

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 10, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Torrefazione Italia LLC

v.

Trinidad Coffee Company, Inc.

Cancellation No. 92058192

Julia Anne Matheson and Anna B. Naydonov of Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P. for Torrefazione Italia LLC

Trinidad Coffee Company, Inc., *pro se*

Before Kuhlke, Wolfson and Adlin, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Torrefazione Italia LLC (“Petitioner”) seeks to cancel the registration of the mark depicted below (the “T and Design” mark) owned by Trinidad Coffee Company, Inc. for: “caffeine-free coffee; coffee; coffee [sic]; coffee and tea; coffee beans; ground coffee beans; roasted coffee beans” in International Class 30:



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Petitioner alleges that Respondent's T and Design mark so resembles Petitioner's two previously used and registered TORREFAZIONE ITALIA COFFEE and design marks (depicted below, hereinafter the "TORREFAZIONE ITALIA and Design" marks) as to cause a likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).²



Petitioner implicitly and explicitly alleges that it has used these marks in connection with coffee products and related services since well prior to the filing date

¹ Registration No. 4298186, issued March 5, 2013 from an application filed July 17, 2012. The description of the mark reads: "The mark consists of a griffin and a laurel wreath. The base of the laurel wreath is a pedestal. The griffin is perched upon the pedestal, and within the laurel wreath. Within the pedestal appears a capital letter 'T'."

² Petitioner also pled dilution under Section 43(c), 15 U.S.C. § 1125(c). Petitioner's dilution claim was not pursued at briefing; thus it is waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner waived claims not argued before the Board).

of the application that matured into Registration No. 4298186.³ Petitioner further alleges ownership of two registrations for the black-and-white TORREFAZIONE ITALIA and Design mark and one registration for the mark in color, as follows:

Reg. No. 3617700, registered May 5, 2009 for , for, *inter alia*: “ground and whole bean coffee, cocoa, herbal and non-herbal tea, coffee, tea, cocoa and espresso beverages, and beverages made with a base of coffee and/or espresso” in International Class 30;⁴

Reg. No. 3910244, registered January 25, 2011 for , for: “franchising, namely, providing technical assistance in the establishment and/or operation of restaurants, cafes, coffee houses and snack bars; retail store services in the field of ready-to-drink coffee beverages; mail order services and mail order catalog services, in the field of ground and whole bean coffee, coffee and espresso beverages, and beverages made with a base of coffee and/or espresso, housewares, and kitchenware; ordering services featuring coffee beverages” in International Class 35; and “preparation of carry-out beverages; restaurant services featuring carry-out beverages” in International Class 43; and

Reg. No. 4388424, registered August 20, 2013 for , for, *inter alia*: “ground and whole bean coffee, cocoa, herbal and non-herbal tea, coffee, tea, cocoa and espresso based beverages, and beverages made with a base of coffee and/or

³ Petition to Cancel ¶7, 1 TTABVUE 9. Although Petitioner does not specifically allege prior use of the black-and-white version of its mark, Petitioner alleges that both marks became famous “well prior to both the filing date of the application that matured into the subject registration, and any date of first use alleged by Registrant.” We have construed this statement as implicitly alleging prior use of the black-and-white version of the mark prior to the filing date of Respondent’s application.

⁴ A Section 8 and 15 combined declaration has been accepted and acknowledged.

espresso, beverages made with a base of tea” in International Class 30.

In each registration, “COFFEE” is disclaimed, and a claim of in-part acquired distinctiveness for the wording “TORREFAZIONE ITALIA” has been entered.⁵ Each registration also contains a description of the elements of each mark.⁶

In its answer, Respondent admits Petitioner’s ownership of the pleaded registrations.⁷ Respondent further admits the similarity of the Class 30 (coffee) goods.⁸ Respondent denies the remaining salient allegations in the petition to cancel.⁹

During trial, Petitioner presented evidence of its purported use of an additional (unregistered) mark that is shown below (Petitioner’s “Laurel Wreath” mark):¹⁰

⁵ The record indicates that the Italian term “Torrefazione” in the mark translates to “roasting or toasting” and the term “Italia” translates to “Italy.”

⁶ The descriptions vary. In Reg. Nos. 3617700 and 3910244, the description reads: “The mark consists of concentric circles with the words ‘TORREFAZIONE ITALIA’ in the upper portion of the logo and ‘COFFEE’ in the lower half of the logo and a rooster with wings in the center of the logo.” In Reg. No. 4388424 (the color mark), the animal pictured in the center of the mark is described as a gold griffin with red highlights, and not as a rooster with wings. The record also shows that each mark is coded with several design search codes, including “04.05.01 – Griffons; Dragons” and “03.01.02 - Lion insignia (heraldic lion).” None have been coded for “roosters.”

⁷ Answer ¶¶5 and 6, 4 TTABVUE 2-3.

⁸ Answer ¶13, 4 TTABVUE 3.

⁹ Respondent raised several affirmative defenses that were not pursued at trial and are accordingly waived. *See Cerveceria India Inc. v. Cerveceria Centroamericana, S.A.*, 10 USPQ2d 1064, 1066, n.3 (TTAB 1989), *aff’d*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989) (affirmative defenses waived).

¹⁰ The mark does not reproduce well from the material of record. All matter contained within the laurel wreath design is the same as in Petitioner’s registered TORREFAZIONE ITALIA and Design marks.



Petitioner argues that it has prior common law rights in the Laurel Wreath mark. However, Petitioner did not plead use of the Laurel Wreath mark in the petition to cancel and therefore may not rely on its priority allegations raised for the first time at trial. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009) (“A party may not rely on an unpleaded claim.”); *see also* TBMP § 314 (2015). We must therefore determine whether the issue of likelihood of confusion with Petitioner’s Laurel Wreath mark has been tried by express or implied consent under Fed. R. Civ. P. 15(b).

With respect to express consent, Respondent, in its trial brief, specifically states that none of Petitioner’s registered marks contain a laurel wreath design element:

Petitioner also contends that various uses of the TI Marks incorporate a laurel wreath, allegedly add[ing] to the overall similarity between the marks. However, ‘the issue of likelihood of confusion must be determined on the basis of the mark as it is presented for registration. Evidence showing uses of the mark in a form different from that displayed on the drawing is not relevant.’ *The Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022, 1024 (TTAB 1983). None of (sic) drawings contained in the registrations for the TI Marks depict a laurel wreath encircling the designs.¹¹

¹¹ 34 TTABVUE 30.

We have treated Respondent's argument that we should disregard the Laurel Wreath mark because it differs in form from the mark "on the drawing[s]" of Petitioner's registrations as an express denial of Petitioner's right to rely on its purported common law rights in the Laurel Wreath mark, leading to the conclusion that the issue has not been tried by express consent.

With respect to implied consent, however, we find that the issue has been so tried. Implied consent can be found where the non-offering party: (1) raised no objection to the introduction of evidence on the issue; and (2) was fairly apprised that the evidence was being offered in support of the issue. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134 (TTAB 2009) (witness's testimony on cross-examination insufficient to put adverse party on notice that fraud claim was being tried); *see also UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011) (although opposer did not properly plead its fame for purposes of dilution, the Board deemed the dilution claim tried by implied consent); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1924-27 (TTAB 2011) ("Because petitioner may not rely on unpleaded marks," Board must determine whether its rights in such marks were tried by implied consent; held petitioner's rights in unpleaded mark tried by implied consent); TBMP § 507.03(b) (2015).

Petitioner introduced the testimony deposition of Holly Gray, director of brand management for Starbucks Coffee Company, who testified that since 2007, Petitioner has been distributing a Product Guide (Exhibit 9, filed under seal), to its customers,

which displays Petitioner's line of goods, including coffee, beverages, equipment for making, storing, and serving coffee and beverages, and cups and paper products.¹² Ms. Gray described Exhibit 9 as "the product and marketing guide that we currently use to support all of the products that are available for our wholesale customers from Torrefazione Italia." She confirmed that the Guide illustrates "the variety of coffee packages and formats that are available under the TI griffin logo," as well as "paper products, the cups and the sleeves" and "airpots and shuttles, [which] are coffee serving vessels that wholesale accounts use to serve coffee to their customers."¹³ Ms. Gray testified that the Laurel Wreath appeared on "coffee and hot water identifier decals" for use on airpot and shuttles and that these "executions" are actually used by many of Petitioner's customers:

Q. Now, please take a closer look at the coffee and hot water identifier decals shown on page TI 1414. Are there any additional elements on the decals around the Torrefazione Italia logo?

A. Yes. There is a wreath, a vegetal wreath, a wreath around the Torrefazione Italia logo on each decal.

Q. Is it a laurel wreath?

A. Yes.

Q. And are these examples of the executions that are actually used by many of your customers?

A. Yes.

Q. Now, let's take a look at TI 1415. What is shown here?

¹² 15 TTABVUE 31; Exhibit 9 (confidential).

¹³ Gray Test., p. 26, 15 TTABVUE 29.

A. We have additional decals that support the Torrefazione Italia brand as well as what we call coffee ID stands for accounts that are utilizing stainless steel servers and don't have a place to place a decal. So they would set these stands next to their coffee servers.

Q. Finally, please turn to page TI 1416, where it says branded signs and posters. What are these?

A. These are signs and posters that are available to our accounts to be used either externally or internally within their spaces to depict that they are serving Torrefazione Italia Coffee.

Q. And these are some of the signs and posters that are actually used by your customers, correct?

A. Yes. Yes.

Q. Is the laurel wreath also featured around the Torrefazione Italia griffin logo and the branded signs and posters shown on TI 1416?

A. Yes.

Q. And all of the products shown in this product guide have been created and used since at least 2007, correct?

A. Yes.

Respondent did not object to the testimony or the exhibits, and it was clearly offered to show that Petitioner had been using the Laurel Wreath mark since 2007. Accordingly, we hold that the issue of Petitioner's common law rights to the Laurel Wreath mark was tried by implied consent and we deem the petition to cancel to be amended accordingly.

Evidentiary Objections

Each party has objected to the admissibility of testimony and evidence. Petitioner objects to Respondent's Notices of Reliance Nos. 3-5 and to portions of

Michael Rhee's affidavit testimony. Respondent objects to Petitioner's Notices of Reliance Nos. 1, 3 and 4.

Petitioner's Objections

Petitioner objects to the testimony of Michael Rhee, Respondent's Sales Director, on the grounds of irrelevance, improper expert testimony, lack of personal knowledge, inadmissible hearsay and lack of foundation. Specifically, Petitioner objects to his testimony relating to the parties' trade channels and customers, their business operations and the operations of unrelated third parties. Petitioner further objects to any statements constituting opinions directed to the ultimate issue of whether there is a likelihood of confusion in this case. Finally, Petitioner objects to



the admission into evidence of Respondent's prior registration for the mark **TRINIDAD** and Mr. Rhee's testimony about it.¹⁴

To the extent Mr. Rhee's statements regarding the parties' trade channels and customers, their business operations and the operations of third parties (including whether certain practices are common in the field or whether consumers are sophisticated) were based on personal knowledge and experience, they are relevant and admissible. On the other hand, statements constituting legal opinion are of little probative value and have been disregarded. Our determination of whether there is a likelihood of confusion is based on all of the facts that have properly been made of

¹⁴ Reg. No. 4108475, registered March 6, 2012 for "Caffeine-free coffee; Coffee; Coffee [sic]; Coffee and tea; Coffee beans; Coffee pods; Ground coffee beans; Roasted coffee beans."

record. *Cf. Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 56 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (prior inconsistent position taken by party does not “relieve the decision maker of the burden of reaching his own conclusion on the entire record.”). Thus, while we have considered the affidavit in its entirety, we give due weight to those fact-based statements made on personal knowledge and disregard those lacking foundation or constituting mere opinion. We have also considered Respondent’s prior registration as relevant to Respondent’s showing of the purported weakness of Petitioner’s marks due to other “griffin” marks either registered or in use, but have not considered it for any other purpose, such as tacking. Finally, we have disregarded Mr. Rhee’s testimony in Paragraph 49, commenting on Charles Sarosi’s testimony, as Mr. Sarosi’s testimony is of record, from which we may draw our own conclusions.¹⁵

Regarding Respondent’s Notices of Reliance 3-5, containing print-outs of third-party websites purporting to show that wholesale consumers are sophisticated and that the parties’ goods travel in differing trade channels, Petitioner’s objections thereto are overruled. If a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010); *see also Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101

¹⁵ As noted below, Mr. Sarosi is director of national accounts for Starbucks Coffee Company.

USPQ2d 1731, 1735 (TTAB 2012) (Internet printouts submitted as exhibits to testimony are not hearsay); TBMP §§ 528.05(e) and 704.08(b). We recognize, however, that the probative value of Internet documents is limited because such printouts are inadmissible to prove the truth of the matters asserted therein. *Safer*, 94 USPQ2d at 1040. (“[Internet printouts] are admissible only to show what has been printed, not the truth of what has been printed.”). Thus, we have considered the Internet printouts for what information the relevant purchasing public may have encountered in browsing websites pertaining to the goods or services involved herein, and have not considered them to demonstrate the truth of any statements made in any of the webpages.

Respondent’s Objections

Respondent’s objections to Petitioner’s Notices of Reliance Nos. 1, 3 and 4 on the grounds of hearsay, irrelevance and immateriality are overruled for the same reasons stated above. Petitioner’s Notice of Reliance No. 1 contains dictionary definitions of “laurel” from several print and online sources. These have been considered as evidence of the “collective understanding of the community” with respect to the definition of the term. *In re Boulevard Entertainment Inc.*, 334 F.3d 1336, 67 USPQ2d 1475, 1478 (Fed. Cir. 2003). We have also considered the Internet references to laurel wreaths in Petitioner’s Notice of Reliance No. 3 to be relevant to the question of likelihood of confusion. We do not take the Internet references for the truth of any matter asserted therein, but only to the extent that they show that relevant consumers may have been exposed to the references and may therefore have

an understanding of the significance of a laurel wreath in various contexts. As to the news articles and other publications that accompany Notice of Reliance No. 4, we have again considered them for what they show on their face only, taking into account the years in which the submitted materials were published and whether their titles indicate publication in a particular city. We have not considered them for the truth of any matters asserted therein.

The Record

In addition to the pleadings, the file of Respondent's registration forms part of the record without any action by the parties. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Petitioner's pleaded registrations are also of record, as TESS print-outs for the pleaded TORREFAZIONI ITALIA and Design marks, showing the current status and title of the registrations, were attached to the petition to cancel. Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d).

Petitioner's Testimony and Evidence

Petitioner introduced the testimony deposition of Holly Gray, director of brand management for Starbucks Coffee Company, with attached exhibits 1-24.¹⁶ Petitioner further introduced the testimony deposition of Charles Sarosi, director of national accounts for Starbucks Coffee Company, with attached exhibits 1-16.¹⁷

Petitioner filed the following evidence under Notices of Reliance:

1. Copies of dictionary definitions of the term "laurel";¹⁸
2. Copies of Respondent's confidential responses to Interrogatories Nos. 6 and 7 of Petitioner's First Set of Interrogatories;¹⁹
3. Copies of Internet print-outs;²⁰ and
4. Copies of unsolicited articles from printed publications.²¹

Respondent's Testimony and Evidence

Respondent introduced the Rhee affidavit with attached exhibits 1-4,²² pursuant to the parties' stipulation allowing Mr. Rhee's testimony to be introduced

¹⁶ 15 TTABVUE 9. Ms. Gray testified that Starbucks Coffee Company acquired Torrefazione Italia LLC in 2003. 15 TTABVUE 10.

¹⁷ 19 TTABVUE 10. Mr. Sarosi testified that Torrefazione Italia LLC is a subsidiary of Starbucks Corporation. Neither deponent clarified whether Starbucks Coffee Company and Starbucks Corporation are related companies, or whether they are actually two separate companies. However, the oversight is immaterial to our decision.

¹⁸ 10 TTABVUE 1-50.

¹⁹ 11 TTABVUE 1-8.

²⁰ 12 TTABVUE 1-147, Exhibits 1-19.

²¹ 16 TTABVUE 1-452, Exhibits 1-114.

²² 21 TTABVUE.

by affidavit.²³ Respondent also introduced the following evidence under Notice of Reliance:

1. Petitioner's responses to Interrogatory No. 1 of Respondent's First Set of Interrogatories;²⁴
2. Internet print-outs regarding griffin designs;²⁵ and
3. Copies of Internet materials regarding the parties' trade channels²⁶ and the marks.²⁷

Standing

Petitioner's pleaded registrations establish its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

Petitioner has also established its priority with respect to its registered marks. The filing dates of all three of Petitioner's registrations predate the July 17, 2012 filing date of Respondent's registration.²⁸ See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (where both parties hold registrations, each is entitled to rely on the application filing date of its registration "for the limited

²³ 17 TTABVUE.

²⁴ 23 TTABVUE, Respondent's Notice of Reliance No.1.

²⁵ 23 TTABVUE 10, Respondent's Notice of Reliance No. 2.

²⁶ 24 TTABVUE, Respondent's Notices of Reliance Nos. 3-4; and 25 TTABVUE, Respondent's Notice of Reliance No. 5.

²⁷ 26 TTABVUE, Respondent's Notices of Reliance No. 6.

²⁸ October 25, 2004 (for Reg. No. 3617700 and No. 3910244) and October 3, 2005 (for Reg. No. 4388424).

purpose of proving that its mark was in use as of the application filing date.”). Further, according to the parties’ *Stipulation as to Certain Facts to be Entered into the Record and for Certain Documents to be Entered into Evidence* (the “Stipulation of Facts”),²⁹ Petitioner first used its registered marks on December 31, 2003 in connection with coffee and related goods and services and Respondent first used its mark in connection with coffee and related goods on April 25, 2012.³⁰ Petitioner has thus established its priority with respect to its pleaded registrations.

Petitioner has also established priority with respect to its common law mark, the Laurel Wreath design. Ms. Gray testified that since 2007, Petitioner has been publishing a Product Guide similar to the one attached as Exhibit 9 to her testimony, and that decals for coffee airpots and shuttles, bearing the Laurel Wreath mark, were displayed therein and the decals, signs and posters bearing the Laurel Wreath mark were used by customers since 2007. Her testimony is sufficient to establish 2007 as Petitioner’s date of first use of the Laurel Wreath mark. *See, e.g. Nat’l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 827, 828 (TTAB 1993) (acknowledging that oral testimony may be sufficient to prove the first use of a party’s mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted); *GAF Corp. v. Amatol Analytical Servs., Inc.*, 192 USPQ 576, 577 (TTAB 1976) (“It is established that ownership of a trademark and of a trademark registration *as well as use of a mark* may be established by the oral testimony of a

²⁹ Sarosi Exhibit 15, 19 TTABVUE 131.

³⁰ *See also* Rhee Aff. Test., ¶ 11; 21 TTABVUE 4 (confidential).

single witness where such testimony is clear, consistent, convincing, circumstantial and uncontradicted.”) (emphasis added). The 2007 Product Guide corroborates her testimony. It includes a picture of each product bearing the mark, the specific “sku” number for the product, and pricing information. Accordingly, Petitioner has proven its priority of use with respect to the Laurel Wreath mark.

Likelihood of Confusion

Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The Goods

Considering first the relatedness of the goods, there is no dispute that the goods are in-part identical and otherwise highly related. Respondent admits in its

answer that the goods are related.³¹ Likewise, in the Stipulation of Facts, the parties agree that they each use their respective mark(s) on “coffee and related goods.”³² The second *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade; Classes of Purchasers; Conditions under which Sales are Made

Because the goods listed in both Respondent’s registration and Petitioner’s registrations include identical (*e.g.*, “coffee,” “tea”) as well as legally identical goods (*e.g.*, “ground and whole bean coffee; beverages made with a base of coffee and/or espresso” in Petitioner’s registrations; “caffeine-free coffee; coffee beans; ground coffee beans” in Respondent’s registration), and neither Petitioner’s nor Respondent’s registrations contain any limitations on the channels of trade and classes of purchasers, we must presume that the channels of trade and classes of purchasers for these goods are the same. *See Stone Lion Capital Partners*, 746 F.3d 1317, 110 U.S.P.Q.2d 1157, 1161 (Fed. Cir. 2014); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

³¹ *Answer*, ¶13, 4 TTABVUE 3.

³² Paragraph 15 of Stipulation of Facts, 19 TTABVUE 137.

Respondent argues that foodservice and foodservice management companies are sophisticated, discriminating purchasers, who carefully select vendors (such as Petitioner) through a rigorous application process. Respondent submitted printouts from third-party foodservice company websites, including application forms for doing business with the companies.³³ However, the fact that these distributors may be selective in their choice of vendor does not mean they are immune from confusion. Moreover, the record demonstrates that both parties also sell their products directly to members of the general public through online retail stores,³⁴ and that Petitioner's distributors also sell to retail coffee shops which feature Petitioner's marks on signage and menu boards viewable by the general public.³⁵ When determining the nature of the relevant purchaser, we base our decision "on the least sophisticated potential purchasers" at issue. *Stone Lion*, 110 USPQ2d at 1163 (Fed. Cir. 2014). Even if such sales do not make up a large part of either parties' business, these sales must be considered. Average retail consumers of coffee and coffee-based beverages exercise only ordinary care in making their purchasing decisions.

Based on the identity of the goods and their presumptively overlapping trade channels, the third (the similarity or dissimilarity of established, likely-to-continue trade channels) and fourth *du Pont* factors (conditions under which and buyers to whom sales are made) also favor a finding of likely confusion.

³³ See, e.g., Respondent's Notices of Reliance Nos. 3 and 4.

³⁴ Gray Test., p. 21, 15 TTABVUE 24; Rhee Aff. Test., p. 5, 22 TTABVUE 5 (redacted).

³⁵ Sarosi Test., p. 16, 19 TTABVUE 20; Gray Test, p. 30, 15 TTABVUE 33.

Strength of Petitioner's Marks

The relative strength of a mark is determined by weighing two factors: (1) the degree of inherent distinctiveness of the mark; and (2) the marketplace recognition of the mark. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (“In determining the strength of a mark we consider both its inherent strength based on the nature of the mark itself and its market strength.”). Market strength is the extent to which the relevant public recognizes a mark as denoting a single source. *Tea Board*, 80 USPQ2d at 1899. In other words, it is similar to acquired distinctiveness.

The design element in Petitioner's marks, comprising a griffin in profile and a background border design of concentric circles, curlicues, and (in its common law mark) a surrounding Laurel Wreath, is inherently distinctive. While the literal elements of Petitioner's marks are not inherently distinctive (TERRAFAZIONE ITALIA acquired distinctiveness under Section 2(f) and COFFEE is generic), the marks in their entireties are inherently distinctive.

Petitioner's marks are also commercially strong.³⁶ The commercial strength 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

³⁶ Based on the record before us, the same cannot be said of Petitioner's Laurel Wreath mark. It has not been shown to be commercially strong or well-known.

time those indicia of commercial awareness have been evident,” though some context in which to place raw statistics may be necessary. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Petitioner has submitted, under seal, evidence showing significant sales to its wholesale customers of coffee under, and advertising expenditures for, the TORREFAZIONE ITALIA and Design marks.³⁷ Petitioner also offers its products directly to ultimate consumers via an online website.³⁸ Ms. Gray testified that since 2003, the marks have been prominently featured on “all Torrefazione coffee packaging”³⁹ as well as on “millions” of paper products such as cups and cup sleeves.⁴⁰ In addition, Petitioner has shown that it promotes its coffee products to its wholesale accounts through sales presentations and training, and supplies promotional point-of-sale material, such as decals for use on airpots, table tents and coffee ID stands to its wholesale accounts.⁴¹ However, the record does not make clear the extent to which the public may have been exposed to such material. Finally, Petitioner introduced 114 unsolicited media articles from the Lexis-Nexis database, the majority of which tout Petitioner’s coffee

³⁷ See Sarosi Exhibit 2; 19 TTABVUE 105 (“Sales Document,” confidential). Because they have been identified as confidential, we will not discuss Petitioner’s sales figures or advertising expenses other than in a summary fashion.

³⁸ Gray Test., p. 23, Exhibit 6 (screenshots from Starbucksstore.com website), 15 TTABVUE 26.

³⁹ Gray Test., p. 23, 15 TTABVUE 26.

⁴⁰ Gray Test., p. 26, 15 TTABVUE 29.

⁴¹ See, e.g., Gray Test., p. 25-28, 15 TTABVUE 28-31; Exhibit 9 (product and marketing guide); p. 24, 15 TTABVUE 27, Exhibit 7 (coffee blend decals); p. 43, 15 TTABVUE 46, Exhibit 16 (table tents); pp. 45-46, 15 TTABVUE 48-49 Exhibit 18 (recipe and equipment cards that provide training to wholesale accounts).

as high quality and urge consumers to visit retail outlets, particularly in Seattle, that serve Petitioner's branded coffee.⁴² While these are evidence of the extent to which the public may have been exposed to reviews of Petitioner's business, and provide support for the claim that TORREFAZIONE ITALIA is well-known, none of the printouts included graphics from the articles showing the marks at issue in this proceeding,⁴³ which lessens their probative value.

We have also considered the over ten-year length of time Petitioner's marks have been in use, and the fact that no third parties have been shown to use "griffin" marks in the food or beverage industry. In this regard, we note that Respondent has shown that the griffin is well-known as a symbol in heraldry, in literature, and as school emblems and mascots, and has been used in some unrelated industries as a symbol or brand name.⁴⁴ However, with the exception of the involved marks and Respondent's prior Reg. No. 4108475, there is no showing in the record of any "griffin" design marks registered, or in use, on or in connection with food or beverages, or related services.

On balance, the evidence supports a finding that the marks are strong in the coffee beverage industry and thus accorded a broad scope of protection.

⁴² Petitioner's Notice of Reliance No. 4, 16 TTABVUE. A minority of articles describe the acquisition of Petitioner by Starbucks Corp.

⁴³ Although there are no pictures, several of the articles contain a written description of any graphics that appeared as part of the article. One of them, *Coffee culture percolates throughout Seattle*, from the San Diego Union-Tribune, August 15, 2004, describes what may be one of Petitioner's marks ("signs...such as this circular green, white and red emblem that indicates Torrefazione Italia coffee is for sale"). Petitioner's Notice of Reliance No. 4, Exhibit 96, 16 TTABVUE 373.

⁴⁴ Respondent's Notice of Reliance No. 2.

The Marks

We next consider the marks in their entireties as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. *In re Viterra*, 101 USPQ2d at 1908 (quoting *du Pont*); *Palm Bay*, 73 USPQ2d at 1692. In comparing the marks, we are mindful that where, as here, the goods are identical in part, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992); *see also*, *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007); *see also* *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks

into their various components. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). However, different features may be analyzed to determine whether the marks are similar. *National Data*, 224 USPQ at 751 (nothing improper in giving more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties). The average purchaser normally retains a general rather than a specific impression of trademarks. See *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Respondent’s registration for the mark -



and Petitioner’s registrations for the marks -



and



each contain, as their central

design feature, a mythological beast that Respondent identified as a griffin in its description of the mark and which the parties have stipulated to is a “gryphon” in

Petitioner's mark, notwithstanding Petitioner's initial characterization of this animal as a "rooster with wings."⁴⁵ Regardless of how the animal is described, however, we find that consumers are likely to recognize the animals portrayed in the marks as griffins because they are likely to recall those attributes that are common to most heraldic displays of griffins, namely, the portrayal of a beast resembling a lion and the "rampant" stance.⁴⁶ But they will readily perceive the major differences in the designs. Petitioner's griffin has a large mane, wears a crown and has a long tail, a beak and soft wings. It resembles a lion. Respondent's griffin has no mane or crown, sports a serpent-like tongue and scales on its wings, and has no tail. It does not resemble a lion. Notably, Respondent's griffin's legs are not visible; the griffin may be sitting on a pedestal or standing with legs obscured by the pedestal. Petitioner's griffin is in the classic "rampant" position.

We do not suggest that purchasers will parse out these features separately, or recall them specifically. We do not place the marks side-by-side in our analysis, but consider the marketplace, the consumer's hazy recollection, and the overall impressions made by each parties' griffin design, which we find readily

⁴⁵ The parties stipulated that the animal design in Petitioner's registrations is that of "a gryphon in profile, i.e., depicted from a side view, with arms extended." 20 TTABVUE 1091.

⁴⁶ See, e.g., at <http://en.wikipedia.org>, attached to Respondent's Notice of Reliance No. 2 ("A beast rampant (Old French: "rearing up") is depicted in profile standing erect with forepaws raised.") The term *segreant* is also used "for mythical creatures,...such as griffins and dragons."). *Id.* The evidence suggests that this is the "natural" or most popular pose for a depiction of a griffin. See, e.g., "*The Gryphon In Heraldry*" at <http://www.gryphonpages.com>, 23 TTABVUE 92 ("A *Griffin proper* [i.e., shown in its natural color] would be a gold Gryphon.... The most popular pose...is *rampant*, which means that the creature is standing on one hind leg..."). However, because griffins have not been shown to have been incorporated into trade or service marks in the food or beverage industry, even if true, this does not weaken the mark's inherent distinctiveness.

distinguishable. Further, we compare the marks in terms of their overall appearances, pronunciation, connotation and commercial impressions, and conclude that there is no likelihood that consumers will confuse the source of each parties' goods based on the marks.

In terms of appearance, simply put, the marks do not look anything alike. Petitioner's mark combines its griffin design with multiple ornamental design features that add to the clear visual differences between the marks. Petitioner's mark includes concentric circles, curlicues, and an abstract representation of the Italian flag that underscores the Italian theme of the mark. The prominent wording TERRAFAZIONE ITALIA COFFEE encircles the mark. Overall, Petitioner's mark visually presents an enclosed, double-circular shape. Where it appears, the laurel wreath design serves merely as an additional border concentric to the circles. Respondent's mark, on the other hand, is open at the top as opposed to being enclosed, with a seated griffin on a pedestal etched with the capital letter "T" surrounded by a laurel wreath. The conspicuous griffin in the center of Respondent's mark and the smaller griffin in Petitioner's marks are so dissimilar in appearance, as are the marks overall, that the fact that both include a griffin design is an insufficient basis upon which to find likely confusion.

In pronunciation, the letter "T" sounds nothing like TORREFAZIONE ITALIA COFFEE, and the remainder of Respondent's mark is not susceptible of being spoken, unlike the words TORREFAZIONE ITALIA COFFEE in Petitioner's mark. Moreover, the term "TORREFAZIONE ITALIA" is an important part of Petitioner's mark

overall and is far more likely to be impressed upon a purchaser's memory than the design features. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) ("In the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the products.") (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)). To the extent the marks project a meaning or connotation, Petitioner's mark suggests an Italian blend of roasted coffee while Respondent's mark does not, and Petitioner's argument that consumers are likely to interpret the "T" in Respondent's mark as "Torrefazione" is not supported by the testimony.⁴⁷ When viewed in their entireties, we find that Respondent's mark is not similar in sight, sound, meaning or commercial impression to Petitioner's marks.

⁴⁷ Sarosi Test., p. 6-7, 19 TTABVUE 10-11. Mr. Sarosi indicated only that consumers may shorten "Torrefazione Italia" to "TI." Nowhere is it shown that consumers see the words as anything but a unit or would perceive a "T" standing alone as "Torrefazione."

Conclusion

Having accorded due weight to the *du Pont* factors found in Petitioner’s favor, we find that the marks’ dissimilarities are dispositive of a finding of no likelihood of confusion. That is, the dissimilarity in the commercial impressions conveyed by the competing marks outweighs our findings in favor of Petitioner with respect to the other relevant *du Pont* factors. That one *du Pont* factor may be dispositive in a likelihood of confusion analysis is established, “especially when that single factor is the dissimilarity of the marks.” *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (no likelihood of confusion between “Crystal Creek” mark for wine and “Cristal” marks for champagne). *See also Odom’s Tennessee Pride Sausage, Inc. v. FF Acq., L.L.C.*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (Board did not err in basing its decision on the dissimilarity of the marks alone; “the visual distinctions between [the parties’ differing ‘farm boy’ design trademarks] create unquestionably different commercial impressions”); *Kellogg Co. v. Pack ‘em Enters., Inc.*, 951 F.2d 330 (Fed.Cir.1991) (FROOTEE ICE for flavored ice bars not likely to cause confusion with FROOT LOOPS for breakfast cereal and related products).

Decision: The petition for cancellation is denied.