

9/18/01

**THIS DISPOSITION
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Paper No. 9
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Republic Tobacco L.P.

Serial No. 75/657,359

Antony J. McShane of Katten Muchin & Zavis
for Republic Tobacco L.P.

Curtis W. French, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Hairston, Wendel and Rogers, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Republic Tobacco L.P. has filed an application to
register TOBACCO WRAPS for "cigarette rolling papers made
with tobacco leaves."¹

Registration has been finally refused under Section
2(e)(1) on the ground that the mark, if used in connection
with applicant's goods, would be merely descriptive
thereof. The refusal has been appealed and applicant and

¹ Serial No. 75/657,359, filed March 10, 1999, based on an
allegation of a bona fide intention to use the mark in commerce.

the Examining Attorney have filed briefs. An oral hearing was not requested.

As a preliminary matter, the Examining Attorney has objected to the copies of third-party registrations which applicant has attached to its brief as being untimely new evidence under Trademark Rule 2.142(d). Applicant contends that it is simply curing the defect previously pointed out by the Examining Attorney when applicant submitted only listings of the registrations. Applicant requests that the copies be considered as acceptable versions of evidence previously submitted. In the alternative, applicant requests that the Board suspend the appeal and remand the case to the Examining Attorney for consideration of the evidence.

The copies of the third-party registrations attached to applicant's brief in Exhibit B are clearly untimely under Trademark Rule 2.142(d). Applicant could have timely corrected the defect pointed out by the Examining Attorney by filing the evidence as part of a request for reconsideration.² Applicant did not avail itself of this opportunity and accordingly the evidence in Exhibit B will

² We also note that the third-party registrations of Exhibit B to the brief cover more than the marks earlier noted by applicant, the "WRAP" registrations not having been previously listed.

be given no consideration.³ Applicant's alternative request for a remand is denied, there being no good cause therefor.

Turning to the refusal under Section 2(e)(1), the Examining Attorney argues that the term TOBACCO WRAPS, when used in connection with applicant's cigarette rolling papers made of tobacco, merely describes a feature of and a use for the goods. In the first place, the Examining Attorney argues, the term merely describes applicant's goods as a "wrap" made of tobacco leaves used to roll and enclose "tobacco." Or, looking at the term in another way, the term merely describes the goods of applicant as cigarette rolling "wraps" made of "tobacco." The Examining Attorney has introduced dictionary definitions of the terms "tobacco" and "wrap" to support his refusal,⁴ as well as evidence both from the NEXIS database and the web page of a competitor of the use of the term "wrap" to describe tobacco or cigar rolling materials.

³ We would add that, even if this evidence had been considered, our decision would be the same.

⁴ The definitions relied upon by the Examining Attorney are as follows:

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| tobacco | any of the various plants of the genus <i>Nicotiana</i> , especially <i>N. tabacum</i> , native to tropical America and widely cultivated for its leaves, which are primarily used for smoking. |
| wrap | n. wrapping or wrapper
v. to enclose, especially in paper, and fasten. |

All definitions come from *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

Applicant argues that thought and imagination are necessary to determine the specific nature of the goods with which applicant uses the mark TOBACCO WRAPS. Applicant contends that the combination of the two descriptive words TOBACCO and WRAPS does not result in a combination which is merely descriptive but rather one which creates ambiguity and thus requires thought and perception on the part of the public. Applicant insists that WRAP brings to mind various connotations, either that of the "contemporary fascination with wrapped foods," or that of the superiority of cigars over cigarettes, since the term "wrapper" has long been used for the finishing leaf for cigars, or that of the method of use of the object. The term TOBACCO is argued to also raise conflicting impressions since cigarette rolling papers are conventionally made of wood pulp paper, whereas applicant's products are made substantially of processed tobacco leaves. As a whole, applicant argues that TOBACCO WRAPS requires the public to use some thought to decide whether it refers to qualities of the papers themselves or to the materials being rolled.

In addition, applicant argues that the Examining Attorney has failed to provide evidence that "tobacco wraps" has been used descriptively for cigarette rolling

papers. Applicant insists that the only uses shown by the Examining Attorney, particularly that of the use by a competitor, relate to cigar wrappers, not cigarette rolling papers.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, function, feature or use of the goods with which it is being used or is intended to be used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term or phrase is merely descriptive is determined not in the abstract, but rather in relation to the goods for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

We find the dictionary definitions relied upon by the Examining Attorney sufficient in themselves to establish the descriptiveness of TOBACCO WRAPS, when used in connection with cigarette rolling papers made with tobacco leaves. In one sense, the "wraps" are wrappers used to

enclose other material and this other material is "tobacco," thus, they are "wraps" for "tobacco." In another sense, the "wraps" are themselves made of "tobacco" and thus are "tobacco wraps." Either way, the term TOBACCO WRAPS is merely descriptive of applicant's goods. Simply because the term may convey information with respect to applicant's goods in two ways does not detract from the descriptive nature of the term or render the term ambiguous. See *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (affirming refusal based on Board's conclusion that BED & BREAKFAST REGISTRY "would be understood to describe a register of bed and breakfast lodgings, and may convey the related thought of registering at a bed and breakfast lodging."); *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542 (TTAB 1994) ("as to each of these possibilities, the words sought to be registered would be immediately understood to convey information concerning the nature of the services.").

Furthermore, as has often been stated, the descriptiveness of a term is not determined in a vacuum, but in relation to the goods with which the term is being used, or is intended to be used. The question is not whether consumers, upon encountering the term TOBACCO WRAPS in itself, would fully comprehend the nature of the

goods with which it is intended to be used. Instead, the question is whether consumers, upon seeing TOBACCO WRAPS being used in connection with cigarette rolling papers made with tobacco leaves, would immediately comprehend the informational significance of the term. We are convinced that consumers would immediately understand the descriptive significance of TOBACCO WRAPS when viewed in connection with applicant's goods, whether as describing the cigarette papers as "wraps" for "tobacco" or as "wraps" made of "tobacco." No thought or imagination is necessary to make this correlation.

Finally, even if there were no evidence of use of the term "tobacco wraps" by others in the field for cigarette rolling papers, this would not be dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999). Moreover, we find that there is some evidence of record of use of the term by at least one competitor. Although it is true that the excerpts from the NEXIS database all refer to tobacco being used for "cigar wraps,"⁵ the web page introduced by the Examining Attorney

⁵ We have considered the full version submitted by applicant of the excerpt relied upon by the Examining Attorney with respect to the usage of "metallized paper for a cigarette wrap" and agree that when taken in proper context this reference is to a wrap used to package the cigarettes within the individual packs and

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does contain references to an "all natural tobacco wrap" and to the use of this wrap for "hand-rolling their favorite tobaccos or [to] creatively roll their own cigars, without the harsh taste of paper." As such, it would appear that the use of a "tobacco wrap" for the rolling of cigarettes, as well as cigars, has been contemplated by at least one competitor.

Accordingly, we find TOBACCO WRAPS would be merely descriptive, if used as intended with applicant's cigarette rolling papers made with tobacco leaves.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

not to one for making the cigarette per se. As such this reference is irrelevant.

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