

<p>This Opinion is Not a Precedent of the TTAB</p>
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Mailed: February 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Kicking Horse Coffee Co. Ltd.*

*v.*

*David John Critchley*

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Opposition No. 91218282  
Cancellation No. 92059924  
(Consolidated)

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Jeffrey L. Costellia and Robert A. Weikert of Nixon Peabody LLP,  
for Kicking Horse Coffee Co. Ltd.

Cathleen E. Stadecker and Peter Kunin of Downs Rachlin Martin PLLC,  
for David John Critchley.

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Before Wellington, Wolfson, and Larkin,  
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

David John Critchley (“Critchley”) owns Registration No. 4553724 of the mark

KICK ASS in standard characters on the Principal Register for:

Clothing, namely, articles of sports clothing, articles of clothing for sportswear, articles of outer clothing for sportswear, articles of outer clothing, articles of clothing for leisure wear, all the aforesaid being neckscarves,

trousers and overtrousers, shorts, shirts, t-shirts, t-shirts of cotton, polo shirts, sweatshirts, jumpers, sweaters, hooded sweatshirts, track suits, coats, anoraks, raincoats, fleece jackets, jackets, waterproof trousers, waterproof overtrousers, waterproof jackets, scarves, underwear, thermal underwear, swimwear, football jerseys, football shirts, football shorts, football socks, rugby jerseys, rugby shorts, rugby shirts, rugby socks, sports socks, sports shorts, sports jerseys, sports shirts, water-resistant jackets and waterproof pants, sports jackets, in International Class 25

and

Energy drinks, fruit and vegetable juices, fruit and vegetable juice-based drinks, bottled drinking water, mineral and tonic water, excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient, in International Class 32.<sup>1</sup>

Critchley also seeks registration on the Principal Register of the mark KICK ASS in standard characters for “Fruit and vegetable juices, fruit and vegetable juice-based drinks, bottled drinking water, mineral and tonic water; energy drinks, excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient,” in International Class 32.<sup>2</sup>

Kicking Horse Coffee Co. Ltd. (“Kicking Horse”) seeks cancellation of Critchley’s registration, and opposes Critchley’s application, on two grounds: (1) under Section 2(d) of the Trademark Act (the “Act”), 15 U.S.C. § 1052(d), on the ground that

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<sup>1</sup> Critchley’s registration issued on June 24, 2014 under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based on his United Kingdom Registration Nos. 005047378, 2409252, and 1523240.

<sup>2</sup> Application Serial No. 85844858 was filed on February 8, 2013 under Sections 1(b) and 44(e) of the Trademark Act, 15 U.S.C. §§ 1051(b) and 1126(e), on the basis of Critchley’s allegation of a bona fide intention to use the mark in commerce and his United Kingdom Registration No. 2409252 and Community Trademark Registration No. 5047378.

Critchley's KICK ASS mark so resembles the standard character mark KICK ASS in Kicking Horse's Registration No. 2896141 for coffee as to be likely, when used on or in connection with the goods identified in Critchley's registration and application, to cause confusion, to cause mistake, or to deceive consumers; and (2) under Section 1(b) of the Act, 15 U.S.C. § 1051(b), on the ground that Critchley lacked a bona fide intention to use the KICK ASS mark in commerce in the United States when Critchley filed the application that matured into Registration No. 4553724 and the opposed application.

The cases are fully briefed. We sustain the opposition, and grant the petition to cancel, on the basis of Kicking Horse's Section 2(d) likelihood of confusion claim.<sup>3</sup>

## **I. Background, Trial Record, and Evidentiary Matters**

### **A. Background**

These consolidated cases are not the first time that the Board has considered the parties' respective marks. In 2006, Critchley filed Application Serial No. 78877552, which ultimately matured into the involved registration, to register KICK ASS for clothing and for goods then identified in Class 32 as "energy drinks, fruit and vegetable juices, fruit and vegetable juice-based drinks, bottled water, mineral and tonic water." The examining attorney assigned to the application issued a final

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<sup>3</sup> We have "discretion to decide only those claims necessary to enter judgment and dispose of the case" because our "determination of registrability does not require, in every instance, decision on every pleaded claim." *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013). Accordingly, we do not reach Kicking Horse's claims that Critchley lacked a bona fide intention to use the KICK ASS mark. *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1064 (TTAB 2017).

refusal to register the mark only with respect to the beverages under Section 2(d) based on Kicking Horse's registration of KICK ASS for coffee, and Critchley appealed to the Board, which affirmed the refusal, 36 TTABVUE (Serial No. 78877552),<sup>4</sup> and denied reconsideration of its ruling. 38 TTABVUE (Serial No. 78877552).<sup>5</sup>

In January 2013, Critchley commenced a civil action in the United States District Court for the Eastern District of Virginia seeking review of the Board's decision. 39 TTABVUE (Serial No. 78877552). Critchley and the United States Patent and Trademark Office ("USPTO") subsequently stipulated to the dismissal of the civil action on the condition that upon remand of the case to the USPTO, Critchley would seek to amend the identification of his Class 32 goods to read "Energy drinks, fruit and vegetable juices, fruit and vegetable juice-based drinks, bottled drinking water, mineral and tonic water, excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient." 40 TTABVUE 1 (Serial No. 78877552).

The case was remanded to the Board, which in turn remanded the case to the examining attorney for consideration of the amendment. 41 TTABVUE 2 (Serial No. 78877552). After the amendment was accepted, the application was published for opposition and when no opposition was filed, Critchley's Registration No. 4553724 issued on June 24, 2014. On September 10, 2014 Kicking Horse filed Cancellation No.

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<sup>4</sup> Except where otherwise indicated (as here), all subsequent citations in this opinion to the briefs and the record are to the TTABVUE docket in Opposition No. 91218282, the parent case in these consolidated proceedings.

<sup>5</sup> The Class 25 goods identified in the application and the resulting involved registration were not at issue on the previous appeal. 36 TTABVUE 2 (Serial No. 78877552).

92059924 against the registration and Opposition No. 91218282 to Application Serial No. 85844858, which Critchley had filed in February 2013 while his district court appeal was pending. The Board consolidated the cases on November 14, 2014, designating Opposition No. 91218282 as the parent case. 5 TTABVue 2.

Kicking Horse was subsequently granted leave to file an Amended Notice of Opposition and an Amended Petition to Cancel. 22 TTABVue 3-8. Those amended pleadings, 16 TTABVue 13-48, and Critchley's answers thereto, 24 TTABVue 2-4; 6 TTABVue 2-5 (Cancellation No. 92059924), are the operative pleadings in the consolidated cases. Critchley denies the material allegations in Kicking Horse's amended pleadings, but did not assert any affirmative defenses in his answers or counterclaim to cancel any of Kicking Horse's pleaded registrations.<sup>6</sup>

Prior to trial, Critchley filed a motion pursuant to Section 18 of the Trademark Act, 15 U.S.C. § 1068, to amend the Class 32 goods identifications in his registration and application to cover solely "energy drinks, excluding coffee-flavoured energy

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<sup>6</sup> Kicking Horse made three pleaded registrations of the marks KICK ASS, KICKING HORSE, and KICKING HORSE COFFEE and design of record in both cases by attaching information regarding the registrations from the USPTO's electronic database record to its Amended Notice of Opposition and Amended Petition to Cancel, pursuant to Rule 2.122(d)(1) of the Trademark Rules of Practice, 37 C.F.R. § 2.122(d)(1). 16 TTABVue 14-15, 19-29 (Amended Not. of Opp. ¶¶ 1-3; Exs. A-C), 31-32, 38-48 (Amended Pet. to Cancel ¶¶ 3-5; Exs. A-C). Kicking Horse also pleaded common law rights in these marks. Kicking Horse mentions all of the pleaded marks once in its main brief, 42 TTABVue 7, but states that "[d]ue to the identical nature of [its] KICK ASS registration [for coffee], and Critchley's KICK ASS application and registration, [Kicking Horse's] brief will focus on these marks." *Id.* Like Kicking Horse, we will focus on the registered KICK ASS mark for coffee as the one most relevant to our *du Pont* analysis. If we find a likelihood of confusion as to this mark, we need not find it as to the others; conversely, if we do not find a likelihood of confusion as to this mark, we would not find it as to the others. *See, e.g., Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015).

drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient,” if the Board determined that Critchley was not otherwise entitled to registration. 21 TTABVUE 2-3. The Board deferred decision on that motion until final hearing. 22 TTABVUE 2-3.

## **B. Trial Record**

The record consists of the pleadings, the files of Critchley’s registration and application, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), and the following evidence submitted by the parties:

### **Kicking Horse’s Evidence**

1. First Notice of Reliance,<sup>7</sup> 25 TTABVUE, on third-party registrations, which Kicking Horse claims “are relevant to show that numerous third parties have registered trademarks that cover both coffee . . . and energy drinks (or sports drinks),” *id.* at 5-6, and webpages, which Kicking Horse claims show “the use of the same mark for both coffee and energy (or sports) drinks, *id.* at 4;
2. Second Notice of Reliance, 26 TTABVUE, on third-party registrations, which Kicking Horse claims “are relevant to show that numerous third parties have registered trademarks that cover both coffee . . . and clothing,” *id.* at 5, and webpages, which Kicking Horse claims show “the use of the same mark for both coffee and clothing,” *id.* at 4, and that coffee and

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<sup>7</sup> Other than on the cover sheet of Kicking Horse’s rebuttal notice of reliance, 41 TTABVUE 1, Kicking Horse did not assign numbers to its notices. We have identified all them by ordinal numbers corresponding to their order of entry into the TTABVUE docket.

clothing are offered and promoted through the same channels of trade and to identical classes of consumers, *id.* at 6;

3. Third Notice of Reliance, 27 TTABVUE, on certain of Critchley's discovery responses, which Kicking Horse claims are relevant to show that "no relevant documents were produced" by Critchley, *id.* at 2; and
4. Fourth Notice of Reliance, 41 TTABVUE, on various printed publications, which Kicking Horse submitted to rebut Critchley's Second Notice of Reliance and which Kicking Horse claims "show the relatedness of the goods in that they are discussed in the same news articles and/or compared as to safety and efficacy," *id.* at 2, and that coffee and energy drinks or sports drinks "are offered and promoted through the same channels of trade and to identical classes of customers." *Id.* at 3.

### **Critchley's Evidence**

1. First Notice of Reliance, 29 TTABVUE, on various printed publications, including dictionary definitions of the phrase "kick ass" and the word "coffee," a Wikipedia entry regarding coffee drinks, and other materials, which Critchley claims "are relevant to the issue of likelihood of confusion, specifically the meaning/connotation of the parties' respective marks, and the relatedness between the parties' respective goods and services," *id.* at 3; various pages from Kicking Horse's website and marketing materials, which Critchley claims "are relevant to the issue of likelihood of confusion, specifically the meaning/connotation of [Kicking Horse's] marks, the

strength of [its] marks, and the variety of goods on which its marks are or are not used,” *id.* at 5; and webpages regarding third-party uses of the phrases “Kick Ass” or “kick ass,” which Critchley claims are “relevant to the issue of likelihood of confusion, specifically the meaning/connotation of the parties’ respective marks, and the strength of [Kicking Horse’s] marks,” *id.* at 11;

2. Second Notice of Reliance, 31 TTABVUE, on webpages of sellers of coffee and energy drinks, which Critchley claims “are relevant to the issue of likelihood of confusion, specifically whether the parties’ respective goods are related such that customers are likely to believe they originate from the same source,” *id.* at 5,7;
3. Critchley’s testimony deposition upon written questions, and exhibits thereto,<sup>8</sup> 39 TTABVUE;<sup>9</sup> and
4. Third Notice of Reliance, 40 TTABVUE, on third-party registrations, applications, and webpages, including from Kicking Horse’s website, which Critchley claims “are relevant to the issue of likelihood of confusion, specifically the meaning/connotation of the parties’ respective marks, and

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<sup>8</sup> These consolidated cases were tried prior to the effective date of the revisions to the Trademark Rules of Practice that allow the submission of trial testimony by declaration or affidavit.

<sup>9</sup> We will cite Critchley’s testimony by the number of the written question that elicited the testimony (e.g., “Answer to 81 Direct”) and we will refer to exhibits identified during his testimony by their assigned exhibit numbers.



the strength of [Kicking Horse's] marks" and "the variety of goods on which its marks are or are not used." *Id.* at 3-4.

### **C. Evidentiary Objections**

In its main brief, Kicking Horse objects to the introduction of certain documents through Critchley's testimony deposition on written questions, and any testimony related to the documents, on the ground that the documents were "selectively produced well-after the close of discovery . . . and make reference to other documents that were *not* produced . . . ." 42 TTABVUE 8. Kicking Horse acknowledges that a "Motion to Exclude these documents was filed by [Kicking Horse] on or around February 17, 2016," but claims that it "remains pending before the Board." *Id.* at 9. Critchley responds that this objection was ruled on by the Board when it denied Kicking Horse's motion to exclude, and that Kicking Horse's "statement that its motion 'remains pending before the Board' . . . is therefore incorrect, and the Board should disregard this objection." 43 TTABVUE 5.

Kicking Horse's motion to exclude was filed after Critchley gave notice of his intention to take a testimony deposition on written questions, 28 TTABVUE 2, and requested that the Board "preclude [Critchley] from using in any way the documents produced to counsel for [Kicking Horse] on September 22, 2015 and October 23, 2015, more than two months after the close of Discovery on July 19, 2015." 30 TTABVUE 2. The Board denied the motion, finding that "the exclusion of these documents and the related testimony would not be appropriate given the circumstances of this case." 35 TTABVUE 5.

In its reply brief, Kicking Horse acknowledges the Board's ruling, but states that Kicking Horse "believes the Motion was incorrectly decided and therefore maintains its objection to those documents and the testimony based thereon." 44 TTABVUE 6. This position is not well-taken. If Kicking Horse believed that the motion was incorrectly decided, its remedy was to request reconsideration of the Board's order pursuant to Rule 2.127(b) of the Trademark Rules of Practice, but Kicking Horse did not do so. We overrule Kicking Horse's objection.<sup>10</sup>

## II. Standing

A threshold issue in every inter partes case is the plaintiff's standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Kicking Horse must show that it possesses a real interest in the proceeding beyond that of a mere intermeddler, and that it has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

Critchley "does not contest [Kicking Horse's] standing," 43 TTABVUE 9, and Kicking Horse has affirmatively established its standing in both cases by properly making of record its pleaded registration of KICK ASS for coffee, pursuant to

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<sup>10</sup> In his brief, Critchley objects to three of Kicking Horse's questions at his testimony deposition that sought "information about whether [he] did or did not produce certain documents 'prior to July 19, 2015'" on the ground that the Board's order on Kicking Horse's motion to exclude rendered those questions irrelevant. 43 TTABVUE 6. We overrule these objections because the questions generally address the existence of documents that might be relevant to the issue of Critchley's bona fide intention to use his mark.

Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1), 16 TTABVue 19-23 (Amended Not. of Opp. Ex. A); 38-42 (Amended Pet. to Cancel Ex. A), which gives Kicking Horse a likelihood of confusion claim that is not wholly without merit. *Lipton Indus. Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

### III. Analysis of Likelihood of Confusion Claims<sup>11</sup>

Section 2(d) of the Trademark Act prohibits the registration of a mark that “[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). To prevail on its Section 2(d) claims, Kicking Horse must prove, by a preponderance of the evidence, that it has priority with respect to its KICK ASS mark vis-à-vis Critchley’s registered KICK ASS mark,<sup>12</sup> and that Critchley’s prospective use of his marks in connection with the goods identified in the registration and application is likely to cause confusion, mistake, or deception as to the source or sponsorship of those goods.<sup>13</sup> *Cunningham v. Laser Golf Corp.*, 222 F.3d

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<sup>11</sup> The consolidated opposition and cancellation proceedings retain their separate character and require the entry of separate judgments, which we render in this opinion. We will discuss Kicking Horse’s likelihood of confusion claims together, however, because the marks, and the goods in Classes 30 and 32, are the same in both proceedings.

<sup>12</sup> The presence in the record of Kicking Horse’s pleaded and unchallenged registration of KICK ASS for coffee eliminates priority as an issue with respect to those goods. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012).

<sup>13</sup> There are multiple goods in the Class 25 and Class 32 identifications of goods in Critchley’s registration and in the Class 32 identification of goods in his application. “[L]ikelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to

943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *WeaponX Performance Prods. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

### **A. Priority**

In a Section 2(d) case, the plaintiff “must show proprietary rights in the mark that produces a likelihood of confusion.” *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981)). “These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko*, 64 USPQ2d at 1378.

In a cancellation, where both parties own registrations, each party can rely for priority purposes on the filing date of the application that matured into that party’s registration, in the absence of evidence of earlier use of that party’s mark. *See, e.g., Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1283-84 (TTAB 1998). The March 4, 2002 constructive use priority filing date of the application that matured into Kicking Horse’s registration for coffee predates the December 16, 2005 Section 44(d) priority filing date for the application that matured into Critchley’s registration, and Critchley has not presented any evidence to establish an earlier priority date.

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*any* [good] that comes within the recitation of [goods] in that class.” *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1033 (TTAB 2016) (emphasis in original) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981)).

Moreover, Critchley has “accept[ed] that [Kicking Horse] has demonstrated priority in the mark KICK ASS for use in connection with ‘coffee,’ in Class 30 based on its ownership of U.S. Reg. No. 2,896,141.” 43 TTABVUE 9. Accordingly, we find that Kicking Horse has priority with respect to its pleaded registration of KICK ASS for coffee vis-à-vis Critchley’s registration in the cancellation, and, as noted above, priority is not an issue in the opposition.

### **B. Likelihood of Confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all probative facts in evidence that are relevant to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (*du Pont* “articulated thirteen factors to consider when determining likelihood of confusion”). “Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered,” *id.* (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010)), but all factors “‘must be considered’ when [they] are of record.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (quoting *In re Dixie Rests, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (internal quotation omitted)).

As Kicking Horse correctly points out, “similarity of the marks and relatedness of the goods tend to be the two key determinants of likelihood of confusion.” 42 TTABVUE 19 (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes

to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”)). Kicking Horse also discusses the third *du Pont* factor, the “similarity or dissimilarity of established, likely-to-continue trade channels,” *du Pont*, 177 USPQ at 567, 42 TTABVUE 24-25; the fourth *du Pont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. ‘careful, sophisticated purchasing,” *du Pont*, 177 USPQ at 567, 42 TTABVUE 25; and the sixth *du Pont* factor, the “number and nature of similar marks in use on similar goods.” *du Pont*, 177 USPQ at 567, 42 TTABVUE 25-27.

Critchley largely agrees with Kicking Horse that the relevant *du Pont* factors “are (1) the similarity or dissimilarity and nature of the goods, (2) the similarity or dissimilarity of the marks, (3) the similarity or dissimilarity of established, likely-to-continue trade channels, and (4) the number and nature of similar marks in use on similar goods.” 43 TTABVUE 15. Critchley also argues, however, that “neither party has submitted any evidence on the issue of whether buyers of coffee, clothing, and energy drinks are either impulsive or particularly careful,” and that Kicking Horse has not “submitted any evidence or argument suggesting that its mark is famous.” *Id.*

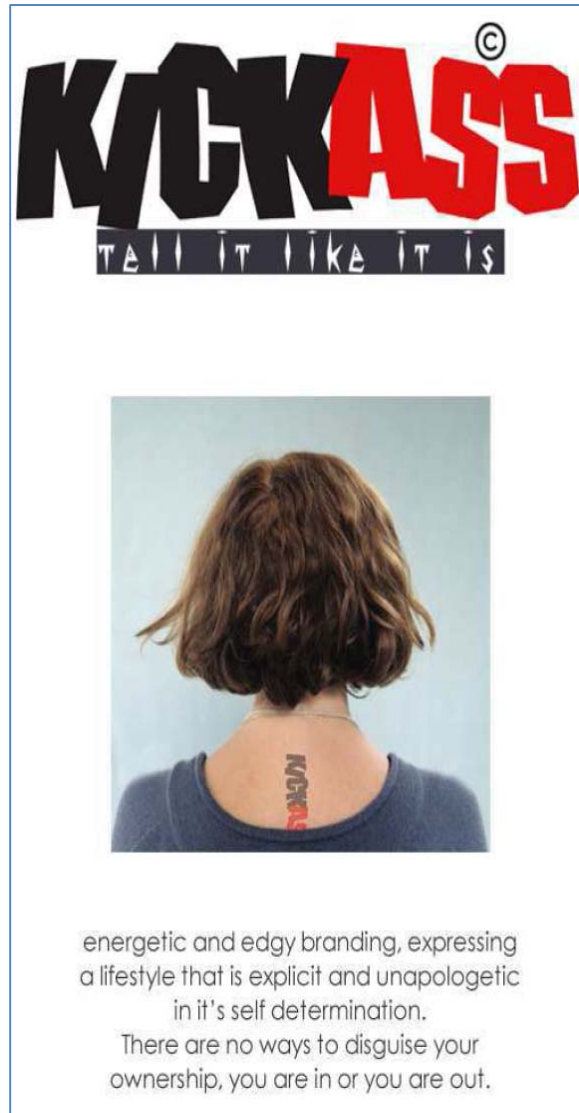
### **1. Similarity or Dissimilarity of the Marks**

The first *du Pont* factor is “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Critchley

“concedes that the marks at issue are identical.” 43 TTABVUE 21. He argues, however, that Kicking Horse’s KICK ASS mark “is weak . . . and is therefore entitled to a limited scope of protection” because “kick ass” is a “largely laudatory term,” *id.* at 23, that is used by both Kicking Horse and third parties “to extol the qualities of food and beverages.” *Id.* at 21.

Even if KICK ASS for coffee is laudatory, and thus somewhat suggestive, its nature does not negate the impact of the identity of the conflicting marks in the overall *du Pont* analysis because the record shows that KICK ASS has the same meaning when it is used by both parties. In denying reconsideration of its ruling on the previous appeal, the Board panel found that “KICK ASS in regard to the involved goods [coffee and fruit drinks] has the same meaning and commercial impression; the meaning and commercial impression of the mark does not change when used on applicant’s or registrant’s goods.” 36 TTABVUE 5-6 (Serial No. 78877552) (citing DICTIONARY OF AMERICAN SLANG AND COLLOQUIAL EXPRESSIONS)).

Here, Critchley does not argue, and the record does not show, that KICK ASS has a different meaning when it is used as a mark for non-coffee related energy drinks or clothing. Exemplars of Critchley’s intended uses of KICK ASS, identified at his testimony deposition to show the bona fides of his intention to use the mark in the United States, suggest that KICK ASS will have essentially the same connotation when it is used for coffee, energy drinks, or clothing. We reproduce some examples below:

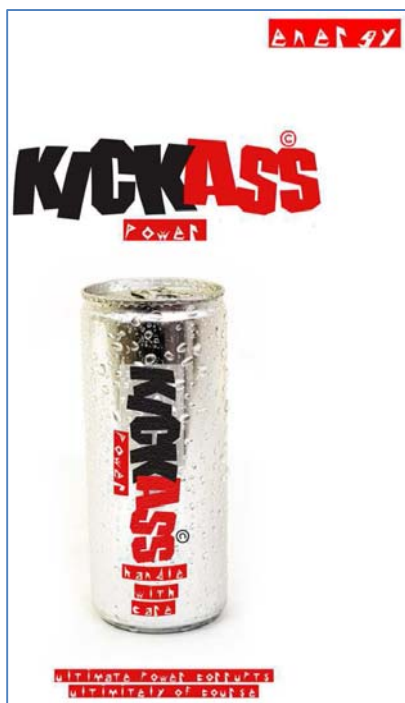


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<sup>14</sup> 39 TTABVUE 62; Ex. 10. Critchley testified that this image and others in Exhibit 10 to his testimony deposition were created for a presentation pack and brochure by a designer employed by a company with whom Critchley was negotiating regarding possible representation in the United States. Answers to 55 Direct, 57 Direct, 81-83 Direct; Ex. 10. He testified that he was not sure whether these materials were presented to potential licensees in the United States, Answers to 85-86 Direct, but he argues in his brief that these "logo designs, clothing designs and energy drink designs, all relat[e] to the KICK ASS mark" that he claims he intends to use in the United States, 43 TTABVUE 10, and we find them probative of the intended and likely meaning of the mark.





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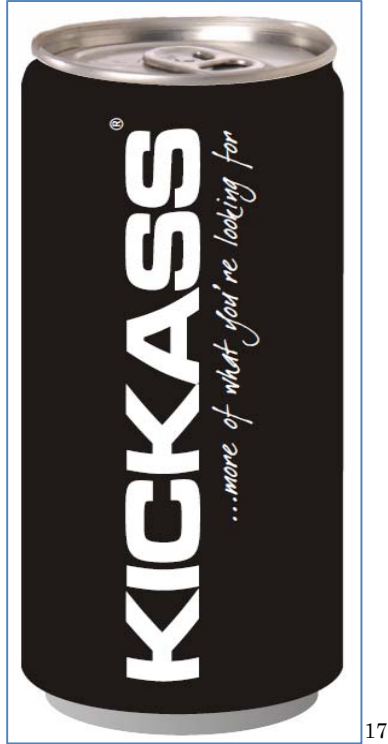


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<sup>15</sup> 39 TTABVUE 73.

<sup>16</sup> *Id.* at 67.



The identity of the marks in appearance, sound, and meaning causes the first *du Pont* factor to support a finding of a likelihood of confusion. *See, e.g., In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (affirming that Board “correctly determined that the first *DuPont* factor ‘weighs heavily’ in favor of a likelihood of confusion” where subject marks were identical and citing *In re Majestic Distilling Co.*, 315 F.3d 1201, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (“when word marks are identical but neither suggestive nor descriptive of the goods associated with them, the first *DuPont* factor weighs heavily against the applicant”)); *cf. Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720-22 (Fed. Cir. 2012) (COACH marks that were identical in sound and appearance

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<sup>17</sup> 39 TTABVUE 83. Critchley testified that this image and others regarding KICK ASS energy drinks were shown to prospective licensees in the United States. Answers to 87-93 Direct; Ex. 11.

had different connotations as applied to the subject goods, and the first *du Pont* factor thus favored the applicant); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1929 (TTAB 2006) (TUNDRA marks that were identical in sound and appearance “convey[ed] somewhat different meanings and commercial impressions in connection with clothing and automobiles”). We turn next to the issue of the strength of the registered KICK ASS mark for coffee and third-party KICK ASS marks.

## **2. The Strength of the KICK ASS Mark for Coffee and the Number and Nature of Similar Marks in Use on Similar Goods<sup>18</sup>**

Critchley invokes the sixth *du Pont* factor, 43 TTABVUE 22-23, which “considers ‘[t]he number and nature of similar marks in use on similar goods.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *du Pont*, 177 USPQ at 567). “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by

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<sup>18</sup> Kicking Horse argues that Critchley’s position regarding weakness “appears disingenuous” because the KICK ASS mark is registered on the Principal Register. 44 TTABVUE 10. Kicking Horse’s KICK ASS mark for coffee was registered on the Principal Register without the requirement of a showing of acquired distinctiveness, and it is thus presumed to be inherently distinctive, *Tea Bd. of India v. Republic of Tea*, 80 USPQ2d 1881, 1899 (TTAB 2006), and at least suggestive because of the presumptions afforded the registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *See, e.g., In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517 (TTAB 2016); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1363 (TTAB 2007). That presumption is conclusive here as to the KICK ASS mark because the right to use the registered mark has become incontestable. 15 U.S.C. § 1115(b). But neither the fact that the KICK ASS mark is registered, nor its incontestability, establishes that it is strong. *Safer Inc. v. OMS Invests. Inc.*, 94 USPQ2d 1031, 1035-36, 1044 (TTAB 2010) (finding that incontestably registered DEER AWAY and DEER AWAY PROFESSIONAL marks were highly suggestive); *Fat Boys*, 118 USPQ2d at 1517-18 (finding that incontestably registered mark THE BLOB for giant inflatable floating air bags used to propel divers into the water, “although presumptively distinctive, is nevertheless weak as a source indicator” due to “usage evidence bearing on the public’s understanding of the term BLOB”).

a plethora of such similar marks that customers have been educated to distinguish between [such] marks on the bases of minute distinctions.” *Id.* at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693) (internal quotation omitted)). Here, Critchley admits that there are **no** distinctions between the marks, minute or otherwise, and he argues that “Kicking Horse’s KICK ASS mark is entitled to a limited scope of protection not necessarily because there is a crowded field of registered KICK ASS marks, but because the term is largely laudatory, and therefore weak.” 43 TTABVUE 22-23. He claims that “several third party registrations for marks including ‘KICK’ and ‘ASS,’” combine with dictionary definitions of the term and descriptive third-party uses to “demonstrate[ ] that the term is weak.” *Id.* at 23.

We begin with the meaning of the term “kick ass.” In its adjectival form, the term “kick-ass” is a mildly impolite expression that has various meanings, including “strikingly or overwhelmingly tough, aggressive, powerful or effective,” 29 TTABVUE 13 (MERRIAM-WEBSTER DICTIONARY), “extremely good or of a high quality,” *id.* at 15 (MACMILLAN DICTIONARY), and “cool,” “great,” and “something that’s really awesome.” *Id.* at 17 (URBAN DICTIONARY).<sup>19</sup> Kicking Horse has used “kick ass” in these senses to convey that its coffee “is guaranteed to kick ass,” *id.* at 54, and that it makes “coffee that kicks ass.” 40 TTABVUE 9. Its website uses “kick ass” in both its adjectival and

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<sup>19</sup> The “Urban Dictionary (urbandictionary.com) is a slang dictionary with definitions submitted by visitors to the website.” *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2061 n.3 (TTAB 2013). The “Board will consider dictionary definitions taken from Urban Dictionary so long as the non-offering party has an opportunity to rebut that evidence by submitting other definitions that may call into question the accuracy of the particular Urban Dictionary definitions.” *Id.* Kicking Horse has not challenged the Urban Dictionary definitions, and we will consider them, together with the other dictionary definitions, for whatever probative value they may have.

verb forms, in asking “How do we produce the most kick ass coffee there is?” 29 TTABVUE 55, in explaining “How to Brew a Kick Ass Cup at Home,” *id.* at 56, and in urging consumers of its coffee to “Wake Up & Kick Ass.” 40 TTABVUE 6.

The record reflects use by third parties of “kick-ass” or “kick ass” in connection with mudslide cocktails, 29 TTABVUE 61, coffee, *id.* at 66, 137,<sup>20</sup> party punch, *id.* at 85, tea, *id.* at 146, and sangria, *id.* at 182, and with a host of food products and services, and food preparation advice. *Id.* at 60, 63-64, 70-84, 91-136, 143-145, 151-181, 184-321. Nearly all of these uses are non-trademark uses of the terms “kick ass” or “kick-ass,” in their adjectival form.<sup>21</sup> The only clear uses of KICK ASS as source-identifiers are the Best Ever Kick-Ass Mudslide, *id.* at 61-62, KICKASS beef jerky, *id.* at 63-64, Kick Ass Coffee Co., *id.* at 66-69, and Kick Ass Kitchen. *Id.* at 156-159.

Kicking Horse argues that “the fact that others use the phrase ‘Kick Ass’ does not demonstrate weakness, because some of these uses have been challenged and others are for unrelated goods.” 44 TTABVUE 10. There is nothing in the record showing that any of the uses have been challenged, and against the backdrop of the various dictionary definitions of “kick ass,” the multiple descriptive third-party uses collectively show that “kick ass” is a laudatory term. We thus agree with the Board

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<sup>20</sup> One of these uses involves a recipe for “A ‘Kick Ass’ Mocha” using Kicking Horse’s KICK ASS coffee beans. 29 TTABVUE 137-142.

<sup>21</sup> Examples include “Can Kick-Ass Food Sell Cars?”, 29 TTABVUE 87-90, “How to make a kick-ass Roast Chicken,” *id.* at 91-96, “support us on kickstarter to build a kick ass food truck,” *id.* at 97, “A Guy’s Guide to Cooking Kick-Ass Food,” *id.* at 99-103, “L’s Kick-Ass Minestrone Soup,” *id.* at 109-117, “Kick Ass Chicken Lasagna,” *id.* at 117-136, “Easy DIY Kick Ass Thai Food,” *id.* at 151-153, “Kick-Ass Mashed Potatoes,” *id.* at 160-168, “Kick Ass Rice,” *id.* at 206-207, “Kick-Ass Vegetarian Chili,” *id.* at 211-213, “Kick Ass Morning Muesli,” *id.* at 219-223, and “11 Kick Ass Cinnamon Roll Recipes.” *Id.* at 254-269.

panel on the previous appeal that the KICK ASS mark for coffee “does have some suggestive connotation in relation to the goods.” 38 TTABVUE 4 (Serial No. 78877552).

Critchley also made of record 11 third-party registrations of marks containing the words KICK and ASS in support of his claim that KICK ASS is weak. 40 TTABVUE 37, 48-55, 65-68.<sup>22</sup> There are problems with both the quantity and quality of this evidence.

While there is no minimum number of third-party marks required to show weakness, 11 registrations,<sup>23</sup> coupled with two common law uses of KICK ASS marks,<sup>24</sup> are a relatively small number compared to the number of such marks in cases that have found weakness based on those marks. *See, e.g., Inn at St. John’s*, 126 USPQ2d at 1746 (four third-party registrations and no third-party uses were “a far cry from the large quantum of evidence of third-party use and third-party registrations that was held to be significant” in the Federal Circuit’s decisions in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports*,

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<sup>22</sup> In addition to the registrations, Critchley made of record two third-party applications to register KICK ASS-formative marks, together with their specimens of use. 40 TTABVUE 38-47, 56-64. “[P]ending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018) (citing *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007)). We have given the applications and their specimens no weight in our analysis under the sixth *du Pont* factor.

<sup>23</sup> The number of different entities who have registered KICK ASS-formative marks is actually 10 because the registrations of KICK YO ASS and KICK YO’ ASS HOT have the same owner. 40 TTABVUE 48-49 (Registration Nos. 3919326 and 3919322).

<sup>24</sup> As discussed below, two of the four examples of third-party trademark use of KICK ASS involve the use of registered marks.

*S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 Fed. Cir. 2015)).<sup>25</sup> Cf. *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1427-28 n.92 (TTAB 2018) (67 third-party registrations and numerous uses of TRADER-formative marks showed that the formative was weak and could not form the basis of petitioner’s claimed family of marks); *i.am.symbolic*, 123 USPQ2d at 1751 (where the conflicting marks were identical, evidence of the coexistence of the cited registered mark with two third-party registrations of the same mark for the same or similar goods “falls short of the ‘ubiquitous’ or ‘considerable’ use of the mark components present in” *Jack Wolfskin* and *Juice Generation*). The Federal Circuit has held that “extensive evidence of third-party use and registration ‘is powerful on its face,’ even where the specific extent and impact of the usage has not been established,” *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation*, 115 USPQ2d at 1674-75), but because there is no such “extensive” evidence here, we must scrutinize the third-party marks carefully to determine whether they show that the KICK ASS mark for coffee is weak.

Critchley made of record evidence of use of only two of the registered marks, KICKASS for jerky and BEST EVER KICK-ASS alcoholic cocktails, 29 TTABVue 61-64, as well as use of the apparent common law marks Kick Ass Koffee Co. for a

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<sup>25</sup> In *Jack Wolfskin*, there were at least 14 third-party registrations and uses of paw print marks that showed the weakness of that design element in the opposer’s mark, 116 USPQ2d at 1136 n.2, while in *Juice Generation*, there were approximately 26 third-party registrations and uses of marks containing the words “Peace” and “Love” that showed the weakness of those words in the opposer’s marks. 115 USPQ2d at 1673 n.1.

coffeehouse in Astoria, Oregon, and Kick Ass Kitchen for a restaurant in east Los Angeles, California. *Id.* at 66-69, 156-159. There is no evidence of the extent or duration of any of these uses, however, or of the degree of their exposure to consumers in the United States.<sup>26</sup> In the absence of such evidence, we cannot conclude that these uses have weakened the KICK ASS mark for coffee.

With respect to the registrations per se, five cover some form of clothing,<sup>27</sup> one covers prepared alcoholic cocktails,<sup>28</sup> one covers non-alcoholic cocktail mixes, hot sauce, and other foods,<sup>29</sup> one covers hot sauce alone,<sup>30</sup> and the others cover cheese,<sup>31</sup> jerky,<sup>32</sup> and a prepared beef filet.<sup>33</sup> None covers coffee or energy drinks.

The five registrations for clothing show marks containing the words KICK ASS and other words. While they indicate that multiple KICK ASS-formative marks for clothing can coexist based on the differences between them, they tell us little, if

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<sup>26</sup> The coffeehouse use has particular potential relevance, but we note that it is described in reviews on tripadvisor.com as a “little coffee drive-through,” and a “great little coffee shop” located in a “small building.” 29 TTABVUE 67. Whether or not that is true, we cannot find, on the basis of a handful of reviews alone, that there has been significant exposure of the Kick Ass Koffee Co. mark.

<sup>27</sup> Registration Nos. 4978914 of KICK ASS VEGETABLES and design (40 TTABVUE 54-55); 2039645 of KICK ASS LIMITED and design (*id.* at 65); 4929030 of GKA GIRLS KICK ASS (*id.* at 66); 4864534 of ENTREPRENEURS KICK ASS (*id.* at 67), and 4401243 of KICK ASS KENTUCKIAN (*id.* at 68). Two of the registrations also cover a few other goods and services.

<sup>28</sup> Registration No. 2235525 of BEST EVER KICK-ASS on the Supplemental Register (*id.* at 51).

<sup>29</sup> Registration No. 3919322 of KICK YO’ ASS HOT! (*id.* at 49).

<sup>30</sup> Registration Nos. 3919326 for KICK YO ASS (*id.* at 48-49). This registration has the same owner as the registration of KICK YO’ ASS HOT!.

<sup>31</sup> Registration No. 5011427 of KICK-ASS (*id.* at 37), which issued under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), without a showing of use in commerce.

<sup>32</sup> Registration No. 4026000 of KICKASS (40 TTABVUE 50).

<sup>33</sup> Registration No. 1696285 of KICK ASS FILET (*id.* at 53).



anything, about the strength of KICK ASS alone for coffee, or whether KICK ASS alone for coffee, and KICK ASS alone for clothing or energy drinks, are confusingly similar. *See Inn at St. John's*, 126 USPQ2d at 1745-46. The third-party registrations for the various beverages and foods, all but two of which also show marks consisting of the words KICK ASS together with other words, similarly have little, if any, probative value regarding the weakness of KICK ASS for coffee in the absence of evidence that those foods and beverages are goods that are related to coffee. *Id.* at 1745; *i.am.symbolic*, 123 USPQ2d at 1751; *cf. Omaha Steaks*, 128 USPQ2d at 1693-95 (finding that third-party uses of Omaha-formative marks had to be shown to be related to the particular goods at issue to have probative value on the weakness of the opposer's OMAHA STEAKS mark); *Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

The sixth *du Pont* factor is neutral in our analysis of likelihood of confusion.

### **3. Similarity or Dissimilarity of the Goods**

The second *du Pont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.’” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *du Pont*, 177 USPQ at 567). Our analysis under this factor is based on the identifications of goods in the application and registrations. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). “[L]ikelihood of confusion can be found ‘if the respective products are related in some manner and/or if the circumstances surrounding their marketing are such that they

could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs.*, 101 USPQ2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

“The degree of ‘relatedness’ must be viewed in the context of all the factors, in determining whether the [goods] are sufficiently related that a reasonable consumer would be confused as to source or sponsorship.” *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Where, as here, the marks are identical, the degree of similarity between the goods required for confusion to be likely declines. *See, e.g., Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1117 (TTAB 2015). “[T]here need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists.” *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). *See also Shell Oil*, 26 USPQ2d at 1689; *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.18 (TTAB 2015); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009).

**a. Interpretation of the Identifications of Goods<sup>34</sup>**

**(i) Kicking Horse’s Registration for Coffee**

Kicking Horse’s pertinent registration covers goods identified as “coffee.” This identification is broad and unrestricted, and thus must be deemed to include “all the goods of the nature and type described therein,” *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006), but the parties dispute the “nature and type” of the goods.

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<sup>34</sup> The parties do not dispute the meaning of the various items of clothing identified in the Class 25 portion of Critchley’s registration.

Kicking Horse claims that Critchley construes the word to mean only “coffee beans,” 44 TTABVUE 9, while Critchley claims that Kicking Horse “adopts a broad definition of its own goods, which are limited to ‘coffee,’ to include not only coffee but also coffee-based beverages.” 43 TTABVUE 16.

Critchley similarly argued on the previous appeal that “‘coffee’ in [Kicking Horse’s] identification of goods is limited to ‘ingredients for making coffee beverages (i.e., ground coffee, coffee beans)’ as opposed to coffee beverages.” 36 TTABVUE 9 (Serial No. 78877552). The Board panel rejected that argument, finding that it was required to “presume that ‘coffee’ as broadly identified in the registration encompasses all types of coffee, including whole bean ground and roasted coffee, as well as coffee beverages.” *Id.* at 10 (citing MERRIAM-WEBSTER DICTIONARY). Critchley acknowledges here that “[c]offee’ means coffee beans or coffee brewed from ground coffee beans,” 43 TTABVUE 16, and he cites the same dictionary definition of “coffee” cited by the Board panel on the previous appeal, which he made of record here. 43 TTABVUE 16 (citing 29 TTABVUE 27).<sup>35</sup> Under this definition, “coffee” means “a beverage made by percolation, infusion, or decoction from the roasted and ground seeds of a coffee plant,” “coffee seeds especially roasted and often ground,” and “a dehydrated product made from brewed coffee <instant coffee>; *also*: a beverage made from this.” 29 TTABVUE 27.

After acknowledging the definition, Critchley proceeds to argue that there is no evidence “that ‘coffee’ should be interpreted in a way that it [sic] inconsistent with

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<sup>35</sup> Kicking Horse cites the same definition. 44 TTABVUE 9.

the plain meaning of the word,” 43 TTABVUE 16, and that “Kicking Horse’s apparent assumption that the term ‘coffee’ is broad enough to include coffee-based beverages is entirely lacking in support.” *Id.* He does not identify specific examples of this “apparent assumption,” however, or explain why the word “coffee” in the identification necessarily excludes all “coffee-based beverages,” which he does not define. The record shows that “coffee” includes brewed coffee, as well as “coffee-based beverages” sold in ready-to-drink form in which milk, sugar, or flavorings have been added to coffee.

We take judicial notice pursuant to Rule 201(b)(1) of the Federal Rules of Evidence that cream, milk, and/or sugar are commonly added to coffee when it is consumed, and the record shows that packaged ready-to-drink coffee, including espresso,<sup>36</sup> often contains milk and sugar,<sup>37</sup> or other pre-added flavorings.<sup>38</sup> These beverages are often expressly identified as “coffee,” and the fact that they contain additives does not transform them into something else. Such “coffee-based beverages” fairly fall within the agreed-upon definition of “coffee,” and we agree with the Board panel on the

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<sup>36</sup> The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed form or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). We take judicial notice that “espresso” is “coffee brewed by forcing steam or hot water through finely ground darkly roasted coffee beans.” MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on February 25, 2019).

<sup>37</sup> Examples include Starbucks’ “Iced Coffee + Milk” and “Doubleshot Energy Coffee Drink,” 25 TTABVUE 389, 434, and various cold brew coffee beverages sold under the “hi\*ball” mark. *Id.* at 392, 394, 397.

<sup>38</sup> Examples include Starbucks’ “Caramel Iced Coffee,” “Iced Coffee Caramel,” and “Vanilla Iced Coffee.” 25 TTABVUE 389.

previous appeal that “coffee” in Kicking Horse’s identification of goods includes “whole bean, ground and roasted coffee, as well as coffee beverages.” 36 TTABVUE 10 (Serial No. 78877552).<sup>39</sup>

**(ii) The Energy Drinks Identified in Critchley’s Registration and Application**

The parties focus solely on the goods identified as “energy drinks” in Class 32 in Critchley’s registration (“Energy drinks . . . excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient”) and application (“energy drinks, excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient”). These portions of the identifications contain express limitations on the nature and type of “energy drinks” in the form of exclusions from the coverage of that term. The parties disagree about the impact of the exclusions on the issue of the relatedness of the goods. Critchley argues that “Kicking Horse repeatedly refers to ‘coffee’ and ‘energy drinks,’ ignoring the fact that Critchley has expressly excluded “coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient.” 43 TTABVUE 16.<sup>40</sup> Kicking Horse responds that “consumers would certainly be

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<sup>39</sup> Critchley also argues that coffee “is a gourmet specialty item, generally sold in sealed bags or tins for brewing at home,” while “energy drinks are sold in small, metal cans for quick consumption.” 43 TTABVUE 17. Kicking Horse’s registration contains no limitation as to the packaging or delivery means for the goods identified as “coffee,” and, as noted above, the record shows that coffee is sold in ready-to-drink form in cans and bottles. We find that the word “coffee” in the identification covers ready-to-drink coffee sold in bottles and cans.

<sup>40</sup> Critchley goes so far as to claim that the “USPTO has already carefully considered the exact issue before the Board, and determined that the mark KICK ASS for ‘coffee’ and the mark KICK ASS for, *inter alia*, energy drinks excluding ‘coffee-flavored energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient’ can coexist.” 43 TTABVUE 23. This appears to be a reference to the resolution of Critchley’s district court

unaware of this limitation in Critchley’s applications,” and that, in any event, “energy drinks, whether offered with or without coffee or coffee flavoring, remain energy drinks, and are therefore related to coffee.” 44 TTABVUE 7.

We take judicial notice that “energy drink” means “a usually carbonated beverage that typically contains caffeine and other ingredients (such as taurine and ginseng) intended to increase the drinker’s energy.” MERRIAM-WEBSTER DICTIONARY (merriam-webster.com, last accessed on February 25, 2019). The record shows that there are a wide variety of energy drinks, and that there are many energy drinks that are not coffee flavored or based, and that do not contain coffee as an ingredient.<sup>41</sup>

**b. Relatedness of Coffee and Non-Coffee Related Energy Drinks**

Kicking Horse makes three arguments to show the relatedness of these beverages. First, Kicking Horse argues that the function of both is “to awaken or energize a consumer.” 42 TTABVUE 22. Kicking Horse claims that webpages and printed publications in the record show the use of the goods for this purpose, and compare their relative safety and efficacy. *Id.* Second, Kicking Horse argues that third-party

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appeal through the entry of the referenced amendment to the identification of the goods, and the USPTO’s subsequent approval of the amended application that matured into Critchley’s registration. The USPTO’s election not to pursue the Section 2(d) ex parte refusal further and to approve the amended application does not bind us in these inter partes proceedings. *See, e.g., McDonald’s Corp. v. McClain*, 37 USPQ2d 1274, 1277 (TTAB 1995) (in an inter partes proceeding following ex parte approval of an application, “we necessarily have the authority to reach whatever decision is supported by this record”).

<sup>41</sup> We refer to these drinks in this opinion as “non-coffee related energy drinks.” Examples include “hi\*ball” energy drinks flavored with pomegranate and acai, lemon lime, wild berry, vanilla, black cherry, 25 TTABVUE 392-95; Starbucks’ Blueberry Acai, Raspberry Pomegranate, and Strawberry Lemonade energy drinks, *id.* at 435-37, and energy drinks sold under the Red Bull and Red Devil marks, 29 TTABVUE 65-67, 120-21, as well as the numerous types of energy drinks shown on the websites of companies that Critchley describes as “major energy drink brands.” 43 TTABVUE 17 (citing 31 TTABVUE 65-121).

registrations of marks for both coffee and energy drinks “serve to suggest that . . . coffee and energy drinks . . . are [goods] that emanate from a single source.” *Id.* at 22-23. Finally, Kicking Horse argues that it “has made of record more than 25 examples showing the co-branding of coffee and energy drinks” and that these examples “are real world evidence of the relatedness of these goods.” *Id.* at 23.

We begin with Kicking Horse’s registration evidence.

[U]se-based, third-party registrations, although not evidence that the marks shown therein are in use or that the public is familiar with them, nonetheless have probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source under a single mark.

*Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (finding that third-party registrations covering both wine and water were probative of the relatedness of those beverages). *See also In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Critchley acknowledges that the record contains “31 active registrations that include both ‘coffee’ and ‘energy drinks.’” 43 TTABVUE 17. By our count, there are 35 such registrations,<sup>42</sup> but the discrepancy is inconsequential. Even though some of

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<sup>42</sup> Registration Nos. 4793269, 4765519, 4620762, 4542536, 4500898, 4856040, 4319026, 4089150, 4064851, 4676767, 4546441, 4649967, 4645461, 4635110, 4599681, 4595257, 4261589, 4504326, 4522691, 4369987, 4238545, 4238538, 4305814, 4332359, 4343043, 3772704, 3772667, 3681347, 4384167, 3862503, 3782242, 3861510, 3864878, 3593803, and 3114545 (25 TTABVUE 15-17, 21-23, 34-39, 43-48, 53-66, 71-76, 78-101, 106-111, 114-120, 157-175, 212-219, 234-236, 263-265, 284-297, 308-316, and 356-358). Consistent with our interpretation of the word “coffee” in Kicking Horse’s identification of goods, we have included registrations in which the word appears in the terms “iced coffee,” “prepared coffee,” “ground coffee,” and “coffee drinks, namely, coffee-based beverage containing milk.”

the registrations have common ownership,<sup>43</sup> the record shows that at least 20 different entities have registered their marks for goods identified as both “coffee” and “energy drinks,” which we deem to include non-coffee related energy drinks. *Jump Designs*, 80 USPQ2d at 1374. The registrations serve to suggest that coffee and non-coffee related energy drinks may emanate from the same source under the same mark. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009) (21 third-party registrations probative of relatedness of subject goods); *In re Anderson*, 101 USPQ2d 1912, 1919-20 (TTAB 2012) (numerous third-party registrations probative of relatedness); cf. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1356 (TTAB 2015) (although five third-party registrations were “limited in number,” “they nonetheless ha[d] probative value to the extent they serve to suggest that the identified goods are of a kind which are produced or marketed by a single source under a single mark”); *In re Davia*, 110 USPQ2d 1810, 1817 n.15 (TTAB 2014) (two third-party registrations of marks for pepper sauce and natural sweeteners were probative of relatedness of pepper sauce and agave sweeteners where record showed that agave “is a natural sweetener”).

We turn next to Kicking Horse’s use evidence. Evidence of the sale of different goods under the same mark is probative of their relatedness. *Id.* at 1355-56; *Davey*

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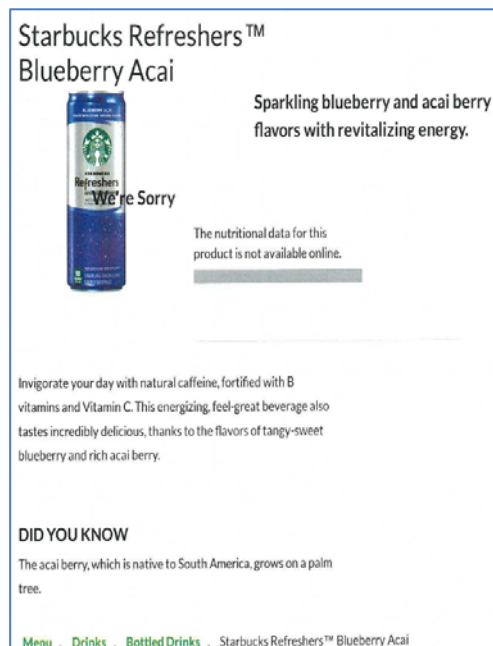
<sup>43</sup> These groups of commonly owned registrations are Registration Nos. 4620762, 4599681, 4504326, and 4500898 (Suja Life, LLC); Registration Nos. 4319026, 4089150, and 4064851 (Nature’s Best Distribution, LLC); Registration Nos. 4343043 and 4332359 (Orient Provision Trading Co. Ltd.); and Registration Nos. 3782242 and 3861510 (Cumberland Farms, Inc.).



*Prods.*, 92 USPQ2d at 1203. We reproduce below examples of webpages showing the sale of coffee and non-coffee related energy drinks:



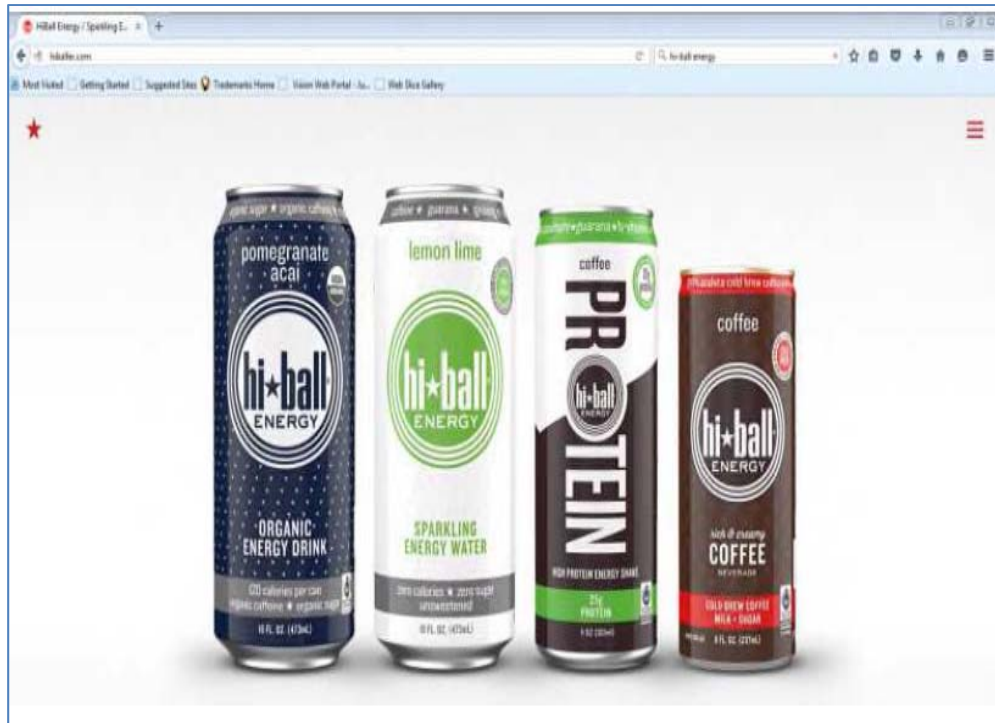
44



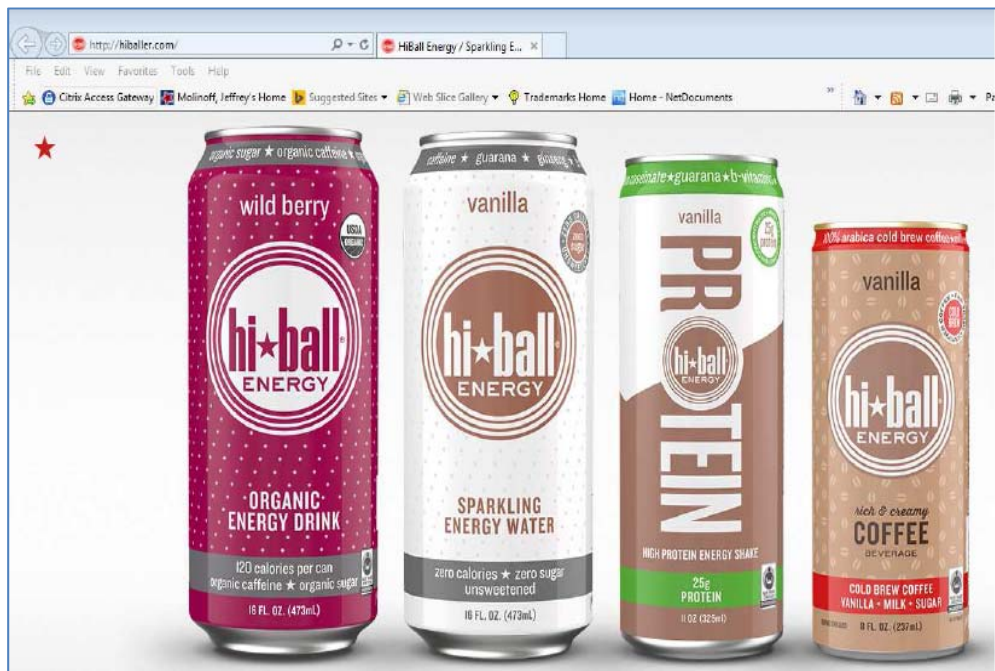
45

<sup>44</sup> 25 TTABVUE 389.

<sup>45</sup> *Id.* at 435-37. These non-coffee related drinks are not called “energy drinks” per se, but they fall within the meaning of that term given their touted ingredients, function, and effect.



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46 25 TTABVUE 392.

47 *Id.* at 394. For the reasons discussed above, the “Coffee Beverage” consisting of “Cold Brew Coffee” to which milk, sugar, and vanilla flavoring have been added falls within the definition of “coffee” in Kicking Horse’s goods identification.

**Dutch Classics**  
 - HOT OR ICED -  
 SMALL (10.99) MEDIUM (12.99) LARGE (14.99) EXTRA SHOT ADD 50¢

**Kicker.**  
The original silky blend of Irish Cream

**Annihilator.**  
Chocolate macadamia nut sensation

**Caramelizer.**  
Mocha spun with velvety caramel

**Cocomo.**  
Dazzling chocolate, coconut infusion

**White Chocolate Mocha**  
White and milk chocolate swirled mocha

**Chai Tea**  
Black tea, honey, vanilla, and spices

**911.**  
Intense blend of Irish Cream and 6 shots

**Double Torture.**  
Vanilla mocha with 2 extra shots

**Blended**  
 16oz. 24oz. 32oz.

**DUTCH FREEZE**  
A frosty, creamy, ESPRESSO blend, made from scratch

**DUTCH FROST**  
A frozen, creamy shake

**Real Fruit Smoothies**  
 WILDBERRY PEACH  
 BLUEBERRY POMEGRANATE  
 GREEN APPLE MANGO  
 STRAWBERRY

**Infused Teas & Sodas**  
**Dutch Tea**  
Black or Green, or infuse with your favorite flavor (Dutch blend)  
 SMALL MEDIUM LARGE  
**Dutch Soda**  
Add your favorite flavor, cream and top with whip

**Private Reserve**  
**Dutch Cocoa**  
Made from our very own creamy chocolate blend  
 SMALL MEDIUM LARGE  
**Americano**  
Private Reserve Espresso over water (hot or iced)  
 SMALL MEDIUM LARGE  
**DB CUPS**  
Dutch Bros. Private Reserve in the convenience of your home  
 SINGLE 1.5L 2L 3L 4L 5L 6L 7L 8L 9L 10L 11L 12L 13L 14L 15L 16L 17L 18L 19L 20L

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**Dutch Bros.**  
**BLUE REBEL**  
 ENERGY DRINK

**REBEL**  
 ENERGY DRINK

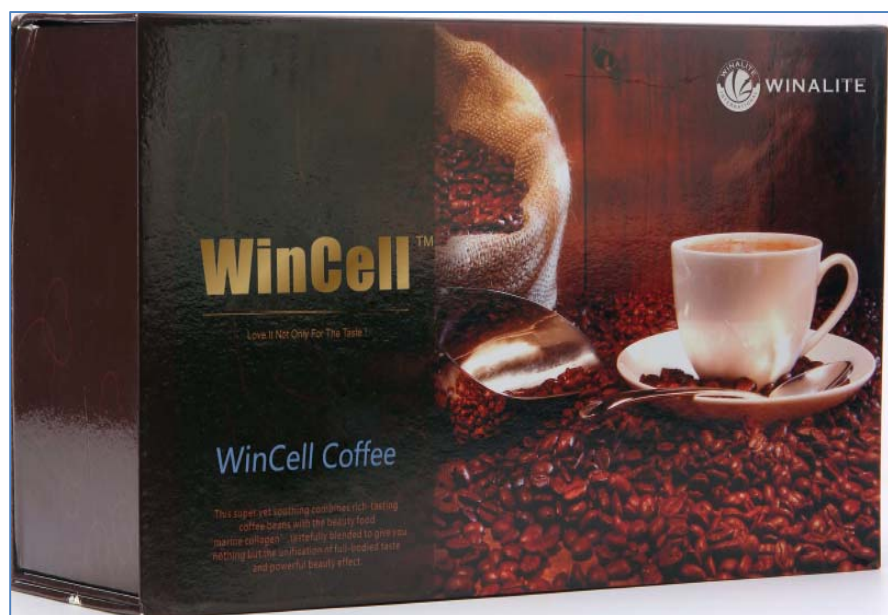
**Dutch Bros. Coffee**

49

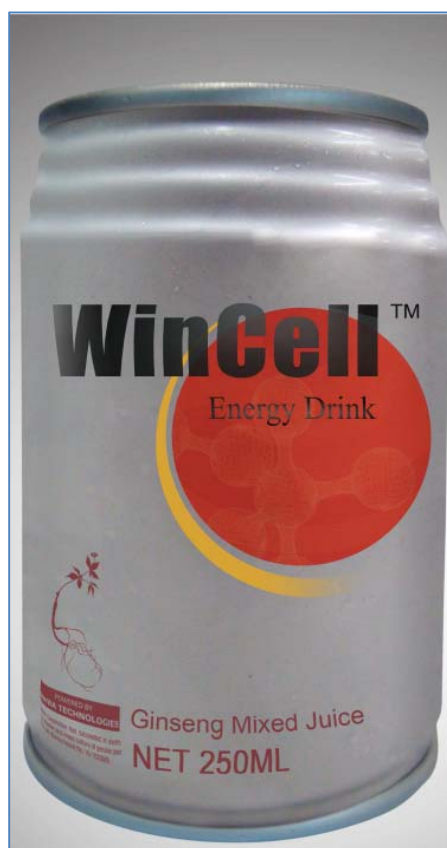
<sup>48</sup> 25 TTABVue 449.

<sup>49</sup> *Id.* at 451. Dutch Brothers owns Registration No. 4595257 for the mark DUTCH BROS., which covers “coffee and coffee-based beverages” and “energy drinks.” *Id.* at 98-101.





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<sup>50</sup> 25 TTABVUE 469.

<sup>51</sup> *Id.* at 470.

Critchley challenges both the quantity and the quality of this evidence. He claims that it is “vastly overstated” because “multiple brands appear more than once, with only 7 different owners represented,” 43 TTABVUE 17, and because “the majority of these companies are co-branding either coffee beans and coffee-based energy drinks (e.g. Starbucks) or coffee-based beverages and coffee-based energy drinks (e.g., Hi-ball Energy, Monster Energy, Killer Buzz, Rockstar Roasted Energy).” *Id.* at 18. He also argues that he “has made of record excerpts of the websites of twenty major coffee brands, none of which feature any co-branded energy drinks,” *id.* at 16-17 (citing 31 TTABVUE 9-64), as well as “excerpts of the websites of twenty major energy drink brands, none of which feature any co-branded coffee beans.” *Id.* at 17 (citing 31 TTABVUE 65-121).<sup>52</sup>

We agree with Critchley that the record shows that many coffee sellers do not sell non-coffee related energy drinks,<sup>53</sup> and that many energy drinks sellers do not sell coffee. The fact that many companies sell only one of those goods, however, does not negate Kicking Horse’s evidence that multiple companies do sell both under the same

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<sup>52</sup> Portions of many of the websites are barely legible or entirely illegible (e.g., 31 TTABVUE 69-71, 73, 79, 81, 83, 85-93, 103, 106-107, 109, 111-112, and 116). A party “has a duty to ensure that the evidence it submits is legible.” *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013) (citation omitted). We “can only review evidence that is clear and unobstructed,” and “we have considered this evidence to the extent it is legible and we are able to read the entire context of the evidence.” *Id.*

<sup>53</sup> Starbucks is not one of them, however, because, as shown above, it offers both coffee and non-coffee related energy drinks. 25 TTABVUE 389, 435-437. This is a significant omission from Critchley’s evidence because the Board found more than a decade ago that Starbucks is “one of the most famous brands in the world.” *See Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1751 (TTAB 2006). Critchley also included only one page from the Dutch Bros. website, 31 TTABVUE 45, and the record shows that Dutch Bros. offers both coffee and non-coffee related energy drinks. 25 TTABVUE 449-51.

mark. Kicking Horse's third-party use evidence is highly probative of the relatedness of the goods when considered together with its third-party registration evidence discussed above. *See, e.g., C.H. Hanson Co.*, 116 USPQ2d at 1355-56 (six websites showing sale of the subject goods, coupled with five third-party registrations of marks for them, "support the conclusion that the goods are related"); *Davey Prods.*, 92 USPQ2d at 1203 (two websites showing sale of the subject goods, coupled with 21 third-party registrations of marks for them, supported finding of relatedness).<sup>54</sup>

Finally, we address Kicking Horse's claim that coffee and energy drinks serve a similar function, "to awaken or energize a consumer." 42 TTABVUE 22. Evidence that different goods serve a similar function is probative of the fact that they may be viewed as coming from a common source when offered under the same mark. *Davia*, 110 USPQ2d at 1815 (agave sweeteners and pepper sauce found to be related in part because both are used as a condiment and are often used together).

Critchley concedes "that customers seeking to get an immediate energy boost might decide between purchasing an energy drink and a pre-made coffee-based beverage." 43 TTABVUE 18. Kicking Horse made of record several articles and webpages discussing the manner in which caffeinated drinks, including coffee and energy drinks, boost energy. 41 TTABVUE 6-47.<sup>55</sup> One article discusses "[s]lamming

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<sup>54</sup> We note that the Board panel on the previous appeal found that two third-party registrations of marks for both coffee and fruit drinks, coupled with two third-party uses of marks for both goods, showed that "purchasers would consider the same mark or highly-similar marks on such goods to emanate from the same source." 36 TTABVUE 11 (Serial No. 78877552).

<sup>55</sup> Internet webpages and printed publications are "admissible only to show what has been printed, not the truth of what has been printed." *Safer*, 94 USPQ2d at 1040. Kicking Horse's evidence is relevant for the limited purpose for which it is offered, namely, to show that coffee

an energy drink instead of slowly sipping coffee in the morning” and relates the results of a study at Washington State University addressing “the popular opinion that energy drinks create an unsafe ‘jolt’ of energy, while coffee provides a safer, more drawn-out buzz.” *Id.* at 19.<sup>56</sup> Other articles, one of which is entitled *Coffee v. energy drink: a jolt is a jolt*, discuss this study. *Id.* at 21-22, 46-47. Three webpages compare the caffeine content of energy drinks and coffee. *Id.* at 35-41, 44-45.<sup>57</sup>

In addition, some of Critchley’s own evidence reflects the similar functions of coffee and non-coffee related energy drinks. The website of 5-hour Energy asks what someone “hitting the wall” of fatigue would do, including “Run for the coffee?”, and states that the 5-hour Energy product has “as much caffeine as a cup of the leading premium coffee.” 31 TTABVUE 94. The website of the Bomba cherry energy drink states that “[f]or thousands of years people all around the world have used caffeine-rich drinks such as tea, coffee and cola to enhance their focus and give them a kick of energy.” *Id.* at 101. A page from the website of Hype Energy Drinks appears to show coffee beans as a typical source of caffeine. *Id.* at 112.

The record as a whole reflects a consumer perception that both coffee and energy drinks perform the similar general function of providing energy. This perception is

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and energy drinks are “discussed in the same news articles and/or compared as to safety and efficacy.” 41 TTABVUE 2.

<sup>56</sup> A summary of the study is also in the record. *Id.* at 42-43.

<sup>57</sup> Critchley argues that this evidence “also suffers from an over-inclusive definition of the ‘energy drinks’ at issue in this case.” 43 TTABVUE 18. The only specific article or website cited by Critchley discusses a college athlete’s creation of an energy drink from coffee, which Critchley dismisses as “irrelevant because Critchley’s goods exclude energy drinks made from coffee.” *Id.* The other materials discuss or display non-coffee related energy drinks as well as coffee-related ones.

probative of the relatedness of the goods, *Davia*, 110 USPQ2d at 1815, because it is consistent with a perception of a KICK ASS-brand non-coffee related energy drink as a line extension by the producer of KICK ASS coffee into another form of energizing beverage that appeals to different tastes or practicalities.<sup>58</sup>

The third-party use and registration evidence, the Internet and printed publication evidence, and the other materials in the record, collectively establish that there is more than a “viable relationship” between coffee and non-coffee related energy drinks. *See C.H. Hanson Co.*, 116 USPQ2d at 1355-56; *Davia*, 110 USPQ2d 1815-18; *Anderson*, 101 USPQ2d at 1919-20; *Davey Prods.*, 92 USPQ2d at 1202-03. The second *du Pont* factor supports a finding of a likelihood of confusion as to those goods.

### **c. Relatedness of Coffee and Clothing**

To show the relatedness of coffee and clothing, Kicking Horse relies principally on third-party registration and use evidence. 42 TTABVUE 23-24.<sup>59</sup> Kicking Horse claims that “[m]ore than 80 third-party registrations are of record,” *id.* at 23, and that

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<sup>58</sup> As noted above, Critchley dismisses this evidence because his “goods exclude energy drinks made from coffee,” 43 TTABVUE 18, but consumers confronted with a non-coffee related energy drink sold under the KICK ASS mark would be unaware that Critchley has excluded coffee related energy drinks from his claimed right to register that mark.

<sup>59</sup> Kicking Horse also invokes the “natural zone of expansion doctrine,” 42 TTABVUE 24, which it claims “dictates that [it] is entitled to protection of its brand in areas where it could be expected to expand its business.” *Id.* The doctrine of natural expansion is generally used in inter partes cases to show priority. *Orange Bang*, 116 USPQ2d at 1119. Under the doctrine, the first user of a mark in connection with particular goods or services “possesses superior rights in the mark as against subsequent users of the same or similar mark for any goods or services which purchasers might reasonably expect to emanate from it in the normal expansion of its business under the mark.” *Id.* (citation omitted). As discussed above, there is no issue of priority in these cases, and we need not apply the doctrine because the evidence is sufficient to enable us to determine whether the goods are related. *Id.*



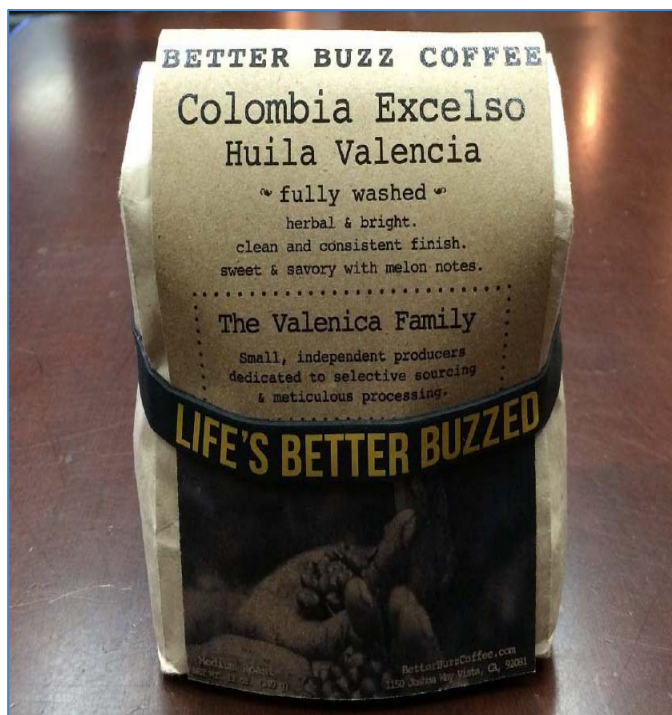
“evidence of actual use of the same marks for coffee and clothing is also abundant and of record,” *id.*, including evidence showing that “many beverage manufacturers offer branded clothing to strengthen marketing campaigns and brand recognition.” *Id.* at 24. We reproduce below representative examples of Kicking Horse’s evidence of use of the same mark for coffee and clothing:



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<sup>60</sup> 26 TTABVUE 360 (specimen of use in Registration No. 4841281).

<sup>61</sup> *Id.* at 359 (specimen of use in Registration No. 4841281).



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<sup>62</sup> 26 TTABVUE 369 (specimen of use in Registration No. 4793633).

<sup>63</sup> *Id.* at 368 (specimen of use in Registration No. 4793633).



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<sup>64</sup> 26 TTABVUE 392 (specimen of use in Registration No. 4742756).

<sup>65</sup> *Id.* at 391 (specimen of use in Registration No. 4742756).

Critchley primarily disputes the quality of this evidence. He concedes that “the third party registrations submitted by Kicking Horse show, at most, that 60 companies have registered marks for both coffee and clothing items.” 43 TTABVue 18. By our count, there are 74 active, use-based third-party registrations of marks for both coffee and one or more of the clothing items identified in Critchley’s registration,<sup>66</sup> and while there is considerable common ownership,<sup>67</sup> there are at least 50 different companies and individuals who have registered marks for both coffee and one or more of the clothing items identified in Critchley’s registration.

Critchley acknowledges that “third-party registrations may in some cases suggest relatedness,” *id.* at 18-19, but argues that “it’s clear from the specimens and other evidence of actual use that these are not really examples of ‘co-branding’ because none

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<sup>66</sup> Registration Nos. 4862645, 4862008, 4841281, 4702763, 4793633, 4787482, 4734307, 4591959, 4600316, 4639963, 4639859, 4639819, 4742756, 4742755, 4727131, 4707076, 4651408, 4648517, 4635440, 4635438, 4600130, 4591746, 4533532, 4525304, 4207049, 4716797, 4241681, 4806325, 4206464, 4434007, 3910864, 4201645, 4207138, 4635110, 4629285, 4621624, 4595257, 4595256, 4572688, 4515520, 4143339, 4143338, 4546259, 4391893, 4518831, 4452508, 4409982, 4357528, 4495718, 4382869, 4404663, 4404662, 4324275, 4316570, 4316569, 4286244, 4341097, 4278586, 4459706, 4442188, 4325464, 4183262, 4363122, 4502136, 4157537, 4332527, 4240414, 4538053, 4176490, 4180230, 4002371, 4176476, 3969498, and 3662079 (26 TTABVue 8-141, 147-294, 299-319, 326-332). A few of the registrations listed by Kicking Horse in its main brief are not in the record, and they are not listed above.

<sup>67</sup> These groups of commonly owned registrations are Registration Nos. 4702763, 4734307, and 4734308 (Halekulani Corporation); Registration Nos. 4591959 and 4600316 (DD IP Holder LLC); Registration Nos. 4639963, 4639859, 4639819, and 4639818 (Thrive Farmers International, Inc.); Registration Nos. 4742756 and 4742755 (PRL USA Holdings, Inc.); Registration Nos. 4651408, 4635440, and 4635438 (TAT & G, LLC); Registration Nos. 4600130 and 4591746 (owned by Tastefully Simple, Inc.); Registration Nos. 4595256 and 4595257 (owned by Dutch Bros. L.L.C.); Registration Nos. 4572688 and 4538053 (Starbucks Corporation); Registration Nos. 4143338 and 4143339 (PocoLoco, LLC); Registration Nos. 4409982 and 4357528 (Airship Coffee, LLC); Registration Nos. 4404662 and 4404663 (Philz Coffee, Inc.); Registration Nos. 4316569 and 4316570 (Cafe Moto); Registration Nos. 4176490 and 4180230 (Ben & Jerry’s Homemade, Inc.); and Registration Nos. 4002371 and 4176476 (Donut Joe’s, Inc.).

of these companies are actually in the clothing business” and that they are instead “simply putting their logos on t-shirts and hats to promote their coffee.” *Id.*

Critchley also argues more broadly that “[i]f Kicking Horse’s definition of relatedness were accepted, then clothing would be ‘related’ to an overly wide variety of otherwise completely unrelated goods and services,” *id.*, and that “just because it is common for trademarks to be used on collateral goods like clothes does not mean that clothing is related to every other conceivable product and services as a matter of law.” *Id.* (internal quotation marks omitted). According to Critchley, “[b]ecause customers understand that companies routinely sell, or give away, t-shirts and other promotional material bearing the mark of their primary goods or services, a finding of relatedness is not warranted in these circumstances.” *Id.*

In support of these arguments, Critchley cites three non-precedential Board decisions, *Collegetown Relocation, LLC v. Garan Servs. Corp.*, Opp. No. 91122058, 2004 TTAB Lexis 747 (TTAB December 29, 2004), *Walden Book Co. v. Brenntano Co., Ltd.*, Opp. No. 91085214, 1997 WL 796199 (TTAB December 29, 1997), and *CNL Tampa Int’l Hotel P’ship, LP v. Palazollo*, Opp. No. 91163724, 2007 WL 760521 (TTAB March 7, 2007), *id.* at 19-20;<sup>68</sup> two precedential Board decisions, *Standard Knitting, supra*, and *Dubonnet Wine Corp. v. Les Tricots Dubonnet Ltee.*, 156 USPQ 694 (TTAB 1968); and a federal district court case, *Michael Caruso & Co. v. Estefan Enters., Inc.*, 994 F. Supp.1454 (S.D. Fla. 1998). All are distinguishable.

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<sup>68</sup> “Non-precedential decisions are not binding on the Board, but may be cited to and considered for whatever persuasive value they may hold.” *In re Fiat Grp. Mktg. & Corporate Commc’ns S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014).

In *Collegetown Relocation*, the Board found that there was no admissible evidence of the relatedness of real estate relocation and educational information services and clothing, 33 TTABVUE 28-29 (Opp. No. 91122058), and that the opposer's reliance on the common promotional practice of using marks on collateral products, including its own claimed use, was insufficient where the opposer's mark was not famous or renowned. *Id.* at 27-30. In *Walden Book*, the Board found that the opposer's use of its mark on shirts worn by its employees, two registrations for both clothing and bookstore services and one instance of third-party use of a bookstore mark on clothing, were insufficient collectively to show that retail bookstore services and clothing were related. 1997 WL 796199, \*4.<sup>69</sup> The evidence of relatedness of coffee and clothing here is far stronger than the evidence of the relatedness of the goods and services was in either *Collegetown Relocation* or *Walden Book*.

In *CNL Tampa Int'l*, the Board found that clothing and restaurant services were not related where the only evidence of relatedness was an unspecified number of use-based third-party registrations of marks for both clothing and restaurant services.<sup>70</sup> 13 TTABVUE 8-11 (Opposition No. 91163724). The Board rejected the opposer's "natural zone of expansion" argument, which the Board found would apply "if the evidence shows that consumers would generally expect that restaurant services and shirts emanate from the same source," *id.* at 9, and found that the third-party

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<sup>69</sup> The Board's 1997 decision in this case is not available through the TTABVUE system.

<sup>70</sup> The Board noted that there were 102 third-party registrations in the record, 13 TTABVUE 3 (Opp. No. 91163724), but it considered only "the registrations based on use in commerce." *Id.* at 4. Although the number of such registrations appears to be large, it is not specified in the opinion.

registrations were insufficient to show relatedness where the opposer's mark was not famous or well-known. *Id.* at 10. The Board found that "opposer failed to offer persuasive evidence that [it] has prior rights in the mark PELAGIA used in connection with shirts." *Id.* at 11. The Board went on to say in what appears to be dicta that "if third-party registrations alone are considered sufficient to prove that goods and services are related, then virtually all consumer products and services would be related," and that "a per se rule regarding the relatedness of goods and services is contrary to trademark law which requires that each case be decided on the basis of all of the relevant facts in evidence." *Id.* at 12.

While we are mindful that we must avoid creating "a per se rule regarding the relatedness of goods and services," *id.*, "each case be decided on the basis of all of the relevant facts in evidence," *id.*, and we rely here on all of the relevant facts in evidence, including Kicking Horse's third-party registration and use evidence, and Critchley's admissions that "customers understand that companies routinely sell, or give away, t-shirts and other promotional material bearing the mark of their primary goods or services," and that "a number of coffee companies sell t-shirts to promote their café or company name." 43 TTABVue 19.

The precedential Board decisions are similarly inapposite. In *Standard Knitting*, the Board found that the opposer had failed to prove that clothing and automobiles were related where the opposer's relevant and admissible evidence consisted of a "number" of third-party registrations and evidence of the applicant's own use of the

subject mark for both goods. 77 USPQ2d at 1931 nn.25-26.<sup>71</sup> In *Dubonnet Wine*, the Board found that aperitif wine and clothing were not related where the “only circumstance or condition relied on by opposer herein to establish a relationship between ‘DUBONNET’ wine and ‘DUBONNET’ clothing is that . . . opposer has promoted its wine in connection with fashions for women’s garments.” 156 USPQ at 698. The record evidence here of numerous third-party registrations and multiple third-party uses is stronger in both quantity and quality than the evidence in these cases.

Finally, while we are not bound by district court decisions, the court’s opinion in *Michael Caruso & Co.* is also distinguishable. In that case, the court denied a motion for a preliminary injunction, finding that there was no likelihood of confusion between the marks BONGO for clothing and BONGOS CUBAN CAFE for restaurant services. The plaintiff’s evidence of the similarity of the goods and services was the fact that the defendant’s gift shop sold some clothing items under the defendant’s mark. 994 F. Supp. at 1461. The court found that neither point-of-sale confusion in the gift shop nor post sale confusion was likely because “the words ‘Cuban Cafe’ clearly delineate that Defendants’ clothing products are souvenirs from a restaurant,” *id.*, and “people are accustomed to clothing items that refer to services and establishments. The marks here are identical, and there is nothing on the face of Critchley’s applied-for

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<sup>71</sup> The exact number of the third-party registrations is not specified in the Board’s opinion. In addition, as discussed above, the TUNDRA marks in that case were identical in sound and appearance, but differed in meaning.



KICK ASS mark to indicate that clothing sold under that mark refers to Critchley and his beverages rather than to Kicking Horse and its beverages.

Critchley has failed to persuade us that we should apply a different standard for relatedness when the goods are clothing as opposed to energy drinks. More than 50 companies and individuals have registered their marks for both coffee and clothing, particularly shirts, and the record as a whole, including Kicking Horse’s use evidence and Critchley’s admissions, indicates that KICK ASS clothing would reasonably be viewed by consumers familiar with KICK ASS coffee as emanating from the coffee company, even if the coffee company is not “actually in the clothing business.” 43 TTABVUE 19. We find that there is at least a “viable relationship” between coffee and clothing sold under the identical mark, and the second *du Pont* thus supports a finding of a likelihood of confusion as to these goods.

#### **4. Similarity or Dissimilarity of Channels of Trade**

The third *du Pont* factor “considers [t]he similarity or dissimilarity of established, likely-to-continue trade channels.” *Detroit Athletic Co.*, 128 USPQ2d at 1052 (quoting *du Pont*, 177 USPQ at 567). We must assess the similarity of the trade channels by reference to the identifications of goods. *Id.*

Kicking Horse argues that the parties’ beverages “clearly travel through the same trade channels” because they are both “non-alcoholic products offered to the general public,” specifically to “people who are interested in an energy boost.” 42 TTABVUE 24. Kicking Horse argues that coffee and clothing are also purchased by the general public, that both beverages and clothing generally “can be purchased in convenience

stores, malls, retail stores and outlets, and even online,” and that “the trade channels through which these products are offered are the same.” *Id.* at 23-24. Critchley effectively acknowledges that “the goods at issue could all be sold in malls and retail stores,” but argues that this should “be given little weight given the wide variety of goods that can be purchased in large retail stores,” 43 TTABVUE 22, and that there “is no evidence in the record that coffee and energy drinks are likely to be displayed side by side on a shelf.” *Id.*

As shown above, coffee and non-coffee related energy drinks are offered on the websites of coffee companies such as Starbucks and Dutch Bros. Critchley “concedes that the goods at issue could all be sold online,” but argues that “this is not sufficient to establish that they are sold through the same channels of trade,” *id.*, citing *Parfums de Couer, Ltd. v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007). *Parfums de Couer* does not support Critchley. Although the Board held in that case that “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade” because the “Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet,” *id.* at 1021, the Board noted that “if the goods or services were promoted or offered through the same website, that might constitute a circumstance that could lead to likelihood of confusion.” *Id.* That circumstance exists here, and we can also infer from the presence of the goods on the same websites that they are also offered together in the brick-and-mortar outlets of the online sellers. The record thus shows at least some overlap in the channels of

trade for coffee and non-coffee related energy drinks beyond their acknowledged presence together in large retailers that carry a wide variety of goods. The third *du Pont* factor slightly supports a finding of a likelihood of confusion as to the beverages.

As shown above, there is also some evidence that coffee and clothing, including shirts, are also sold together in retail coffee stores, and Critchley concedes as much in stating that “the evidence of record shows that a number of coffee companies sell t-shirts to promote their café or company name.” 43 TTABVUE 19. The record thus shows at least some overlap in the channels of trade for these goods, and the third *du Pont* factor also slightly supports a finding of a likelihood of confusion as to Critchley’s Class 25 goods.

#### **5. Sophistication of Purchasers**

The fourth *du Pont* factor is the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ v. ‘careful, sophisticated purchasing.’” *du Pont*, 177 USPQ at 567. Kicking Horse argues that “the goods offered or to be offered by Opposer and Applicant are offered to the general public – not sophisticated purchasers,” and that “these customers are not exercising a higher-than-normal duty of care, and are susceptible to source confusion.” 42 TTABVUE 25. Critchley responds that “[n]either party has submitted any evidence on the issue of whether buyers of coffee, clothing, and energy drinks are either impulsive or particularly careful.” 43 TTABVUE 15.

We can infer from the identifications of goods that they may be purchased by members of the general public, but our determination under this *du Pont* factor must be based on the degree of care exercised by the least sophisticated purchasers of the

goods. *Stone Lion*, 110 USPQ2d at 1163. In the absence of any evidence regarding the purchasing habits of the least sophisticated purchasers of coffee, non-coffee related energy drinks, and various items of clothing, we find that this *du Pont* factor is neutral in our analysis of likelihood of confusion.

## **6. Section 18 Motion**

We turn finally to disposition of Critchley's pre-trial motion to amend his Class 32 identifications of goods in his registration and application pursuant to Section 18 of the Act, 15 U.S.C. § 1068, to cover solely "energy drinks, excluding coffee-flavoured energy drinks, coffee-based energy drinks, and energy drinks having coffee as an ingredient." The proposed amendment would delete the portion of the identifications on which the Board affirmed the refusal to register on the previous appeal.

Section 18 gives the Board the equitable power to restrict the goods or services identified in an application or registration. *See, e.g., Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013). To prevail on his motion, Critchley must show that the amendment will avoid a finding of a likelihood of confusion. *See Orange Bang*, 116 USPQ2d at 1111; *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co.*, 34 USPQ2d 1266, 1270 (TTAB 1994). The proposed amendment seeks to restrict the Class 32 identifications in his registration and application to the very goods on which we have analyzed likelihood of confusion, and have found it to exist. Critchley's motion would not alter that finding, and his motion is denied.

## **7. Conclusion and Summary of *du Pont* Factors**

All of the relevant *du Pont* factors support a finding of a likelihood of confusion, or are neutral. Kicking Horse's mark KICK ASS for coffee is slightly suggestive and thus somewhat weak conceptually, but the marks are identical in all respects, including in meaning, and the conceptual weakness of Kicking Horse's mark does not negate the impact of the identity of the marks in the balancing of the *du Pont* factors. The record shows that coffee and non-coffee related energy drinks have similar energy-providing functions and have been shown to emanate from the same source under the same marks. The record similarly shows that there is at least a viable relationship between coffee and clothing due to their common sourcing under the same marks, even if that sourcing reflects the promotion of coffee products. There is at least some overlap in the channels of trade for coffee, non-coffee related energy drinks, and clothing. The evidence of third-party use and registration of KICK ASS-formative marks is insufficient to weaken the KICK ASS mark for coffee commercially, or to suggest that consumers can distinguish the sources of coffee, non-coffee related energy drinks, and clothing sold under identical KICK ASS marks.

We find, on the basis of the record as a whole, that Kicking Horse proved, by a preponderance of the evidence, that consumers familiar with the KICK ASS mark for coffee who encounter non-coffee related energy drinks and clothing sold under the identical KICK ASS mark are likely to believe mistakenly that those goods originate with, or are sponsored or authorized by, the seller of KICK ASS coffee.

**Decision:** The opposition is sustained and the petition to cancel is granted.

Registration No. 4553724 will be cancelled in due course.