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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Max Rohr, Inc.

Serial No. 78489076

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 24, 2004, Max Rohr, Inc. (applicant) applied to register the mark PINA COLADA, in standard character form, on the Principal Register¹ for "cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco" in Class 34. The application (Serial

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).

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No. 78489076) 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:

"Pina Colada" is defined as "a mixed drink made of rum, coconut cream, and unsweetened pineapple juice." However, Pina Colada is not only used to describe a mixed drink. It is a well-known flavor in tobacco products.

Brief at unnumbered p. 5. "Because 'Pina Colada' is a flavoring used in tobacco, applicant's mark PINA COLADA as applied to" applicant's goods, is merely descriptive.

Brief at unnumbered p. 8.

In turn, applicant argues that that "pina colada' is not merely descriptive of its tobacco products. "Rather than describing Applicant's goods, the PINA COLADA mark evokes a Caribbean lifestyle of relaxation and refreshment, conjuring the indirect connotation of a tropical island vacation where cigars can be lazily enjoyed." Brief at 6.

Furthermore, applicant maintains that:

In point of fact, there is no such thing as a pina colada flavor. According to the definition cited by the Examining Attorney, a pina colada is a mixed drink containing rum, coconut cream and pineapple juice. It is these ingredients which give the drink its distinctive flavor. But applicant is not attempting to register the terms "rum," "coconut cream" or

pineapple juice." Were applicant attempting to register these terms, the Examining Attorney's position might possibly be sustainable.

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).

The examining attorney provided the following evidence to support her position that the mark PINA COLADA is merely descriptive. As mentioned earlier, this evidence includes a definition of "Pina Colada." See Final Office Action at 2. In addition, the examining attorney submitted internet printouts (emphasis added) that show that various tobacco products are "Pina Colada" flavored.

PINA COLADA HOOKAH
HOOKAH PREMIUM TOBACCO

A tropical blend of coconut and ripe juice pineapple with the slightest hint of spiced rum, our **Pina Colada** tobacco is a refreshing Caribbean treat.

Only the choicest most selected parts of the hand-picked tobacco leaf is used. Creating a deliciously smooth, mouth-watering smoking experience.
www.hookahhub.com

Pina Colada Flavor Cigarette Tobacco Blend - 6.2 oz. Bag
Pineapple and coconut are the basis for the very popular refreshment that we named this tobacco after.
www.store.yahoo.com/careysmokeshop

True Blunt **Pina Colada**
25 Count Box
www.monstermarketplace.com/TrueBlunts

R.J. Reynolds Criticized for New **Pina Colada** Flavored Cigarettes
www.jointogether.org

Examples of pina colada-flavored cigars offered by Ricardo's Cigar Shop at www.amishshop.com are set out below:

	Length	Ring
Cuban Pleasures Pina Colada	5	36

Island Delights Pina Colada	5.5	42
Phillies Blunt Pina Colada 5 Pack	4.88	42
Salsa Mini Cigars Pina Colada	3.5	22
Ricardo Pleasures Pina Colada	5	26
Tropical Treasures Pina Colada	5	42

The evidence supports the examining attorney's position that the term "Pina Colada" is merely descriptive of various tobacco products inasmuch as these products are referred to as "pina colada" to describe their flavor.

Applicant argues that:

However, in each case, the tobacco manufacturer referred to the distinctive components of a pina colada cocktail, namely, coconut and pineapple, to describe the flavor used in the tobacco. There is no such thing as "pina colada-flavored" tobacco. Each of these manufacturers is advertising and selling a coconut/pineapple/rum-flavored tobacco product. More importantly, these manufacturers clearly know that, without this additional description, customers would not understand that the term "pina colada" is descriptive of flavored tobacco.

Reply Brief at 3.

Furthermore, "Applicant contends that, unless the goods at issue contain pina colada cocktail as an ingredient, the term 'pina colada' cannot be merely descriptive of the goods." Reply Brief at 4.

Applicant's position that the term pina colada can only be merely descriptive of a product that contains a pina colada cocktail is inconsistent 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 tobacco products do not actually have a pina colada cocktail as an ingredient, the term can still be merely descriptive if the goods have a pina colada flavor. We also point out that numerous cigars on the www.amishshop.com website are listed as "Pina Colada" cigars without any explanation of the coconut/pineapple/rum ingredients listed. The term "Pina Colada" simply and immediately describes the flavor of the cigars at least as directly as the combined term coconut/pineapple/rum. The evidence supports the examining attorney's determination that tobacco products

can have a pina colada flavor and, thus, we find that the term is merely descriptive.²

Applicant argues that its "PINA COLADA mark is, at the very least, suggestive of cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco flavored with a combination of rum, pineapple juice and coconut cream. Moreover, Applicant's PINA COLADA mark is arbitrary when used in connection with flavorless cigars, little cigars, roll-your-own tobacco, pipe tobacco or smokeless tobacco." Reply Brief at 4. As we have previously determined, the term PINA COLADA is merely descriptive of cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco to the extent that they can be pina colada 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, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco that can have a pina

² 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 pina colada for tobacco product 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.

colada flavor. Whether the term PINA COLADA for “unflavored cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco” is arbitrary or deceptively misdescriptive is not before us.³

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 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”).

³ Even if “Applicant’s cigars and pipe tobacco will not be flavored with pina colada cocktail” (Brief at 8), it does not foreclose the possibility that they will have a pina colada flavor as the candy in the *Andes* case had a crème de menthe flavor.

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 PINA COLADA on cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless 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 PINA COLADA on the ground that it is merely descriptive of its goods is affirmed.