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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bacardi & Company Limited

Serial No. 74/534,896

William R. Golden, Jr., Kelley, Drye & Warren for applicant.

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

Before Sams, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Bacardi & Company Limited has filed a trademark
application to register the mark, HAVANA STYLE¹ for "rum."

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(3) of the Trademark Act, 15
U.S.C. 1052(e)(3),² on the ground that applicant's mark is

¹ Serial No. 74/534,896, in International Class 33, filed June 8, 1994, based on a bona fide intention to use the mark in commerce. The application includes a disclaimer of the term STYLE apart from the mark as a whole.

² The amendments to Section 2 of the Trademark Act of 1946 made by Public Law 103-183, 107 Stat. 2057, The North American Free Trade Enactment Act, apply to applications filed on or after December 8, 1993. Prior to these amendments, the prohibitions against registration on the

primarily geographically deceptively misdescriptive in connection with its proposed goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

In order for registration to be properly refused under Section 2(e)(3), it is necessary to show that (i) the mark sought to be registered is the name of a place known generally to the public; and that (ii) purchasers are likely to believe, mistakenly, that the goods or services sold under applicant's mark have their origin in or are somehow connected with the geographic place named in the mark. *In re Nantucket, Inc.*, 677 F.2d 95, 213 USPQ 889 (CCPA 1982). *See also, In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988), citing *In re Societa Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987).

The issues presented in this case are identical, and the facts are similar, to those presented in the appeals in applications Serial Nos. 74/534,897 (HAVANA SELECT),

grounds that a mark is primarily geographically descriptive or that a mark is primarily geographically deceptively misdescriptive were contained in Section 2(e)(2) of the Act. Under the law as amended, the prohibition against registration on the ground that a mark is primarily geographically deceptively misdescriptive is contained in Section 2(e)(3) of the Act, which is applicable to the cases herein. The legal standard for determining this issue has not changed, although marks found to be primarily geographically deceptively misdescriptive are no longer eligible for registration under the provisions of Section 2(f) of the Act, subject to certain grandfather provisions.

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74/535,875 (HABANA CLASICO), 74/535,192 (OLD HAVANA),
74/532,342 (HAVANA PRIMO), and 74/532,527 (HAVANA CLIPPER).

We affirm the refusal herein for the reasons asserted in the single decision of the Board in those cases and we incorporate that decision by reference herein. A copy of the Board's decision is enclosed.

With respect to the mark in this case, we briefly address the question of whether the addition of the term STYLE to the geographic term HAVANA detracts from the primary geographic significance of the proposed composite mark, HAVANA STYLE.³

Regarding this issue, applicant merely reiterates its unsupported contention that the mark "evokes the image of a pre-Castro, free-wheeling lifestyle that would appeal to the purchasers of aged, fine rum"; and makes the also unsupported contention that applicant is "internationally renowned for being the originator of the light style of Cuban rum, aged and carefully blended, which became a favorite in the United States after Prohibition and continues to gain in popularity today." (Applicant's brief, p. 3.) The Examining Attorney contends that, even if the mark conveys that it is "of the Havana type" of rum, that the mark remains primarily geographic as it connotes that

³ The Examining Attorney submitted a definition of STYLE as "n. a particular kind, sort or type, as with reference to form" from *The Random House College Dictionary* (1973), and contends that STYLE is descriptive in relation to alcoholic beverages.

"the rum from Havana is of a particular kind." (Examining Attorney's brief, p. 8.)

We agree with the Examining Attorney that, in this case, the primary connotation of the mark remains geographic. In certain cases, by adding the word STYLE to a geographic term in a mark, the connotation of the mark, when considered in connection with the identified goods or services, may be descriptive of a style of the goods or services rather than primarily descriptive of the geographic origin of the goods or services. However, this determination must be made on a case-by-case basis and will depend on a balancing of the evidence of a goods/place association and any evidence that the geographic term is also descriptive of a style of the goods or services. In this case, while there is strong evidence that HAVANA is a geographic location for which rum is a significant product so that, as concluded herein, consumers are likely to make a goods/place association, there is no evidence to support applicant's contention that consumers would be aware of a HAVANA style of rum. Further, even if consumers might understand the mark HAVANA STYLE as also identifying a style of rum, there is no evidence that consumers would not also believe, primarily, that all such rum comes from HAVANA. Thus, we conclude that HAVANA STYLE remains primarily geographic in connotation.

In further support of our conclusion that the addition of the word STYLE to HAVANA does not alter its primary significance as indicating geographic origin in connection with applicant's rum, we note the recent amendment to Section 2(a) of the Trademark Act,⁴ as indicated in bold print:

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 --
(a) consists of or comprises . . . **a geographical indication which, when used in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after [January 1, 1995].**

This amendment, contained in P.L. 103-465, implements the United States' obligations under the Agreement Establishing the World Trade Organization (WTO) and the annexed Uruguay Round agreements, which includes the Agreement on the Trade Related Aspects of Intellectual Property (TRIPs). Of relevance to us in this case, is Article 23 of Section 3 [Geographical Indications]⁵ of the TRIPs Agreement, which states, in pertinent part, as follows:

Each Member shall provide the legal means for interested parties to prevent use of a geographical indication . . . identifying spirits

⁴ Public Law 103-465, § 522, 108 Stat. 4982, the Uruguay Round Agreement Act, signed into law on December 8, 1994, and effective January 1, 1996.

⁵ Geographical indications are defined in TRIPs Article 22(1) as "indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin."

not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind," "type," "style," "imitation" or the like.

This prohibition, required by the TRIPs Agreement and implemented by the amendment to Section 2(a) of the Trademark Act of P.L. 103-465, is an absolute prohibition against the registration, in connection with wines or spirits, of a mark that includes a geographical indication if the wines or spirits do not originate in that geographic area.⁶ Further, the language of Section 23 of the TRIPs Agreement makes it clear that the addition of certain terms, in particular STYLE, does not alter the primary geographic significance of the geographic indication. While the refusal to register in the case before us is under Section 2(e)(3), rather than Section 2(a), the question of the geographic connotation of the mark is the same under both sections. Thus, we believe these amendments to Section 2(a) and the reasons therefor are very relevant to our

⁶ See, Senate Report No. 103-412, *Joint Report of the Committee on Finance, Committee on Agriculture, Nutrition, and Forestry, Committee on Governmental Affairs of the United States Senate to Accompany S. 2476, Uruguay Round Agreements Act*, p. 226, which states: "TRIPs requires WTO member countries to refuse or invalidate a registration of any trademark consisting of a geographic indication identifying wines or spirits not originating in the place indicated. Section 522 of the bill amends section 2 of the Trademark Act to provide that marks for wines or spirits are not registerable to the extent they include a geographical indication if in fact, the wines or spirits do not originate in that geographic area."

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consideration herein of the connotation of HAVANA STYLE as primarily geographic.⁷

⁷ We do not consider herein the propriety of a refusal to register in this case under Section 2(a). However, while this intent-to-use application was filed and examined prior to the effective date of the noted amendments to Section 2(a), if applicant was to submit an amendment to allege use or a statement of use indicating that use of the mark commenced subsequent to January 1, 1995, it would be appropriate for the Examining Attorney to consider whether to refuse registration under the provisions of Section 2(a) as amended by P.L. 103-465.

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Decision: The refusal under Section 2(e)(3) of the Act is affirmed.

J. D. Sams

T. J. Quinn

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board