From: Reihner, David

Sent: 8/27/2014 1:12:33 PM

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Subject: U.S. TRADEMARK APPLICATION NO. 77129912 - GRAN HABANO - 130171.01010 - Request for Reconsideration Denied - Return to TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 77129912 **MARK:** GRAN HABANO	
CORRESPONDENT ADDRESS: STEVEN J. WADYKA, JR. GREENBERG TRAURIG, LLP 2101 L STREET, N.W., SUITE 1000 WASHINGTON, DC 20037	**GENERAL TRADEMARK INFORMATION:** http://www.uspto.gov/trademarks/index.jsp VIEW YOUR APPLICATION FILE
APPLICANT: SANTA CRUZ TOACCO CO., INC.	
CORRESPONDENT'S REFERENCE/DOCKET NO: 130171.01010 **CORRESPONDENT E-MAIL ADDRESS:** dcipmail@gtlaw.com	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/27/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated February 2, 2014 is maintained and continued to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

Refusal

Registration has been refused under Trademark Act § 2(e)(3) because GRAN HABANO is primarily geographically deceptively misdescriptive of cigars made from Cuban seed tobacco. Applicant presents two arguments asserting that the refusal to register is inappropriate.

Argument 1

Applicant contends that materiality, so that the mark would influence purchasers to buy applicant's cigars, has not been shown. Reliance upon the case of *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085 (TTAB, 2012) (GUANTANAMERA unregistrable for tobacco, namely, cigars), by the Examiner is misplaced. Applicant asserts that "there is no evidence of advertisements, webpages, testimony, magazines and cigar publications and encyclopedias that establish that sellers of cigars in the United States market non-Cuban cigars through branding and marketing associations with Cuba because they believe that consumers value associations with Cuba in making purchasing decisions" (Applicant's Request for Reconsideration, pg. 5, par. 2). To the contrary, the Board in the GUANTANAMERA case stated that "[t]he record … contains articles from various magazines, cigar publications and cigar encyclopedias which reflect that the cigar consumer values Cuban Tobacco and cigars." *Guantanamera*, supra, 1103. The material cited by the Board contained articles from cigarnexus.com, bloomberg.com, *Smoke*, *Cigar Aficionado*, and *Slate* magazines (which were all in the English language). Then the Board stated that "[f]rom the advertisements, webpages, testimony, magazines and cigar publications and encyclopedias, we find that opposer has established that **sellers of cigars in the United States** market non-Cuban cigars through branding and marketing associations with Cuba because they believe that consumers value associations with Cuba in making purchasing decisions." *Guantanamera*, supra, 1103-1104 (emphasis added). Correspondingly, the evidence appended to the Office actions in this application and the finding by the Board in GUANTANAMERA demonstrate that applicant's mark would be material in purchasers buying applicant's cigars.

Argument 2

Applicant contends that the purchasers of its cigars are not Spanish speakers and would not be materially influenced to purchase applicant's goods even though the word "habano" forms part of the mark. (Applicant's Request for Reconsideration, pg. 6, par. 2). Put another way, because the purchasers of applicant's cigars do not speak Spanish, the Spanish words forming the mark would not influence them to purchase applicant's goods. This contention is unpersuasive.

In the case of *In re Jonathan Drew Inc.*, 97 USPQ2d 1640 (TTAB, 2011), the designation KUBA KUBA for cigars and tobacco products was refused registration under Trademark Act § 2(e)(3). The Board stated that "[b]ecause KUBA looks and sounds similar to Cuba, with no other recognized and/or pertinent meaning attached to that particular spelling, we find that the primary significance of KUBA is the geographic meaning of Cuba." *Drew*, supra, 1644. Here, "Habano" looks and sounds similar to Havana and appears to be a derivation of the word. It is noted that an on-line search for the word "Habana" in The Columbia Gazetteer of the World website produces references to Havana. (Copy unavailable). As far as the word GRAN, it too appears to be a misspelling of another word, and that word is GRAND. Correspondingly, purchasers, who do not speak Spanish, would see GRAN HABANO and associate those words with the English language words "grand Havana" or "great Havana". Correspondingly, a substantial portion of the non-Spanish speaking portion of the United States population, who purchase cigars, would likely be deceived by applicant's mark into believing that the cigars come from Havana, Cuba, when they do not.

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/David C. Reihner/

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