

THIS OPINION IS
A PRECEDENT
OF THE T.T.A.B.

Mailed:
February 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Corporacion Habanos, S.A.

v.

Guantanamera Cigars Company¹

Opposition No. 91152248 to application
Serial No. 76256068 filed on May 14, 2001

David B. Goldstein of Rabinowitz, Boudin, Standard, Krinsky
& Lieberman, P.C. for Corporacion Habanos, S.A.

Frank Herrera of Frank Herrera, P.A. for Guantanamera Cigars
Company.

Before Hairston, Zervas and Cataldo, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Guantanamera Cigars Company ("applicant") is the owner
of an application (filed on May 14, 2001) for registration
of the mark GUANTANAMERA (in standard character form) on the

¹ On September 26, 2003, the Board granted applicant's motion to substitute Guantanamera Cigars Company for Guantanamera Cigars, Inc., which was identified in the original application. Thus, opposer's statement in fn. 3 of its brief that the Board has not acted on applicant's motion to substitute is incorrect.

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Principal Register for "tobacco, namely cigars" in International Class 34. Applicant has claimed first use anywhere and first use in commerce on May 1, 2000.

Corporacion Habanos, S.A. ("opposer"), a Cuban company, has opposed registration of applicant's mark. In its notice of opposition, opposer has alleged that it has pending an application to register the mark GUANTANAMERA in the United States for cigars, articles for smokers and matches; that its ability to register its mark, and use the mark in the United States, will be impaired if applicant is allowed to register its mark; that the term GUANTANAMERA denotes "(i) the feminine adjectival form of GUANTANAMO, meaning having to do with or belonging to the city or province of Guantanamo, Cuba; and/or (ii) a woman from the city or province of Guantanamo, Cuba"; and that all Spanish speakers and United States consumers would so understand the term. As grounds for opposition, opposer has alleged that applicant's mark is primarily geographically deceptively misdescriptive within the meaning of Trademark Act §2(e)(3) and deceptive within the meaning of Trademark Act §2(a); and that applicant has committed fraud on the U.S. Patent and Trademark Office in that applicant knew or should have known that it made false, material misrepresentations to the

Office when it informed the Office that its mark GUANTANAMERA had no meaning or English translation.²

Applicant has answered the amended notice of opposition by denying the salient allegations thereof. This case has been fully briefed.

The Record

The record consists of the pleadings; the file of the involved application; the trial testimony on written questions and exhibits of Manuel G. Morejon, opposer's Commercial Vice-President; the trial testimony and exhibits of Professor Flora Gonzalez, opposer's expert witness; the trial testimony and exhibits of Jose L. Montagne, applicant's President; opposer's notice of reliance and exhibits thereto; applicant's notice of reliance and exhibits thereto; and opposer's rebuttal notice of reliance and exhibits thereto.

Applicant's Motion to Strike

By separate motion filed on June 18, 2007, applicant has moved to strike opposer's entire reply brief. Applicant contends that applicant filed a statement of evidentiary objections apart from its main brief; that TBMP § 801.03 (2d ed. rev. 2004) provides that "[i]f a plaintiff files a reply

² Opposer also has alleged that applicant's mark is deceptively misdescriptive within the meaning of Trademark Act §2(e)(1), 15 U.S.C. § 1052(e)(1). Because opposer has not discussed its Section 2(e)(1) claim in its brief, we consider opposer to have waived any such claim.

brief, the brief must be confined to rebutting the defendant's main brief"; and that "[s]ince the Statement of Evidentiary Objections is not within the 'main brief' of Applicant's Trial Brief, such cannot be the subject of rebuttal or other arguments by Opposer in its Trial Reply Brief." Motion at p. 2.

Inasmuch as a party has the option of making evidentiary objections in a main brief or in a separate statement, by extension, a response to evidentiary objections may be made in a responsive brief or in a separate statement. See TBMP § 801.03. Applicant's motion is therefore denied and we have considered opposer's response in its entirety.³

Standing

To establish standing, opposer must show that it has a "real interest" in the outcome of the proceeding; that is, that it has a direct and personal stake in the outcome of the opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987) ("it is in the pleading stage of the opposition proceeding that the opposer must plead facts

³ Because of the large number of objections applicant has made to opposer's evidence, as well as the large number of objections opposer has made to applicant's evidence, we have set forth our rulings on each party's objections in a separate order.

sufficient only to show a personal interest in the outcome of the case beyond that of the general public.").

Opposer has submitted evidence that it has filed an application for the mark GUANTANAMERA with the U.S. Patent and Trademark Office for "cigars, matches, cigar cutters, cigar boxes, cigar holders, tobacco pouches, smokers' pipes, ashtrays, match boxes and humidors," which Office records indicate has been suspended. Opposer's notice of reliance ex. 9. Opposer, a Cuban entity subject to the U.S. embargo on Cuban goods, has also submitted a letter from the Department of Treasury confirming that Cuban entities are permitted under Section 515.527 of the Cuban Assets Control Regulations, 31 C.F.R. Part 515, to "file an opposition to the registration of a new trademark ... where these actions relate to the protection of a trademark in which Cuba ... has an interest." Opposer's notice of reliance ex. 5. In view thereof, we find that opposer has a "real interest" in the outcome of this proceeding; that opposer, as a Cuban entity, is not restricted from pursuing this opposition; and that opposer has established its standing.

Opposer's Section 2(a) Claim

The Federal Circuit, in addressing Sections 2(a) and 2(e)(3) in view of changes to the Trademark Act due to the North American Free Trade Agreement (NAFTA) Implementation

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Act, Pub. L. No. 103-182, 107 Stat. 2057 (1993), has stated as follows:

The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under §1052(a).

As a result of the NAFTA changes to the Lanham Act, geographic deception is specifically dealt with in subsection (e)(3), while deception in general continues to be addressed under subsection (a). Consequently this court anticipates that the PTO will usually address geographically deceptive marks under subsection (e)(3) of the amended Lanham Act rather than subsection (a). While there are identical legal standards for deception in each section, subsection (e)(3) specifically involves deception involving geographic marks.

In re California Innovations, Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1856-57 (Fed. Cir. 2003). See also *In re South Park Cigar, Inc.*, 82 USPQ2d 1507, 1509 (TTAB 2007) (the appropriate refusal for an examining attorney in an ex parte matter involving an allegedly geographically deceptive mark is only the Section 2(e)(3) primarily geographically deceptively misdescriptive, and not the Section 2(a) deceptiveness refusal). In view thereof, we give no further consideration to petitioner's Section 2(a) claim, but consider the Section 2(e)(3) ground.

Opposer's Section 2(e)(3) Claim

The elements of a Section 2(e)(3) claim are as follows:
(a) the primary significance of the mark is a generally

known geographic location; (b) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark (i.e., that a goods-place association exists), when in fact the goods do not come from that place; and (c) the misrepresentation would be a material factor in the consumer's decision to purchase the goods. *California Innovations*, 66 USPQ2d at 1858. We address each of these elements in turn below.

a. The primary significance of the mark is a generally known geographic location.

Opposer has shown from entries in *The Columbia Gazetteer of North America* (2000) that "Guantanamo" is the name of a city in eastern Cuba of about 200,000 people and is the name of the province in which that city is located; and that Guantanamo Bay, Cuba, in Guantanamo province, is the site of a United States naval base. Opposer's notice of reliance ex. 11. Through numerous articles in *The New York Times*, *The Miami Herald* and other newspapers regarding the naval base and the U.S. detention facility for terrorism suspects located at the naval base, opposer has established that the relevant public, composed of consumers of cigars in the United States, is familiar with Guantanamo Bay, Cuba, which is also referred to in newspapers as "Guantanamo." See opposer's notice of reliance ex. 12 and 13. We therefore find that opposer has established that

Guantanamo is a geographic location in Cuba and that Guantanamo, Cuba is known to the relevant public.

Opposer has also established that "guantanamera" is translated from Spanish to "female person from Guantanamo," and "of or from Guantanamo." "Guantanamera" is defined in *Larousse Gran Diccionario* (2d ed. 2002) as "of/from Guantanamo (Cuba)" and as the feminine form for "person from Guantanamo (Cuba)." Opposer's notice of reliance ex. 22. Similarly, *Lema Diccionario De La Lengua Espanola* (1st ed. 2001) defines "guantanamera" as "related to Guantanamo, a Cuban locality, or to its inhabitants," and as the feminine form for a "[person] who is from Guantanamo: a country girl from Guantanamo," and *Diccionario de la Lengua Espanola, Real Academia Espanola* (3d ed. 2001) defines "guantanamera" as "[a] native of Guantanamo" and "[b]elonging to or related to this Cuban city or province." Opposer's notice of reliance ex. 20 and ex. 21.

Professor Gonzalez,⁴ opposer's expert, has testified regarding the significance of the "era" ending in Spanish

⁴ Professor Gonzalez was born in Cuba and is a tenured Professor of Writing, Literature and Publishing at Emerson College, Boston, Massachusetts, and is fluent in both Spanish and English. The focus of her academic research has been on Cuban literature and culture, she has published numerous works on Cuban literature and Cuban writers, and she has translated the works of Spanish language authors into English. Gonzalez dep. ex. 1.

words.⁵ She testified that the "era" ending of "guantanamera" is the standard form in Spanish to express that a female is from a place that ends in a vowel: "in the Spanish language, usually when you are a person of a certain city that ends in a vowel, you [add] the ero or era ending ... If you happen to be from Guantanamo, you are Guantanamero or Guantanamera," in the same way that a New Yorker is someone from New York. Gonzales dep. at pp. 36 - 37. According to Professor Gonzalez, who has taught Spanish, this grammatical rule in Spanish is "common knowledge" which is taught to middle and high school students in the United States who are learning Spanish. *Id.* at p. 37.⁶

Applicant argues "'Guantanamera' has a wide-spectrum of meanings." Brief at p. 29. One meaning applicant

⁵ Applicant's arguments regarding the weight to be accorded to Professor Gonzalez's testimony set forth in applicant's objections to opposer's notice of reliance are noted. We do not find any of such arguments particularly persuasive, and therefore accord Professor Gonzalez's testimony full weight. Specifically, applicant has not established that Professor Gonzalez's testimony is biased and we deem the sources she relied upon in arriving at her opinions to be sufficient. Further, applicant's contention that she should have considered other meanings of "guantanamera" understood by Cuban-Americans is not well taken; we do not restrict our consideration of Section 2(e)(3) to Cuban-American consumers of cigars, and applicant has not offered any evidence to show that Spanish speaking consumers in the United States who are not Cuban-Americans would know of such other meanings of "guantanamera."

⁶ Applicant's challenge to Professor Gonzalez's testimony on the basis that she did not consult dictionaries which contain the etymology of "guantanamera" or the multi-volume version of *Diccionario de la Lengua Espanola* is not well taken; applicant has not introduced any evidence from such dictionaries which

relies upon is the third definition of "guantanamera" in *Diccionario de la Lengua Espanola, Real Academia Espanola*, namely, "coloq. Cuba. A harsh or impudent reprimand. To make, give, form, cause a guantanamera." As to this definition, we find that it is not the primary meaning of "guantanamera." First, this definition is not identified as generally used in Spanish but is identified as a colloquial Cuban term, and we do not consider only Cuban-Americans in determining the meaning of "guantanamera." Second, it would not be logical to give "guantanamera" the "harsh or impudent reprimand" meaning when a more appropriate meaning in the context of a cigar is a meaning concerning the origin of the cigar or its tobacco. Third, Prof. Gonzalez, who has for many years studied the Spanish language and Cuban literature, and has traveled to Cuba and other Spanish-speaking countries, has testified that she was not aware of the third definition in *Diccionario de la Lengua Espanola, Real Academia Espanola*, prior to consulting the dictionary. Gonzalez dep. at pp. 62 - 63. We thus conclude that the meaning is not widely understood or used among Spanish-speaking consumers of cigars in the United States.

Applicant also relies on entries in *Diccionario Mayor de Cubanismos* (1st ed. 1999) (translated as "The Great

contradict any materials that Professor Gonzales consulted or her

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Dictionary of Cuban Expressions"), applicant's notice of reliance ex. 5, which contains the following expressions incorporating "guantanamera":

No me mezcles en esa Guanta[na]mera [Don't get me mixed up in that mess.]

Cantar hasta la Guantanamera. [Tell it all when one is stopped by the police.]

Cantarle a alguien la Guantanamera. [To have died.]

Meter una Guantanamera. [Make a terrible fuss with someone. Create a big ruckus.]

Se algo una Guantanamera. [To be very tragic.]

The uses of "Guantanamera" in *Diccionario Mayor de Cubanismos* are all within multi-word expressions; applicant's mark is not part of an expression but is simply the single word "guantanamera." Thus, the expressions from *Diccionario Mayor de Cubanismos* are inapposite. Also, the evidence suggests that only Cubans and Cuban-Americans use these expressions, and, as noted above, we do not consider only Cuban-Americans in determining the meaning of "guantanamera." Further, Professor Gonzales testified that these expressions are "street expressions." Gonzalez dep. at p. 67; Gonzales dep. ex. 1 at ¶ 22. We hence conclude that they would not be widely known to Spanish-speaking consumers of applicant's goods.

testimony.

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In addition, Mr. Montagne, applicant's president, has testified as follows regarding the meaning of "guantanamera"; "Guantanamera is a mess, it's a problem. It's a type of musical rhythm. When someone dies they say you got the Guantanamera. When your husband leaves you, you got the Guantanamera." Applicant's notice of reliance ex. 1 (Montagne discovery dep. at p. 74). His testimony is not persuasive in that the meanings he testifies to appear to be the same as or similar to those identified in the dictionary of Cuban expressions, which we do not find applicable in this case. Also, with respect to those meanings that he has testified to and are not the same as the definitions listed in the dictionaries of record, his testimony is not corroborated by any documentary evidence. Further, Mr. Montagne has acknowledged that one definition of "guantanamera" is "a woman from Guantanamo." *Id.*

We now consider applicant's contention that the primary meaning of GUANTANAMERA to the relevant public is a Spanish language folk song. Brief at p. 29. The evidence that has properly been made of record reflects that the band "The Sandpipers" recorded a version of the song "Guantanamera" which reached Number 9 on Billboard's popular music chart in 1966; that American folk singer Pete Seeger, who formed musical groups in the 1940s, recorded the song; that Celia Cruz, the "icon of Cuban music" and

"prominent singer for the Cuban-American community" sang "Guantanamera" in one of the scenes in the film *The Mambo Kings*; and that the song is widely know among the Cuban-American community. Opposer's notice of reliance ex. 11 and 36; Gonzales dep. pp. 45 - 49 and Gonzales dep. ex. 1 at ¶ 11. The song "Guantanamera" has been discussed in numerous articles in *The Miami Herald* and *The New York Times* and is the subject of certain webpages. Opposer's notice of reliance ex. 14 and 15, and ex. 30, 31 and 38, which are subject to the parties' stipulation regarding the authenticity of certain evidence. Further, Professor Gonzalez has stated in her expert report that "[b]ased on my experience, the word "Guantanamera" is most commonly known to the American public and the Cuban-American community in particular as one of the most famous traditional songs in Cuba, known worldwide, including in the United States." Gonzalez dep. ex. 1, ¶ 10.

Despite this evidence, we are not persuaded that the consuming public would recognize the primary meaning of the mark in the context of applicant's goods as the song "Guantanamera." First, evidence that the song was a hit fifty years ago, was sung by a folk singer from another era or was sung in one scene in a movie is of minor probative value regarding the notoriety of the song today. Second, even if the song is well known in the United States, one of

the refrains in the song includes the phrase "guajira guantanamera," which means "a country girl from Guantanamo." See *Lema Diccionario De La Lengua Espanola*, opposer's notice of reliance ex. 21. Thus, even if consumers consider the mark as referring to the song by the same name, such consumers, who know the song and who know Spanish, will know of the geographic significance of "Guantanamera" from the song's lyrics. We agree with opposer that the song actually reinforces the primary significance of "guantanamera" as a generally known geographic location. Brief at p. 30. Third, Professor Gonzales' statement quoted above regarding the American public's knowledge of the word "Guantanamera" actually supports opposer's position, at least for those who know Spanish; Professor Gonzales also testified that "[i]n the song, 'Guantanamera' refers to a girl from Guantanamo." Opposer's notice of reliance ex. 1 at ¶ 10. Fourth, applicant's goods are cigars, and the record reflects that tobacco and cigars from certain countries, such as Cuba, are more highly regarded than tobacco and cigars from other countries. From this, we can infer that U.S. consumers of cigars, even those who know that Cuban goods cannot be sold in the United States due to the U.S. embargo on Cuban goods,⁷ will have a heightened awareness of terms which

⁷ As to such consumers, they will know of Cuban cigars due to

have a plausible geographic meaning. In the context of applicant's goods, consumers will ascribe the geographic meaning to the mark rather than, as applicant suggests, associate the mark with the title of a Spanish language folk song.

As an alternative argument, applicant states "consumers faced with Applicant's mark would conclude that the trademark engendered a vague Spanish connotation," citing to the Board's decision in *Conagra, Inc. v. Saavedra*, 4 USPQ2d 1245 (TTAB 1987). In *Conagra*, the Board dismissed plaintiff's claims that the mark TAPATIO was deceptive and primarily geographically deceptively misdescriptive, even though there was evidence that the term, used in connection with a hot sauce, denoted people or things from Guadalajara, Mexico. Brief at pp. 29 - 30. *Conagra* is inapposite because in that case, "there [was] no evidence that even a significant portion of the Spanish-speaking consuming public recognizes 'tapatio' as a primarily geographical designation." *Id.* at p. 1249. In the case before us, there is significant evidence that Spanish-speaking consumers of

articles about Cuban cigars in U.S. magazines such as *Smoke* magazine, Morejon ex. 10; and U.S. books such as *Shanken's Cigar Handbook, A Connoisseur's Guide to Smoking Pleasure* (1997) ("Cuba has a long tradition as the source of the best cigar tobacco ... Cuban cigar tobacco is still acknowledged by many as setting the standard that the rest of the world follows"), opposer's notice of reliance ex. 40. They will also know about Cuban cigars through their travels to foreign countries where Cuban cigars are available for sale.

applicant's goods recognize GUANTANAMERA as a primarily geographical designation.

Applicant also argues that even if "'Guantanamera'" means a girl from Guantanamo, or things from or relating to Guantanamo, ... there currently exists a wide spectrum of registered trademarks on the Federal Trademark Record which relate to a feminine adjectival form of a word." Applicant cites to THE GIRL FROM IPANEMA (Registration No. 2842768) for "swimwear, dresses, cover-ups, shorts, sarongs, skirts" and IPANEMA GIRLS (Registration No. 1697110) for "hostessing and cocktail waitressing services." Applicant's notice of reliance ex. 36. Applicant's citation to and reliance on these two registrations is not persuasive; the issue here is not whether a mark is unregistrable because the primary significance of the mark is a generally known geographic location; the issue is whether the mark is primarily geographically deceptively misdescriptive. Thus, a mark may be registered even if its primary significance is geographic, provided that there is no association between the place and the goods or services. See *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889, 893 (CCPA 1982), ("geographically deceptive misdescriptiveness cannot be determined without considering whether the public associates the goods with the place which the mark names. If the goods do not come from the place named, and the public makes no

goods-place association, the public is not deceived and the mark is accordingly not geographically deceptively misdescriptive.").

In view of the foregoing, we find that the primary meaning of the term "Guantanamera" is "of or from Guantanamo, Cuba" or "a female from Guantanamo"; that those consumers of cigars in the United States who speak Spanish would know that Guantanamo is a geographic location and recognize the meaning of "Guantanamera" as "of or from Guantanamo, Cuba" or "a female from Guantanamo"; and that this would be the case especially in the context of applicant's goods. The fact that the term is in the adjectival form of "Guantanamo" does not diminish the geographic significance of the term. See *In re Joint-Stock Co. "Baik"*, 80 USPQ2d 1305, 1310 (TTAB 2006) ("The fact that BAIKALSKAYA is the adjectival form of a geographic term does not diminish its geographic significance"); *In re Jack's Hi-Grade Foods, Inc.*, 226 USPQ 1028 (TTAB 1985) (NEOPOLITAN is primarily geographically deceptively descriptive of sausage). The first element of the Section 2(e)(3) test therefore has been met.

b. Goods-Place Association.

As applied to this case, the second prong of the test requires proof that the public is likely to believe that applicant's cigars originate in Guantanamo, Cuba. *In re*

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Save Venice New York Inc., 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001) ("Under this prong, we consider whether the public would reasonably identify or associate the goods sold under the mark with the geographic location contained in the mark.").

Mr. Morejon, opposer's commercial vice-president, has testified that tobacco is grown today in the region that is now the province of Guantanamo. Morejon dep. at p. 78. Other evidence establishes that the province of Guantanamo is part of the former province of Oriente, and that cigar consumers have been exposed to Oriente as a region in Cuba where tobacco is grown. See entry for "Guantanamo" from *The Columbia Gazetteer of North America* (2000), "[c]reated as one of five prov[ince]s out of old Oriente prov[ince]," opposer's notice of reliance ex. 11; *Perleman's Pocket Cyclopedia of Havana Cigars*, at p. 15 (Los Angeles, 3d ed. 2005), identifying tobacco growing areas "in the center of the island and from Oriente, located at the far eastern edge of Cuba," rebuttal notice of reliance ex. 2; *Cigar Aficionado*, "Guan-tan-a-mera. Oh! Guan-tan-a-mera," Sept. 3, 2002, by James Suckling, identifying tobacco growing areas in eastern Cuba, including "such tobacco areas as ... Oriente," Morejon ex. 9; *Smoke*, "Cuba at the Crossroads" (Summer 2003 ed.) at p. 42, identifying tobacco from the "region of Oriente," Morejon ex. 10; and M. Shanken,

Shanken's Cigar Handbook (Cigar Aficionado), A Connoisseur's Guide to Smoking Pleasure (1997) at pp. 110 - 111, "Cuba's finest tobacco-growing area is the legendary Vuelta Abajo, part of the Pinar del Rio region in western Cuba. Other Cuban cigar-tobacco-growing areas are ... the Oriente and Remedios regions in the southeast," opposer's notice of reliance ex. 40. Also, Mr. Montagne has testified that Guantanamo Province is known as Oriente by many Cubans. Montagne testimonial dep. at p. 71, Montagne discovery dep. at pp. 68 - 69 ("[T]o me it's still Oriente [and] to many Cubans.").

Further, the record reflects that Cuba is renowned for its tobacco and cigars. *The New Encyclopaedia Britannica* (15th ed. 1988) states "[t]he quality products of the tobacco industry, notably Havana cigars, have brought Cuba word fame." Opposer's notice of reliance ex. 42. *The Columbia Gazetteer of North America* (2000) identifies cigars as one of five "important" exports from Cuba, and that such cigars contain "[h]igh-quality tobacco." Opposer's notice of reliance ex. 11. *The Encyclopedia Britannica* (2006) states that one of Cuba's main exports is "tobacco (notably cigars)." Opposer's notice of reliance ex. 41.

Applicant itself has sought to foster an association of its goods with Cuba. In early packaging bearing the mark, applicant falsely included the designation of origin,

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"Guantanamera, Cuba." Montagne discovery dep. p. 128 and Montagne discovery dep. ex. 10 . On such packaging, applicant also included the false claims "Genuine Cuban Tobacco" and "Hecho Por Cubanos 100%" ("Made by Cubans 100%"), although applicant's cigars, which are sold in the United States, do not and legally cannot, contain genuine Cuban tobacco due to the United States' embargo on Cuban goods. Montagne discovery dep. ex. 10; Montagne testimony dep. at p. 25 (Q: "[Y]our cigars come from Honduras?" A. "Yes.") and pp. 139 - 141. Promoting this false goods-place association suggests that applicant intended consumers of its goods to make the same association of the goods with Cuba.

This evidence makes clear that consumers are likely to believe, and we therefore find, that there is a goods-place association between cigars and Guantanamo, Cuba. The second element of the Section 2(e)(3) test therefore has been met.

c. The misrepresentation is a material factor in the consumer's decision to purchase the cigars.

The final prong of the three-part test requires proof that the misleading goods-place association is a material factor in the customer's decision to purchase applicant's cigars. Because opposer has established Cuba's renown and reputation for high-quality cigars, see evidence discussed above, we find that the goods-place association created by

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applicant's mark with Cuba is material in a consumer's decision to purchase applicant's cigars. Applicant evidently believed that the use of Cuban tobacco is a material factor in the decision to purchase a cigar because it included the false claim "Genuine Cuban Tobacco" on its product packaging. Accordingly, we find that the third element of the Section 2(e)(3) test has been met.

Conclusion

Based on the evidence of record and for the reasons discussed above, we find that opposer has satisfied all of the three elements of its Section 2(e)(3) claim. The primary significance of applicant's mark is that of a generally known geographic place; there is a goods-place association, and applicant's goods will not come from the place named; and such goods-place association arising from use of applicant's mark would be material to the decision to purchase applicant's goods. We have considered all of applicant's arguments and evidence to the contrary, but are not persuaded that our conclusion is erroneous.

Fraud

In view of our decision in opposer's favor regarding its Section 2(e)(3) claim, we need not and do not reach opposer's pleaded claim of fraud.

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DECISION: The opposition based on Section 2(e)(3) of the Trademark Act is sustained and registration to applicant is refused.