

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*In re Bayou Grande Coffee Roasting Company*

Serial No. 90549985

Nicholas Pfeifer of Smith & Hopen PA,  
for Bayou Grande Coffee Roasting Company.

Laura D. Golden, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

Before Lykos, English and Casagrande,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On February 26, 2021, Bayou Grande Coffee Roasting Company (“Applicant”) filed an application to register on the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), the standard character mark KAHWA for “Cafés; Coffee shops” in International Class 43.<sup>1</sup> The application was accompanied by the following

<sup>1</sup> Application Serial No. 90549985, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging March 13, 2008 as the date of first use anywhere and in commerce.

Page references to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. References to the briefs on appeal refer to the Board’s TTABVue docket system. *See Turdin v. Trilobite, Ltd.*,

statement to support Applicant's claim of acquired distinctiveness:<sup>2</sup>

The mark has become distinctive of the [services] through the applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

Applicant did not submit a translation statement, but did claim ownership of Registration No. 6130452 for the composite mark KAHWA COFFEE ROASTING displayed below on the Principal Register for "Coffee; Coffee based beverages; Coffee beans; Ground coffee beans; Roasted coffee beans" in International Class 30 and

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109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

<sup>2</sup> Typically under this procedural posture the Board would construe Applicant's seeking registration under Section 2(f) as originally filed as constituting a concession that the mark is, at a minimum, merely descriptive of the identified services under Trademark Act Section 2(e)(1). *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) ("Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive.") (citation omitted). Here, however, during prosecution, Applicant made clear that its claim of acquired distinctiveness was in the alternative, and both the Examining Attorney and Applicant have treated it as such in their briefs. *See* Applicant's Brief, pp. 7-8; 4 TTABVUE 8-9; Examining Attorney's Brief, 6 TTABVUE 3. We therefore find that Applicant has not conceded that its mark is merely descriptive for the services. *See In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1952 (TTAB 2018) (Board considered applicant's statements during prosecution and in appeal brief to find that amendment to the Supplemental Register was made in the alternative, meaning that applicant had not conceded mere descriptiveness).

“Coffee shops” in International Class 43:<sup>3</sup>



In the prior registration, Applicant made the following statement: “The English translation of the word ‘KAHWA’ in the mark is ‘coffee’.” Applicant also disclaimed the wording KAHWA COFFEE ROASTING apart from the mark as shown.

The Trademark Examining Attorney has refused registration on the grounds that Applicant’s proposed mark is generic for the identified services under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051-53, 1127; and alternatively, that Applicant’s mark is merely descriptive of the identified services under Trademark

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<sup>3</sup> Registered on August 18, 2020. The description of the mark is as follows: “The mark consists of stylized word ‘KAHWA’ in golden brown above the words ‘COFFEE ROASTING’ in golden brown, with a dark brown stylized coffee bean in the background and a darker shade of brown as the background which has a white border with a darker brown border on the outside.” The colors golden brown, dark brown, brown and white are claimed as a feature of the mark.

Because only the Examining Attorney referred to the registration in his brief, and Applicant did not discuss the prior registration at all, either in its brief or during prosecution, we do not treat it as if it is part of the record. *Cf. In re Int’l Watchman, Inc.*, 2021 USPQ2d 1171, at \*29 n.49 (TTAB 2021) (Board treated applicant’s prior registration as if of record because examining attorney and applicant referred to it in briefing the appeal); *In re Olin Corp.*, 124 USPQ2d 1327, 1335 n.22 (TTAB 2017) ((because applicant addressed one of its registrations that was not of record and the examining attorney addressed both of applicant’s registrations in her brief, and neither objected to the discussion of the registrations, Board treated both registrations as though they were of record). The same holds true for Applicant’s previously registered mark KAHWA on the Supplemental Register (Reg. No. 6303153) for “Cafés; Coffee shops” in International Class 43 also discussed only in the Examining Attorney’s brief.

Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and that Applicant has failed to meet its burden of proving that its applied-for mark has acquired distinctiveness within the meaning of Section 2(f).<sup>4</sup> The Examining Attorney also refused to register Applicant's mark because Applicant did not comply with the requirement under Trademark Rule 2.32(a)(9), 37 C.F.R. § 2.32(a)(9), of submitting a translation of KAHWA as meaning "coffee" in English based on a transliteration from Arabic.

Applicant timely filed a notice of appeal and request for reconsideration which was denied. The appeal is fully briefed.

For the reasons explained below, we affirm the genericness refusal under Trademark Act Sections 1, 2, 3, and 45. We also affirm the alternate refusal that Applicant's proposed mark is merely descriptive under Section 2(e)(1) and its showing under Section 2(f) is insufficient to establish acquired distinctiveness. We do not reach the refusal based on the translation requirement under Trademark Rule 2.32(a)(9).

#### I. Translation Requirement and Doctrine of Foreign Equivalents

Both Applicant and the Examining Attorney devote the majority of their briefs to addressing the issue of whether KAHWA constitutes an English letter transliteration of the Arabic word for "coffee," and whether the doctrine of foreign equivalents applies in this case. However, as explained in more detail below, some of the evidence submitted by both the Examining Attorney and Applicant also shows a well-

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<sup>4</sup> The Examining Attorney withdrew the specimen refusal in the September 6, 2022 Denial of the Request for Reconsideration.

recognized, alternative meaning to “kahwa” as a type of green tea drink originating from Kashmir. By way of illustration, Applicant submitted the following chart reproduced below in order to argue that U.S. consumers will not recognize “kahwa” as meaning “coffee” in Arabic. The chart summarizes the first four pages of Google® search engine results for the term “kahwa” showing no reference to “kahwa” as the Arabic word for “coffee” but instead references to Applicant’s coffee and coffee shops under the applied-for trademark KAHWA and references to “kahwa” as a type of Kashmiri green tea beverage.<sup>5</sup>

Exhibit	Website	Description
5	kahwacoffee.com	official website for Applicant’s KAHWA coffee
6	en.wikipedia.org	online information site with definition, preparation and history of kahwa tea
7	whiskaffair.com	food and recipe blog with recipe for kahwa tea
8	m.tarladalal.com	blog with recipe for kahwa tea
9	youtube.com	video sharing website with recipe video for kahwa tea
10	yummefy.com	food recipe source with recipe for kahwa tea
11	facebook.com	social media page for Applicant’s KAHWA coffee
12	vegrecipesofindia.com	food blog with article and recipe for kahwa tea
13	grubhub.com	online food ordering service selling Applicant’s KAHWA coffee
14	amazon.com	e-commerce company selling Applicant’s KAHWA coffee
15	youtube.com	video sharing website with recipe video for kahwa tea
16	instagram.com	social media page for Applicant’s KAHWA coffee
17	amazon.com	e-commerce company selling tea
18	ubereats.com	online food ordering service selling Applicant’s KAHWA coffee
19	mapleandmarigold.com	blog with article on kahwa tea
20	apps.apple.com	digital distribution service offering a mobile app for Applicant
21	food.ndtv.com	food news source with article on health benefits of kahwa tea
22	yelp.com	online consumer information resource profile for Applicant’s KAHWA coffee shop
23	boadiceaperfume.com	retail website selling kahwa perfume
24	twitter.com	social media page for Applicant’s KAHWA coffee
25	cookclickndevour.com	recipe blog with recipe for kahwa tea
26	indianexpress.com	blog with article on kahwa tea
27	moustachescapes.com	blog with article on kahwa tea
28	play.google.com	digital distribution service offering a mobile app for Applicant
29	harney.com	retail website selling kahwa tea
30	ilovetheburg.com	local news and attractions source with article about Applicant’s KAHWA coffee
31	tampaairport.com	local airport website with information about Applicant’s KAHWA coffee shop
32	vahdamteas.com	retail website selling kahwa tea
33	fragrantica.com	retail website selling kahwa perfume
34	bebodywise.com	blog with article on health benefits of kahwa tea
35	tarladalal.com	blog with recipe for kahwa tea
36	recipes.timesofindia.com	food recipe source with recipe for kahwa tea
37	foodche.com	food recipe source with recipe for kahwa tea
38	healthyandhygiene.com	health and hygiene blog with article on health benefits of kahwa tea
39	definitions.net	dictionary website with definition and translation of kahwa
40	paradisadv.com	advertising page for Applicant’s KAHWA coffee
41	thequint.com	blog with article on kahwa tea
42	paradisefl.com	local news source with article on Applicant’s KAHWA coffee

<sup>5</sup> February 14, 2022 Response to Office Action at TSDR 3-4 (highlighting added).

Discussing this evidence in its brief, Applicant argued that this shows that one meaning of KAHWA “to American purchasers” is “a traditional preparation of green tea.”<sup>6</sup> The Examining Attorney also submitted evidence of this alternative meaning of “kahwa,” and in some instances, from the exact same websites as Applicant.<sup>7</sup>

Evidence properly made of record by either the examining attorney or by the applicant may be used for any permissible purpose. *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*10 n.4 (TTAB 2020); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 1208 (2023). In addition, “[t]he Board need not find that the examining attorney’s rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale.” TBMP § 1217 (citing *In re D.B. Kaplan Delicatessen*, 225 USPQ 342, 342 n.2 (TTAB 1985)).

With this other meaning of “kahwa” in mind, we exercise our discretion not to decide the translation requirement and instead proceed with our analysis of the remaining refusals. *See, e.g., In re La. Fish Fry Prods.*, 797 F.3d 1332, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (“We do not need to reach the Board’s genericness determination because we hold that substantial evidence supports the Board’s determination that Louisiana Fish Fry failed to show that FISH FRY PRODUCTS has acquired distinctiveness.”).

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<sup>6</sup> Appeal Brief, 4 TTABVUE 19; *see also id.* at 20 (“extensive evidence that establishes that the American purchasing public is familiar with the word ‘kahwa’ as either Bayou’s coffee shops and coffee products or as a specialized Central Asian green tea beverage”).

<sup>7</sup> *See* Section II.C. *infra*.

## II. Genericness Refusal

Any term that the relevant public uses or understands to refer to the genus of goods or services, or a key aspect or central focus or subcategory of the genus, is generic. *Royal Crown Co., Inc. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046-47 (Fed. Cir. 2018). “[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests.*, 823 F.3d 594, 118 USPQ2d 1632, 1638 (Fed. Cir. 2016) (holding CHURRASCOS, a word that is generic for a type of grilled meat, to be generic for restaurant services because it referred to a key aspect of those services). “A generic name—the name of a class of products or services—is ineligible for federal trademark registration.” *USPTO v. Booking.com B.V.*, 140 S. Ct. 2298, 2020 USPQ2d 10729, at \*2 (2020). “Because generic terms ‘are by definition incapable of indicating a particular source of the goods or services,’ they cannot be registered as trademarks.” *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001)); *see also In re Cordua Rests.*, 18 USPQ2d at 1634.

“The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *Princeton Vanguard*, 114 USPQ2d at 1830 (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). Making this determination involves a two-step inquiry:

First, what is the genus of goods or services at issue?

Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

*Marvin Ginn*, 228 USPQ at 530; *see also Princeton Vanguard*, 114 USPQ2d at 1829 (“there is only one legal standard for genericness: the two-part test set forth in *Marvin Ginn*”).

Whether a particular term is generic is a question of fact. *In re Cordua Rests.*, 118 USPQ2d at 1634. “Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Royal Crown*, 127 USPQ2d at 1046 (quoting *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); *see also In re Cordua Rests.*, 118 USPQ2d at 1634; *Princeton Vanguard*, 114 USPQ2d at 1830; *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (finding third-party websites competent sources for determining what the relevant public understands mark to mean); *see also Booking.com*, 2020 USPQ2d 10729, at \*7 n.6 (“Evidence informing [a genericness] inquiry can include not only consumer surveys, but also dictionaries, usage by consumers and competitors, and any other source of evidence bearing on how consumers perceive a term’s meaning.”). Competitor use also is probative on the issue of genericness. *See, e.g., Booking.com*, 2020 USPQ2d 10729, at \*9 (evidence of genericness “can include ... usage by ... competitors”).



A. What is the genus?

We begin by agreeing with the Examining Attorney that the genus is adequately defined by Applicant's identification of services, "Cafés; Coffee shops." *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of services set forth in the [application or] certificate of registration."); *see also In re Cordua Rests.*, 118 USPQ2d at 1636.

As the U.S. Court of Appeals for the Federal Circuit has explained, "a term can be generic for a genus of goods or services if the relevant public ... understands the term to refer to a key aspect of that genus—e.g., a key good that characterizes a particular genus of retail services." *In re Cordua Rests.*, 118 USPQ2d at 1637. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE defines a "coffee shop" as "a small restaurant in which coffee and light meals are served."<sup>8</sup> THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, defines a "café" as "a restaurant serving coffee and other beverages along with baked goods or light meals."<sup>9</sup> Likewise, THE MERRIAM-WEBSTER DICTIONARY defines "café" as "a usually small and informal establishment serving various refreshments (such as coffee)."<sup>10</sup>

The record further shows that both cafés and coffee shops sell not only coffee but other beverages such as tea:<sup>11</sup>

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<sup>8</sup> September 21, 2021 Office Action at TSDR 8.

<sup>9</sup> September 21, 2021 Office Action at TSDR 9.

<sup>10</sup> May 11, 2022 Office Action at TSDR 60.

<sup>11</sup> In view of Applicant's failure to object, the Board has considered website and social media evidence submitted by the Examining Attorney without the URL or access date. *See In re I-*

French Truck Coffee in New Orleans, Louisiana offers coffee and chai, a type of tea;<sup>12</sup>

Tryst in Washington D.C. offers a variety of barista made teas;<sup>13</sup> and

Starbucks, a national chain, offers a variety of barista made coffee drinks as well as black, chai and green teas.<sup>14</sup>

Even Applicant's own cafés and coffee shops located at Kahwa Coffee West in St. Petersburg, Florida and Kahwa Coffee (Henderson Blvd) in Tampa, Florida offer tea drinks such as "Hot Tea," "Iced Tea," "Chai Tea Latte" and "Iced Tea Latte."<sup>15</sup> Indeed, in an article entitled "Kahwa Coffee debuting new drive-thru in Dunedin" posted on That's So Tampa.com (June 7, 2021), the author Andrew Harlin noted that Applicant offers "your favorite drinks such as lattes, cappuccino, cold brew (**and their pretty famous) chai tea latte.**" (emphasis added).<sup>16</sup>

Thus, the genus is defined by the identification, cafés and coffee shops, and the record shows that a key aspect of coffee shop and café services is the serving of tea beverages. *See, e.g., In re Cordua Rests.*, 118 USPQ2d at 1637-38 (a mark that identifies a product that is a "key aspect" of the services is generic for the service).

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*Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018) ("Accordingly, we have recently held that to properly make such website evidence of record, a trademark examining attorney must include the URL and the date when the material was accessed, and that if an examining attorney fails to do so, and the applicant objects, the material will not be considered."); *accord In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1586-87 (TTAB 2018) (by failing to object to Internet excerpts submitted by the examining attorney that did not include URLs and access dates, applicant waived its objections to the submission of those websites).

<sup>12</sup> May 11, 2022 Office Action at TSDR 44.

<sup>13</sup> May 11, 2022 Office Action at TSDR 64-65.

<sup>14</sup> May 11, 2022 Office Action at TSDR 66.

<sup>15</sup> February 14, 2022 Response to Office Action at TSDR 153-157, 189-194, 378, 396-401.

<sup>16</sup> February 14, 2022 Response to Office Action at TSDR 469 and 700.

B. Who is the relevant public?

Next we determine the relevant public. In the context of a genericness inquiry, the relevant public is “the actual or potential purchasers of the services.” *Loglan Inst. Inc. v. Logical Language Grp., Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992) (quoting *Magic Wand*, 19 USPQ2d at 1553).

Here, because there are no restrictions on or limitations to the channels of trade or classes of consumers in the application on appeal, the relevant public comprises ordinary consumers who frequent cafés and coffee shops. *See In re Mecca Grade Growers*, 125 USPQ2d at 1957 (Board took into account that the identification contained no restrictions as to trade channels or end users in determining the relevant public).

C. Does the relevant public understand KAHWA primarily to refer to the genus or subgenus of café and coffee shop services?

We now turn to the question of whether the designation KAHWA is understood by the relevant purchasing public as primarily referring to cafés or coffee shops or as a source-identifier for Applicant’s services as Applicant contends. As noted above, a term may be generic for a genus or subgenus of services if the relevant public understands the term to refer to a key aspect of that genus, such as a key product that characterizes a particular genus of retail services or identifies a category of goods or services within the genus. *See In re Cordua Rests.*, 118 USPQ2d at 1637-38 (finding substantial evidence supported the Board’s conclusion that CHURRASCOS was generic because it referred to a key aspect of restaurant services featuring grilled meat as one of its menu items);. If a term is generic for one or more of the services

listed in an application, it is treated as being generic for an entire class for which registration is sought. *See In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

The following excerpts from third-party websites and online articles show that KAHWA is a type of green tea drink made with spices originating from Kashmir that has gained renown in the United States:

Whisk Affair: Helping People Experience Food describes “Kahwa” as “a Kashmiri tea flavored with cinnamon, cardamom and saffron.” The article recommends brands of Kahwa tea beverages available for purchase in the United States and provides a recipe for kahwa to make at home.<sup>17</sup>

Dassana’s Veg Recipes entry for Kahwa/Kashmiri Kahwa (last updated August 9, 2019) describes “Kahwa” as a “fragrant mild green tea made with whole spices, saffron, and almonds and originally from the Kashmiri cuisine.” The article provides a recipe for making kahwa tea and references premade kahwa tea beverages available for purchase in markets.<sup>18</sup>

Moustache Escapes “Kahwa: A Taste of Kashmir’s Green Tea” (published on June 8, 2021) refers to Kahwa as “the Green Tea of Kashmir.”<sup>19</sup>

Maple Marigold provides a “Kashmiri kahwa recipe using saffron, cardamom, and cinnamon.”<sup>20</sup>

Cook, Click and Devoured (published January 19, 2021) describes “Kahwa” as “a soothing Kashmiri tea with green leaves, whole spices, saffron, almonds and dried rose

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<sup>17</sup> May 11, 2022 Office Action at TSDR 46 and Applicant’s February 14, 2022 Response to Office Action at TSDR 83-98.

<sup>18</sup> May 11, 2022 Office Action at TSDR 47 and Applicant’s February 14, 2022 Response to Office Action at TSDR 130-152.

<sup>19</sup> May 11, 2022 Office Action at TSDR 48.

<sup>20</sup> May 11, 2022 Office Action at TSDR 52-54.

petals.”<sup>21</sup> It mentions that Kahwa tea bags can be purchased in stores or made at home.

Harvey & Sons manufactures a kahwa tea under the brand “Kangra Kahwa,”<sup>22</sup> inspired by the founder’s travels to the Himalayas where he was served “kahwa.”

Vahdam manufactures a kahwa tea under the brand name “Detox Kahwa Tea” and describes the tea on the packaging as “active green tea with spices and rock salt.”<sup>23</sup>

The blog Be Body Wise posted an article by Upsana Mani (December 7 2020) entitled “5 Benefits of Kahwa Tea – Health Benefits” describing “Kahwa Tea” as “Kashmiri green tea leaves, whole spices like cardamom, cinnamon and cloves, nuts and saffron and has astounding benefits that are goods for skin and health” along with a recipe.<sup>24</sup>

Yummefy provides a video and recipe on how to make Kashmiri Kahwa tea. It describes Kahwa as made with Kashmiri green tea and “fragrant spices like cinnamon, cardamom, and saffron, along with dried rose petals.”<sup>25</sup>

The Quint describes “kahwa” as “a type of green tea infused with the scent of cardamom pods, cinnamon barks and saffron, that is later crowned with almonds.”<sup>26</sup>

A search for “kahwa” on Amazon shows that pre-packaged “kahwa” tea beverages are offered for sale online to U.S. consumers by numerous tea manufacturers such

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<sup>21</sup> May 11, 2022 Office Action at TSDR 55-59 and February 14, 2022 Response to Office Action at TSDR 260-261.

<sup>22</sup> February 14, 2022 Response to Office Action at TSDR 272.

<sup>23</sup> February 14, 2022 Response to Office Action at TSDR 282.

<sup>24</sup> February 14, 2022 Response to Office Action at TSDR 295.

<sup>25</sup> February 14, 2022 Response to Office Action at TSDR 122.

<sup>26</sup> February 14, 2022 Response to Office Action at TSDR 334.

Vahdam, Girnar, Tea Heaven, Teamonk, Vital Tea, NatureVibe Botanicals, Octavius, Al-Aqeeq, Orajias, Chai Craft, Apsara, Gimar, and Isvaari:<sup>27</sup>



VAHDAM, Kashmiri Kahwa Tea



Girnar Green Tea Desi Kahwa

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<sup>27</sup> February 14, 2022 Response to Office Action at TSDR 158-162. *See also* Amazon search results at TSDR 446-449. Both results retrieved some uses by Applicant of the applied-for mark KAHWA in connection with coffee.



The Tea Heaven, Kashmiri Kahwa Tea | Loose Leaf Chai Tea | Cinnamon, Clove, Cardamom, Star...  
**Loose Leaves · 3.52 Ounce (Pack of 1)**  
 ★★★★★ ☆ 1,043  
 \$14<sup>99</sup> (\$4.28/Ounce)  
 Save more with Subscribe & Save  
 ✓prime Get it as soon as Mon, Dec 20  
 FREE Shipping on orders over \$25 shipped by Amazon



Teamonk Premium High Mountain Kashmiri Kahwa Green Loose Leaf Tea (100 Cups) | 100% Natural Kashmiri...  
**Loose Leaves · 7 Ounce (Pack of 1)**  
 ★★★★★ ☆ 462  
 \$22<sup>99</sup> (\$3.28/Count)  
 ✓prime Get it as soon as Thu, Dec 23  
 FREE Shipping on orders over \$25 shipped by Amazon  
 Only 2 left in stock - order soon.

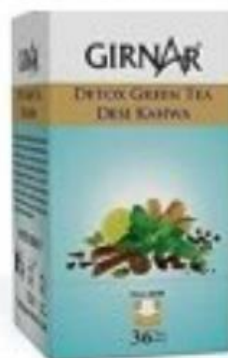


Vital Tea Peshawari Afghan Kahwa 100% Natural Green Tea 220 Gram Plastic Bottle by Eastern Products  
**Green Tea · 7.76 Ounce (Pack of 1)**  
 ★★★★★ ☆ 25  
 Save 6%  
 \$11<sup>99</sup> (\$1.55/Ounce) \$12.99  
 Lowest price in 30 days  
 ✓prime Get it as soon as Mon, Dec 20  
 FREE Shipping on orders over \$25 shipped by Amazon

Amazon.com : kahwa



Naturevibe Botanicals Kashmiri Kahwa Tea Blend, 3.52 Ounces | Natural green tea leaves, Almond, Cinnamon,...  
**Loose Leaves · 3.52 Ounce (Pack of 1)**  
 ★★★★★ ☆ 59  
 \$8<sup>15</sup> (\$2.32/Ounce)  
 ✓prime Get it as soon as Mon, Dec 20  
 FREE Shipping on orders over \$25 shipped by Amazon



Girnar Detox Green Tea - Desi Kahwa (36 Tea Bags)  
**Green · 36 Count (Pack of 1)**  
 ★★★★★ ☆ 3  
 \$9<sup>96</sup> (\$0.28/Count)  
 Get it Fri, Jan 14 - Mon, Feb 7  
 FREE Shipping  
 Only 12 left in stock - order soon.



Girnar Green Tea, Desi Kahwa, 36 Tea Bags (36 Tea Bag (Pack of 4))  
**Green · 36 Count (Pack of 4)**  
 ★★★★★ ☆ 23  
 \$36<sup>67</sup> (\$9.17/Count)  
 Get it Fri, Jan 14 - Mon, Feb 7  
 FREE Shipping



Kashmiri Kahwa Rose, Saffron, Almonds Chai Tea -Makes 50 Cups

**Rose · 3.5 Ounce (Pack of 1)**

★★★★☆ ~ 45

**\$18<sup>49</sup>** (\$5.28/Ounce)

✓prime Get it as soon as Tue, Dec 21

FREE Shipping on orders over \$25 shipped by Amazon

Only 6 left in stock - order soon.



Kashmiri Saffron Kahwa Tea By Al-Aqeeq | Loose Leaf Tea | Green Tea From Darjeeling | Loose Tea Leaves With Saffr...

**Loose Leaves**

★★★★☆ ~ 3

**\$15<sup>00</sup>** (\$4.25/Ounce)

✓prime Get it as soon as Tue, Dec 21

FREE Shipping on orders over \$25 shipped by Amazon



Orajaa Kahwa Loose Leaf Green Tea | Rejuvenate Kashmiri Herbal Tea | Saffron, Cardamom, Rose Petals,...

**Loose Leaves**

★★★★☆ ~ 19

**\$29<sup>99</sup>** (\$5.67/Ounce)

✓prime Get it as soon as Sun, Dec 19

FREE Shipping by Amazon



Girnar Detox Green Tea (desi Kahwa) - 10 Bags X 2 Pack

**Green Tea**

★★★★☆ ~ 2

**\$11<sup>99</sup>** (\$5.80/Ounce)

Get it as soon as Wed, Dec 22  
FREE Shipping

Only 10 left in stock - order soon.



Kashmir Kahwa Green Tea, 20 Premium Quality Kashmir Kahwa Tea Bags, Kashmir Kahwa Green Tea, Whole Le...

**Green Tea**

★★★★☆ ~ 1

**\$4<sup>99</sup>** (\$4.99/Count) ~~\$5.99~~

✓prime Get it as soon as Wed, Dec 22

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Girnar Detox Green Tea, 10 Sachet Pack

**Green Tea · Teabags · 10 Count (Pack of 1)**

★★★★☆ ~ 544

**\$8<sup>74</sup>** (\$8.74/Count) ~~\$9.26~~

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**Chai Craft Kashmiri Kahwa**  
Green Tea Traditional & Royal  
Taste, 25 x 3- 75 Tea Bags  
(Pack of 3)

**\$9<sup>99</sup>** (\$0.13/Count)

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**Dec 20**

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**APSARA Green Tea**  
Detoxifying Kahwa Green Tea  
Spiced with Cinnamon,  
Cardamom, Black Pepper,...

★★★★☆ - 1,254

**\$9<sup>99</sup>** (\$9.99/Count)

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**Isvaari Herbal Kashmiri Kahwa**  
Tea | Loose Leaf Herbal Tea |  
1.8 Oz (25 Cups) | Whole  
Green Tea leaves, Cardamo...

★★★★☆ - 8

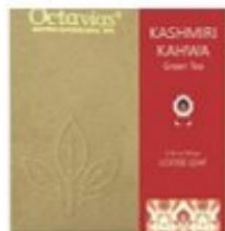
**\$11<sup>83</sup>** (\$6.71/Ounce)

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**Octavius Kashmiri Kahwa**  
Loose Leaf Green Tea - 100  
Gms

**Green Tea - Loose Leaves**

★★★★☆ - 184



**Gimar Instant Premix Kashmiri**  
Kahwa With 5 Sachets - Pack  
Of 2

**Teabags**

★★★★☆ - 91



**VAHDAM, Organic Himalayan**  
Green Tea Leaves (100 Tea  
Bags) | 100% Natural Green  
Tea, Detox Tea,...

**Green Tea - 100 Count (Pack of 1)**

★★★★☆ - 6,814

**Limited time deal**

**\$14<sup>99</sup>** (\$0.15/Count) ~~\$19.99~~

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Taken together, this evidence shows that the relevant public regards KAHWA as the generic designation for a type of green tea beverage. The Court in *In re Cordua Restaurants* noted that it, the Board and other courts have long held that a term that identifies a good that is a key aspect of the service is generic for the service. *In re Cordua Rests.*, 118 USPQ2d at 1637-38); *see, e.g., Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 254 (4th Cir. 2001) (holding that “crab house” is a generic term for restaurants). As noted earlier, the record shows that tea beverages are often served at cafés and coffee shops,<sup>28</sup> meaning that one of the “key aspects” of cafés and coffee shops is to serve a variety of tea beverages, such as green tea drinks. Applicant’s proposed mark KAHWA therefore refers to a “key aspect” of cafés and coffee shops. As further explained by the Court in *In re Cordua Restaurants*:

[A] term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole. Thus, the term “pizzeria” would be generic for restaurant services, even though the public understands the term to refer to a particular sub-group or type of restaurant rather than to all restaurants. [citations omitted].

118 USPQ2d at 1637. And as mentioned earlier, Applicant expressly acknowledged that “extensive evidence that establishes that the American purchasing public is familiar with the word ‘kahwa’ as either Bayou’s coffee shops and coffee products or as a specialized Central Asian green tea beverage” (one meaning of KAHWA “to American purchasers” is “a traditional preparation of green tea”).<sup>29</sup>

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<sup>28</sup> See Section II.A., *supra*.

<sup>29</sup> Applicant’s Appeal Brief, p. 14; 4 TTABVUE 20; *see also id.* at p. 13 and 4 TTABVUE 19

We caution that our determination is based on the broad, unrestricted identification of services that forms the basis for the overall genus. As the Court said in *In re Cordua Restaurants*:

We do not, of course, suggest that the term “churrascos” is necessarily generic as to any and all restaurant services. Had another applicant applied for registration of the mark CHURRASCOS in connection not with the entire broad genus of restaurant services but instead with a narrower sub—genre of restaurant at which grilled meat is not a key aspect of the service provided—for example, vegetarian or sushi restaurants—the result could well have been different.

*Id.* at 1638-39. In other words, registration of KAHWA on the Principal Register would give Applicant a broad scope of rights that it could enforce against competitors in the marketplace for café and coffee shop services where tea beverages are served. *See id.* at 1639.<sup>30</sup>

In sum, considering the record as a whole, we find based on a preponderance of the evidence that the relevant consuming public views KAHWA as a type of green tea beverage, and as a result, a key aspect of the genus of cafés and coffee shops. *See In re Uman Diagnostics AB*, 2023 USPQ2d 191, at \*28 (TTAB 2023) (applying preponderance of the evidence standard).<sup>31</sup> The fact that the record includes uses by Applicant of KAHWA as a trademark for coffee does not make this a “mixed record.” *See In re Merrill Lynch*, 4 USPQ2d at 1144. “[T]he mere fact that a record includes

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<sup>30</sup> To state the obvious, KAHWA is not the only generic designation for cafés and coffee shops; more than one generic term for a particular genus of services may exist. “Any term that the relevant public understands to refer to the genus ... is generic.” *Royal Crown*, 127 USPQ2d at 1046-47 (quoting *In re Cordua Rests.*, 118 USPQ2d at 1638).

<sup>31</sup> Even if the standard for finding genericness were “clear and convincing evidence,” we find that elevated standard has been met as well.

evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney's evidence of genericness.” *In re Am. Online, Inc.*, 77 USPQ2d 1618, 1623 (TTAB 2006). In view thereof, the genericness refusal is affirmed.

### III. Mere Descriptiveness

We now consider the alternative refusal of whether Applicant's mark is merely descriptive of Applicant's services.

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a mark on the Principal Register that, when used in connection with an applicant's services, is merely descriptive of them. 15 U.S.C. § 1052(e)(1).<sup>32</sup> “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); see also *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By contrast, a mark is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the [services].” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

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<sup>32</sup> “No trademark by which the [services] of the applicant may be distinguished from the [services] of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the [services] of the applicant is merely descriptive ....”

The determination of whether a mark is merely descriptive must be made in relation to the services for which registration is sought, not in the abstract. *Chamber of Commerce*, 102 USPQ2d at 1219; *Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those services, and the possible significance that the mark would have to the average purchaser of the services in the marketplace. *Chamber of Commerce*, 102 USPQ2d at 1219; *Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987). In other words, the question is not whether someone presented only with the mark could guess the services listed in the identification. Rather, the question is whether someone who knows what the services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

It is not necessary that a proposed mark describe all of the purposes, functions, characteristics, or features of a service to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *In re Chamber of Commerce*, 102 USPQ2d at 1219 (citing *In re Dial-A-Mattress Operating Corp.*, 57 USPQ2d at 1812); *see also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.”) (citation omitted).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys,” *Bayer*, 82 USPQ2d at 1831, as well as “labels, packages, or in advertising material directed to the [services].” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). For use-based applications, it may also be obtained from an applicant’s own specimen and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001); *see also Mecca Grade Growers*, 125 USPQ2d at 1953.

Based on the evidence of record, we find that Applicant’s mark immediately conveys to prospective consumers a characteristic of the service. The evidence discussed above shows that “kahwa” is a type of green tea beverage, and that cafés and coffee shops frequently serve tea beverages. Thus, when the proposed mark is viewed in the context of Applicant’s services broadly identified as cafés and coffee shops, the term KAHWA immediately informs prospective customers that the establishment serves this particular type of green tea drink. In other words, no imagination or thought is required by prospective consumers to discern the nature of Applicant’s services. Applicant’s proposed mark immediately conveys, without conjecture or speculation, an attribute of Applicant’s services. Accordingly, we find Applicant’s proposed standard character mark KAHWA to be merely descriptive of cafés and coffee shops.

#### IV. Acquired Distinctiveness Under Section 2(f)

Lastly we address Applicant's evidence of acquired distinctiveness under Section 2(f), and the issue of whether Applicant's mark is so highly descriptive of the identified services under Trademark Act Section 2(e)(1) that Applicant has failed to meet its burden of proving that its applied-for mark has acquired distinctiveness within the meaning of Section 2(f).

Section 2(f) of the Trademark Act states in relevant part:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods [or services] in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods [or services] in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. ...

The underlying rationale of Section 2(f) has been explained as follows:

[U]nlike the first five sections of 15 U.S.C. § 1052 which define the grounds upon which a trademark registration is to be refused, Section 2(f) serves as an exception to a rejection under the provisions of one of the other sections, Section 2(e) (citation omitted). Section 2(f) permits registration of marks that, despite not qualifying for registration in light of Section 2(e), have nevertheless "become distinctive of the applicant's goods [or services] in commerce." Thus, "Section 2(f) is not a provision on which registration can be refused," ... but is a provision under which an applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused.

*Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1007 (Fed. Cir. 1988) (quoting *In re Cap. Formation Counselors, Inc.*, 219 USPQ 916, 917 n.2

(TTAB 1983)) (emphasis added). “The statute is silent as to the weight of evidence required for a showing under Section 2(f) ‘except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.’” *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985) (quoting *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381, 382-83 (CCPA 1960)). Trademark Rule 2.41, 37 C.F.R. § 2.41, entitled “Proof of distinctiveness under section 2(f),” fills in this gap, stating in relevant part:

(a) For a trademark or service mark—

(1) Ownership of prior registration(s). In appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application; however, further evidence may be required.

(2) Five years substantially exclusive and continuous use in commerce. In appropriate cases, if a trademark or service mark is said to have become distinctive of the applicant’s goods or services by reason of the applicant’s substantially exclusive and continuous use of the mark in commerce for the five years before the date on which the claim of distinctiveness is made, a showing by way of verified statements in the application may be accepted as prima facie evidence of distinctiveness; however, further evidence may be required.

(3) Other evidence. In appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant’s goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified



statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

Other relevant factors may include “copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, consumer studies (linking the name to a source),” *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (citing *Cicena Ltd. v. Columbia Telecomms. Grp.*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990)), and as set forth in *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018), the following six non-exhaustive factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by consumer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark. No single factor is determinative. *In re Steelbuilding.com*, 75 USPQ2d at 1424. Rather, all factors are weighed together in light of all the circumstances to determine whether the mark has acquired distinctiveness. *Id.*

Applicant has the burden of establishing that its mark has become distinctive. *In re La. Fish Fry Prods.*, 116 USPQ2d at 1264 (citing *In re Steelbuilding.com*, 75 USPQ2d at 1422). In other words, Applicant must show that “in the minds of the public, the primary significance of a [service] feature or term is to identify the source

of the product rather than the [service] itself.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012) (internal citation omitted). The more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. *Royal Crown*, 127 USPQ2d at 1045 (citing *In re Steelbuilding.com*, 75 USPQ2d at 1424).

Whether acquired distinctiveness has been established is a question of fact. *In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1375 (Fed. Cir. 2012). The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. *Yamaha*, 6 USPQ2d at 1008; *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970); *In re Hehr Mfg. Co.*, 126 USPQ at 383.

Thus, the issues before us are whether Applicant’s mark is so highly descriptive of the services that Applicant is subject to a higher burden of proof to demonstrate acquired distinctiveness and, if so, whether Applicant has in fact met that burden.

A. Is Applicant’s mark highly descriptive of the identified services?

We must first determine “whether the proposed mark is highly descriptive rather than merely descriptive.” *Royal Crown*, 127 USPQ2d at 1045; *see also, e.g., In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (“On appeal, Louisiana Fish Fry does not challenge the Board’s finding that the term FISH FRY PRODUCTS is highly descriptive [of marinade; sauce mixes, namely barbecue shrimp sauce mix; remoulade dressing; cocktail sauce, seafood sauce; tartar sauce; gumbo file; and cayenne

pepper].”); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1765 (TTAB 2013) (“the evidence discussed above amply demonstrates that the mark [ANNAPOLIS TOURS for ‘conducting guided tours of historic districts and other areas of cities’], while not generic, is highly descriptive.”), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.).

When proposed marks are highly descriptive, evidence of use for five years, or even longer, is generally insufficient to show acquired distinctiveness. *See In re La. Fish Fry Prods.*, 116 USPQ2d at 1265 (“[p]articularly for a mark that is as highly descriptive like FISH FRY PRODUCTS, the Board was within its discretion not to accept Louisiana Fish Fry’s alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.”). Rather, for highly descriptive terms, an applicant faces an “elevated burden to establish acquired distinctiveness.” *Id.* Under “this sliding-scale approach,” the more highly descriptive the proposed mark, the greater the burden. *Royal Crown*, 127 USPQ2d at 1047; *see also In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (“[T]he greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” (quoting *In re Bongrain Int’l (Am.) Corp.*, 894 F.2d 1316, 1317 n.4[, 13 USPQ2d 1727, 1728 n.4] (Fed. Cir. 1990))).

The evidence previously discussed demonstrates that on the sliding scale ranging from the merely descriptive to generic ends of the spectrum, Applicant’s mark KAHWA is much closer to the generic end, making it highly descriptive of cafés and coffee shops. *See, e.g., In re Sausser Summers PC*, 2021 USPQ2d 618, at \*12 (TTAB 2021) (finding [onlinetrademarkattorneys.com](https://onlinetrademarkattorneys.com) highly descriptive of “legal services”);

*In re Guaranteed Rate, Inc.*, 2020 USPQ2d 10869, at \*3 (TTAB 2020) (third-party uses of the terms “guaranteed rate,” “guaranteed mortgage rate,” and “guaranteed interest rate” established GUARANTEED RATE is highly descriptive of mortgage-related services); *In re Virtual Indep. Paralegals*, 2019 USPQ2d 111512, at \*11 (TTAB 2019) (combination of descriptive terms “virtual,” “independent,” and “paralegals” in claimed VIRTUAL INDEPENDENT PARALEGALS mark for paralegal services made mark “highly descriptive of those services”).

In light of our determination, Applicant’s verified statement that the mark has become distinctive of Applicant’s services by reason of substantially exclusive and continuous use in commerce for at least five years prior to February 26, 2021, the date the statement was made, is insufficient to prove acquired distinctiveness. *In re Uman Diagnostics AB*, 2023 USPQ2d 191, at \*41 (“While ‘it is true that evidence of substantially exclusive use for a period of five years immediately preceding the filing of an application may be considered prima facie evidence of acquired distinctiveness’ under Section 2(f), *In re Ennco Display Sys., Inc.*, 56 USPQ2d 1279, 1286 (TTAB 2000), the ‘language of the statute is permissive, and the weight to be accorded this kind of evidence depends on the facts and circumstances of the particular case.’ We have discretion to find that evidence of a period of use is insufficient to show acquired distinctiveness, and we do so here because of the highly descriptive nature of Applicant’s proposed mark.”) (also citing *Yamaha*, 6 USPQ2d at 1004). Although Applicant argues 14 years of use, this length of time alone is insufficient to establish acquired distinctiveness given the highly descriptive nature of Applicant’s proposed mark. *See In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at \*20 (TTAB 2020)

(“Where, as here, the applied-for mark is highly descriptive or non-distinctive, use for a period of approximately fourteen years is insufficient to establish acquired distinctiveness.”).

B. Applicant’s further evidence of acquired distinctiveness

Having determined that KAHWA is highly descriptive of the identified services and that Applicant’s evidence of 14 years of use is insufficient standing alone to prove acquired distinctiveness, we now examine Applicant’s further evidence in support of its claim of acquired distinctiveness:

- Since the launch of Applicant’s brand KAHWA for cafés and coffee shops, Applicant has been rapidly expanding, opening 14 locations (Exhibit 83). In addition, KAHWA coffee shops are often located in very prominent high-traffic locations—for example, Tampa International Airport (Exhibit 84), which is expected to handle over 20 million passengers in 2022 (Exhibit 85); International Plaza in Tampa, Florida (Exhibit 86), which attracts about 19 million visitors annually (Exhibit 87); Tampa Convention Center, where KAHWA coffee shop replaced Starbucks (Exhibit 88); and the tourist hotspot of Miami Beach, Florida (Exhibit 89).<sup>33</sup>
- In 2019, Applicant hired Paradise Advertising & Marketing, Inc.—a high-profile marketing firm—to promote its KAHWA brand. (Exhibit 90). Paradise Advertising prominently features KAHWA on its website as one of its representative success stories. (Exhibit 91). KAHWA advertises its brand via partnerships with some of the world’s most famous celebrities. In 2022, KAHWA launched a high-profile campaign featuring a superstar MLB player David Ortiz, who was recently inducted into the MLB Hall of Fame. (Exhibit 92) (see also a news video covering this partnership at <https://news.yahoo.com/big-papi-goes-hallfame-210859871.html>). Another successful high-profile campaign involved partnership with MLB

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<sup>33</sup> February 14, 2022 Response to Office Action at TSDR 40

superstar Evan Longoria, which has been featured on the official MLB website—mlb.com (Exhibit 93). Applicant’s KAHWA brand has also been featured on national TV on Home Shopping Network (HSN). (Exhibit 94). In addition, Applicant promotes its KAHWA brand via partnerships with such nationally prominent organizations as the MLB team Tampa Bay Rays, Disney World, and Publix Grocery Stores. (Exhibit 95).<sup>34</sup>

- On May 15, 2020, Florida Business Observer reported that KAHWA coffee has been generating “more than \$10 million in annual sales, with revenues growing 10-20% year-over-year.” (Exhibit 95). On February 2, 2022, another independent media source reported that “Kahwa has become the largest independent coffee roaster in the state of Florida with 14 retail locations and more than 800 wholesale customers.” (Exhibit 96) (emphasis added). This evidence weighs heavily in support that KAHWA has acquired a secondary meaning for Applicant’s cafés and coffee shops.<sup>35</sup>

- Unsolicited media recognition of Applicant and its services from the following sources as summarized in the chart below.<sup>36</sup>

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<sup>34</sup> February 14, 2022 Response to Office Action at TSDR 40.

<sup>35</sup> February 14, 2022 Response to Office Action at TSDR 41.

<sup>36</sup> February 14, 2022 Response to Office Action at TSDR 41-42.

Exhibit	Website	Description
97	thatssotampa.com	news source with article about event with deal on Applicant's KAHWA coffee
98	abcactionnews.com	news source with article about Applicant's KAHWA coffee at event
99	stpetecatalyst.com	news source with article about owner of Applicant's KAHWA coffee
100	dailycoffeenews.com	online news source with article about Applicant's KAHWA coffee being sold at Winn-Dixie stores
101	dailycoffeenews.com	online news source with article about Applicant's KAHWA coffee being sold at Publix stores
102	srqmagazine.com	online news source with article about Applicant's new KAHWA café
103	stpetecatalyst.com	news source with article about Applicant's KAHWA coffee being sold at Publix stores
104	ilovetheburg.com	news and attractions source with article about Applicant's KAHWA coffee
105	stpetecatalyst.com	news source with article about Applicant's KAHWA coffee
106	bradenton.com	news source with article about Applicant's KAHWA coffee being sold at Publix stores
107	stpeterising.com	online news source with article about Applicant's new KAHWA café
108	stpetecatalyst.com	news source with article about Applicant's capital raise
109	thatssotampa.com	news and attractions source with article about Applicant's new KAHWA coffee drive-thru
110	ilovetheburg.com	news and attractions source with article about Applicant's new KAHWA coffee drive-thru
111	thejaxsonmag.com	news and attractions source with article about Applicant's new KAHWA coffee location
112	businessobserverfl.com	business news source with article about Applicant's KAHWA coffee company
113	tampabay.com	news source with article about growth of Applicant's KAHWA coffee business
114	bizjournals.com	business news source with article about Applicant's KAHWA coffee mobile coffee shop
115	thatssotampa.com	news and attractions source with article about Applicant's KAHWA coffee giveaway
116	stpetecatalyst.com	news source with article about Applicant's new KAHWA coffee store
117	sarasotamagazine.com	news source with article about mayor handing out free KAHWA coffee
118	sarasotamagazine.com	news source with article about Applicant's new KAHWA coffee shop
		events news source with article about Applicant's KAHWA coffee

119	cltampa.com	collaboration with Evan Longoria
120	paradiseneewsfl.com	news source with article about Applicant's KAHWA coffee event
121	progressivegrocer.com	retail food industry news source with article about Publix testing KAHWA coffee cafes
122	wtsp.com	news source with article about KAHWA coffee cafes in Publix stores
123	wfla.com	news source with article about Applicant's KAHWA coffee company expansion
124	bizjournals.com	business news source with article about the story of Applicant's KAHWA coffee
125	ilovetheburg.com	news and attractions source with article about the food at Applicant's KAHWA coffee shop
126	stpetecatalyst.com	news source with article about newest KAHWA coffee shop location
127	thatssotampa.com	news source with article about Applicant's new KAHWA coffee shops

We agree with the Examining Attorney that based on the totality of the evidence of record, Applicant has failed to establish acquired distinctiveness of its proposed mark KAHWA under Section 2(f). We reiterate that Applicant bears the burden of

establishing acquired distinctiveness, which given the highly descriptive nature of KAHWA, requires an elevated level of proof.

Applicant touts its operation of over 14 cafés and coffee shops in high-traffic locations as well as its collaborations with celebrities and prominent organizations, all of which are impressive. However, the record is devoid of competent evidence regarding annual revenues and advertising expenditures under the mark KAHWA for the relevant time period. Instead of submitting an article from a local newspaper referencing Applicant's revenues for a single year, a declaration from Applicant providing sales revenues and advertising expenditures under Applicant's mark for the identified services would have been more probative. Moreover, from what we can discern, the majority of the unsolicited media references of Applicant's proposed mark are from local, state, and regional publications. We lack evidence regarding the circulation of these publications. *Cf. In re Soccer Sport Supply Co.*, 507 F.2d 1400, 184 USPQ 345, 348 (CCPA 1975) ("The advertisements of record do not support an inference of distinctiveness inasmuch as the evidence fails to disclose information from which the number of people exposed to the design could be estimated" including the "circulation of such publications in which the advertisements appear" and "number of advertisements published"). While we have considered this evidence as indicative of some public recognition, it is less persuasive than would be media mentions from publications with a national circulation. *Compare New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*11-12 (TTAB 2020) (finding opposer's mark "on the much higher end of the commercial strength spectrum" in part because the mark had received "unsolicited media recognition in publications with a national



circulation, such as The New York Times, USA TODAY, Entrepreneur and FORBES.”) *with Blue Man Prods., Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005) (publications of “limited circulation” are “not likely to be seen by large numbers of the general public” and therefore are “of extremely limited value in proving fame” of a mark).

Although not argued by Applicant, we have also considered the Google® search results for the term “kahwa” made of record.<sup>37</sup> *See, e.g., In re Country Music Ass’n, Inc.*, 100 USPQ2d 1824, 1834 (TTAB 2011) (finding applicant’s expenditure of resources “to ensure that when Internet users type the phrase ‘Country Music Association’ into an Internet search engine, the first hit that appears on a search results list is a link to the home page of applicant’s website” probative of acquired distinctiveness). The fact that many of the results on the first several pages refer to Applicant has a bearing on the acquired distinctiveness determination. *See id.* The search results support some degree of consumer recognition.

However, when viewed in its entirety, we find Applicant’s evidence falls short of demonstrating acquired distinctiveness. Given the highly descriptive nature of Applicant’s mark, Applicant is obliged to adduce a great deal more evidence to meet its burden of proof. *See, e.g., In re JC Hosp. LLC*, 802 F. App’x 579, 2020 USPQ2d 10067 (Fed. Cir. 2020) (Board correctly determined that a higher burden of proof was required to show acquired distinctiveness for Applicant’s highly descriptive mark THE JOINT for “entertainment services, namely live musical performances, shows,

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<sup>37</sup> See chart summarizing the results in Section I.

and concerts; and nightclub services” and “restaurant, bar and catering services”; evidence of over \$12 million in marketing expenditures, total gross revenue over \$104 million, social media presence (e.g., Yelp and TripAdvisor forums, and YouTube) was insufficient); *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374 (TTAB 2007) (holding applicant’s evidence of acquired distinctiveness, including a claim of use since 1990, sales of more than 7,650,000,000 units of its goods, and extensive display of its mark CRYSTAL GEYSER ALPINE SPRING WATER on advertising and delivery trucks and promotional paraphernalia, insufficient to establish that the highly descriptive phrase ALPINE SPRING WATER had acquired distinctiveness for applicant’s bottled spring water); *see also Topps Co. v. Panini Am., Inc.*, 113 USPQ2d 1808, 1822 (TTAB 2015) (“Given that the proposed mark is highly descriptive, much more evidence, especially in the form of direct evidence from the relevant purchasing public, than what Applicant has submitted would be necessary to show that the designation LIMITED has become distinctive for Applicant’s sports trading cards.”); *In re Greenliant Sys., Inc.*, 97 USPQ2d 1078, 1085 (TTAB 2010) (same).

While the evidence does point to some consumer recognition of Applicant and commercial success, it fails to rise to the level of demonstrating acquired distinctiveness for Applicant’s highly descriptive mark.

**Decision:** The genericness refusal under Trademark Act Sections 1, 2, 3, and 45 is affirmed; the refusal in the alternative that Applicant’s proposed mark is merely descriptive under Trademark Act Section 2(e)(1) and its showing under Section 2(f) is insufficient to establish acquired distinctiveness is also affirmed. We do not reach the refusal based on the translation requirement.