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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barrie House Coffee Co., Inc.

Serial No. 76695202

Myron Amer for Barrie House Coffee Co., Inc.

Jaclyn Kidwell Walker, Trademark Examining Attorney, Law
Office 112 (Angela Bishop Wilson, Managing Attorney).

Before Walters, Bucher and Wellington, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Barrie House Coffee Co., Inc. has filed an application
to register on the Supplemental Register the standard
character mark MOCCA for "coffee product, namely, coffee
beans, and not including coffee bean-derived coffee," in
International Class 30.¹

¹ Serial No. 76695202, filed January 9, 2009, based on use of the mark
in commerce, alleging first use and use in commerce as of December 22,
2008.

The examining attorney has issued a final refusal to register, under Section 23(c) of the Trademark Act, 15 U.S.C. 1091(c), on the ground that the word MOCCA is generic in connection with applicant's goods. The examining attorney has also based the final refusal on the grounds that the specimen of use does not show use of MOCCA as a trademark, and the identification of goods is indefinite.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We will address each of the bases for refusal in turn.

Specimen of Use

For completeness, we also address the refusals based on the specimen of use and the identification of goods. Considering, first, the specimen, the examining attorney contends that "the specimen is not acceptable because it is merely a photocopy of the drawing or a picture or rendering of the applied-for mark and does not show the applied-for mark in actual use in commerce on the goods or packaging for the goods." (Office Action, February 19, 2009.)

Applicant responds that the specimen is acceptable because it shows the stamping produced by the rubber stamp used to affix the mark to the packaging for the goods. The examining attorney contends that this explanation is insufficient because it does not show the rubber-stamped mark affixed to the goods or packaging, which the examining

attorney contends is required to show actual use of the mark in commerce on the goods or packaging.

Section 45 of the Trademark Act states that a mark is deemed to be in use in commerce

(1) on goods when -

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with goods or their sale, and

(B) the goods are sold or transported in commerce.

Trademark Rule 2.56(b)(1), 37 CFR 2.56(b)(1) provides:

(b)(1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

. . .

(c) A photocopy or other reproduction of a specimen of the mark as actually used on or in connection with the goods, or in the sale or advertising of the services, is acceptable. However, a photocopy of the drawing required by § 2.51 is not a proper specimen.

In *In re Crucible Steel Co. of America*, 150 USPQ 757 (TTAB 1966), the specimen was a tag with the mark stamped thereon and the Board held that the stamping of a mark on a tag or container for goods is sufficient to demonstrate use of the mark in commerce. Section 904.03(b) of the *Trademark Manual of Examining Procedure (TMEP)* recognizes the holding of this case; expressly permits stamping of the mark by rubber stamp or inking the mark using a stencil or template; and states, in reference to the situation herein, "[w]hen the specimen consists of a stamp on paper, the applicant must explain the nature of the specimen and how it is used." Applicant has clearly stated that its specimen is the stamping of the mark on a piece of paper using the rubber stamp that is used to affix the mark to the packaging for the coffee beans. Moreover, applicant has submitted the declaration of its Chief Operating Officer attesting to this fact. (Response March 9, 2009.)

The examining attorney has not made a case for the additional requirement of a photo or other copy of the actual packaging with the mark stamped thereon. In an analogous situation, the USPTO accepts labels and tags that applicant states are affixed to goods without requiring a photo or other copy of the product with the mark so affixed. The examining attorney is not in a position to doubt the veracity of applicant's statement as to the nature and use

of its specimen and mark - such issues, if they exist, are more appropriately exposed in *inter partes* challenges to the validity of a registration.

Therefore, the refusal based on the requirement for acceptable substitute specimens is reversed.

Identification of Goods

The goods are identified in the application as "coffee product, namely, coffee beans and not including coffee bean-derived coffee." The Examining Attorney has required applicant to delete the phrase "and not including coffee bean-derived coffee" from its identification of goods, stating that the phrase is unclear because it "can be read to imply that no goods are being provided." (Office Action of February 19, 2009.)

The application is based on applicant's assertion of use the mark in commerce on the identified goods. Section 1(a)(2) of the Trademark Act, 15 U.S.C. §1051(a)(2), requires that the written application specify the goods or services on or in connection with which applicant uses the mark. Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth "the particular goods" with which the mark is used or is intended to be used.

Further, the identification of goods or services must be specific and definite. See TMEP §§805 and 1402.01-

1402.01(a) (7th ed. 2010). It is within the discretion of the United States Patent and Trademark Office (USPTO) to require that the goods or services be specified with particularity. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein, rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998). As stated in TMEP §1402.01 (7th ed. 2010): "To 'specify' means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. ... The identification of goods or services must be specific, definite, clear, accurate and concise. ..."

The USPTO's *Trademark Acceptable Identification of Goods and Services Manual* ("Identification Manual") indicates that "coffee beans" is an acceptable identification of goods. "Coffee products" alone is indefinite and an unnecessary addition to applicant's identification; however, since "coffee products" is clearly limited by "namely, coffee beans," that portion of the identification is acceptable and is not challenged by the examining attorney. Regardless of whether we consider the additional phrase "and not including coffee bean-derived coffee" to modify "coffee beans" or "coffee product," the phrase is non-sensical and vague in the context of the identification of goods. The identification includes *only*

"coffee beans" so it is illogical to exclude coffee from that identification. Neither "coffee" (i.e., the drink derived from coffee beans) nor "coffee substitutes" (i.e., a drink that is not derived from coffee beans) is encompassed within "coffee beans." While we do not necessarily agree with the examining attorney that the noted phrase has the connotation she suggests,² we do agree that the addition of the phrase "and not including coffee bean-derived coffee" to the identification of goods renders the identification of goods as a whole so vague as to be unacceptable.

Therefore, the examining attorney's requirement for a more definite identification of goods is proper and well taken because the language proposed by applicant does not clearly and with the necessary specificity identify applicant's goods. See *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985).

Genericness

We start by noting that the examining attorney has also made an alternative refusal on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1). This refusal, while appropriate in an application on the Principal Register, became moot when applicant amended its application to seek registration

² "Based on the nature of coffee all coffee originally derives from a coffee bean unless otherwise specifically noted that it is some coffee-

on the Supplemental Register. Such an amendment is, essentially, an admission that its mark is not inherently distinctive.

The evidence of genericness submitted by the examining attorney consists of definitions from four dictionaries of the term "mocha" as "a rich pungent Arabian coffee"³; and excerpts from three websites describing the mocha coffee bean. The following are representative samples:

www.chestofbooks.com:

Among the coffees largely sold upon the American market are those which go by the name of "**Mocha.**" Because of the commercial value of the true **Mocha bean**, it becomes necessary to indicate the restrictions which must be placed upon the coffees put upon the market and sold under the name of "**Mocha.**" This matter has been fully investigated and valuable information obtained through the Department of State and from the consul and consular agent in those districts where the true **Mocha coffee** is grown and whence it is shipped to America and other parts of the world.

www.coffeeserviceplus.com:

What is Mocha Coffee? True **Mocha coffee** is produced in the Yemeni port city of **Mocha.** ... **Mocha** was the first type of coffee enjoyed by Europeans. ... **Mocha coffee beans** are rare and difficult to obtain. ... This is evident in the fact that **Mocha coffee** is distinguished for its heavy body and unique flavors that are absent from the nearby Ethiopian coffee.

www.ringsurf.com/online/2106-mocha.html:

While **Mocha** is a type of **coffee bean** that originates from the Yemeni port that has the

like substitute." Trademark Examining Attorney's brief at unnumbered 14.

³ *The American Heritage Dictionary* (4th ed 2000). The term is similarly defined in the excerpts of record from *Merriam-Webster Dictionary* (2009), *Dictionary of Food: International Food and Cooking Terms from A to Z* (2009), and *The Penguin English Dictionary* (2000).

distinction of being the type of **coffee bean** that made Europe pay attention to the smooth taste of **coffee**, the **Mocha** drink purchased in sophisticated **coffee** shops are completely different from this. While **Mocha coffee beans** may be used in making a **Mocha** drink, a **Mocha** drink is one that is made with **coffee** and cocoa.

"The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

Id. See also *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); and *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001).

The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." *In re Merrill Lynch, Fenner and Smith Inc.*,

828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). "Doubt on the issue of genericness is resolved in favor of the applicant." *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

The examining attorney contends MOCCA is only a slight misspelling of the word "mocha," which is a type of coffee bean; that the misspelling does not create a unique commercial impression or play on words; that the connotation and pronunciation of MOCCA is likely to be identical to that of "mocha"; and that MOCCA and "mocha" are equally generic terms in connection with the identified goods.

Applicant contends that the genus of goods is "a coffee beverage derived from coffee beans" and, therefore, since applicant has excluded coffee-bean derived coffee, its goods are not within this genus; and that the evidence is inapposite due to the different spelling of its mark.

As discussed in connection with the acceptability of the identification of goods herein, "coffee product, namely, coffee beans" is definite and acceptable; whereas, the addition of the phrase "and not including coffee bean-derived coffee" renders the identification as a whole nonsensical. Therefore, in conducting our analysis of the

issue of genericness, we have focused on the definite portion of the identification of goods, *i.e.*, applicant's goods are coffee beans.

The examining attorney has clearly established that "mocha" is a type of coffee bean. Considering the identification of goods in the context of the first part of the *Marvin Ginn* test for genericness, there is no question that the genus or class of goods involved herein is coffee beans.

We turn now to the second part of the *Marvin Ginn* test, *i.e.*, does the relevant public understand the word MOCCA to refer primarily to this genus of goods. There is no question that the relevant public for coffee beans is the general public, which encompasses all levels of purchasing care and sophistication.

We take judicial notice of the additional dictionary definition of "mocha" from the *Random House Dictionary* (2011):

[**moh**-kuh]

1. Also, **Mukha**, a seaport in the Republic of Yemen on the Red Sea. 25,000.
2. A choice variety of coffee, originally grown in Arabia.
3. A flavoring obtained from a coffee infusion or a combined infusion of chocolate and coffee.

While "mocha" may also describe a coffee drink that blends coffee and chocolate flavor, within the genus of coffee beans, the evidence clearly establishes that

purchasers will understand the word "mocha" as identifying a type of coffee bean and, thus, that "mocha" is a generic term in connection with coffee beans.

However, the question remains whether MOCCA is also a generic term in connection with coffee beans, *i.e.*, whether the misspelling renders it capable of functioning as a source-identifier.

The words MOCCA and "mocha" differ by only one letter in the middle/latter part of each word. The accepted pronunciation of "mocha," noted in the *Random House Dictionary* excerpt, is with the "ch" having a soft "k" sound. MOCCA is likely to have the same pronunciation as "mocha," regardless of whether it is the accepted pronunciation or another pronunciation. There is no evidence that MOCCA would be understood as having a different connotation from "mocha."

We conclude that the misspelling of the generic term "mocha" as MOCCA is immaterial; that among members of the relevant public who even notice the misspelling, MOCCA will be understood as naming the "mocha" coffee bean; and that, thus, under the two-part *Marvin Ginn* analysis, MOCCA is a generic term in connection with coffee beans, as identified in the application, because nothing is left for speculation or conjecture. See *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING would be perceived by consumers as the

equivalent of merely descriptive URBAN HOUSING); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007) (generic meaning of "togs" not overcome by the misspelling of the term as TOGGS); and *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock).

Decision: The refusal is affirmed based on the grounds that the mark is generic in connection with the identified goods, under Section 23(c) of the Act; and that the identification of goods is unacceptable because it is indefinite. The refusal is reversed based on the ground that the specimen of record is unacceptable to show use of the mark on any goods, under Sections 1 and 45 of the Trademark Act, 15 U.S.C §§1051, 1127. Because two of the three grounds for registration have been affirmed, registration to applicant is refused.