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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165519
Party	Plaintiff Corporacion Habanos, S.A.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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CORPORACION HABANOS, S.A.,	)	
	)	
Opposer,	)	<b>Opposition No. 91165519</b>
	)	
v.	)	
	)	
ANNCAS, INC.,	)	
	)	
Applicant.	)	

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**OPPOSER CORPORACION HABANOS, S.A.’S STATEMENT OF  
EVIDENTIARY OBJECTIONS**

PLEASE TAKE NOTICE THAT Opposer Corporacion Habanos, S.A. (“Opposer” or “Habanos, S.A.”), pursuant to 37 C.F.R. § 2.123(k) and T.B.M.P. §§ 707.02(c), 707.03(c), 801.03, hereby files its separate Statement of Evidentiary Objections to certain of Applicant’s exhibits that have been submitted in connection with the Trial Testimony of William Bock (“Bock Ex. \_\_”) (Docket Nos. 48-49) and to the Exhibits submitted with Applicant’s Notice of Reliance (“App. NOR \_\_”) (Docket No. 43, 45); to certain of the trial testimony of William Bock (“Bock Tr. \_\_”) and Benjamin Gomez (“Gomez Tr. \_\_”) (Docket No. 48); and to certain of the cross-examination questions during the trial testimony of Manuel Garcia Morejon, Eumelio Espino Marrero, and Richard B. Perelman (Docket No. 44).

Nothing stated herein, or in not opposing the *admissibility* of certain of Applicant’s exhibits, should be construed or understood as a concession or acceptance of any of the arguments, characterizations, or statements that Applicant has made in its Notice of Reliance, or otherwise, concerning any of the Exhibits, and Opposer reserves all rights with respect to such arguments, characterizations, and statements of Applicant.

Opposer objects to the introduction in evidence of the documents identified below, which were submitted as exhibits both to William Bock's Trial Testimony and to Applicant's Notice of Reliance. Opposer has filed a separate Motion to Strike Applicant's Exhibits referenced in its Notice of Reliance for failure to serve them on Opposer and for late filing (Docket No. 54).

1. App. NOR 1-61, also submitted as Bock Ex. 7-27, 29-68: Printouts from the PTO TESS database for twelve (12) applications, three (3) cancelled registrations, and forty-two (42) registrations of third parties, and three (3) registrations of Opposer Habanos, S.A. (and one duplicate file, App. NOR 46, duplicating App. NOR 10; Bock Ex. 53, duplicating Bock Ex. 16). Each exhibit is purportedly offered, according to each Notice of Reliance entry, either to "demonstrate[] how the word 'Havana' for identification of the goods, has been widely accepted in the Patent and Trademark office with regards to the cigar/industry market"; or to "demonstrate[] how the word 'Havana' and the descriptive phrase 'Cigars made from Cuban seed tobacco' for identification of the goods, have been widely accepted in the Patent and Trademark office with regards to the cigar/industry market" (or for "Habana," "Habano," "Habanero"). Thus, these exhibits are offered solely in support of Applicant's claim to the registrability of the HAVANA CLUB mark. Applicant has submitted no information about the registration record of any of these marks other than the TESS reports.

Opposer objects to all of these exhibits on grounds of relevance, and further objects on separate additional specified grounds of relevance to certain of the exhibits, as set forth, *infra*, ¶¶ 2-8. Opposer maintained a standing objection to the admissibility of these TESS reports proffered during Mr. Bock's trial testimony. Bock Tr. 24:6-25:10, 28:5-16.

Third party applications and cancelled registrations (addressed separately in ¶ 2, *infra*) and current registrations, at least in the absence of the record of the registration files, are

generally of no probative value, and hence are irrelevant and inadmissible, on the issue of the registrability of the mark at issue, the only issue for which they are proffered here. For example, in *In re Jack's Hi-Grade Foods, Inc.*, 226 U.S.P.Q. 1028 (T.T.A.B. 1985), the Board held that the existence of third party registrations for the identical mark “*in no way bears on the question of the registrability of*” the mark at issue. *Id.* at 1030 (emphasis added). In *In re Wells Fargo Home Mortgage*, Serial No. 76624811, at 7 n.4 (T.T.A.B. June 27, 2007), the applicant submitted copies of third party registrations registered under section 2(f) in support of its claim that it too was entitled to a section 2(f) registration. The Board was unconvinced: “We remind applicant that each case must be decide on its own factual record and, therefore, these registrations are *of no probative value*. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed Cir. 2001) and cases cited therein.” (Emphasis added).

Similarly, in *In re Compania Tabacalera Santiaguense, S.A.*, 1999 WL 546830 (T.T.A.B. 1999) (copy annexed), the applicant argued that the fact that the applicant had previously registered the identical mark for identical goods (but let the registration lapse) was evidence “that its mark is registrable.” *Id.* at \*3. The Board, however held, “The decision of a prior Examining Attorney to register the mark in 1984, *based on a record which is not before us, can have no bearing upon our present determination.*” *Id.* (emphasis added); T.B.M.P. § 704.03(b)(1)(B) & nn. 161-162 (“third party registrations *may* be entitled to *some* weight” on issues such as the meaning of a mark or likelihood of confusion, citing cases; none of numerous listed cases are cited for proposition that such registrations are relevant on issue of registrability) (emphasis added). When a document is “of no probative value,” and “in no way bears on” an issue, then that document is, by definition, irrelevant, and hence inadmissible.

Opposer further objects to each of these exhibits on relevance grounds to Applicant's claim that these records show "how the word 'Havana' [or variants] *for identification of the goods*, has been widely accepted in the Patent and Trademark office with regards to the cigar/industry market." (Emphasis added). The word "Havana," or variants, is not used in any of the TESS reports for "identification of the goods," but rather appears in the TESS "Word Mark" field, and so is irrelevant for this proposition.

2. App. NOR 3, 7, 20, 23, 28, 35, 36, 37, 38, 39, 40, 43; also submitted as Bock Ex. 9, 13, 26, 30, 35, 42, 43, 44, 45, 46, 47, 50 (printouts from the PTO TESS database of twelve (12) pending third party applications); and App. NOR 51, 55, 56; also submitted as Bock Ex. 58, 62, 63 (printouts from the PTO TESS database of three (3) canceled third party registrations, *see* Opp. Rebuttal NOR 23, 24, 25), offered as quoted in para. 1, *supra*.

Opposer objects to the admission of these documents on the ground of relevance, as a third party application or third party cancelled registration has no probative value, and hence is irrelevant, as to the *registrability* of the mark at issue. *See In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614, 1619 (T.T.A.B. 2007) ("the third party applications and cancelled registrations ... *have no probative value* on the issue of registrability," and "are evidence only of the fact that the application or registration was filed on a certain date."). Applicant has not proffered these TESS reports for the fact that the applications or cancelled registrations were filed on a certain date. *See also The Black & Decker Corp. v. Emerson Electrical Co.*, 84 U.S.P.Q.2d 1482, 1487 n.9 (T.T.A.B. 2007) (cancelled registration has "no probative weight"). Because these exhibits have "no probative value" on the only issue for which they have been proffered, they are irrelevant and inadmissible.

3. App. NOR 24, 26, 27, 33, 47, 52; also submitted as Bock Ex. 31, 33, 34, 40, 54, 59: Printouts from the PTO TESS database of six (6) registrations on the Supplemental Register, offered as quoted in para. 1, *supra* (or, in one case, for “cigarettes,” App. NOR 33).

Opposer objects to the admission of these documents on the ground of relevance, as third party “registrations issued on the Supplemental Register ... are of *no probative value* in determining the registrability of the mark now before us on the Principal Register.” *In re Miracom Corp*, Serial No. 75915846, at 5-6 (T.T.A.B. Feb. 5, 2003); *see also Spirits of New Merced*, 85 U.S.P.Q.2d at 1619 (giving no consideration to third party mark registered on the Supplemental Register). Because these exhibits have “no probative value” on the only issue for which they have been proffered, they are irrelevant and inadmissible.

4. App. NOR 21, 22, 29, 32, 49, 60, also submitted as Bock Ex. 27, 29, 36, 39, 56, 67: Printouts from the PTO TESS database of six (6) registrations registered under section 2(f), 15 U.S.C. § 1052(f), offered as quoted in para. 1, *supra*

Opposer objects to the admission of these documents on the ground of relevance, as third party registrations issued under section 2(f), particularly in the absence of any record of the claim to acquired distinctiveness, are of no probative value in determining the registrability of a mark on the Principal Register without resort to section 2(f). *See Wells Fargo Home Mortgage, supra*, Serial No. 76624811, at 7 n.4 (Applicant submitted copies of third party registrations registered under section 2(f); “We remind applicant that each case must be decide on its own factual record and, therefore, these registrations are *of no probative value.*”) (emphasis added). Moreover, the reasons that a registration on the Supplemental Register has “no probative value” on the issue of registrability on the Principal Register apply with equal force to a claim that a registration under section 2(f) is relevant to registrability without resort to section 2(f) on the Principal Register.

Because these exhibits concerning section 2(f) registrations have “no probative value” on the issue for which they have been proffered, they are irrelevant and inadmissible.

5. App. NOR 2, 15, 16, 54, 61, also submitted as Bock Ex. 8, 21, 22, 61, 68. Printouts from the PTO TESS database of five (5) registrations, three (3) owned by Opposer Habanos, S.A, one by another Cuban cigar company, and a certification mark owned by the Republic of Cuba, offered as quoted in para. 1, *supra*.

Opposer objects to the admission of these documents on the ground of relevance. Applicant’s assertion that the existence of registrations to Cuban cigar companies or the Cuban government, in connection with Cuban origin cigars, is relevant to its claim to registration is patently frivolous, and frankly inexplicable. Specifically, one of the marks is a multi-word *certification* mark owned by the Republic of Cuba. App. NOR 61. Three of the Cuban cigar marks are either design marks or word and design marks, which include in tiny print “Habana, Cuba” as part of the design, correctly denoting the origin of the goods, and thus appear in the TESS “Word Field.” App. NOR 2, 15, 16, and one mark, owned by Opposer Habanos, S.A., self-referentially plays on the historic fame of Havana cigars, HABANOS UNICOS DESDE 1492 (Unique Havana Cigars since 1492). App. NOR 54.

6. App. NOR 17, 18, 19; Bock Ex. 23, 24, 25: Printouts from the PTO TESS database of three (3) registrations, offered as quoted in para. 1, *supra*

Opposer objects to the admission of these documents on the ground of relevance. These three marks are historic pre-Revolution Cuban marks – PUNCH, BACCHANTE (registered in 1957), and BELINDA (registered in 1927), whose ownership rights in the United States have been judicially determined to remain with the pre-Revolution Cuban owners of the marks after they left Cuba, and in which the term “Habana” appears in tiny print as part of the historic design

of these originally Cuban marks. Opp. Rebuttal NOR 4; *see Empresa Cubana del Tabaco v. Culbro Corp.*, 213 F. Supp. 2d 247, 256 (S.D.N.Y. 2002), *rev'd on other grounds*, 399 F.3d 462 (2d Cir. 2005). Both the legal rationales for the determination of U.S. ownership of these historic Cuban marks, and the use of “Habana” in tiny letters as part of the historic design mark, make these exhibits wholly irrelevant to Applicant’s claim of registrability.

7. App. NOR 5, 6, 8, 9, 13, 41, 44, 48, 50, also submitted as Bock Ex. 11, 12, 14, 15, 19, 48, 51, 55, 57: Printouts of nine (9) PTO TESS reports, offered as quoted in para. 1, *supra*.

Opposer objects to the admission of these documents on the ground of relevance. These nine (9) TESS reports, six (6) of which are design marks, create a substantially different commercial impression from Applicant’s standard character HAVANA CLUB mark. In these marks, “Havana” or “Habana” is a minor or obscure feature of the mark, or is included in the TESS “Word Field” because it appears in the design. *See, e.g.*, App. NOR 5, 13, 41, 44; 48, 50, Bock Exs. 11, 19, 48, 51, 55, 57 (GIRALDILLA DE LA HAVANA HAND MADE CIGARS & DESIGN; MONSEÑOR DE LA HABANA; LA HABANERA; H JOYA DE HAVANNA HAND MADE & DESIGN; K HANSOTIA & CO. TOBACCO MERCHANTS HAVANA LEGEND 4421 SELECT PREMIUM; SIMPLY THE SWEETEST SMOKE THIS SIDE OF HAVANA). Two of the marks are elaborate design marks that include the registrant’s name in the design, “Habana Cuba Cigar Company.” These marks, which create a substantially different commercial impression, and which use the term “Havana” in a different way than HAVANA CLUB are of no probative value on the issue of the registrability of the mark. *See Spirits of New Merced*, 85 U.S.P.Q.2d at 1619 (identifying several submitted marks as “creat[ing] different commercial impressions,” and giving them no further consideration).<sup>1</sup>

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<sup>1</sup> Nothing herein concedes that any of these marks were entitled to registration, only that these marks create a substantially different commercial impression from HAVANA CLUB.

8. App. NOR 34, also submitted as Bock Ex. 41: Printouts of one (1) PTO TESS report, offered as quoted in para. 1, *supra*.

Opposer objects to the admission of this document on the ground of relevance. The identified goods for this mark are “chewing tobacco.” There is nothing in the record concerning whether Havana or Cuba is known or renowned for “chewing tobacco,” nor is there any registration record other than the TESS Report. The fact of this registration for “chewing tobacco” has no relevance to the registrability of Applicant’s mark for cigars.

9. Bock Ex. 5, 6: TESS printouts of lists of applications and registrations based on a search for “live and havana” and “live and habana.”

Opposer objects to these two exhibits on the ground of relevance. Opposer objected to Bock Ex. 5, 6 on grounds of relevance at the time they were identified. Bock Tr. 20:11-19; 21:17. These mere lists of marks, which include any “live” *application* or registration with the word “Havana” in the “TESS “Word Field,” in *any* International Class, for *any* goods, on both the Supplemental and Principal Register and for section 2(f) registrations, and regardless of the commercial impression created (*e.g.*, “Gavina Gourmet Coffee Since 1870 Old Havana Espresso”; “The Original Havana Roadhouse Famous Cuban Sandwich”), have no probative value as to the registrability of Applicant’s mark at issue, for the reasons stated above, ¶¶ 1-8, or to any other issue in the case and, therefore, are inadmissible. Even if the lists had been limited solely to a list of current *registrations* in IC 34 for cigars, mere lists of third party marks are irrelevant on the issue of registrability of Applicant’s mark. T.B.M.P. § 704.03(b)(1)(B).

Further, Mr. Bock inaccurately identified Exhibit 5 as “documents with Havana that have some Havana Classics or Havana Honeys that have registrations pertaining to cigars.” Bock Tr.

19:23-20:2. On its face, the document is not limited either to registrations, as it includes numerous applications, or to cigars, or to IC 34.

10. Bock Ex. 28: One page printout of an advertisement for “Havana Honeys.”

Opposer objects to the admission of this document on grounds of authentication and relevance. Opposer objected to this exhibit at the time it was identified. Bock Tr. 40:16-24. Mr. Bock testified, “I’m not sure if I printed it from a Web site – their web site or their ad. I believe it was from their web site.” *Id.* 40:16-24. Bock’s uncertainty by itself fails to authenticate the document, as his testimony fails to “satisf[y] by evidence sufficient to support a finding that the matter in question is what its proponent claims.” Fed. R. Evid. 901(a). Further, none of the expected information of a web site printout appears on the face of the document, such as the web address, the date of printout, the name of the website, or page numbers (*see, e.g.*, Bock Ex. 5-27, 29-30, all of which show such internet printout identifiers and which Bock testified he printed, Bock Tr. 20:3-13, 21:19-22:2, 23:1-10, 25:17-24). On its face, the document almost certainly does not come from the internet, but from an unidentified catalog or magazine. Although publications available to the general public can be admissible if properly authenticated, there is no evidence sufficient to identify where this document came from, or when it was published, sufficient to satisfy Fed. R. Evid. 901(a).

Furthermore, the document, an ad for a flavored cigar product (flavors such as honey, vanilla, blackberry) called “Havana Honeys,” has no probative value as to the registrability of Applicant’s mark, or any other issue in this case.

11. Bock Ex. 70. A copy of an article in *Smoke Magazine Online* (Spring 2004). Opposer objects on the ground of hearsay to the extent Applicant is offering this article, or any statement in this article, for the truth of any matters asserted in the article. Opposer objected to

this exhibit at the time it was identified on the ground of hearsay. Bock Tr. 40:16-24. In particular, Opposer objects to the statements attributed in the article to what the reporter states that Daniel Nunez told the reporter, which is the subject of Mr. Bock's testimony. Bock Tr. 76:12-78:20. Applicant, in Mr. Bock's testimony, plainly sought to use the article and Mr. Nunez's statement for the truth of the matter asserted. The article, and any statements in the article, are inadmissible hearsay, and in the case of statements attributed to Mr. Nunez, are hearsay within hearsay, to the extent offered for the truth of the matter asserted. Fed. R. Evid. 801(c). No exception to the hearsay rule is applicable either to the article generally or to what the article says Mr. Nunez said to the reporter. *See In re Columbia Securities Litigation*, 155 F.R.D. 466, 475 (S.D.N.Y.1994) (holding that *Forbes* magazine and Reuters news articles were hearsay because they were out-of-court statements offered to prove the truth of the matter asserted); *Green v. Baca*, 226 F.R.D. 624 (C.D.Cal. 2005) ("[T]o the extent the articles quote statements by ... individuals, and those statements are offered for the truth of the matter asserted, they constitute double hearsay.").

12. Opposer further objects to the admission in evidence of those portions of the trial testimony of William Bock and Benjamin Gomez to which Opposer objected at the time the testimony was taken, as reflected in the transcripts of that testimony; and objects to those cross-examination questions during the trial testimony of Manuel Garcia Morejon, Eumilio Espino Marrero, and Richard B. Perelman, as reflected in the transcripts of that testimony, and further objects to the testimony of Messrs. Bock and Gomez, as follows:

a. Opposer objects on grounds of relevance to Mr. Bock's testimony concerning Bock Ex. 5-68, for the reasons stated *supra*, ¶¶ 1-10. Bock Tr. 19:9-68:24. Opposer made a

standing relevance objection to the testimony based on those exhibits. Bock Tr. 24:6-25:10, 28:5-16.

b. Opposer objects on grounds of hearsay to Mr. Bock's testimony of what tobacco growers or anyone else told Mr. Bock about the claimed "Cuban seed tobacco" or about where they claimed to get their tobacco seed, and to any testimony about the content of Exhibit 70 (*see* ¶ 11, *supra*), to the extent offered for the truth of the matter asserted, in particular, Bock Tr. 70:14-22; 71:25-74:16; 76:10-78:20. The statements of what others told Mr. Bock are pure hearsay, Fed. R. Evid. 801(c), and no hearsay exception is applicable. Opposer objected to this testimony on hearsay grounds at the time. *See generally* Bock Tr. 70:20-78:20.

c. Opposer objects on grounds of relevance to the testimony of Benjamin Gomez concerning "Havana Sunrise," or other marks, presumably offered on the issue of the registrability of Applicant's mark, for the reasons stated in ¶ 1, *supra*. Gomez Tr. 5:8-12:17.

Dated: March 14, 2008

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing Opposer Corporacion Habanos, S.A.'s Statement Of Evidentiary Objections was sent by email to, and was served upon, Applicant by mailing, postage prepaid, first class United States mail, on March 14, 2008 to:

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# **Annex A**

\*1 THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

IN RE COMPANIA TABACALERA SANTIAGUENSE, S.A.  
Serial No. 74/719,339  
July 21, 1999

Stewart J. Bellus of Collard & Roe, P.C. for Compania Tabacalera Santiaguense, S.A.

David C. Reihner

Trademark Examining Attorney

Law Office 107

(Thomas Lamone, Managing Attorney).

Before Sams, Simms and Wendel

Administrative Trademark Judges.

Opinion by Wendel

Administrative Trademark Judge:

Compania Tabacalera Santiaguense, S.A. (a corporation of the Dominican Republic) has filed an application to register the mark LA HABANERA for cigars. [FN1]

Registration has been finally refused on the grounds that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) and geographically deceptive under Section 2(a). Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The determination of whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) requires analysis under the following two-prong test:

(1) whether the primary significance of the mark as it is used is a generally known geographic place; and

(2) whether the public would make a goods/place association, i.e., believe the goods for which the mark is sought to be registered originate in that place.

Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992), citing In re Societe Generale des Eaux Minerales de Vittel, S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982); In re Bacardi & Co., 48 USPQ2d 1031 (TTAB 1997). In order for a mark to be geographically deceptive under Section 2(a), it must be shown that the mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) and additionally that the geographic misrepresentation is material to the decision of the purchaser to buy the goods bearing this mark. Institut National v. Vintners International, supra; In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992). [FN2]

Here the major issues arise under the first prong of the test. Applicant has set forth in its application the statement that "La Habanera" is the name of a Cuban dance and maintains that this is the meaning or primary significance of its mark. The Examining Attorney, on the other hand, has introduced definitions from Spanish-English dictionaries of the term "habanera" as meaning "of Havana" or "native of Havana." On this basis, the Examining Attorney argues that the primary significance of LA HABANERA, as used by applicant, is as a reference to something that originates from Havana.

Looking to the dictionary definitions of record, we see that the definition that has been submitted by applicant from an English language dictionary for "habanera" is:

**\*2** 1. A Cuban dance in slow duple time 2. the music for the habanera. Webster's Ninth New Collegiate Dictionary [FN3]

The definitions relied upon by the Examining Attorney, as found in Spanish-English dictionaries, are:

habanero/a 1. adj., of or from Havana 2. nm/f., native or inhabitant of Havana. Collins Spanish-English, English-Spanish Dictionary (1993)

habanero, -ra, a., n.m.f. (native) of Havana Cassell's Spanish-English, English-Spanish Dictionary (1978).

In each of the latter dictionaries, there is also a listing for "habanera," without any translation, as a musical term.

Applicant makes two arguments with respect to the meaning of its mark LA HABANERA. First, applicant insists that the mark should not be translated at all, since it is a recognized word in the English language. To demonstrate this recognition of the term "habanera" in its musical sense in the English language, applicant has made of record various Internet excerpts and copies of programs and brochures showing use of the term to refer to either the dance form or music for the dance. Second, applicant argues that, even if the mark is translated, it refers to a female person from Havana, not an object from this location. Applicant argues that the addition of the article "La" requires that the mark be considered as a noun, and not as an adjective, as would be the appropriate form, if descriptive of the geographic origin of goods.

We do not agree with applicant's initial argument that the mark should not be translated at all, but taken solely for its meaning in the English language. While "habanera" may be recognized as a musical term in the English language by some purchasers of cigars, we believe that most would be likely to view applicant's mark as a Spanish term. Thus, the translations must be taken into consideration. In doing so, we simply are following the well established rule that no distinction will be made between an English term and its foreign equivalent, so that if the translation of LA HABANERA is geographically descriptive, the mark is equally so, even though the Spanish term may not be readily known to the United States public. See *In re Atavio Inc.*, 25 USPQ2d 1360 (TTAB 1992) and the cases cited therein.

Furthermore, and as pointed out by the Examining Attorney, we must determine the most appropriate or relevant meaning for LA HABANERA as applied to applicant's goods, namely, cigars. See *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) [while term "Neapolitan" has several dictionary definitions, only its meaning as a geographic term is logical when used in connection with sausage]. Although in Spanish "habanera" is also the name given to a Cuban dance, we do not believe most purchasers of applicant's goods would be likely to make any association between a Cuban dance and cigars. On the other hand, even when strictly translated from the Spanish language, and with attention being given to the presence of the article "La", applicant's mark refers to a female inhabitant of Havana or a female Havanan. Given this meaning, we believe that the mark possesses a geographic connotation, just as the term "the American," even when used as a noun, has a geographic connotation. Although the reference is gender specific in Spanish, whereas in English "the American" could be either masculine or feminine, the geographic significance is not lost. In view of the well-known association of cigars with Havana, we find that the reference to geographic origin would be the most logical interpretation of LA HABANERA, as used on applicant's goods. Even if potential purchasers were not familiar with Spanish, we find it highly likely that at least a general connection would be made between the mark LA HABANERA and the geographic location Havana. We find no need to take the further step of determining the propriety of translating applicant's mark in the adjectival form advanced by the Examining Attorney, namely, "of or from Havana."

**\*3** Insofar as the second prong of the test is concerned, applicant has conceded that there is a goods/place association between Havana and cigars. (Brief, p.2). Thus, it is not necessary for us to review the evidence submitted by the Examining

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(Cite as: 1999 WL 546830 (Trademark Tr. & App. Bd.))

Attorney to establish this relationship. Nor must we consider any effect that the U. S. trade embargo with Cuba might have on the availability of cigars from Havana, this issue not having been raised by applicant. For a general discussion of this matter, see *In re Bacardi & Co., Ltd.*, supra at 1035-37.

Accordingly, since applicant is a corporation of the Dominican Republic and has made no contention that its cigars originate from other than the Dominican Republic, we find the mark LA HABANERA primarily geographically deceptively misdescriptive of applicant's goods. Likewise, since applicant has failed to contest the refusal under Section 2(a) on any other basis than the primary significance of its mark, we find the mark geographically deceptive under Section 2(a).

Applicant has raised the additional argument that there is a viable presumption that its mark is registrable, because of the issuance of a prior registration to applicant for the same mark and the same goods in 1984, [FN4] which registration was inadvertently allowed to lapse for failure to file a Section 8 affidavit. Applicant points out that the statement made in that registration that "La Habanera refers to a Cuban dance or a female person" was accepted by the Office and the registration was allowed to issue.

Once a registration has been cancelled under the provisions of Section 8 of the Trademark Act, however, it cannot serve as evidence of any existing rights in the mark. *In re Grey Hosiery Mills*, 137 USPO 455 (TTAB 1963). The decision of a prior Examining Attorney to register the mark in 1984, based on a record which is not before us, can have no bearing upon our present determination. By failing to timely file a Section 8 affidavit, applicant has opened up its mark to reexamination under present standards.

Decision: The refusals to register under Section 2(e)(3) and 2(a) are affirmed.

J. D. Sams

R. L. Simms

H. R. Wendel

Trademark Administrative Judges, Trademark Trial and Appeal Board

FN1. Serial No. 74/719,339, filed August 23, 1995, claiming a date of first use of April 21, 1922 and a date of first use in commerce of October 9, 1980. The statement is set forth in the application that "La Habanera is a Cuban dance."

FN2. Section 2 of the Trademark Act was amended by Public Law 103-183, 107 Stat. 2057, The North American Free Trade Enactment Act, effective for applications filed on or after December 8, 1993. As a result, the prohibition against registration on the basis of being primarily geographically deceptively misdescriptive was moved from Section 2(e)(2) to Section 2(e)(3) and the availability of Section 2(f) for marks of this nature was eliminated. Thus, the major distinction between being refused registration as primarily geographically deceptively misdescriptive and geographically deceptive under Section 2(a) no longer exists, in that registration under the provisions of Section 2(f) is not an option in either case.

FN3. The definitions in The Random House Dictionary (2d ed.) are nearly identical.

FN4. Reg, No, 1,297,961, issued Sept., 25, 1984, cancelled under Section 8 Feb. 12, 1991.

1999 WL 546830 (Trademark Tr. & App. Bd.)

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