

This Opinion is Not a
Precedent of the TTAB

Mailed: July 10, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Detroit Rivertown Brewing Company, LLC
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Serial No. 86640818
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Daniel Christopherson of Lehrman Beverage Law, PLLC,
for Detroit Rivertown Brewing Company, LLC.

Caile Morris, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Zervas, Hightower, and Coggins,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Applicant Detroit Rivertown Brewing Company, LLC seeks registration on the Principal Register of the mark VANILLA JAVA PORTER, in standard characters and with “porter” disclaimed, for “beer” in International Class 32.¹ Applicant claims that the mark as a whole has become distinctive of its goods in commerce pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

¹ Application Serial No. 86640818 was filed on May 26, 2015, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based on allegations of first use anywhere and in commerce as of January 2006.

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that VANILLA JAVA PORTER is merely descriptive of the goods identified in the application, and Applicant has not provided sufficient evidence of acquired distinctiveness to support registration under Section 2(f).

After the refusal was made final, Applicant appealed, and briefing is complete. We affirm the refusal to register.

Although Applicant initially contested the descriptiveness refusal, Applicant has conceded for procedural purposes that VANILLA JAVA PORTER is merely descriptive by amending its application to seek registration under Section 2(f). *See Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Therefore, the only issue before us is whether Applicant's evidence of acquired distinctiveness for the mark VANILLA JAVA PORTER is sufficient. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 116 USPQ2d 1262, 1264 (Fed. Cir. 2015); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Applicant bears the burden of proving acquired distinctiveness. "To show that a mark has acquired distinctiveness, an applicant must demonstrate that the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005) (citing *Qualitex Co. v. Jacobson Prods. Inc.*, 514 US 159, 163, 34 USPQ2d 1161 (1995)).

Trademark Rule 2.41(a)(3), 37 C.F.R. § 2.41(a)(3), states that an applicant may submit, in support of registration under Section 2(f),

appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.

See also Steelbuilding.com, 75 USPQ2d at 1424 (“In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source)).” Applicant submitted an affidavit from its president stating in substantive part that:

The VANILLA JAVA PORTER mark has become distinctive for beer through Applicant’s substantially exclusive and continuous use in commerce for almost ten (10) years, and based on:

- a. Extensive sales of the beer in the United States across at least 20 states and the District of Columbia amounting to more than \$5,000,000 in retail sales;
- b. Extensive advertising expenditures in association with the mark amounting to more than \$250,000 over the past ten (10) years, including advertisements in Michigan Beer Guide and Great Lakes Brewing News, extensive promotions at retail, significant monetary expenditures on new packaging, point of sale materials, and social media campaigns.
- c. This beer has been mentioned in numerous articles, including various publications on web magazines like www.cleveland.com and www.mlive.com
- d. This is the flagship beer of one of the fastest growing craft breweries in the United States.

- e. The top 20 results in a Google search for “VANILLA JAVA PORTER” all relate to Applicant’s beer²

Descriptive words must be left free for competitive use. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978); *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). More evidence of acquired distinctiveness is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods would be less likely to believe that it indicates source in any one party. In other words, “the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.” *In re Bongrain Int’l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990) (quotations omitted); *see also Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1767 (TTAB 2013), *aff’d mem.*, 565 Fed. Appx. 900 (Fed. Cir. 2014).

Here, VANILLA JAVA PORTER is highly descriptive of the qualities, ingredients, and characteristics of the applicant’s goods. *See In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). On its website, Applicant describes its goods offered under VANILLA JAVA PORTER as follows:

With a beautifully crafted, copper cored, English Style Porter at its heart, Atwater’s Vanilla Java Porter tips its hat to the modern audience with the addition of vanilla and coffee that is locally brewed cold to eliminate burnt flavors. The beer, vanilla & coffee tumble together, enhancing the smooth nature of each.³

² Exhibit A to December 15, 2015, Response to Office Action at 7-9 (dated December 14, 2015).

³ June 22, 2015 Office Action at 5-6; *see also* Exhibit B to December 15, 2015 Response to Office Action at 10-11 (same). Atwater is Applicant’s trade name. Appeal Brief at 9, 4 TTABVUE 10.

The following evidence establishes that the words constituting the matter Applicant seeks to register have descriptive significance in association with its goods:

- Vanilla: The Examining Attorney introduced dictionary definitions of “vanilla” that include:
 - “*n.* 1. Any of tropical American vines of the genus *Vanilla* in the orchid family, especially *V. planifolia*, widely cultivated for its long narrow seedpods, which yield an aromatic substance used especially as a flavoring.”
 - “*adj.* 1. a. Flavored with vanilla: *vanilla pudding*.”⁴
- Java: We take judicial notice that the definition of “java” in the Merriam-Webster online dictionary is “coffee.”⁵ The Examining Attorney also introduced dictionary definitions of “java” including “*Informal* Brewed coffee.”⁶
- Porter (disclaimed): The Examining Attorney submitted dictionary definitions of “porter” including: “A dark beer resembling light stout, made from malt browned or charred by drying at a high temperature.”⁷ Applicant also introduced evidence that “Porters” are the name of a beer style family.⁸

Thus, it is plain from the record that Applicant’s goods are a porter-style beer containing vanilla and brewed coffee, that is, java. Each of these words retains its descriptive significance in the combination VANILLA JAVA PORTER, which forms

⁴ June 22, 2015 Office Action at 2 (from AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2011) at thefreedictionary.com/vanilla).

⁵ From merriam-webster.com/dictionary/java (last visited July 10, 2017). The Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format or have regular fixed editions. *E.g.*, *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 n.10 (TTAB 2015).

⁶ June 22, 2015 Office Action at 3 (from AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2011) at thefreedictionary.com/java).

⁷ *Id.* at 4 (from AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2011) at thefreedictionary.com/porter).

⁸ Exhibit D to December 15, 2015 Response to Office Action at 115-19 (from the “Beer Styles Study Guide” at CraftBeer.com).

a composite that is itself highly descriptive of Applicant's goods. *See, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (finding SNAP SIMPLY SAFER merely descriptive for cannulae, needles, and syringes); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1173 (TTAB 2013) (holding SUPERJAWS merely descriptive for tools).

Although Section 2(f) provides that the PTO may accept five years of "substantially exclusive and continuous use" as *prima facie* evidence of acquired distinctiveness, the statute does not require the PTO to do so. *La. Fish Fry*, 116 USPQ2d at 1265. For highly descriptive marks, passage of time alone may be insufficient to establish secondary meaning. *See, e.g., Alcatraz Media*, 107 USPQ2d at 1766 (finding 21 years of continuous use alone insufficient to establish acquired distinctiveness of highly descriptive phrase ANNAPOLIS TOURS); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984) (deeming use of PACKAGING SPECIALISTS, INC. for 16 years "a substantial period but not necessarily conclusive or persuasive on the Section 2(f) showing").

We find VANILLA JAVA PORTER to be such a phrase. Because it is so highly descriptive of Applicant's goods, ten years of use – even if it has been substantially exclusive, which we assume without deciding⁹ – is insufficient to establish *prima facie* that the phrase has acquired distinctiveness.

⁹ Much of Applicant's appeal brief and evidence submitted with its May 11, 2016 Response to Office Action is directed to countering the Examining Attorney's evidence of third-party use of the same phrase or its constituent elements in association with beer.

Considering Applicant's other evidence, we find that \$5 million in retail sales and \$250,000 in advertising over a ten-year period is insufficient to establish that the applied-for matter has become distinctive of Applicant's goods. Moreover, although the articles and advertising referenced in Applicant's affidavit are not of record, the ads mentioned include only what appear to be two specialty publications, likely from the same geographic area: "Michigan Beer Guide" and "Great Lakes Brewing News." Applicant did submit Internet printouts of two newspaper articles referencing its VANILLA JAVA PORTER and at least one discussion thread specifically about a home brew attempt to clone it.¹⁰ This evidence does not establish "the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product." *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985).

On this record, we find that Applicant has not established that, "in the minds of the public, the primary significance of [VANILLA JAVA PORTER] is to identify the source of the product rather than the product itself." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012) (quotation omitted).

Decision: The refusal to register is affirmed.

¹⁰ Exhibits X (Robert Allen, *Detroit's most popular beers, St. Patrick's Day faves*, DETROIT FREE PRESS, March 16, 2016); Y (Kevin Revolinski, *A toast to good news from Detroit*, CHI. TRIB., Dec. 14, 2013); and J ("Atwater brewery vanilla java porter clone") to May 11, 2016 Response to Office Action at 59-63, 130-39.