

United States Court of Appeals  
for the Federal Circuit

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(Opposition No. 91170112)

COACH SERVICES, INC.,  
*Appellant,*

v.

TRIUMPH LEARNING LLC,  
*Appellee.*

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2011-1129

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Appeal from the United States Patent and Trademark  
Office, Trademark Trial and Appeal Board.

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Decided: February 21, 2012

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NORMAN H. ZIVIN, Cooper & Dunham, LLP, of New  
York, New York, argued for appellant. With him on the  
brief was TONIA A. SAYOUR.

R. DAVID HOSP, Goodwin Procter, LLP, of Boston,  
Massachusetts, argued for appellee. With him on the  
brief was ANTHONY H. CATALDO. Of counsel was JOHN T.  
BENNETT.

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Before NEWMAN, O'MALLEY, and REYNA, *Circuit Judges.*

O'MALLEY, *Circuit Judge*.

Coach Services, Inc. ("CSI") appeals from the final decision of the Trademark Trial and Appeal Board ("the Board") dismissing its opposition to Triumph Learning, LLC's ("Triumph") use-based applications to register the mark COACH for educational materials used to prepare students for standardized tests. The Board found that: (1) there was no likelihood of confusion between the parties' COACH marks; (2) CSI failed to prove likelihood of dilution; and (3) although Triumph's marks are merely descriptive, they have acquired secondary meaning, and thus are entitled to registration. *Coach Services, Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600 (T.T.A.B. Sept. 17, 2010) ("Board Decision"). For the reasons discussed below, we find no error in the Board's decisions regarding likelihood of confusion and dilution, and thus affirm as to those grounds. With respect to the Board's acquired distinctiveness analysis, however, we find that certain evidentiary errors require us to vacate and remand solely with respect to the Board's determination of Triumph's "substantially exclusive and continuous use" of its marks. Accordingly, we affirm-in-part, vacate-in-part, and remand this matter for further proceedings.

#### BACKGROUND

##### A. Triumph's Use of the COACH Mark

Triumph publishes books and software used to assist teachers and students in preparing for standardized tests. Triumph claims that it has used the COACH mark in connection with its products since at least 1986. According to Triumph: (1) the "market for test preparation materials for state-sponsored standardized tests is highly specific and targeted"; and (2) much of the marketing takes place through face to face contact with sales representatives or in the form of direct mailings to previously

identified educational department heads. Appellee's Br. 6.

Triumph explains that, when Congress passed the No Child Left Behind Act in 2001, which mandated that all states administer standardized tests to monitor academic advancement, Triumph made additional investments in its marketing. It began focusing on the style of its brand and developed a mascot – a cartoon coach – and a slogan: "America's best for student success." Triumph invested significantly in its marketing efforts, and, according to Triumph, it has had substantial commercial success selling products under its COACH mark.

In December 2004, Triumph filed use-based applications for three marks: (1) the COACH word mark (Serial No. 78/535,642); (2) a stylized COACH mark (Serial No. 78/536,065); and (3) a COACH mark and design (Serial No. 78/536,143) (referred to collectively as "Triumph's COACH marks"). The COACH mark with a design appears as follows:



Each of the applications is for the following goods in International Classes 9 and 16:

Computer software for use in child and adult education, namely, software to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized

exams; prerecorded audio and video tapes in the field of child and adult education, featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 9; and

Printed materials in the field of child and adult education, namely, textbooks, workbooks, teacher guides and manuals, posters and flashcards, all featuring materials to assist teachers and students at all levels in mastering standards-based curricula and in preparing for standardized exams, in Class 16.

Triumph's COACH marks were published for opposition on September 20, 2005.

#### B. CSI's COACH Marks

CSI advertises and sells a wide variety of "accessible luxury" products, including handbags, luggage, clothing, watches, eye glasses, and wallets. It has been using the COACH mark in connection with its products since at least December 28, 1961.<sup>1</sup> CSI owns sixteen incontestable trademark registrations for the COACH mark, all but one of which issued before Triumph's applications were filed in December 2004.

CSI sells its COACH products in its own 400 retail stores, in department stores, and over the Internet through its website. It also promotes its goods by catalogs. CSI advertises and markets its COACH line of products throughout the United States using "magazine and newspaper ads, billboards and bus and phone kiosks." Appellant's Br. 5. For example, CSI's COACH brand products have been advertised in national fashion publi-

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<sup>1</sup> CSI claims that its predecessor first began using the COACH mark in 1957.

cations, including *Elle*, *Vogue*, *Mademoiselle*, and *Vanity Fair*.

Although CSI's briefing to this court includes advertising and sales figures from 2000-2008, including a representation that its sales exceeded \$10 billion over that time frame, as discussed below, this evidence was not properly submitted to the Board and thus was not considered. In fact, the Board found that CSI introduced evidence of its advertising and sales only for 2008. Specifically, CSI introduced the testimony deposition of Carole P. Sadler, the former Vice President, General Counsel, and Secretary of CSI, who testified that, in 2008: (1) CSI's annual sales were roughly \$3.5 billion; and (2) CSI spent about "30-60 million a year" on advertising. Joint Appendix ("J.A.") 3659-60.

To further support the popularity and commercial success of its COACH mark, CSI points to: (1) its joint marketing efforts with other popular brands, including LEXUS and CANON; (2) unsolicited media attention from the fashion press; (3) an internal market study conducted in June and July 2007 of persons between the ages of 18-24, which showed that the COACH brand had 96% aided awareness; and (4) the fact that CSI has taken steps to enforce its trademark rights against past infringers.

It is undisputed that CSI is not in the education or test-preparation industry, does not consider Triumph a competitor, and did not present any evidence of any actual confusion stemming from Triumph's use of the Coach mark in conjunction with its educational materials.

### C. TTAB Opposition Proceedings

On March 17, 2006, CSI filed a Notice of Opposition opposing registration of all three of Triumph's COACH marks on grounds of likelihood of confusion under 15

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