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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE

APPLICATION OF

COMPAÑIA DE LICORES
INTERNACIONALES, S.A.

Filing Date 10/25/1995

Mark : Old Havana

Serial Number 75010230



06-23-2003

U.S. Patent & TMOic/TM Mail Rpt Dt. #22

APPEAL BRIEF

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

COMES NOW, Applicant, **COMPAÑIA DE LICORES INTERNACIONALES, S.A.** (hereinafter CLI or Applicant), through its undersigned counsel, and respectfully submits its Appeal Brief:

1. Applicant filed its Application for Registration of the mark Old Havana on October 25, 1995 in the United States Patent and Trademark Office.
2. On August 7, 2001, an Office Action was mailed refusing registration of the mark under Trademark Act Section 2(e)(3) as a primarily geographically deceptively misdescriptive mark.
3. Applicant timely filed a response to this action on January 30, 2002.
4. On October 25, 2002, a final action was issued refusing registration of the mark Old Havana under Trademark Act §2(e)(3).

5. Pursuant to 37 C.F.R. §2.64(a) (now §2.142(a)), Applicant filed a Notice of Appeal to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration of the mark Old Havana.

6. Said notice of appeal was acknowledged by the Trademark Trial and Appeal Board on May 20, 2003.

7. Applicant hereby files its Appeal Brief within 60 days pursuant to 37 C.F.R. §2.142(b)(1).

8. The registration of the mark Old Havana was refused under Trademark Act § 2(e)(3), 15 U.S.C. §1052 (e)(3). Said section provides as follows:

"No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(e) Consists of a mark which, ... (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them"

9. It is Applicant's position that the mark Old Havana is not primarily geographically deceptively misdescriptive of the goods of Applicant.

10. In order for a registration to be properly refused under Section 2(e)(3), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public; and that (ii) purchasers are likely

to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark. See *In Re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982).

11. The mark "Old Havana" contains the word Havana, which is a name of a city in Cuba. It is conceded that said word is city of Cuba; however, the mark contains other words, specifically the word "Old" and as such it must be looked at as a whole, as "Old Havana". The term Old Havana does not refer to any particular location in Cuba.

12. Applicant's designation of its rum with the mark "Old Havana" therefore constitutes an arbitrary use. The brand suggests a product originating in the Caribbean and not necessarily only in Cuba. The mark suggests an old, prestigious rum of proven superior quality.

13. Furthermore, rum is not particularly distinctive only from Cuba. More so, when we take into consideration that the embargo imposed on Cuba has eliminated the possibility for Cuban rum to enter the United States; thereby eliminating Americans' access to the full market of Cuban alcoholic beverages. Given this situation, consumers have not developed an association with rum and Cuba, so as to bar registration of the mark.

14. The mark Old Havana has a distinctive Caribbean and tropical taste to it. Although Havana is a city in Cuba, it is important to note that most, if not all, Americans are aware of the restrictions not only to enter Cuba but to purchase any goods originating in Cuba. It is widely known of the prohibition to import any

goods from Cuba; therefore, the possibility of confusion in consumers' minds as to the origin of the particular mark is not probable with regards to Old Havana.

15. Use of the name of a geographical location as a mark does not, by itself, amount to deception, disparagement, or false connection. The test for deceptive misdescriptiveness has two parts: first, it must be determined whether the matter sought to be registered misdescribes the goods or services; second, it must be determined whether anyone is likely to believe the misrepresentation.

16. Applicant's position is that the mark Old Havana does not misdescribe the goods to be registered. The label does not in any manner indicate the rum is originated in Cuba. In fact, the label indicates the rum is a product from the USA. The wording is in the English language. The label specifically indicates the company which distributes the rum as a company from Lake Alfred, Florida.

17. In addition, it is to be expected that an ordinary American consumer, when purchasing a brand, reads the label to see for example who produces it, the percentage of alcohol, the place where it comes from. Therefore, a label, such as the one in question, which specifically describes the origin of the rum, cannot be misdescriptive as the Trademark Office suggests.

18. The mark Old Havana does not induce consumers to believe that the rum is originated in Cuba. On this line, even though, as stated above, Applicant's position is that Cuba is not exclusively, nor primarily known for its rum, let us assume it is for the sake of argument. The fact that Cuba might be noted for rum, in and of itself, does not support a refusal to register under section

2(e)(3) of the Trademark Act. An inquiry must be made regarding whether the name is likely to mislead consumers to believe that the geographic origin of the product is Cuba.

19. In this case, given the current situation with Cuba where no products may enter the United States, there is no possibility to purchase products originating in Cuba in the United States, and Americans citizens are not allowed to travel from the U.S. to Cuba, it is highly improbable that consumers will be misled by the name.

20. When the mark is analyzed, it is important to take into consideration the totality of circumstances surrounding the mark, including the label. Moreover, when we consider that when consumers acquire the rum, they do so after evaluating the label.

21. The label of Old Havana contains 10 lines:
1. Old
 2. Havana
 3. Brand
 4. Cuban Style
 5. Rum
 6. With Natural Flavor
 7. 35% Alc. Vol. (70 Proof)
 8. Produced and Bottled By
 9. Compañía de Licores Internacionales, S.A.
 10. Lake Alfred, FI – Product of USA

22. The label mentions the words Cuban and Havana once. These are the only references to Cuba. The rest of the label clearly describes the rum as a product of the USA. The label contains the wording: "PRODUCED AND BOTTLED BY Compañía de Licores Internacionales S.A., LAKE ALFRED, FL. PRODUCT OF USA". See Exhibit 1, Label of mark Old Havana.

23. The logo on the label, together with the words Cuban and Havana, may be interpreted as referring to the old colonization times when Spaniards discovered the Caribbean and fortifications were built.

24. If the mark is evaluated from the perspective of the consumer, without any knowledge of the applicable law, we would need to conclude that the ordinary consumer would have no doubt in his or her mind that the purchased rum is neither produced nor bottled in Cuba.

25. It is argued by the Patent and Trademark Office that the trade embargo imposed on Cuba has no bearing on the consumers' association of the goods with Cuba. This interpretation is grounded on speculation. The boycott of goods between Cuba and the United States is widely known. In fact, every day there is a particular news item pertaining to Cuba.

26. There have been movies made regarding this situation, regarding the Cuban missile crisis, and other aspects portraying the situation with Cuba. Furthermore, in the American media there is no mention or advertising of products originating in Cuba.

27. To argue that ordinary consumers might conclude that if Old Havana is sold in the United States it must be because there is some sort of an agreement between a business in the United States and one in Cuba is to give too much credit to the associations made by consumers. The ordinary consumer associates a brand with a particular taste, a quality, a style or a producer. The ordinary consumer is not wondering about the business relationship between the producer and the United States.

28. On the same line, the argument that American tourists who go to Europe and purchase rum made in Havana there, would be more knowledgeable about Havana rum trade and more readily understand the rum industry in Havana, is speculative. It is ingenuous to believe that a distinguishable, or even noticeable aspect of Europe for an American tourist would be a brand of alcohol originating in Cuba. From the universe of American tourists who go to Europe, a small percentage is involved in drinking rather than sightseeing. Of this small percentage, a smaller percentage purchases Cuban brands. It is naïve to conclude that from this limited exposure, American citizens would associate Cuba with Old Havana rum.

29. In the alternative it is considered that the mark is primarily geographically deceptively misdescriptive of rum, Applicant's position is that the mark Old Havana has acquired a secondary meaning. Therefore, it must be registered pursuant to the Trademark Act, section 2(f).

30. Section 2(f) of the Trademark Act provides, in its relevant portion;

"(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act."

31. Since 1991 a label application was made (see Exhibit 2), and the Treasury Department Bureau of Alcohol, Tobacco and Firearms granted its use, thus establishing Applicant's prima facie intention of use since then. Subsequently, a first use of the mark in commerce in the U.S. was effected on November 27, 1991 and continues its use to the present. See Exhibit 3.

32. Applicant's usage of said trademark extends to several countries in this hemisphere, and trademark registrations have already been obtained in such important countries as Mexico and Brasil.

33. In the European continent, usage also has been in progress and trademark registrations already obtained in the Benelux countries (Belgium, Netherlands and Luxembourg) and usage and application for trademark registration are in progress for other European countries, such as Spain.

34. Old Havana has been sold in the United States by Applicant for more than 10 years, since 1991 with the same label of mark Old Havana. See Exhibits 1 and 2. Given the amount of time the mark has been on the market, consumers have come to recognize the brand and associate it as a USA product. The mark Old Havana has come to be viewed by consumers as a symbol of quality rum, with a distinctive Caribbean taste.

35. The set of circumstances previously described make it more probable than not, that consumers have come to associate the name "Old Havana" with its American producer; thereby rendering the mark susceptible of registration.

36. Based on the above, it is Applicant's position that consumers do not make a goods/place association of Applicant's product with Cuba. Therefore, the mark "Old Havana" is not misdescriptive and/or deceptive. In the alternative, the mark has become distinctive of the quality rum produced by Applicant, rendering it susceptible of registration.

WHEREFORE, it is hereby requested from the Trademark Trial and Appeal Board that it REVERSE Final Action dated October 25, 2002 refusing registration of the mark Old Havana, Serial Number 75010230 and that the Application for Registration filed by Compañía de Licores Internacionales, S.A. for the mark Old Havana for rum, class 33, be allowed to enter the Principal Register.

CERTIFICATE OF MAILING

I hereby certify that this Appeal Brief is being deposited with Federal Express service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202 with a mailing label with tracking number 8406 3838 8506 on the 20th day of June, 2003.

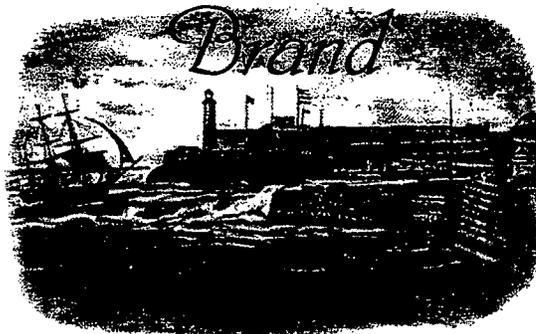
I further certify that a copy of this Appeal Brief has been sent to the Examining Attorney, David C. Reihner, Law Office 107, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

In San Juan, Puerto Rico, this 20th day of June, 2003.

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PEDRO J. CRUZ SOTO
Attorney for Applicant

Old
HAVANA



Cuban Style
Rum

With Natural Flavor
35% Alc. Vol. (70 Proof)

PRODUCED AND BOTTLED BY
Compañía de Licores Internacionales S.A.
LAKE ALFRED, FL • PRODUCT OF USA

DEPARTMENT OF THE TREASURY - BUREAU OF ALCOHOL, TOBACCO AND FIREARMS
APPLICATION FOR LABEL CERTIFICATION/EXEMPTION OF LIQUOR/BOTTLE APPROVAL
 (See Instructions and Paperwork Reduction Act Notices on Back)

PART I - APPLICATION

EXHIBIT 2

FOR ATF USE ONLY

3. NAME AND ADDRESS AND PLANT REGISTRY NO. OR BASIC PERMIT NO. OF APPLICANT

000006912410

TODHUNTER INTERNATIONAL, INC.
 DBA/Compania De Licores Internacionales S.A.
 530 Dakota Avenue
 P. O. Box 1447
 Lake Alfred, FL 33850

CT 649 OR 76 AP

1. VENDOR CODE (Required) 9016 2. SERIAL NO. (Required) 91-049

5. BRAND NAME (Required) OLD HAVANA

6. CLASS AND TYPE (Required) Distilled Spirits Specialty

DSP-FLA-1

7. FANCIFUL NAME (If Any)

4. TYPE OF APPLICATION (Check Applicable Box)

8. VINTAGE (Wine Only)

- a. CERTIFICATE OF LABEL APPROVAL
 b. CERTIFICATE OF EXEMPTION FROM LABEL APPROVAL "FOR SALE IN _____ ONLY"
 (Fill in State abbreviation)
 c. DISTINCTIVE LIQUOR BOTTLE APPROVAL
 TOTAL BOTTLE CAPACITY BEFORE CLOSURE _____ (Fill in amount)

10. FORMULA NO. (If Any) 131 11. LAB. ANALYSIS NO.

12. STATE ANY WORDING, NOT SHOWN ON LABELS (Caps, celloseals, etc.)

NET CONTENTS BLOWN INTO BOTTLE SIZE: 750ml

PART II - APPLICANT'S CERTIFICATION

The applicant hereby declares under the penalties of perjury that to the best of his/her knowledge and belief all statements appearing in the above application are true and correct and the representations of the labels and in the supplemental documents truly and correctly represent the contents of the containers to which such labels will be applied. Additionally, the applicant for exemption from label approval further certifies that the product will be exclusively disposed of in the State shown in Item 4b. and that each container will bear the legend "For Sale in (State shown in Item 4b.) only".

13. DATE OF APPLICATION
6/26/91

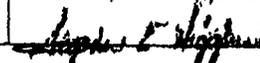
14. SIGNATURE OF APPLICANT OR AUTHORIZED AGENT

ATTY-IN-FACT

PART III - ATF CERTIFICATE

This certificate is issued subject to applicable laws and regulations and conditions as set forth on the back of this form.

15. DATE ISSUED
JUN 26 1991

16. SIGNATURE OF DIRECTOR, BUREAU OF ALCOHOL, TOBACCO AND FIREARMS


FOR ATF USE ONLY

QUALIFICATIONS

TERMINATION DATE
 (If Any)

TRAIGHT BILL OF LADING—SHORT FORM—ORIGINAL—NOT NEGOTIABLE

RECEIVED, subject to the classifications and lawfully filed tariffs in effect on the date of issue of this Bill of Lading.
 The property described below, in apparent good order, except as noted (contents and condition of contents of packages unknown), marked, consigned and destined as indicated below, which said carrier (the word carrier being understood throughout this contract meaning any person or corporation in possession of the property under the contract) agrees to carry to its usual place of delivery at said destination, if on its route, otherwise to deliver to another carrier on the route to said destination. It is mutually agreed, that each carrier of all or any of said property over all or any portion of said route to destination, and as to each party at any time interested in all or any of said property, that every service to be performed hereunder shall be subject to all the terms and conditions of the Uniform Domestic Straight Bill of Lading set forth (1) in Uniform Freight Classification in effect on the date hereof, if this is a rail or a rail-water shipment, or (2) in the applicable motor carrier classification or tariff if this is a motor carrier shipment. The shipper hereby certifies that he is familiar with all the terms and conditions of the said bill of lading, set forth in the classification or tariff which governs the transportation of this shipment, and the said terms and conditions are hereby agreed by the shipper and accepted for himself and his assigns.

DESIGNATE WITH AN (X)
BY TRUCK **FREIGHT**

FLORIDA DISTILLERS COMPANY
 P. O. Box 1447 • Lake Alfred, FL 33850
 AUBURNDALE PLANT

DATE 11/27 19 91 SHIPPER'S NO. 888

CARRIER BY ROUTE CAROLINA DELIVERING CARRIER

MULLEN & GUNN, INC.
 555 YOUNG STREET
 TONAWANDA, N.Y. 14150

CAR OR VEHICLE INITIALS & NO. # 250376

NO. OF PACKAGES	HM	DESCRIPTION OF ARTICLES, SPECIAL MARKS AND EXCEPTIONS	WEIGHT (SUBJECT TO CORR.)	CLASS OR RATE
0	CS	LIQUOR	325	LBS
<div style="border: 2px solid black; padding: 5px; display: inline-block;"> CAROLINA LKL 3160170929 </div>				
PALLET(S): /				

Subject to Section 7 of Conditions of applicable bill of lading, if this shipment is to be delivered to the consignee without recourse on the consignee, the consignee shall sign the following statement:
 The carrier shall not make delivery of this shipment without payment of freight and all other lawful charges.
 Per _____
 (Signature of Consignor)
 If charges are to be prepaid, write or stamp here, "To be Prepaid."
PREPAID
 Received \$ _____
 to apply in prepayment of the charges on the property described hereon.
 Agent or Cashier: _____
 Per _____
 (The signature here acknowledges only the amount prepaid).
 Charges Advanced: \$ _____

Transporting hazardous materials include the technical or chemical name for N.O.S. (not otherwise specified) or generic description of material with UN or NA number as defined in US DOT Emergency Response Communication Standard (HM-125C). Provide emergency response phone number in case of incident or accident. (In box at right)
 EMERGENCY RESPONSE PHONE NO

INS CERTIFICATION: This is to certify that the above-named materials are properly classified, described, packaged, marked and labeled, and are in proper condition for transportation according to the applicable regulations of the Department of Transportation.
 SIGNATURE *Patty McElroy*

When shipment moves between two ports by a carrier by water, the law requires that the bill of lading shall state whether it is "carrier's or shipper's weight." Where the rate is dependent on value, shippers are required to state specifically in writing the agreed or declared value of the property. If the agreed or declared value of the property is hereby specifically stated by the shipper to be not exceeding _____

THIS SHIPMENT IS CORRECTLY DESCRIBED. The above boxes used for this shipment conform to the specifications set forth in the box makers certificate thereon, and all other requirements of the Consolidated Freight Classification.
 GROSS WEIGHT IS _____ LBS. Shipper

RIDA DISTILLERS COMPANY
 Box 1447 • Lake Alfred, FL 33850

Shipper, Per *(PM)* Agent, Per *CFCC* *(BMC)*

ment post-office address of shipper + MARK WITH "X" TO DESIGNATE HAZARDOUS MATERIAL AS DEFINED IN TITLE 49 OF FEDERAL REGI