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Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kicking Horse Coffee, Ltd.
v.
The Original Coffee Brake

Opposition No. 91193625
to Application Serial No. 77740713
filed on May 19, 2009

Mark D. Robins and David G. Murphy of Nixon Peabody LLP for
Kicking Horse Coffee, Ltd.

Joseph Mohr of Mohr Intellectual Property Law Solutions,
P.C. for The Original Coffee Brake.

Before Cataldo, Bergsman and Ritchie,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Original Coffee Brake ("applicant") filed a use-based application to register the mark KICK AX COFFEE GET BIG WOOD WITH OLD GROWTH BLEND COFFEE and design, shown below, for "coffee," in Class 30.



Applicant disclaimed the exclusive right to use the words "Coffee" and "Blend" and the designs of coffee beans.

Kicking Horse Coffee, Ltd. ("opposer") opposed the registration of applicant's mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Opposer alleged that it has used the mark KICK ASS COFFEE for coffee long prior to any date on which applicant can rely for the first use of its mark and that applicant's use of the mark KICK AX COFFEE and design for coffee so resembles opposer's mark KICK ASS COFFEE for coffee as to be likely to cause confusion. Opposer claimed ownership of Registration No. 2896141 for the mark KICK ASS COFFEE for coffee.¹ Opposer attached to the notice of opposition a copy of its registration printed from the electronic database of the U.S. Patent and Trademark Office showing the current status of and title to the registration.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

On February 23, 2011, the parties filed a stipulation setting forth their agreement to resolve this proceeding by utilizing the Board's Accelerated Case Resolution process.

¹ Issued October 19, 2004; Sections 8 and 15 affidavits accepted and acknowledged.

Preliminary Issue

After the notice of opposition was filed, opposer filed a request to amend the drawing of its registered mark to delete the word "coffee." The amendment was approved and opposer's registered mark is now KICK ASS. Because the word "coffee" is generic as part of a mark used to identify "coffee," the mark KICK ASS is the legal equivalent of the mark KICK ASS COFFEE and, therefore, the amendment to opposer's mark deleting the word "coffee" has no bearing on our likelihood of confusion analysis.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark.² The record also includes the following evidence:

A. Opposer's Evidence.

1. The affidavit of David G. Murphy, opposer's counsel, introducing the following exhibits:

- a. Applicant's supplemental responses to opposer's first set of interrogatories;
- b. Screen shot from the Lovemarks website (lovemarks.com);

² Accordingly, opposer did not have to submit portions of the application to make it of record.

- c. Screen shot from the Ethical Ocean website (ethicalocean.com);
- d. Screen shot from the Boys to Men Gifts website (boystomengifts.com);
- e. Copy of the November 3, 2008 Office Action in applicant's Serial No. 77530493 for the mark KICK AX COFFEE, in standard character form;
- f. Applicant's response to opposer's requests for admission and selected documents authenticated by the requests for admission; and
- g. A photograph of applicant's packaging featuring applicant's mark; and

2. The affidavit of Leo Johnson, opposer's President, with the following exhibits:

- a. Various documents from the file of opposer's pleaded registration;
- b. An excerpt from *Profit Magazine* (November 2006) referencing opposer's growth;
- c. An excerpt from *Ecoprenuer.ca* magazine (no date) referencing opposer and KICK ASS COFFEE;
- d. A screen shot from the television show *Model Latina* displaying opposer's product; and

- e. Summaries of opposer's revenues and advertising expenditures, a list of distributors, customer contacts, and a Nielsen report regarding popular coffee brands in Ontario and Western Canada (all confidential).

B. Applicant's evidence.³

1. Opposer's responses to applicant's first set of interrogatories;
2. Declaration of Cathy Jackson-Zellmer, applicant's owner;
3. Copies of six third-party registrations for coffee; and
4. Evidence of third-party use of KICK ASS marks for coffee.

Standing

As indicated above, opposer attached a copy of its pleaded registration from the electronic records of the USPTO showing the current status and title of the registration. The registration is admissible pursuant to

³ Applicant submitted its supplemental responses to opposer's first set of interrogatories. Ordinarily, an answer to an interrogatory may be submitted and made part of the record only by the inquiring party. Trademark Rule 2.120(j)(5). However, as noted above, opposer submitted applicant's supplemental responses to opposer's first set of interrogatories. When evidence is made of record by one party, it may be referred to by any other party for any purpose permitted by the Rules of Evidence. *Anheuser-Busch, Inc. v. Major Mud & Chemical Co., Inc.*, 221 USPQ 1191, 1192 n.7 (TTAB 1984).

Trademark Rule 2.122(d)(1). Because opposer has properly made its pleaded registration of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Because opposer's pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the goods covered by the registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on 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, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

- A. The similarity or dissimilarity and nature of the goods at issue, the established, likely-to-continue trade channels and classes of consumers.

The goods at issue are identical (*i.e.*, coffee). Because the goods described in the application and opposer's pleaded registration are identical, we must presume that the

channels of trade and classes of purchasers are the same. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

B. The strength of opposer's mark.

Opposer contends that its mark KICK ASS has achieved widespread recognition based on multiple publications that have written about its popularity, the resources opposer devotes to advertising and marketing, and steadily rising sales.⁴ Opposer's advertising and sales figures were designated as confidential so we may only refer to them in general terms. In the abstract, opposer's sales and advertising figures are not so significant as to indicate that opposer's mark has achieved widespread recognition. In this regard, opposer failed to introduce any testimony or evidence that would place its advertising expenditures and revenues in context (e.g., market share, a comparison of

⁴ Opposer's Brief, pp. 4-6 and 21-22.

advertising expenditures by competitors). *Cf. Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002).

The websites and other media introduced by opposer fail to show that opposer's mark has achieved widespread recognition in the United States. The excerpt from the Lovemarks website sets forth comments from three individuals identified as Canadian. There are no comments from U.S. residents and no indication as to how many U.S. residents access this website. The excerpt from the Ethical Ocean website provides shipping and handling costs for Canada only. There are no costs for shipping and handling to sales in the United States and no indication that the product is sold in the United States through this website. The excerpt from the Boys to Men Gifts website provides an advertisement for KICK ASS COFFEE and it indicates that the product is "one of Canada's best kept secrets." There is no indication that the "secret" has reached the United States.

The *Profit Magazine* article (November 2006) identifies Elana Rosenfeld, opposer's CEO, as one of Canada's top women entrepreneurs. The article stated that opposer "had climbed to No. 1 nationally [Canada] in grocery-store sales of super-premium coffee" and that the company goal is "to become the No. 1 coffee of any kind in Canada." The article

does not reference any plans to expand into the United States, nor does the article reference KICK ASS COFFEE.

The *Ecopreneur.ca* magazine article profiles opposer as an ecologically friendly Canadian company. It does not report on opposer's plans, if any, to expand into the United States.

Opposer contends that the renown of opposer's mark in Canada "can spill over, such that the mark becomes well known in [America]." Citing 3 McCarthy on Trademarks and Unfair Competition § 29:64 (4th ed. 2004). The citation to the McCarthy treatise references the "Well-Known Marks Doctrine" and the "Spill over of fame between nations." The bases of the spill over effect is that the mark at issue is so well known in its home country that it has also become well known in other countries even though the goods are not sold or the services rendered in the other countries. The problem with opposer's argument is that opposer failed to show that opposer's mark has any renown in the United States.

Applicant, as part of its case, attempted to prove that opposer's mark is a weak mark, entitled to only a narrow scope of protection or exclusivity of use. Applicant's attempt to show that extensive third-party use weakens opposer's mark is no more persuasive than opposer's attempt to show that its mark has achieved widespread renown

throughout the United States. First, applicant introduced six third-party registrations, owned by five entities, for coffee, none of which include the term KICK ASS. The marks are BAD ASS, GOLDEN KICK, HALF ASS, TRUE KICK and WILD ASS. There is little, if any, probative value in third-party registrations that show marks different in appearance from those of the parties to this proceeding.

Moreover, the third-party registrations introduced by applicant are not evidence that those marks have been used so extensively that consumers have become sufficiently conditioned by their usage so that they can distinguish between such marks on the bases of minute differences. The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 192 USPQ 289, 294 (2d Cir. 1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers."). As the Court pointed out in *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406, 407 (C.C.P.A. 1967), "the existence of these registrations is not evidence of what happens in the market place or that customers are familiar with their use." Where, as here, the "record includes no evidence about the extent of [third-

party] uses ... [t]he probative value of this evidence is thus minimal."

With respect to the relevant third-party use, applicant submitted the following:

1. An advertisement for a coffee cup with the slogan "Unicorns Kick Ass." "Unicorns Kick Ass" is an ornamental statement and it will not be perceived as a trademark.

2. An excerpt from the *kickbuttcffee.com* website providing the history of the coffee shop and advertising an open mic comedy performance.

3. An excerpt from the *kick-asscoffee.com* website advertising the sale of "Kick-Ass Coffee" from Costa Rica.

4. The photograph of a sign for what appears to be a coffee stand at an unidentified site taken on an unidentified day. The sign reads "Kick Ass Koffee" with a design.

5. An excerpt from the Kona CyberCafe website advertising Kona Kick Ass coffee.⁵ According to the website, Kick Ass coffee is organically grown coffee from Kona, Hawaii.

We are a small 100% organic Hawaiian Farming family. ... We have only been selling our coffee to our friends and family in the main land US and several coffee shops in California and New York. Our friends encouraged us to expand our

⁵ Applicant stamped the exhibit number over the URL making it unreadable.

operation and offer 100% organic coffee to other organic coffee lovers as well.

The probative value of applicant's third party evidence is limited because applicant did not provide any evidence regarding the extent of the use of the marks by the third parties. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1284 n.5 (TTAB 1998) (white pages listings do not show that the public is aware of the companies); *but see In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 n.16 (TTAB 1996) ("the magnitude of applicant's evidentiary record is such that even allowing for these possibilities [some of the entities are out of business, are small enterprises, are in remote locations, or have reached only a miniscule portion of the relevant public], there is still a significant body of evidence of third-party use"). Unlike *Broadway Chicken* where there hundreds of third parties using the name at issue, in this case, four third parties is not sufficient to show that the term KICK ASS is so commonly used that KICK ASS is a weak mark.

The *du Pont* factor regarding the number and nature of similar mark in use on similar goods (*i.e.*, the strength of opposer's mark) is neutral.

C. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the

marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we are mindful that where, as here, the goods are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

In addition, in comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons*

Restaurants Inc. v. Morrison Inc., 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is an ordinary coffee drinker.

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, there is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

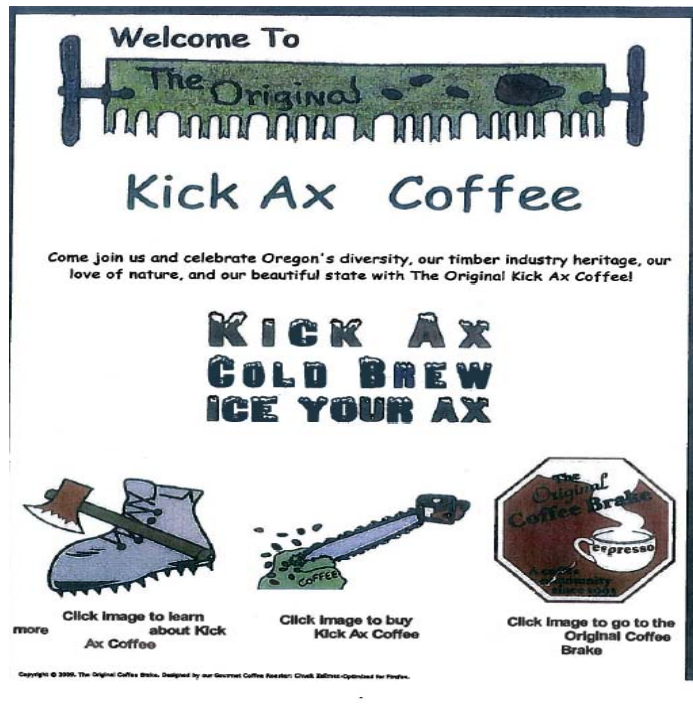
In this regard, there are a number of cases that reflect the principle that if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). In this case, we find that the word portion of applicant's mark is the dominant element because consumers will use them to call for applicant's coffee.

Specifically, consumers will refer to applicant's product as KICK AX COFFEE because they will shorten KICK AX COFFEE GET BIG WOOD WITH OLD GROWTH BLEND COFFEE, to KICK AX COFFEE. "[U]sers of language have a universal habit of shortening full names - from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station." *In re Abcor Development Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring).

[C]ompanies are frequently called by shortened names, such as Penney's for J.C. Penney's, Sears for Sears and Roebuck (even before it officially

changed its name to Sears alone), Ward's for Montgomery Ward's, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992). Applicant itself refers to its product as KICK AX COFFEE in its marketing materials.⁶ Excerpts from applicant's website are set forth below.



⁶ Murphy Affidavit, Exhibits 7 and 9. The reference in Exhibit 7 is barely legible and, therefore, has not been reproduced in this decision.



Opposer's mark KICK ASS and the dominant portion of applicant's mark KICK AX COFFEE are similar in appearance and sound. Both marks start with the word "kick" followed by a one syllable word starting with the letter "a" ("ass" vs. "ax"). KICK ASS is pronounced "kik as." KICK AX is pronounced "kik aks."

With respect to the meaning of the marks, opposer's mark KICK ASS means "1. powerful, aggressive, thuggish or violent. 2. ... terrific, exciting." The Cassell Dictionary of Slang, p. 692 (1998).⁷ Leo Johnson, opposer's President,

⁷ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

stated in his affidavit that "[t]he name KICK ASS COFFEE was chosen to evoke the stimulating and enlivening impact of its bold and invigorating taste would have on consumers upon tasting it." The meaning of opposer's mark KICK ASS is the same as the commercial impression that it engenders (*i.e.*, a powerful aggressive flavor).

Applicant's mark KICK AX COFFEE, on the other hand, does not have a readily understood meaning. KICK AX appears to be a coined term. The manner in which the mark is used is a play on the logging culture. See the drawing of the mark and the Internet advertisements note above. However, since the term "Kick Ax" does not have any meaning, consumers will associate it with the more familiar term "Kick ass." This finding is corroborated by applicant's use of KICK AX COFFEE without the design element. For example, applicant has a URL www.KICKAXCOFFEE.com and the statement "Coffee Brake is the home of KICK AX Coffee."

Considering the marks in their entirety, and also factoring in the identity of the goods, we find that the similarity of the marks outweigh the differences. It is not likely that the two marks will be subject to a side-by-side comparison by consumers. Coffee purchasers will, therefore, be comparing the mark that they see with the mark that they think they remembers seeing (*i.e.*, KICK ASS and KICK AX COFFEE). The fallibility of memory as to details in such a

situation is well known. Therefore, the similarity in the appearance and sound of the marks will be dominant in the mind of the average consumer.

D. The nature and extent of any actual confusion.

Applicant argues that there is no likelihood of confusion as evidenced by the lack of any reported instances of actual confusion. However, the absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its mark. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring"). Although opposer and

applicant do business in Oregon, the evidence does not support the fact that there has been a reasonable opportunity for actual confusion to have occurred.

Cathy Jackson-Zelmer, applicant's owner, testified that applicant first used the mark in August 2008⁸ and that applicant "sells beverages and roasted coffee beans to customers at its coffee shop in Aloha, Oregon and at local farmer's markets," as well as "limited sales of roasted coffee beans over the internet."⁹ On the other hand, Leo Johnson, opposer's President, testified that opposer sells its product "at supermarkets, drug stores, and several other venues across the United States," including Oregon, as well as through the Internet.¹⁰ At the time the parties filed their briefs, there has been less than three years of simultaneous use. Any overlapping sales or advertising appears to be *de minimis*. Therefore, we find that there has not been an appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its mark.¹¹

⁸ Applicant's responses to opposer's interrogatory No. 1.

⁹ Zellmer Declaration ¶ 1. See also Applicant's response to opposer's Interrogatory Nos. 10, 11, 31, 33, 34, and 36 indicating that applicant has made limited sales and has made limited advertising expenditures.

¹⁰ Johnson Affidavit ¶¶ 16 and 17.

¹¹ Each party argues an inconsistent position on this issue. For example, opposer argues that its mark has widespread renown and that confusion is inevitable, yet opposer fails offer a reasonable explanation as to why there are no reported instances of confusion. Likewise, applicant argues that the lack of any reported instances of confusion is highly probative, on the one

E. Balancing the factors.

Because the marks are similar, the goods are identical and the presumption that the goods travel in the same channels of trade and are sold to the same classes of consumers, we find that applicant's mark KICK AX COFFEE GET BIG WOOD WITH OLD GROWTH BLEND COFFEE and design for coffee is likely to cause confusion with the mark KICK ASS for coffee.

Decision: The opposition is sustained and registration to applicant is refused.

hand, but on the other hand, argues that opposer's renown is not widespread which logically minimizes the opportunity for confusion to occur.