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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Max Rohr, Inc.

Serial No. 78486814

Charles W. Grimes of Grimes & Battersby, LLP for Max Rohr, Inc.

Margery A. Tierney, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Hohein, Grendel, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On September 21, 2004, Max Rohr, Inc. (applicant) applied to register the mark SAMBUCA, in standard character form, on the Principal Register¹ for "cigars and pipe

¹ Applicant subsequently offered to amend the application to seek registration on the Supplemental Register (Response dated August 22, 2005) but, because it had not filed an amendment to allege use, it was not permitted to amend to that register. 37 CFR § 2.75(b).

tobacco" in Class 34.² The application (Serial No. 78486814) is based on applicant's assertion of a bona fide intention to use the mark in commerce.

The examining attorney refused to register the mark on the ground that the mark is merely descriptive of applicant's goods under 15 U.S.C. § 1052(e)(1). The examining attorney argues that "SAMBUCA is not only used to describe a liqueur. It is a well-known flavor in tobacco products." Brief at unnumbered p. 5. "Because 'SAMBUCA' is a flavoring used in tobacco, applicant's mark SAMBUCA as applied to" applicant's goods, is merely descriptive. Brief at unnumbered p. 7.

Applicant responds by arguing that "[r]ather than describing Applicant's goods, the SAMBUCA mark conjures an indirect connotation of the rich Italian culture where cigars are often enjoyed with an after-dinner drink." Brief at 6. Furthermore, applicant maintains that "there is no such thing as a sambuca flavor. According to the

² Both applicant and the examining attorney at times refer to the goods as "cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco." See Examining Attorney's Brief at unnumbered pp. 1-2 and Reply Brief at 4. *But see* Applicant's Brief at 3 (Applicant "filed its application for ... 'cigars and pipe tobacco'") and Final Refusal at 1 ("cigars and pipe tobacco"). Inasmuch as the goods in the application as filed were identified simply as "cigars and pipe tobacco," they cannot be expanded to include other types of tobacco such as smokeless and roll-your-own tobacco. 37 CFR § 2.71(a). Therefore, we must consider the goods as simply "cigars and pipe tobacco."

definition cited by the Examining Attorney, sambuca is a liqueur flavored with licorice." Brief at 7.

When the examining attorney made the refusal to register final, this appeal followed.

A mark is merely descriptive if it immediately conveys "knowledge of a quality, feature, function, or characteristic of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). See also *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). A characteristic of a product includes its "flavor characteristic." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) and *In re Andes Candies Inc.*, 478 F.2d 1264 178 USPQ 156, 157 (CCPA 1973). To be merely descriptive, a term need only describe a single significant quality, property, or characteristic of the goods or services. *Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Mere descriptiveness is not determined in the abstract but rather in relation to the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

To support her argument that applicant's mark is merely descriptive, the examining attorney submitted a

definition of "sambuca" as meaning "an Italian liqueur made from elderberries and flavored with licorice." See Final Office Action at 2. In addition, the examining attorney submitted internet printouts (emphasis added) that show that cigars and pipe tobacco are flavored and sold as "sambuca" cigars and tobacco.

Aromatic Tobaccos - 700 Series...
747 **Sambuca** - We matched this classic cordial in a pipe tobacco that delivers taste, aroma, and unsurpassed satisfaction.
www.altadisusa.com

PHILLIES - FLAVORED
CIGARS BLUNT **SAMBUCA**
Cigars
If you love Black Licorice you have to try this!
www.lilbrown.com

Lars Tetens Cigars, Acid Cigars, Coffee, Mint, Other Spirits, **Sambuca** Flavored Cigars
www.amishshop.com

The examining attorney also included evidence of the sale of various cigars that are referred to as "Sambuca" cigars.

	Length	Ring
Cojimar Sambuca Senora Corona	5.5	42
Cojimar Sambuca Seniorita	5	30
Taino Sweets Sambuca	5.5	42
www.amishshop.com		
Sambuca Seniorita	5	30
Sambuca Senora	5.5	42
www.cvtobacco.com		

The evidence supports the examining attorney's position that the term "Sambuca" is merely descriptive of cigars and pipe tobacco. Applicant argues that:

Thus, each of these manufacturers is advertising and selling a licorice-flavored tobacco product. In other words, the average consumer must make a leap of imagination to associate the liqueur with the licorice flavor and then to associate that flavor with the flavored tobacco product.

Reply Brief at 3.

Furthermore, "Applicant contends that, unless the goods at issue contain sambuca liqueur as an ingredient, the term 'sambuca' cannot be merely descriptive of the goods." Reply Brief at 3-4.

We note that this is not a case where cigars are advertised as having a licorice flavor and that, when purchasers see applicant's SAMBUCA mark, they will associate the licorice flavor with the licorice flavor of sambuca. Here, the evidence indicates that cigars and pipe tobacco are advertised as having a sambuca flavor. Thus, there is no leap of imagination for consumers to make. The term would immediately inform prospective purchasers of the flavor of the cigars. Furthermore, the examining attorney's position is consistent with the precedent of our primary reviewing court and its predecessor in cases involving flavors. For example, in

Andes Candies, the CCPA held that the term CRÈME DE MENTHE for laminated chocolate mint candy squares that "do not contain any creme de menthe liqueur" was merely descriptive. 178 USPQ at 156.

We think the only possible reaction of purchasers, upon being presented with CREME DE MENTHE chocolate wafers, is the expectation that the wafers will have a mint taste something like that of creme de menthe liqueur. Surely, the purchasers would not expect to find a cherry or rum or butterscotch flavor in the candies.

Id. at 157.

Similarly, in *Gyulay*, the Federal Circuit held that the term APPLE PIE was merely descriptive of potpourri. "It is thus sufficient that the term describes the scent." 3 USPQ2d at 1010.

Thus, even if cigars and pipe tobacco do not actually have sambuca as an ingredient, the term can still be merely descriptive if the goods have a sambuca flavor. The evidence supports the examining attorney's determination that cigars and tobacco have a sambuca flavor and thus we find that the term is merely descriptive.³

³ We add that nothing in *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985), as the case upon which applicant relies, compels a different result. The term sambuca for cigars and tobacco requires no imagination for prospective purchasers to immediately understand that it describes a characteristic of the goods. Furthermore, it is a term that competitors need to use to describe their products.

Applicant argues that its "SAMBUCA mark is, at the very least, suggestive of cigars ... [and] pipe tobacco ... flavored with black licorice. Moreover, Applicant's SAMBUCA mark is arbitrary when used in connection with flavorless cigars" and pipe tobacco. Reply Brief at 4. As we have previously determined, the term SAMBUCA is merely descriptive of cigars and pipe tobacco to the extent that they can be sambuca flavored. Regarding applicant's argument about unflavored tobacco products, we do not address this issue. Applicant has not limited its identification of goods to "unflavored" or "flavorless" tobacco products and therefore its identification of goods includes cigars and pipe tobacco that can have a sambuca flavor. Whether the term SAMBUCA for "unflavored cigars and pipe tobacco" is arbitrary or deceptively misdescriptive is not before us.⁴

Applicant also attaches copies of four registrations and an application to its brief in support of its argument that its mark is not merely descriptive. The examining attorney has objected to three of the registrations and the application. We sustain the objection. 37 CFR

⁴ Even if applicant's "cigars and pipe tobacco will not be flavored with sambuca liqueur" (Brief at 8), it does not foreclose the possibility that they will have a sambuca flavor as the candy in the *Andes* case had a crème de menthe flavor.

2.142(d) ("The record in the application should be complete prior to the filing of an appeal"). *In re L.C. Licensing Inc.*, 49 USPQ2d 1379, 1380 n.3 (TTAB 1998) (Third-party registrations submitted with brief not considered). We add that since one of the marks is a mark in an abandoned application, it would not have been relevant even if it had been timely submitted. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002) ("While applicant also submitted a copy of a third-party application..., such has no probative value other than as evidence that the application was filed").

The examining attorney did address one registration (No. 3,050,147) for the mark CITRUS BLAST for smoking articles that applicant had referenced earlier. The examining attorney pointed out that "the exclusive right to use the term CITRUS, which is a flavoring, was disclaimed." Brief at unnumbered p. 3. We add that the other registrations for different terms, even if we considered them, would have very little relevance. *In re Nett Designs Inc.*, 236 F.3d 1339 57 USPQ2d 1564, 1566 (Fed. Cir. 2003) ("Even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court").

We conclude that the record supports the conclusion that when prospective purchasers encounter the mark SAMBUCA on cigars and pipe tobacco they will immediately understand that the term describe a characteristic of the goods, i.e., their flavor. Therefore, the term is merely descriptive of applicant's goods.

Decision: The examining attorney's refusal to register applicant's mark SAMBUCA on the ground that it is merely descriptive of its goods is affirmed.