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The National Law Journal | February 21, 2012



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The U.S. Court of Appeals for the Federal Circuit has issued a split ruling regarding luxury accessories maker Coach's opposition to the registration of "Coach" trademarks by test prep publishing company Triumph Learning LLC.



On Feb. 21, a unanimous panel affirmed a ruling by the Trademark Trial and Appeal Board that there's no likelihood of confusion between the parties' marks and there's no likelihood of dilution of Coach's mark for lifestyle goods by Triumph's "Coach" marks for educational materials. But the court vacated the trademark board's decision that Triumph's "Coach" marks had acquired secondary meaning in the marketplace.



Cooper & Dunham's
Norman Zivin



Goodwin Procter's R.
David Hosp

The Federal Circuit's ruling in *Coach Services Inc. v. Triumph Learning LLC* affirmed two of three rulings by the board in its September 2010 judgment, which

dismissed Coach's opposition to Triumph's three trademark applications. The Federal Circuit ruled that the trademark board made evidentiary errors on its analysis of the secondary-meaning issue and remanded the case for further proceedings on that issue.

Under trademark law, marks that are "merely descriptive" of the goods and services are not entitled to trademark protection. A valid trademark must have secondary meaning in the minds of the public through its use in commerce.

Triumph publishes books and software for standardized test preparation. The company claims it has used the "Coach" mark since at least 1986. In December 2004, Triumph filed three use-based trademark applications for the "Coach" mark, one with just the word, another using a stylized font and the third with the mark "Coach" with a mascot and the tagline "America's Best for Student Success."

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The Board has also found that Coach's secondary meaning claim has been used by Coach since at least December 1961. It has also filed 16 trademark registrations for the "Coach" mark, including 15 in which the mark issued before December 2004.

In March 2006, Coach Services filed a notice of opposition with the trademark board opposing Triumph's registration of all three "Coach" marks on grounds of likelihood of confusion and dilution. In October 2006, Coach Services amended its notice to add the claim that Triumph can't register the "Coach" mark because the mark is "merely descriptive when used on goods in the educational and test preparation industries."

Judge Kathleen O'Malley authored the opinion, joined by judges Pauline Newman and Jimmie Reyna.

On the substantive issues, the Federal Circuit agreed with the board that "despite their undisputed similarity, the marks have different meanings and create distinct commercial impressions. This is particularly true given that the word "coach" is a common English word that has many different definitions in different contexts."

"We agree with the Board that these distinct commercial impressions outweigh the similarities in sound and appearance, particularly since...the parties' goods are unrelated," O'Malley wrote.

O'Malley found that "the Board did not err in concluding that the goods are not related and the channels of trade are distinct." Even if there is some customer overlap, the purchasers are unlikely to associate the two companies' products, O'Malley wrote. "And, there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source."

O'Malley noted that Coach Services failed to prove fame for dilution purposes, which has a high burden of proof. "We do not hold that [Coach Services] could never establish the requisite level of fame for dilution purposes," O'Malley wrote. "We hold only that, on the record presented to it, the Board had substantial support for its conclusion that [Coach Services'] evidentiary showing was just too weak to do so here."

On the issue of whether Triumph can claim a "substantially exclusive use," which underpins its secondary meaning, the Federal Circuit concluded that the trademark board's failure to consider all third-party uses of the term "coach" for educational materials undermines the mark's secondary meaning.

O'Malley also faulted the board's conclusion that Triumph has been promoting itself as the 'Coach' brand since 1989, because it relied on the testimony of Triumph's vice president of marketing, Jane Fisher, who began working for Triumph in July 2003.

"Given the Board's ruling excluding testimony by Ms. Fisher about marketing activities of which she had no personal knowledge..., there is no admissible testimony in the record regarding the actual use of the catalogs or the fact of marketing prior to 2003," O'Malley wrote. "Accordingly, on remand, the Board must address the weight, if any, to be given to pre-July 2003 documents in the absence of any testimony authenticating them or addressing their use. The Board must then assess whether these apparent gaps in Triumph's proofs impact the Board's determination that the mark was in continuous use during any relevant period."

Norman Zivin, a partner at New York-based Cooper & Dunham, who argued the case for Coach, said, "I'm gratified that the court of appeals held that Coach is a famous mark and that the applicant Triumph Learning is not entitled to register the mark Coach based on the present record."

R. David Hosp, a partner at Boston-based Goodwin Procter who argued for Triumph, said that Triumph has always been confident that its educational products are "not confusingly similar to petitioner's luxury goods and that there was no possibility of dilution."

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secondary meaning were only two of many pieces of evidence with respect to the secondary meaning in Triumph's marks," Hosp said. "We have very little doubt that the board will arrive at the same conclusion on remand."

It's probably going to be difficult for Triumph to show that it has established secondary meaning for "Coach," said Andrew Berger an intellectual property counsel to New York-based Tannenbaum Helpen Syracuse & Hirschtritt who isn't involved in the case. "That's the thorn in their side, despite what appears to be a pretty hard fought victory," Berger said.

Sheri Qualters can be contacted at squalters@alm.com.

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