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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re G&R Brands, LLC

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Serial No. 77011920

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Dana B. Robinson of Dana Robinson & Associates for G&R Brands, LLC.

Kathleen M. Vanston, Trademark Examining Attorney, Law Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Grendel, Taylor and Ritchie, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On October 2, 2006, applicant G&R Brands LLC filed an application under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), for registration of the mark MOJAVE in standard character form on the Principal Register for goods ultimately identified as "Absorbent paper for tobacco pipes; Asian long tobacco pipe sheaths; Asian long tobacco pipes (kiseru); Cigar bands; Cigar boxes not of precious

metal; Cigar cutters; Cigar humidifiers; Cigar tubes; Cigarette ash receptacles; Cigarette cases, not of precious metal; Cigarette holders, not of precious metal; Cigarette lighters not for land vehicles; Cigarette lighters not of precious metal; Cigarette papers; Cigarette rolling machines; Cigarette rolling papers; Cigarette tubes; Cigarettes; Cigarettes containing tobacco substitutes not for medical purposes; Cigars; Filter-tipped cigarettes; Hand-rolling tobacco; Hookahs; Lighters for smokers; Machines allowing smokers to make cigarettes by themselves; Mentholated pipes; Non-electric cigar lighters not of precious metal; Pipe pouches; Pipe tampers; Pipe tobacco; Pocket apparatus for rolling cigarettes; Pocket apparatus for self-rolling cigarettes; Pocket appliances for rolling one's own cigarettes; Roll your own tobacco; Smokeless tobacco; Smoking pipe cleaners; Smoking pipes; Smoking tobacco; Tobacco; Tobacco filters; Tobacco grinders; Tobacco pipe cleaners; Tobacco pipes; Tobacco pouches; Tobacco substitutes; Hookah pipes; charcoal for use with hookah pipes; and accessories related to tobacco and hookah pipes, namely, replacement stems, hookah hoses, hookah bases, tobacco bowls, charcoal tongs, plastic hose tips, hookah foil, wind covers, charcoal screens, flip caps, hose

plugs, base protectors, grommet sets, charcoal holders; Tobacco tins," in International Class 34.

The examining attorney refused registration of applicant's mark pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. 1052(a), on the ground that applicant's mark consists of or comprises matter which falsely suggests a connection with the Fort Mojave Indian Tribe of Arizona, California & Nevada, a federally-recognized Indian tribe.

Applicant has appealed the final refusal of its application. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Trademark Act Section 2(a) states, in relevant part,

> 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 - (a) consists of or comprises… matter which may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.

In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular

personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in *Notre Dame*, required that the following four elements be satisfied in order to establish a false suggestion of a connection under Trademark Act Section 2(a):

> (i) that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed.

Id. at 429.

In this ex parte proceeding, it is the Office which must establish the elements relating to the "plaintiff's" name, which is the name with which the examining attorney asserts the applicant's mark falsely suggests a connection. Accordingly, we examine the arguments and evidence submitted by applicant and the examining attorney for each of the four *Buffett* elements.

(i) The Office must prove that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity.

Applicant argues that its mark, consisting solely of the word "MOJAVE," is not "the same or a close approximation" of the much longer term Fort Mojave Indian Tribe of Arizona, California & Nevada. The examining attorney, however, argues that the tribe is also known as "Mojave," and that therefore applicant's mark is indeed the same or a close approximation of the name of the tribe. To support its argument, the examining attorney submitted dictionary definitions of the word "Mojave" as follows:

> "1. a) A Native American people inhabiting lands along the lower Colorado River on the Arizona-California border; b) a member of this people. 2. The Yuman language of the Mohave." *American Heritage Dictionary of the English Language* (3d ed. 1992).
>
> "1. A member of a North American Indian tribe belonging to the Yuman linguistic family, formerly located in the Colorado River Valley of Arizona and California. 2. Of or pertaining to the Mohave tribe." *Dictionary.com.*
>
> "1. Member of Native N. American People: A member of the Native North American people who lived along the Colorado River Valley on the border between California and Arizona. 2. Native N. American Language: The language of the Mohave people. It belongs to the Yuman branch of the Hokan-Siouan languages." *Encarta Dictionaries (Encarta.msn.com/dictionaries).*

To establish a 2(a) refusal, the examining attorney need not show that applicant's mark is the actual, legal name of the tribe. *See Buffett v. Chi-*

Chi's, 226 USPQ at 429 (holding MARGARITAVILLE for restaurant services to be the persona of singer Jimmy Buffett). The Board has held that "an applicant cannot take a significant element of the name of another and avoid a refusal by leaving one or more elements behind, provided that that which has been taken still would be unmistakably associated with the other person." *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006), *internal cites omitted* (holding that MOHAWK for cigarettes falsely suggested an association with the St. Regis Band of Mohawk Indians of New York). Dictionary evidence may be sufficient to establish the connection. *In re Cotter & Co.*, 228 USPQ 202, 204 (TTAB 1985) (holding that WESTPOINT for various firearms created a false association with the Westpoint military academy, based on dictionary definitions). The examining attorney here has also provided corroborating encyclopedic evidence from "Tiller's Guide to Indian Country: Economic Profiles of American Indian Reservations" (BowArrow Pub. 2005) and the Intertribal Council of Arizona (*itcaonline.com/tribes_mojave.html*), both referring to the tribe interchangeably by its full legal name, and simply as "Mojave." We find this evidence establishes

that "MOJAVE" is the same or a close approximation of the Fort Mojave Indian Tribe of Arizona, California & Nevada.

(ii) The Office must prove that the mark would be recognized as such.

As suggested by its legal name, the federally-designated reservation of the Fort Mojave Indian Tribe of Arizona, California, and Nevada encompasses portions of each of those three states. (*Tiller* at 412). Accordingly, it is not surprising that areas within and adjacent to the reservation in the three states bear the name "Mojave." Among these, as applicant points out, are the Mojave Desert; the Mojave Valley; the Mojave River; Mojave County, Arizona; and Mojave, California. However, this does not lead us to the conclusion, as applicant suggests it should, that the term "MOJAVE" therefore would not be recognized as referring to the Mojave tribe. *See University of Notre Dame, du Lac v. J.C. Gourmet Food Imports Co.*, 217 USPQ at 509 (finding that NOTRE DAME for cheese did not unmistakably point to the University of Notre Dame where other famous uses of the term co-existed).

Rather, the examining attorney has submitted Wikipedia and other Internet evidence to show that these various geographical locations and places derive their names from the Mojave tribe. This is analogous to the situation in *In re White*, wherein the Board found that the various uses of the word "Mohawk" to identify a haircut, a ski resort, a college, two state forests, a hiking trail, and a military aircraft did not detract from the public's recognition of the term as referring to the Mohawk tribe, since all of these seemingly unrelated uses were either "named after" or at least "do not detract from the association" of the word "Mohawk" with the tribe. 80 USPQ2d at 1659. Accordingly, we find that applicant's "MOJAVE" mark would be recognized as referring to the Fort Mojave Indians of Arizona, California, and Nevada, also known as the Mojave tribe.

(iii) The Office must prove that the plaintiff is not connected with the activities performed by the defendant under the mark.

Applicant has admitted to having no connection with the Fort Mojave Indian Tribe of Arizona, California, and Nevada. *Applicant's Response to OA, 6/6/07.*

(iv) The Office must prove that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed.

The examining attorney has submitted three types of evidence to show the fame of the Mojave tribe. First, as discussed above, the examining attorney submitted dictionary definitions from major dictionaries in general circulation, showing "Mojave" defined as the members of the Mojave tribe. Second, the examining attorney submitted evidence to show the continuing existence and physical presence of members of the Fort Mojave Indian Tribe of Arizona, California, and Nevada in the three states mentioned. *See for example Tiller* at 412-413. Finally, the examining attorney submitted evidence, as discussed below, to show the commercial impact of the Mojave tribe. *Id.*

Applicant disputes the fame of the Mojave tribe, arguing that the tribe is small and relatively unknown, not even being one of the 30 largest Indian tribes of North America. However, the evidence of record shows that the Mojave tribe employs 3,000 people and contributes approximately $250 million in

economic output along with over $140 million in income in the area. *See Tiller* at 413. Altogether, we find the evidence of record more than adequate to show that the Mojave tribe is well known among residents of the region and visitors to the area. *In re White,* 80 USPQ at 1661 (finding sufficient fame from evidence of dictionary definitions, physical presence, and commercial enterprises).

The examining attorney has also submitted three types of evidence to show that the relevant public perceives a connection between Indian tribes and tobacco-related products such as those identified in applicant's recital of goods. First, the examining attorney submitted articles and information from the Internet discussing tobacco-related products produced by Indian tribes. A sampling of this evidence includes the following excerpts:

> "We are your source for authentic Native American-made cigarettes . . . . Located on the Winnebago Reservation in northeast Nebraska, HCI Distribution serves clients from California to New York." *www.hcidistribution.com*.
> "We only sell the finest Native American made cigarettes and Native made tobacco products . . . . Our cigarettes contain only the purest Native made tobacco." *www.blackhawktobacco.com.*
> "All cigarettes offered by California Cigarettes are sold from the Aqua Caliente Indian Reservation . . . . All Native made tobacco products offered by California Cigarettes are

> sold by Native Americans to Native Americans and Non-Native Americans from the Sovereign Territory of the Aqua Caliente." *www.californiacigarette.com.*

Second, the examining attorney produced articles and information from the Internet discussing the benefits of buying tax-free tobacco and other products on Indian reservations. A sampling of this evidence includes the following excerpts:

> "The State of Arizona does not tax Indian lands and Indian-owned property on reservations. . . . Indian people are also exempt from state and local sales taxes on consumer products purchased on the reservation unless such taxes are imposed by the tribal government." *Fort Mojave Reservation Profile, prepared by the Arizona Dept. of Commerce.*

> "On the basis of tribal membership, each tribe has been allocated a maximum number of tax-exempt cigarettes that can be sold annually on a reservation to enrolled members of the tribe by an Indian tribe, an Indian retailer, or a federally-licensed Indian trader." *The University of Dayton School of Law*.

> "The tobacco deal, which is awaiting legislative approval, is designed to end the cat-and-mouse game between the Puyallup smoke shops and the state over the smuggling of untaxed cigarettes. Tribal smoke shops can make big money by selling black market cigarettes at cheaper prices than non-Indian retailers if they evade the $14.25 per carton excise tax." *Seattle Post*.

Finally, the examining attorney submitted evidence specifically showing a connection between the Mojave tribe and tobacco-related products. In

particular, the Mojave tribe operates a smoke shop. *See Fort Mojave Reservation Profile, prepared by the Arizona Dept. of Commerce.* Accordingly, we find that purchasers of applicant's identified goods would be aware of Native American manufacturing and marketing of Native American brand cigarettes, and, given the fame of its name, would think uniquely of the Mojave tribe when they see MOJAVE as a mark used on or in connection with those identified goods. *See In re White,* 80 USPQ at 1662.

Applicant submitted with its response to the first office action lists of live and dead third-party registrations containing the word "MOJAVE," "CHEROKEE," and other Indian tribe names, apparently to show how the names of Indian tribes have been registered for various goods, including tobacco-related products. The examining attorney objected to the lists in the final office action as an improper submission of third-party registrations. In order to make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office should be submitted. *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455, 1456 n. 2 (TTAB

1998); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). Merely listing such registrations, as applicant has done here, is insufficient to make them of record. *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n. 2 (TTAB 1998). Accordingly, we sustain the objection.

In sum, we find that the examining attorney has satisfied her burden in establishing the four factors relevant to the 2(a) refusal for false suggestion of a connection. First, applicant's mark, MOJAVE, is the same or a close approximation of the name of the Mojave tribe. Second, the mark would be recognized as such. Third, applicant is not connected with the activities performed by the Mojave tribe under the mark. Finally, the Mojave tribe is of sufficient fame or reputation that when applicant's mark is used on the identified goods, a connection with the Mojave tribe would be presumed.

DECISION: The refusal to register the mark under Section 2(a) of the Trademark Act is affirmed.