

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 21, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Compania Tabacalera Santiaguense, S.A.

Serial No. 74/719,339

Stewart J. Bellus of Collard & Roe, P.C.
for Compania Tabacalera Santiaguense, S.A.

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

Before Sams, Simms and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Compania Tabacalera Santiaguense, S.A. (a corporation
of the Dominican Republic) has filed an application to
register the mark LA HABANERA for cigars.¹

Registration has been finally refused on the grounds
that the mark is primarily geographically deceptively

¹ Serial No. 74/719,339, filed August 23, 1995, claiming a date
of first use of April 21, 1922 and a date of first use in
commerce of October 9, 1980. The statement is set forth in the
application that "La Habanera is a Cuban dance."

misdescriptive under Section 2(e)(3) and geographically deceptive under Section 2(a). Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The determination of whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) requires analysis under the following two-prong test:

- (1) whether the primary significance of the mark as it is used is a generally known geographic place; and
- (2) whether the public would make a goods/place association, i.e., believe the goods for which the mark is sought to be registered originate in that place.

Institut National des Appellations D'Origine v. Vintners International Co. Inc., 958 F.2d 1574, 22 USPQ2d 1190, 1195 (Fed. Cir. 1992), citing In re Societe Generale des Eaux Minerales de Vittel, S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); In re Nantucket, Inc., 677 F.2d 95, 213 USPQ 889 (CCPA 1982); In re Bacardi & Co., 48 USPQ2d 1031 (TTAB 1997). In order for a mark to be geographically deceptive under Section 2(a), it must be shown that the mark is primarily geographically deceptively

misdescriptive under Section 2(e)(3) and additionally that the geographic misrepresentation is material to the decision of the purchaser to buy the goods bearing this mark. *Institut National v. Vintners International, supra; In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992).*²

Here the major issues arise under the first prong of the test. Applicant has set forth in its application the statement that "La Habanera" is the name of a Cuban dance and maintains that this is the meaning or primary significance of its mark. The Examining Attorney, on the other hand, has introduced definitions from Spanish-English dictionaries of the term "habanera" as meaning "of Havana" or "native of Havana." On this basis, the Examining Attorney argues that the primary significance of LA HABANERA, as used by applicant, is as a reference to something that originates from Havana.

² Section 2 of the Trademark Act was amended by Public Law 103-183, 107 Stat. 2057, The North American Free Trade Enactment Act, effective for applications filed on or after December 8, 1993. As a result, the prohibition against registration on the basis of being primarily geographically deceptively misdescriptive was moved from Section 2(e)(2) to Section 2(e)(3) and the availability of Section 2(f) for marks of this nature was eliminated. Thus, the major distinction between being refused registration as primarily geographically deceptively misdescriptive and geographically deceptive under Section 2(a) no longer exists, in that registration under the provisions of Section 2(f) is not an option in either case.

Looking to the dictionary definitions of record, we see that the definition that has been submitted by applicant from an English language dictionary for "habanera" is:

1. A Cuban dance in slow duple time
 2. the music for the habanera.
- Webster's Ninth New Collegiate Dictionary*³

The definitions relied upon by the Examining Attorney, as found in Spanish-English dictionaries, are:

- habanero/a
1. *adj.*, of or from Havana
 2. *nm/f.*, native or inhabitant of Havana.
- Collins Spanish-English, English-Spanish Dictionary* (1993)

- habanero, -ra, *a., n.m.f.* (native) of Havana
- Cassell's Spanish-English, English-Spanish Dictionary* (1978).

In each of the latter dictionaries, there is also a listing for "habanera," without any translation, as a musical term.

Applicant makes two arguments with respect to the meaning of its mark LA HABANERA. First, applicant insists that the mark should not be translated at all, since it is a recognized word in the English language. To demonstrate this recognition of the term "habanera" in its musical sense in the English language, applicant has made of record

³ The definitions in *The Random House Dictionary* (2d ed.) are nearly identical.

various Internet excerpts and copies of programs and brochures showing use of the term to refer to either the dance form or music for the dance. Second, applicant argues that, even if the mark is translated, it refers to a female person from Havana, not an object from this location. Applicant argues that the addition of the article "La" requires that the mark be considered as a noun, and not as an adjective, as would be the appropriate form, if descriptive of the geographic origin of goods.

We do not agree with applicant's initial argument that the mark should not be translated at all, but taken solely for its meaning in the English language. While "habanera" may be recognized as a musical term in the English language by some purchasers of cigars, we believe that most would be likely to view applicant's mark as a Spanish term. Thus, the translations must be taken into consideration. In doing so, we simply are following the well established rule that no distinction will be made between an English term and its foreign equivalent, so that if the translation of LA HABANERA is geographically descriptive, the mark is equally so, even though the Spanish term may not be readily known to the United States public. See *In re Atavio Inc.*, 25 USPQ2d 1360 (TTAB 1992) and the cases cited therein.

Furthermore, and as pointed out by the Examining Attorney, we must determine the most appropriate or relevant meaning for LA HABANERA as applied to applicant's goods, namely, cigars. See In re Jack's Hi-Grade Foods, Inc., 226 USPQ 1028 (TTAB 1985)[while term "Neapolitan" has several dictionary definitions, only its meaning as a geographic term is logical when used in connection with sausage]. Although in Spanish "habanera" is also the name given to a Cuban dance, we do not believe most purchasers of applicant's goods would be likely to make any association between a Cuban dance and cigars. On the other hand, even when strictly translated from the Spanish language, and with attention being given to the presence of the article "La", applicant's mark refers to a female inhabitant of Havana or a female Havanan. Given this meaning, we believe that the mark possesses a geographic connotation, just as the term "the American," even when used as a noun, has a geographic connotation. Although the reference is gender specific in Spanish, whereas in English "the American" could be either masculine or feminine, the geographic significance is not lost. In view of the well-known association of cigars with Havana, we find that the reference to geographic origin would be the most logical interpretation of LA HABANERA, as used on applicant's

goods. Even if potential purchasers were not familiar with Spanish, we find it highly likely that at least a general connection would be made between the mark LA HABANERA and the geographic location Havana. We find no need to take the further step of determining the propriety of translating applicant's mark in the adjectival form advanced by the Examining Attorney, namely, "of or from Havana."

Insofar as the second prong of the test is concerned, applicant has conceded that there is a goods/place association between Havana and cigars. (Brief, p.2). Thus, it is not necessary for us to review the evidence submitted by the Examining Attorney to establish this relationship. Nor must we consider any effect that the U. S. trade embargo with Cuba might have on the availability of cigars from Havana, this issue not having been raised by applicant. For a general discussion of this matter, see *In re Bacardi & Co., Ltd.*, supra at 1035-37.

Accordingly, since applicant is a corporation of the Dominican Republic and has made no contention that its cigars originate from other than the Dominican Republic, we find the mark LA HABANERA primarily geographically deceptively misdescriptive of applicant's goods. Likewise, since applicant has failed to contest the refusal under

Section 2(a) on any other basis than the primary significance of its mark, we find the mark geographically deceptive under Section 2(a).

Applicant has raised the additional argument that there is a viable presumption that its mark is registrable, because of the issuance of a prior registration to applicant for the same mark and the same goods in 1984,⁴ which registration was inadvertently allowed to lapse for failure to file a Section 8 affidavit. Applicant points out that the statement made in that registration that "La Habanera refers to a Cuban dance or a female person" was accepted by the Office and the registration was allowed to issue.

Once a registration has been cancelled under the provisions of Section 8 of the Trademark Act, however, it cannot serve as evidence of any existing rights in the mark. In re Grey Hosiery Mills, 137 USPQ 455 (TTAB 1963). The decision of a prior Examining Attorney to register the mark in 1984, based on a record which is not before us, can have no bearing upon our present determination. By failing to timely file a Section 8 affidavit, applicant has opened up its mark to reexamination under present standards.

⁴ Reg, No, 1,297,961, issued Sept., 25, 1984, cancelled under Section 8 Feb. 12, 1991.

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Decision: The refusals to register under Section
2(e)(3) and 2(a) are affirmed.

J. D. Sams

R. L. Simms

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board