

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Quaker Coffee Company Inc.

Serial No. 78465668

Paul A. Beck of Paul A. Beck & Associates, P.C. for Quaker
Coffee Company Inc.

Dahlia George, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Bucher, Grendel and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark **QUAKER COFFEE** (*in standard character format*) for
services recited in the application, as amended, as "coffee
shop services" in International Class 43.¹

¹ Application Serial No. 78465668 was filed on August 11, 2004 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. Applicant has disclaimed the word "Coffee" apart from the mark as shown. The amended goods in International Class 30, which were part of this application at the time of filing, have been divided out into application Serial No. 78976794, having the following identification of goods: "beverages made from coffee base; espresso; coffee beans; and dry roasted coffee available from a coffee shop."

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney asserts that applicant's mark, when used in connection with the recited services, so resembles the mark **QUAKER STEAK & LUBE** (*in standard character format*), which is registered for "restaurant services"² and the mark **QUAKER STEAK & WINGS** (*in standard character format*), also registered for "restaurant services,"³ as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the case. We reverse the refusal to register.

The Trademark Examining Attorney argues that the word "Quaker" is the dominant term in all of these marks inasmuch as it is the first word in each mark, it is a term that has not been registered by third parties on the Federal Trademark Register in connection with restaurant services, and it is a completely arbitrary term as applied to establishments

² Registration No. 1130163 issued on January 29, 1980, claiming first use anywhere and first use in commerce at least as early as February 1974; renewed.

³ Registration No. 2083548 issued on July 29, 1997, claiming first use anywhere and first use in commerce at least as early as November 17, 1991; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. The term "Steak & Wings" is disclaimed apart from the mark as shown.

providing foods and beverages. Moreover, she argues that the services herein are very closely related.

Applicant, in turn, places a great deal of emphasis on the arguably unique connotation of registrant's marks, when used in conjunction with an automotive-themed restaurant as a nostalgic take-off on **QUAKER STATE** motor oil and gas stations. Applicant also contends that the Trademark Examining Attorney has failed to give any weight to the declarations of applicant's consumers and its marketing expert.

Our determination under Section 2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities or differences between the marks and the relationship of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The Services

We turn first to the du Pont factor focusing on the relationship of the services. As argued by the Trademark Examining Attorney, the involved services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-596 (TTAB 1978).

On this factor, applicant argues that it is "a coffee shop that specializes in coffee and is not a restaurant that provides meals serving a broad range of food." Applicant's appeal brief at p. 7. However, it is clear from the record that both applicant and registrant market their services to consumers who are seeking physical sustenance. We find it reasonable to presume that registrant's "restaurant services" include, *inter alia*, serving coffee and baked goods. Conversely, successful coffee shops in this country rarely limit their activities to the sale of coffee alone, but

typically also sell bakery items like scones and muffins, or even sandwiches,⁴ making them alternative sources for the type of fare offered in carry-out, fast food, delicatessen or casual-dining restaurants. Cf. Marriott-Hot Shoppes, Inc. v. McKee Baking Company, 159 USPQ 685, 686 (TTAB 1968) [baked goods related to restaurant services].

Moreover, the Trademark Examining Attorney included a sampling from the X-SEARCH database of third-party registrations showing the same mark registered in connection with restaurant services and coffee shop services. We have found that these printouts have probative value to the extent that they serve to suggest that the services listed therein, namely restaurant services and coffee shop services, are of a kind that may emanate from a single source. See In re Infinity Broad. Corp., 60 USPQ2d 1214, 1217-1218 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

Furthermore, as noted by the Trademark Examining Attorney, in applicant's original application papers of

⁴ According to dictionary entries placed into the record by the Trademark Examining Attorney, a "coffee shop" is defined as a "small restaurant in which light meals are served." *The American Heritage® Dictionary of the English Language, New College Edition* (1976); see also online version of *Merriam Webster Online Dictionary, Tenth Edition*.

October 11, 2004, applicant recited its services as "coffee shop **restaurant** services" (**emphasis** supplied).

For all these reasons, we conclude that the relationship between a "coffee shop" and "restaurant" is apparent, and this du Pont factor favors the position of the Trademark Examining Attorney.

Nonetheless, applicant argues that it has proffered declarations from twenty-one consumers who buy and drink coffee in applicant's **QUAKER COFFEE** shop, and who also frequent restaurants. Evidently applicant solicited these form declarations primarily at the Wynnewood Train Station from commuters to and from Philadelphia during a twelve-day period in July 2005. Applicant submitted ten form declarations containing the following identical wording:

2. I am a customer who buys and drinks coffee in a Quaker Coffee shop. I am also a customer of restaurants and supermarkets.
3. I recognize that coffee shop services are distinguishable from restaurant services. Coffee shops specialize in coffee. Restaurants provide meals, serving a broad range of food.
4. I do not believe that the source of restaurant services would be the same source as coffee services.
5. Quaker Coffee is different and distinguishable from Quaker Steak & Lube or Quaker Steak & Wings.
6. I do not believe that the source of restaurant services under either of the names, "Quaker Steak & Lube" or "Quaker Steak & Wings", would be the same source as coffee shop services under the name of "Quaker Coffee".

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⁵ Eleven additional examples of a second form declaration clarify that consumers recognize differences among various third-party **QUAKER** marks for a variety of different beverages:

2. I am a customer who buys and drinks coffee in a Quaker Coffee shop. I am also a customer of restaurants and supermarkets.
3. Quaker Coffee is different and distinguishable from Quaker.

From these form declarations, applicant concludes that consumers "recognize that coffee shops specialize in coffee, and restaurants provide meals serving a broad range of food."

Admittedly, the Trademark Examining Attorney has not produced a consumer survey rebutting this claim. Nor is she required to do so, inasmuch as the question before us is not whether consumers know the difference between a coffee shop and a full-service restaurant. Rather, if these prospective purchasers were to encounter these somewhat different services under the same or similar marks, the issue is whether it would be reasonable for them to assume, mistakenly, that they originate from the same source. In re A and S Corp., 194 USPQ 304 (TTAB 1977).

Accordingly, these consumer declarations do not have a great deal of probative value on the question before us. Applicant has not shared with us the circumstances under which the declarations were solicited. Based on when the declarations were taken and on their content, we suspect that this particular, extremely narrow slice of consumer opinions

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| <ol style="list-style-type: none">4. I do not believe that bottled water, sold under the trademark Quaker, and coffee, sold under the trademark Quaker Coffee, would originate from the same source. Coffee and bottled water are different.5. I do not believe that dairy based beverages, sold under the trademark Quaker, and coffee, sold under the trademark Quaker Coffee, would originate from the same source. Coffee and dairy based beverages are different.6. I do not believe that oat-based beverages, sold under the trademark Quaker, and coffee, sold under the trademark Quaker Coffee, would originate from the same source. Coffee and oat based beverages are different. |
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may well have been guided as much by the prosecution of this application as by any earlier perceptions of applicant's customers. The existence of a relatively small number of people willing to sign a form declaration is simply insufficient for us to find that the average consumer in the Commonwealth of Pennsylvania, for example, will conclude that the purveyor of scones and coffee would never be the same as the provider of restaurant services. These form statements, undoubtedly prepared by counsel, comprise legal conclusions, and do not demonstrate factually that the source of restaurant services would be different from the source of coffee shop services. Clearly, there is nothing probative in the record to show how these purchasers would have come to these shared conclusions that seem antithetical to the commercial patterns suggested by the many third-party registrations on the federal register - as well as to common sense.

As to applicant's expert, based upon his credentials, we find that Mr. Donald J. Sommerville qualifies as an expert with respect to the marketing of food items. However, in reviewing his declaration, we have not considered him to be an expert in trademark law, and any of his opinions relating to the ultimate question of law in this case has been given no weight. *See, e.g., Harjo v. Pro-Football Inc.*, 50 USPQ2d

1705, 1718 (TTAB 1999); and Medtronic, Inc. v. Medical Devices, Inc., 204 USPQ 317, 325 (TTAB 1979).

Channels of Trade and Conditions of Sale

In order to demonstrate differences in the respective services and the conditions of their sale, applicant has stressed repeatedly the unique way in which the Quaker Steak & Lube chain of restaurants markets itself:

The restaurants are all tied into a motor vehicle concept. The motor vehicle items show a gas pump outside the restaurant. The web page refers to "Lube Racing" and shows white auto gas stations. It implies that Quaker Steak is using a former Quaker State oil and gasoline service station. The restaurants are intended to look like a gas station. In particular, the gas station that is being mimicked is the old "Quaker State" Motor Oil & Gas Station. The gas station was white, so is the restaurant.



The actual web site ... shows the same white lettering on a green background as the lettering on an old can of motor oil by Quaker State Motor Oil.⁶

⁶ Applicant's appeal brief, pp. 8 - 9.



Welcome To Quaker Steak & Lube,
America's #1 Motorsports-Themed
Family Restaurant. ⁷

Applicant also introduced into the record copies of several trademark registrations owned by Quaker State Oil Company for the mark **QUAKER STATE** registered in connection with, *inter alia*, lubricating oils, and a recently expired registration for its abandoned service stations:

**QUAKER
STATE**

for "lubricating oils and greases, fuel and illuminating oils, road oils, blended and straight refined gasoline and wax-namely, paraffin refined from paraffin crude petroleum" in International Class 4;⁸ and

QUAKER STATE

for "automotive service station services" in International Class 37.⁹

Furthermore, applicant cites to "The Lube Story" located on registrant's website:

The year was 1974, the country was in the midst of its first gas crisis and the price of

⁷ Registrant's website is at www.lubewings.com, applicant's exhibit 1-6.

⁸ Registration No. 0336158 issued on June 30, 1936; third renewal.

⁹ Registration No. 0976156 issued on January 1, 1974; now expired.

gasoline was skyrocketing. Speed limits were soon to be set at 55 M.P.H. nationwide, gas stations were closing and the call went out to develop cars that got better mileage ..., but what to do with those old gas stations and high-powered muscle cars?

Enter George "Jig" Warren III and Gary "Moe" Meszaros to save the day. Well maybe not necessarily the entire day, but certainly one old gas station and a bunch of muscle cars, by turning the abandoned station into the Quaker Steak & Lube, a "Cook Your Own Steak" restaurant. They gave the cars, which included a 1936 Chevrolet, frozen in time on the original hydraulic grease rack, a loving home. The concept was so successful that Jig and Moe were able to hire a cook so their customers no longer had to do their own cooking and the menu was expanded to include a variety of family friendly foods, including chicken wings.

Of course, one problem with applicant's argument is that there are no limitations in either applicant's or the registrant's recitations as to the channels of trade, the décor of the eating establishments or their respective classes of customers. The Trademark Examining Attorney makes the point that the issue of likelihood of confusion between an applied-for mark and registered marks must be determined on the basis of the services as they are recited in the involved application and cited registrations, not on the basis of whatever the extrinsic evidence may show. See In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993); and Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); Paula Payne

Products Company v. Johnson Publishing Company, 177 USPQ 76 (CCPA 1973).

Additionally, we find that items such as a cup of coffee or an order of wings are inexpensive, often purchased on impulse during a road trip, without a great deal of care.

Where the services in a cited registration are broadly described and there are no limitations in the recitation of services as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all services of the nature and type described, that the identified services move in all channels of trade that would be normal for such services, and that the services would be offered to all potential customers. The Kalart Company, Inc. v. The Camera-Mart, Inc. 258 F.2d 956, 119 USPQ 139 (CCPA 1958). Accordingly, both applicant's and registrant's services must be deemed to be rendered in all channels of trade that are appropriate for such services, and to be purchased by all classes of ordinary purchasers of food, including steaks, wings, scones and muffins, and of beverages, including coffee and beer. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991) [women's shoes are complementary to women's outerwear, and there are no restrictions on registrant's channels of trade]; and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981) ["geriatric preparation" is considered

to encompass "therapeutic soak for arthritic hands and feet"]. Hence, the related du Pont factors focusing on the channels of trade and conditions of sale also favor a finding of likelihood of confusion.

The Marks

We turn then to the du Pont factor focused on the similarity of the marks in their entireties. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The Trademark Examining Attorney argues that applicant's mark is highly similar to the registered marks, at least as to sound, meaning and commercial impression.

As to the appearance of the respective marks, we should note at the outset that all these marks are standard character format drawings. Although the images from registrant's website show white letters on green background, any depiction of color within or surrounding the words as they are actually used on the Internet or exterior signage are irrelevant for our purposes. Hence, we are comparing applicant's mark, **QUAKER COFFEE** (*in standard character format*), with registrant's marks, **QUAKER STEAK & LUBE** and **QUAKER STEAK & WINGS** (*both in standard character format*). As noted by the Trademark Examining Attorney, applicant's and registrant's

marks begin with the word "Quaker." The first word visually and the first two syllables phonetically are identical. While applicant's mark ends with the single, generic word "Coffee," both of registrant's marks end up with a pair of words joined with an ampersand, none of which looks or sounds like the word "coffee." Registrant's marks thus create somewhat of a visual difference, as well as adding a fifth syllable to the aural perceptions of registrant's marks.

The Trademark Examining Attorney consistently argues that the dominant portion of applicant's mark and registrant's marks is the identical, leading word, QUAKER. In her brief, she points out that the dominance of the term QUAKER is reinforced by applicant's exhibits of registrant's website promotions. Specifically, she contends that inasmuch as the term QUAKER appears by itself, in larger letters and above the words STEAK & LUBE, these ads actually undercut applicant's theory that the term QUAKER STEAK will necessarily be perceived as a combined term.

In turning to the meaning or connotation of applicant's mark, the record shows that applicant herein set up a bakery shop and coffee shop in a commuter train station on the Main Line north of Philadelphia and Germantown. Applicant's positioning in that niche market supports the position of the Trademark Examining Attorney, that when consumers see the

mark **QUAKER COFFEE**, they might well create a mental association with the Society of Friends in view of Philadelphia's deep Quaker roots.

Moreover, applicant's logo shows a child in what may well be seen as a traditional Quaker outfit - dark pants, a long-sleeved shirt with suspenders and a broad-brimmed hat - riding away on his bike with upraised hands free of the handlebars.



However, it is on the connotation of registrant's mark that applicant and the Trademark Examining Attorney take decidedly different approaches. The Trademark Examining Attorney argues that the term QUAKER alone is the dominant term in the registered marks. She concludes, therefore, that " ... the entire marks in both cited registrations give the impression of either 'steak and wings' or 'steak and lube' provided by a Quaker, *i.e.*, a member of the Society of Friends." Trademark Examining Attorney's appeal brief, unnumbered page 7.

By contrast, applicant claims in its reply brief that " ... registrant would likely be surprised and disappointed if this were the impression Registrant was giving to the consumer by its marks." Applicant's reply brief, p. 2.

Referring again to registrant's website, applicant argues that registrant with its choice of **QUAKER STEAK** in both of its marks is quite intentionally creating a play on words with the mark for oil and lube, **QUAKER STATE**. It is no coincidence, applicant argues, that abandoned **QUAKER STATE** gas stations in western Pennsylvania, Ohio and surrounding areas, upon being vacated, were transformed into **QUAKER STEAK & LUBE** restaurants. Moreover, all of the restaurants in this chain have been promoted with an automotive- and motorcycle-themed atmosphere that continues to play off the nostalgia of **QUAKER STATE** gas and lube stations. Applicant argues that with this theme and unavoidable play on words, registrant wants consumers to recall or recognize the restaurants as being **QUAKER STEAK**, and not just **QUAKER**.

If applicant is correct, then clearly this is quite a different connotation than that proffered by the Trademark Examining Attorney, namely, that "consumers are likely to recall or recommend the establishment as just '**QUAKER**'." Trademark Examining Attorney's appeal brief, unnumbered p. 6.

On this critical point, we agree with applicant. It is unmistakable that to the average consumer, the overall commercial impression of registrant's marks will be of **QUAKER STEAK** as a play on **QUAKER STATE**. Hence, this two-

word term (a "thing") is the dominant portion of registrant's marks, and not just the initial term, "Quaker," alone (a "person," "group" or "lifestyle").

Applicant continues:

The Examining Attorney appears to be using the "Quaker-as-the-dominant-term" argument as a way to argue connotation of the Registrant's marks. The connotation the Examining Attorney is suggesting for the Registrant's marks is one of a Quaker providing steak, wings and a lube. That is not the connotation. Applicant's position is that the connotation of the Registrant's marks is a restaurant serving steaks and wings with an automotive theme ...

If two conflicting marks each have an aura of suggestion but each suggest something different to the buyer, this tends to indicate a lack of likelihood of confusion. Differences of connotation and meaning are key factors in determining likelihood of confusion.

Applicant also pointed out that, consistent with usage of "The Lube Story" on registrant's website, registrant has obtained a separate federal trademark registration for **THE LUBE**.¹⁰ Hence, at least as to the cited mark for **QUAKER STEAK & LUBE**, the source identifying significance of the arbitrary word "Lube" (for restaurant services) cannot be so easily dismissed from the Trademark Examining Attorney's likelihood of confusion considerations.

¹⁰ Registration No. 2880832 issued to Quaker Steak & Lube Franchising Corporation on September 7, 2004 for "restaurant services and take-out restaurant services" claiming use in commerce since at least as early as January 1988.

Certainly, upon reflection, there are a number of areas of trademark law where contextual, secondary connotations change the results of a registrability decision.

For example, an identical term may take on very different meanings as applied to related goods, overcoming a likelihood of confusion. See In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) [the Board held that the mark PLAYERS on men's underwear and men's shoes would not result in consumer confusion as to the source of the goods inasmuch as "'PLAYERS' for shoes implies a fit, style, color and durability adapted to outdoor activities. 'PLAYERS' for men's underwear implies something else, primarily indoors in nature."].

A second analogous pattern under the Lanham Act occurs when a newly-coined combination of descriptive components creates a readily-understood, alternative meaning. Such a mark is known to comprise a "double entendre." A double entendre will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the involved goods or services. See In re Kraft, Inc., 218 USPQ 571, 573 (TTAB 1983) [the Board found inappropriate a requirement for a disclaimer of the word LIGHT apart from the mark LIGHT N' LIVELY for reduced calorie mayonnaise: "The mark LIGHT N' LIVELY as a whole has a

suggestive significance which is distinctly different from the merely descriptive significance of the term LIGHT *per se*. That is, the merely descriptive significance of the term LIGHT is lost in the mark as a whole. Moreover, the expression as a whole has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole."]. See also In re Symbra'ette, Inc., 189 USPQ 448 (TTAB 1975) [SHEER ELEGANCE for panty hose held to be a registrable unitary expression; thus, no disclaimer of SHEER considered necessary]; In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) [SUGAR & SPICE for bakery products]; and In re National Tea Co., 144 USPQ 286 (TTAB 1965) [NO BONES ABOUT IT for fresh pre-cooked ham]. In each of these cases, the secondary interpretations that make each expression a double entendre consist of an association that members of the public would make quite readily.

Similarly, we conclude on this record, that members of the public who become acquainted with registrant's services would readily make an association between its **QUAKER STEAK** marks and **QUAKER STATE** oils and lubes.

Inasmuch as consumers are accustomed to seeking out themed restaurants and coffee shops featuring a variety of specific cuisines, atmospheres, décors and/or modes of

service, we find that applicant's **QUAKER COFFEE** mark, as applied to its coffee shop services, will suggest the historically significant Society of Friends of southeastern Pennsylvania. This connotation is underscored by the logo of a Quaker boy on his bicycle that applicant often uses with its service mark. By contrast, the **QUAKER STEAK** ... marks project a significantly different commercial impression by evoking the **QUAKER STATE** gas stations and associated oil and lube products.

Accordingly, notwithstanding the phonetic and visual similarities in the respective marks and the closely-related nature of applicant's and registrant's services, we find on the record before us, in light of the significant differences in connotation, that applicant's mark is sufficiently distinguishable in commercial impression from registrant's marks such that confusion as to origin or affiliation is not likely. See *In re British Bulldog, Ltd.*, *supra*.

Decision: The refusal to register under Section 2(d) of the Lanham Act is hereby reversed. A Notice of Allowance will issue to applicant in due course.