

TTAB Puts Embargo on Kuba Kuba Application for Cigars

February 11, 2011

In a precedential decision, the Trademark Trial and Appeal Board (“TTAB”) held that the mark KUBA KUBA was primarily geographically deceptively misdescriptive when used in connection with cigars and other tobacco products. Accordingly, the TTAB affirmed the refusal to register the mark under Section 2(e)(3) of the Lanham Act. *In re Jonathan Drew, Inc.*, Serial No. 77099522 (T.T.A.B. Jan. 28, 2011).

The TTAB stated that a mark is primarily geographically deceptively misdescriptive if (1) the mark’s primary significance is a generally known geographic location; (2) the relevant public would likely believe that the goods originate in the place named in the mark (*i.e.*, a “goods/place association” exists) when in fact the goods do not come from that place; and (3) the misrepresentation is a material factor in the consumer’s decision.

With respect to the first factor the TTAB said, “Because KUBA looks and sounds similar to Cuba, with no other recognized and/or pertinent meaning attached to that particular spelling, we find that the primary significance of KUBA is the geographic meaning of Cuba. Furthermore, the repeated use of KUBA does not alter its impression as a geographic term.” Accordingly, the TTAB held KUBA KUBA would be perceived as a mere misspelling of “Cuba,” a generally known geographic location, and would not have another significance to the relevant public.

The TTAB’s analysis of the “goods/place association” was brief. The TTAB said that because the evidence showed Cuba is famous for producing cigars and tobacco but the applicant’s cigars are *not* from Cuba and would not incorporate Cuban seed tobacco, “the relevant public would be likely to believe that applicant’s cigars offered under the mark KUBA KUBA come from Cuba, *i.e.*, that a goods/place association exists, when in fact the goods will not come from that place.”

Finally, the TTAB addressed whether this misrepresentation was material to the consumer's decision. The TTAB said, "In order to establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or service by the geographic meaning of the mark." The TTAB highlighted the importance of the second factor when analyzing this third factor, stating that "it has been consistently held . . . that a strong or heightened goods/place association, which we have here, is sufficient to support a finding of materiality."

Based on the TTAB's determination that the primary significance of the mark was Cuba, and in view of the demonstrated reputation of Cuban cigars, the TTAB said it could "infer that at least a substantial portion of consumers who encounter KUBA KUBA on applicant's cigars are likely to be deceived into believing that the cigars come from Cuba," thus supporting a finding of materiality. The TTAB rejected the applicant's argument that direct evidence of actual public deception was required and held that although the relevant public's understanding of a mark may be shown by direct evidence such as consumer testimony and surveys, the public's understanding may also be inferred from indirect or circumstantial evidence, such as reference materials and third-party Web site content.

In its final paragraph the TTAB rejected the applicant's argument that because of the U.S. embargo on Cuban products consumers would not likely believe that the applicant's goods originated in Cuba. Citing decisions from 1997 and 2000, the TTAB explained that it had previously considered and rejected this embargo argument and said that "applicant has offered no evidence that the embargo on Cuban products would have any effect on the perception of KUBA KUBA as a geographically deceptive term."