

This Opinion is Not a
Precedent of the TTAB

Hearing: January 31, 2023

Mailed: May 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Starbucks Corporation
v.
Mountains and Mermaids, LLC

—
Opposition Nos. 91250027 & 91250160¹

—
Anessa Owen Kramer, Mary A. Hyde, Ka'Nea Brooks and Amanda Blackburn of
Honigman LLP for Starbucks Corporation

Olivia Muller and Erik M. Pelton of Erik M. Pelton & Associates, PLLC for
Mountains and Mermaids, LLC

—
Before Wellington, Lynch and Dunn,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

¹ The Board previously consolidated these oppositions and designated Opposition No. 91250027 as the parent case. 6 TTABVUE. We cite to the TTABVUE record in the parent case unless otherwise indicated.

I. Background and Opposer's Motion

In two applications, Mountains and Mermaids, LLC (“Applicant”) seeks registration on the Principal Register of the standard-character mark SIREN’S BREW for “shirts; sweat shirts” in International Class 25² and “coffee beans; ground coffee beans” in International Class 30.³ Applicant disclaimed BREW in the latter application.

In its Notices of Opposition, Starbucks Corporation (“Opposer”) opposes registration of Applicant’s mark on two grounds. First, Opposers allege likelihood of confusion under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), with Opposer’s alleged common law use of SIREN in connection with “coffee and coffee-related goods and services, as well as the associated merchandising goods,”⁴ and with numerous registered design and composite marks,⁵ including:

² Application Serial No. 88215319 was filed on December 3, 2018 based on alleged use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The application claims first use of the mark in September 2017 and first use of the mark in commerce in March 2018.

³ Application Serial No. 88202494 was filed on November 21, 2018 based on alleged intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

⁴ 1 TTABVue 74-75 (Notice of Opposition).

⁵ Opposer’s pleaded registrations that are of record are: Registration Nos. 1417602, 1098925, 1542775, 1815937, 1815938, 1943361, 2120653, 2091941, 2266351, 2553708, 3298945, 3931909, 3702367, 3673335, 2696192, 4538053, 4572688.



for goods that include coffee in International Class 30;⁶



for goods that include ground and whole bean coffee in International Class 30;



for a variety of goods and services, including t-shirts, polo shirts and sweatshirts in International Class 25 and ground and whole-bean coffee and in International Class 30;⁷ and

⁶ Registration No. 1417602 issued November 18, 1986, and has been maintained.

⁷ Registration No. 4538053 issued March 27, 2014, and has been maintained. The registration includes the following description: “The mark consists of a circular seal with the design of a siren (a two-tailed mermaid) wearing a crown.”



for a variety of goods and services, including t-shirts, polo shirts and sweatshirts in International Class 25, and ground and whole-bean coffee in International Class 30.⁸

Second, Opposer alleges dilution by blurring of its pleaded registered marks under Section 43(c) of the Act, 15 U.S.C. 1093(c).

As Opposer does, we focus particularly on the last two registrations listed above, as they contain the most relevant marks for purposes of challenging the subject applications on both grounds, and the most relevant goods for purposes of the likelihood of confusion claim. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we would not rule for Opposer based on these registrations, we would not rule for Opposer based on the other registrations. We refer in this decision to the image in these marks as Opposer’s “Design Logo,” for ease of reference.

In its Answers, Applicant denied the salient allegations in the Notices of Opposition.⁹ Applicant also included assertions under the heading “Affirmative Defenses and Amplifications,” but they are not true affirmative defenses, and we do not treat them as such. *The Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at

⁸ Registration No. 4572688 issued July 22, 2014, and has been maintained. The registration includes the following description: “The mark consists of a circular seal with the design of a siren (a two-tailed mermaid) wearing a crown.”

⁹ 4 TTABVUE (Answer).

*4 (TTAB 2021); *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *1 (TTAB 2020). Regardless, Applicant did not pursue any purported affirmative defenses at trial. We therefore also consider any affirmative defenses waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2022) (“If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived”).

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the opposed applications. Both parties supplemented the record with documents filed under notices of reliance, as well as testimony with exhibits. As testimony, Opposer introduced a declaration from its Brand Manager/Group Director, Destiny Linayao, and discovery deposition testimony (Rule 30(b)(6))¹⁰ from Applicant's co-owners, Jeffrey Hamilton (Sarah Hamilton and Monica Hamilton. Applicant submitted a declaration from Monica Hamilton and discovery deposition testimony (Rule 30(b)(6)) from Destiny Linayao.

The consolidated proceeding has been fully briefed, and neither party lodged or preserved objections in briefing the case. Applicant explicitly concurred with Opposer's recitation of the contents of the evidentiary record.¹¹ An oral hearing occurred on January 31, 2023.

¹⁰ Federal Rule of Civil Procedure 30(b)(6) provides for corporate depositions, whereby the named organization designates one or more representatives to testify on its behalf.

¹¹ 68 TTABVUE 15.

Following the Board's request at the hearing that Opposer review its confidentiality designations of evidence and submit public versions if appropriate, Opposer moved to submit public versions of certain evidence previously designated confidential.¹² We grant the motion and accept the public versions of these previously submitted evidentiary submissions.

II. Statutory Entitlement to Oppose

To establish statutory entitlement to oppose under Section 13 of the Act, 15 U.S.C. § 1063, Opposer must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012).

Opposer attached to the Notices of Opposition USPTO database records for its pleaded registrations.¹³ Opposer's ownership of the pleaded registrations, for which status and title are established through the records, support its plausible likelihood of confusion claim against the involved applications, thereby showing its real interest in this proceeding, and a reasonable basis for its belief of damage. Opposer has established a statutory entitlement to oppose.¹⁴ *See Coach Servs.*, 101 USPQ2d at

¹² 78 TTABVUE.

¹³ 1 TTABVUE 95-283.

¹⁴ Applicant does not challenge Opposer's entitlement to a statutory cause of action, and instead, despite the absence of a counterclaim, in this section of its brief, only asserts

1727-28; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). “Where a plaintiff has proven entitlement to a statutory cause of action as to at least one properly pleaded ground, it has established [statutory entitlement to a cause of action] for any other legally sufficient ground.” See *Int’l Dairy Foods Ass’n v. Interprofession du Gruyere*, 2020 USPQ2d 10892, at *9 (TTAB 2020).

III. Priority and Likelihood of Confusion

To prevail on the likelihood of confusion ground under Section 2(d) of the Act, Opposer bears the burden to prove by a preponderance of the evidence both priority of use and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1848; *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (“The burden of proof rests with the [plaintiff] ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion.”). The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental

Applicant’s own entitlement “to a statutory cause of action in its position as the defendant in both proceedings.” 68 TTABVUE 16.

inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Priority

1. Applicant’s Priority Dates

Applicant’s Class 25 application contains a March 2018 date of first use in commerce, and its declaration testimony similarly claims that Applicant undertook use of its mark on clothing in March 2018.¹⁵ This serves as Applicant’s priority date for its identified clothing goods. Applicant’s Class 30 application, filed November 21, 2018, is based on intent-to-use, and Applicant’s testimony asserts that it undertook use of its mark on coffee beans and ground coffee in May 2019.¹⁶ Applicant’s November 21, 2018 filing date serves as its priority date for its identified coffee goods. *See Executive Coach Builders, Inc. v. SPV Coach Co., Inc.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (citing *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009)).

2. Registrations

Because Opposer has made its registrations of record, which Applicant has not counterclaimed to cancel, priority is not an issue as to the marks and goods and services covered by the registrations. *See Top Tobacco LP v. N. Atl. Op. Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011) (citing *King Candy, Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974)); *see also Massey Junior Coll., Inc. v.*

¹⁵ 58 TTABVUE 4 (Monica Hamilton Declaration).

¹⁶ 58 TTABVUE 6 (Monica Hamilton Declaration).

Fashion Inst. of Tech., 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) (“prior use need not be shown by a plaintiff relying on a registered mark unless the defendant counterclaims for cancellation”); *Itel Corp. v. Ainslie*, 8 USPQ2d 1168, 1169 (TTAB 1988) (“because of the existence of opposer’s valid and subsisting registration, it need not prove prior use as to the services recited therein”).

3. Common Law

To the extent Opposer relies on alleged common law rights, it must prove that, vis-à-vis Applicant, Opposer owns proprietary rights in “a mark or trade name previously used in the United States . . . and not abandoned . . .” *Threshold.TV, Inc. v. Metronome Enters., Inc.*, 96 USPQ2d 1031, 1036-37 (TTAB 2010) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981)); see also *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). “These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *DeVivo v. Ortiz*, 2020 USPQ2d 10153, at *3 (citing *Herbko Int’l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002)).

Opposer essentially asserts five bases for common-law priority: (1) Current use of SIREN’S BLEND for coffee¹⁷ tacked onto alleged prior rights in SIREN’S NOTE

¹⁷ Ms. Linayao testified that SIREN’S BLEND launched in stores in “September of 2019,” the month after Opposer filed these proceedings. 78 TTABVUE 77. Opposer sold whole bean coffee under this mark. 78 TTABVUE 81.

BLEND for coffee; (2) Prior trade name use of Siren Retail Group, which allegedly has offered “premium coffee-related experiences” since 2016; (3) Prior alleged use of the word mark SIREN “in connection with many goods and services, including coffee-related goods and services and apparel;”¹⁸ (4) Prior alleged use of SIREN in Opposer’s “branding and promotional efforts in a manner analogous to trademark use;”¹⁹ and (5) alleged public association of “Siren” with Opposer as a nickname for Opposer.

a. Tacking

The Supreme Court characterized tacking in *Hana Fin., Inc. v. Hana Bank*, 135 S. Ct. 907, 190 L. Ed. 2d 800, 113 USPQ2d 1365, 1366 (2015) as follows:

Recognizing that trademark users ought to be permitted to make certain modifications to their marks over time without losing priority, lower courts have provided that, in limited circumstances, a party may clothe a new mark with the priority position of an older mark. This doctrine is called ‘tacking,’ and lower courts have found tacking to be available when the original and revised marks are ‘legal equivalents’ in that they create the same, continuing commercial impression.

For two reasons, we reject Opposer’s claim of priority arising from its new SIREN’S BLEND coffee,²⁰ launched after Applicant’s priority date, based on tacking to SIREN’S NOTE BLEND coffee, which dates back to 1998, and was discontinued

¹⁸ 65 TTABVUE 27 (Opposer’s Brief).

¹⁹ *Id.*

²⁰ Ms. Linayao testified that SIREN’S BLEND launched in stores in “September of 2019,” the month after Opposer filed these proceedings. 78 TTABVUE 77.

by March 2006 at the latest, when Opposer's registration for this mark was cancelled.²¹

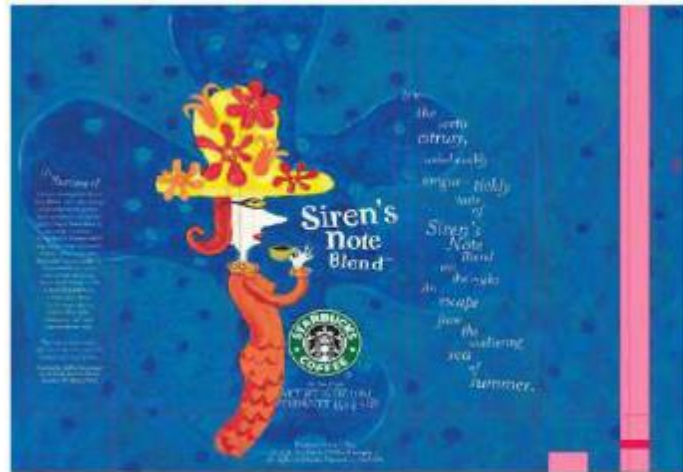
First, Opposer abandoned SIREN'S NOTE BLEND. Under Section 2(d), Opposer's prior use of the mark need not be continuous, *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1605-06 (TTAB 2018) (citing *West Fla. Seafood*, 31 USPQ2d at 1665), but the mark must have been "not abandoned." 15 U.S.C. § 1052(d). "Section 45 of the Trademark Act, 15 U.S.C. § 1127, provides in relevant part that a mark shall be deemed 'abandoned': When its use has been discontinued with intent not to resume such use." *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017) (quoting 15 U.S.C. § 1127). "[E]vidence of nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that a mark was abandoned without intent to resume use." *Id.* (citing *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998)).

Ms. Linayao testified:

I understand that Starbucks previously filed a trademark application, U.S. Trademark Application No. 75372700, for the mark SIREN'S NOTE BLEND covering ground and whole bean coffee and coffee drinks in Class 30, and that this application eventually registered, as U.S. Registration No. 2,254,396 on June 15, 1999 (which was later cancelled). I understand that the Siren's Note Blend brand coffee was sold in the United States beginning in April of 1998. Examples of Starbucks packaging and promotional materials for, and information about, the Siren's Note

²¹ 78 TTABVUE 80. Opposer owned a registration for SIREN'S NOTE BLEND for "ground and whole bean coffee and coffee drinks" that issued in 1999 and was cancelled in 2006. 30 TTABVUE 418-19.

Blend Coffee product, are shown below and included in attached Exhibit 4:



As shown in the samples above, the “SIREN’S” portion of the mark appears separately from the “NOTE BLEND” portion. I understand that Starbucks never intended to abandon “SIREN;” this mark has always been part of Starbucks branding, and Starbucks continues to use “SIREN” in its branding to this day, as further explained below.²²

The declaration testimony provides no additional information about the coffee sales that occurred in or potentially after April 1998. Although Ms. Linayao testified that she worked for Starbucks “when Siren’s Note Blend was discontinued,” she did not recall when that was.²³ When shown the USPTO record of the cancellation of Opposer’s registration for SIREN’S NOTE BLEND, with a cancellation date of March 18, 2006, Ms. Linayao stated, “Seems in keeping with when. I wasn’t on – I wasn’t part of discontinuing or on the coffee team at the time. But it seems right.”²⁴ Ms.

²² 31 TTABVUE 20-21 (Linayao Declaration).

²³ 78 TTABVUE 78 (30(b)(6) Deposition).

²⁴ 78 TTABVUE 80 (30(b)(6) Deposition).

Linayao went on to testify that she started working for Opposer in 2001, and agreed that “Siren’s Note Blend was discontinued within [her] first few years of working at Starbucks.”²⁵

The two elements of abandonment are nonuse of the mark and intent not to resume use. *Executive Coach Builders*, 123 USPQ2d at 1180. The record establishes that Opposer discontinued use of SIREN’S NOTE BLEND by March 2006 at the latest, and there is no evidence of any resumption of use. Thus, the period of nonuse far exceeds the three-year period that triggers a statutory presumption of abandonment. “If a defendant raising abandonment as an affirmative defense against prior common law rights can show three consecutive years of nonuse, it has established a prima facie showing of abandonment, creating a rebuttable presumption that the mark was abandoned with intent not to resume use.” *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1485 (TTAB 2017). The burden of production (i.e., going forward) then shifts to the plaintiff, to produce evidence that it has either used the mark or that it has intended to resume use. *Id.* at 1485.

Opposer counters the presumption only with an assertion that it never intended to abandon the mark, citing Ms. Linayao’s testimony quoted above – “I understand that Starbucks never intended to abandon ‘SIREN;’ this mark has always been part of Starbucks branding, and Starbucks continues to use ‘SIREN’ in its branding to this day.”²⁶ This type of bare bones assertion about SIREN does not suffice to rebut the

²⁵ *Id.*

²⁶ 78 TTABVUE 77.

presumption of abandonment for SIREN'S NOTE BLEND, however. In addition to referring to a different mark, an affirmative desire not to relinquish a mark is not determinative of the intent element of abandonment under the Trademark Act. *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1538 (TTAB 2018); *Azeka Bldg. Corp.*, 122 USPQ2d at 1487 (quoting *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990) (“In every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise there would be no contest.”)). We therefore conclude that Opposer abandoned SIREN'S NOTE BLEND through nonuse, and therefore cannot rely on it for tacking.

As a second reason that tacking could not apply here, we find that SIREN'S NOTE BLEND and SIREN'S BLEND are not legally equivalent marks for this purpose. To meet the legal equivalents test, two marks must “create the same, continuing commercial impression so that consumers consider both as the same mark.” *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1768 n. 8 (TTAB 2015) (quoting *Hana Fin.*, 113 USPQ2d at 1367); *see also In re Nielsen Bus. Media, Inc.*, 93 USPQ2d 1545, 1547 (TTAB 2010). SIREN'S NOTE BLEND is not the legal equivalent of SIREN'S BLEND because the deletion of the word NOTE changes the appearance, sound, connotation and commercial impression of the marks in a significant enough way that they are not essentially the same. *See, e.g., The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629 (TTAB 2007) (Applicant cannot tack on prior user of ELIZABETH ARDEN to later use of ARDENBEAUTY in order to achieve

priority, noting that the standard for tacking is “very strict” and is permitted only in “rare cases.”); *see also Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991) (“[T]he standard of legal equivalence used in reviewing efforts to ‘tack’ the prior use of one mark onto that of another is higher than that used in evaluating two competing marks. ... [E]ven if the two marks are confusingly similar, they still may not be legal equivalents.”). In addition to the obvious phonetic and visual differences due to the added word NOTE, because mythical sirens were known for music,²⁷ a siren’s note conjures up the sense of a musical note emanating from a siren, a distinctly different connotation and impression than a siren’s blend, which conjures up the sense of a mixture coming from a siren. Considering the marks in their entirety, they do not create the same continuing commercial impression.

b. Trade Name Use

Opposer presented testimony that it “created its widely-publicized ‘Siren Retail Group,’ which encompasses a full line-up of premium retail experiences, including its Reserve Roastery, Reserve Store, Reserve Coffee Bar, and Princi Bakery,” pointing to an accompanying photograph of “The Starbucks Siren ... as an architectural component of the New York Starbucks Reserve Roastery, a part of the Siren Retail Group.”²⁸ Ms. Linayao testified that the Siren Retail Group was “widely publicized,”

²⁷ 59 TTABVUE 8. Merriam-Webster Dictionary defines “siren” in relevant part as “any of a group of female and partly human creatures in Greek mythology that lured mariners to destruction by their singing.”

²⁸ 31 TTABVUE 21; *see also* 32 TTABVUE 1-65.

but only testified to four corporate news articles regarding the Siren Retail Group from Retail TouchPoints (July 2016), Market Watch (July 2016), and the Puget Sound Business Journal (April and July 2018).²⁹ The articles describe SIREN RETAIL as an “arm,” “initiative,” “new retail group within the company,” and “part of several organizational changes” of Starbucks, to oversee the retail businesses mentioned by Ms. Linayao.³⁰ The same articles indicate that the various “premium” retail services are offered to consumers under different names, such as “Reserve Roastery” or “Princi Bakery.”³¹

Applicant argues that the trade name use is not sufficiently public-facing, and that SIREN RETAIL GROUP “seems to be merely an internal arm of Starbucks that provides management services for STARBUCKS RESERVE, STARBUCKS ROASTERY, and PRINCI bakeries.”³² We agree.

Prior trade name use may establish priority for purposes of barring registration of a mark that is confusingly similar to the trade name. *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993) (trade name use may serve as the basis for priority); *Nat’l Cable Television Ass’n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) (same). However, such trade name use, for purposes of priority, must generate public awareness. For example, “[i]t is well established that mere incorporation, in itself,

²⁹ 31 TTABVUE 155-170.

³⁰ *Id.*

³¹ *Id.*

³² 28 TTABVUE 27 (Applicant’s Brief).

cannot establish priority of use of a trademark or trade name.” *Sperry Rand Corp. v. Select Beauty Brands, Inc.*, 184 USPQ 767 (TTAB 1974) citing *The Geo. Washington Mint, Inc. v. The Washington Mint, Inc.*, 349 F. Supp. 255, 176 USPQ 251 (S.D.N.Y. 1972), and cases cited therein; *McNeil v. Mini Mansions, Inc.*, 178 USPQ 312 (TTAB 1973).

We find that Opposer has not met its burden to show that “Siren Retail Group” is a trade name with sufficient public recognition to establish priority of use. Without saying precisely what the Siren Retail Group was or is, Ms. Linayao testified ambiguously that it was “created” and that it “encompasses a full line-up of premium retail experiences.”³³ She stated, in a conclusory way, that this creation was widely publicized, but the documentation she relies upon does not bear this out. The three publications appear to be aimed at an industry-specific, rather than mainstream, audience, and we have no information about the scope of their readership. Also, while Opposer’s Brief implies that retail coffee-related experiences are offered under the trade name, Ms. Linayao’s testimony and the accompanying articles instead seem to indicate that the Siren Retail Group merely manages a retail segment of Opposer, and the retailers do not operate under this so-called trade name. Ultimately, we cannot find public exposure to Siren Retail Group as a trade name for priority purposes. Opposer has not established common law priority based on a putative SIREN RETAIL GROUP trade name.³⁴

³³ 31 TTABVUE 21.

³⁴ We are not persuaded by Opposer’s assertion in its Reply Brief that the Siren Retail Group is a subsidiary of Starbucks, and we decline to consider material underlying the hyperlink

c. Common Law Use of SIREN

In support of Opposer's alleged use of SIREN in connection with many goods and services, including coffee-related goods and services and apparel, its main brief cites only to paragraphs 24 and 25 of the Linayao Declaration, and its exhibits.³⁵ These two declaration paragraphs merely state:

24. Starbucks and Starbucks employees also have produced and sold various merchandise items using the SIREN mark, including purses, figurines, musical albums, books, and bookmarks, as shown below and in **Exhibit 7**:

included in Opposer's Reply Brief, as evidence not filed in compliance with the rules of practice governing opposition proceedings before the Board will not be considered. *See Swiss Watch Int'l Inc. v. Federation of the Swiss Watch Ind.*, 101 USPQ2d 1731, 1734-35 (TTAB 2012); *see also In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013) (providing hyperlinks to Internet materials is insufficient to make linked materials of record); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n.3 (TTAB 2012) (The Board "will not utilize a link or reference to a website's internet address to access the site to consider whatever content may appear therein.").

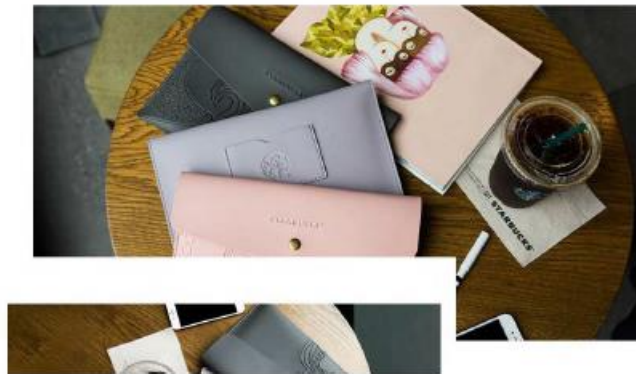
³⁵ 65 TTABVUE 67.

- <https://unicornmermaid.com/2017/08/21/starbucks-has-launched-a-new-siren-tail-clutch/>

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Starbucks has launched a new Siren Tail Clutch

AUGUST 21, 2017 MERMAID



- <https://www.matteocibicstudio.com/ulyssesandsirens/43yob8kuxux2lz256avzmo45lrs0cc>



Finally, when the sea and night sky become as dark as the brew he's holding, a siren leaps from the water and he witnesses a flash of her tails.*

A special edition of 100 small Ulysses and the Sirens and an edition of 10 bigger sculpture of the Siren with the two tails are available in the Starbucks Reserve in Milan, Seattle, Shanghai. Ceramic and 24K gold.

- Various Musical Compilations titled “Songs of the Siren”; *see e.g.*:



25. Lists reflecting further representative examples of Starbucks products created and sold under a SIREN name or mark are attached as **Exhibit 8**.³⁶

This vague and indefinite testimony and the similarly inconclusive accompanying exhibits fail to establish priority from common law use of SIREN as a mark. The testimony is conspicuously silent as to the date of alleged sales, and the exhibits do not correct this deficiency. “The oral testimony even of a single witness may be adequate to establish priority, but only if it is sufficiently probative,” and the testimony should not be characterized by “indefiniteness but should carry with it conviction of its accuracy and applicability.” *Exec. Coach Builders*, 123 USPQ2d at

³⁶ 31 TTABVUE 21-23 (emphasis in original); *see also* 32 TTABVUE (Exhibit 7), 78 TTABVUE (Exhibit 8, redacted).

1184 (quoting *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945); citing *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d 1361, 1372 (TTAB 2014)). Ms. Linayao's testimony is not supported by the type of documentary evidence of sales that one would expect to be readily available to show the use alleged. The list in Exhibit 8 does not reflect or refer to sales under the word mark SIREN, nor does the documentation in Exhibit 7. *See Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at *20 (TTAB 2021) (probative value of testimony also is significantly undermined by witness' utter lack of detail); *H. Betti Indus., Inc. v. Brunswick Corp.*, 211 USPQ 1188, 1197 (TTAB 1981) (vague, indefinite and inconsistent testimony accompanied by inadequate documentary evidence insufficient to support priority claim). We therefore reject Opposer's priority claim based on common law use of the word mark SIREN. *See Syngenta Crop Protection*, 90 USPQ2d at 1119 (dismissing opposition for failure to prove priority where "neither Mr. Marier's testimony nor that of Ms. Watson clearly indicates when opposer began using its AGROMETER mark").

d. Use of SIREN Analogous to Trademark Use

Priority may be grounded on the prior use of a term in a manner analogous to service mark or trademark use. *See, e.g., Steer Inn Sys., Inc. v. Laughner's Drive-In, Inc.*, 405 F.2d 1401, 160 USPQ 626 (CCPA 1969) (successful opposition to registration of service mark). However, the analogous use is must be of such a nature and extent as to create public identification of the target term with Opposer's product or service. *See, e.g., Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572,

1578, 19 U.S.P.Q.2D (BNA) 1424, 1429 (Fed. Cir. 1991); *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1640 (Fed. Cir. 1989).

For Opposer's assertion of priority based on use of the term SIREN in a manner analogous to trademark use, the only testimony it cites are the same portions of the Linayao Declaration discussed above in connection with SIREN RETAIL GROUP and the assertion that "Starbucks and Starbucks employees also have produced and sold various merchandise items using the SIREN mark."³⁷ Opposer also relies on Exhibit 10 of the Linayao Declaration, but the testimony introducing it noted only that "[f]or many years, Starbucks has also used the term 'SIREN' in connection with promotional materials and art at its various locations nationally, representative examples of which are shown ... in **Exhibit 10**."³⁸ In addition to the weakness of the evidence offered to support priority based on the Siren Retail Group purported trade name as discussed above, the lack of specific dates and general indefiniteness of the cited testimony renders it, and the accompanying exhibits, inadequate to establish priority under an analogous use theory. *See, e.g., Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1218-19 (TTAB 2007) (opposer failed to acquire rights through analogous trademark use; "For purposes of establishing priority via analogous trademark use, the critical factor is the actual number of prospective customers reached"); *see also T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996) (evidence must show "sufficiently clear, widespread and

³⁷ 31 TTABVUE 21.

³⁸ 31 TTABVUE 23 (emphasis in original); 33 TTABVUE; 47 TTABVUE78 TTABVUE 21 (Exhibit 10b redacted).

repetitive to create the required association in the minds of potential purchasers between the mark as an indicator of a particular source and the service to become available later”).

e. Public Association of Opposer with SIREN as a Nickname

Opposer contends it “has priority in SIREN’ by virtue of the public’s association of ‘SIREN’ with Starbucks.”³⁹ The blog evidence to which Opposer points for statements about the ubiquity or recognition of “the Starbucks Siren” or “the Siren” logo does not establish the truth of the statements therein. Rather, blog printouts can be relied on for what they show on their face – public exposure to descriptions of or references to Opposer’s mark as a siren or as “the Starbucks Siren.”⁴⁰ Their number is relatively small and their reach is unclear. Opposer then makes a sweeping assertion that “[t]here are thousands of examples of the public’s association of ‘SIREN’ with Starbucks and its products and services on social media.... Many of these uses occurred prior to any date on which Applicant can rely.”⁴¹ Apparently placing the onus on the Board to parse through the examples it submitted to check for relevant content and dates, Opposer then concludes that the Board, relying on *West Florida*

³⁹ 69 TTABVUE 17 (Opposer’s Reply Brief).

⁴⁰ Notably, several of the “representative examples” cited by Opposer in its Brief come from foreign blogs that are not very probative of U.S. consumer exposure. *E.g.*, 35 TTABVUE 26 (India); 35 TTABVUE 32 (Philippines).

⁴¹ 65 TTABVUE 30.

Seafood, should consider this evidence as a whole to establish priority in “coffee- and apparel-related goods and services.”⁴²

We have considered the record in its entirety. As discussed below in connection with the similarity of the marks analysis, we find much of the evidence cited here by Opposer sufficient and convincing to establish consumer recognition that Opposer’s Design Logo is a siren. However, given the quantity and nature of the third-party blog and social media evidence on which Opposer relies, we do not find the situation analogous to cases with successful nickname showings such as *Nat’l Cable*, 19 USPQ2d at 1428, where “[t]he evidence is profuse that Editors has publicly been known as ACE since prior to 1979, as attested to by members of Editors, as well as shown by newspaper articles and third party correspondence where the name American Cinema Editors has routinely been shortened to ACE,” and *VolkswagenwerkAG v. Advance Welding & Mfg. Corp.*, 193 USPQ 673 (TTAB 1976), which involved “articles in well-known and nationally circulated newspapers as well as in local newspapers and in nationally known magazines such as ‘Time’, ‘Fortune’, ‘Business Week’, ‘The Wall Street Journal’, ‘Sports Illustrated’, ‘Life’, and others.” *See also Big Blue Products, Inc. v. Int’l Business Machines Corp.*, 19 USPQ2d 1072, 1074 (TTAB 1991) (summary judgment as to nickname priority denied even where IBM has submitted over 500 articles appearing in a wide array of publications which predate September 27, 1984 (opposer’s claimed first use date)). We therefore do not find this to be one of the limited circumstances in which priority arises out of third-

⁴² *Id.*

party nickname use, and we decline to accord Opposer priority in the word SIREN on this theory.

f. Conclusion Regarding Priority

Thus, Opposer's priority in this case is established only as to its pleaded registrations, as priority is not at issue for the coffee and clothing goods in its Design Logo registrations, but not as to common law rights in any variant of the word SIREN, for which Opposer did not meet its burden of proof to establish priority.

B. The Goods

Relying only on Opposer's pleaded registrations, we turn to the likelihood of confusion analysis and the relevant *DuPont* factors. "[L]ikelihood of confusion can be found 'if the respective goods are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.'" *Coach Servs.*, 101 USPQ2d at 1722 (internal citations omitted). We "focus on the application[s] and registrations rather than on real world conditions, because 'the question of registrability of an Applicant's mark must be decided on the basis of the identification of goods set forth in the application[s].'" *Stone Lion Capital Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014).

Opposer's goods in its registrations and Applicant's goods are identical and legally identical. Applicant's identification of whole coffee beans and ground coffee beans overlaps with Opposer's "coffee" and its identification of ground and whole-bean coffee. *See S.W. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015)

(where the goods in an application or registration are broadly described, they are deemed to encompass all the goods of the nature and type described therein); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”). Similarly, Applicant’s “shirts; sweat shirts,” which include all types of shirts, overlap with Opposer’s “T-shirts, polo shirts, [and] sweatshirts.”

C. Trade Channels and Classes of Consumers

Because Applicant’s goods are identical and legally identical to Opposer’s goods in its registrations, we must presume that they travel in some of the same channels of trade to at least some of the same classes of consumers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d mem.*, (No. 18-2236) (Fed. Cir. September 13, 2019) (“Because the services described in the application and the cited registration are identical, we presume that the channels of trade and classes of purchasers are the same.”).

D. Commercial Strength of Opposer’s Marks

Opposer argues under the fifth *DuPont* factor that the Design Logo in its marks, which it refers to as “the Starbucks Siren,” should be deemed famous. The strength of a mark rests on the extent to which “a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator.” *Joseph Phelps Vineyards, LLC*

v. Fairmont Holdings, LLC, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). As the Federal Circuit has explained, “[w]hile dilution fame is an either/or proposition--fame either does or does not exist--likelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards*, 122 USPQ2d at 1734 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation omitted)). A very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis. *See id.* at 1694 (strong marks “enjoy wide latitude of legal protection” and are “more attractive as targets for would-be copyists”). Strength may be measured indirectly by the volume of sales and advertising expenditures in connection with the goods and services sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods and services identified by the marks; and the general reputation of the goods and services. *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose*, 63 USPQ2d at 1308 (recognizing indirect evidence as appropriate proof of strength).

To demonstrate fame, Opposer provided a variety of evidence, some of which is confidential and therefore will be discussed only in general terms. As background, in Opposer’s 2010 Annual Report, which featured a variation of its Design Logo on the cover, Opposer held itself out as “the premier roaster and retailer of specialty coffee

in the world,” and described its business as involving “coffee and tea beverages and a variety of fresh food items.”⁴³ Opposer has used one or more of the forms below of “the Starbucks Siren” since 1971.⁴⁴



Ms. Linayao testified to “how central the Siren image and logo is to the Starbucks company identity,” citing an internal guide that displays the image on the far right above, stating that “[t]he Siren is our muse, the face of our brand. Her image and our strong wordmark are our most recognizable brand assets.”⁴⁵

Opposer “prominently features the Starbucks Siren” on its app, which was used by over 23 million consumers in 2019.⁴⁶ Opposer also “prominently features the Starbucks Siren” on its website, which from April 1 to September 30, 2020, had “over 15.8 million page-views.”⁴⁷ Opposer has approximately 15,000 stores nationwide, and another 6,000 locations operated by licensees “in locations like grocery stores, retail stores, hotels, airports, and hospitals,”⁴⁸ all of which feature “images of the Starbucks

⁴³ 29 TTABVUE 14.

⁴⁴ 31 TTABVUE 3 (Linayao Declaration).

⁴⁵ *Id.* at 20; 44 TTABVUE 55 (confidential Exhibit 3.b).

⁴⁶ 31 TTABVUE at 3.

⁴⁷ *Id.*

⁴⁸ *Id.* at 4.

Siren on the store signage, promotional material, menu, and/or product packaging.”⁴⁹ Ms. Linayao testified that Opposer has stores in “high-profile locations,” more than 1600 Target retail stores, major U.S. airports and “well-known national chain hotels,” where “the Starbucks Siren appears on the signage, menu boards, cups, and/or product packaging.”⁵⁰ Ms. Linayao does not provide greater detail about the nature and extent of such appearances of the marks in Opposer’s many locations, nor does her testimony explicitly point to representative examples from which we could judge any prominence or extent of the appearances of Opposer’s Design Logo. Nonetheless, Ms. Linayao estimates that as a result of Opposer’s commercial presence, “[t]ens of millions of customers encounter Starbucks and the Starbucks Siren every day.”⁵¹

Opposer introduced some – but not an overwhelming number of – examples of recognition of its marks, including its Design Logo marks, in mainstream media. Recognition in the media includes, for example, a Huffington Post online article on December 6, 2017 titled “The Legend of the Starbucks Siren” that included the following statements: “Since 1971, the ubiquitous image of the Starbucks Siren has been a constant companion to coffee cups from the chain. Whether tall, grande, or venti, if you’re spotted carrying a cuppa joe with a green siren printed on the cup’s packaging it is universally known that you just went to Starbucks.”⁵² Another online article dated February 1, 2011 from Slate magazine reads, “A few weeks ago, when

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

⁵² 31 TTABVUE 35-36.

Starbucks announced that it was going to be changing its logo, we introduced you to the Starbucks Siren, the beautiful, mermaid-like creature whose two-finned salute has adorned the company's coffee cups since 1971.”⁵³

Revenue and advertising figures, and the context for those figures, often comprise a significant consideration for strength. *See Bose*, 63 USPQ2d at 1305 (“our cases teach that the fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident”). In this case, however, Opposer does not provide testimony with supporting exhibits for these numbers, but instead, only points to its what it identified in its Notice of Reliance (Exhibit 9) as “Annual Reports of Starbucks Corporation, Fiscal Years 2010 to 2019.”⁵⁴ The reports are not documents generally admissible under notice of reliance, as they are not printed publications or Internet materials under Trademark Rule 2.122(e).⁵⁵ *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 at n. 5 (TTAB 1989), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *Coach Servs.*, 101 USPQ2d at 1718. “Nevertheless, since [Applicant did not object] to the reliance on annual reports by its adversary, the Board considers this material to be of record in the same manner as if it had been

⁵³ *Id.* at 36.

⁵⁴ 29 TTABVUE 3 (Notice of Reliance description of Exhibit 9); *see also* 65 TTABVUE 35 (Opposer's Brief, citing only to the Notice of Reliance for its sales and advertising figures).

⁵⁵ While Opposer's annual reports include copies of Opposer's Form 10-K filings, these are not public records from the Securities and Exchange Commission and there is no accompanying testimony to qualify them as business records.

stipulated into evidence and said material has been considered for whatever limited probative value it is entitled to, namely, for what this material shows on its face.” *Midwest Plastic Fabricators*, 12 USPQ2d at 1270 n.5; *see also Coach Servs.*, 101 USPQ2d at 1719 (nothing “independently establishing the information contained [in annual reports relied on for sales and advertising figures]”); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007).

The probative value of the sales and advertising figures held out by Opposer in its annual reports is considerably diminished because the reports do not provide the relevant information for an assessment of strength of the particular marks at issue in this case. As Opposer recognizes in its Brief, the critical sales figure would be “products and services offered with its Siren Marks” and the critical promotional figure would be spending on “advertising goods and services in connection with its Siren Marks.”⁵⁶ While Opposer cites to its annual reports for this information, the reports contain no such restriction to the “Siren Marks.” Instead, they provide Opposer’s overall revenue and advertising,⁵⁷ which does not distinguish between, for example, sales and advertising in connection with the STARBUCKS standalone word mark versus the Design Logo marks at issue here. These broad figures suggest that Opposer has significant revenues and spends a substantial sum on advertising,⁵⁸ but

⁵⁶ 65 TTABVUE 35.

⁵⁷ *E.g.*, 30 TTABVUE 63, 100 (exemplary pages to which Opposer cites in its Brief).

⁵⁸ Also, in a belated attempt to place the sales figures in context, Opposer’s Brief makes an assertion of market share not supported by record evidence. 65 TTABVUE 35. “Large market shares of product sales or large percentages of advertising expenditures in a product line would buttress claims to fame.” *Bose*, 63 USPQ2d at 1309. We decline to consider material underlying the hyperlink included in Opposer’s Brief, as evidence not filed in compliance with

we do not find the evidence so persuasive as to the specific strength of Opposer's Design Logo marks at issue. *Cf. Bose*, 63 USPQ2d at 1308 (if marks at issue are used in tandem with a famous house mark, the party asserting that the marks at issue are famous should prove that the product marks "can properly be seen as independent of the famous house mark").

Similarly, Opposer submitted its ranking at #24 in the BrandZ Top 100 Most Valuable Global Brands, but the ranking is not tied specifically to the marks at issue (versus Opposer's word mark, STARBUCKS, for example) and is not limited to the United States.⁵⁹ The same applies to the BrandFinance Global 500 2019 list and the Interbrand Best Global Brands 2019 Rankings.⁶⁰ However, the BrandZ and Interbrand lists display the Design Logo to represent Opposer in their rankings, suggesting the Design Logo's significance to Opposer's valuable brand, and therefore some commercial strength.

Opposer also cites *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006) for the proposition that its marks are famous, but we cannot transfer that finding to this case for numerous reasons. First, the fame finding in that case refers to the word marks STARBUCKS and STARBUCKS COFFEE. *Id.* at 1750-51. Second, that case was decided on a different factual record 17 years ago that apparently included, for example, **testimony** regarding sales revenue and promotional

the rules of practice governing opposition proceedings before the Board will not be considered. *See* cases cited in fn.34, *supra*.

⁵⁹ 30 TTABVUE 207.

⁶⁰ *Id.* at 339—416.

expenditures “**under the STARBUCKS mark,**” *id.* at 1750-51 (emphasis added), specifics about advertising, and unsolicited media attention “in numerous national television and radio programs and press articles” that is not present in this case. The different record and the passage of time underscore why “[e]ach case must be decided on its own facts.” *See, e.g., Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). However, the discussion of the record in *Starbucks U.S. Brands*, certainly is informative of the more rigorous evidentiary showing necessary to show that a “mark is truly a famous mark.” *Starbucks U.S. Brands*, 78 USPQ2d at 1751.

Opposer’s evidence of commercial strength that includes its commercial presence, customer volume, website and social media traffic, third-party social media activity, and some unsolicited media coverage, reflects widespread consumer exposure to and recognition of Opposer’s Design Logo marks in connection with its self-described primary business of coffee-related goods and services.⁶¹ Based on this record as a whole, including the absence of specific sales and advertising expenditures under the marks, we cannot place Opposer’s Design Logo marks at the furthest end of the spectrum of strength,⁶² but the record suffices to find them commercially strong in

⁶¹ Opposer’s 2019 Form 10K “Description of Business” states, “[w]e purchase and roast high-quality coffees that we sell, along with handcrafted coffee and tea beverages and a variety of fresh and prepared food items, through our company-operated stores. We also sell a variety of coffee and tea products and license our trademarks through other channels such as licensed stores, grocery and foodservice.” 30 TTABVUE 94.

⁶² We note that Opposer also relies on testimony regarding third-party brand valuation and ranking of “Starbucks,” 31 TTABVUE 5, but it is not at all clear whether and to what extent this applies to the marks at issue, as distinct from the word mark STARBUCKS and other components of Opposer’s “brand.”

connection with coffee-related goods and services.⁶³ However, based on this record, we find no such showing as to clothing.

E. The Number and Nature of Similar Marks for Similar Goods

Applicant argues under the sixth *DuPont* factor that “[u]se of the word and/or image of a mermaid or “SIREN” is also rather diluted in the coffee and apparel industries.”⁶⁴ The Federal Circuit has held that evidence of the extensive use of a term by others can be powerful evidence of the term’s weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

Applicant points to its notice of reliance on 13 third-party uses of “siren” and/or the image of a mermaid⁶⁵ “in connection with coffee goods and/or services.”⁶⁶

And “in connection with clothing goods,” Applicant points to 28 third-party uses of the term “siren” and/or image of a mermaid.⁶⁷

Applicant’s screenshot evidence, on its face, generally does not reflect how long, and often does not reflect how extensively, these third-party uses have occurred. As

⁶³ Applicant states in its Brief that it “does not necessarily disagree with the assertion of the fame of Starbucks’ marks; however it contends that such fame is connected solely to the word STARBUCKS.” 68 TTABVUE 22.

⁶⁴ 68 TTABVUE 37 (Opposer’s Brief).


⁶⁵ Although Opposer contends that images or references to “mermaids” are irrelevant, given that Opposer’s argument involves consumers construing its Design Logo as a siren, which Opposer’s own mark descriptions acknowledge is a type of mermaid, we find the images and references at least somewhat probative.

⁶⁶ *Id.* at 38-39; *see also* 59 TTABVUE, Exhibit B.

⁶⁷ *Id.* at 39-42; *see also* 59 TTABVUE, Exhibit C.

to coffee-related goods and services, Opposer countered with rebuttal evidence⁶⁸ it argues shows that most of Applicant’s evidence “reflect[s] limited uses at single storefronts, single-location restaurants, and internet websites with unclear reach and sales volumes; [and] some are not in the nature of trademark use at all.”⁶⁹ Opposer introduced USPTO records reflecting that applications to register the third-party



marks SALTY SIREN and  have been suspended based on prior marks, including those involved in this proceeding,⁷⁰ although this does not necessarily affect their use. We note that the webpage for “Siren Song” roast states, “Availability: Out of Stock.”⁷¹ Siren Craft Brew, which involved beer that incorporates coffee,⁷² is featured on the website of a craft brewery from the United Kingdom, so is not probative of U.S. consumer exposure.⁷³ Mermaid Morning Bliss Coffee is described on the webpage for Mermaid Cottages in Tybee Island, Georgia as “roasted exclusively for Mermaid Cottages by local owned and operated, PERC Coffee” and available for purchase “at Seaside Sisters, located at 1207 Hwy. 80 East.”⁷⁴ The Mermaid Coffee Bar website refers to only a single location in Newport Beach “on the

⁶⁸ 64 TTABVUE.

⁶⁹ 69 TTABVUE 19 (Opposer’s Reply Brief).

⁷⁰ 64 TTABVUE 7-17.

⁷¹ 59 TTABVUE 32.

⁷² 59 TTABVUE 22-31.

⁷³ 64 TTABVUE 36

⁷⁴ 59 TTABVUE 42.

boardwalk to the left of the auto ferry landing.”⁷⁵ The Mermaid Room “About Us” page states that it is “run by a local LBI [Long Beach Island, New Jersey] family we are a boutique coffee shop located inside Beach Barn Boutique.”⁷⁶ The Little Mermaid Café, named for the “literary fairy tale,” “is located in the Museum building” in Askov, Minnesota.⁷⁷ The Mermaid Grotto Café and Boutique is featured on the CoolWorks jobs site stating that “2022 will be our second summer in business,” “[n]estled at the end of Port Avenue,” “in the little seaside town of Seward,” Alaska.⁷⁸ Opposer supplemented the record with numerous other “about” webpages from the third-party sites in Applicant’s submission, to show that they are single-location or localized businesses, some of which do not specialize in coffee.⁷⁹ For example, “Siren Kitchen & Bar is a casual, new American, full-service restaurant and bar” located in Essex, Connecticut.⁸⁰ Considering what both parties presented, there are only a handful of third-party uses of “siren” in connection with coffee-related goods and services, and they appear mostly to be small, local businesses.

As to clothing, in response to Applicant’s 28 examples of third-party use, Opposer also submitted “about” webpages and argued a limited degree of consumer exposure to the third-party marks.⁸¹ For example, the store Siren describes itself as a surf shop

⁷⁵ 59 TTABVUE 38.

⁷⁶ 59 TTABVUE 41.

⁷⁷ 59 TTABVUE 49.

⁷⁸ 59 TTABVUE 50-51.

⁷⁹ 64 TTABVUE 18-119.

⁸⁰ *Id.* at 51-52.

⁸¹ 64 TTABVUE

that has “added new and innovative products to our lineup” that include some clothing, but states, “[w]e also refrain from extensive marketing, choosing instead to rely upon our loyal customers to share the Siren love.”⁸² The Siren Boutique is “San Francisco based and locally owned and operated,” describing itself as a small business with many “local” products.⁸³ Sweet Siren is Los Angeles-based, offering “[h]andmade accessories, uniquely curated graphic tees for both men and women, clothing and some oddities” and is available “at many pop up events through out [sic] the year.”⁸⁴ Siren The Brand characterizes itself as “a small solely owned independent brand.”⁸⁵ Siren Basics is a women’s underwear brand operated by two sisters.⁸⁶ Golden Siren Resortwear custom-makes prints and its “garments are created in small batches in Los Angeles.”⁸⁷ “Siren” appears on the Macys.com site in connection with swimsuits, Opposer introduced evidence to show that it refers to one line of MiracleSuit swimwear.⁸⁸ Overall, while Opposer diminished the persuasiveness of a few of the third-party clothing uses, in contrast to the rebuttal evidence relating to coffee, most of the third-party clothing-related uses were not negated or significantly minimized by Opposer’s rebuttal evidence.

⁸² *Id.* at 54-55.

⁸³ *Id.* at 57.

⁸⁴ *Id.* at 87.

⁸⁵ *Id.* at 100.

⁸⁶ *Id.* at 108-13.

⁸⁷ *Id.* at 119.

⁸⁸ 64 TTABVUE 71-85.

We weigh commercial weakness based on third-party use of similar marks on or in connection with similar goods or services based on the nature and extent of their use. *Palm Bay Imps.*, 73 USPQ2d at 1693. For coffee-related goods and services, taken as a whole, we cannot infer such a degree of recent consumer exposure as would show that consumers generally distinguish among marks containing mermaid or siren images, or the word “siren,” based on minor distinctions. Given the nature and quantity of third-party use evidence, we are not convinced that Opposer’s marks are diluted so as to significantly diminish their scope of protection for coffee-related goods and services. *Cf. Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030 (TTAB 2016) (weakness found based on at least 85 actual uses of ROSE-formative marks for similar services, eight similar third-party registrations, expert testimony and other evidence regarding the common nature of ROSE-formative marks in the industry, and testimony by opposer that it did not vigorously enforce its mark). The small number of mostly small, local business uses falls short of “enough to render [Opposer’s marks] unprotectable,” or even entitle it to less protection. *See In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451 at *6 (Fed. Cir. 2023).

However, Applicant’s record as to clothing is somewhat more persuasive, and the quantity and nature of the evidence suggests some commercial dilution of mermaid or siren images, and the word “siren,” in connection with clothing-related goods and services. Even where Opposer pointed out third-party use involving single locations, unlike with the coffee-related evidence, the clothing stores tended to be in major

metropolitan areas such as Los Angeles and San Francisco, increasing the likelihood of more significant consumer exposure to them. While Opposer argues that we should disregard mermaid-related evidence as irrelevant, we disagree. Opposer has described the image in its Design Logo marks as a two-tailed mermaid, and therefore, where Opposer seeks to equate the image with wording, we do not consider mermaid-related third-party use evidence irrelevant.

F. Similarity of the Marks

Turning to the first *DuPont* factor, we must compare the marks “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay*, 73 USPQ2d at 1691 (quoting *DuPont*, 177 USPQ at 567). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d at 1746 (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. Sept. 13, 2019)). The test assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d at 1721; *see also Edom Labs. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Where, as in this case, the marks are used in connection with in-part legally identical goods, the degree of similarity between the marks necessary to support likely confusion declines. *Viterra*, 101 USPQ2d at 1908; *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1935 (TTAB 2012).



With Opposer’s Design Logo marks, as reflected in its registered mark , among others, this factor presents the unusual scenario in this case where we focus on comparing a design to Applicant’s word mark, SIREN’S BREW. First, Opposer contends that on its face, its Design Logo marks depict a siren, and therefore should be considered the legal equivalent of the word SIREN, for purposes of this analysis. Opposer cites precedent from the CCPA and the Board finding designs to be legally equivalent to word marks such as SQUIRREL, SCOTCHMAN, TIGER HEAD, LION and THE PELICAN.⁸⁹

Beyond just considering the Design Logo marks on their face, Opposer also introduced evidence that it has named the Design Logo “the Siren” or “the Starbucks Siren,” names which it asserts are known to the consuming public. Opposer’s online company profile, under “Folklore,” states that its “logo is also inspired by the sea – featuring a twin-tailed siren from Greek mythology.”⁹⁰ A December 23, 2016 article from the “Starbucks Stories & News” webpage is titled “Who is the Starbucks Siren,” and explains that the logo is a siren, which “is like a super mermaid ... a siren is often depicted with two tails,” and is “the biggest symbol of [Starbucks] brand, really, other than [its] partners (employees).”⁹¹

⁸⁹ 65 TTABVUE 40-43 (Opposer’s Brief and cases cited therein).

⁹⁰ 32 TTABVUE 139 (Linayao Declaration Exhibit 10a).

⁹¹ 32 TTABVUE 143 (Linayao Declaration Exhibit 10a).

In terms of consumer exposure to the Design Logo's name or identity as a siren, Ms. Linayao testified to Opposer's publicizing that its marks are "sirens" by naming various products such as a coffee blend using that word, offering a "Siren Tail Clutch," offering musical compilations titled "Songs of the Siren," and using "Siren" in "promotional materials and art at its various locations nationally," with the following cited as "representative examples":



A third-party Facebook post in the record appears to show the "Siren Love" sign above on display in a Starbucks location, and the post refers to "The Starbucks siren."⁹³ Photographs of store displays from Starbucks locations also show the "Siren Love" sign.⁹⁴ Opposer also offered evidence that it promotes its logo design as the "Siren" on social media, by using the hashtag #siren in its posts, and in ways such as the Instagram screenshot below, featuring a photo of a beverage bearing the logo design

⁹² *Id.* at 20-24.

⁹³ 32 TTABVUE 150.

⁹⁴ 32 TTABVUE 151-57.

with the title “Celebrating with a Siren,” and offering discounted Frappuccinos “at participating US stores.”⁹⁵ The screenshot below shows “365,400 likes.”

- <https://www.instagram.com/p/BHVVXEDhx-r/?hl=en>



Other evidence consists of third-party use on social media of hashtags such as #siren in reference to Starbucks and references by consumers to the Design Logo or Starbucks as the siren.⁹⁶ For example, under #siren, the post below shows two women in costumes referred to as their “version of the Starbucks siren.”⁹⁷

⁹⁵ *Id.* at 29-30.

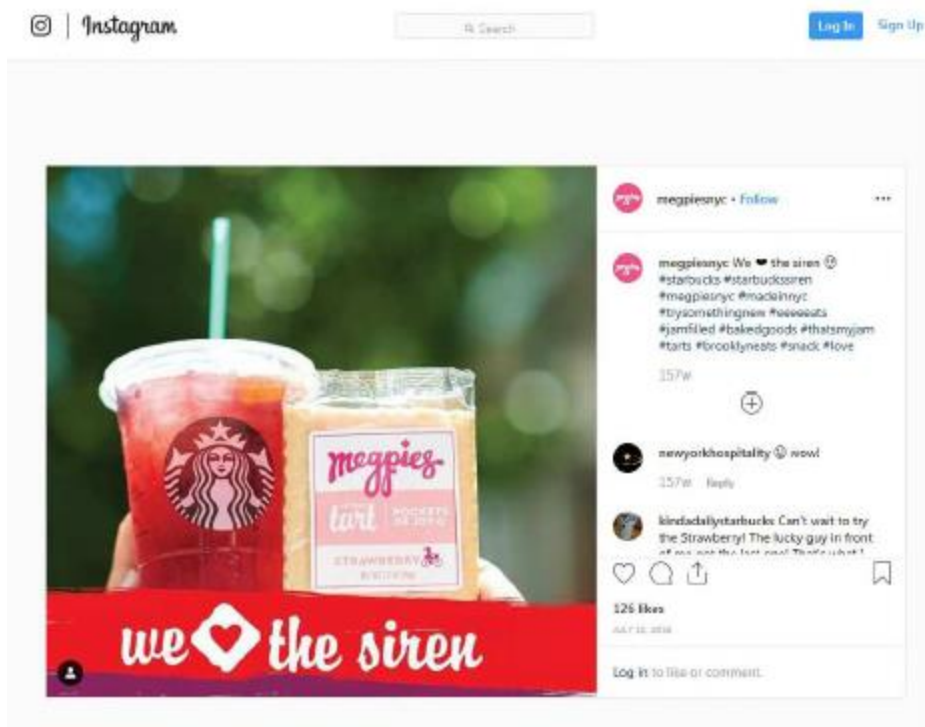
⁹⁶ *E.g.*, 36 TTABVUE 39-131; 37-40 TTABVUE.

⁹⁷ 34 TTABVUE 8.



Another post shows the registered mark along with “we ♥ the siren”:

<https://www.instagram.com/p/BH5igBuD-om/?hl=en>



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Another post features a photo of a Starbucks gift card that displays the registered mark and states in part, “Dive into the mystical world of the Starbucks Siren with Starbucks’s Anniversary Blend Card,” along with the hashtag #Siren.⁹⁹ The use of #siren as well as references to “the siren” in connection with Opposer suggest that these third parties associate “siren” with Opposer and its mark. While the third-party social media evidence offers examples from a relatively small portion of Opposer’s large customer base, we find the evidence probative to show some of Opposer’s consumers associating and equating Opposer’s Design Logo with the term “Siren.”¹⁰⁰

⁹⁸ 31 TTABVUE 39,

⁹⁹ 34 TTABVUE 20.

¹⁰⁰ We are less persuaded by Opposer’s excerpts from Reddit chats, including one titled “Anyone here go through some personal worker growth with the siren??: starbucks” that appear to be an online discussion about working at Starbucks. ³² TTABVUE 159-65 (Linayao

Opposer also introduced through testimony some articles, websites and blogs that identify Opposer's Design Logo as a siren, or as "the Starbucks Siren."¹⁰¹ A few come from mainstream Internet sources that likely garner wide public exposure. For example, the Huffington Post featured an online article on December 6, 2017 titled "The Legend of the Starbucks Siren" that included the statements, "Since 1971, the ubiquitous image of the Starbucks Siren has been a constant companion to coffee cups from the chain. Whether tall, grande, or venti, if you're spotted carrying a cuppa joe with a green siren printed on the cup's packaging it is universally known that you just went to Starbucks."¹⁰² Another online article dated February 1, 2011 from Slate magazine reads, "A few weeks ago, when Starbucks announced that it was going to be changing its logo, we introduced you to the Starbucks Siren, the beautiful, mermaid-like creature whose two-finned salute has adorned the company's coffee cups since 1971."¹⁰³ A more recent 2020 article on the Fox Business site refers to Opposer's launch of Siren's Blend coffee, noting that the "name is derived from Starbucks' logo, which features a siren on a green background."¹⁰⁴

Declaration Exhibit 11). *See also* 33 TTABVUE (other chats regarding Starbucks that also refer to the "siren").

¹⁰¹ 32 TTABVUE 34-37; 36 TTABVUE.

¹⁰² 31 TTABVUE 35-36.

¹⁰³ *Id.* at 36.

¹⁰⁴ 34 TTABVUE 90-92.

A few other articles were published in traditional newspapers, such as The Seattle Times,¹⁰⁵ The Sentinel Echo (of London, Kentucky),¹⁰⁶ and the Daily Press (of Newport News, Virginia), the latter two likely having a smaller readership.¹⁰⁷ Other media and blog sources that appear to be industry-specific or tailored to a specific base include “StarbucksMelody: Unofficial Starbucks News and Culture,”¹⁰⁸ the FaceCebu.Net Travel, Lifestyle, Food & Cebu News or “All About Cebu” blog,¹⁰⁹ the Dead Programmer’s Café Blog,¹¹⁰ the Logoworks Blog,¹¹¹ the Promo Marketing Magazine website,¹¹² the Daily Aztec (San Diego State college publication),¹¹³ the Building Champions Blog,¹¹⁴ the Intepat Intellectual Property Blog,¹¹⁵ “Jezebel, A Supposedly Feminist Website,”¹¹⁶ the Atlas Obscura site,¹¹⁷ and the Fast Company site.¹¹⁸ They contain references to Opposer’s logo as the Siren. For example, an article from the Mental Floss website titled “10 Things You Don’t Know About Starbucks

¹⁰⁵ 34 TTABVUE 43, 46-48.

¹⁰⁶ 34 TTABVUE 31-32.

¹⁰⁷ 34 TTABVUE 45.

¹⁰⁸ 34 TTABVUE 49-58; 35 TTABVUE 84-100 & 36 TTABVUE 1-22.

¹⁰⁹ 35 TTABVUE 32-35; 36 TTABVUE 34-37.

¹¹⁰ 35 TTABVUE 36-47.

¹¹¹ 34 TTABVUE 84-89; 35 TTABVUE 78-82.

¹¹² 35 TTABVUE 11-12 (stating in part, “in case you were unaware, the green woman that graces each cup of Starbucks coffee is, in fact, a siren”).

¹¹³ 35 TTABVUE 17-18.

¹¹⁴ 35 TTABVUE 21-23.

¹¹⁵ 35 TTABVUE 26-31.

¹¹⁶ 35 TTABVUE 73-77.

¹¹⁷ 36 TTABVUE 23-33.

¹¹⁸ 34 TTABVUE 62-67; *id.* at 74-83.

(But Should!)” explains that the Starbucks Design Logo was inspired by “an image of a siren.”¹¹⁹ The blog and media evidence reflects consumer exposure to the Design Logo as a siren.

Other proffered media stories referring to the Design Logo as “the Siren” have less probative value.¹²⁰ Some are newswire press releases, which lack information as to their distribution and public availability, and therefore are less persuasive.¹²¹ Newswire articles and other documents whose distribution is uncertain generally have limited probative value in that we cannot judge the public’s exposure to the use of the phrase in the newswire. *See In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003); *In re Int’l Business Machines Corp.*, 81 USPQ2d 1677, 1683 n.10 (TTAB 2006). Nonetheless, the press releases have some probative value to corroborate Opposer’s efforts to hold out the Design Logo as a siren.

As discussed above in the priority section, the Linayao Declaration generally asserts that “Starbucks and Starbucks employees also have produced and sold

¹¹⁹ 34 TTABVUE 93-105.

¹²⁰ We do not consider the French language article from Fubiz Media regardless of its English-language headline. *Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (noting that printed publications submitted in a foreign language without translations lack probative value).

¹²¹ ENP Newswire stories, the distribution and public availability of which is unclear, contain no URL, and appear to come from a source in the United Kingdom, rendering them even less persuasive. The news releases appear to have come from “the Starbucks Newsroom” and “[e]ditorial queries ... should be sent to newswire@enpublishing.co.uk.” *Id.* at 28, 30. Another “Business Wire” release has a subheading “**Distribution:** Business Editors” and bears the URL <http://www.businesswire.com>. 34 TTABVUE 26-30. Other documents containing no URL bear the heading “Starbucks brand identity, BrandPackaging December 2011,” and “Starbucks celebrates 40 years in the coffee industry Images Retail March 8, 2011,” noting “distributed by Contify.com,” and these also lack clarity as to potential public exposure. 34 TTABVUE 33-35.

various merchandise items using the SIREN mark, including purses, figurines, musical albums, books, and bookmarks;” the testimony does not include specifics or dates of such sales, but generally points to attached exhibits.¹²² Screenshots dated 12/5/2019 from a third-party site called “Unicorn Mermaid” show a post titled “Starbucks has launched a new Siren Tail Clutch,” that states in part, “[k]eeping in line with their mermaid logo, Starbucks has launched new mermaid-themed merchandise,” including clutches that “feature[] a really pretty Siren’s tail at the front,” as shown in the photo below, with a clutch bearing a tag that reads “Starbucks Siren’s Tail Set.”¹²³



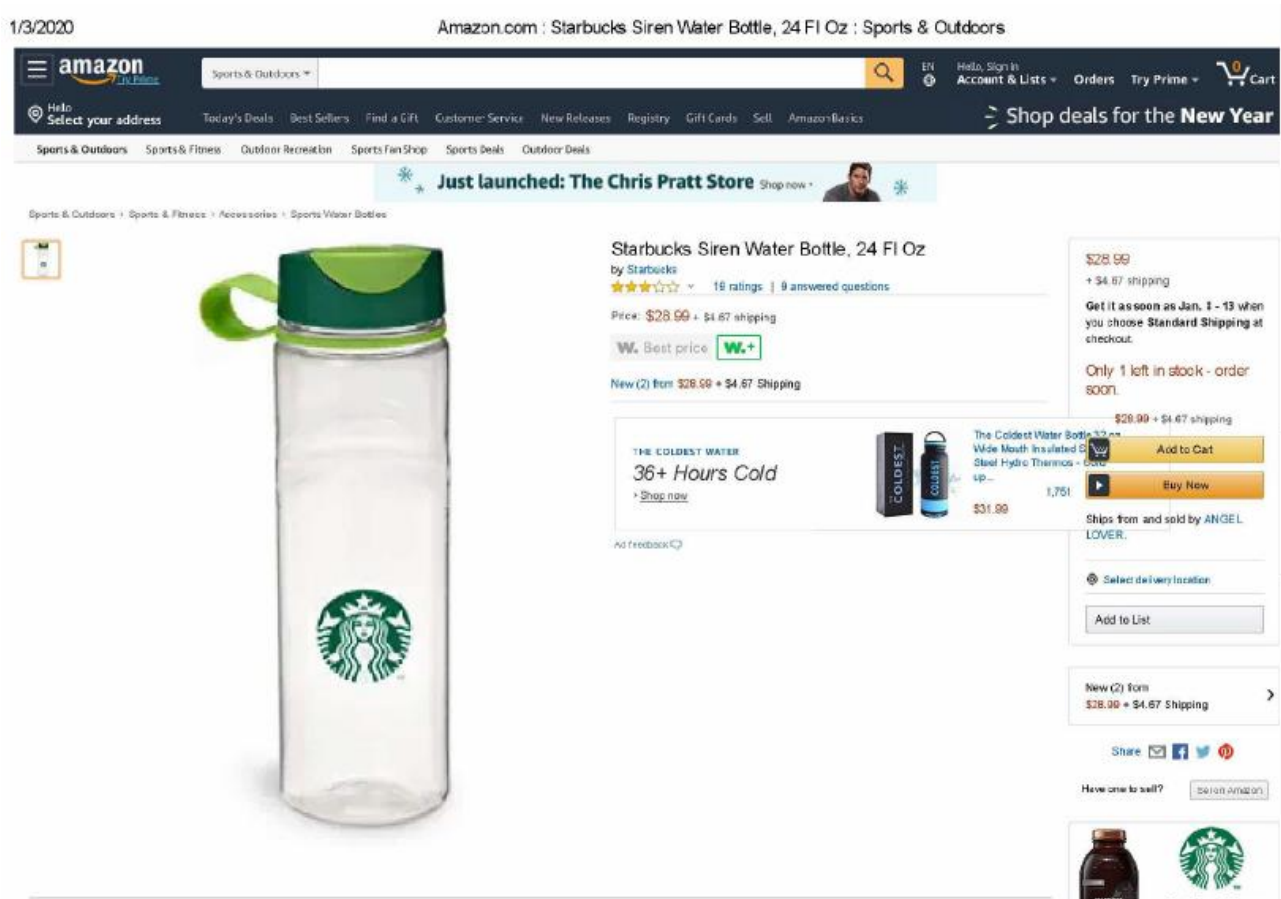
As for the music, attached Internet screenshots show CD compilations from Opposer titled “Songs of the Siren – Starbucks Favorite Divas,” “Songs of the Siren

¹²² 31 TTABVUE 21 (Linayao Declaration).

¹²³ 32 TTABVUE 94-101 (Linayao Declaration Exhibit 7a). The declaration also includes a screenshot dated 12/5/2019 that promotes “Anniversary Collection Featuring the celestial beauty of our Siren!” but the URL suggests that it comes from the Starbucks website for the Philippines, starbucks.ph, which lacks probative value for our purposes. 32 TTABVUE 134 (Linayao Declaration Exhibit 7a).

(Irresistible Voices),” and “Starbucks Songs of the Siren: Her Own Story,” designated with CD release dates in 1996, 2000 and 2006.¹²⁴

Third-party Amazon screenshots of Starbucks merchandise referred to as “Starbucks Siren” goods include some that feature the Design Logo marks, and Applicant characterizes the use of “Siren” as descriptive of the figure appearing on the goods.¹²⁵ Representative examples include:



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¹²⁴ 32 TTABVUE 106-11 (Linayao Declaration Exhibit 7a).

¹²⁵ 68 TTABVUE 29.

¹²⁶ 32 TTABVUE 79.

5/21/2020 Amazon.com: Starbucks Siren Collection Ceramic Mug: Home & Kitchen

amazon Home & Kitchen "siren collection" Hello, Sign in Account & Lists Returns & Orders Try Prime Cart

Home & Kitchen | Kitchen & Dining | Travel & To-Go Drinkware | Travel Mugs & Tumblers

Starbucks
Starbucks Siren Collection Ceramic Mug

Price: ~~\$69.95~~ & **FREE Shipping**

W. Best price **W. +**

Get \$10 off instantly. Pay \$49.95 upon approval for the Amazon Prime Store Card.

PillPack by Amazon Pharmacy
Your medication, delivered. [Learn more >](#)

\$59.95
& **FREE Shipping**

Get it as soon as **May 28 - June 2** when you choose **Expedited Shipping** at checkout.

Only 4 left in stock - order soon.

Qty: 1

\$59.95 + Free Shipping


Add to Cart

Buy Now

Ships from and sold by **ABM Enterprises**.

Select delivery location

Add to List



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When asked whether, in September 2019 when Opposer launched SIREN'S BLEND coffee, Opposer had "any other Starbucks brands using the name, the word 'Siren' that were active," Ms. Linayao responded "we've had like the Siren line of drinkware. We've had other merchandise items we've referred to as The Siren Collection. We've – it's usually surrounding an anniversary, anniversary blend that depicts the Siren, so the product that surrounds that has always been The Siren Collection. It's been in many artwork, poems on our product previous to the launch and since the launch."¹²⁹ Corroborating this testimony, the Amazon.com listing for the mug pictured above refers to it as "Starbucks Siren Collection Ceramic Mug."¹³⁰

¹²⁸ 32 TTABVUE 70-71 (Linayao Declaration Exhibit 7a).

¹²⁹ 78 TTABVUE 84 (30(b)(6) Deposition).

¹³⁰ 32 TTABVUE 74.

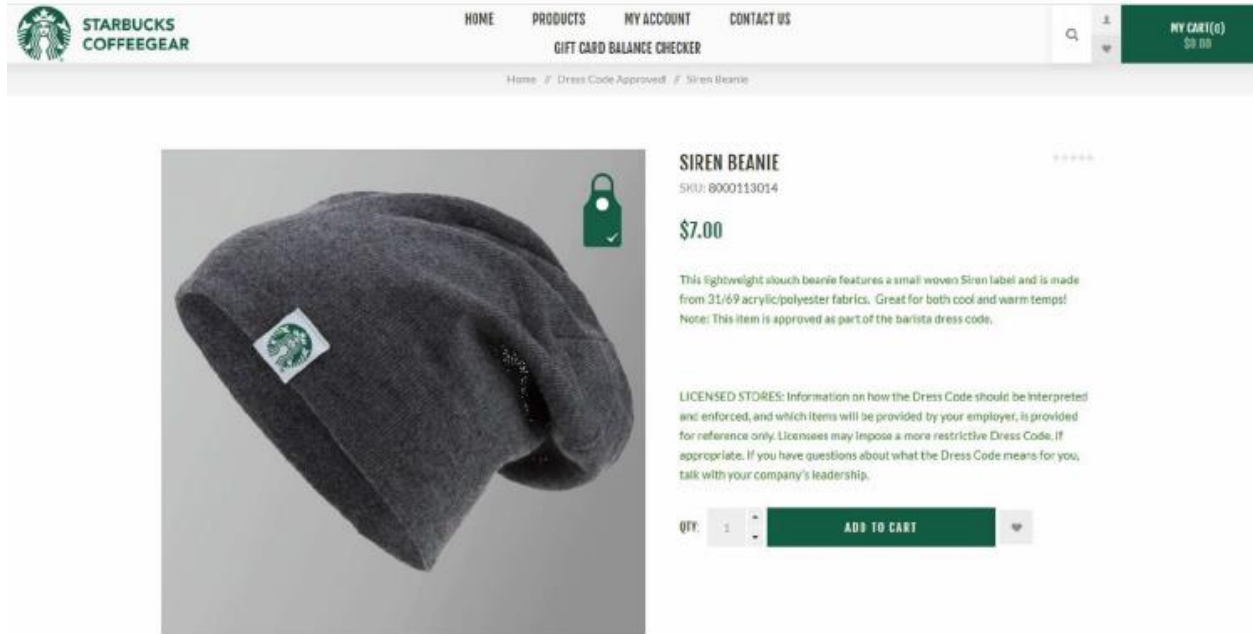
We briefly address the undated screenshots from Opposer’s internal portal “STARBUCKS COFFEEGEAR” site, introduced through Ms. Linayao’s testimony, which feature merchandise available only to Starbucks employees (approximately 190,000 in the U.S.)¹³¹ and other “partners.”¹³² The clothing items featured in the Starbucks CoffeeGear portal are the only examples Opposer offers of its use of its marks on clothing, and we emphasize that according to Ms. Linayao, this type of merchandise now is offered by Opposer through an online portal open to employees and partners, and Opposer closed its retail store at Opposer’s headquarters that previously made some such items available to the broader public.¹³³ In one example shown below, a hat bearing the Design Logo is referred to as “SIREN BEANIE,” and described as a “lightweight slouch beanie featur[ing] a small woven Siren label.”¹³⁴ The description also states that “[t]his item is approved as part of the barista dress code.”

¹³¹ 31 TTABVUE 24 (Linayao Declaration); *id.* at 107-38 (Exhibit 2).

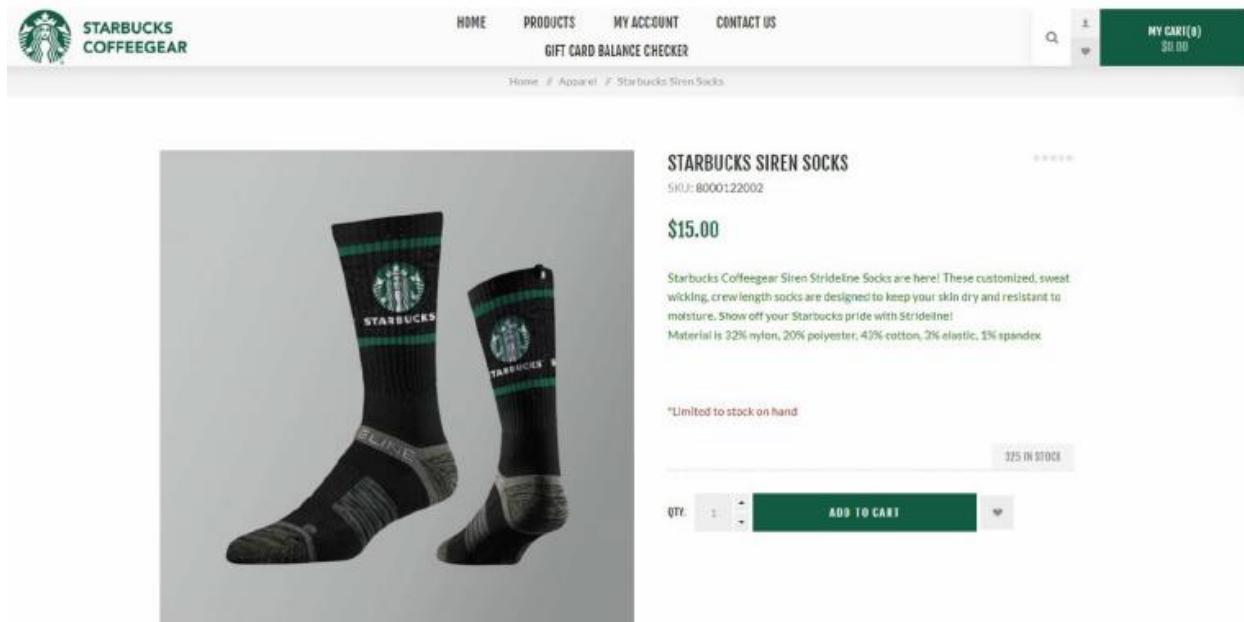
¹³² 32 TTABVUE 67-70 (Linayao Declaration Exhibit 7a). Ms. Linayao testified in her Rule 30(b)(6) deposition that “Coffeegear is our internal, like, ability to get product for partners.” 78 TTABVUE 120. While at first she indicated that “partners” is synonymous with “employees,” she subsequently indicated that other “partners” who might have access to Coffeegear could include Opposer’s licensees and joint venture partners. *Id.* at 120-22. These attachments to Ms. Linayao’s declaration on this point do not include dates.

¹³³ 78 TTABVUE 123-27 (Linayao Deposition).

¹³⁴ 32 TTABVUE 68.



Another example shown below refers to “STARBUCKS SIREN SOCKS” alongside a photo of socks bearing the logo.¹³⁵



¹³⁵ 32 TTABVue 69.

While this evidence reflects Opposer’s internal use of “Siren” and “Starbucks Siren” to refer to clothing featuring the Design Logo, it is not persuasive of consumer exposure to the same, given the restricted access to the CoffeeGear portal.

Considering the record as a whole, Opposer has demonstrated that the connotation and commercial impression of its Design Logo marks, such as



, is a siren, as indicated in its mark descriptions that state that it is “a siren (a two-tailed mermaid) wearing a crown.” Although dictionary definitions of “siren” tend to refer more generally to mythological female part-human creatures,¹³⁶ Applicant’s witnesses conceded the common understanding that a siren is a mermaid with two tails. Applicant’s 30(b)(6) witness (Monica Hamilton) stated on behalf of Applicant that a siren is “a form of a mermaid that lures the men in,” and in answer to a question about what is “different about a siren than just a regular mermaid,” she responded “[t]he two tails.”¹³⁷ Sarah Hamilton testified that she “agree[d] that another name for a mermaid with two tails is a siren.”¹³⁸

More significantly, from the record as a whole, we find substantial evidence of public exposure to Opposer’s Design Logo marks associated with and characterized

¹³⁶ *E.g.*, 59 TTABVUE 8. Merriam-Webster Dictionary defines “siren” in relevant part as “any of a group of female and partly human creatures in Greek mythology that lured mariners to destruction by their singing.”


¹³⁷ 28 TTABVUE 367.

¹³⁸ 28 TTABVUE 267. Applicant’s witness, Mr. Hamilton, also testified that he “use[s] the terms [mermaid and siren] synonymously. 28 TTABVUE 43.

as a siren, and that the Design Logo often is referred to by consumers as the Siren or the Starbucks Siren. While the design on its face is less straightforward than most of the designs in the legal equivalence cases cited by Opposer, the record reflects the developed understanding by many consumers that Opposer's Design Logo marks depict a siren.

With this background, we compare Opposer's and Applicant's marks. Applicant's



SIREN'S BREW mark does not look similar to , but consumers recognize Opposer's Design Logo marks as a siren, and we find that this creates some similarity in connotations and commercial impressions. In some cases, words and pictures that designate the same thing share similar meanings. *See Izod Ltd. v. Zip Hosiery Co.*, 405 F.2d 575, 56 C.C.P.A. 812, 160 USPQ 202, 203 (CCPA 1969) (TIGER HEAD is similar to a tiger design); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (PENGUIN is similar to a penguin design); *Squirrel Brand Co. v. Green Gables Inv. Co.*, 223 USPQ 154, 155 (TTAB 1984) (SQUIRREL BRAND is similar to a squirrel design).

Here, Opposer's marks depict a siren, and Applicant's mark is SIREN'S BREW, which combines the possessive form of "siren" with the word BREW. As explained below, depending on which goods of Applicant SIREN'S BREW appears on or with, the overall connotations and commercial impression may vary. Opposer introduced several dictionary entries for "brew":

- Oxford English Dictionary entry in noun form as “[t]he action, process, or result, of brewing; the beverage, etc. brewed; sometimes used locally for ‘yeast’;”¹³⁹
- Random House Webster’s College Dictionary entry in noun form as “a quantity brewed in a single process;” “a brewed beverage;” “any concoction, esp. a liquid produced by a mixture of unusual ingredients: *a witches’ brew*; and “*Informal*, beer or ale.”¹⁴⁰
- Webster’s Dictionary entry in noun form as “a beverage formed by brewing” and “a drink of such beverage (as coffee or tea).”¹⁴¹

We find these noun-form meanings more applicable than the verb-form definition of BREW Applicant proposes in its Brief,¹⁴² “[t]o concoct, contrive, prepare, bring about, cause: spec. a. evil, mischief, trouble woe.”¹⁴³ Where BREW in Applicant’s mark follows the possessive SIREN’S, consumers are more likely to draw on the noun-form meaning of brew.

1. Similarity in the Class 30 (Coffee Goods) Context

As the definitions make clear, in the context of Applicant’s coffee-related goods, BREW is highly descriptive or generic, consistent with Applicant’s disclaimer of the word as to its Class 30 goods. Applicant’s 30(b)(6) witness agreed that “one word for

¹³⁹ 30 TTABVUE 167.

¹⁴⁰ 30 TTABVUE 179-81.

¹⁴¹ 30 TTABVUE 185-87.

¹⁴² 68 TTABVUE 36-37.

¹⁴³ 30 TTABVUE 171.

coffee is 'brew.'"¹⁴⁴ In relation to coffee goods, we find that consumers would perceive SIREN'S BREW as the coffee of a siren. In the context of coffee-related goods, the brewed beverage definition will be at the top of the consumer's mind because coffee is such a beverage. Although our ultimate conclusion regarding similarity rests on a consideration of the marks in their entirety, SIREN'S especially stands out as dominant for Applicant's Class 30 goods, because consumers are less likely to rely on BREW for source-indication as it refers to or describes the coffee offered under the mark. *See Viterra*, 101 USPQ2d at 1908. Therefore, in addition to the prominence that comes from SIREN'S appearing first in the mark, the only other word, BREW, occupies a secondary and subordinate role in the mark as the "thing" belonging to or coming from the Siren, and BREW lacks distinctiveness for Applicant's coffee goods in Class 30. *See In re Detroit Ath. Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *see also Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1288 (TTAB 2007) (finding BARB'S dominates BARB'S BUNS BAKERY, INC. and BARBARA'S dominates BARBARA'S BAKERY).

We bear in mind the commercial strength of Opposer's Design Logo marks in relation to coffee-related goods and services under the fifth *DuPont* factor, and the lack of weakness in relation to coffee-related goods and services under the sixth *DuPont* factor. These considerations entitle Opposer's marks to a broader scope of protection in this context. As the connotation and commercial impression of its registered Design Logo marks is that of a siren, and Applicant's mark is SIREN'S

¹⁴⁴ 28 TTABVUE 354.

BREW, dominated by SIREN'S in the coffee context, we find the marks similar overall.

2. Similarity in the Class 25 (Clothing) Context

By contrast, in the context of Applicant's clothing goods, the meaning of BREW is more open-ended and subject to various interpretations, none of which are descriptive of or generic for the clothing goods. Thus, SIREN'S does not stand out as much in this clothing context, as it is not the only source-indicating term. Both components of the SIREN'S BREW mark are arbitrary as to clothing, and their combination refers to some beverage or concoction belonging to or created by a siren. The SIREN'S BREW mark used on clothing still gives the meaning and impression of the brew of a siren, but that brew could be a beer, tea, coffee, any other brewed beverage, or indeed any concoction of unusual ingredients. Unlike with coffee-related goods, nothing about the shirts and sweatshirts points to any particular one of the several possible meanings of BREW. Overall, in the clothing context, where BREW is not a generic reference to the goods, the SIREN'S BREW mark creates a different connotation and commercial impression than just "siren."

We also bear in mind that Opposer's commercial strength does not arise from use of its marks in connection with clothing, and in fact, Opposer's record is notably lacking evidence of use on clothing sold to the general public under any of its marks. Also, Applicant provided proof of consumer exposure to similar third-party marks for clothing-related goods and services that suggest consumers are at least somewhat conditioned to distinguish among marks with similar wording or symbols based on small differences. Given this narrower scope of protection, and the different

connotation and commercial impression engendered by SIREN'S BREW in the context of clothing, we do not find it similar overall to Opposer's registered marks.

G. Actual Confusion

Under the seventh and eighth factors, we consider the parties' respective use "such that we could make a finding as to the 'length of time during and conditions under which there has been concurrent use without evidence of actual confusion.'" *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *25 (TTAB 2020). Here, the parties agree that the record does not contain proof of actual consumer confusion.

Applicant's Class 30 application is based on intent-to-use, although Applicant's testimony asserts that it undertook use of its mark on coffee beans and ground coffee in May 2019.¹⁴⁵ Applicant's Class 25 application contains a 2018 date of first use in commerce, and its declaration testimony similarly claims that Applicant undertook use of its mark on clothing in March 2018.¹⁴⁶ The record contains Applicant's confidential historical sales information, including for the coffee and clothing items at issue in this case.¹⁴⁷ Without discussing specifics of the confidential record, based on the sales information, despite the three to four-year period of concurrent use, we cannot conclude that there has been an appreciable opportunity for actual consumer confusion to occur. *See DuPont*, 177 USPQ at 567 (identifying seventh and eighth *du Pont* factors as "[t]he nature and extent of any actual confusion," and "[t]he length of

¹⁴⁵ 58 TTABVUE 6 (Monica Hamilton Declaration).

¹⁴⁶ 58 TTABVUE 4 (Monica Hamilton Declaration).

¹⁴⁷ 28 TTABVUE.

time during and conditions under which there has been concurrent use without evidence of actual confusion”). Accordingly, we find the seventh and eighth factors neutral.

H. Purchasing Conditions

Opposer argues that the factor regarding purchasing conditions weighs in favor of likely confusion because coffee and clothing are “impulse” purchase items, but failed to introduce any supporting evidence. “Attorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005)). We agree that coffee and clothing are ordinary consumer products, but the record in this case does not support finding a tendency for impulse purchasing or an elevated degree of consumer care. We consider the fourth *DuPont* factor neutral.

I. Weighing the DuPont Factors

While the Board previously consolidated these oppositions, the likelihood of confusion analysis is not the same for each application. We must “weigh the *DuPont* factors used in [our] analysis and explain the results of that weighing.” *Charger Ventures*, 2023 USPQ2d 451, at *7 (emphasis in boldface originally in italics). “In any given case, different *DuPont* factors may play a dominant role,” *id.*, at *4, and the “weight given to each factor depends on the circumstances of each case.” *Id.* (citation omitted). A “single *DuPont* factor may, for example, be dispositive of the likelihood of confusion analysis.” *Id.* (citing *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1999)).

1. Application Serial No. 88202494 for “coffee beans; ground coffee beans” in International Class 30

Applicant’s and Opposer’s coffee goods in Class 30 are identical, and presumed to travel in the same trade channels, such that the second and third *DuPont* factors weigh in favor of likely confusion. Opposer’s Design Logo registered marks are commercially strong and remain relatively undiluted by third-party use in connection with coffee-related goods and services, entitling Opposer’s marks to a broader than usual scope of protection under the fifth and sixth *DuPont* factors. Applying this heightened protection in the context of Applicant’s Class 30 application, in which SIREN’S BREW consists of SIREN’S and a generic or highly descriptive word for coffee, we find Opposer’s Design Logo marks, which are recognized as a siren, sufficiently similar to Applicant’s mark to render confusion likely. The Design Logo is well known enough as a siren in connection with Opposer’s coffee-related goods and services that consumers encountering Applicant’s word mark SIREN’S BREW on coffee are likely to associate it with the so-called Starbucks Siren and believe the coffee comes from Opposer. Opposer’s Section 2(d) claim is sustained as to Class 30.

2. Application Serial No. 88215319 for “shirts; sweat shirts” in International Class 25

However, our analysis differs for the application for Class 25 clothing goods. Applicant’s and Opposer’s clothing goods in Class 25 are identical, and presumed to travel in the same trade channels, such that the second and third *DuPont* factors weigh in favor of likely confusion. But under the fifth factor, we found that Opposer’s Design Logo marks’ commercial strength has not been developed in connection with clothing, for which Opposer is not well known, and under the sixth factor, the use of

siren and mermaid wording and imagery is more common in the clothing context, reflecting consumers' ability to distinguish among marks with these elements based on what may be considered otherwise smaller differences. Based on the fifth and sixth factors, we are not inclined to extend the scope of protection for Opposer's Design Logo marks as broadly in the clothing context as we do in the context of coffee. With Applicant's clothing goods, its SIREN'S BREW mark does not contain generic or highly descriptive wording, and we find the connotation and commercial impression sufficiently different to render confusion unlikely. Consumers encountering Applicant's word mark SIREN'S BREW on clothing simply are unlikely to associate it with the so-called Starbucks Siren, and would not believe that the clothing comes from Opposer. Opposer's Section 2(d) claim is dismissed as to Class 25.

IV. Dilution by Blurring

Because Opposer did not prevail on its claim under Section 2(d) as to the Class 25 goods, we consider its dilution claim based on its Design Logo marks.¹⁴⁸ Opposer's dilution claim rests on the alleged fame of its so-called "Starbucks Siren."¹⁴⁹ "Dilution by blurring is 'association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.' Trademark Act Section 43(c)(2)(B)." *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015) (quoting 15 U.S.C. § 1125(c)(1) and (2)(B)). To prevail on a claim of dilution by blurring, Opposer must show that: (1) it owns a famous mark that

¹⁴⁸ See 65 TTABVUE 50 (Opposer's Brief); 69 TTABVUE 23 (Opposer's Reply Brief).

¹⁴⁹ 65 TTABVUE 50-53 (Opposer's Brief); 69 TTABVUE 23 (Opposer's Reply Brief).

is distinctive; (2) Applicant is using a mark in commerce that allegedly dilutes Opposer's famous mark; (3) Applicant's use of its mark began after Opposer's became famous; and (4) Applicant's use of its mark is likely to cause dilution by blurring or tarnishment. *N.Y. Yankees P'ship*, 114 USPQ2d at 1502 (quoting *Coach Servs.*, 101 USPQ2d at 1723-24).

The "threshold question in a federal dilution claim is whether the plaintiff's mark is famous," *New York Yankees P'ship*, 114 USPQ2d at 1502, and "[i]t is well-established that dilution fame is difficult to prove." *Coach Servs.*, 101 USPQ2d at 1724; *see also Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1180 (TTAB 2001) ("Fame for dilution purposes is difficult to prove."); *Everest Capital Ltd. v. Everest Funds Mgmt. LLC*, 393 F.3d 755, 73 USPQ2d 1580, 1585 (8th Cir. 2005) ("The judicial consensus is that 'famous' is a rigorous standard."). A mark is famous for dilution purposes "if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A). An opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1103 (TTAB 2018) (quoting *Coach Servs.*, 101 USPQ2d at 1725). In other words, the record must show that the mark has become a "household name." *Coach Servs.*, 101 USPQ2d at 1724 (cleaned up). Fame for purposes of dilution applies to a select class of marks proven to be truly renowned.

In this case, Applicant began using its mark at issue in March 2018,¹⁵⁰ so Opposer's proof must show fame prior to that date. There are four non-exclusive factors to consider when determining whether a mark is famous:

- i. The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- ii. The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- iii. The extent of actual recognition of the mark.
- iv. Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

TiVo Brands, 129 USPQ2d 1104 (quoting 15 U.S.C. § 1125(c)(2)(A)).

Under the first fame factor, as discussed above in connection with commercial strength, Opposer did not provide testimony regarding advertising and promotional spending. Opposer submitted its annual reports with general advertising expenditures for 2010-2019, which were not explicitly limited to advertising under its marks at issue. Ms. Linayao testified that Opposer "prominently features the Starbucks Siren" on its website, which received "over 15.8 million page-views" from April 1, 2020 to September 30, 2020. She further testified that Starbucks's app also "prominently features the Starbucks Siren" and "was used by over 23 million users to purchase Starbucks products in 2019."¹⁵¹ For purposes of dilution fame, however,

¹⁵⁰ 58 TTABVUE 4-5.

¹⁵¹ 31 TTABVUE 3.

the 2020 dates of this Internet and app promotional information come after the proper timeframe for consideration, because they are **after** Applicant began using its mark in March 2018. Ms. Linayao's declaration supplies information about Opposer's **current** large number of locations, and the only figure for the number of customers served, while substantial, was "in 2018," and therefore does not clearly pre-date Applicant's March 2018 use of its mark, as would be relevant for dilution fame. *Cf. N.Y. Yankees P'ship*, 114 USPQ2d at 1503 (testimony regarding sales figures for period between 1995 and 2015 faulted for not specifying how much occurred by the relevant date for dilution fame, 2008).

In addition, the testimony that the marks are displayed at Opposer's locations was vague and general, noting only that the Design Logo marks would appear "on the store signage, promotional material, menu, and/or product packaging," with the "or" leaving open the possibility that the Design Logo marks may be featured in only one of the listed ways.¹⁵² The relatively modest showing of media coverage does not rise to the level of showing that Opposer's Design Logo marks are akin to a "household term." *See TiVo Brands*, 129 USPQ2d at 1105 (discussing news articles describing the opposer's TIVO mark "as having 'near household-name recognition'"); *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1024-26 (TTAB 2011) (fame of opposer's JUST DO IT mark evidenced by "third-party references to and discussions about the mark," which "have been pervasive, reflecting the extreme popularity of the mark and the message

¹⁵² 31 TTABVUE 4; *see also id.* (similarly vague testimony regarding display of the marks at licensee locations).

of compelled action that it represents,” including numerous articles in well-known publications around the United States and listings of the slogan as among the most memorable slogans of the 20th Century).

We note Ms. Linayao’s testimony that the “Starbucks Siren” has been in use by Opposer since 1971, but her declaration indicates, as noted above, that the appearance of the Siren has evolved, and she does not specifically attest to the duration of use of the version for which Opposer asserts dilution fame.¹⁵³ Nonetheless, the use dates in Opposer’s registrations, coupled with Ms. Linayao’s testimony, support that Opposer’s Design Logo marks have been in use for decades.

The record overall is quite sparse regarding the duration, extent, and geographic reach of advertising and publicity of Opposer’s marks during the relevant time. On this basis, we cannot find the requisite type of ubiquitous and sustained exposure of the marks to the general public in the United States prior to March 2018. *Cf. Coach Servs.*, 101 USPQ2d at 1724.

Under the second fame factor, as discussed above in connection with commercial strength, Opposer did not provide testimony regarding sales under the marks, and submitted its annual reports with general revenue figures that were not explicitly limited to revenue under the marks at issue. Thus, the record overall is quite sparse regarding the amount, volume, and geographic extent of sales of goods or services offered under Opposer’s marks prior to March 2018.

¹⁵³ 31 TTABVUE 3.

“Perhaps the most significant of the four elements set forth in the Act to determine fame is the extent of actual public recognition of the mark as a source-indicator for the goods or services in connection with which it is used.” *TiVo Brands*, 129 USPQ2d at 1104 (quoting *Nike*, 100 USPQ2d at 1024). Under the third factor, Opposer did not offer direct evidence in the form of a consumer survey. Instead, Opposer’s Brief points to third-party brand rankings for the proposition that “Starbucks is consistently ranked among the most valuable and best brands” and “[t]hese reports use the Starbucks Siren Marks to refer to Starbucks and the value of its brand.”¹⁵⁴ In addition to the lack of clarity that the brand rankings pertain particularly to Opposer’s Design Logo marks at issue (rather than, for example, the STARBUCKS standalone word mark), the brand rankings are all for the year 2019,¹⁵⁵ and therefore do not predate Applicant’s use of its mark, as would be necessary for dilution fame. Opposer also asserts that the record contains “voluminous evidence reflecting that third parties and consumers readily associate the Siren Marks and ‘Siren’ with Starbucks.”¹⁵⁶ While we relied on some of the same evidence cited by Opposer for this proposition when we found the Design Logo marks commercially strong in connection with coffee-related goods and services and that Opposer’s consumers recognize the Design Logo as a siren, the evidence mostly focused on Opposer’s customer base and does not rise to the requisite level to establish the type of “household term”-type recognition among

¹⁵⁴ 65 TTABVUE 52.

¹⁵⁵ 30 TTABVUE 190-415.

¹⁵⁶ 65 TTABVUE 52.

the entire general consuming public, before March 2018. *Cf. New York Yankees P'ship*, 114 USPQ2d at 1503 (fame of New York Yankees' logo shown in part through exposure of the mark on national television networks such as ESPN, Fox, CBS, NBC, ABC, and TBS). Opposer's Brief again cites the 2008 Board decision in *Starbucks*, 78 USPQ2d 1741, and for the reasons previously discussed, we find it unpersuasive.

Under the fourth factor, Opposer's Design Logo is or is part of numerous marks registered as inherently distinctive.

Although Opposer's Design Logo marks are registered and have been in long use, none of the first three fame factors support finding dilution fame in this case. The record is simply too thin to establish, by a preponderance of the evidence, that Opposer's marks were famous as of March 2018. Above, we found Opposer's Design Logo registered marks commercially strong – but not even at the far end of the spectrum – based on its showing in connection with coffee-related goods and services. However, “[t]he fame that must attach to a mark for it to be eligible for protection under the dilution provisions of the Trademark Act is greater than that which qualifies a mark as famous [or commercially strong] for the *du Pont* analysis of likelihood of confusion.” *TiVo Brands*, 129 USPQ2d at 1103 (citing *Coach Servs.*, 101 USPQ2d at 1724 (“Fame for likelihood of confusion and fame for dilution are distinct concepts, and dilution fame requires a more stringent showing.”)). Opposer thus “has the burden of a ‘higher and more rigorous standard for dilution fame.’” *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1887 (TTAB 2005) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694). “[F]ame for dilution requires widespread recognition

by the general public,” *Coach Servs.*, 101 USPQ2d at 1725, and dilution fame must have attached to the subject marks before the challenged use began. *TiVo Brands*, 129 USPQ2d at 1112. Opposer’s evidentiary record in this case falls short of establishing fame by the relevant date for dilution purposes.

Opposer failed to prove the threshold element of its dilution claim, and we need not consider the other elements of the claim. The claim necessarily fails, and we dismiss the dilution claim.

Decision: The opposition is sustained as to Application Serial No. 88202494, under Section 2(d). The opposition is dismissed as to Application Serial No. 88215319.