

**This Opinion is Not a  
Precedent of the TTAB**

Oral Hearing: February 19, 2014

Mailed: March 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Drew Estate Holding Company, LLC*

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Serial No. 77840485

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Roberta Jacobs-Meadway of Eckert Seamans Cherin & Mellot, LLC,  
for Drew Estate Holding Company, LLC.

David C. Reihner, Trademark Examining Attorney, Law Office 111,  
Robert Lorenzo, Managing Attorney.

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Before Bucher, Mermelstein and Gorowitz,  
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Drew Estate Holding Company, LLC (“applicant”) seeks registration on the Principal Register of the mark **KUBA KUBA BY DREW ESTATE** (*in standard character format*) for goods identified, as amended, as “cigars made with Cuban seed tobacco” in International Class 34.<sup>1</sup>

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<sup>1</sup> Application Serial No. 77840485 was filed on October 2, 2009, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On December 29, 2011, applicant filed an amendment to allege use (AAU), claiming use anywhere and use in commerce since at least as early as the year 2000. On the same date, applicant filed a declaration supporting its claim of acquired distinctiveness under Section 2(f) of the Trademark Act and volunteered to disclaim the repeated word “Kuba Kuba” apart from the mark as shown.

The examining attorney has refused registration of applicant's mark as primarily geographically deceptively misdescriptive under Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3).<sup>2</sup> Additionally, the examining attorney has refused registration under §§ 1 and 45 of the Trademark Act, 15 U.S.C. §§ 1051 and 1127, contending that the terms "Kuba Kuba" and "By Drew Estate" as shown on applicant's substitute specimen constitute two different marks. In the face of this refusal, applicant has failed to submit acceptable specimens or otherwise comply with Trademark Rule 2.51(b).

When the refusals were made final, applicant appealed and requested reconsideration. After the examining attorney denied the request for reconsideration, the appeal was resumed. We affirm both refusals to register.

**I. Is applicant's composite mark primarily geographically deceptively misdescriptive?**

Applicant seeks to register the wording **KUBA KUBA BY DREW ESTATE** for cigars made from Cuban seed tobacco. The examining attorney argues that when this composite is used on or in connection with applicant's cigars, the applied-for mark is primarily geographically deceptively misdescriptive inasmuch as he has demonstrated that the following four factors are all true:

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<sup>2</sup> 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 ....



- The primary significance of the mark is a generally known geographic place or location;
- The goods for which applicant seeks registration do not originate in the geographic place identified in the mark;
- Purchasers would be likely to make a goods-place association; that is, purchasers would be likely to believe that the goods originate in the geographic place identified in the mark; and,
- The misrepresentation regarding the geographic origin of the goods would be a material factor in a significant portion of the relevant consumers' decision to buy the goods in question.

*See In re Les Halles De Paris J. V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003); *In re Cal. Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003), *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *see also In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1492-93 (Fed. Cir. 2009).

**A. The primary significance of the mark is a generally known geographic place**

Applicant argues that it is seeking to register a five-word composite mark, **KUBA KUBA BY DREW ESTATE**, and that this applied-for mark must be considered as a whole, not dissected. Applicant attempts to create distance between its composite mark and the nation of Cuba by pointing out a series of differences:

- the repetition of sounds in “Kuba Kuba” creates a distinctive resonance;
- “Kuba Kuba” might well be seen as referring to a notable, historic (16<sup>th</sup> to 19<sup>th</sup> centuries) African civilization known as “the Kuba Kingdom” that existed in the current Democratic Republic of the Congo (formerly Zaire);
- consumers who are not aware of the history or artifacts of the Kuba Kingdom in Africa will view “Kuba Kuba” as arbitrary when they see it used on or in connection with applicant’s cigars;

- there are cities called “Kuba” across the globe including in Panama, Japan, Turkey, Azerbaijan and Uzbekistan;
- the term “Kuba” has been adopted by third parties (e.g., →  <sup>4</sup> and **KATE KUBA**,<sup>5</sup>  both for clothing;
- other uses include a “Kuba Kuba” restaurant in Richmond, VA (“Richmond’s best option for Cuban food ....”), “Kuba” is used as a first name in Poland, “KUBA” is an acronym for the Korea University’s Buddy Assistance program, and it serves as a trade name for construction companies (e.g., in FL and WI);
- according to THE URBAN DICTIONARY, the word “Kuba” is a slang term with meanings including “a sexy, smart, intelligent guy”; and
- this composite mark cannot be a “generally known geographic place” in light of the significant source-indicating element “By Drew Estate.”

The examining attorney has demonstrated that “Cuba” is the name of an island nation in the Caribbean Sea, in which tobacco is grown and cigars are

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<sup>3</sup> Registration No. 1983879 issued on July 2, 1996; renewed. No claim is made to the exclusive right to use the words “Ponche” and “Leche” apart from the mark as shown.

<sup>4</sup> Registration No. 3449782 issued on June 17, 2008; a request for extension of protection was filed on May 14, 2007, pursuant to Section 66A of the Trademark Act.

<sup>5</sup> Registration No. 3964477 issued on May 24, 2011; a request for extension of protection was filed on April 1, 2010, pursuant to Section 66A of the Trademark Act.

manufactured.<sup>6</sup> Applicant concedes that while this may well be true, “it has no bearing on the facts at issue here.” While we agree with applicant that applicant’s applied-for mark does not contain the word “Cuba” (spelled with the letter “C”), we must still determine whether consumers of applicant’s cigars would perceive this repetition of a slightly misspelled version of the geographic term “Cuba” (i.e., in the “Kuba Kuba” portion of applicant’s mark) as denoting the island nation of Cuba.

While arguing that the holding does not apply in the instant case, applicant cannot deny this Board recently determined in the case of *In re Jonathan Drew Inc.*, 97 USPQ2d 1640 (TTAB 2011) (involving this applicant’s previous attempt to register **KUBA KUBA** for “cigars, tobacco and related products ...”), 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.” See applicant’s reply brief at 2 (“Applicant’s mark contains the term KUBA KUBA, *arguendo*, a term which signifies Cuba.”) Applicant attempts to distinguish the instant case by arguing in its request for reconsideration after final action that this record “contains a significant amount of evidence supporting the conclusion that KUBA has other recognized and pertinent meanings.” However, we note that both records contain substantially the same evidence. See *Jonathan Drew*, 97 USPQ2d at 1643. Accordingly, we agree with

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<sup>6</sup> <http://www.columbiagazetteer.org/> as accessed on January 30, 2008 (“Other important exports include nickel, fish, citrus fruits, and cigars. High-quality tobacco is grown, especially in the Vuelta Abajo region of Pinar del Río province, and coffee, rice, corn, citrus fruits, and sweet potatoes are important. However, the emphasis on export crops (sugar and, to a lesser degree, tobacco) necessitates the importation of much food ...”).

the reasoning of this earlier Board panel that when the term “Kuba Kuba” is viewed in connection with cigars, for which Cuba is famous, the most likely meaning of the term would be a reference to the island nation of Cuba. *Id.* at 1643-44.

Applicant argues that the holding in the earlier *Jonathan Drew* case is not binding in this case because the instant mark has added the inherently distinctive term “By Drew Estate.” Applicant argues that inasmuch as this composite incorporates a well-known mark, such element has a significant impact on the overall commercial impression of the resulting composite mark. However, as noted by the examining attorney, a refusal under Trademark Act § 2(e)(3) is appropriate even if only a portion of the composite consists of primarily geographically deceptively misdescriptive matter. *See In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540-41 (Fed. Cir. 1999) (in **NEW YORK WAYS GALLERY**, the primary geographic significance of “New York” is not lost by the addition of the words “Ways Gallery”);

and *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (the design of The Lion of St. Mark does not diminish the geographical impact of the wording depicted above and below the



design). Moreover, applicant cites to *In re Sharky's Drygoods Co.*, 23 USPQ2d 1061 (TTAB 1992) in support of the proposition that the current composite may have a non-geographical significance. However, we have no analogous set of facts to those in *Sharky's*, where a majority of the Board panel found **PARIS BEACH CLUB** to be a humorous and incongruous juxtaposition of land-locked “Paris” with the term

“Beach Club.” Accordingly, we find that the primary significance of the applied-for, composite mark is a generally known geographic place.

**B. The goods for which applicant seeks registration do not originate in the geographic place identified in the mark**

Applicant argues, in the alternative, that its goods do have an origin in Cuba. Applicant contends that “[i]t is undisputed that Applicant’s cigars are derived from Cuban seed tobacco and that Cuban seed tobacco has its origins in Cuba.” In fact, applicant argues in its appeal brief at 9 that:

As the Board has properly held: “A product may be found to originate from a place, even though the product is manufactured elsewhere.” *See Corporation Habanos, S.A. v. Annkas, Inc.*, 88 USPQ2d 1785 (TTAB 2004) *citing In re Nantucket Allserve Inc.*, 28 USPQ2d 1144 (TTAB 1993) ... and *In re Joint-Stock Company “Baik,”* 80 USPQ2d 1305 (TTAB 2006).

However, as noted by the examining attorney, the Board in the *Annkas* case went on to find that “cigars made with Cuban seed tobacco” is a marketing term used in the United States to refer to tobacco actually grown outside Cuba (e.g., in tropical nations in Central America, and elsewhere in the Caribbean, like Nicaragua, Honduras, Panama, Costa Rica and the Dominican Republic) that is claimed to be grown from multi-generation descendants of seeds taken from Cuba more than fifty or sixty years ago. This “claim of distant descent” was found to be insufficient to warrant a finding that “cigars made with Cuban seed tobacco” come from or originate in Cuba. As the Board discussed in *Annkas*, given that the characteristics of a cigar are based on factors such as the genetic type and purity of the tobacco, the soil, the climate, as well as agricultural and manufacturing

processes, tobacco grown and processed outside Cuba over many generations cannot replicate the qualities or characteristics of tobacco grown, cultivated and processed in Cuba – genuine, 100% Cuban cigars available in much of the world outside the United States. *In re Annkas*, 88 USPQ2d at 1792. The reasoning in the *Annkas* case seems sound, and nothing that applicant has submitted would make us find differently than we did just a few years ago.

Accordingly, in this case, the connection between applicant’s named goods and Cuba is far too tenuous to be analogized to the factual situations in *Nantucket* (e.g., **NANTUCKET NECTARS** soft drinks originate from a company that has its headquarters and its research and development center on Nantucket) and *In re Joint-Stock Company “Baik,”* 80 USPQ2d 1305 (TTAB 2006) (applicant makes its **BAIKALSKAYA** vodka from the water of Lake Baikal).

Hence, we find that applicant’s cigars do not originate in Cuba, the geographic place identified in the composite mark.

### **C. U.S. purchasers would likely make a goods-place association**

The record shows that fine tobacco is grown in Cuba, and that the tobacco is then rolled by expert artisans into premium cigars. The record makes clear that Cuba does export these premium cigars to countries all across the globe – even if not to the United States. However, despite this long-standing embargo, consumers in the United States are aware that Cuba is famous for its cigars.<sup>7</sup> Accordingly, we

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<sup>7</sup> The examining attorney on July 25, 2012, provided for applicant and for the record copies of online articles (most dated January 2008) from the following websites: <http://www.news.cornell.edu/stories/2008/01/>, “Alumna’s photos show how Cuba’s world-



find that U.S. purchasers of cigars would likely make a goods-place association with the island of Cuba.

**D. This misrepresentation as to geographic origin of the goods would be a material factor in a significant portion of the relevant consumers' decision to buy the goods in question**<sup>8</sup>

The examining attorney argues that the record demonstrates that a substantial portion of the relevant consumers in the United States would be materially influenced in the decision to purchase the product by the geographic meaning of the mark. *See Spirits*, 90 USPQ2d at 1495. As did an earlier panel of the Board in *Jonathan Drew*, 97 USPQ2d at 1646, we infer that a substantial portion of consumers who encounter “Kuba Kuba” along with “By Drew Estate” on applicant’s cigar boxes are likely to be deceived into believing that the cigars come from Cuba. Cuba is well-known for the quality of its cigars and, despite the trade embargo, those cigars would be highly desirable to U.S. consumers, including those consumers who might incorrectly think that applicant’s cigars are somehow eligible for an exception to the embargo, or even those who would believe – mistakenly – that applicant may be selling genuine Cuban cigars in violation of the law.

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renowned cigars are crafted”; <http://www.nationalcigarmuseum/>, National Cigar Museum, Cuban Life & Boxes; <http://smokers-express.net/>; <http://www.jrcigars.com/jr/index.cfm/> Cigar Tobacco Growing Regions; and <http://www.hmsf.org/collections-tropical-traditions.htm#crafts>, Historical Museum of Southern Florida, Arts & Crafts, “Hand-rolled Cuban cigars are world renowned for their excellence. With the U.S. embargo on Cuban products, many small cigar-rolling businesses opened in Miami.”

<sup>8</sup> Of course, according to our primary reviewing Court, the legal standard for deception involving geographic marks post-NAFTA is identical under Sections 2(e)(3) and 2(a), requiring the heightened standard for deception under Sections 2(e)(3) (i.e., that the misrepresentation was a material factor in the consumer’s decision). *See California Innovations*, 66 USPQ2d at 1855-58.

Nonetheless, in its brief and at oral argument, applicant argues that given fifty years of an embargo on Cuban-made goods (*see* 31 CFR § 515.204), all the relevant U.S. consumers understand that any cigar purchased legally in this country did not ship from Cuba.

However, as noted by the Board in *Jonathan Drew*,

[t]hat argument has been previously considered and rejected by the Board. *See In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1946 (TTAB 2000) (noting that the embargo provides no justification for registration); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1035 (TTAB 1997) (“regardless of the existence of trade sanctions against Cuba, we have determined that the marks herein would be subject to refusal under Section 2(e)(2), if the identified goods are intended to originate in HAVANA, or Section 2(e)(3), if the identified goods are not intended to originate in HAVANA.”). It is the perception of the mark by the public which controls whether the mark is primarily geographically deceptive, and applicant has offered no evidence that the embargo on Cuban products would have any effect on the perception of KUBA KUBA as a geographically deceptive term.

97 USPQ2d at 1646-47. Although applicant suggests that consumer perceptions have changed since we decided *Jonathan Drew*, applicant has offered no evidence or other reason to believe that the impression of **KUBA KUBA** on potential purchasers has in fact changed significantly in just three years.

Accordingly, we are convinced that despite applicant’s arguments regarding the logic and insights of the cigar purchaser in the United States, the examining attorney’s indirect evidence of consumer perception of the mark, as we have in the present case (*see* footnotes 6 and 7, *supra*), are sufficient to establish a reasonable predicate that this applied-for mark includes primarily geographically deceptively

misdescriptive matter as applied to cigars, namely “Kuba Kuba.” Accordingly, the refusal to register under Section 2(e)(3) is affirmed.<sup>9</sup>

**II. Do applicant’s specimens show “KUBA KUBA BY DREW ESTATE” to be a single trademark?**

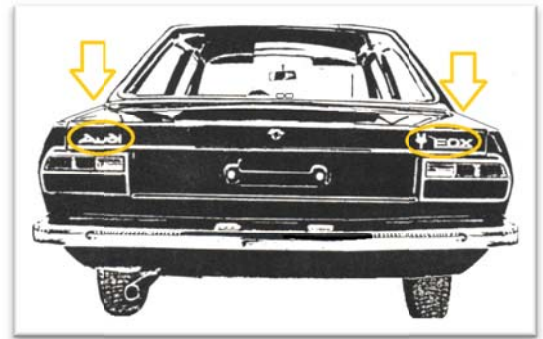
The Lanham Act, the Trademark Rules and our case precedents are all firmly grounded on the principle that a trademark applicant may obtain registration of only a single mark in any one application. *In re Int’l Flavors & Fragrances Inc.*, 183 F3d 1361, 51 USPQ2d 1513, 1516 (Fed. Cir. 1999). When the specimen discloses that applicant seeks to register two marks in one application, refusal of registration is proper. When determining whether the composite mark in the drawing sought to be registered projects a single commercial impression, “[e]verything depends on the specimens.” *In re Audi NSU Auto Union AG*, 197 USPQ 649, 650 (TTAB 1977). Accordingly, under Trademark Rule 2.51(b), the drawing of the mark in an application filed under Section 1(b) of the Act, must be a substantially exact representation of the mark as intended to be used on or in connection with the goods identified in the application, and once an amendment to allege use (AAU)

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<sup>9</sup> On its own initiative, applicant has disclaimed “Kuba Kuba” and tried to overcome the statutory refusal under Section 2(e)(3) with a claim of acquired distinctiveness. However, with the incorporation of the North American Free Trade Agreement (NAFTA) amendments into the Lanham Act in 1993, marks containing primarily geographically deceptively misdescriptive matter were precluded from registration under all circumstances, even with a showing of acquired distinctiveness (*see* 15 U.S.C. § 1052(f) (1994)), nor will a composite mark be rendered registrable with a voluntary disclaimer of the geographically deceptively misdescriptive component (*see* U.S. Patent and Trademark Office, 1162 OFFICIAL GAZETTE 15 (May 3, 1994)). As to the claim of acquired distinctiveness, we have no reason on this record to believe that this mark should be grandfathered under the NAFTA Implementation Act inasmuch as applicant has not made the claim that its composite mark became distinctive of the applicant’s goods in commerce before December 8, 1993.

under § 2.76 has been filed, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods.

In the *Audi* case, the word AUDI represented applicant’s house mark or “brand,” while the word FOX was the name for a particular line or “model” of applicant’s cars. In spite of the fact that members of the relevant purchasing public had been conditioned to expect this dual designation in the context of the automobile industry, the determination that this consisted of two marks was based largely on the wide space on the auto’s trunk lid between the word “Audi” and the word “Fox” (and fox design). While sympathetic to applicant’s explanation that this spacing results from aesthetic and engineering considerations, the Board held, based upon this specimen, that applicant was not permitted to register “AUDI FOX and design” as a single mark. *In re Audi*, 197 USPQ at 650-51.



Similarly, when Jordan Industries sought to register **JORDAN JIF-LOK** based upon the following presentation of these two terms on the front of the specimen (center image), the Board held that the designation JIF-LOK was likely to be seen



as part of the larger phrase “JIF-LOK ‘Miracle’ Fastener,” and not as part of a single, composite mark, including applicant’s somewhat larger and separated house mark, JORDAN. The specimen colors and layout, as well as the usage in other documents in the record, were all relevant inquiries in making the final determination:

On the face of the specimens the initial “J” of the name “JORDAN” is white with an orange border within a black outline while the rest of the name is printed in orange letters on a white background. The whole name is enclosed by a black outline around a white rectangle. The word “JIF-LOK” is in white letters, in a different typeface from that used for “JORDAN,” and, ... is part of the entire expression “JIF-LOK ‘MIRACLE’ FASTENER.” In our view, which is necessarily subjective, the manner in which “JORDAN” is presented separates the commercial impression created by that name from the impression generated by “JIF-LOK” especially when the latter is seen, as it naturally would be observed by the average customer, as part of the complete expression “JIF-LOK ‘MIRACLE’ FASTENER.”

Our conclusion is that “JORDAN” and “JIF-LOK” are two separate trademarks but not a single or unitary mark. This opinion is fortified by the matter on the reverse side of the specimens, where “JIF-LOK” is printed without “JORDAN” in the heading and under the left and center illustrations while “JORDAN” is printed only as part of the corporate name “Jordan Industries, Inc.” at the bottom.

Inspection of the entire specimen, which is apparently a card to which a blister pack of fasteners is attached, leaves us with the firm impression that “JORDAN” would be regarded as the house mark and “JIF-LOK” would be regarded as a separate specific product mark. This impression is further strengthened by the copy of applicant’s catalog sheet submitted with the response filed December 16, 1974. This sheet shows “JORDAN Industries, Inc.” and an address in white letters on a black triangular background in the upper left corner and “JIF-LOK” in large orange letters above “Miracle Fastener” in black letters, all on a white unenclosed background in the black letters, all on a white unenclosed background in the upper right corner. Above the name “JORDAN” is the expression “Jordan Manufactures EYE-LINE® Fasteners.” Throughout the rest of the front and back of the page, wherever “JIF-LOK” is printed (about eleven times), it is unaccompanied by “JORDAN.” The commercial impression fostered by applicant is that “JIF-LOK” is a single trademark separate and apart from “JORDAN.”

*In re Jordan Industries, Inc.*, 210 USPQ 158, 159-160 (TTAB 1980).

Applicant and the examining attorney disagree about how this principle is to be applied to the substitute specimen submitted by applicant on July 3, 2012. The inside of the lid of the cigar box displays a prominent image of a motorcyclist smoking a cigar and leaning against his bike, above the words “ACID Cigars.” The words “Kuba Kuba” are depicted in white letters against a black rectangle in a vertical plane of the upper right border of the motorcycle imagery. The words “by Drew Estate” are etched (or burned) into the wood grain of the box beneath the “ACID Cigars” label, as shown below. Given the spatial separation, the strong



intervening imagery as well as the difference in orientation, lettering styles and manners of affixation (e.g., printed/pasted vs. burned/etched) of lettering between “Kuba Kuba” and “by Drew Estate,” the examining attorney argues that these disjointed pieces cannot be viewed as a single composite mark. It appears that for other of its cigar products, applicant uses a similar

image of a silhouetted biker on the “ACID Cigars” label, but uses other product marks on the vertical, white-on-black rectangle (showing “Kuba Kuba” herein). Moreover, applicant represents that the more proximate terms “ACID Cigars” and “by Drew Estate” are two of its well-known house marks.

Similar to the time-honored practice of using dual brand/model designations in the automobile industry (as seen above in the *Audi* decision), applicant is free to use multiple marks for each of its products. Accordingly, an applicant is granted some latitude in selecting the mark it wants to register. See TMEP § 807.12(d). Historically, the Office has provided applicants with some discretion in deciding upon whether various elements should be registered separately in multiple applications or as a composite mark in yet another application. We acknowledge that there is always some degree of subjectivity involved in this kind of determination, but observe that, consistent with guidance in the TMEP, the Office gives applicants considerable latitude in deciding what all comprises a single, composite mark.

Nonetheless, where multiple elements are combined into a single drawing, it is required that the combined elements present a single commercial impression apart from any and all other matter with which the mark is used on the specimen(s) of record. In light of the overall composition of the elements on the lid of this cigar box, we agree with the examining attorney these are two separate marks. As was the case with the applied-for marks in *Audi* and *Jordan*, we find that “Kuba Kuba” and “by Drew Estate” as shown on this specimen do not form a single, composite mark, but rather reflect two distant and totally separate marks.

### **III. Summary**

Applicant’s mark is denied registration (i) as being primarily geographically deceptively misdescriptive under Trademark Act § 2(e)(3), and (ii) under §§ 1 and 45

of the Trademark Act, we also find that applicant's specimen shows this to be two different marks, and applicant has failed to submit a specimen that comports with the requirements of Trademark Rule 2.51(b).

**Decision:** The refusals to register applicant's mark are both hereby affirmed.