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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Cubacaney Enterprises**

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Serial No. 75/547,960

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**Christopher J. McDonald and Stewart L. Gitler** of **Hoffman, Wasson & Gitler, PC** for **Cubacaney Enterprises**.

**David C. Reihner**, Trademark Examining Attorney, Law Office 107  
(**Thomas Lamone**, Managing Attorney).

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Before **Seeherman, Hohein** and **Walters**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

**Cubacaney Enterprises** has filed an application to register the mark "CUBACANEY" for "cigars."<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the

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<sup>1</sup> Ser. No. 75/547,960, filed on September 4, 1998, which alleges dates of first use of May 1998.

mark "CANEY," which is registered for "cigars,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), "in any likelihood of confusion analysis[,] two key considerations are the similarity of the goods and the similarity of the marks."<sup>3</sup> Here, inasmuch as applicant's goods are identical to registrant's goods, the focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entireties. Moreover, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ... , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

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<sup>2</sup> Reg. No. 1,237,591, issued on May 10, 1983, which sets forth a date of first use anywhere of January 1950 and a date of first use in commerce of January 16, 1968; affidavit §8 accepted.

<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Turning, therefore, to consideration of the respective marks, applicant argues that, when considered in their entirety, the marks are dissimilar in appearance, sound and commercial impression. Applicant also maintains that the respective marks are distinguishable in connotation inasmuch as the registered mark "CANEY" is "the name of a town in Cuba, or Spanish for the term VALLEY,"<sup>4</sup> while applicant's "CUBACANEY" mark "is a single term having no geographical significance" or other meaning. As to the latter, applicant contends in particular that:

The term CUBACANEY is the combination of two words, CANEY and CUBA, written as one word and in reverse order of what would normally be expected. By reversing the order and writing it as a unitary term, the mark is an arbitrary term and loses any geographical significance.

The Examining Attorney, while acknowledging that applicant is correct that the marks at issue must be compared in their entirety, nevertheless properly points out that our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for

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<sup>4</sup> Among other things, the excerpt of record from The Columbia Gazetteer of the World (1998) lists "Caney" as a "town, Santiago de Cuba prov., E Cuba," which "[h]as iron mines and [a] textile factory" and was the "[s]ite of fort stormed (1898) by Amer. forces during Span.-Amer. War." However, contrary to applicant's assertion, we judicially notice that as set forth in Cassell's English-Spanish Spanish-English Dictionary (1978), "valle" is listed at 1082 as the Spanish word for "valley," while "caney" is defined at 132 as a Spanish term meaning "(Cub.) bend (of river); (Cub., Ven.) log cabin." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du

rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...." 224 USPQ at 751. Here, because of the strong geographical significance of the word "CUBA," especially in relation to cigars, the Examining Attorney insists that the dominant and distinguishing portion of applicant's mark is the term "CANEY," which is identical to registrant's mark.

Specifically, the Examining Attorney urges in this regard that:

It is now well known that Cuba is famous for cigars. No proof of this commonly known fact should be necessary. The growing, picking, and storage of the tobacco and the rolling and aging of the cigars produced differentiate Cuban cigars from all others. Even though applicant's goods are not grown or produced in Cuba, the use of the word Cuba in relation to cigars is ... suggestive of their style. Purchasers would think that applicant's goods have some relation to Cuba in that the cigars are produced from Cuban seed tobacco or are rolled or aged using the same techniques utilized by Cuban cigar producers or that the same craftsmanship learned by Cuban émigrés, while they were in Cuba, is now used in producing applicant's goods.

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Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In the case of *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB, 1984), a likelihood of confusion was determined to be present between the marks "Collegian of California" and design and "Collegienne" and design[,] both for clothing[,] because the word "California signaled to purchasers that the goods so branded formed a new line of "Collegienne" clothing featuring a "California" or west coast style. Similarly, in the case of *Henri Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154 (TTAB, 1087), a likelihood of confusion was determined to be present between the mark "Chic" and the mark "L.A. Chic" even though the geographical location "L.A." was added to the word "Chic" as a prefix. The Board indicated that the mark 'L.A. Chic' is simply a variation of petitioner's mark 'Chic' used to designate a particular line of clothing made by petitioner in Los Angeles, California, or being of the style prevalent there." *Henri Siegel*, supra, 1161. ....

Here, the same holds true. Because the word "Cuba", used to form the mark "Cubacaney", is ... suggestive of the style of applicant's goods, it is weak and has been given less weight when the likelihood of confusion was considered vis-à-vis the mark "Caney". ....

In reply, applicant does not take issue with the Examining Attorney's assertions regarding the renown of Cuba for cigars. Instead, applicant contends that the cases relied upon by the Examining Attorney are "easily distinguishable from the instant case." Among other things, applicant asserts that in this case, "the word 'CUBA' is neither descriptive of the origin, or suggestive of the style[,] of the good[s] to which the mark is applied." Specifically, applicant maintains that this case "is distinguishable in that it involves two single word marks and the term 'CUBA', as a first component of a single word, loses any geographical connotation to the average consumer." Applicant

therefore concludes that "[t]he instant mark, CUBACANEY, is an arbitrary term and, taken as a whole, creates a commercial impression so differing from the mark CANEY" that there is no likelihood of confusion.

We agree with the Examining Attorney, however, that confusion is likely from the contemporaneous use of the marks "CUBACANEY" and "CANNEY" in connection with cigars. Contrary to applicant's contentions, we believe that the average cigar purchaser in the United States would not be aware of any geographical or other significance for the term "Caney," but would certainly be cognizant of, and would appreciate the significance of, the geographical term "Cuba," especially as such term relates to cigars. Consequently, the ordinary consumer of cigars in this country would regard registrant's "CANNEY" mark as an arbitrary designation and would likewise view the "CANNEY" portion of applicant's "CUBACANEY" mark, when considered in its entirety, as an arbitrary element, particularly since the presence of the term "CUBA" in applicant's mark has such a strong geographic connotation in connection with cigars. The fact that the word "CUBA" in applicant's "CUBACANEY" mark is telescoped into a single term, rather than being set forth as a separate word, simply does not alter the descriptive significance of such word or lessen its recognition, given the notoriety of Cuba for cigars. Consequently, it is the arbitrary term "CANNEY," which obviously is identical to registrant's mark, which functions as the principal source-indicative portion of applicant's "CUBACANEY" mark.

In view thereof, it is readily apparent that the term "CANEY" in applicant's "CUBACANEY" mark constitutes a prominent and significant element thereof, resulting in a mark which, when considered in its entirety, is substantially similar in sound, appearance and overall commercial impression to registrant's "CANEY" mark. Confusion as to origin or affiliation is likely to occur from the contemporaneous use of the respective marks in connection with identical goods, namely, cigars. Even assuming, moreover, that purchasers acquainted with registrant's "CANEY" mark would notice the "CUBA" feature of applicant's "CUBACANEY" mark, they still would be likely to believe, for example, that registrant has expanded its goods to include a new line of cigars evocative of those made in Cuba.

**Decision:** The refusal under Section 2(d) is affirmed.