

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
November 20, 2003

Mailed: February 19, 2004
Paper No. 25
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Arabica Funding, Inc.
v.
Ryan Bros. Coffee, Inc.

Opposition Nos. 91150409; 91150575; and 91150426
to application Serial Nos. 76216469; 76216470; and
76216471
filed on February 23, 2001

Travis L. Buchman, Peter Lancaster, and Elizabeth C.
Buckingham of Dorsey & Whitney LLP for Arabica Funding,
Inc.

James E. Schneider L.L.M., of Law Office of James E.
Schneider L.L.M. for Ryan Bros. Coffee, Inc.

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Ryan Bros. Coffee, Inc. has filed applications to
register the mark LIFE IS TOO SHORT TO BE BITTER for

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"coffee;"¹ "coffee mugs and coffee cups;"² and "clothing, namely, shirts, hats, jackets, and sweatshirts."³

Registration has been opposed by Arabica Funding, Inc. on the grounds that it or its predecessor has used the mark "LIFE IS SHORT. STAY AWAKE FOR IT." in connection with restaurant services and retail store services in the field of coffee, t-shirts, and beverageware since at least as early as February 23, 2001, the filing date of applicant's applications; that opposer is the owner of two registrations for the mark "LIFE IS SHORT. STAY AWAKE FOR IT.", namely, Registration No. 2,008,379 (issued October 15, 1996; Section 8 affidavit accepted, Section 15 affidavit acknowledged) for "restaurant services and retail store services in the field of coffee;" and Registration No. 2,000,062 (issued September 10, 1996; Section 8 affidavit accepted, Section 15 affidavit acknowledged) for "t-shirts;" and that applicant's mark, if used on the identified goods, would so resemble opposer's previously used and registered mark, as to be likely to cause confusion.

¹ Serial No. 76216469, filed February 23, 2001, and based on a bona fide intention to use the mark in commerce.

² Serial No. 76216470, filed February 23, 2001, and based on a bona fide intention to use the mark in commerce

³ Serial No. 76216471, filed February 23, 2001, and based on a bona fide intention to use the mark in commerce.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

Preliminarily, we note that opposer has objected to Exhibit 2 to applicant's notice of reliance, which consists of a printout of the results of a search of the Internet for "life is short." Opposer has objected to this exhibit on the ground that an Internet printout does not qualify as a printed publication under Trademark Rule 2.122(e). Applicant does not dispute opposer's contention and, in any event, opposer's objection is well taken. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). Thus, we have not considered the printout in reaching our decision herein.

The record consists of the pleadings, the files of the opposed applications; trial testimony with related exhibits taken by both parties; and applicant's notice of reliance on a list of third-party registrations and applications for marks which include the phrase "LIFE IS (TOO) SHORT"; copies of several third-party registrations for marks which include the phrase; and opposer's responses to applicant's interrogatories.

Both parties filed briefs on the case and both were represented by counsel at an oral hearing held before the Board.

The record shows that opposer licenses use of the mark "LIFE IS SHORT. STAY AWAKE FOR IT." to Caribou Coffee Company (Caribou). Caribou was the original owner of the pleaded registrations and assigned the mark to opposer on April 20, 2001. Caribou began as a "mom and pop" coffee store in Edina, Minnesota in December 1992. It quickly expanded to twelve retail stores in Minnesota and in September 1994 opened its first store in Atlanta, Georgia. It was then that Caribou began use of the slogan "LIFE IS SHORT. STAY AWAKE FOR IT." in connection with its restaurant services and retail store services in the field of coffee. According to opposer's witness Kimberly Puckett, the slogan was adopted "to communicate to [Caribou's] customers the differences between [it and Starbucks]". (Puckett dep., p. 17). The mark was first used on posters and in newspaper advertisements in connection with Caribou's services. The mark has since come to be used on t-shirts (1994); mugs (1994); thermoses (1997); and pre-packed coffee (1995). The mark is currently used on virtually all of Caribou's advertising and promotional materials.

Caribou is the second largest company-owned coffee retailer in the United States, and it has approximately 150 retail stores in seven states and the District of

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Columbia. Caribou also sells its coffee through commercial channels to office coffee services, restaurants, hotels and grocery stores. Caribou's yearly sales and advertising figures were filed under seal, but as opposer notes in its brief, for the period 1994-2002, Caribou's total sales were over \$450 million and Caribou spent over \$10 million advertising and marketing products in connection with which the mark "LIFE IS SHORT. STAY AWAKE FOR IT." was used.

Applicant, Ryan Bros. Coffee, Inc. began business in 1994 with a single coffee cart in downtown San Diego, California and subsequently expanded to a retail store. Applicant ceased its retail operations in 2000 and is currently a "microroaster" and wholesaler of specialty coffee beans and teas to hotels, restaurants, cafes and delis.

Applicant is a family-owned and managed business. According to one of the owners, Harry Ryan, applicant adopted the slogan "LIFE IS TOO SHORT TO BE BITTER" in 1999 as the result of a family argument and because applicant wanted to convey to customers that its coffee is smooth instead of bitter. Applicant began use of the mark in 1999 and currently uses "LIFE IS TOO SHORT TO BE BITTER" on coffee cups, mugs, t-shirts, and other

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clothing for promotional purposes only, and not for resale. Applicant markets its coffee and tea products by "cold calling" and "word of mouth." Applicant maintains a website for informational purposes only; the website contains descriptions of applicant's coffee and teas, but customers may not order products online.

Opposer, through the testimony of its witness, has introduced as exhibits copies of its pleaded registrations for the mark "LIFE IS SHORT. STAY AWAKE FOR IT." which show that each of the registrations is subsisting and owned by opposer. Thus, there is no issue with respect to opposer's priority vis-à-vis the goods and services identified in opposer's registrations. *King's Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, (CCPA 1974). Moreover, the uncontroverted testimony of opposer's witnesses demonstrates that opposer has prior common law rights in its mark for pre-packed coffee and beverage ware, i.e., mugs and thermoses, by virtue of use prior to applicant's first use in 1999. In any event, applicant does not dispute opposer's priority. (Applicant's brief, p.6).

We turn our attention then to the issue of likelihood of confusion.⁴ Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 56 (CCPA 1973). 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

⁴ Although opposer did not plead a likelihood of confusion vis-à-vis its pre-packed coffee and the goods identified in applicant's application, we deem the notice of opposition amended to include such a claim. Fed. R. Civ. P. 15(b).

differences in the essential characteristics of the goods and the differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Upon consideration of the relevant duPont factors, it is our view that confusion as to source or sponsorship is not likely to occur. We acknowledge, in this regard, that while many factors favor opposer and, thus, a finding of likelihood of confusion, such factors are simply outweighed by the significant differences in the respective marks, which are readily distinguishable when considered in their entireties.

In the present case, there is no question that the goods identified in applicant's application are identical and otherwise closely related to the goods and services identified in opposer's registrations and the goods for which opposer has established prior common law rights in its trademark. Specifically, applicant's coffee mugs and coffee cups are identical in part and otherwise closely related to opposer's mugs and thermoses; applicant's clothing items are identical in part and otherwise closely related to opposer's t-shirts. Further, applicant's coffee is identical in part and otherwise closely related to opposer's pre-packed coffee,

restaurant services and retail store services in the field of coffee. In the latter regard, it has been frequently held that likelihood of confusion may arise from the use by different parties of the same or similar marks for goods, on the one hand, and in connection with services which deal with those goods, on the other.

Further, although it appears that applicant limits the sale of its coffee to wholesalers and that its coffee cups, coffee mugs and clothing are used for promotional purposes only, there are no limitations in applicant's applications with respect to channels of trade or purchasers. Thus, for purposes of our likelihood of confusion analysis, we must presume that applicant's goods are sold in all the normal channels of trade to all the usual purchasers for the goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we can draw no distinction between the channels of trade and class of purchasers of the parties' respective goods and services.

We turn then to a determination of what we find to be the key likelihood of confusion factor in this case, i.e., whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance,

sound, and connotation, are similar or dissimilar in their overall commercial impression. Comparing the marks first in terms of their respective connotations or meanings, we recognize that they both began with the generally known catch phrase or slogan "LIFE IS (TOO) SHORT."⁵ However, we find that this phrase is not a dominant feature of either of the parties' marks and that the mere presence of the phrase in both marks is insufficient, without more, to warrant a finding that the marks are confusingly similar in their entireties.

As for the rest of the respective marks, opposer argues that the "STAY AWAKE FOR IT." portion of its mark refers to the fact that the caffeine in coffee keeps one awake and alert, and that the TO BE BITTER portion of applicant's mark refers to coffee which is smooth rather than bitter. Opposer argues, therefore, that both marks, when viewed in their entireties, have the same meaning, namely, "LIFE IS (TOO) SHORT plus a desirable quality of coffee." (Brief, p. 16).

We are not persuaded that the marks have the same connotation, as opposer contends. As acknowledged by

⁵ We judicially notice that A Dictionary of Catch Phrases (1992) contains the following listing:

life is too short. "It [whatever "it" is] may be doable, but the results won't be worth the effort: US: from 1960 or earlier" (R.C. 1978).

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opposer, the "STAY AWAKE FOR IT." portion of its mark has a specific and readily-recognized meaning as used in connection with its goods and services; "STAY AWAKE FOR IT." connotes that drinking coffee keeps one awake and alert.

The "TO BE BITTER" portion of applicant's mark, apart from being a double entendre, also has a specific and readily-recognizable meaning as used in connection with applicant's goods; it connotes the bitter taste of some coffee. This is a negative quality, not a desirable quality of coffee, as opposer contends. Purchasers encountering the respective marks in connection with the parties' goods and services will ascribe these specific meanings to "STAY AWAKE FOR IT." and "TO BE BITTER," rather than "a desirable quality of coffee" as opposer contends. Because the "STAY AWAKE FOR IT." portion of opposer's mark and the "TO BE BITTER" portion of applicant's mark have such different connotations, they will not be brought together in meaning by virtue of being combined with LIFE IS (TOO) SHORT. Moreover, even the phrases "LIFE IS SHORT" and "LIFE IS TOO SHORT." have different meanings. The first simply connotes the briefness of life, whereas the latter connotes that life is too short to either do or not do something. In sum, we find that when the respective marks are compared in their entireties, they have vastly different connotations.

We also find that the marks are more dissimilar than similar when compared in their entireties in terms of

appearance and sound. Opposer's mark consists of two separate phrases set off by periods, and begins with the phrase LIFE IS SHORT. Applicant's mark, on the other hand, is a single phrase, and begins with LIFE IS TOO SHORT. In addition, because of the differences in appearance and sound of "STAY AWAKE FOR IT." and "TO BE BITTER", the marks, when considered in their entirety, are distinguishable in appearance and sound.

Although opposer argues that its "LIFE IS SHORT. STAY AWAKE FOR IT." mark is strong and well known, we find that the evidence falls short of establishing the fame of opposer's mark. There is no evidence regarding the extent of consumer recognition of "LIFE IS SHORT. STAY AWAKE FOR IT." with opposer's goods and services, and we are not convinced, based on opposer's advertising and sales figures alone, that the mark has achieved the status of a famous mark. Compare: *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1991).

Several other matters require comment although they did not affect our decision herein.

The first matter relates to the list of third-party registrations/applications and copies of third-party registrations for LIFE IS (TOO) SHORT marks made of

record by applicant. Applicant maintains that this evidence demonstrates that opposer's mark is weak. Apart from the fact that a mere listing of third-party registrations and applications is not the proper way to make such registrations and applications of record, we note that third-party registrations are not evidence that the marks shown therein are in use (and third-party applications are evidence only of the fact they have been filed). Moreover, only three of the registrations cover goods/services of a type involved herein and these three registrations are owned by the same entity. Thus, the third-party registrations and applications are of limited probative value.

Finally, applicant's argument that there is no likelihood of confusion because each party displays its involved mark along with its respective house mark is without merit. We cannot consider the parties' house marks as elements that could help distinguish applicant's mark from opposer's mark because the house marks are not part of opposer's pleaded mark or part of the mark in the involved applications. *Vornado, Inc. v. Breuer Electric Mfg. Co.*, 390 F.2d 724, 156 USPQ 340, 342 (CCPA 1968).

In sum, after careful consideration of the evidence of record with respect to the relevant duPont factors and

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the parties' arguments with respect thereto, we conclude that there is no likelihood of confusion in this case,

That is, notwithstanding the fact that the parties are using their respective marks on identical and otherwise closely related goods and services which may be marketed in the same channels of trade to the same purchasers, we find that the marks are too dissimilar, especially in terms of their meanings and overall commercial impressions, to support a determination that confusion is likely. See e.g., *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991).

Decision: The opposition is dismissed.