

Hearing:
April 27, 2011

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
September 14, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cigars International, Inc.

Serial No. 77262426

Sean W. Dwyer, Timothy D. Pecsénye and David M. Perry of
Blank Rome LLP for Cigars International, Inc.

Evelyn Bradley, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Bucher, Grendel and Ritchie, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Cigars International, Inc. seeks registration on the
Principal Register of the mark **MEGA-SAMPLER** (*in standard
character format*) for "cigars" in International Class 34.¹

The Trademark Examining Attorney refused registration
on the ground that the term is merely descriptive under
Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§ 1052(e)(1). Applicant argued against this refusal, and
takes the position that, in the alternative, there is

¹ Application Serial No. 77262426 was filed on August 23, 2007
based upon applicant's claim of use anywhere and use in commerce
since at least as early as August 12, 2004.

sufficient evidence in the record to show that this term has acquired distinctiveness as a source indicator, under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board.

We reverse the refusal to register.

The Trademark Examining Attorney argues that the evidence of record demonstrates that the term "Mega-Sampler" is highly descriptive of applicant's goods inasmuch as applicant's packaged goods "feature a large selection of representative cigars." She argues that the term "mega sampler" is "widely used in the cigar industry in a descriptive manner in reference to cigars."

By contrast, applicant contends that its mark is suggestive, at worst, given the ambiguous nature of the "mega-" prefix. This ambiguity infects the combined term, applicant argues, and ensures that applicant's chosen designation does not describe generally an "immediate" characteristic or quality of any product, and hence, in this specific case, cannot deprive competitors of an apt description of cigars. Furthermore, applicant contends that most of the third-party uses singled out by the Trademark Examining Attorney are in actuality applicant's own uses. Moreover, applicant contends that if there is any doubt as

to the character of applicant's mark, the doubt must be resolved in favor of applicant.

Merely Descriptive under Section 2(e)(1)


A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys "knowledge of a quality, feature, function, or characteristic of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) [ASPIRINA is merely descriptive of analgesic product]. See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD are merely descriptive of applicant's "affinity" credit card services; a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]; *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) [THE ULTIMATE BIKE RACK is merely descriptive of bicycle racks]; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE is merely descriptive of a potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980) [QUIK-PRINT is merely descriptive of

"same day" services of printing, photocopying, collating, binding, cutting, drilling, folding, padding, stapling, and perforating]. To be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. *Gyulay*, 3 USPQ2d at 1009.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted) *In re Gyulay*, 3 USPQ2d at 1009; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

Hence, the ultimate question before us is whether the term **MEGA-SAMPLER** conveys information about a significant feature of applicant's goods with the immediacy and particularity required by the Trademark Act.

Background

In its specimen of record, applicant shows under its generic category of "Samplers," a menu selection known as Mega-Sampler™ (e.g., Home : Samplers : Mega-Sampler™), on a web page showing its house mark  , and where the bold heading on the page is **Mega-Sampler**, followed by a series of options such as "5 Vegas 'Double Nickel' Mega-Sampler." The record shows that many of applicant's various Mega-Sampler™ products are resold online by a wide variety of Internet retailers.

Analysis

The Trademark Examining Attorney has urged us to take judicial notice of dictionary entries for the terms "mega"² and "sampler." Applicant's own usage of the word "sampler" various places on its website demonstrates a highly descriptive usage of this word in the context of online marketing of collections of, for example, twenty cigars of five varieties drawn from among the hundreds of various cigars having differing brands and sizes. Similarly, screenprints from the websites of competitors confirm that

² **Mega-** combining form 1. large; 2. denoting a factor of one million (10⁶) -- ORIGIN from Greek *megas* 'great' Compact Oxford English Dictionary, <http://oxforddictionaries.com/>

Mega- prefix (BIG/GOOD)

INFORMAL: large in amount or size.

"sampler" is a frequently used term in this industry. However, the sole issue on which applicant and the Trademark Examining Attorney differ is whether the combined designation, MEGA-SAMPLER, as a whole, is merely descriptive.

With each office action, the Trademark Examining Attorney submitted screenprints showing uses of the term "Mega-Sampler" reflecting a variety of different websites of online retailers. On close examination, however, we find that most of the Internet evidence submitted by the Trademark Examining Attorney comprises references to applicant's usage of its adopted mark, MEGA-SAMPLER, rather than being merely descriptive uses by third parties:

- **GURKHA CLASS REGENT MEGA-SAMPLER** and **GURKHA LEGENDARY MEGA-SAMPLER** refer to cigars from applicant;³
- **CAO MEGA [CIGAR] SAMPLER** shows usage by a reseller who modified slightly applicant's claimed mark by inserting the word "Cigar" between the words "Mega" and "Sampler";⁴
- **MAN O'WAR**⁵ **MEGA-SAMPLER** reflects usage of applicant's mark in advertising by a reseller of applicant's cigars;⁶

³ www.bizrate.com/tobaccoproducts/ on July 16, 2008.

⁴ www.overstock.com/Gifts-Flowers/ on July 16, 2008.

⁵ Applicant's Registration No. 3327063.

⁶ <http://shopping.msn.com/> on July 16, 2008.

- **MONTECRISTO MEDIA NOCHE MEGA-SAMPLER** reflects usage of applicant's mark in advertising by a reseller of applicant's cigars;⁷
- **SOL CUBANO CUBAN MEGA-SAMPLER** reflects usage of applicant's mark in advertising by a reseller of applicant's cigars;⁸
- **SIGNATURE COLLECTION MEGA-SAMPLER** reflects appropriate links to applicant by a reseller of applicant's cigars;⁹
- **GREYCLIFF MEGA-SAMPLER** reflects promotion of a product originating with applicant;¹⁰
- **DOUBLE HAPPINESS MEGA-CAMPLER** reflects usage of applicant's mark in advertising by a reseller of applicant's cigars;¹¹
- **NON CUBAN CIGAR MEGA SAMPLER** of 25 hand-rolled cigars, with free Humidor, being promoted by Absolute Cigars, reflects a reseller of applicant's goods;¹²
- The Cigar Hut was marketing a "16 Tobacconist Series Mega Cigar Sampler" of **VICTOR SINCLAIR** cigars that appears to be derived from applicant's **VICTOR SINCLAIR MEGA-SAMPLER** (as seen elsewhere in the record on applicant's home page and catalogues);¹³
- **GREYCLIFF MEGA-SAMPLER** on a website owned by applicant and displaying one of applicant's cartoon logos;¹⁴

⁷ www.shopping.com/ on May 14, 2008.

⁸ <http://shopping.msn.com> on May 14, 2008.

⁹ www.mysimon.com, on May 14, 2008.

¹⁰ www.epinions.com/

¹¹ www.shopping.com/ on October 20, 2007.

¹² <http://www.absolutecigars.com/MegaSampler.html> on July 21, 2008.

¹³ <http://www.cigarsforless.com/16-cigar-tobacconist-series-mega-sampler-p-1693.html> on July 21, 2008.

¹⁴ www.cigarbid.com on May 14, 2008.

- **ALEC BRADLEY MEGA-SAMPLER** is another reference to applicant on the same website;¹⁵
- **PUROS INDIOS MEGA-SAMPLER, VICTOR SINCLAIR MEGA-SAMPLER** and **ROCKY PATEL MEGA-SAMPLER** reflects usage of applicant's mark in advertising by a reseller of applicant's cigars;¹⁶
- A blog of January 31, 2008, actually reflects a positive review of applicant's cigars;¹⁷
- As shown repeatedly in the record, the designations **CARLOS TORAÑO MEGA-SAMPLER** and **ROCKY PATEL DOUBLE MADURO MEGA-SAMPLER** appear on applicant's website and in its catalogues;¹⁸
- As also shown repeatedly in the record, the designation **INDIAN TABAC RETRO MEGA-SAMPLER** appears on applicant's website, in its catalogues, as well as on third-party online retail sites;¹⁹
- **CAO MEGA-SAMPLER, GRAYCLIFF MEGA-SAMPLER, TORANO MEGA-SAMPLER; INDIAN TABAC MEGA-SAMPLER, and CAMACHO MEGA-SAMPLER** all appear to reflect applicant's usage - although this website also contains usage of "Mega-Sampler" as a source indicator for cigars that are not clearly associated with applicant;²⁰

¹⁵ www.cigarbid.com on October 20, 2007.

¹⁶ www.bizrate.com/tobaccoproducts/ on October 20, 2007.

¹⁷ <http://torocigars.blogspot.com/2008/01/gran-habano-mega-sampler-20-cigars-only.html> on May and July of 2008.

¹⁸ www.cigarsinternational.com/

¹⁹ www.overstock.com/Gifts-Flowers/ on May 14, 2008; and www.bizrate.com/tobaccoproducts/ on October 20, 2007.

²⁰ www.AtlanticCigar.com/cigarcloseouts1.html. For example, applicant has not shown usage of combinations like **COHIBA MEGA-SAMPLER, DUNHILL MEGA-SAMPLER, HELIX MEGA-SAMPLER** and **LA FLOR DOMINICANA MEGA-SAMPLER**. Similarly, we cannot be sure of whether MEGA-SAMPLER used by V-CIGAR for products manufactured by "La Aurora" at <http://www.vcigar.com/megasampler-p-2345.html> on July 21, 2008, and **ARTURO FUENTE 15 Count MEGA SAMPLER** at

As pointed out by applicant, the record does reflect past usage of the term "Mega-Sampler" by two of applicant's direct competitors (Thompson Cigar and Corona Cigar). Applicant alleges that these represented improper usage of applicant's mark - misuses that applicant alleges in its briefs it continues to pursue. For example, Thompson used MEGA MEGA SAMPLER, MEGA SAMPLER III and MEGA 16 SAMPLER,²¹ while Corona used MEGA-SAMPLER and MEGA CIGAR SAMPLER.²²


Accordingly, we agree with applicant that the majority of the Trademark Examining Attorney's evidence reflects applicant's and its resellers' use of its adopted mark. Furthermore, where this is not clear, or where the usage clearly originated with one of two named competitors, even then it is used in the form of a source identifier, not in a merely descriptive manner.

Applicant also submitted for the record a sampling of third-party registrations in a variety of fields. Applicant acknowledges that while third-party registrations are not determinative of descriptiveness, the presence of the following "MEGA-" prefix marks registered on the Principal Register seems to reflect more than a dozen years of Office

<http://www.factorydirectcigars.com/> represent applicant's goods or a misuse of its claimed trademark.

²¹ <http://www.thompsoncigar.com/> and www.bizrate.com/tobaccoproducts/, both on May and July 2008.

practice apparently treating composite marks having a
"MEGA-" prefix as inherently distinctive:

MEGA LIGHTER	for "cigarette lighters, not of precious metal" in International Class 34; ²³
MEGA MATCH	for "barbecue lighter" in International Class 34; ²⁴
MEGA JERKY	for "meat snacks" in International Class 29; ²⁵
MEGA RACER	for "toy vehicles" in International Class 28; ²⁶
	for "carpets, rugs, mats and matting, linoleum for covering existing floors" in International Class 27; ²⁷
MegaWall	for "slatwall system, namely, slatwall display racks used to display merchandise and slatwall panels for displaying merchandise" in International Class 20; ²⁸
MEGA CLAMP	for "non-metal clamps, clasps, clips and cuffs for bundling of loose and continuous material, namely, cable, cord, extrusions, foliage, metal, paper, plastic, ropes,

²² <http://www.coronacigar.com/> on October 20, 2007 and May 14, 2008, and www.rancherocigars.net on October 20, 2007.

²³ Registration No. 2170964 issued on July 7, 1998; renewed. No claim is made to the exclusive right to use the word "Lighter" apart from the mark as shown.

²⁴ Registration No. 3039946 issued on January 10, 2006.

²⁵ Registration No. 3109316 issued on June 27, 2006. No claim is made to the exclusive right to use the word "Jerky" apart from the mark as shown.

²⁶ Registration No. 3111757 issued on July 4, 2006. No claim is made to the exclusive right to use the word "Racer" apart from the mark as shown.

²⁷ Registration No. 3143179 issued on September 12, 2006. No claim is made to the exclusive right to use the word "Carpets" apart from the mark as shown.

²⁸ Registration No. 3168572 issued on November 7, 2006.

	textiles, wire and wood" in International Class 20; ²⁹
MEGA EVENT	for "real estate auctions" in International Class 35; ³⁰
MEGA CUFF	for "non-metal clamps, clasps, clips and cuffs for bundling of loose and continuous material, namely, cable, cord, extrusions, foliage, metal, paper, plastic, ropes, textiles, wire and wood" in International Class 20; ³¹
Mega Search	for "providing customized on-line web pages featuring user-defined information in the field of travel and vacation planning, which includes search engines and online web links to other websites in order to create an online information service; computer services, namely, extraction and retrieval of information and data mining in the field of travel and vacation planning; computer services, namely, creating indexes of information, indexes of websites, and indexes of other information sources available on computer networks in the field of travel and vacation planning" in International Class 42; ³²
MEGAMinerals	for "body and beauty care cosmetics; cosmetic creams for skin care; cosmetic preparations for body care; cosmetics; cosmetics, namely, compacts; make-up kits comprised primarily of compacts and makeup brushes" in International Class 3; ³³

²⁹ Registration No. 3242922 issued on May 15, 2007. No claim is made to the exclusive right to use the word "Clamp" apart from the mark as shown.

³⁰ Registration No. 3247127 issued on May 29, 2007. No claim is made to the exclusive right to use the word "Event" apart from the mark as shown.

³¹ Registration No. 3248259 issued on May 29, 2007. No claim is made to the exclusive right to use the word "Cuff" apart from the mark as shown.

³² Registration No. 3253273 issued on June 19, 2007. No claim is made to the exclusive right to use the word "Search" apart from the mark as shown.

³³ Registration No. 3289030 issued on September 4, 2007.

MEGA STEP	for "vehicle accessory, namely side assist entry step" in International Class 12; ³⁴
MEGAPLUG	for "port hubs, adapters, and extenders for network and wireless communications" in International Class 9; ³⁵
COUNTRY MEGATICKET	for "promoting a variety of live entertainment events for others and merchandise related thereto via a global computer network, television, radio, billboards and printed matter; retail merchandise services, namely online retail store services featuring artist and tour-related merchandise and collectibles; promoting the goods and services of others through an online subscription service through which users can link to online retail services and internet service providers; promoting the goods and services of others in the fields of entertainment through the distribution of special offers via an online subscription service" in International Class 35; "ticket agency services for musical concerts and other entertainment events through an online subscription service" in International Class 41; ³⁶
MEGATICKET	for "ticket agency services for sporting events, musical concerts and other entertainment events through an online subscription service; promoting a variety of live entertainment events for others and merchandise related thereto" in International Class 35; "arranging for ticket reservations for sporting events, musical concerts, and other entertainment events; providing national schedules of live entertainment events, entertainment news and personality profiles of touring talent over a global computer network; providing information in the field of sports and entertainment through an

³⁴ Registration No. 3299342 issued on September 25, 2007.

³⁵ Registration No. 3304080 issued on October 2, 2007.

³⁶ Registration No. 3334708 issued on November 13, 2007. No claim is made to the exclusive right to use the word "Country" apart from the mark as shown.

	online subscription service" in International Class 41; ³⁷ and
MEGATRAIN	for, <i>inter alia</i> , "train transport; transportation of passengers by train ... " in International Class 39. ³⁸

Again, we agree with applicant that it would seem as if in many of the examples above, the prefix MEGA- has been treated as a laudatorily suggestive term that will support a finding of inherent distinctiveness, even when the base term is clearly generic.

Applicant also contends that consistency and predictability on the part of this tribunal would place its applied-for mark in the suggestive category. Specifically, applicant points to several non-precedential cases where the TTAB explicitly referred to the MEGA- prefix as being suggestive. The decisions involved likelihood of confusion cases under Section 2(d) of the Act, and none raised descriptiveness issues under Section 2(e)(1). They are also in no way to be deemed precedential. However, in the process of analyzing the respective marks under the first du Pont factor, it is true that various panels of the Board have specifically referred to the MEGA- prefix as being suggestive:

³⁷ Registration No. 3383439 issued on February 12, 2008.

³⁸ Registration No. 3385364 issued on February 19, 2008.

Although MEGAWAVE has a certain suggestive connotation, there is no evidence of third-party usage or registration which would lead us to conclude that MEGAWAVE CORPORATION and design is a weak mark. In re Telect, Inc. [Serial No. 75921736, May 30, 2002].

MEGA, although perhaps slightly laudatory, nonetheless is a suggestive and therefore inherently distinctive term as applied to the goods at issue here. The other wording in each of these marks is descriptive or generic matter ... In re Food Processing Equipment Co. [Serial Nos. 75909661; 75909662; 75909664; 75909666; 75909667; 75909668; and 75917250, May 7, 2003].

The "MEGA" component with which each of the marks starts means the same thing in each mark, i.e., "large," "surpassing other examples of its kind; extraordinary." We are not persuaded that this term is merely descriptive, as argued by applicant. At most, it is suggestive of the goods at issue. In re Mad Dog Multimedia, Inc., [MEGA-STORAGE v. MEGA-STOR, 2(d) affirmed, Serial No. 78407114, May 15, 2006].

Likewise, we find the instant mark to be suggestive.

Employing the dictionary definitions proffered by the Trademark Examining Attorney, we find that the prefix "mega-" suggests a relatively large number of cigars in applicant's samplers. While applicant often includes twenty cigars in these large samplers, the usual range seems to be fifteen to twenty-five cigars. However, based upon all the evidence in this record, we agree with applicant that whatever the attenuated connections between the connotations of the component words and applicant's goods, the information conveyed herein is not immediate enough to sustain a descriptiveness refusal. Applicant admits it may be somewhat laudatory, serve as a boast, an exaggeration, a

swaggering or whimsical use of a common English-language prefix, but that applicant coined this moniker and with few exceptions has successfully policed usage of this term in its field of competition.

Moreover, we agree with applicant that this combined term seems too ambiguous to cause consumers to associate immediately that phrase with a feature or characteristic of appellant's cigars.

The Trademark Examining Attorney has failed to provide probative evidence that applicant's competitors need to use this term in order to compete with applicant. MEGA-SAMPLER does not immediately convey knowledge about a significant characteristic of the identified goods, and hence, must be held registrable.³⁹

The Trademark Examining Attorney has the burden of proof on this issue, and any doubts we have must be resolved in favor of the applicant. Inasmuch as the record submitted by the Trademark Examining Attorney leaves us unsure that this term describes a significant feature or characteristic of the goods with which applicant uses it, we cannot affirm

³⁹ Having found that applicant's mark is inherently distinctive, we have no need to pursue applicant's alternative arguments as to its showing of acquired distinctiveness.

the refusal to register under Section 2(e)(1) of the Trademark Act.

Of course, in the event that applicant's competitors need to use this combined term to describe their own goods in this field, they will be free to oppose registration to applicant. If they could create a record that establishes that this term has mere descriptive significance in connection with goods similar to those of applicant, such an opposition would be sustained.

Decision: We hereby reverse the refusal of the Trademark Examining Attorney to register this mark under Section 2(e)(1) of the Lanham Act.