

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Coach Services, Inc.
v.
Triumph Learning LLC

Opposition No. 91170112
to Application Serial No. 78535642
filed on December 20, 2004

and to Application Serial No. 78536065
and Application Serial No. 78536143
filed on December 21, 2004

ON REMAND FROM THE U.S. COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

Norman H. Zivin of Cooper & Dunham LLP for Coach Services,
Inc.

R. David Hosp and Robert M. O'Connell, Jr. of Goodwin
Procter LLP for Triumph Learning LLC.

Before Holtzman, Bergsman and Kuczma,¹
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

¹ Judge Walsh sat on the panel at the oral argument and participated in writing the September 17, 2010 decision. Judge Walsh has since retired, and Judge Kuczma has been substituted for him on the panel deciding this case. The change in composition of the panel does not necessitate a rehearing of the oral argument. *In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1560 (TTAB 2011).

Triumph Learning LLC ("applicant") filed use-based applications for the mark COACH, in standard character form (Serial No. 78535642), Coach (stylized), shown below (Serial No. 78536065),

Coach

and COACH and design, shown below (Serial No. 78536143), (applicant's marks are hereinafter referred to as "COACH")



all for the following goods:

Computer software for use in child and adult education, namely, software to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams; prerecorded audio and video tapes in the field of child and adult education, featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 9; and,

Printed materials in the field of child and adult education, namely, textbooks, workbooks, teacher guides and manuals, posters and flashcards, all featuring materials to assist teachers and

students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 16.

(hereinafter "educational materials for preparing for standardized tests").

Coach Services, Inc. ("opposer") opposed the registration of applicant's marks on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), dilution under Section 43(c) of the Trademark Act of 1946, 15 U.S.C. § 1125(c), and that applicant's marks are merely descriptive under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1).

Applicant, in its answer, denied the salient allegations in the notice of opposition and, as an affirmative defense, claimed that if its COACH marks were found to be merely descriptive, that they have acquired distinctiveness.

In a decision dated September 17, 2010, the Board found that there was no likelihood of confusion, that there was no dilution and that applicant's mark was merely descriptive, but that it had acquired distinctiveness. *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010). On appeal, the Court of Appeals for the Federal Circuit affirmed the Board's findings that there is no likelihood of confusion, there is no dilution, and that applicant's mark

is merely descriptive. However, the court vacated "the Board's decision solely on its finding of acquired distinctiveness" and remanded for further proceedings. *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1730 (Fed. Cir. 2012).

Specifically, the court noted that there were two errors in the Board's analysis of acquired distinctiveness. First, the Board did not consider five book titles that were published after applicant filed its applications. "Acquired distinctiveness and buyer recognition is to be tested in an opposition proceeding as of the date the issue is under consideration. The filing date is not a cutoff for any evidence developing after that time." *Id.*, quoting *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007). Accordingly, the case was remanded "so that the Board can assess the extent to which those titles might cut against a claim of 'substantially exclusive use.'" *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1730.

Second, the court found that applicant failed to lay the proper foundation to establish that the catalogs identified by applicant's witness Jane Fisher were prepared and kept as business records. "Accordingly, on remand, the Board must address the weight, if any, to be given to pre-July 2003 documents in the absence of any testimony authenticating them or addressing their use. The Board must

then assess whether these apparent gaps in [applicant's] proofs impact the Board's determination that the mark was in continuous use during any relevant period." *Id.*

We presume the parties are familiar with the record in this case.

Secondary Meaning/Acquired Distinctiveness

As its sixth affirmative defense in its answer to opposer's amended notice of opposition, applicant pleaded that its COACH marks have acquired distinctiveness or secondary meaning. Based on the record, we find the following facts:²

1. Applicant began using the word COACH as a trademark in 1986.

Applicant first used the word COACH as a trademark in connection with its sale of various printed test preparation materials in 1986. ... Since 1986, the products on which Applicant has used various COACH marks have included: textbooks; teach guides; software applications; as well as free promotional items such as t-shirts, polo shirts, canvas tote bags, buttons, pens, whistles, and caps.³

² Pursuant to the instructions in the Federal Circuit's decision on appeal, the Board has not considered any pre-2003 documents, nor has the Board considered any testimony by Jane Fisher regarding activities taking place prior to 2003.

³ Opposer's first notice of reliance, Exhibit 236, applicant's responses to opposer's first set of interrogatories, Nos. 1-3.

2. Applicant is the largest publisher of educational materials for preparing for standardized tests and COACH is applicant's primary trademark;⁴

3. Between 2003 and 2008, applicant's advertising expenditures quadrupled.⁵ Because applicant's advertising expenditures and revenues have been designated confidential, we may refer to them only in general terms. Applicant's annual advertising expenditures exceed six figures;⁶

4. Between 2003 and 2008, applicant has increased its distribution of promotional pieces from one million in 2003 to four million in 2008. Of the four million promotional pieces that applicant distributed in 2008, three million were catalogs and the balance were flyers or brochures;⁷

5. Between 2003 and 2007, applicant's revenues have been substantial.⁸ They reach seven figures annually; and

6. In 2003, applicant began using COACH as a stand alone mark for its educational materials,⁹ and has been continuously using COACH as a stand alone mark since then.¹⁰

Opposer contends applicant's evidence does not prove that applicant's COACH marks have acquired distinctiveness

⁴ Fisher Testimony Dep., p. 133.

⁵ Fisher Testimony Dep., pp. 137-138.

⁶ *Id.*

⁷ *Id.* at pp. 115-116.

⁸ *Id.* at pp. 144-148 and Exhibits 142-144. Opposer noted "Indeed, that Applicant has 'multiple millions' in sales casts grave doubt on its portrayal of itself as a 'smaller company' with few resources." (Opposer's Reply Brief, p. 10 n.6).

⁹ *Id.*, Exhibit 45 (software) and Exhibit 46 (books).

¹⁰ *Id.*, Exhibits 47-145.

because (1) there is no direct evidence of consumer recognition of applicant's marks, (2) Ms. Fisher's testimony is self-serving, (3) applicant's sales success is not necessarily indicative of acquired distinctiveness, (4) applicant's use has not been substantially exclusive and (5) applicant has not presented any evidence of media recognition or copying.¹¹ We disagree with opposer's conclusion and find that applicant has shown that its COACH marks have acquired distinctiveness.

To prove that its mark has acquired distinctive under Section 2(f) of the Trademark Act, an applicant may submit any "appropriate evidence tending to show the mark distinguishes [applicant's] goods." *Yamaha International v. Hoshino Gakki*, 840 F.2d 1572, 6 USPQ2d 1001, 1010 (Fed. Cir. 1988), quoting Trademark Rule 2.41(a), 37 CFR 2.41(a). Such evidence includes the duration, extent and nature of the use of the mark in commerce, advertising expenditures, letters or statements from the trade or public, and other appropriate evidence. Trademark Rule 2.41(a); see also *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (acquired distinctiveness may be shown by copying, unsolicited media coverage and consumer surveys). "The amount and character of the evidence, if any, required to establish that a given word or phrase ... 'has become

¹¹ Opposer's Reply Brief, pp. 9-11.

distinctive' of the goods necessarily depends on the facts of each case and the nature of the alleged mark." *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970); see also *In re Steelbuilding.com*, 75 USPQ2d at 1424 ("no single factor is determinative ... the determination examines all of the circumstances involving the use of the mark"). With respect to the nature of the alleged mark, "the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning." *In re Steelbuilding.com*, 75 USPQ2d at 1424.

We note that while applicant's COACH mark is merely descriptive, it is not so highly descriptive that applicant has the burden to show a concomitantly high level of acquired distinctiveness. Also, contrary to opposer's contention, applicant is not required to introduce a consumer survey or other direct evidence of consumer recognition. *Yamaha International v. Hoshino Gakki*, 6 USPQ2d at 1010; *Roux Laboratories, Inc. v. Clairol Inc.*, 166 USPQ at 37 n.6. It is well settled that we may determine the consumer's reaction to the mark based on the inferences that we can draw from the evidence that is of record. *Id.*

Contrary to our findings of fact listed above, opposer contends that with the exception of what it characterizes as

Ms. Fisher's self-serving and uncorroborated testimony, applicant did not provide any evidence to show that applicant's use of COACH had acquired distinctiveness.¹² To the extent that we relied on her testimony, we note that Ms. Fisher was subjected to rigorous cross-examination, and we find that her testimony was credible.¹³ There were no contradictions or inconsistencies and it was sufficiently definite.

With respect to the nature of applicant's use of its COACH marks, we note that while applicant has been using the word "Coach" as a stand alone trademark on its educational materials only since 2003, it has been promoting itself as the "Coach" brand since 1986. Its marketing efforts evidently have been effective because applicant has become the largest publisher of educational materials for preparing for standardized testing.¹⁴

Based on the record before us, we find that applicant's use of its COACH marks for educational materials for preparing for standardized tests is, and has been, substantially exclusive. The requirement for substantially

¹² Opposer's rebuttal brief, p. 9.

¹³ As indicated above, the Board did not rely on Ms. Fisher's testimony regarding any pre-2003 activities.

¹⁴ Fisher Testimony Dep., p. 133.

exclusive use makes allowance for use by others that may be inconsequential or infringing. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999); *Yamaha International v. Hoshino Gakki*, 6 USPQ2d at 1010 (applicant proved that its product configuration had acquired distinctiveness despite evidence that four other companies made similar products prior to registration).

Opposer introduced into evidence 43 titles of books and software incorporating the word "coach" in the title,¹⁵ seven websites,¹⁶ and emails from Ken Butkus, applicant's Executive Vice President of Sales and Marketing, warning that competitors may be using titles or marks with the word "Coach."¹⁷ Of the book and software titles made of record by opposer, few appear to be related to applicant's subject matter. The following titles may fall within the penumbra of educational materials for preparing for standardized tests:

1. A Writer's Coach: An Editor's Guide to Words that Work;
2. The Effective Literacy Coach: Using Inquiry to Support Teaching and Learning;
3. Writer's Coach: The Complete Guide to Writing Strategies That Work;

¹⁵ Opposer's third notice of reliance.

¹⁶ Fisher Testimony Dep., pp. 158-167 and Exhibits 154-160.

¹⁷ Fisher Testimony Dep., pp. 183-188 and Exhibits 449-450.

4. My SAT Coach; and

5. My Word Coach.

This evidence of purported third-party use is of limited probative value because there is nothing to show that the public is aware of the books and software or if any have been sold. Likewise, there is no evidence of whether the public is aware of the businesses identified by the websites, the number of the customers or the trading area for these businesses. See *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 n.5 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 n.16 (TTAB 1996).

With respect to the book titles, the title of a single creative work, as we have here, does not serve as a source identifier that would demonstrate that applicant's use of its COACH mark is anything other than substantially exclusive. See *Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) ("the title of a single book cannot serve as a source identifier"); *In re Cooper*, 254 F.2d 611, 117 USPQ 396, 400 (CCPA 1958), cert denied, 358 U.S. 840, 119 USPQ 501 (1958) ("A book title ... identifies a specific literary work ... and is not associated in the public mind with the publisher, printer or bookseller ...").

The book titles and websites are evidence for what they show on their face: that a large number of books have

"Coach" in their title and that various companies purport to offer self-help counseling, consulting in the field of sports coaching, business consulting services and medical services for low income children using the word "Coach" as part of their name.¹⁸ This evidence does not show that applicant's use of its COACH marks for educational materials for preparing for standardized examinations is not substantially exclusive.

Finally, the "Coach" marks referenced in the Butkus emails have little probative value. First, Ms. Fisher, the witness authenticating the emails, had no knowledge regarding the products referenced in the emails and Ms. Fisher testified that to the best of her knowledge the companies purportedly publishing the other "Coach" materials were not competitors of applicant.¹⁹ Second, there is no evidence that the purported third-party "Coach" products were ever marketed.

In view of the foregoing, we find that applicant's use of its COACH marks has made an impact on the purchasing public in the field of educational materials for preparing for standardized tests as an indication of origin and has acquired distinctiveness. In view thereof, applicant has

¹⁸ Two of the websites were for totally irrelevant products: COACHGUARD microphone shield device and the COACH 2 Incentive Spirometer, a device to facilitate post-surgical breathing.

¹⁹ Fisher Testimony Dep., pp. 183-186.

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established its affirmative defense that its COACH marks have acquired distinctiveness and applicant's registrations will issue with the appropriate notation.

Decision: The opposition is dismissed.