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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Corporacion Habanos, S.A. and Empresa Cubano del Tabaco, dba, Cubatabaco

v.

Xikar, Inc.
—

Opposition No. 91186534
—

David B. Goldstein of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. for
Corporacion Hababos, S.A. and Empresa Cubano del Tabaco.

J. David Wharton of Stinson Morrison Hecker LLP for Xikar, Inc.
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Before Bucher, Bergsman and Shaw, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Xikar, Inc. (“applicant”) filed a use based application for the mark HAVANA COLLECTION, in standard character form, for goods ultimately identified as “cigar cutters; non-electric cigar lighters not of precious metal; humidors; and cigar carrying cases not of precious metal,” in Class 34. Applicant disclaimed the exclusive right to use the word “Collection.”

Corporacion Hababos, S.A. and Empresa Cubano del Tabaco (“opposers”) opposed the registration of applicant’s mark under Section 2(e)(3) of the Trademark Act of 1946, 15 U.S.C. § 1052(e), on the ground that applicant’s mark is primarily geographically deceptively misdescriptive because, according to opposers, despite the consumer association between Havana and cigar accessories, applicant’s goods do not come from Havana, Cuba.¹

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant’s application file. In addition, the parties introduced the following testimony and evidence:

A. Opposers' testimony and evidence.

1. Declaration of Ana López Garcia, former Director of Marketing at Corporacion Habanos, S.A., former Corporate Director at the English firm of Hunters & Frankau Ltd., a cigar import and distribution company that is the exclusive United Kingdom distributor of cigars imported from Cuba by Habanos, S.A., and currently an employee at Empresa Cubano del Tabaco involved in

¹ Opposers also asserted that applicant’s mark is deceptive under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). However, the Federal Circuit has held that with the NAFTA amendments, Section 2 of the Trademark Act “no longer treats geographically deceptively misdescriptive marks differently from geographically deceptive marks,” and anticipated that the “PTO will usually address geographically deceptive marks under subsection 2(e)(3) of the amended Lanham Act rather than subsection 2(a).” *In re California Innovations Inc.*, 329 F.3d 1334, 1340, 66 USPQ2d 1853, 1856-57 (Fed. Cir. 2003), *reh’g denied*, 2003 U.S. App. LEXIS 18883 (Fed. Cir. Aug. 20, 2003). Thus, the legal standards for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under § 2(e)(3) are the same as those applied in determining deceptiveness under Section 2(a). *Id.* at 1857.

marketing and exporting Cuban cigars and cigar related accessories, with attached exhibits.²

2. Notice of reliance on the following items:³
 - a. Entries for “Havana” from encyclopedias, dictionaries, and **THE COLUMBIA GAZETTEER OF THE WORLD** purportedly to show that Havana is a well-known geographic location in Cuba, that Havana has meaning as a cigar made in Cuba or grown from Cuban tobacco, and that Havana is known for the production of cigars and tobacco products;
 - b. Excerpts from “consumer-oriented English-language cigar books published or sold in the United States, which purportedly use the term ‘Havana(s)’ or ‘Havana cigar(s)’ to mean cigars manufactured in Cuba from Cuban tobacco and that Havana is known for as a source for humidors;
 - c. Excerpts from the *Cigar Aficionado* magazine and website purportedly to show that cigar accessories are advertised and

² The parties filed a stipulation on April 13, 2011 agreeing that opposers may introduce the Declaration of Ana Lopez Garcia as her trial testimony.

³ Opposers also introduced excerpts from applicant’s product catalogues through the notice of reliance, however, product catalogues are not publications in general circulation among members of the general public within the meaning of Trademark Rule 2.122(e) and, therefore, we have not considered the catalogues. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1104-05 (TTAB 2009). Opposers introduced an affidavit of Steve J. Albert, Senior Account Manager at LanguageWorks, regarding the translation of the phrase “a la Havane.” However, because the parties did not stipulate to the introduction of Mr. Albert’s affidavit as testimony, we have not considered the affidavit. *See Trademark Rule 2.123(b)* (“By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses.”).

- covered in news articles along with cigars and that cigar accessories are made in Cuba;
- d. Excerpts from the *Smoke* magazine and website and the *Tobacco Journal International* magazine purportedly to show that cigar accessories are advertised and covered in news articles along with cigars and that cigar accessories are made in Cuba;
 - e. Excerpts from the *Smokeshop* magazine and website purportedly to show that cigar accessories are advertised and written about in news articles along with cigars and that cigar accessories are made in Cuba;
 - f. News articles from U.S. newspapers discussing and referring to “Havana(s)” or “Havana cigar(s)” as cigars and discussing humidors made in Cuba;
 - g. Nine articles found on the Internet discussing the fame and reputation of Cuban-origin cigars;
 - h. Entries from four websites discussing Cuban-origin cigars, including a *NationalCigarMuseum.com* article about humidors made in Cuba;
 - i. Entries from opposer Habanos, S.A.’s website and the website of one of its distributors featuring the sale of humidors made in Cuba;
 - j. Excerpts from applicant’s website;

- k. Excerpts from the websites of cigar retailers advertising applicant's products;
 - l. Applicant's Supplemental Responses to Opposers' First Set of Interrogatories;
 - m. Applicant's Responses to Opposers' Second Set of Interrogatories;
 - n. A copy of Registration No. 1970911 for the mark LA CASA DEL HABANO and design and Registration No. 2177837 for the mark HABANOS UNICOS DESDE 1492 and design printed from the electronic records of the United States Patent and Trademark Office showing the current status and title to the registration;
 - o. Entries from English-Spanish dictionaries translating the terms "Habano" and "Habana"; and
 - p. Excerpts from the discovery deposition of applicant's President Kurt Van Keppel with attached exhibits.
3. Opposers' rebuttal notice of reliance on the following items:
- a. Excerpts from applicant's website;
 - b. Excerpts from websites of four purported cigar retailers; and
 - c. Excerpts from cigar magazines *Cigar Aficionado*, *Smoke* and *Smokeshop*.

B. Applicant's testimony and evidence.

1. Notice of reliance on the following items:
 - a. *Wikipedia* entry for Cuba;
 - b. *CIA – The World Fact Book (cia.gov)* entry for Cuba;
 - c. *Cigar Encyclopedia* website (*cigarencyclopedia.com*) entry for applicant;
 - d. *Wikipedia* entry for Havana
 - e. **COLUMBIA ENCYCLOPEDIA** (6th ed. 2007) entry for Havana
 - f. Webpage from *NYCGO.com* entitled “Havana Central Times Square”;
 - g. *Ezinearticles.com* webpage entitled “A Moveable Feast In Havana”;
 - h. A webpage from *Havanacentral.com*;
 - i. Excerpts from opposers' application files;
 - j. Excerpts from opposers' registration files;
 - k. Excerpt from opposer Habanos website (*habanos.com*);
 - l. Excerpts from Perelman's **INTERNATIONAL DIRECTORY OF RETAIL TOBACCONISTS** (2008); and
 - m. Printouts from applicant's website.
2. The entire discovery deposition of applicant's President Kurt Van Keppel with attached exhibits.⁴

⁴ In their April 13, 2011 stipulation, the parties agreed that Mr. Van Keppel's deposition may be introduced into evidence.

Standing

Ana López Garcia testified that “[s]ince its creation in 1994, Habanos S.A. has been responsible for the promotion and marketing in Cuba and abroad of all Cuban premium, that is, hand-made, cigar brands and cigar-related accessories.”⁵ The precise nature of the business of opposer Empresa Cubano del Tabaco is not clear from Ms. Garcia’s affidavit. However, she testified that while employed by that company she was involved in the marketing and export of Cuban cigars and cigar-related accessories.⁶ In addition, Ms. Garcia testified as follows:

During my employment with [Empresa Cubano del Tabaco] and Habanos S.A., I have joined or directed strategic efforts to position premium Cuban cigar brands and cigar-related products for introduction to the U.S. market upon termination of the present embargo on U.S.-Cuba trade. The size of the U.S. economy, the number of U.S. cigar consumers, and the proximity of the United States to Cuba make the U.S. market an important factor in [Empresa Cubano del Tabaco’s] and Habanos S.A.’s long-term planning. All of the marketing strategies and policies I devised as Habanos S.A.’s Director of Marketing are formed in part by the prospect of eventual entry into the U.S. domestic market.⁷

Accordingly, opposers have a legitimate personal interest in this proceeding and, therefore, have standing. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

⁵ Garcia Affidavit ¶7.

⁶ *Id.*

⁷ *Id.* at ¶11.

Whether the mark HAVANA COLLECTON for cigar accessories is primarily geographically deceptively misdescriptive?

The elements of a claim under Trademark Act § 2(e)(3) are as follows:

(1) The primary significance of the mark is a generally known geographic location;

(2) The goods or services do not originate in the place identified in the mark;

(3) Purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and

(4) The misrepresentation would be a material factor in a significant portion of the relevant consumers' decision to buy the goods or use the services.

See In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1489, 1495 (Fed. Cir. 2009); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006), *In re California Innovations*, 66 USPQ2d at 1858; *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1843 (TTAB 2012).

A. The primary significance of the term "Havana."

A mark is not primarily geographic where the geographic meaning is obscure, minor, remote, or not likely to be connected with the goods. *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively misdescriptive where manufacturing listings and Nexis® excerpts showed that handbags and luggage are designed and manufactured in New York); *In re Jacques Bernier, Inc.*, 894 F.2d 389, 13 USPQ2d 1725, 1726 (Fed. Cir. 1990); *In re Compania de Licores Internacionales S.A.*, 102

USPQ2d at 1844-45. Because the applied-for mark is a composite mark, HAVANA COLLECTION must be evaluated as a whole. *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (THE VENICE COLLECTION and SAVE VENICE INC. composite marks featuring an image of the winged Lion of St. Mark held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an encyclopedia and a gazetteer showed that Venice was a large metropolitan area where fine art objects, glassware, and decorative items had been made and sold for centuries, and a popular tourist destination); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1844-45. It is not improper, however, to give greater weight to the dominant feature of a composite mark in the course of evaluating the mark as a whole. *In re Wada*, 52 USPQ2d at 1541; *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1845.

To support a refusal to register geographic matter, the Trademark Act requires that the mark be primarily geographic, that is, that its primary significance be that of a geographic location. The fact that the proposed mark has meaning or usage other than as a geographic term does not necessarily alter its primary geographic significance. Thus, if a geographic term has another meaning, we must determine whether the primary significance is geographic. *See, e.g., In re Wada*, 52 USPQ2d at 1540 (the primary geographic significance of NEW YORK is not lost by the addition of the words WAYS GALLERY); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1845-46 (the primary significance of HAVANA

in the mark OLD HAVANA is the city of Havana); *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) (THE NASHVILLE NETWORK held primarily geographically descriptive of television program production and distribution services, the Board finding that the primary significance of the term was Nashville, Tennessee, and not that of a style of music); *In re Cookie Kitchen, Inc.*, 228 USPQ 873, 874 (TTAB 1986) (the fact that MANHATTAN identifies an alcoholic cocktail does not alter the primary significance of that term as a borough of New York City); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028, 1029 (TTAB 1985) (finding that the fact that NEAPOLITAN identifies, among other things, a type of ice cream, does not alter the primary significance of that term as meaning “of or pertaining to Naples in Italy”).

Applicant concedes that Havana is a city in Cuba.⁸ Moreover, it is beyond dispute that Havana, Cuba is a generally known geographic location. Accordingly, we find that primary significance of the term “Havana” is a well-known geographic location.

The addition of “Collection” to “Havana” does not diminish the primary geographic significance of the term “Havana” when the mark HAVANA COLLECTION is considered in its entirety. The mark HAVANA COLLECTION engenders the commercial impression of a grouping of items that share a connection with Havana, Cuba.

⁸ Applicant’s Brief, p. 1 (“No issue with regard to the fact that Havana is a city in Cuba and that Cuba is associated with quality cigars.”) and p. 4 (“Applicant does not deny, and has consistently recognized in this proceeding, that the primary significance of Havana is geographic.”).

B. The origins of applicant's cigar accessories.

It is undisputed that applicant's cigar accessories do not originate in Havana, Cuba.

C. Goods/place association.

To establish a goods/place association, opposers may provide such evidence as excerpts from telephone directories, gazetteers, encyclopedias, geographic dictionaries, the LexisNexis® database, or the results of an Internet search. *See In re Loew's Theaters, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (finding evidence from a gazetteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico sufficient to establish a prima facie goods/place association); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1847. Opposers may also reference applicant's specimen displaying the use of its mark and any other evidence in the record that shows the context in which the mark is used. *See In re Les Halles de Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.”). *See also In re Save Venice New York Inc.*, 59 USPQ2d at 1783-84; *In re Wada*, 52 USPQ2d at 1541; *In re Loew's Theatres, Inc.*, 226 USPQ at 868; *In re Joint-Stock Co. “Baik,”* 80 USPQ2d 1305 (TTAB 2006) (BAIKALSKAYA held primarily geographically descriptive of vodka where the record showed that applicant is located in Irkutsk, Russia, a city near Lake Baikal and one of the main export regions of Russian vodka, applicant's vodka is made from water piped directly from

Lake Baikal, Lake Baikal is the world's largest fresh water lake, and there are numerous references to “Baikal” in publications from various cities throughout the United States and in national publications); *In re Broyhill Furniture Indus., Inc.*, 60 USPQ2d 1511, 1516-17 (TTAB 2001) (finding evidence that Tuscany, Italy is an important industrial center that produces a variety of products including furniture, and that several businesses advertise the sale of furniture from Tuscany on the Internet, was sufficient to establish a goods/place association between Tuscany and furniture, even though Tuscany is not famous for its furniture); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (HAVANA RESORT & CASINO and ROYAL HAVANA RESORT & CASINO held primarily geographically deceptively misdescriptive of wearing apparel, beauty products and perfume that do not come from Havana, Cuba; goods/place association established where the record showed that Havana produces a variety of goods, including clothing and cosmetic items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1035 (TTAB 1997) (OLD HAVANA, HAVANA SELECT, HABANA CLASICO, HAVANA PRIMO, and HAVANA CLIPPER all held primarily geographically deceptively misdescriptive of rum that does not originate in Havana, Cuba; goods/place association established by evidence showing that Havana is a major city and rum is a significant product).

Applicant concedes that there is a goods/place association between “Havana” and cigars,⁹ but denies that there is a goods/place association between “Havana” and cigar accessories.¹⁰

⁹ Applicant’s Brief, p. 4 (“Applicant has not denied, at any time in this proceeding, the relevant public’s association of Havana with cigars.”).

The record is clear that Havana is associated with cigars. “Havana” is defined as “1. the capital of Cuba ... 2. a cigar made in Cuba.”¹¹ According to **THE NEW ENCYCLOPAEDIA BRITANNICA**, Vol. 20, p. 534 (1988), “The quality products of the tobacco industry, notably Havana cigars, have brought Cuba world fame.”¹²

AN ILLUSTRATED ENCYCLOPEDIA OF POST-REVOLUTION HAVANA CIGARS, by Min Ron Nee,¹³ p. 193 (2003) cited to a “Bulletin to Members Number 690” of the America Fair Trade Association (February 14, 1928) as the best definition of “Havana.”

“Havana” as a trade name for cigars is with little doubt the oldest trade name in America as it has been used since the days of Columbus to describe tobacco grown on the Island of Cuba.

This historical fact was brought out by the Federal Trade Commission in its case against XXXXX Cigars, Inc., in which it was charged that the word “Havana” was used to describe tobacco not grown on the Island of Cuba and that

¹⁰ Applicant’s Brief, p. 4 (“[T]here is no basis for even an *inference* that a ‘reasonably prudent consumer’ ... would make any association between [cigar accessories] and Havana.”). (Emphasis in the original).

¹¹ Opposers’ notice of reliance, **RANDOM HOUSE WEBSTER’S DICTIONARY**, p. 331 (4th ed. 2001). *See also* Opposers’ notice of reliance **THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (UNABRIDGED)**, p. 877 (2nd ed. 1987); **WEBSTER’S NEW COLLEGIATE DICTIONARY**, Vol. 5, p. 525 (1977); **THE OXFORD ENGLISH DICTIONARY**(1970); Merriam-Webster online (*m-w.com*); *Online Etymology Dictionary* (*etymonline.com*).

¹² Opposers’ notice of reliance. *See also* Opposers’ notice of reliance **THE WORLD BOOK ENCYCLOPEDIA**, Vol. 9, p. 87 (1992) (“Havana’s most important manufacturing activity is the processing of tobacco.”).

¹³ This reference work is cited in **PERELMAN’S POCKET CYCLOPEDIA OF HAVANA CIGARS**, p. 2 (3rd ed. 2005) as “a repository of information simply not available anywhere else.” In July/August 2005 issue of *Cigar Aficionado* article “The New Geneva,” the author referred to the reference work as “the definitive work on the subject.” (Opposers’ notice of reliance, Exhibit 3).

such use of the word was misleading to the purchasing public and constituted an unfair practice of the trade.

“The tobacco grown on the Island of Cuba has, since the days of Columbus, borne the name ‘Havana’, the tobacco no doubt having taken the name of the city of Havana where it was first manufactured into cigars from which such cigars and the tobacco have been exported to all parts of the world as the Havana tobacco and Havana cigars,” says Henry Miller, the commission’s attorney in his brief of the case.

... Havana became the cigar manufacturing center of the world and the tobacco and the cigars were marketed under the name Havana.

Ana López Garcia testified as follows:

12. Havana, Cuba, in particular, is world renowned for its production and export of high-quality, premium cigars. In fact, Havana is so closely associated with the famous Cuban cigars that Cuban cigars are commonly referred to as “Havanas” in English-speaking countries.

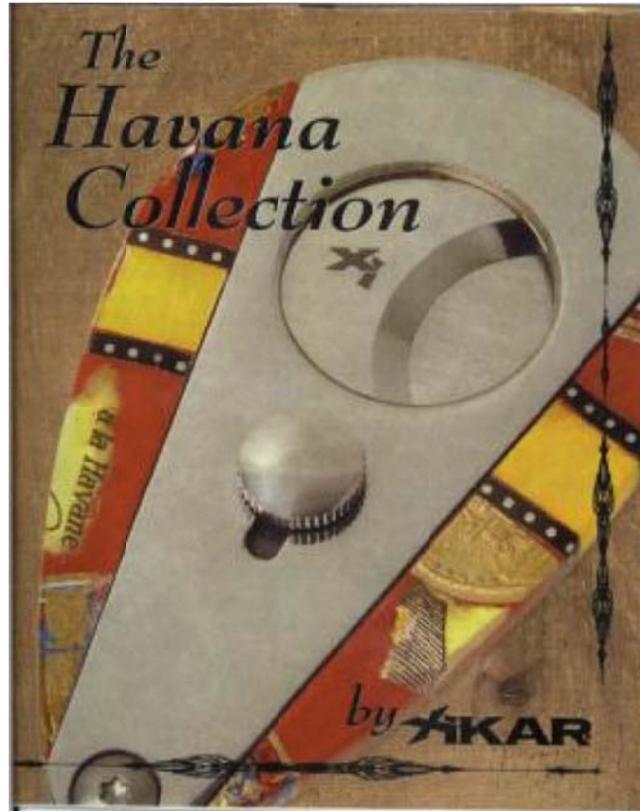
13. Havana, Cuba, in particular, is internationally renowned for the production of high quality humidors, which are both sold in Cuba and exported throughout the world. ... These humidors are frequently sold under the same marks as the famous Cuban cigar brands, including COHIBA, MONTECRISTO, ROMEO Y JULIETA, PARTAGAS and H. UPMANN. ...

15. Habanos S.A. also exports humidors made in Cuba for sale in countries throughout the world, including Europe, Latin America and the Caribbean, Asia, the Middle East and North America. Humidors made in Cuba are also special ordered from all over the world, including from Hong Kong, Japan, France, Spain, Italy, Germany, Belgium, Holland, Luxembourg, Libya and Mexico. ...

* * *

25. Cigar accessories, such as humidors, cigar cutters, cigar holders and cigar cases/travel humidors, have no function or use other than in connection with cigars.

As indicated above, we may look to applicant's specimen of use filed with its application to see the context in which applicant uses its mark. Applicant's specimen is a copy of a product insert. The cover of the insert is displayed below.



The term “a la Havane” appearing on the left-hand side of the cover means “in the style of Havana.”¹⁴

On the second page of the insert, applicant explains how a Parisian artist fashioned the cigar cutter handles from French maple and hand painted them.

It is a handmade piece of art that liberates the spirit of the quintessential cigar city, Havana.

¹⁴ “A la” means “according to; in the style of.” **THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE (UNABRIDGED)**, p. 46 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Finally, the insert includes a “Certificate of Authenticity” shown below.



There was very little direct evidence referencing Havana in connection with cigar accessories. The Summer 2008 issue of *Smoke* magazine featured an excerpt from an article about the Cuban cigars noting that at the Habanos Festival, Cuba’s annual international cigar festival, “Gifted Cuban crafters fashioned high quality humidors in virtually every shape of the imagination: thatch-roof huts, storage barns, historical busts of persons – even a 1949 Chevy Fastback.”¹⁵ Indeed, the Habanos Festival features an auction of humidors for charity.¹⁶

The *NationalCigarMuseum.com* website has a webpage about “Cuban Chests.”¹⁷

¹⁵ Applicant’s notice of reliance Exhibit H.

¹⁶ Lopez Dec. ¶¶17-18, Exhibits 6 – 8; Opposers’ notice of reliance Exhibits 3,4, 6 and 9.

¹⁷ Opposers’ notice of reliance Exhibit 9. The National Cigar Museum is a private endeavor “designed to tell the stories behind all those folks and all those brands, the processes and procedures, the battles and strategies, the schemes, the triumphs and failures.”

When Europeans arrived in Cuba they discovered more than tobacco. Numerous fruits and veggies were added to the world's tables. Exotic hardwoods were none the less prized. The island soon became known for fine woodworking, much of which went into creating chests for the island's cigars so highly prized by the wealthy worldwide. All Cuban export cigar companies seem to have used fancy chests at one time or another.

Based on our review of the all the evidence in the record, including evidence not specifically referenced above, we find that there is a goods/place association between cigars and Havana. However, to the extent that there is a goods/place association between cigar accessories and Havana, it exists solely as a result of the fame of Havana in connection with cigars and because cigar accessories are related to cigars. Because Havana is so well-known for cigars, consumers seeing Havana used in connection with a product associated with cigars are likely to believe that there is a goods/place association between those products and Havana.

The Court of Appeals for the Federal Circuit specifically addressed whether the related goods test is applicable to geographic marks in *In re Save Venice N.Y., Inc.*, 59 USPQ2d at 1784 (emphasis added):

In the modern marketing context, geographic regions that are noted for certain products or services actively promote and adapt their specialties to fit changing consumer needs. Thus we see no reason to believe that a modern merchant of Venice would not expand on the traditional Venetian products listed by the Board, to begin marketing products or services related to such goods. Similarly, from the consumer's perspective, we also find no reason to believe that the public strictly limits its association of a place to the geographic region's traditional products or services. Because we consider that consumers may assume that geographic regions, like other commercial actors, are likely to expand from their traditional goods or services into related goods or services, ***we hold that the***

registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there. The essence of the test is whether consumers are likely to be confused by the source of the related goods identified by a distinctive geographic mark.

In its application of the “related goods” test, the Board found that many of applicant's goods “reflect product types, decorative themes and material compositions” associated with the city of Venice, Italy. As a result, the Board concluded that consumers would make a goods/place association between Venice, Italy and applicant's related goods. **We agree with the Board that certain derivative “related goods” carrying a distinctive geographic mark would likely confuse consumers as to the source of the “related goods.”**

In other words, “we are really saying no more than that we must look to the evidence that has been presented about the probable reaction of purchasers to a particular geographic term when it is applied to particular goods.” *In re House of Windsor, Inc.*, 221 USPQ 53, 57 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984).¹⁸

D. Materiality.

To establish that a geographic term is primarily geographically deceptively misdescriptive under 15 U.S.C. § 1052(e)(3), opposers must show that the goods/place association made by a consumer is material to the consumer’s decision to purchase those goods. *In re California Innovations Inc.*, 66 USPQ2d at 1856. In

¹⁸ *House of Windsor* was a refusal under Section 2(a) on the ground that the mark BAHIA for cigars is deceptive. However, as noted in footnote 1, the legal standards for determining whether, post-NAFTA, a mark is primarily geographically deceptively misdescriptive under § 2(e)(3) are the same as those applied in determining deceptiveness under Section 2(a).

other words, the issue is whether a known or possible misdescription in the mark would affect a substantial portion of the relevant consumers' decision to purchase the goods. As indicated above, we focus on "the probable reaction of purchasers to a particular geographic term when it is applied to particular goods." *In re House of Windsor, Inc.*, 221 USPQ at 57.

If the evidence shows that the geographical area named in the mark is sufficiently known to lead purchasers to make a goods/place association, but the record does not show that the relevant goods are a principal product of that geographical area, the deception will most likely be found not to be material. If, however, there is evidence that the relevant goods, *or related goods*, are a principal product of the geographical area named by the mark, then the deception will most likely be found to be material. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1850.

The materiality element in cases involving goods generally will be satisfied if there is evidence showing that the place named in the mark is well known for the goods; or the goods are a principal product of the place named in the mark; or the goods are, or are related to, the traditional products of the place named in the mark, or are an expansion of the traditional products of the place named in the mark. *See In re California Innovations Inc.*, 66 USPQ2d at 1857 ("[I]f there is evidence that goods like applicant's or goods related to applicant's are a principal product of the geographical area named by the mark, then the deception will most likely be found

material and the mark, therefore, deceptive.” (quoting *In re House of Windsor*, 221 USPQ at 57)); *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d at 1850.

In *Save Venice*, the court affirmed the Board's refusal to register applicant's mark a logo containing the terms “THE VENICE COLLECTION” and “SAVE VENICE, INC.” for a variety of goods in nine different international designated classes, including potpourri, tableware made of precious and nonprecious metals, lamps, clocks, art prints, paper products, residential furniture, dinnerware, glassware, bedding and carpets because of the “substantial evidence available showing that Venice, Italy is known for glass, lace, art objects, jewelry, cotton and silk textiles, printing and publishing.” 59 USPQ2d at 1783. Although the court in *Save Venice* did not expressly address the materiality issue, because it was not officially recognized in this context, the court concluded that the public would mistakenly believe they were purchasing traditional Venetian products because “certain derivative ‘related goods’ carrying a distinctive geographic mark would likely confuse consumers as to the source of the ‘related goods.’” *Id.* at 1784.

As indicated above, HAVANA is well-known, if not famous, for its cigars. Because cigar accessories have no purpose other than to be used in connection with cigars, it follows that cigar accessories are more desirable if there is some association with HAVANA. This conclusion is reinforced by applicant's specimen of use, a product insert featuring the term “a la Havane” and a certificate of authenticity. The product depicted on the cover of the product insert is a cigar cutter underneath the term “THE HAVANA COLLECTION.” On the left-hand side

of the product insert is the term “a la Havane.” The last page of the product insert is a “Certificate of Authenticity.” At first blush, a consumer will believe that applicant is certifying that the product is from Havana because it is part of the “HAVANA COLLECTION.” The commercial impression engendered by the mark HAVANA COLLECTION is that is part of a group of items from Havana. Only if the consumer reads the small print will he/she learn that applicant is certifying that the “HAVANA COLLECTION” is a hand-made limited production cutter. Under these circumstances, we find that applicant is trying to associate his product with the positive commercial impressions engendered by Havana in connection with cigars. We find that this evidence is sufficient to show that purchasers of applicant’s cigar cutters would expect the goods to have their origin in Havana, Cuba. Thus, the use of the word HAVANA in connection with cigar accessories is a material factor in the purchasing decision.

Applicant’s reliance on our decision in *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537 (TTAB 2006) is not well founded. In *U.S. Playing Card Co. v. Harbro, LLC*, the Board held that the mark VEGAS was not primarily geographically deceptively misdescriptive of playing cards that do not originate in Las Vegas, finding that the opposer failed to establish that the misleading goods/place association would be a material factor in the customer’s decision to purchase the goods. The Board rejected opposers’ argument that opposer had met the materiality factor by proving that there is a market for cancelled casino cards from Las Vegas casinos, stating that “[a]lthough the evidence demonstrates that

consumers are interested in obtaining cards that were used in casinos, the evidence does not establish that they are interested in purchasing playing cards that were manufactured or used in Las Vegas.” The Board also disagreed with opposers’ contention that the goods/place association between Las Vegas and playing cards was so strong that materiality could be presumed. 81 USPQ2d at 1542.

E. Conclusion

The primary significance of Havana is the capital city of Cuba, a geographic area that is generally known to American consumers. Because Havana is well known, if not famous, for cigars, consumers will make a goods/place association between cigar accessories and Havana. That is, consumers will mistakenly believe that applicant’s cigar accessories originate in Havana when they do not. Lastly, because of the renown of Havana for cigars, the geographic origin of cigar accessories is a material factor for consumers in their decision to buy such products.

In view of the foregoing, opposers have established that the mark HAVANA COLLECTION for cigar accessories is geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act.

Decision: The opposition is sustained and registration to applicant is refused.