with respondent's registered mark, it is clear that petitioner is being damaged by the existence of the registration it seeks to cancel by means of this proceeding. Petitioner's standing to bring this action is therefore established.

Turning, then, to petitioner's claims of priority and likelihood of confusion, we note first that respondent argues that petitioner cannot use 1975 as the date of its first use in order to establish priority. Respondent notes that since 1975, petitioner and its predecessor have combined several different combinations

of words and designs with the words “COFFEE EXPRESS” in connection with various aspects of its coffee business. Respondent’s position seems to be that each time additional words or designs were added to or deleted from “COFFEE EXPRESS,” petitioner brought a new mark into the world and could no longer claim priority based on the previous version or versions of its trademark.

As petitioner correctly points out, however, this is not the case. The record clearly shows continuous use of “COFFEE EXPRESS” as the trade name of petitioner and its predecessor and as a trademark in connection with petitioner’s goods since the mid-1970s. Mr. Isiah testified that petitioner first used “COFFEE EXPRESS” as a trademark on coffee in 1979, well before the 1995 first use date claimed by respondent for its registered mark; and that petitioner continues to use the mark in connection with its products. The words “COFFEE EXPRESS” have certainly been used by petitioner with a number of different combinations of words and designs, but throughout the years, the words “COFFEE EXPRESS” have always functioned as petitioner’s trademark.

In view of petitioner’s priority, the question becomes whether the use of respondent’s registered mark, which combines the words “COFFEE EXPRESS” with a design

of a coffee cup for liquid coffee concentrate and powdered coffee, is likely to cause confusion with petitioner's trademarks, all of which are for or are dominated by the words "COFFEE EXPRESS," for coffee and coffee-related products. Confusion is plainly likely because the commercial impressions of petitioner's trademarks are quite similar to that of the mark petitioner seeks to cancel, and the goods in connection with which they are all used are commercially related.

The predecessor to our primary reviewing court set out the factors to be considered in determining whether confusion is likely in In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, (CCPA 1973). Although we do not have probative evidence relating to all of the thirteen factors listed therein, the evidence we do have establishes that confusion is likely.

As noted above, although the marks do possess some differences, they create similar commercial impressions because the words "COFFEE EXPRESS" are the dominant portion of respondent's mark and the trademarks of petitioner. "COFFEE EXPRESS" is suggestive in connection with the coffee products sold under these marks, but the suggestion is the same, namely that the goods involve providing coffee quickly.

The second factor, the relationship between the goods with which the marks are used, also cuts in petitioner's favor. As noted above, under its mark petitioner sells coffee beans, ground roasted coffee and related products such as coffee pots and coffee mugs. The goods specified in respondent's registration are powdered coffee and liquid coffee concentrate. We are not able to precisely differentiate powdered coffee from ground coffee, but, at a minimum, these goods appear to be very similar, and in view of the unrestricted manner in which they are identified in respondent's registration, we must assume that these goods move in all the usual trade channels for such products to all the usual purchasers of them, which would clearly overlap.

In fact, the testimony indicates that respondent conducts business in the same markets as petitioner and has attended the same type of trade shows. Contrary to respondent's contentions, there is no evidence that the purchasers of ground coffee or powdered coffee are sophisticated or knowledgeable such that they are likely to avoid being confused by the use of such similar trademarks in connection with goods which are so closely related.

Several of the factors identified in the DuPont case do not cut in favor of either party in the instant case. We have no proof that any of these marks has acquired fame, and the testimony concerning actual confusion that was alledged to have occurred is vague, confusing and insufficient to support a conclusion that customers of petitioner were actually confused.

Petitioner has used and continues to use marks consisting of or dominated by the words “COFFEE EXPRESS” on a wide variety of collateral goods, from jackets and mugs to napkins. As noted above, it owns a valid and subsisting registration of the mark for coffee pots. As we explain below, the counterclaim to cancel that registration because the mark is generic is without merit.

When all of the evidence of record is considered, we conclude that confusion is likely.

In addition to finding that petitioner has priority and that confusion is likely, we also hold that respondent has not provided sufficient proof in support of its affirmative defense of laches. This action to cancel was brought a year and seven months after respondent’s mark was published for opposition. Respondent does not explain how bringing this action at

that time could be considered untimely, especially in light of the fact that petitioner advised respondent of its rights and threatened to bring a cancellation proceeding less than a year after respondent's mark had been published.

We thus turn to consideration of respondent's counterclaim. Respondent has not established any factual basis for its counterclaim to cancel petitioner's registration of "COFFEE EXPRESS" on the ground of genericness. Although some of the evidence relied upon by respondent does indicate that there are a couple of other entities in this country using "COFFEE EXPRESS" in conjunction with coffee shop services, it is not at all clear whether this use is use as a service mark, much less that it is use as a generic term for any goods or services. Moreover, even if respondent had established widespread use of "COFFEE EXPRESS" in connection with coffee shop services, such uses do not prove that the term has become generic for non-electric coffee pots, which are the goods identified in the registration respondent seeks to cancel by means of its counterclaim. Respondent argues in its brief that petitioner has abandoned use of this registered mark, but that ground was not pleaded by respondent.

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Decision: The counterclaim to cancel Reg. No. 1,395,742 is denied, and the petition to cancel Reg. No. 2,081,278 is granted.