To:	DD IP Holder LLC (wades@dicksteinshapiro.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85739062 - BEST COFFEE IN AMERICA - D1383.1457
Sent:	11/9/2012 11:43:47 AM
Sent As:	ECOM107@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6 Attachment - 7 Attachment - 8 Attachment - 9 Attachment - 10 Attachment - 11 Attachment - 12 Attachment - 13 Attachment - 14 Attachment - 15 Attachment - 16 Attachment - 17 Attachment - 18 Attachment - 19 Attachment - 20 Attachment - 21 Attachment - 22 Attachment - 23 Attachment - 24 Attachment - 25 Attachment - 26 Attachment - 27 Attachment - 28 Attachment - 29 Attachment - 30 Attachment - 31 Attachment - 32 Attachment - 33 Attachment - 34

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85739062

MARK: BEST COFFEE IN AMERICA

85739062

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http://www.uspto.gov/trademarks/teas/response_forms.j

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APPLICANT: DD IP Holder LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :
D1383.1457
CORRESPONDENT E-MAIL ADDRESS:
wades@dicksteinshapiro.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 11/9/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

SUMMARY OF ISSUES that applicant must address:

- Mark is merely descriptive – Incapable of registration on Principal Register

Mark Is Merely Descriptive – Section 2(f) Claim Insufficient

Applicant seeks registration of the mark "BEST COFFEE IN AMERICA" for "restaurant services; cafe services; snack bar services; fast-food restaurant services" on the Principal Register under Trademark Act Section 2(f). In support of its claim of acquired distinctiveness, applicant submitted only an allegation of five years' use, based on use of the mark since April 11, 2006.

Registration is refused because the applied-for mark is merely laudatory and descriptive of the alleged merit of applicant's services and the goods featured therein. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.* Further, applicant's informational slogan is nothing more than a claim of superiority and is so highly laudatory and descriptive of the quality of the coffee featured in applicant's restaurants, cafes and snack bars that applicant's claim of acquired distinctiveness, based on five years' use of the mark in commerce, is insufficient and unpersuasive. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). See also TMEP §§1209.02 *et seq.*, 1202.04 and cases cited therein.

For procedural purposes, a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co.* , 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Prof'l Learning Ctrs., Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984).

Thus, the issue here is whether applicant's mark has acquired distinctiveness or secondary meaning. In this case, applicant's allegation of five years' use is insufficient to show acquired distinctiveness because the proposed mark is highly laudatory and descriptive and incapable of achieving secondary meaning. *In re Kalmbach Publ'g Co.* , 14 USPQ2d 1490 (TTAB 1989); TMEP §1212.05(a).

"Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive" because "[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services]." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d ___, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); *see In re The Boston Beer Co.*, 198 F.3d at 1373-74, 53 USPQ2d at 1058-59 (holding THE BEST BEER IN AMERICA so highly laudatory and descriptive of applicant's beer and ale being of a superior quality that it is incapable of acquiring distinctiveness); *In re Carvel Corp.*, 223 USPQ 65, 68-69 (TTAB 1984) (holding AMERICA'S FRESHEST ICE CREAM so highly laudatory and descriptive of applicant's frozen desserts and ice cream being of a superior quality that it is incapable of registration on the Supplemental Register); *In re Wileswood, Inc.*, 201 USPQ 400, 402-404 (TTAB 1978) (holding AMERICA'S BEST POPCORN! and AMERICA'S FAVORITE POPCORN! highly laudatory and descriptive of applicant's unpopped popcorn being that of a superior quality and popularity); TMEP §1209.03(n). In fact, "puffing, if anything, is *more* likely to render a mark merely descriptive, not less so." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, ___ F.3d at ___, 103 USPQ2d at 1759.

Here, the wording "BEST COFFEE" combines a highly laudatory term with the generic name of the beverage featured in the service. "BEST" is defined as: "used for referring to the person or thing that is the most satisfactory, appropriate, pleasant, effective, of the highest quality, etc.". See attached definition from Macmillan Dictionary, www.macmillandictionary.com. Regarding "COFFEE", defined as: "a hot, slightly bitter drink made by pouring hot water over brown powder consisting of coffee beans that have been ground (=crushed into very small pieces)", this term clearly identifies the featured item sold by applicant in its restaurants. It is well established that a mark that consists of the generic name of a food that is the specialty of the house or a principal attraction of the restaurant has been held merely descriptive of restaurant services. See attached definition from Macmillan Dictionary, www.macmillandictionary.com. *See In re Fr. Croissant, Ltd.*, 1 USPQ2d 1238 (TTAB 1986) (holding LE CROISSANT SHOP merely descriptive of restaurant services providing croissants); *In re Le Sorbet, Inc.*, 228 USPQ 27 (TTAB 1985) (holding LE SORBET descriptive of restaurant and carryout shops which serve fruit ices); TMEP §1209.03(r). This wording, combined with "IN AMERICA", is a claim that the coffee featured at applicant's restaurants is superior to other coffees in America.

In further support of this refusal, the Examining Attorney refers to the excerpted articles demonstrating the highly descriptiveness nature of the terms in the mark, all obtained from the internet using the GOOGLE® search engine. See attachments. Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which the public is using a term. TMEP §710.01(b). *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-1 (TTAB 1998). Also, material obtained from applicant's website is acceptable as competent evidence. *See In re N.V. Organon*, 79 USPQ2d 1639, 1642-43 (TTAB 2006); *In re Promo Ink*, 78 USPQ2d 1301, 1302-03 (TTAB 2006); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1898 (TTAB 2001); TBMP §1208.03; TMEP §710.01(b).

The attached evidence demonstrates the highly laudatory nature of the proposed mark. Businesses as well as consumers use the wording "best coffee" and "best coffee in America" to refer to a wide variety of coffee shops and coffee brands. Also included are surveys or rankings of coffee, including a 2011 Zagat® survey of the "Best Coffee" [1], in which applicant was ranked along with other competitors, and a ranking of the "best coffee" category from Forbes.com's "50 of America's Best". [2] Another article discusses a Consumers Report ranking of the best coffee in America.[3]

Applicant itself uses this slogan descriptively in its own literature found on its website to refer to the comparative superiority of its coffee. One example of this appears in its press release from January 24, 2006, titled *JetBlue Airways and Dunkin' Donuts Brew New Partnership*, where applicant touts the following: "Dunkin' Donuts Consistently Rated ***Best Coffee in America***". [4] In another release from July 25, 2005, applicant notes that it is "officially recognized as the ***Best Coffee in America***" while promoting its new line of iced-coffee.[5] In another release from May 24, 2004, applicant lists its stable of drinks as follows in the following excerpt: "As the coffee leader, iced lattes are the perfect complement to our stable of delicious drinks, including our COOLATTAS® slush drinks, hot espresso-based beverages, and the ***best coffee in America***, as touted on the "Today Show."" [6] In a related release, applicant again touts its ranking as "Best Coffee in America" by NBC's "Today" show. [7] [All emphasis added.]

In *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1922 (TTAB 1998), the TTAB stated in its refusal to registration of "THE BEST BEER IN AMERICA" that "The issues are not whether applicant uses the phrase as a trademark or whether applicant wants to secure for the designation the protections afforded by registering it as its trademark. The issue is instead whether these laudatory words, which are highly descriptive of the claimed superior quality of applicant's goods, indicate the source of applicant's goods, or whether all they do is tout applicant's goods as the best in America."

The evidence shows here that applicant promotes the recognition it received from an independent survey and uses the mark descriptively to convey that ranking.

Furthermore, the TTAB in *Boston Beer* declared that the wording "THE BEST BEER IN AMERICA" is so highly laudatory and descriptive that it "inherently cannot function as a trademark". *Id.* at 1920. Likewise, "[s]uch other expressions as "Best Car in America," "Best Hotel in the State" and "Best Restaurant in Town," for example, are slogans which can be referred to as mere "puffery." Such claims of superiority should be freely available to all competitors in any given field to refer to their products or services, subject to whatever limits the law may impose on truthful advertising and unfair competition." *Id.*

Applicant's mark fits firmly in the category of marks identified the by Board above as being mere "puffery" and incapable of functioning as a trademark. "BEST COFFEE IN AMERICA" touts simply that the coffee featured at applicant's restaurants are superior to other coffees in this country. While applicant may use this wording in promoting its restaurants and cafes and the coffee sold therein, the proposed mark does not function to indicate the source of applicant's services or distinguish applicant's services from those of others.

Accordingly, given the highly laudatory and descriptive nature of the applicant's mark, the Section 2(f) claim of acquired distinctiveness based on five years' use in commerce is insufficient to show acquired distinctiveness of the mark.

Registration is refused.

Distinctiveness Claim for Highly Descriptive Designations

First, it is noted that an applicant may not base a claim of acquired distinctiveness under Trademark Act Section 2(f) on ownership of a registration on the Supplemental Register. *In re Canron, Inc.*, 219 USPQ 820 (TTAB 1983); TMEP §1212.04(d).

When asserting a Trademark Act Section 2(f) claim, the burden of proving that a mark has acquired distinctiveness is on the applicant. *Yamaha Int'l Corp. v. Yoshino Gakki Co.* , 840 F.2d 1572, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 948, 122 USPQ 372, 375 (C.C.P.A. 1959); TMEP §1212.01. Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin. The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *see In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); TMEP §1212.05(a).

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods and/or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l Corp.* , 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657 (TTAB 1986).

If additional evidence is submitted, the following factors are generally considered when determining acquired distinctiveness: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider all these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; *see* TMEP §§1212 *et seq.* The Office will decide each case on its own merits.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

General Response Guidelines

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements.

To expedite prosecution of the application, applicant is encouraged to file its response to this Office action online via the Trademark Electronic Application System (TEAS), which is available at http://www.uspto.gov/trademarks/teas/index.jsp. If applicant has technical questions about the TEAS response to Office action form, applicant can review the electronic filing tips available online at http://www.uspto.gov/trademarks/teas/e_filing_tips.jsp and email technical questions to TEAS@uspto.gov.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Kevin M. Dinallo/

Trademark Attorney
Law Office 107
571-272-9731
kevin.dinallo@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

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[1] See attached, from http://www.zagat.com/fastfood.

[2] See attached, from http://www.forbes.com/forbes-life-magazine/2001/0430/058_4.html.

[3] See attached, from http://news.stylecaster.com/best-coffee-in-america-where-find-your-perfect-cup/.

[4] See attached, from http://news.dunkindonuts.com/article_display.cfm?article_id=1190.

[5] See attached, from http://news.dunkindonuts.com/article_display.cfm?article_id=1202.

[6] See attached, from http://news.dunkindonuts.com/article_print.cfm?article_id=1218.

[7] See attached, from http://news.dunkindonuts.com/article_display.cfm?article_id=1220.