From: Reihner, David

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Subject: U.S. TRADEMARK APPLICATION NO. 85590981 - LA AROMA DE CUBA PASION - N/A - Request for Reconsideration Denied - Return to TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85590981

MARK: LA AROMA DE CUBA PASION

CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

APPLICANT: Holt's Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 5/5/2014

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The refusal made final in the Office action dated October 16, 2013, is repeated and continued to be final. *See* TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a).

Amendment of the recitation of goods

Applicant filed April 16, 2014, an appeal from the final refusal to register and amended the recitation of goods from "cigars" to "cigars made from tobacco grown from Cuban seed." The amendment of the recitation of goods has been accepted; however, the refusal to register is undisturbed by the amendment.

Registration of applicant's mark, "LA AROMA DE CUBA PASION," because it is primarily geographically deceptively misdescriptive of cigars has been refused. Trademark Act § 2(e)(3). Applicant now asserts that by amending the goods from "cigars" to "cigars made from tobacco grown from Cuban seed" the refusal to register would be obviated. Applicant supports this position by citing the case of *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640 (TTAB, 2011) ("KUBA KUBA" unregistrable for cigars, tobacco and related products, namely, cigarettes, cigar boxes, lighters, holders, ashtrays, cigar bands, cigar cutters, humidors, and cigar tubes). This issue was addressed in the final refusal to register dated October 16, 2013.

Applicant argued in its response dated October 10, 2012, that if the goods, for which the mark was sought to be registered, were amended to be "cigars made from Cuban seed tobacco," the refusal would be overcome. In the final refusal to register dated October 16, 2013, (pg. 5, par. 2) that issue was addressed (in which the case of *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB, 2008) (Anncas) was heavily relied upon), and found to be unpersuasive. The following argument was presented:

> It could also be argued that the goods are not just cigars, but cigars that could be made from Cuban seed tobacco. Applicant contends that its goods could be made from Cuban seed tobacco, even though, at this juncture, the application is based upon an intent-to-use and the goods have not yet been produced. (Applicant's response dated October 10, 2012, pg. 3, par. 3). Because the cigars could be made with Cuban seed tobacco, the source, or origin, of the goods would be Cuba, so that the mark would not be geographically deceptively misdescriptive of the goods. This argument is unpersuasive. In the *Anncas* case, supra, the Board determined that four factors are necessary to produce a Cuban cigar. The tobacco, soil, climate, and the

> agricultural and manufacturing processes, which are only found and employed in Cuba, are necessary to produce a Cuban cigar. *Anncas*, supra, 1792. The Board stated that "there is little or no connection between the characteristics of 'cigars made from Cuban seed tobacco' and 100% or genuine Cuban cigars." *Anncas*, supra, 1793. Identifying cigars as being "made with Cuban seed tobacco" does not mean they are cigars with their origins in Cuba; only cigars produced in Cuba can be called Cuban cigars. Correspondingly, if applicant's goods would be composed of Cuban seed tobacco, they still would not be Cuban cigars and the use of the word Cuban would misdescribe the goods.

Applicant has amended the recitation of goods to be "cigars made from tobacco grown from Cuban seed." The possibility of applicant's goods being identified as "cigars made from tobacco grown from Cuban seed" is now an actuality. Nonetheless, the amendment does not overcome the refusal to register. Applicant's attention is called to the recently decided case of *In re Drew Estate Holding Company, LLC*, application no. 77840485 (TTAB, decided March 25, 2014) (a non-precedential decision), in which the refusal to register the proposed mark "KUBA KUBA BY DREW ESTATE" for "cigars made with Cuba seed tobacco" was affirmed by the Trademark Trial & Appeal Board. The same reasoning used in the *Jonathan Drew* case, supra [owned by the applicant's predecessor], was applied in the decision. Since the goods, either identified as cigars or cigars made with Cuba seed tobacco, do not originate in Cuba [see: *Anncas*], the mark containing the word Cuba or derivation of it, is considered to primarily geographically deceptively misdescriptive. The same is applicable here. Even though applicant's goods are identified as "cigars made from tobacco grown form Cuban seed" the mark is primarily geographically deceptively misdescriptive, and unregistrable under Trademark Act § 2(e)(3).

Applicant's request has not resolved the outstanding refusal, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/David C. Reihner/

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