

UNITED STATES - TTAB SAYS COACH MARKS PRODUCE “DIFFERENT COMMERCIAL IMPRESSION”

The Trademark Trial and Appeal Board (TTAB) dismissed an opposition filed by Coach Services, Inc. (CSI), owner of COACH as used with handbags and consumer fashion products and accessories. *Coach Services, Inc. v. Triumph Learning LLC*, Opposition No. 91170112 (T.T.A.B. September 17, 2010) [precedential].

Triumph Learning LLC applied to register the mark COACH for use with various educational materials for preparing for standardized tests. CSI opposed the applications on the grounds of priority of use and likelihood of confusion, dilution, and descriptiveness.

The TTAB found that CSI’s COACH mark was famous, based on sales volume and advertising expenditures. Fame, however, did not prove a likelihood of confusion. The TTAB said that notwithstanding the famousness of CSI’s mark, the goods at issue were not “similar or related in any way . . . the goods move in different channels of trade” and “the marks, as used by the parties, have different meanings and engender different commercial impressions.” Accordingly, the Board held that Triumph’s use of its COACH mark for educational materials was not likely to cause confusion with CSI’s COACH mark for handbags and consumer fashion products and accessories.

With regard to dilution, the TTAB noted that although COACH is famous for purposes of the likelihood-of-confusion analysis, fame for dilution purposes “requires a more stringent showing”—the mark “must be a household name.” The TTAB found that CSI’s evidence did not meet this stringent requirement and that its COACH mark was not famous for dilution purposes. That finding notwithstanding, the TTAB still proceeded to discuss dilution by blurring and by tarnishment, and found there was no dilution by either.

Last, the Board considered CSI’s assertion that Triumph’s mark was descriptive. Noting that Triumph’s mark immediately conveyed to consumers the purpose of the materials—preparing students for a test—and that potential consumers did not have “to use any imagination, thought or perception to reach a conclusion as to the nature of the goods,” the TTAB concluded that Triumph’s mark was merely descriptive.

However, the Board found that Triumph proved its marks had made an impact on the purchasing public as a source indicator in the field of educational materials. Consequently, it held that Triumph’s mark had acquired distinctiveness and was entitled to registration with the appropriate Section 2(f) notation. The TTAB dismissed all three counts of CSI’s opposition.

Coach has appealed the TTAB’s decision to the Court of Appeals for the Federal Circuit.

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