

From: Rauen, James

Sent: 1/31/2007 5:50:00 PM

To: TTAB EFiling

CC:

Subject: TRADEMARK APPLICATION NO. 78554967 - MONTECRISTO CLASSIC
COLLECTION - CB079UST

Attachment Information:

Count: 1

Files: 78554967.doc

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/554967

APPLICANT: Cuban Cigar Brands, N.V.



**BEFORE THE
TRADEMARK TRIAL
AND APPEAL BOARD
ON APPEAL**

CORRESPONDENT ADDRESS:
CHARLES W. GRIMES
GRIMES & BATTERSBY, LLP
488 MAIN AVE STE 3
NORWALK, CT 06851-1008

MARK: MONTECRISTO CLASSIC COLLECTION

CORRESPONDENT'S REFERENCE/DOCKET NO: CB079UST

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

FACTS

The applicant appeals from the examining attorney's final requirement that it disclaim the wording CLASSIC COLLECTION in its proposed mark MONTECRISTO CLASSIC COLLECTION for "cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco" in International Class 34. The disclaimer was required because the wording at issue is merely descriptive of the identified goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 *et seq.* No other issues remain.

ARGUMENT

As a preliminary matter, the examining attorney objects to the applicant's reference to previously registered marks. The Trademark Trial and Appeal Board does not take

judicial notice of registrations, and the mere submission of a list of registrations does not make these registrations part of the record. *In re Delbar Products, Inc.*, 217 USPQ 859 (TTAB 1981); *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Although the applicant has attached copies of the registrations to its appeal brief, such a submission is untimely. The record in any application must be complete *prior* to appeal. 37 C.F.R. §2.142(d); TMEP §710.01(c); TBMP §§1207.01 *et seq.* See *Rexall Drug Co. v. Manhattan Drug Co.*, 284 F.2d 391, 128 USPQ 114 (C.C.P.A. 1960); *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999). Accordingly, the examining attorney respectfully requests that the Board disregard these registrations and any arguments based thereon.

Introduction

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Section 2(e) of the Trademark Act, the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A term is merely descriptive under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods and/or services. *In*

re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

The determination of whether a term is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978); *see, e.g., In re Polo Int'l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk” where relevant trade uses the denomination “concurrent” as a descriptor of this particular type of operating system); *see* TMEP §1209.01(b).

For the purpose of a Section 2(e)(1) analysis, a term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 U.S.P.Q.2d 1807 (Fed. Cir. 2001). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“[A] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.”) (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)).

Analysis

The applicant seeks to register, without disclaimer, MONTECRISTO CLASSIC COLLECTION for cigars and tobacco. As demonstrated by the dictionary definitions contained in the first Office action, the wording at issue, “Classic Collection,” is a combination of two terms which indicate two characteristics of the applicant’s goods: they are of a well-known type (as opposed to being “contemporary,” or “modern,” or “avante-guard”) and they are grouped together (as opposed to being one-of-a-kind items).

Further evidence of the descriptiveness of each of the terms at issue, as applied to the applicant’s goods, was found in the NEXIS® computerized database in which the term “classic cigar” appeared in 130 articles, and “cigar collection” appeared in 111 articles. Excerpts from 20 relevant articles concerning each term were attached to the second Office action. The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984); TMEP §710.01(a).¹

As to the combination of the two terms, it is true that a mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382

¹ The applicant argues that this evidence is relevant only as to its cigars, and not to the applicant’s other goods. However, it is well settled that where a mark is merely descriptive of one or more items of goods in an application but not as to other items, registration is properly refused if the mark is descriptive of any of the goods for which registration is sought. *In re Analog Devices, Inc.*, 6 USPQ2d 1808 (TTAB 1988). See also *In re Canon, Inc.*, 219 USPQ 820 (TTAB 1983). Moreover, the applicant’s other identified tobacco goods are so closely related to cigars that the same arguments regarding descriptiveness apply to them as well.

(C.C.P.A. 1968) (holding SUGAR & SPICE not to be merely descriptive of bakery products). However, the mere combination of descriptive words does not automatically create a new nondescriptive word or phrase. *E.g.*, *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (finding GROUP SALES BOX OFFICE descriptive for theater ticket sales services).

The registrability of a term created by combining only descriptive words depends on whether a new and different commercial impression is created, and/or the term so created imparts an incongruous meaning as used in connection with the goods and/or services.

Where, as in the present case, the combination of the descriptive words creates no incongruity, and no imagination is required to understand the nature of the goods and/or services, the term is merely descriptive. *E.g.*, *In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994); *Associated Theatre Clubs*, 9 USPQ2d at 1662.² *See, e.g.*, *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of “computer software for use in development and deployment of application programs on a global computer network”); *In re Putman Publ’g Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ON-LINE merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals

² The examining attorney does not contend, as the applicant would have it, that simply because the words “classic” and “collection” are found in the dictionary, those terms are “de jure descriptive of any type of good at all and can never warrant trademark protection.” Applicant’s Brief at 7. The examining attorney limits his analysis, as the law requires, to those terms *as applied to the applicant’s goods*. And the evidence cited above clearly demonstrates that those terms have meaning to potential purchasers of the applicant’s goods.

employing electrophoretic displays); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts).

Even in the unlikely event that the applicant were the first and only producer of cigars to use the combination "Classic Collection" in connection with its goods, it would not obviate the disclaimer requirement. The fact that an applicant may be the first and sole user of a merely descriptive designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) (COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments); *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field); TMEP §1209.03(c).

The applicant argues that the wording "Classic Collection" is not descriptive because the applicant "in no way asserts that its [goods] will be of a well-known type or that Applicant will group them together." Applicant's Brief at 6. The applicant cites no authority for this proposition and the examining attorney is aware of none. The applicant seems to be suggesting that a finding of descriptiveness requires an applicant to assert that its goods or services do indeed have the characteristic indicated by the wording at issue. This is simply not the law, and never has been. Logic tells us why: it would be a rare applicant indeed who would make such an assertion, knowing it would preclude the registration of their mark without disclaimer. Nor can the examining attorney be required to prove that the applicant's goods have the characteristic indicated by the wording at

issue. That would be impossible in the context of applications, such as this one, filed under Trademark Act Section 1(b), in which the mark is not yet in use.

The two major reasons for not protecting descriptive terms are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods or services; and (2) to avoid the possibility of costly infringement suits brought by the registrant. This enables businesses and competitors to have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (C.C.P.A. 1968); *Armour & Co. v. Organon Inc.*, 245 F.2d 495, 114 USPQ 334, 337 (C.C.P.A. 1957); *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1526-1527 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000).

In this regard, the applicant asserts that if registration of its proposed mark were allowed without disclaimer, “competitors will not be deprived of the right to use the terms ‘classic’ and ‘collection’ in their descriptive, non-trademark connotation if ... use of these words would be appropriate when the goods in question are of a well-known type grouped together.” Applicant’s Brief at 8. The applicant seems to be under the misapprehension that there is a descriptiveness exception to enforcement of registered trademarks. There is not. Because marks, once registered, can be enforced against all, the only way to ensure that descriptive terms remain free for all to use is to refuse registration of descriptive terms in the first place.

Conclusion

For the foregoing reasons, the requirement that the applicant disclaim the wording CLASSIC COLLECTION under Trademark Act Section 2(e)(1) because it is merely descriptive of the applicant's goods should be affirmed.

Respectfully submitted,

/James A. Rauen/
Trademark Examining Attorney
Law Office 109
Phone 571-272-9211
Fax 571-273-9109

Dan Vavonese
Managing Attorney
Law Office - 109