

This Opinion is Not a
Precedent of the TTAB

Mailed: August 15, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re K & G Concepts LLC
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Serial No. 85940179
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Kattina V. Barsik, Esq.
for K & G Concepts LLC.

Rudy Singleton, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Quinn, Lykos and Gorowitz,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On May 22, 2013, K & G Concepts LLC (“Applicant”) filed an application to register as a mark **SMOOTH WRAP** in standard characters on the Principal Register for, as amended, “cigarillos; cigars; flavored tobacco; hand-rolling tobacco; leaf tobacco; roll your own tobacco; tobacco, cigars and cigarettes” in International Class 34.¹ The Trademark Examining Attorney refused registration of the mark

¹ Application Serial No. 85940179, filed pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. The word WRAP

under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant's identified goods. In an effort to overcome the refusal, Applicant amended the identification of goods to delete "cigar wraps." The Examining Attorney accepted Applicant's amendment but maintained and made final the refusal.

Applicant appealed and filed a request for reconsideration which was denied.² The appeal is now fully briefed. For the reasons set forth below, we affirm the refusal to register.

Whether the Mark is Merely Descriptive?

Section 2(e)(1) of the Trademark Act precludes registration of a mark that, when used in connection with the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1).³ "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). The determination of whether a

has been disclaimed. The mark was originally displayed as **SMOOTHWRAP** but was subsequently amended.

² The Examining Attorney rejected Applicant's amendment to the Supplemental Register, noting that the application is based on Applicant's bona fide intention to use the mark in commerce under Section 1(b), and that Applicant did not submit an amendment to allege use. Applicant then withdrew its amendment to the Supplemental Register.

³ "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them. ..."

mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the purchasers of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)).

Notwithstanding Applicant’s voluntary disclaimer of the word **WRAP** the issue before the Board is whether Applicant’s mark **SMOOTH WRAP**, as a whole, is merely descriptive of the identified goods.

Applicant contends that because it has amended the identification of goods to delete “cigar wraps,” its proposed mark **SMOOTH WRAP** is not descriptive of the remaining goods. Applicant’s argument reflects a misunderstanding of the descriptiveness analysis. A descriptiveness refusal is not limited to a term which constitutes a designation for the actual good itself (i.e. a wrap for a cigar); rather, it also applies to a “quality, feature, or characteristic” of a good. *See In re Chamber of Commerce*, 102 USPQ2d at 1219. In this case, there remain several goods in the

identification subject to the descriptiveness refusal – namely, “cigars”, “cigarillos”, and “cigarettes.”

Based on the evidence of record, we find that Applicant’s mark **SMOOTH WRAP** immediately conveys to prospective purchasers a significant feature of the outer portion of Applicant’s “cigars,” “cigarillos,” and “cigarettes;” specifically, that they are comprised of a “wrap” that has the characteristic of being “smooth.” The adjective “smooth” is defined as “completely even with no rough areas or lumps.”⁴ When the adjective “smooth” is combined with the noun “wrap” the result is a merely descriptive mark which immediately conveys to the consumer that the wrap of Applicant’s “cigars,” “cigarillos,” and “cigarettes” is smooth in texture.

In particular with regard to cigars, the exterior wrap is not only one of the initial attributes a prospective consumer will notice but also an important consideration in making a purchasing decision. Note the following excerpt from an article entitled “Cigar Rap: The Wrap on Cigars”:

Besides having a major impact on the flavor, the wrapper leaf can make or break a cigar just on aesthetics alone. When you first pick up a cigar at your favorite cigar merchant, what is it we do as cigar smokers? We of course give the cigar “the once over” just like we would a person we were thinking of courting. ***We inspect the cigar and observe, is the wrapper oily, does it have a silky feel, how smooth is it,*** are the veins on the wrapper excessive or are they barely visible giving the cigar a sleek appearance? People in general (not just guys, sorry ladies) form opinions by looking before consuming; an example of this would be a well-prepared meal that is displayed and garnished to astonish! The same is true when picking out a

⁴ Applicant points to the definition of “wrap” as a verb from the *Merriam Webster Dictionary* (www.merriam-webster.com). March 17, 2014 Response to Office Action. In the context of Applicant’s mark SMOOTH WRAP, the word “wrap” is used as a noun; therefore, the definition cited to by Applicant has little, if any, relevance here.

cigar and rightfully so, since a good-looking wrapper will almost always be the sign of a quality smoke.⁵

(Emphasis added). This evidence shows that the nature and quality of the “wrap” is a critical component of cigars. Our determination is bolstered by the evidence made of record by the Examining Attorney showing that it is not uncommon for third parties to use the term “smooth” to denote the nature of the “wrap” of a cigars. By way of illustration, we highlight the following:

Price \$9.99 Double Platinum Blunt Wraps provide hand rollers with premium quality tobacco paper that rolls up as **smooth** as they smoke. Double Platinum Cigar **wraps** are imported directly from the Dominican Republic, a nation with a long cigar producing history. Each **wrap** is crafted of the finest pipe tobacco, blended to perfection, flavored with amazing natural essences and pressed in to a silky **smooth** rolling sheet.”⁶

(Emphasis added). As the aforementioned evidence shows, wraps are a critical component of cigars, and the texture and feel of the wrap is a significant feature that consumers take into consideration.⁷

⁵ www.honestcigarsreviews.com (April 9, 2014, Office Action).

⁶ www.cacatches.com (April 9, 2014, Office Action).

⁷ Applicant also points to the following three registered marks as evidence that its proposed mark is inherently distinctive: SUPERSMOOTH for cigars and cigarettes; NICE AND SMOOTH for tobacco leaves and rolling cigarillos and cigars; and SOFT & SWEET VANILLA for cigars. As the Examining Attorney correctly points out, Applicant did not provide information regarding whether the marks are registered on the Principal Register without any claim of acquired distinctiveness, under Trademark Act Section 2(f) or on the Supplemental Register. That being said, even if this information had been made of record, these third-party marks are distinct from the mark at issue here. *See In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”).

In sum, we find that Applicant's proposed mark **SMOOTH WRAP** for "cigarillos; cigars; flavored tobacco; hand-rolling tobacco; leaf tobacco; roll your own tobacco; tobacco, cigars and cigarettes" in International Class 34 is merely descriptive. *Cf. In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, unpublished at 10 USPQ2d 1879 (Fed. Cir. 1989) (registration will be refused for a term that is generic of a category or class of products where some but not all of the goods identified fall within that category.").

Decision: The descriptiveness refusal under Section 2(e)(1) of the Trademark Act is affirmed.