

This Opinion is Not a Precedent of the TTAB
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Hearings: July 17, 2018 (Serial No. 86689423)  
and November 21, 2018 (Serial No. 85792872)

Mailed: January 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board

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*In re Starbucks Corporation*

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Serial Nos. 85792872 and 86689423

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Julia Anne Matheson of Hogan Lovells US LLP  
for Starbucks Corporation.

Mark Rademacher, Trademark Legal Policy Office,  
Jennifer Chicoski, Administrator for Trademark Policy and Procedure.

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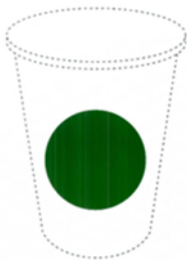

Before Adlin, Goodman and Heasley,  
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Starbucks Corporation seeks registration of two marks consisting of “a green circle placed centrally on the front exterior side of a white cup.” Although the two marks are not identical, and the grounds for their refusal are only partially similar, the records, arguments and evidence in the two appeals overlap enough that we decide both appeals in this single decision; “each appeal stands on its own merits,” however. *In re Hudson News Co.*, 39 USPQ2d 1915, 1916 & n.5 (TTAB 1996); *see also In re Supply Guys Inc.*, 86 USPQ2d 1488, 1490 (TTAB 2008).

## I. Background

Applicant seeks registration of the two marks summarized below:

<b>Application Serial No.</b>	<b>85792872</b> (the “872 Application”)	<b>86689423</b> (the “423 Application”)
Drawing of Mark		
Goods/Services	<p>“Coffee, tea, coffee and tea based beverages, and cocoa” in International Class 30; and</p> <p>“Restaurants, cafes, cafeterias, snack bars and coffee bars; carry-out restaurant and food preparation services” in International Class 43.</p>	<p>“Coffee-based beverages; cocoa; chocolate-based beverages; tea and herbal tea; tea and herbal tea-based beverages” in International Class 30; and</p> <p>“Restaurant, cafe, cafeteria, snack bar, coffee bar, tea bar, tea house, and carry out restaurant services; catering services; preparation of food and beverages; restaurant services featuring a customer loyalty program that provides restaurant benefits to reward repeat customers” in International Class 43.</p>
Description of Mark in Application	<p>“The mark consists of a green circle placed centrally on the front exterior side of a white cup. The broken lines depict the outline of the white cup and show the relative placement of the green circle. No claim is made to the portions of the drawing represented by the dotted lines nor the overall shape or size of the cup.”</p>	<p>“The mark consists of a green circle placed centrally on the front exterior side of a white cup. The colors green and white are claimed as elements of the mark. The color black appears simply to designate the shape of the elements comprising the mark and is not a part of the mark.”</p>
First Use Dates	March 8, 2011	September 2, 2008

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The Examining Attorney finally refused registration of the mark in the '423



Application because he found that Applicant's drawing of the mark ( ) is not a "substantially exact representation" of the marks shown on Applicant's two specimens, depicted below:



the "Package Specimen"



the "Counter Display Specimen."

The Examining Attorney finally refused registration of the mark in the '872 Application on several grounds. As with the '423 Application, he found that



Applicant's drawing of the mark in the '872 Application ( ) is not a

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“substantially exact representation” of the marks shown on any of Applicant’s six specimens, depicted below:



<sup>1</sup> Submitted with original application on December 3, 2012.

<sup>2</sup> The four specimens following the photograph of an actual coffee cup with a green “siren” logo in the center were all submitted with Applicant’s Office Action response of February 10, 2015.



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In addition, the Examining Attorney refused registration of the mark in the '872 Application because: Applicant did not describe the mark in the application as being three-dimensional; “the mark is not sufficiently associated with the services in the specimens of record;” and Applicant has not established that its mark has acquired distinctiveness.<sup>4</sup>

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<sup>3</sup> Submitted with Office Action response of November 17, 2015.

<sup>4</sup> The Examining Attorney also finally refused registration of the mark in the '872 Application on the ground that it is not inherently distinctive. Although Applicant appealed from this refusal as well as the others, 21 TTABVue 9, at the oral hearing it “conceded” on the question of inherent distinctiveness. Thus, Applicant now relies solely on its claim that the mark has acquired distinctiveness. In any event, as explained below in connection with Applicant’s claim of acquired distinctiveness, the mark in the '872 Application is not the type of mark likely to be perceived as a source indicator, and is protectable only upon proof of acquired distinctiveness. See e.g. *In re American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002) (“However, ordinary geometric shapes such as circles, ovals, squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof of acquired distinctiveness.”).



## II. Analysis

At the outset, we reject Applicant’s argument that the Examining Attorney’s refusals based on the Trademark Rules of Practice have “no basis in any statutory provision (or the common law or another authority carrying the force of law).” 8 TTABVUE 7 (’423 Application); 15 TTABVUE 21 (’872 Application). In fact, Applicant “shall comply with such rules or regulations as may be prescribed by the Director” of the Office, which include the Trademark Rules applied by the Examining Attorney in refusing registration of Applicant’s marks. 15 U.S.C. § 1051(a)(4). These rules and regulations include Trademark Rule 2.51(a), at issue in both of the involved applications. *See e.g. In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) (applying Trademark Rule 2.51(a) in considering an analogous refusal of registration). We now turn to the substantive refusals.

### A. The ’423 Application

The Examining Attorney argues that the “green circle” in Applicant’s drawing of the mark in the ’423 Application is “featureless,” while the instant coffee Package Specimen bears “an irregular green circle formed by paintbrush strokes”:



12 TTABVUE 3, 7.<sup>5</sup> More specifically, the Examining Attorney argues that the circle in the Package Specimen is “formed by paintbrush strokes, with the color green ranging in intensity over different parts of the circle due to the thickness of the paint applied to the surface.” *Id.* at 7. According to the Examining Attorney, the mark in the Package Specimen is different than the mark in the drawing because it “conveys the idea of ... the whimsy and fluidity of fluid paintbrush strokes.” *Id.* at 8.

The Examining Attorney argues that the Counter Display Specimen “features a white cup shown in perspective, suggesting three dimensions, and having accurate and integral details, such as creases and an opening in the lid, depicted in green lines. This second cup includes a solid green circle.” *Id.* at 7. Thus, according to the Examining Attorney, the Counter Display Specimen is different from the drawing because it “conveys the idea of a realistic cup in three dimensions ....” *Id.* at 8.

The Examining Attorney also contends that the mark in the drawing is not “part of” the marks shown in the specimens and does not make a “separable commercial impression” therefrom. *Id.*

Applicant contends that the Examining Attorney’s findings are inconsistent with both precedential Board cases and the Office’s treatment of certain third-party registrations that Applicant made of record.<sup>6</sup> 8 TTABVUE 13-20. It also argues that

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<sup>5</sup> Citations in this subsection are to the record in the ’423 Application.

<sup>6</sup> Applicant argues in its briefs that the refusal should be reversed based on the results of Dr. Leon Kaplan’s consumer survey to assess whether the marks in the ’872 Application and Applicant’s related but uninvolved application Serial No. 85792857 had acquired distinctiveness (“Kaplan Survey”). During the oral hearing, however, Applicant conceded that the Kaplan Survey is irrelevant to the refusal to register the mark in the ’423 Application. Indeed, the survey does not address whether the drawing in the ’423 Application

the differences between the drawing and the specimens are “minute,” and that “consumers confronted with [either specimen] come away with the impression of [Applicant’s drawing].” *Id.* at 9, 11.

Turning first to the Class 30 goods, we find that Applicant’s drawing is a “substantially exact representation of the mark as used” on the instant coffee Package Specimen. Trademark Rule 2.51(a). In fact, the cup in the drawing has the same shape as and appears identical to the cup in the specimen, as both cups are white and bear “a green circle placed centrally on the front exterior side.”

While the Examining Attorney is correct that the green circle in the drawing is “featureless,” while the green circle on the Package Specimen is not, the “features” of the specimen’s green circle are inconspicuous, negligible, and subordinate to the green circle in which they appear. In fact, unless a consumer is close to the green circle depicted in the specimen, its “features” would be imperceptible, or barely perceptible.<sup>7</sup> To the extent that the “fluid paintbrush strokes” in the specimen constitute “features,” they do not change the essence of the mark, which remains, at bottom, a “green circle.” Similarly, while the specimen’s circle is imperfect, especially on its left side, it remains a circle, and the degree of imperfection is minimal.

The “range in intensity” of the color green, caused by “the thickness of the paint applied to the surface,” presents a closer question, at least with respect to the darker

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“matches” the specimens of record. We discuss the survey below, however, in connection with the refusal to register the ’872 Application.

<sup>7</sup> We have considered the viewing distances from which typical coffee and restaurant service consumers would likely encounter Applicant’s marks.



green on the left side of the green circle in the specimen. However, the paint is still green, even if it is a darker green. We find that the shade of green in Applicant's drawing is a "substantially exact" representation of the green in the specimen, including the darker green to the left of the circle. In so finding, we have taken into consideration that Applicant claims the color "green" generally, rather than any particular shade(s) of green. *Cf. In re Cook Medical Technologies LLC*, 105 USPQ2d 1377, 1384 (TTAB 2012) (in the context of a Section 2(d) refusal to register a mark with a color claim, stating that the cited "mark is described only as the color 'blue' (applied to a certain part of the goods), and therefore we have considered the mark to be for any shade that would fall under the general term 'blue.' That is, we decide this ex parte appeal based on the information on the face of the cited registration; we do not read in limitations."); *Amsted Ind. Inc. v. West Coast Wire Rope & Rigging Inc.*, 2 USPQ2d 1755, 1760 (TTAB 1987) ("the likelihood of confusion issue must be determined based on the same presumption ... that the yellow color sought to be registered by West Coast Wire in respect of its wire rope can be any yellow color, including that which is identical to the yellow color used by Amsted"); *see also* TMEP § 1202.05(e) (Oct. 2018) ("if a mark includes gradations of color, the description should so indicate"). Here, Applicant has not claimed any particular shade of green. Of course, Applicant's drawing defines the scope of any rights arising from registration, but in this case, we find that the green in Applicant's drawing is a "substantially exact" representation of the shades of green in the Packaging

Specimen.<sup>8</sup>

Turning next to the Class 43 services, we find that Applicant's drawing, shown below on the left, is a "substantially exact representation of the mark as used" on the Counter Display Specimen, shown below on the right:



The Examining Attorney is correct that the specimen depicts the cup's lid differently than the drawing, perhaps "suggesting three dimensions." Under the circumstances of this case, however, we nevertheless find that the drawing is a substantially exact representation of the mark shown in the specimen. Both feature white cups with a "green circle placed centrally on the front exterior side," and this time the green circles appear identical, and at the very least have substantially exact features.

While the mark in the specimen has "creases and an opening in the lid, depicted in green lines," this distinction does not mean that the drawing is not a substantially

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<sup>8</sup> While Applicant and the Examining Attorney argue about whether the mark in the drawing creates a "separable" commercial impression from the mark in the Package Specimen, and both cite "mutilation" cases, neither argues that the Package Specimen presents a "mutilation" issue. We agree. We address mutilation below in our discussion of the Counter Display Specimen and the '872 Application.

exact representation of the mark in the specimen. According to Applicant's description of its mark, "[t]he color black appears simply to designate the shape of the elements comprising the mark ...." Here, the *shape* of the lid in the drawing is the same as the *shape* of the lid in the specimen, even if the specimen lid depicts a perspective view of creases and an opening and the drawing lid does not.

In any event, the absence of creases and an opening in the drawing is at most a minor alteration. Indeed, the essence of the mark is a white cup with a green circle, and the lid is but a minor detail, in both size and commercial impression. The creases and opening on the lid in the specimen are but a minor detail of this minor detail.<sup>9</sup>

We recognize that this is perhaps not a typical mutilation case, as the creases and opening on the lid are not analogous to a word mark, or to a typical feature of a design mark. *Cf. In re Frankish Enters., Ltd.*, 113 USPQ2d 1964 (TTAB 2015); *In re Supreme Steel Framing System Ass'n Inc.*, 105 USPQ2d 1385 (TTAB 2012); *In re Big Pig Inc.*, 81 USPQ2d 1436 (TTAB 2006); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB 1999). Nevertheless, Applicant still "has some latitude in selecting the mark it wants to register." *In re 1175856 Ontario Ltd.*, 81 USPQ2d 1446, 1448 (TTAB 2006). Furthermore, the cup depicted in Applicant's drawing "creates a commercial impression as an indication of origin separate and apart from" the creases and

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<sup>9</sup> In *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1420 (TTAB 2010), we observed that "the 'classic glass Coca-Cola Bottle' referenced in *Wal-Mart [Stores, Inc. v. Samara Brothers, Inc.]*, 529 U.S. 205, 54 USPQ2d 1065 (2000)], would be no less source indicating when served as an open container to a restaurant patron than when pulled as a closed container from a refrigerated display or store shelf by a consumer."

opening in the lid in the specimen. *In re Frankish*, 113 USPQ2d at 1974. As indicated, leaving the creases and opening in the lid out of the drawing is merely a “minor alteration” which does “not create a new and different mark creating a different commercial impression.” *Id.* (quoting *In re Schecter Bros. Modular Corp.*, 182 USPQ 694, 695 (TTAB 1974)). In fact, this case is analogous to *Schecter Bros.*, in which we found that the drawing of the mark (shown below on the left) is not a mutilation of the mark in the specimen (shown below on the right):



Indeed, the shadow in the specimen in *Schecter Bros.* is much larger and more distinctive, and thus a significantly greater alteration, than the creases and opening in this case.

Finally, under the circumstances of this case, we do not share the Examining Attorney’s apparent concern that the cup in the Counter Display Specimen is “shown in perspective, suggesting three dimensions.” In fact, both the drawing and the specimen are in two dimensions, even if they reveal depth as well as width and height.<sup>10</sup> Moreover, even if we agreed that the cup in the specimen is shown in

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<sup>10</sup> “No drawing of a trademark that is the subject of an application for registration is presented in true three-dimensional form. Even an application to register a configuration of a product depicts a mark in two-dimensional form, perhaps from a view that yields a

perspective suggesting three dimensions, that distinction between the specimen and drawing would be irrelevant in this case. There is no evidence upon which we could find that consumers would perceive a counter display bearing a two-dimensional picture of a cup any differently than the same counter display consisting not of a picture of the cup, but the cup itself. Nor is there any evidence or basis to find that consumers would perceive a cup shown in perspective any differently than the same cup shown without perspective. The commercial impression, in the context of coffee beverages and restaurant and café services, is the same — a white cup with a green circle placed centrally on the front exterior side.

For all of these reasons, we find that the drawing of the mark in the '423 Application is also a substantially exact representation of the mark in the Counter Display Specimen.<sup>11</sup> The refusal to register the mark in the '423 Application is therefore reversed.

## **B. The '872 Application**

Before addressing the merits of the refusals to register this mark, we overrule the Examining Attorney's and Applicant's objections to certain evidence.

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perspective of depth ...." *Duramax Marine LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1792 (TTAB 2006). The same is generally true of specimens, including in this case.

<sup>11</sup> One could question the Examining Attorney's assumption that the lid in the drawing does not include creases or an opening. While it is true that Applicant has *not claimed trademark rights* in creases or an opening, its drawing — which uses the color black only to designate *shape* — is broad enough to encompass lids of the shape shown in the Counter Display Specimen, whether or not those lids include openings or creases. Furthermore, takeaway coffee cups are now ubiquitous (a development for which, the record suggests, Applicant deserves much of the credit or blame), and we do not require evidence to recognize that many takeaway coffee cup lids include creases or openings. Therefore, consumers could very well assume from experience that the lid on the cup in the drawing in fact has creases and an opening, even if they are not visible in the drawing.

## **1. Evidentiary Objections**

The Examining Attorney objects to the Declaration of Ana B. Naydonov, an attorney with Applicant's former law firm, as untimely. While the Examining Attorney is correct that "[t]he record in the application should be complete prior to the filing of an appeal," Trademark Rule 2.142(d), in this case, as Applicant points out, the Examining Attorney failed to substantively address the Kaplan Survey for almost four years after it was originally submitted with Applicant's May 15, 2014 Office Action response.<sup>13</sup> TTABVUE.<sup>12</sup> The Naydonov Declaration merely recounts some of the history of Applicant's efforts to direct the Examining Attorney to the Kaplan Survey. While the declaration is ultimately irrelevant to our decision, we have considered it, as its late filing was the result of the Office's long delay in substantively commenting on the Kaplan Survey until after the appeal was filed.<sup>13</sup>

The Examining Attorney also objects to third-party Registration No. 4072993, because he contends that it was not properly introduced. However, it was timely and properly submitted with Applicant's November 21, 2017 Request for Remand. 11 TTABVUE 326-28; TBMP § 1209.04. The Examining Attorney's objections are therefore overruled.

Applicant's objection to the portions of the Examining Attorney's Appeal Brief that criticize the Kaplan Survey are also overruled. The criticisms are not a new basis for refusal, but rather provide more specific reasons for the refusal, and expand on

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<sup>12</sup> Citations in this subsection are to the record in the '872 Application.

<sup>13</sup> The Examining Attorney "recognizes that the prosecution of the application has been complicated," leading to "misunderstandings." 18 TTABVUE 8.



criticisms originally provided on remand. 13 TTABVUE.

## **2. Must Applicant Indicate That the Mark is Three-Dimensional?**

The Examining Attorney argues that Applicant's mark is three-dimensional and that under Trademark Rule 2.52(b)(2) "the applicant must indicate that the mark is three-dimensional." Applicant suggests in its Appeal Brief, 15 TTABVUE 15, and argued at the hearing, that its mark is "both" two-dimensional and three-dimensional, and that its description of the mark is sufficient. According to Applicant, consumers are able "to recognize a single mark across more than one dimension," and the Office has issued a number of registrations which "do not contain a 'dimensional' limitation," and "can be and are represented both two- and three-dimensionally in the specimens." *Id.* at 16-17.





Before addressing the merits, we should note that the Examining Attorney's position has been inconsistent. In the April 8, 2013 Office Action, the original examining attorney<sup>14</sup> found that functional elements of the mark (the cup), were depicted in solid lines in Applicant's original drawing, and required a new drawing depicting unclaimed portions of the mark in broken lines and describing it as three-dimensional. Applicant complied in its October 7, 2013 Office Action response. The original examining attorney then indicated that "the mark does not include a three dimensional configuration of a cup as this portion of the mark is now depicted in dotted lines." Office Action of November 17, 2013. Applicant accordingly amended the

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<sup>14</sup> The current Examining Attorney assumed responsibility for this application from the original examining attorney in 2016.

description of the mark, no longer indicating that it is three-dimensional.

In any event, we do not share the Examining Attorney’s apparent concern that Applicant, by virtue of its drawing and description of its mark, is seeking registration for “more than one mark.” As Applicant points out, there are numerous examples of marks which can be depicted in two-dimensional or three-dimensional form, without constituting “more than one mark,” as shown by a sampling of registrations which are included in the table below:<sup>15</sup>

Mark, Goods and Services, Reg. No. and Cite	Description	Specimen
 coffee  Reg. No. 3175941, 11 TTABVUE 46-51 (Applicant’s mark)	“Color is not claimed as a feature of the mark. The mark consists of a series of five concentric circles in the colors green, white, green, white, and black placed centrally on the exterior of a cup. The portions of the drawing represented by dotted lines are not claimed as elements of the mark.”	
 batteries  Reg. No. 3251144, 11 TTABVUE 52-57 <sup>16</sup>	“Color is not claimed as a feature of the mark. The mark consists of two parallel bands, which extend around an electronic battery. The dashes used to form the outline of a battery are not part of the mark, but are used to show the position of the mark on the goods.”	

<sup>15</sup> While “consistency” arguments based on the Office’s treatment of allegedly similar marks are generally entitled to little weight, we find these examples useful in placing the circumstances of this case in context.

<sup>16</sup> This registration was cancelled for failure to renew after Applicant filed its appeal.

		
 <p>Entertainment services in the form of professional football games</p> <p>Reg. No. 972622, 11 TTABVUE 75-80</p>	<p>None (however, “no claim to exclusive rights in a descriptive representation of a football helmet per se is made apart from the mark as shown”)</p>	
 <p>Franchising services, namely, offering technical assistance in the establishment and/or operation of real estate brokerage firms</p> <p>real estate brokerage services</p>	<p>“The color(s) red, white, and blue is/are claimed as a feature of the mark. The mark consists of a rectangular background used on real estate listing signs and in images thereof containing three horizontal, rectangular bars. The top rectangular bar is red and contains the words ‘For Sale’ in white, and the bottom rectangular bar is blue. The middle bar is white and is bounded on the left and right by dotted lines to show its location; the dotted lines are not part of the mark and no claim is made to such dotted lines.”</p>	

Reg. No. 1702048, 11 TTABVUE 81-86		
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This evidence makes clear that certain registered marks are sometimes depicted two-dimensionally, and other times three-dimensionally. It is perhaps especially noteworthy that in Registration No. 1702048, the description specifically indicates that “the mark consists of a rectangular background *used on real estate listing signs and in images thereof* containing three horizontal, rectangular bars” (emphasis added).

Here, as described, the cup, or depiction of the cup, in each case having a centrally located green dot, may identify the source of the coffee or restaurant and café services. The mark remains the same, and it performs the same source-identifying function.

For all of these reasons, under the circumstances of this case we find that Applicant’s description of its mark is acceptable.

### **3. Does the Drawing “Match” the Specimens?**

The Examining Attorney argues that the mark in the drawing, featuring a solid green circle, is not a “substantially exact” representation of the “siren” design mark featured in some of the specimens. According to the Examining Attorney, “[f]ar from being ‘minute’ or ‘inconsequential,’ the siren is a large and noticeable feature missing from the drawing.” 18 TTABVUE 11. We agree.

In fact, the siren<sup>17</sup> design creates the commercial impression of an

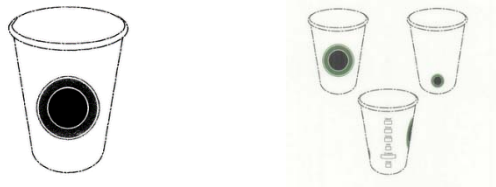
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<sup>17</sup> The siren is sometimes perceived as a mermaid. In fact, in its Registration No. 3428128, Applicant’s description of the mark indicates that a “siren” is “a two-tailed mermaid.” Office

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anthropomorphic female being or character with long hair, wearing a crown with a star on top. While the background of the siren design is at least partially green and at least partially circular, that is where the similarities between the siren design and the mark in the drawing end. In short, no one would describe the siren design in two of the specimens as a green circle, and no one would describe the green circle in the drawing as a siren, or for that matter any other type of anthropomorphic being or character.

Applicant points out that its Registration Nos. 3175941 (below on the left) and 3070042<sup>18</sup> (below on the right)



issued based on specimens which included the siren design rather than colored circles. 15 TTABVUE 13; 11 TTABVUE 46-51. These two examples of inconsistent treatment, one in a now-cancelled registration, standing alone, are unpersuasive. “Neither the Trademark Examining Attorney nor the Board are bound to approve for registration an Applicant’s mark based solely upon the registration of other assertedly similar marks ... having unique evidentiary records.” *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“The Board must decide each case on its own

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Action response of October 7, 2013.

<sup>18</sup> This registration was cancelled after Applicant filed its appeal.

merits ... Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”). There is apparently only one remaining example of the Office determining that the siren design is a “substantially exact” representation of a colored circle. Applicant’s consistency argument is therefore not persuasive on this point, as the Office’s “practice” is not illustrated by a mere one or two examples.<sup>19</sup> In any event, we find that the solid green circle is not a “substantially exact” representation of the siren design.<sup>20</sup>

To the extent this case implicates “mutilation,” we find that essential and integral subject matter – the siren design in both the original specimen and the additional specimen submitted on November 17, 2015 – is missing from Applicant’s drawing. *See* TMEP § 807.12(d) (Oct. 2018). Of course, “applicant may apply to register any element of a composite mark if that element, as shown in the record, presents a separate and distinct commercial impression which indicates the source of applicant’s goods or services and distinguishes applicant’s goods or services from those of others.” *In re Miller Sports*, 51 USPQ2d at 1060-61 (citing, e.g., *In re Chemical Dynamics*, 5

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<sup>19</sup> These rare examples contrast to the Office’s repeated allowance of (at times) three-dimensional marks which are not so described in the application/registration, which Applicant established with numerous examples, a mere sampling of which is discussed above.

<sup>20</sup> Even if Applicant is correct that when viewed at a distance the siren design will be perceived as a green circle, Applicant has not established that any particular viewing distance is part of the “substantially exact” test. In comparing the drawing to the siren design mark in the specimens, we have considered the various viewing distances from which typical coffee and restaurant service consumers would likely encounter Applicant’s marks. At those distances, consumers would perceive the siren as a siren and the solid green circle as a solid green circle.



USPQ2d at 1828 and *Institut National des Appellations D'Origine v. Vintners Int'l Co., Inc.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992)). Here, however, the green circle in Applicant's drawing does not present a "separate and distinct commercial impression" from the siren design.

To the contrary, as explained above, consumers viewing the siren design will perceive an anthropomorphic female rather than any type of green circle. In other words, it is not a composite mark consisting of a siren design and a green circle (used as background or otherwise), let alone a green circle which presents a separate and distinct commercial impression from the siren. The green circle and siren design are simply not "interrelated elements of a single unified design." *Cf. In re Chemical Dynamics*, 5 USPQ2d at 1830.

To the extent consumers perceive the outer boundary of the siren design as circular, it is not a green circle. It is only partially green, and it is not even clear that it is mostly green; it might be more white than green. Furthermore, the bottom of the siren's torso, and other features which reach the circle's boundary, are white, so the siren design is not even enclosed within a green circular outline, but is instead depicted under a green half-circle at the top, with the bottom half-circular outline being largely white.

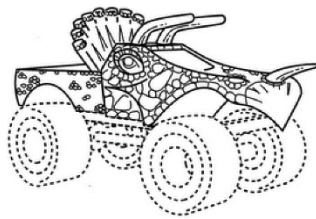
Notwithstanding Applicant's suggestion to the contrary, the green circle in the drawing is anything but a "minor alteration" of the siren design mark in two of Applicant's specimens. *See Schecter Bros.*, 182 USPQ at 695. Indeed, in *In re Univ. of Miami*, 123 USPQ2d 1075, 1077 (TTAB 2017) we found the drawing on the left below

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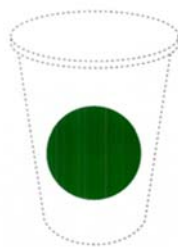
to be merely a minor alteration of the specimen on the right below (and similar specimens)



Similarly, in *In re Frankish Enters.*, 113 USPQ2d at 1964, we found the drawing on the left below to be merely a minor alteration of the specimen on the right below (and other specimens):



The difference between this case and those is obvious when we compare Applicant's drawing on the left below to Applicant's siren design specimen(s) on the right below:



In contrast to *Univ. of Miami* and *Frankish Enters.*, there are wholesale, rather than merely minor, differences between the mark in Applicant's drawing and the mark in its siren specimens.

Turning to Applicant's other specimens, which feature cups with solid green

circles, we disagree with the Examining Attorney's finding that they are unacceptable because "each does not include an actual cup as one might expect for a trade dress specimen." 18 TTABVUE 17. For the reasons stated above in reversing the refusal based on Applicant's failure to identify its mark as three-dimensional, the Examining Attorney's apparent requirement that the specimens "include an actual cup" is misplaced. There is no evidence that consumers would perceive a difference between



the mark in Applicant's drawing, and the mark Applicant's remaining specimens:



Each of the specimens includes a two-dimensional depiction of a white coffee cup with a centrally-placed green circle on the front exterior. Neither the drawing, nor any of the specimens, are actual cups. Whether the mark is placed on an actual three-dimensional cup or is presented as a two-dimensional depiction of an actual cup is

irrelevant given Applicant's identification of goods and services.<sup>21</sup> Even if the two-dimensional depictions of the cups in the specimens were replaced with actual coffee cups, the commercial impressions would be no different.

Finally, to the extent the Examining Attorney argues that the specimens are unacceptable because they do not show "three-dimensional features of the mark," TMEP § 1202.02(c)(iv), we disagree. Each specimen shows three-dimensional features because in the first specimen, the lid reveals three-dimensionality, and in the rest, the liquid and whipped cream contents of the cups reveal three-dimensionality. That is, a lid would not rest on something in only two dimensions, and nothing in two dimensions could hold liquid contents.

In short, we find that Applicant's drawing is not a substantially exact representation of the siren design mark specimens, but is a substantially exact representation of the mark in the remaining specimens.

#### **4. Do the Specimens Show Use of the Mark in Association With the Services?**

A service mark is "any word, name, symbol, or device, or any combination thereof ... [used] to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127. A service mark must be "used in such a manner that it would be

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<sup>21</sup> We do not understand what the Examining Attorney means when he argues that "the cup and circle designs shown in these specimens are not depictions of actual objects like the mark in the drawing." 18 TTABVue 17. There is no evidence that Applicant's drawing depicts an "actual object" either; nor is there any evidence that the specimens do not depict an "actual object," i.e. a specific, existing coffee cup which could have served as a model for the artist who drew the specimens. The point is that in both the specimens and the drawing, the mark's commercial impression is the same.

readily perceived as identifying” the services, which is “determined by examining the specimens of record in the application.” *In re Moody’s Investors Svc. Inc.*, 13 USPQ2d 2043, 2047 (TTAB 1989); *see also In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1458 (TTAB 1998) (a mark “must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin” for the services, but mere intent that it function as a mark is not sufficient); *In re Duratech Industries Inc.*, 13 USPQ2d 2052 (TTAB 1989). “At a minimum, the specimen must show a *direct association* between the services and the mark sought to be registered.” *In re Osmotica Holdings Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010); *see also, In re Advertising & Marketing Development*, 2 USPQ2d at 2014. That is, “[a] specimen that shows only the mark with no reference to, or association with, the services does not show service mark usage.” *In re DSM Pharm., Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008).

Here, the Examining Attorney argues that none of Applicant’s specimens “show the use of the mark in the drawing displayed in the sale or advertising of the services or the rendering of the services ....” 18 TTABVue 24. Applicant counters that its specimens show the mark in connection with its rendering of the services.

Because we have found that Applicant’s drawing is not a “substantially exact” representation of the siren design specimens, we focus on the specimens featuring a solid green circle. Applicant refers to these three specimens as “point-of-sale signage”:



and to this specimen as “retail store window signage”:



Office Action response of and substitute specimens submitted on February 10, 2015. The “point of sale” signage is displayed in the rendering of the services, i.e. at the counter where customers place orders and cashiers accept payment for Applicant’s “coffee bar,” “carry-out restaurant” and other services.<sup>22</sup> The “retail store window” signage advertises Applicant’s services.

In considering whether Applicant’s specimens show use of the green circle mark in connection with Applicant’s services, our review is not limited to the specimens

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<sup>22</sup> A presumably typical point of sale for Applicant’s services is depicted in the final siren design specimen submitted with the Office Action response of November 17, 2015.



themselves. “Both precedent and examination guidance make clear that in assessing the specimens, consideration must be given not only to the information provided by the specimen itself, but also to any explanations offered by Applicant clarifying the nature, content, or context of use of the specimen that are consistent with what the specimen itself shows.” *In re Pitney Bowes, Inc.*, 125 USPQ2d 1417, 1420 (TTAB 2018) (citing *DSM Pharm.*, 87 USPQ2d at 1626 (“In determining whether a specimen is acceptable evidence of service mark use, we may consider applicant’s explanations as to how the specimen is used, along with any other available evidence in the record that shows how the mark is actually used.”)).

The advertising specimen displayed in retail store windows does not refer to the coffee bar, carryout or restaurant services provided inside Applicant’s retail stores. It is therefore unacceptable. In fact, “[f]or advertisement specimens ... ‘[i]n order to create the required ‘direct association,’ the specimen must not only contain a reference to the service, but also the mark must be used on the specimen to identify the service and its source.” *Pitney Bowes*, 125 USPQ2d at 1419 (quoting *Osmotica Holdings*, 95 USPQ2d at 1668); *see also In re Adair*, 45 USPQ2d 1211, 1214-15 (TTAB 1997); *In re Metriplex, Inc.*, 23 USPQ2d 1315, 1317 (TTAB 1992). Here, the cup with a green circle in the advertising specimen does not create a “direct association” with Applicant’s services, as it does not refer to or identify them. Rather, consumers would likely view the specimen as akin to a menu listing that promotes and displays the coffee and oatmeal, rather than Applicant’s service of providing the coffee and oatmeal to the customer. *See In re El Torito Rest. Inc.*, 9 USPQ2d 2002 (TTAB 1988).

The situation is different, however, with respect to the point-of-sale signage specimens. In fact, a specimen need not explicitly refer to the services if it shows the mark used in “rendering” the services. *In re WAY Media, Inc.*, 118 USPQ2d 1697, 1698 (TTAB 2016) (citing *In re Metriplex*, 23 USPQ2d at 1316-17 and *In re Johnson Controls*, 33 USPQ2d 1318, 1320 (TTAB 1994)). Nevertheless, there must still be “something which creates in the mind of the purchaser an association between the mark and the service activity.” *In re Johnson Controls*, 33 USPQ2d at 1320.

We find that Applicant’s point-of-sale specimens display Applicant’s mark in the rendering of the identified services.<sup>23</sup> Indeed, in *In re Metriplex*, the specimens showed “the mark as it appears on a computer terminal in the course of applicant’s rendering of the service,” and were found acceptable. 23 USPQ2d at 1316-17. This case is analogous, as Applicant’s mark appears on the counter where Applicant’s services are requested, provided and purchased.

The Examining Attorney’s reliance on *El Torito* is misplaced. There, “table tents” bearing the mark were placed on restaurant tables, and the table tents and mark identified only food items. In large part because there was “no evidence that the mark is used in the promotion of applicant’s services,” we found that the mark only identified food items. 9 USPQ2d at 2004. Similarly, in *In re Brown & Portillo Inc.*, 5 USPQ2d 1381, 1384 (TTAB 1987), we found, based on “the only evidence of record,” that the mark in question identified only food products. In doing so, however, we

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<sup>23</sup> This is a separate inquiry from whether Applicant’s mark has acquired distinctiveness, which we address below. In this section we assess only whether Applicant’s specimens show use of its mark in association with its services.

discussed our similar decision affirming a refusal to register in *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986), another case involving a mark used only for food items. Our decision in *McDonald's* was ultimately reversed by the Federal Circuit in an unpublished decision, however. In *Brown & Portillo* we distinguished the Federal Circuit's decision in *McDonald's*, pointing out that although the specimens in *McDonald's* identified only food products, there was also an "extensive" record in that case of additional material "consisting of a variety of advertisements, television storyboards and an affidavit of the vice president of McDonald's who indicated, in part, that the purpose of the advertising of McDonald's is to promote not only the sale of breakfast food sandwiches, but also to promote the restaurant services in order to increase sales and promote the image of McDonald's." *In re Brown & Portillo*, 5 USPQ2d at 1383-84. In this case, in contrast to *Brown & Portillo* and *El Torito*, but much like the Federal Circuit's *McDonald's* decision, Applicant has established that a coffee cup with a green circle is extensively used to identify Applicant's services.

For example, the following, which displays the mark in question, was used in a joint promotion between Applicant and Target launched in 2014:



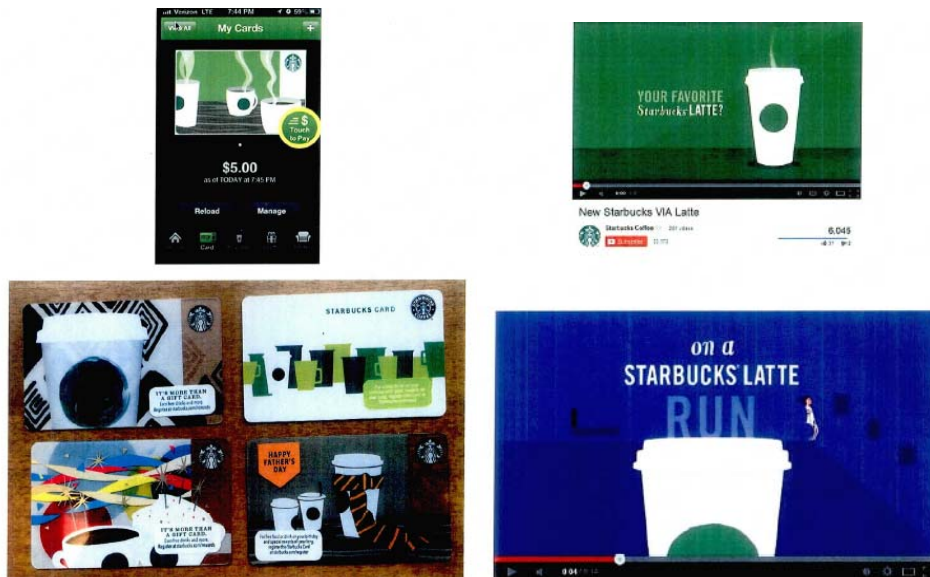
Declaration of Russ Jacobs, Applicant's Director, Corporate Counsel, submitted with Office Action response of February 10, 2015 ("Jacobs Dec.") ¶ 2. Applicant used the

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mark in this billboard advertising, also from 2014:



*Id.* ¶ 5. Applicant uses the mark with its mobile app and gift cards, as well as video advertisements:



Supplemental Declaration of Katherine Seawell, Applicant’s Vice President, Espresso & Brewed (“Supp. Seawell Dec.”), submitted with Applicant’s Office Action response of May 15, 2014 ¶¶ 14-15. There is also evidence that the coffee cup with a green circle is recognized as a mark for Applicant’s restaurant and café services. For example, a newspaper article, discussing Applicant’s service of coffee, states: “I can remember a flash of pleasure when I drove into a small town ... and saw that familiar green circle.” *Id.* at ¶ 11. The cup with a green circle has been featured on the landing

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page for customers accessing Applicant's public wifi network:



Second Supplemental Declaration of Katherine Jean Seawell ("Second Supp. Seawell Dec."), submitted with Applicant's November 17, 2015 Request for Reconsideration

¶ 12. Perhaps most importantly, Applicant has used the cup with green circle mark on its menu boards, *not to identify menu items*, but instead *to identify Applicant's restaurant and café services*, in over 10,000 locations:



*Id.* ¶ 15.

This evidence differentiates this case from *Brown & Portillo* and *El Torito*, and brings it closer to the Federal Circuit's decision in *McDonald's*. That is, after considering Applicant's explanations and evidence "clarifying the nature, content, or context of use of the specimen," *In re Pitney Bowes*, 125 USPQ2d at 1420, including Applicant's other uses of its mark inside and outside its retail stores, online and

otherwise, we find that Applicant's point-of-sale specimens submitted on February 10, 2015 establish a direct association between Applicant's services and the mark in Applicant's drawing. The refusal of registration based on the specimens not showing use of the mark for Applicant's services is therefore also reversed.

#### **5. Has Applicant's Mark Acquired Distinctiveness?**

Because Applicant has conceded that the mark in the '872 Application is not inherently distinctive, it must establish that the mark has acquired distinctiveness.

The Examining Attorney concedes that Applicant is a "commercially successful enterprise," in fact a "juggernaut." 18 TTABVue 20. He argues, however, that Applicant's evidence of widespread general commercial success does not necessarily imply public recognition of the specific mark in question, for the specific goods and services identified in the application. *Id.* He also takes issue with various aspects of the "format and/or the method" of the Kaplan Survey, and concludes that Applicant has not established acquired distinctiveness.

Applicant suggests, for the most part without supporting evidence, that its secondary meaning evidence primarily concerns the mark for which it seeks registration. It also relies heavily on the Kaplan Survey, pointing out that the percentage of respondents identifying Applicant as the source of goods sold under the applied-for mark is greater than is typically required to establish acquired distinctiveness.

Applicant bears the burden of establishing acquired distinctiveness. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001,



1006-07 (Fed. Cir. 1988). In this case, its burden is quite high. Indeed, “[t]he kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case.” *In re Chevron Intellectual Property Grp. LLC*, 96 USPQ2d 2026, 2030 (TTAB 2010). Here, Applicant’s mark — consisting of a common basic shape (a circle), in a particular color (green), placed on a common basic object (a coffee cup) — is not inherently distinctive, as Applicant conceded at the oral hearing. It is not the type of mark likely to be perceived as a source indicator. *See e.g. Yamaha Int’l*, 6 USPQ2d at 1008; *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1073 (TTAB 2018); *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1316-17 (TTAB 2011); *In re Chevron*, 96 USPQ2d at 2030; *In re American Academy*, 64 USPQ2d at 1753 (“However, ordinary geometric shapes such as circles, ovals, squares, stars, etc., are generally regarded as nondistinctive and protectable only upon proof of acquired distinctiveness.”); *Guess? Inc. v. Nationwide Time Inc.*, 16 USPQ2d 1804, 1805 (TTAB 1990); J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:33 (5th ed. Nov. 2018 update) (“Ordinary geometric shapes such as circles, ovals, squares, etc., *even when not used as a background for other marks*, are regarded as nondistinctive and protectable only upon proof of secondary meaning.”) (emphasis added).

Moreover, “[t]he fact that applicant’s [circle] is green does not change the standard by which these types of marks are judged.” *In re Benetton Grp. S.p.A.*, 48 USPQ2d

1214, 1216-17 (TTAB 1998). Nor does it matter that Applicant's mark is unaccompanied by words or other indicia of origin.

Applicant has provided no authority for the proposition that simple geometric shapes (such as circles, squares and equilateral triangles) should, when used by themselves, be regarded as inherently distinctive. It simply makes no sense to say that an equilateral triangle, when used in association with a word, is inherently non-distinctive, and then to say that an equilateral triangle, when used by itself, is inherently distinctive.

*Guess? Inc.*, 16 USPQ2d at 1805.

**a. Sales, Advertising and Unsolicited Media Attention**

Applicant relies on testimony about its revenues and advertising expenditures, as well as unsolicited media attention relating to its marks. The problem, however, is that for the most part it is not clear that this evidence relates to the mark in the '872 Application.

Applicant has taken the position, throughout prosecution, that the drawing of its



mark is a “substantially exact” representation of the siren design

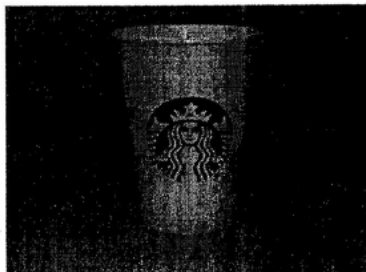


, a position with which we disagree, as indicated above. As a result, when Applicant's testimony refers to Applicant's “mark,” or “logo,” we cannot determine if the reference is to the green circle design shown in the drawing, or to the siren design depicted in some of the specimens, because Applicant views these as essentially the same. To the extent that Applicant's secondary meaning evidence

relates to the siren design — and that extent is unknown — it has at best minimal probative value to our determination regarding whether the green circle mark in the drawing has acquired distinctiveness. While the cups bearing the siren design share some features with the cups bearing the green circle design, the evidence is too uncertain and unreliable to warrant the conclusion that consumer association of one design with Applicant carries over to the other.

Applicant’s conflation of evidence pertaining to the siren design with evidence pertaining to the green circle design is obvious from the prosecution history. Applicant originally depicted the mark in the ‘872 Application as the siren design and referred to it as the “Starbucks Cup Mark:”

3. Starbucks Corp. has offered the Beverages in connection with the Starbucks Cup Mark for over two years, with a date of first use anywhere and first use in commerce of at least as early as March 8, 2011. A true and correct photograph displaying a cup bearing the Starbucks Cup Mark follows below.



Declaration of Katherine Jean Seawell (“Seawell Dec.”) submitted with Applicant’s Office Action response of October 7, 2013 ¶ 3. This discrepancy is perhaps best illustrated by Applicant’s testimony that customers bought *hundreds of millions* (and in 2012 over *one billion*) beverages served in cups bearing the “Starbucks Cup Mark.” Seawell Dec. ¶ 11. At the oral hearing, however, Applicant conceded that it has not

actually sold any beverages in cups bearing the *green circle design*. Rather, it sells beverages in cups bearing the *siren design*. Thus, the astronomical figures in the hundreds of millions, and billions, which Applicant submitted during prosecution, apparently do not pertain to the mark in question. We have therefore focused on Applicant's secondary meaning evidence that clearly refers to the mark in question, the mark in the '872 Application, the green circle design mark.

We acknowledge that after its original Office Action response, Applicant's declarations started defining the mark in the '872 Application as the "Green Circle Design," and seemed to be referring to and providing evidence about that applied-for mark, at least in part. However, the extent to which this more recent testimony and evidence is reliable and relevant remains unclear. For example, in her original declaration, Ms. Seawell testified that "Customers in the United States of America have purchased the Beverages bearing the Starbucks Cup Mark [defined as the siren design mark as set forth above] from STARBUCKS stores, both company-owned and licensed locations, in the following quantities":

Year	Number of Cups
2011 (April through December)	928,000,000
2012	1,297,000,000
2013 (January through March)	378,000,000

Seawell Dec. ¶ 11. In her next declaration, which was clearly referring to the green circle design rather than the siren design, Ms. Seawell testified that "Customers in the U.S. have purchased over *3 billion* Beverages in white cups bearing the Green Circle Design from STARBUCKS stores, both company-owned and licensed locations," in the following amounts:

<b>Year</b>	<b>Number of Cups</b>
2011 (April through December)	679,000,000
2012	977,000,000
2013	1,037,000,000
2014 (January through March)	318,000,000
<b>Total</b>	<b><i>over 3 billion</i><sup>1</sup></b>

Supp. Seawell Dec. ¶ 7. While it would appear from Ms. Seawell’s declarations that Applicant sold beverages in billions of cups bearing the siren design, and billions of cups bearing the green circle design, Applicant specifically denied at the oral hearing that it sold any beverages in cups bearing the green circle design. Therefore, the figures in the more recent Seawell Declarations appear to be incorrect. Furthermore, in her next declaration, Ms. Seawell changed her testimony. Specifically, she indicated that “Customers in the U.S. have purchased the Beverages in cups bearing the Starbucks Cup Mark [defined in her original declaration as the siren design mark] from STARBUCKS stores, both company-owned and licensed locations, in the following quantities”:

<b>Year</b>	<b>Number of Cups</b>
2011 (April through December)	679,000,000
2012	977,000,000
2013	1,037,000,000
2014	1,359,284,000
2015 (January through September)	1,297,732,000
<b>Total</b>	<b><i>over 5 billion</i></b>

Second Supp. Seawell Dec. ¶ 8. Because the number of siren design cups listed for 2011-2013 in this declaration is identical to the number of cups listed for those years in the previous declaration, we infer that the numbers refer to the same type of cup, whether the green circle design or the siren design, and that the discrepancy is merely a typo or an oversight in how the mark is described. The problem, however, is that it

is not clear, from this and other inconsistencies in the declarations, which of the two marks are being discussed, the siren design or the green circle design. Again, Applicant effectively indicated at the oral hearing that the numbers refer to the siren design rather than the green circle design.

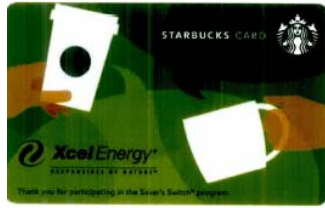
Similarly, much of the unsolicited media attention upon which Applicant relies refers to Applicant's "green logo" (sometimes referred to as "familiar" or "iconic"), but "green logo" could just as easily describe the siren design as the green circle design. Supp. Seawell Dec. ¶ 11 and Ex. B; Second Supp. Seawell Dec. ¶ 9 and Ex. B. In the same way, media references to Applicant's "white-and-green coffee cups," or the equivalent, could just as easily refer to cups bearing the siren design mark as the green circle design mark. It is therefore not clear whether these articles are referring to the mark in question, or the siren design mark. We therefore now turn to only the evidence that clearly refers to the green circle design mark rather than the siren design mark.<sup>24</sup>

Applicant offers the "Starbucks Card," described as a "loyalty card" that "allows customers to pay for their items at company-owned and licensed STARBUCKS stores," which bears the green circle design:

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<sup>24</sup> While we have attempted to give Applicant "credit" for all documented uses of the green circle design, some of the photographs submitted are too unclear, or too small, to determine whether the mark on the cups is the siren design or the green circle design. *See e.g.* Supp. Seawell Dec. ¶ 9.

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Seawell Dec. ¶ 20 and Ex. L. Applicant has not indicated how many consumers' loyalty cards bear the green circle design, however. Similarly, while Applicant has used the green circle design on coffee packaging, such as the specimen submitted and discussed above in connection with the '423 Application, Applicant has not indicated how much coffee bearing this mark has been sold. Applicant also uses the green circle design mark on mobile apps, but does not indicate how many people downloaded or use the apps:



Supp. Seawell Dec. ¶ 14. Applicant used the mark in connection with its "Tweet-a-Coffee" campaign with LinkedIn "that alone generated almost \$180,000 in sales in several months":



*Id.* ¶ 16.

Some of the unsolicited media attention Applicant introduced also appears to relate to the green circle design:

“Starbucks also serves pretty good coffee. I can remember a flash of pleasure when I drove into a small town ... and saw that familiar green circle.” Jon Carroll, *We Cheer the March of the Peet’s*, San Francisco Chronicle, Dec. 15, 2009. *Id.* ¶ 11 and Ex. B.

“Often consumers favor a coffee retailer based on the brand of the cup, such as the green circle emblem at Starbucks, he said.” Jenny Kincaid Boone, The Roanoke Times, Oct. 7, 2007. *Id.*

However, Applicant did not provide circulation figures or other evidence from which we can determine the extent of consumer exposure to these articles.

**b. The Kaplan Survey**

The Kaplan<sup>25</sup> Survey was intended “to measure the degree to which members of the relevant population associate the mark/design in question [the mark in the ‘872 Application] with one or more than one source.” Office Action response of May 15, 2014 (Kaplan Survey at 5). Dr. Kaplan identified the “relevant population” as “individuals 18 and above who in the past 30 days had purchased, for takeout either

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<sup>25</sup> We find that Dr. Kaplan is qualified to provide an expert opinion. He has a Masters Degree from Purdue University, for which he did coursework in industrial psychology, consumer behavior and psychological measurement; a Ph.D from Purdue for which he did coursework in industrial psychology and social research methods; and an MBA from The Wharton School. He has over 40 years of professional experience in consumer and marketing research, including surveys for litigation, and has published extensively on consumer psychology and marketing. He has qualified as an expert in trademark litigation. Office Action response of May 15, 2014 (Kaplan Survey Ex. A).

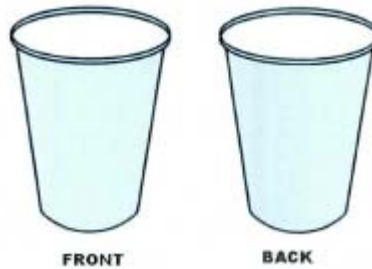


for themselves or for someone else, coffee, tea, a coffee or tea-based beverage, or cocoa or hot chocolate — or were likely to do so in the next 30 days.” *Id.* at 6. The survey was conducted via the Internet, with Dr. Kaplan pointing out, based on a third-party survey, that approximately 85% of American adults use the Internet and opining that “nothing about Internet usage should adversely impact the representativeness of” the surveyed relevant population. *Id.* Potential survey participants were “randomly drawn” such that the selection was “unbiased” and “representative of households in the 50 United States.” *Id.* at 7.

Potential participants were first asked “screening” questions to ensure the sample was representative of the relevant population, geographically, and by age and gender. *Id.* at 8. Respondents who worked, or lived with someone who worked, in the advertising, marketing research, food or beverage or legal industries were excluded. *Id.* at 10. Respondents who accessed the survey on a cellular phone or any device besides a desktop, laptop or tablet computer were also excluded. *Id.* The survey was “double blind,” meaning that participants did not know “the identity of the client, why the research was being conducted, or that it might be used in a legal proceeding,” and “[c]are was taken throughout the design of the study, to not use leading or suggestive wording.” *Id.* at 13. Ultimately, those selected based on their responses to the screening questions proceeded to answer the main questionnaire.

The main questionnaire displayed “a cup for coffee, tea, or cocoa,” and participants were asked to “look at it as you would if you were given the cup or you saw a person carrying or drinking from it.” *Id.* at 11. Some participants, those in one of the “test”

cells, were shown the mark in the drawing of the '872 Application.<sup>26</sup> Others, those in the “control” cell, were shown a “generic light blue cup”:



*Id.* at 12. The purpose of a control such as this is “to estimate and correct for error in the test cell results. This error can have many sources including respondent guessing, etc.” *Id.*

Participants who responded that they associate the cup shown with one company were then asked:

“What, if anything, about this cup makes you say that?”;

“And if you have an opinion, what company do you associate this cup with?”;

“If you have an opinion, what brand name or names, or product name or names, if any, are used by that company?”; and

“If there is anything else you can think of about that company or that would help identify it please write that here.”

*Id.* at 12-13.

According to the Kaplan Survey, 69% of participants shown the mark in the '872

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<sup>26</sup> As indicated, there were two “test” cells, one which considered the mark in the '872 Application, and another which considered another of Applicant’s marks which is displayed on coffee cups (Application Serial No. 85792857).

Application associated it with one company. In the text of his report, Dr. Kaplan indicated that “only about one in 11 associated the Control Design with one company ... When the percent associating the Control Design with one company is used to correct for noise (by subtracting it from the percent associating each of the ‘test’ designs with one company),” 60% of survey participants associated the mark in the ’872 Application with one company. *Id.* at 15.<sup>27</sup> As Applicant points out, results at this level are typically found sufficient to establish that a mark has acquired distinctiveness, all else being equal. 15 TTABVUE 18-19.

Here, however, we have questions about the survey’s probative value. One major issue is the cup Dr. Kaplan chose to use as the “control.” Unlike the “test” cups, the control cup has no markings or identifying features, other than perhaps its unremarkable light blue color.<sup>28</sup> Indeed, Dr. Kaplan himself refers to the “control” cup as “generic.” Office Action response of May 5, 2014 (Kaplan Survey at 12).

Consumers presented with Dr. Kaplan’s chosen “generic” control cup would be much less likely to identify it with one company than a cup bearing some type of marking or other identifying feature, such as a colored geometric shape. Indeed, a small percentage of participants associating the control cup with one company is the

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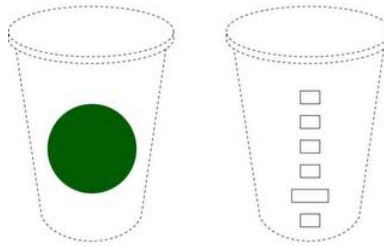
<sup>27</sup> Dr. Kaplan’s report is internally inconsistent on this point. Immediately below this narrative discussion in the Kaplan report, a chart identified as “Table 1” appears which purports to represent the “Associations with Each Cup.” Office Action response of May 5, 2014 (Kaplan Survey at 15). However, the chart is inconsistent with the narrative immediately above which it purports to summarize. Specifically, the chart indicates that only “4%,” rather than “one in 11,” associated the control cup with one company. This inconsistency is unexplained and detracts from the survey’s probative value.

<sup>28</sup> There is no evidence or basis upon which to believe that light blue is an identifying feature. Indeed, all non-transparent cups will have an identifiable color.

exact result that would be expected when consumers are presented with a “generic” cup. It would have been more logical, and reliable, for the “control” cell to be shown a cup more analogous to Applicant’s mark. For example, the control cup would have been more effective if it was beige (or even white) and featured, for example, a blue triangle placed centrally on the front exterior side. By controlling for “noise” this way, the survey would have more reliably revealed why participants identified a cup with one company, and whether Applicant’s mark has truly acquired secondary meaning. As designed, however, the survey is not convincing that consumers’ identification of the test cup with one company was the result of the mark in the ’872 Application. J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 32:187 (“The general principle for choosing an appropriate control is easily stated: It should share as many characteristics with the experimental stimulus as possible, with the key exception of the characteristic whose influence is being assessed.”) (quoting S.S. Diamond, Control Foundations: Rationales and Approaches in Trademark and Deceptive Advertising Surveys 210 (ABA, Eds. Diamond & Swann 2012)).

On the other hand, we acknowledge that 67% of those who associated the test cup with one company “specifically associated” that cup with Applicant, while only 3% of those who associated the control cup with one company specifically associated that cup with Applicant. This persuades us that many in the survey’s sample (apparently only slightly less than 50% of those in the test cell for the mark in the ’872 Application) associated the cup they were shown with Applicant. Nevertheless, this evidence is less significant than it appears on its face, for several reasons.

First, the “data set” attached to the Kaplan Survey as Exhibit E appears to include all survey participants, those in the control group and both test groups. One of the test groups was shown Applicant’s related but uninvolved mark which includes not only the green circle on the front but markings on the back of the cup:



If there is a way to distinguish the information in the data set provided by the test cell for this uninvolved mark from the information provided by the test cell for the involved mark in the '872 Application, that is not explained or apparent from the record. Thus, we do not know from this record which data provided is from survey participants shown the mark in question, making it more difficult to assess the data set and the survey as a whole.<sup>29</sup>

While Dr. Kaplan was apparently able to distinguish one test cell from another and appears to have tallied the results for only those survey participants shown the mark in question, i.e. the mark in the '872 Application, we are unable to examine the data set for only those survey participants in the relevant test cell. Instead, we can

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<sup>29</sup> Some participants identified Applicant as the “one company” identified by the cup because of the “boxes,” “squares” or “markings” on “the back” of the cup, or the “tabs for requests.” These responses seem to make clear that these participants were shown the *uninvolved* mark, but the rest of the data set is unclear as to which mark or control was shown to which participant.

assume only that by referring to Applicant they are from one of the two test cells.<sup>30</sup>

Moreover, some of the participants who specifically identified Applicant as the “one company” identified by the cup mark apparently did so not because of the green circle, but because of features unclaimed in or absent from the involved ’872 Application. For example, some participants indicated that the cup’s “shape” is the reason they identified Applicant, but Applicant does not claim rights in the shape of the cup in the ’872 Application. There is no indication that these or similarly irrelevant results were excluded from Dr. Kaplan’s tally.

More importantly and commonly, a large fraction of participants who identified Applicant as the source of one of the test cups did not do so in a way that indicates that their identification was the result of the mark on the test cup shown to them. While some participants who indicated that the cup was associated with one company, and specifically identified Applicant, stated that the reason for associating the cup with one company was the “green circle” or “green logo” or the equivalent, others gave more ambiguous answers, such as “green equals starbucks” or “Color, gradations.”

A large percentage of participants did not specify why they associated the cup with Applicant. For example, many participants answered simply “Starbucks” or the equivalent. Answers like these may be the result of the mark on the cup the

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<sup>30</sup> Even this assumption might not be safe. The record makes clear that Applicant is one of if not the largest and most well-known coffee and café brands. It would only be natural for consumers to identify Applicant more often than other less successful brands under these circumstances.

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participant was shown, but they may not. Similarly, other participants provided the following answers, which do not suggest that the mark on the cup was the reason for associating the cup with Applicant or one company:

“looks like it would be a logo brand for just 1 company;”

“looks very familiar;”

“I am so familiar with the cup since I drink it almost every day;”

“Starbucks is a frequent stop, and is convenient;”

“Looks like a Starbucks cup;”

“I know whose it is” and “go there often;”

“It is from Starbucks. I spend a few hundred dollars a month there so I know. I have been a gold member since 2009” and “If you cut me I would bleed coffee from starbucks;”

“design;”

“Design;”

“Market is well dominated by this brand;”

“Familiarity” and “Use to seeing;”

“Over priced” and “Good coffee everything else is not good;”

“nothing;”

“I am familiar with this cup as I have been to this coffee shop many time.;”

“N/A” and “no;”

“Idk” and “no;”

“none” and “nine;”

“coffee” and “starbuck;”

“The design is familiar to me;”

“Looks like that shape;”

“plain;”

“Looks like starbucks shape;”

“looks like a cup from coffee chain;”

“Starbucks!!!!!!!!!!!!” and “Because they dominate everything!!!!!!!!!!!!;”

“look the same;” and

“looks.”

Office Action response of May 15, 2014 (Kaplan Survey Ex. E).

We also question the survey’s chosen universe. By only questioning those who purchased relevant beverages in the last 30 days, or plan to do so in the next 30 days, the survey is underinclusive. More occasional consumers are also relevant, and less likely to be familiar with the players in the industry or their cups or trademarks. In fact, if the survey was conducted of only daily purchasers of takeout coffee, the percentage associating the test cups with one company or a specific company would probably be higher, while if the survey was conducted of only biannual purchasers of takeout coffee, the percentages would likely be lower. Here, there is no reason provided for selecting the specific universe chosen. As we held in an analogous situation, involving sandwiches rather than coffee/beverages:

... the universe of respondents is too narrow. The



description of goods in the application is “sandwiches, excluding hot dogs.” As indicated above, the relevant public comprises ordinary consumers who purchase and eat sandwiches. Relevant consumers are not limited to recent and frequent patrons of fast food restaurants and sandwich shops; they include *inter alia* patrons of eat-in and sit-down restaurants, delicatessens, and supermarkets that sell sandwiches. Because the application does not limit the channels of trade or potential customers for applicant's sandwiches, we must presume that they are sold in all normal channels of trade and to all of the usual customers for such goods. *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958)). Accordingly, the survey results may be skewed because the survey did not include all of the potentially relevant consumers.

*Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1361 (TTAB 2013).

Here, as in *Sheetz*, Applicant's identification of goods and services is broad, and includes coffee, cafeterias and restaurants, and these goods and services may be purchased by frequent or infrequent consumers. Moreover, as in *Sheetz*, limiting the universe, in this case to those purchasing takeout coffee (or tea, cocoa or hot chocolate), is underinclusive because the record indicates that purchasers of Applicant's goods and services sometimes consume the products or receive the services inside cafes or restaurants, including Applicant's retail locations, or in their own homes. Takeout coffee is but a portion of Applicant's business.

Relatedly, while we recognize that Internet surveys are becoming increasingly common, and do not suggest that they are invalid or too unreliable to be probative as a general matter, in this case the survey method raises questions. For example, while the Kaplan Survey indicates that “85% of American adults use the Internet,” this

represents a particular subset of the population as a whole, a subset that excludes some purchasers of coffee, an inexpensive item. *See* J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 32:165.25 (“Potential drawbacks of an internet survey are population bias if the target universe consists of low-income, rural, or elderly persons, because those groups have Internet usage in lower percentages than other groups.”). This problem is compounded here not only because of the inexpensive and ubiquitous nature of the goods and services, which are enjoyed by an exceedingly high and diverse fraction of the population as a whole, but because the Kaplan Survey excluded participants who access the Internet on smart phones. This exclusion exacerbated the survey’s underinclusivity.

When we consider the survey and the rest of the record in its entirety, we find that Applicant has failed to establish that the mark in the ’872 Application has acquired distinctiveness. Applicant’s siren design is not at issue here, only the green circle design is. As indicated, and as Applicant admitted at the oral hearing, Applicant does not sell coffee in cups bearing the green circle design. While it uses the green circle design in a number of other ways, perhaps quite extensively, for the most part Applicant has not quantified its use of the green circle design specifically. Indeed, at times during prosecution of the ’872 Application, Applicant appears to have conflated evidence about the siren design mark with evidence concerning the green circle design, compounding the problem. Furthermore, while the Kaplan Survey has some probative value, it also has problems, and raises a number of questions, all of which lead us to question whether it overstates the relevant public’s association of

the mark in the '872 Application with a single source. Indeed, Dr. Kaplan used an inappropriate control, selected an underinclusive universe and designed a survey and questions (and provided a data set) that do not reliably establish an association between the mark in question and Applicant. While the result here might very well be different if the survey and other evidence were more specifically targeted to assessing the mark in the '872 Application specifically, on this record, we find that Applicant has not established that the mark has acquired distinctiveness. The refusal to register the mark in the '872 Application on the ground that it is not inherently distinctive and has not acquired distinctiveness is therefore affirmed.<sup>31</sup>

### **III. Conclusion**

The refusal to register the mark in the '423 Application is reversed, because Applicant's drawing of that mark is a substantially exact representation of the mark in the Package Specimen and the Counter Display Specimen.

The refusals to register the mark in the '872 Application because it is not described as being three-dimensional, because the drawing and specimens do not "match" and because the specimens do not show use of the mark in connection with the identified services are all reversed. The refusal to register the mark in the '872 Application because it is not inherently distinctive and has not acquired distinctiveness is affirmed.

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<sup>31</sup> The '423 Application included a Section 2(f) claim when it was originally filed. The Examining Attorney never addressed the Section 2(f) claim, nor was it an issue on appeal.

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**Decision:** The refusal to register the mark in Application Serial No. 86689423 is reversed. The refusal to register the mark in Application Serial No. 85792872 is affirmed.