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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/417467

MARK: HAVANA TIME

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: G & R Brands, LLC

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EXAMINING ATTORNEY'S APPEAL BRIEF

This is an answer to applicant's Notice of Appeal filed July 27, 2009, and Appeal Brief filed

November 13, 2009.

Issue

Is the trademark "Havana Time" for cigarettes, cigars, and variety of tobacco products all made from Cuban seed tobacco primarily geographically deceptively misdescriptive under Trademark Act § 2(e)(3)?

Facts

Applicant filed March 10, 2008, this trademark application to register the mark “Havana Time” for hand-rolling tobacco; pipe tobacco; roll your own tobacco; rolling tobacco; smoking tobacco; tobacco filters; tobacco grinders; tobacco pipe cleaners; cigar and cigarette boxes not of precious metal; cigar cutters; cigar humidifiers; cigar tubes; cigars; cigarette ash receptacles; cigarette cases, not of precious metal; cigarette holders; cigarette holders, not of precious metal; cigarette lighters not for land vehicles; cigarette lighters not of precious metal; cigarette papers; cigarette rolling machines; cigarette rolling papers; cigarette tubes; cigarettes; filter-tipped cigarettes; hookahs; non-electric cigar lighters not of precious metal; smoking pipe cleaners, smoking pipes; and tobacco pipes. In the first Office Action dated June 18, 2009, registration was refused under Trademark Act § 2(a) because the wording was considered to be geographically deceptive.

Applicant responded November 19, 2008, by amending the recitation of goods; the tobacco goods were amended by indicating that they were made from Cuban seed tobacco. In the second Office Action dated December 15, 2008, the refusal to register under Trademark Act § 2(a) was withdrawn, a request for a complete correction of the recitation of goods was made, and a requirement for applicant to submit a disclaimer of the word “Havana” was issued. Applicant promptly responded December 15, 2008, by fully amending the tobacco goods to be goods made from Cuban seed tobacco.

The application was then reassigned to the present examining attorney and a third Office Action was issued December 17, 2008, in which registration of the mark was refused

under Trademark Act § 2(e)(3) because the mark is primarily geographically deceptively misdescriptive. Applicant responded December 17, 2008, by repeating the amendments it submitted December 15, 2008. Correspondingly, a final refusal to register under Trademark Act § 2(e)(3) was issued January 27, 2009.

An Appeal from the refusal to register was filed July 27, 2009, coupled with a Request for Reconsideration. The Request for Reconsideration was denied September 2, 2009. Then applicant submitted its Appeal Brief November 13, 2009, which prompted this Examiner's Statement.

Procedural Aspects

Applicant submitted along with its Appeal Brief a declaration signed by applicant's manager and information reports taken from the Internet. Objection is made to the submission of the declaration and additional evidence because the record in the application must be complete when an Appeal Brief is filed and additional evidence should not be considered. Trademark Rule § 2.142(d) and *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB, 1994).

Next, applicant indicated that it "is willing to adopt a new identification of goods to clearly state that the tobacco products will be (this is an ITU application) 'made of tobacco grown from seed newly exported from Cuba'" (Appeal Brief, pg. 2, par. 1). It is noted that a suggested amendment to an identification of goods does not constitute a formal request to amend the identification of goods. Such a request to amend an

identification of goods would precipitate a remand to the Examining Attorney for consideration. Although an amendment to an identification of goods may be submitted during an Appeal to obviate a refusal to register, the present suggested amendment would not obviate the refusal. BMEP § 1205.01. The reason will be discussed later.

Finally, applicant indicates that the refusal to register improperly applies to all the goods listed in the recitation of goods; the non-tobacco goods would not engender a goods/place association with Havana in the minds of purchasers (Appeal Brief, pg. 10, par. 2). TMEP § 718.02(a). Applicant's observation is correct; the refusal to register was not restricted to tobacco-related goods contained in the identification of goods. Due to this oversight the refusal to register in this application was applied to all the goods contained in the identification of goods. Correspondingly, the refusal to register is now restricted to the tobacco-related goods, and they are: hand-rolling tobacco grown from Cuban seed tobacco; pipe tobacco grown from Cuban seed tobacco; roll your own tobacco grown from Cuban seed tobacco; rolling tobacco grown from Cuban seed tobacco; smoking tobacco grown from Cuban seed tobacco; cigars made from Cuban seed tobacco; cigarettes made from Cuban seed tobacco; and filter-tipped cigarettes made from Cuban seed tobacco.

Arguments

Applicant presents two arguments against the refusal to register:

1. The mark “Havana Time” is not primarily geographically deceptively misdescriptive because the commercial impression of the mark is non-geographical; and
2. The word “Havana” is geographically descriptive, rather than geographically misdescriptive, because applicant’s tobacco goods are derived from recently exported Cuban tobacco seeds and not tobacco seeds taken from Cuba decades ago.

Commercial Impression

Applicant contends that its mark “Havana Time” creates a commercial impression that does not refer to Havana, Cuba. Rather than Havana itself, the mark “refers to the lifestyle or qualities associated with that place ... parties and carefree living ... for sensuality and entertainment ... and decadent lifestyle[s]” (Appeal Brief, pg. 3, par. 3). Correspondingly, the mark is not primarily geographical in nature. This argument was raised in the case of *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB, 1997). There the marks in issue (in a combined appeal) were “Havana Select” “Habana Clasico” “Old Havana” “Havana Primo” and “Havana Clipper” all for rum. The applicant asserted that the marks produced an historic and stylistic image that was related to a “pre-Castro free-wheeling lifestyle.” *Bacardi*, supra, 1034. The Trademark Trial & Appeal Board rejected the argument indicating that no evidence was presented to establish that relevant purchasers would make such an association. Here, the same is true. No evidence has been provided to show that the primary significance of applicant’s mark is non-

geographical. Only an allegation of such significance was presented. Further, in *Bacardi* the addition of various terms to the words “Havana” and “Habana” did “not detract from the primary geographic significance of each of the proposed composite marks.” *Bacardi*, supra, 1034. In one of the applications (“Old Havana”) the use of the word “Old” actually reinforced the geographic significance of “Havana”. *Bacardi*, supra, 1034. Finally, *Bacardi* runs counter to the holdings in those cases presented by applicant involving geographical locations. Applicant has relied upon *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 93 USPQ 250 (SDNY, 1951) (“Hyde Park” for men’s suits not geographical) and *Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH*, 14 USPQ2d 1487 (TTAB, 1990) (“Park Avenue” for cigarettes and smoking tobacco not geographical). In those cases the geographical locations used as source indicators were not the areas from which the goods identified originated and were not areas known for the production of the goods. Rather, the locations connoted an upscale, affluent, and sophisticated image and style. On the other hand, in *Bacardi*, as well as here, the location (Havana) forming the marks immediately indicates a known geographical location where the identified goods are produced and that fact is known by the relevant purchasing public and relied upon when the identified goods are purchased.

Applicant also argues that its mark is similar to popular advertising slogans which bring to mind to purchasers “fun or [a] pleasant time” in relation to the use of the products identified by the marks. (Appeal Brief, pg. 4, par. 3). “It’s Miller Time” and “Island Time” are given as examples by applicant of such phrases. The first relates to beer and the second to tropical or resort islands where a person may relax. (Request for

Reconsideration, pg. 2, par. 3). Time, referring to an occasion, is coupled with a desired indulgence. Correspondingly, “It’s Miller Time” refers to the occasion for consumption of beer and “Island Time” refers to the occasion for slowing down and thinking about or participating in tropical or leisure island activities. If applicant’s contention is accurate, the designation “Havana Time” refers to the occasion for smoking a cigar from Havana, Cuba. Such a conclusion naturally follows from applicant’s examples. If “It’s Miller Time” suggests a time for having a Miller (beer) and “Island Time” suggests a time for slowing down and thinking about or participating in tropical or leisure island activities, then “Havana Time” suggests a time for having a Havana (cigar). Applicant’s argument is unpersuasive because the geographical nature of the mark is not supplanted by a non-geographical impression. “Havana Time” directly points to an occasion in Havana, Cuba; the geographical location from which applicant’s goods do not originate.

Cuban Seed Tobacco

Applicant asserts that its mark “Havana Time” is not primarily geographically deceptively misdescriptive because its tobacco products (hand-rolling tobacco grown from Cuban seed tobacco; pipe tobacco grown from Cuban seed tobacco; roll your own tobacco grown from Cuban seed tobacco; rolling tobacco grown from Cuban seed tobacco; smoking tobacco grown from Cuban seed tobacco; cigars made from Cuban seed tobacco; cigarettes made from Cuban seed tobacco; and filter-tipped cigarettes made from Cuban seed tobacco) will be made from Cuban seed tobacco, ... and not just Cuban seed tobacco but “tobacco grown from recently exported Cuban seed.” (Appeal Brief,

pg. 7, par. 2). The seeds are “first generation” tobacco seeds. (Appeal Brief, pg. 7, par. 2). Further, “[a]pplicant does not intend to use the mark on tobacco products made from seeds that were exported out of Cuba forty years ago that have been re-propagated elsewhere for many decades.” (Appeal Brief, pg. 7, par. 3). Correspondingly, there will be “a sufficient connection” between applicant’s goods and Cuba to support the contention that applicant’s tobacco products do originate from Havana contrary to the finding in the case of *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1792 (TTAB, 2008), in which the tobacco seeds used to form the tobacco products were taken from Cuba decades ago. (Appeal Brief, pg. 8, par. 3).

Applicant asserts that the re-propagated tobacco seeds taken from Cuba in the past are unlike the tobacco seeds now used in Cuba and which applicant will use. The re-propagated seeds form such a tenuous or remote connection with Cuba that the tobacco grown from them and the tobacco grown from first-generation tobacco seeds are dissimilar. Therefore, the “finding in *Corporacion Habanos* is clearly inapplicable to cigars made of tobacco grown from newly exported Cuban seeds” (Appeal Brief, pg. 9 par. 3). While applicant’s assertion is interesting, the difference between re-propagated Cuban tobacco seeds and first-generation Cuban tobacco seeds used to produce tobacco products constitutes a distinction without a difference.

In the *Anncas case*, the Trademark Trial & Appeal Board indicated (relying upon expert opinion) that “the characteristics of a cigar are based on four factors, namely, the kind (genetic type and purity) of the tobacco; the soil; the climate; and the agricultural and

manufacturing processes ... [and] ... if any ‘one of these factors is missing, then you don’t get the quality that distinguishes the Habano in the world.’” It was also determined that “‘in another environment in another location, the [tobacco] plant is not going to express with loyalty the characteristics that it does express in the area or in the zone that we cultivated in Cuba.’” *Anncas*, supra, 1792. From this standard it appears that using either first-generation Cuban tobacco seeds or re-propagated Cuban tobacco seeds taken from Cuba decades ago in the production of tobacco products outside of Cuba would not produce a tobacco product like that produced in Cuba. Why is this so? Three of the four necessary factors in the production of tobacco with the same qualities or characteristics of genuine Cuban tobacco products would be missing. While the seeds are an important factor in growing tobacco plants used to produce tobacco products, the seeds alone do not determine the finished product. All the factors -- seeds, soil, climate, and agricultural and manufacturing processes -- must be present to produce a tobacco product that can justifiably bear the name Cuban, or here, Havana.

Applicant’s assertion that the use of first-generation Cuban tobacco seeds in the production of tobacco products outside of Cuba is so related to Cuba that applicant may claim the resulting tobacco products have their origin in Cuba or Havana is unpersuasive. Based upon the *Anncas* case, tobacco products produced outside of Cuba using either first-generation Cuban tobacco seeds or re-propagated Cuban tobacco seeds are not so related to Cuba that Cuba could be called the origin of the goods. Correspondingly, applicant may not claim that the goods it intends to produce using first-generation Cuban

tobacco seeds originate in Cuba and by so doing overcome the conclusion that its mark is primarily geographically deceptively misdescriptive.

Summary

It has been shown that Havana is primarily a known geographical location; applicant's tobacco products will not originate from the geographic place identified in the mark, but Las Vegas, Nevada; purchasers would be likely to make a goods-place association and believe that the goods originate from the geographic place identified in the mark; the misrepresentation relating to the geographic origin of the goods would be material to a purchaser's decision to buy the tobacco products; and the addition of the word "Time" to "Havana" would not alter the geographical impression of the mark. Further, applicant's first argument that the mark "Havana Time" would primarily be understood by relevant purchasers to be either suggestive of a carefree, sensual, decadent lifestyle once prevalent in Havana, Cuba, or a common marketing phrase used to sell a variety of products, and applicant's second argument that the goods have their origin in Havana, Cuba, because they are produced using first-generation Cuban tobacco seeds, have been found to be unpersuasive. Therefore, applicant's mark for tobacco products made with Cuban seed tobacco is primarily geographically deceptively misdescriptive.

Conclusion

For the reasons stated above and those contained in the final refusal to register, the refusal to register applicant's mark under Trademark Act § 2(e)(3) should be **affirmed**.

Respectfully submitted,

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Index of Cases

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