

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINATION DIVISION

APPLICANT : Blue Bottle Coffee, LLC)
MARK : Blue Bottle Blue Mark) April A. Hesik
SERIAL NO. : 88/366,378) Trademark Examining Attorney
CLASS: : 43) Law Office 124

RESPONSE TO OFFICE ACTION

Applicant Blue Bottle Coffee, LLC (“Applicant”) hereby responds to the Office Action issued on June 21, 2019, regarding U.S. Trademark Application Serial No. 88/366,378 (“Application”), together with the declaration of Rifkin Young and annexed supporting exhibits (“Young Declaration”).

I. Applicant’s Mark Is Not a Phantom Mark

The Examining Attorney has refused registration of Applicant’s mark on the basis that it seeks to register a mark with a changeable or “phantom” element. Applicant respectfully disagrees that its mark includes any changeable or “phantom” element.

As the Examining Attorney has stated, a phantom mark is a mark that consists of a word, alpha-numeric designation, or component of a mark that is subject to change. *In re Trico Prods. Corp.*, 2006 TTAB LEXIS 279 (TTAB 2006); T.M.E.P § 1214. However, it appears that the Examining Attorney may not have understood the elements of Applicant’s mark. In the Office Action, the Examining Attorney states that the dotted lines appear to be a placeholder for a changeable design element. However, the signage depicted in the dotted lines serve only as a positional reference to illustrate a context in which the Blue Bottle Blue Mark appears – the dotted lines are *not* a feature of the mark. Instead, Applicant seeks to register the particular blue color (Pantone 2995 C) as its mark, which is not changeable.

II. Applicant's Mark Has Acquired Distinctiveness, Entitling It to Registration Under Section 2(f) of the Trademark Act

Applicant's color mark as shown in the Application ("Blue Bottle Blue Mark"), has acquired distinctiveness as a result of its seventeen years of substantial and exclusive use. Thus, it enjoys significant consumer recognition.

A. Applicant Need Only Establish a *Prima Facie* Case of Acquired Distinctiveness

In refusing the Application, the Examining Attorney states that Applicant's Blue Bottle Blue Mark as applied to the product packaging is simply a decorative feature and is not inherently distinctive. The United States Supreme Court has held that "[c]olor can function as a mark if it is used in the manner of a trademark or service mark and if it is perceived by the purchasing public to identify and distinguish the goods or services on or in connection with which it is used and to indicate their source." T.M.E.P. § 1202.05 (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 U.S.P.Q.2d 1161 (1995)).

As with all other types of marks, at this stage of the application process, "an applicant need not conclusively establish distinctiveness, but need only establish a prima facie case to warrant publication of a mark for opposition." *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1576 (Fed. Cir. 1988) (quoting *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. 916, 919 (T.T.A.B. 1983)). It is well settled that borderline cases should be resolved in favor of the applicant "on the theory that any person who believes he would be damaged by the registration will have an opportunity under Section 13 to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect." *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972).

B. Applicant's Significant Use of the Blue Bottle Blue Mark Is Competent Evidence of Its Acquired Distinctiveness

To demonstrate that its mark has acquired distinctiveness, an applicant may submit “any competent evidence” showing that consumers associate the applicant’s goods provided under the applicant’s mark with the applicant. T.M.E.P. §1212.01. “Competent” evidence can take a variety of forms. It includes items that demonstrate the extent and nature of use of the mark in commerce, and those that tend to show the mark distinguishes the goods. 37 C.F.R. §2.41(a). “An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.” *In re Owens-Corning Fiberglas Corp.*, 227 U.S.P.Q. 417, 422 (Fed. Cir. 1985).

Importantly, it is only necessary to show that a substantial segment of the *relevant group* of consumers will make the association between the product and the producer. *Am. Ass’n for Advancement of Science v. Hearst Corp.*, 498 F. Supp. 244, 257 (D.D.C. 1980); *see also Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 226 n.23, 103 U.S.P.Q.2d 1937 (2d Cir. 2012) (holding that the red color contrast of women’s shoe soles had acquired secondary meaning among those in the market for very expensive high-heeled shoes). Here, the relevant group of consumers—consumers of high-quality coffee—associate Applicant’s coffee services and Applicant with the Blue Bottle Blue Mark, as demonstrated below and attested to in the attached Young Declaration and annexed exhibits.

C. The Blue Bottle Blue Mark Is an Integral Element of Applicant’s Services and Marketing Activities

Applicant, founded in 2002, is an extremely popular coffee roaster and retailer. Since its

inception, and at least as early as August 15, 2002, Applicant has used the Blue Bottle Blue Mark as a significant component of its branding for its coffee goods and café services.

The Blue Bottle Blue Mark has become distinctive of Applicant's exceptionally popular café services through Applicant's substantially exclusive and continued use in commerce of the Blue Bottle Blue Mark since 2002. Proof of continuous and substantially exclusive use of a mark for five years constitutes *prima facie* evidence that the mark has become distinctive. *See* 15 U.S.C. § 1052(f). The presence of Applicant's mark for nearly two decades in the market has created a strong association in the minds of the relevant consuming public between the particular shade of blue and the goods and services provided under it. This long period of use renders the mark presumptively distinct as an indicator of source for Applicant's goods and services. It entitles Applicant to the statutory presumption of acquired distinctiveness under Section 2(f) of the Trademark Act. *Id.*

In addition to Applicant's use of the Blue Bottle Blue Mark in its cafés and other retail channels, Applicant has extensively used and promoted the Blue Bottle Blue Mark online, with over 364,000 followers on its Instagram page, 144,000 followers on its Facebook page, and over 68,000 followers on its Twitter page. (See, Young Declaration).

Applicant submits that the foregoing evidence clearly establishes that its mark is strong and is uniquely associated with Applicant and its services. As such, the Blue Bottle Blue Mark has acquired distinctiveness sufficient to merit its registration.

III. Amendment of the Description of the Mark

In accordance with the Examining Attorney's request, Applicant amends the Color Claim and description of the Mark to the following:

The color blue (Pantone 2995 C) is claimed as a feature of the mark.

The mark consists of the color blue (Pantone 2995 C) as used on signage for the services. The dotted lines representing the sign are not claimed as part of the mark and serves only to show the position or placement of the mark.

IV. Response to the Examining Attorney's Inquiries

In response to the Examining Attorney's inquiries, Applicant responds as follows:

(1) An explanation as to whether the identified color(s) serve(s) any purpose as used on the sign for the services

In response to this request, Applicant states that the Blue Bottle Blue Mark does not serve any functional or utilitarian purpose as used on the sign for the services.

(2) Any available advertising, promotional or explanatory literature concerning the goods, particularly any material that relates specifically to the applied-for color mark

In response to this request, Applicant directs the Examining Attorney's attention to the Young Declaration, which provides information and examples of its advertising and promotion of the goods and services, including those which specifically relate to the Blue Bottle Blue Mark.

(3) An explanation as to whether any statutes, regulations, ordinances, codes or industry standards require, regulate and/or standardize the use of the identified color(s) on the sign for the services

In response to this request, Applicant states that no statutes, regulations, ordinances, codes, or industry standards require, regulate, or standardize the use of any color on the services covered by the Application.

(4) An explanation as to the use of the identified color(s) in applicant's industry and any other similar use of color in applicant's industry

In response to this request, Applicant states that it is not the industry standard to use the Blue Bottle Blue Mark in Applicant's industry. Applicant is known as a major player in the third-wave coffee movement and none of the other top brands within the third-wave coffee companies incorporate a light blue color scheme in their logo. For example, Applicant calls to the Examining Attorney's attention the infographic shown below, from a *Business Insider* article

(Exhibit A), which shows the top brands in the third-wave coffee space.



As can be seen, the Applicant is the only one in this list that features a blue color scheme.

(5) An explanation describing any other similar use of color by applicant

In response to this request, Applicant directs the Examiner Attorney's attention to paragraphs 7-8 of the Young Declaration, which discuss other uses of Applicant's color.

(6) Color photographs and color advertisements showing competitive goods in applicant's industry.

In response to this request, Applicant directs the Examining Attorney's attention to **Exhibit A**, discussed above, which lists the top brands in the industry. Additionally, Applicant directs the Examining Attorney's attention to **Exhibit B**, listing other brands within the third wave of coffee brands. As can be seen, the Applicant is the only one that features a light blue color scheme.

V. Amendment of Class 43 Services

Applicant hereby amends the services in Class 43 as follows (in **red**):

Class 43: Cafe, coffee shop, coffee bar, coffee house, and snack-bar services; coffee supply services **for offices in the nature of provision of beverages**; restaurant services

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VI. Conclusion

Having addressed all of the issues raised in the Office Action, Applicant respectfully requests that its mark be passed to publication.

Dated: December 20, 2019

Respectfully submitted,

**KILPATRICK TOWNSEND &
STOCKTON LLP**

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EXHIBIT A



7 popular third-wave coffee brands you can buy online — including Stumptown, Blue Bottle, and Intelligentsia Coffee

Connie Chen Nov 9, 2018, 8:38 PM



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Sightglass Coffee/Instagram

Whereas first wave coffee is characterized by increased accessibility and consumption, and second wave coffee by specialty flavors and the social experience of sitting down at a cafe (think: Starbucks), third wave coffee has forged the most meaningful relationship between customer and cup thus far.

Third wave coffee, which took off during the mid-90s to early 2000s, means that roasters focus on transparency, seasonality, and customer experience. Fair and direct trade practices are central to the business, and customers can learn exactly where their beans came from and how growing partners and farmers are treated. The devotion to the craft and ritual of coffee is clear from the moment you walk through the doors of the beautifully designed coffee shop, and though your cup of joe is expensive, you have to admit — you can taste the difference.

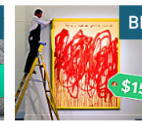
More often than not, these third wave coffee shops in San Francisco, Portland, New York City, and other major hubs aren't casual pit stops on the way to another destination. They are the final destination, and coffee lovers can't imagine a more exciting pilgrimage than the trek to obtain this specialty coffee.

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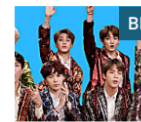
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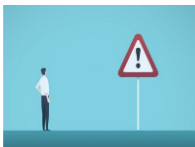
by Taboola



While visiting the coffee shop is the best way to enjoy its blends, the next best option if there's no location near you or you want to make it yourself at home is to find it online. Knowing that bags from these coffee roasters are stocked in your pantry, you'll wake up eager to start your morning routine.

Check out our guide to gifts for coffee lovers here.

Shop the following third wave coffee brands online:



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Intelligentsia Coffee



Intelligentsia Coffee/Instagram

Shop Intelligentsia coffee here: [Amazon](#), [Target](#)

The Chicago-based Intelligentsia says it's the first specialty coffee company to adopt Direct Trade practices, meaning it collaborates directly with the coffee grower, the grower must commit to sustainable environmental and social practices, and growers are paid at least 25% above Fair Trade price. Its sweet and syrupy Black Cat Project Espresso is a flavorful standout.

Blue Bottle



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Blue Bottle Coffee/Instagram

Shop Blue Bottle coffee here: [Blue Bottle](#), [Target](#), [Jet](#)

In 2017, Nestlé took a majority stake in this Silicon Valley favorite, which had raised \$117 million in funding. It sells single-origin whole bean and ground coffee at their peak freshness, which you can order by the bag, or have delivered to you automatically through its subscription option.

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Philz Coffee



Philz Coffee/Instagram

Shop Philz Coffee here: [Amazon](#)

Philz is being called the next Blue Bottle, having raised \$75 million to continue its dominance in the Bay Area and expand beyond. The quirky shop offers a wide range of blends, and its Mint Mojito Iced Coffee has inspired many an internet copycat recipe. Based on how packed its cafes always are, it's clear that loyal customers appreciate its creative coffee and complex flavors.

Stumptown





Stumptown Coffee Roasters/Instagram

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Shop Stumptown coffee here: [Amazon](#), [Target](#)

If you're visiting Portland, make sure to stop by Direct Trade coffee purveyor Stumptown. It boasts a distinct vision that has "always been a little left-of-center," from its extreme attention to detail to the way it treats its customers and coffee farmers. Stumptown's first and most popular blend is the Hair Bender, made up of beans from Indonesia, Latin America, and Africa.

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La Colombe



La Colombe

Shop La Colombe coffee here: [Amazon](#), [Target](#)

Founded on the premise that "America Deserves Better Coffee," this Philadelphia roaster is always innovating in the coffee space. It's hard not to walk around and spot one of its cans of creamy Draft

Latte in someone's hand. The cold-pressed espresso is combined with lactose-free milk, and there's no added sugar, so you get a healthier coffee fix.

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Counter Culture



Counter Culture Coffee/Instagram

Shop Counter Culture coffee here: [Amazon](#)

The mid-'90s were a great time, particularly for those who got to experience the beginnings of Counter Culture Coffee in Durham, North Carolina. Its delicious coffee comes from sustainable farms around the world, and the company has developed multiple programs and initiatives to maintain standards of sustainability. Take advantage of its limited-release blends for the best seasonal experience.

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Sightglass





Sightglass Coffee/Instagram

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Shop Sightglass coffee here: [Amazon](#)

One of the newer entrants to the third-wave coffee club opened its full coffeehouse in San Francisco in 2011, but the founders have been working in coffee since their teens. Find this high-quality coffee in Bay Area institutions like SFMOMA, or get enjoy blends like the heavy, chocolate-y Banner Dark Blend every morning at home.

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EXHIBIT B

The Best Third Wave Coffee Packaging: Intelligentsia, Blue Bottle, Stumptown & More



If you're an avid coffee drinker, graduating beyond the burnt, over-roasted Starbucks on the corner, you may have heard about the third wave of coffee. This is a trend or movement to produce the highest quality coffee, where coffee is seen as artisanal, like fine wine and cheese, rather than the commodity that makes it's way into most cups around the world.

Third wave coffee is a complex world where roasters and brewers alike pay micro-attention to the details. Any one individual cup may be heavily influenced by amount of coffee, ground type, water temperature, brewing method, filter type and even where you pour the water into the grounds.

Along with this attention to detail comes packaging to match. Below, I break down the packaging for five third wave coffee companies and show who does it the best.

The reviewed companies are (in no particular order):

1. Intelligentsia Coffee
2. Stumptown Coffee
3. Blue Bottle Coffee
4. Portola Coffee Roasters
5. Groundwork

Outside Packaging



All coffees ordered were 12 ounces / 340 grams. This is a standard size, so the boxes should ideally match, holding the coffee inside nice and snug for the journey from roaster to consumer. Outside-the-box branding is important too – the Amazon smile logo is a classic exercise in brand building.




Stumptown, Blue Bottle and Groundwork all had good fitting boxes. Intelligentsia and Portola were too big, particularly the former, with no packaging to prevent the bag from sliding all around inside.

Portola loses points for having no branding whatsoever on the outside of the box. Intelligentsia, Stumptown and Blue Bottle all have printed branding on the outside, while Groundwork uses a couple large stamps to brand the box.

When comparing Stumptown and Blue Bottle



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For the reasons points for having no branding whatsoever on the outside of the box. Intelligentsia, Stumptown and Blue Bottle all have printed branding on the outside, while Groundwork uses a couple large stamps to brand the box.

Winners: Stumptown and Blue Bottle

Inside Packaging



INTELLIGENTISIA



STUMPTOWN



BLUE BOTTLE



PORTOLA



GROUNDWORK

What happens when you first open the box? How are you greeted? Does it set the stage for an epic coffee experience? Done right, this creates delight.

Intelligentsia was underwhelming – a bag floating around the box with a packing list, nothing else. Stumptown excelled – an inside box acting as a drawer, holding a bag with an inserted detail card. Blue Bottle also did it right, with an elegant box fold and inside printing, including the URL. Portola was similar to Intelligentsia – just a bag, and not even a packing slip.

Groundwork had the most unfortunate packaging – the seam of the box meets right at the heart of the bag – in my case, the scissors used to slice open the box also sliced right through the bag! My concern approached Matt-Damon-in-The-Martian level. Good thing I was able to immediately transfer that coffee into an airtight container, since the bag was immediately compromised with beans spilling out.

Winners: Stumptown and Blue Bottle

The Bag



INTELLIGENTISIA



STUMPTOWN



BLUE BOTTLE



PORTOLA



GROUNDWORK

The bag that actually holds the coffee is so personal to the coffee experience. It might contain information on the company, brewing methods and the coffee itself. Some of this is printed or augmented with stickers and detail cards.

First of all – the technical components of the bag:

Brand	Roast Date	Lot Number	Resealable	Degassing Valve
Intelligentsia	Yes – 3/10/16	Yes	Plastic Zip Seal	Yes
Stumptown	Yes – 3/9/16	No	Folding Tabs	No
Blue Bottle	Yes – 3/10/16	No	Plastic Zip Seal	Yes
Portola Coffee Roasters	Yes – 3/9/16	No	Plastic Zip Seal	Yes
Groundwork	Yes – 3/9/16	Yes	Folding Tabs	Yes



Brand	Yes - 3/9/16	No	Plastic Zip Seal	Yes
Portola Coffee Roasters	Yes - 3/9/16	No	Plastic Zip Seal	Yes
Groundwork	Yes - 3/9/16	Yes	Folding Tabs	Yes

Intelligentsia and Groundwork are clearly the most artful – well-aligned stickers, good supporting information, and a design that just works. Stumptown has a clever plastic lined pouch to hold a description card, but I'd like to see the specific coffee name on the actual bag itself, and without a good seal and degasser, it has to be transferred almost immediately. Blue Bottle lacked information but the accompanying card is an absolute joy. Portola doesn't have much of anything on their bag.

Winner: Intelligentsia and Groundwork (although the latter needs to protect their bag)

Description

Given that some of these coffees are single source and others are blends, we're comparing apples and oranges with notes of bourbon, toffee and pomegranate. That said, good descriptions show passion for the product and help create a bond between consumer and brand. Following are the verbatim descriptions that accompanied each of the coffees.

I love Intelligentsia's commitment to coffee all the way down to the individual grower – the guy that is actually picking beans at the finca. Blue Bottle's description is whimsical and creative, while Groundwork is quite comprehensive given it's a blend. Portola, again, could do much better.

INTELLIGENTSIA

Colombia – Tres Santos – Direct Trade

Whole Bean – 12oz / 340g – Roasted 3/10

Cultivated in Cauca by our good friends at Finca Santuario, this edition of Tres Santos is wonderfully fragrant and balanced. We taste flavors of sweet dates and cocoa throughout, along with a clean Navel orange and cranberry finish.

Harvested by Finca Santuario / Camilo Merizalde, July-September 2015

STUMPTOWN

Holler Mountain Organic Coffee

Whole Bean – 12oz / 340g – Roasted 3/9

This popular organic offering rotates peak condition Latin American and East African coffees to maintain a balanced, elegant and consistent profile.

Tasting Notes: Citrus zest, hazelnut, caramel

BLUE BOTTLE

Three Africans

Certified Organic

Whole Bean – 12oz / 340g – Roasted 3/10

Details: Three Africans is generally a blend of Ugandan and two different Ethiopian coffees, which rotate seasonally. It yields a fruity yet accessible drip coffee, with plenty of body and a clean aftertaste.

Digression: We like to think of Three Africans' two Ethiopian components – one wet-processed, one dry-processed – as a pair of adventurous twins: rosy-cheeked, scrape-kneed, always a moment away from a romp in the mud. The ultra-balanced Ugandan, meanwhile, is a dutiful parent: loving but firm, ensuring nothing spirals out of control.

Deliciousness: Fruity, radiant, creamy

PORTOLA COFFEE ROASTERS

Alchemistic

12oz / 340g – Roasted 3/9

This coffee is a rich, full-bodied blend of seasonal offerings.

GROUNDWORK

Single Origin Limited Reserve

Rwanda Coolac Kabrizi Washing Station, Light Roast

Fair Trade, Certified Organic

Whole Bean – 12oz / 340g – Roasted 3/9

Bright and complex with a blood orange-like acidity and notes of grenadine, Darjeeling tea, and dark chocolate.

The Winner



The Winner

Intelligentsia and Groundwork both need to box up their artful bags better. Stumptown could use a better sealed bag to protect freshness. Portola roasts and brews a great cup of coffee, but packaging trails far behind. Blue Bottle shows great thought in how they package up and ship their coffee, and this sets them apart.

Winner: Blue Bottle

This comparison was conducted in March, 2016. As companies frequently change packaging and presentation, the information contained above is subject to change. Specialty roasters are welcome to send a bag to us - address is on the [contact page](#).

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Juan Valdez

MARCH 15, 2016 AT 6:52 PM

As someone in the industry for some time, I have received my fair share of coffee orders. However, seeing a comprehensive collection of current packaging trends - curated by a narrator that's obviously interested in coffee - was a delight filled with actionable intelligence 😊

We focus so much on the coffee flavor that the experience of receiving a gift(!) is often lost. As with a hand written letter, receiving a product that is packed with care and attention (but hey, good branding too, am I right) is also important. Good read.

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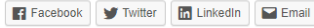
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