

To: Everhart, Joseph, E. (Joe@nc.rr.com)
Subject: TRADEMARK APPLICATION NO. 78463124 - SEATTLE COFFEE COMPANY - N/A
Sent: 3/12/2005 9:06:15 AM
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/463124

APPLICANT: Everhart, Joseph, E.

78463124

CORRESPONDENT ADDRESS:
EVERHART, JOSEPH, E.
311 ARLINGTON RIDGE RD
CARY NC 27513-3442

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: SEATTLE COFFEE COMPANY

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
Joe@nc.rr.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/463124

The assigned examining attorney has reviewed the referenced application and determined the following.

Search Results

Although the examining attorney has searched the Office records and has found no similar *registered* mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), the examining attorney encloses information regarding pending Application Serial Nos. 78431692, 78358204, and 76482034. 37 C.F.R. §2.83.

There may be a likelihood of confusion between the applicant's mark and the marks in the above noted applications under Section 2(d) of the Act. The filing dates of the referenced applications precede the applicant's filing date. If one or more of these earlier#filed applications matures into a registration, the examining attorney may refuse registration under Section 2(d).

2(e)(3) - Geographically Deceptively Misdescriptive Refusal

Registration is refused because the proposed mark consists of or comprises geographically deceptive and primarily geographically deceptively misdescriptive matter in relation to the identified goods and/or services. 15 U.S.C. §§1052(a) and (e)(3); *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *reh'g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003); *See In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989).

The primary significance of the term "SEATTLE" is geographic. The goods do not originate in this geographic location. The public is likely to believe that applicant's goods come from this place because Seattle is well-known for coffee. Furthermore, this belief would materially influence consumers to purchase the goods because of the high quality associated with Seattle coffee. *See In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984).

The addition of a generic or highly descriptive term to a geographic term does not obviate a determination of geographic descriptiveness. TMEP §1210.07(a). *See In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk's International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989); *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1988); *In re Cambridge Digital Systems*, 1 USPQ2d 1659 (TTAB 1986); *In re BankAmerica Corp.*, 231 USPQ 873 (TTAB 1986). Therefore, the addition of the descriptive wording COFFEE COMPANY does not obviate the geographic significance of the mark.

Alternative Refusal **Indicate Geographic Origin**

The applicant must indicate specifically whether the goods will be manufactured or produced in, or will have any other connection with, the geographic location named in the mark. 37 C.F.R. §2.61(b); TMEP §1210.03. If the primary significance of a mark is to indicate a geographic location which is neither obscure nor remote and the applicant's goods are manufactured or produced in the location indicated, then the public is likely to believe that the geographic term identifies the place from which the goods originate. *See In re Nantucket Allserve, Inc.*, 28 USPQ2d 1144 (TTAB 1993).

In that case, registration is refused under Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052(e)(2), because the mark is primarily geographically descriptive of the applicant's goods.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following informalities.

Identification of Goods

The identification of goods is unacceptable as indefinite because it is too broad. TMEP 1402.01. The applicant may adopt the following identification, if accurate: coffee products, namely, brewed coffee, espresso, whole beans, and ground coffee.

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

Disclaimer

The applicant must disclaim the generic wording "COFFEE COMPANY" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP §1213.08(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use COFFEE COMPANY apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm'r Pats. 1983).

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

(1) \$325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or

(2) \$375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be \$325 per class, and if such payments are made with a paper response, the fee will be \$375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

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

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at <http://www.uspto.gov/teas/index.html>.

/Patty Evanko/

Trademark Attorney

Law Office 112

571-272-9404

patty.evanko@uspto.gov (questions only)

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit <http://www.uspto.gov/teas/index.html> and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

Print: Mar 12, 2005

76482034

DESIGN MARK

Serial Number

76482034

Status

OPPOSITION PENDING

Word Mark

THE SEATTLE DRIP COFFEE COMPANY

Standard Character Mark

No

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Seattle Drip Coffee Company, Inc. CORPORATION MISSISSIPPI 961 Madison Ave Madison MISSISSIPPI 39110

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: retail store services featuring gourmet coffee, espresso-based drinks, snack foods and baked goods. First Use: 2002/09/25. The mark was first used anywhere in a different form other than that sought to be registered on 11/01/2000.. First Use In Commerce: 2002/09/25.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SEATTLE" and "COFFEE COMPANY" APART FROM THE MARK AS SHOWN.

Description of Mark

The mark consists of a cartoon rendition of the Seattle skyline with dripping rain clouds with words "The Seattle Drip" appearing in royal blue text above the skyline and the words "Coffee Company" appearing in royal blue text below the skyline.

Filing Date

2003/01/13

Examining Attorney

KIM, SOPHIA S.

Attorney of Record

Print: Mar 12, 2005

76482034

R. Patrick McCraney



DESIGN MARK

Serial Number

78358204

Status

NON-FINAL ACTION - MAILED

Word Mark

SEATTLE DRIP COFFEE COMPANY

Standard Character Mark

No

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Seattle Drip Coffee Company, Inc. CORPORATION MISSISSIPPI 961 Madison Avenue Madison MISSISSIPPI 39110

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050.
G & S: coffee cups and travel mugs for resale.

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: coffee, coffee-based beverages containing milk, espresso, rice-based, wheat-based, and cereal-based foods, cakes and brownies.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: retail store services featuring gourmet coffee, espresso-based drinks, snack foods and baked goods.

Filing Date

2004/01/27

Examining Attorney

AMOS, TANYA

Attorney of Record

Scott K. Haight



DESIGN MARK

Serial Number

78431692

Status

RESPONSE AFTER NON-FINAL ACTION - ENTERED

Word Mark

SEATTLE DRIP COFFEE COMPANY THE SMOOTHEST COFFEE ON THE ROAD!

Standard Character Mark

No

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Seattle Drip Coffee Company, Inc. CORPORATION MISSISSIPPI 961 Madison Avenue Madison MISSISSIPPI 39110

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050.
G & S: coffee mugs and travel mugs for resale.

Goods/Services

Class Status -- ACTIVE. IC 030. US 046. G & S: coffee, coffee-based beverages containing milk, espresso; rice-based, wheat-based, and cereal based snack foods, cakes and brownies.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: retail store services featuring gourmet coffee, espresso-based drinks, snack foods and baked goods.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SEATTLE and COFFEE COMPANY" APART FROM THE MARK AS SHOWN.

Filing Date

2004/06/08

Examining Attorney

AMOS, TANYA

Print: Mar 12, 2005

78431692

Attorney of Record
Scott K. Haight



The Smoothest Coffee on the Road!