

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Santana Tesoro, LLC Mark: THE SANTANA COFFEE COMPANY Class: 30 Serial No.: 88/625,712	RESPONSE TO OFFICE ACTION Warren L. Olandria Trademark Examining Attorney Law Office 112
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In an Office Action dated December 19, 2019, the Examining Attorney refused registration of Applicant's mark THE SANTANA COFFEE COMPANY under Trademark Act 2(e)(4), on the grounds that the "Santana" portion of Applicant's mark is "primarily merely a surname." Applicant respectfully disagrees with this conclusion for the following reasons.

The Primary Significance of "SANTANA" to Relevant Purchasers is Not That of a Surname

Surname significance alone is not sufficient to refuse registration under Section 2(e)(4). The ultimate question is not whether a mark exists as or happens to sound like a surname, but rather whether the *primary* significance of the mark to the relevant purchasing public is that of a surname. *Ex parte Rivera Watch Corp.*, 106 USPQ 145, 149 (Comm'r Pats 1955). If the mark has significance other than as a surname, or the mark would be perceived by the consuming public as something other than as a surname, then the mark cannot be refused as "primarily merely" a surname. Indeed, any doubt as to whether the term may be perceived by the relevant consuming public as fundamentally only a surname must be resolved in favor of Applicant. *In re Benthin Management GmbH*, 37 USPQ2d 1332, 1334 (TTAB 1995).

One of the factors used to determine whether a mark is primarily merely a surname is whether the term has any other recognized meaning. *In re Benthin* (TTAB 1995). Here the term Santana does have another meaning that will be immediately recognized by all of Applicant's consumers: it identifies one of the most famous rock bands in the world.

The SANTANA mark is uniquely associated with the legendary musical artist Carlos Santana and his band, Santana. Through Santana's widespread and substantially exclusive use of the SANTANA marks, for over fifty years, as well as extensive and continuous media coverage, a high degree of consumer recognition of the SANTANA mark, Santana's enormous and loyal

fan base and consumer base, and other factors, the SANTANA mark has become an extremely strong, if not famous, mark.

Santana emerged on the worldwide stage with an epic set at Woodstock in 1969. Since then Applicant has sold tens of millions of records and the band has reached millions of fans at concerts worldwide. To date, Mr. Santana and his namesake band have won 10 Grammy Awards, including a record-tying nine for a single project, 1999’s *Supernatural* (including Album of the Year and Record of the Year for “Smooth”), as well as three Latin Grammys. The musical group Santana was inducted into the Rock and Roll Hall of Fame in 1998. The influential music magazine *Rolling Stone* named Mr. Santana Number 15 on its list of the “100 Greatest Guitarists of All Time.” Mr. Santana received Billboard Latin Music Awards’ 2009 Lifetime Achievement honor, Billboard’s Century Award in 1996, and the 2013 Kennedy Center Honors Award.

Through fifty plus years of continuous use by Applicant, the SANTANA mark has acquired distinctiveness in connection with Applicant’s entertainment services. As a result, when used by Applicant, the primary meaning of the term “Santana” to purchasers is not that of a surname—rather, it clearly refers to the band. While Applicant has not previously applied the mark to coffee, it has used the mark on numerous other licensed products such as salsa, chips, sauces, shoes, hats, clothing, guitars, and eyewear. The very reason Applicant is able to successfully license its mark for use on such a broad range of products is because consumers immediately associate the mark with the world-famous band. Licensees are very intentionally paying for the right to associate their products with the band, and they are betting that consumers will want to associate themselves with the culture surrounding the group and its long history.

Applicant is the owner of a number of federally registered trademarks on the Principal Register for the mark SANTANA, including the following:

Mark	Reg. No.	Registration Date	Goods/Services
SANTANA	2581308	June 18, 2002	9: Pickups for electrical musical instruments 15: electric guitars
SANTANA III	2667018	December 24, 2002	15: guitars
SANTANA II	2646763	November 5, 2002	15: guitars
SANTANA	2,996,432	Sep. 20, 2005	9: musical sound recordings
SANTANA	2,876,815	Aug. 24, 2004	41: entertainment, namely, musical live performances
SANTANA BY	4888910		25: hats

CARLOS SANTANA		January 19, 2016	
CARLOS SANTANA ORGANIC NATURE'S FINEST INGREDIENTS	5022677	August 16, 2016	30: Organic salsa and Mexican and Latin American style foods for human consumption, namely, organic tortilla chips.
CARLOS SANTANA ORGANIC NATURE'S FINEST INGREDIENTS	5055176	October 4, 2016	29: Organic sauces, salsas, moles, picante sauces, dips, hot sauce, and other Mexican and Latin American style foods for human consumption, namely, salsas and mole sauces.
CARLOS SANTANA	5059982	October 11, 2016	30: Sauces, salsas, mole sauces; Mexican and Latin American style foods for human consumption, namely, salsas, and mole sauces.
SANTANA BY CARLOS SANTANA	5680855	February 19, 2019	9: eyewear

Each of the above-cited registrations is live and in good standing with the Trademark Office. Copies of each of these registrations are attached as Exhibit 1.

It is well established that an intent-to-use applicant who has used the mark on other goods or services may claim distinctiveness before filing an amendment to allege use if the applicant can establish that, as a result of the applicant's use of the mark on other goods or services the mark has become distinctive of the goods and services in the intent-to-use application, and that the previously created distinctiveness will transfer to the goods in the the intent-to-use application when use in commerce begins. TMEP §1212.09(a) citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). Applicant submits that, when used by Applicant, there is a strong likelihood that the mark's long-established trademark function will transfer to the goods for which registration is currently being sought.

Relevant Board proceedings support Applicant's contention that "primarily merely" means that the mark's primary significance to the purchasing public is as "fundamentally only" a surname. *In re Yeley*, 85 USPQ2d 1150 (TTAB 2007); *see also Michael S. Sachs v. Corson Art B.V.*, 56 USPQ2d 1132, 1136 (TTAB 2000). As used by Applicant on Applicant's products, SANTANA will not be perceived by consumers as "primarily merely" a surname. The entire reason consumers are likely to purchase the product is in fact the perceived connection with the band Santana. Indeed it would be completely antithetical to Applicant's marketing and branding goals not to associate the products with the band Santana. The success of applicant's branding and marketing to date strongly supports this conclusion.

For all of these reasons and under the authorities discussed above, Applicant submits that its THE SANTANA COFFEE COMPANY mark is registrable, and respectfully requests that the Examining Attorney withdraw the refusal to register the mark and approve it promptly for publication.

Respectfully submitted,

DONAHUE FITZGERALD LLP

Date: June 18, 2020

By: /BLF/
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Oakland, CA 94612

Attorneys for Applicant

EXHIBIT 1

United States of America

United States Patent and Trademark Office

SANTANA

Reg. No. 2,581,308

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)

Registered June 18, 2002

2375 E. TROPICANA AVE., SUITE 8, BOX 270

LAS VEGAS, NV 89119

New Cert. Aug. 30, 2011

FOR: PICKUPS FOR ELECTRICAL MUSICAL INSTRUMENTS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

Int. Cls.: 9 and 15

FIRST USE 0-0-1995; IN COMMERCE 0-0-1995.

TRADEMARK

FOR: ELECTRIC GUITARS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

PRINCIPAL REGISTER

FIRST USE 0-0-1995; IN COMMERCE 0-0-1995.

THE NAME "CARLOS SANTANA" IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

SEC. 2(F).

SER. NO. 76-143,165, FILED 10-10-2000.



David J. Kyffers

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

SANTANA III

Reg. No. 2,667,018

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)

Registered Dec. 24, 2002

2375 E. TROPICANA AVE., SUITE 8, #270
LAS VEGAS, NV 89119

New Cert. Sep. 20, 2011

FOR: GUITARS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

Int. Cl.: 15

FIRST USE 1-0-2001; IN COMMERCE 1-0-2001.

TRADEMARK

THE NAME "SANTANA" IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

PRINCIPAL REGISTER

SER. NO. 76-143,167, FILED 10-10-2000.



David J. Kyffers

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SANTANA II

Reg. No. 2,646,763

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)
2375 E. TROPICANA AVE., SUITE 8, #270
LAS VEGAS, NV 89119

Registered Nov. 5, 2002

Amended Sep. 20, 2011

FOR: GUITARS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

Int. Cl.: 15

FIRST USE 1-0-1998; IN COMMERCE 1-0-1998.

TRADEMARK

"SANTANA" REFERS TO CARLOS SANTANA, A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

PRINCIPAL REGISTER

SER. NO. 76-143,168, FILED 10-10-2000.



David J. Kyffers

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United States of America

United States Patent and Trademark Office

SANTANA

Reg. No. 2,996,432

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)

Registered Sep. 20, 2005

2375 E. TROPICANA AVE., SUITE 8, #270

LAS VEGAS, NV 89119

New Cert. Aug. 30, 2011

FOR: MUSICAL SOUND RECORDINGS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

Int. Cl.: 9

FIRST USE 1-31-1969; IN COMMERCE 1-31-1969.

TRADEMARK

OWNER OF U.S. REG. NOS. 2,581,308, 2,667,018 AND OTHERS.

PRINCIPAL REGISTER

SANTANA IDENTIFIES A PARTICULAR LIVING INDIVIDUAL, NAMELY CARLOS SANTANA, WHOSE CONSENT TO THE REGISTRATION OF HIS NAME IS OF RECORD.

SEC. 2(F).

SER. NO. 76-544,570, FILED 9-12-2003.



David J. Kyffers

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

SANTANA

Reg. No. 2,876,815

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)

Registered Aug. 24, 2004

2375 E. TROPICANA AVE., SUITE 8, # 270

LAS VEGAS, NV 89119

New Cert. Aug. 30, 2011

FOR: ENTERTAINMENT, NAMELY MUSICAL LIVE PERFORMANCES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

Int. Cl.: 41

FIRST USE 7-19-1969; IN COMMERCE 7-25-1969.

SERVICE MARK

SER. NO. 76-543,826, FILED 9-11-2003.

PRINCIPAL REGISTER



David J. Kyffers

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SANTANA BY CARLOS SANTANA

Reg. No. 4,888,910

Registered Jan. 19, 2016

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

SANTANA TESORO, LLC (NEVADA LIMITED LIABILITY COMPANY)
6000 S. EASTERN AVE., SUITE 6A
LAS VEGAS, NV 89119

FOR: HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 3-31-2011; IN COMMERCE 3-31-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 3,782,893, 4,008,938 AND OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK IDENTIFIES "CARLOS SANTANA", WHOSE CONSENT(S) TO REGISTER IS MADE OF RECORD.

SER. NO. 86-638,370, FILED 5-21-2015.

MAYUR VAGHANI, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 5,022,677

Registered Aug. 16, 2016

Int. Cl.: 30

Trademark

Principal Register

Santana Tesoro, LLC (NEVADA LIMITED LIABILITY COMPANY)
6000 S. Eastern Ave, Suite 6A
Las Vegas, NV 89119

CLASS 30: Organic salsa and Mexican and Latin American style foods for human consumption, namely, organic tortilla chips

FIRST USE 8-12-2014; IN COMMERCE 8-12-2014

The mark consists of the words "CARLOS SANTANA" appears in stylized script in the top center, with "Organic" in script letters below. Further below are the words "NATURE'S FINEST INGREDIENTS". A sun with rays is at the center of the logo, with clouds and geometric patterns evoking plants making up the main background. The sky morphs into the shape of a bird in flight. A semi-circle evocative of a Mayan calendar is in the top background. A guitar is on the right, behind a thermostat indicating the hotness of the salsa. The top, right, and bottom edges consist of circles and triangle shapes. A human figure is on the left side, whose skirt consists of stylized snakes, geometric designs, persons and faces, including a person playing a guitar with a halo, a stylized person playing a flute-like instrument, and a dancer. There are butterflies to the right of the person. A small quarter moon with a human face and a tear is in the top left.

No claim is made to the exclusive right to use the following apart from the mark as shown: "ORGANIC" OR "NATURE'S FINEST INGREDIENTS"

The name(s), portrait(s), and/or signature(s) shown in the mark identifies "Carlos Santana", whose consent(s) to register is made of record.

SER. NO. 86-979,738, FILED 10-06-2014

JESSICA ANN LUDEMAN, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
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United States of America

United States Patent and Trademark Office



Reg. No. 5,055,176

Registered Oct. 04, 2016

Int. Cl.: 29

Trademark

Principal Register

Santana Tesoro, LLC (NEVADA LIMITED LIABILITY COMPANY)
6000 S. Eastern Ave, Suite 6A
Las Vegas, NV 89119

CLASS 29: Organic sauces, salsas, moles, picante sauces, dips, hot sauce, and other Mexican and Latin American style foods for human consumption, namely, salsas and mole sauces

FIRST USE 5-19-2015; IN COMMERCE 5-19-2015

The mark consists of the words "CARLOS SANTANA" appears in stylized script in the top center, with "Organic" in script letters below. Further below are the words "NATURE'S FINEST INGREDIENTS". A sun with rays is at the center of the logo, with clouds and geometric patterns evoking plants making up the main background. The sky morphs into the shape of a bird in flight. A semi-circle evocative of a Mayan calendar is in the top background. A guitar is on the right, behind a thermostat indicating the hotness of the salsa. The top, right, and bottom edges consist of circles and triangle shapes. A human figure is on the left side, whose skirt consists of stylized snakes, geometric designs, persons and faces, including a person playing a guitar with a halo, a stylized person playing a flute-like instrument, and a dancer. There are butterflies to the right of the person. A small quarter moon with a human face and a tear is in the top left.

No claim is made to the exclusive right to use the following apart from the mark as shown: "ORGANIC" OR "NATURE'S FINEST INGREDIENTS"

The name(s), portrait(s), and/or signature(s) shown in the mark identifies "Carlos Santana", whose consent(s) to register is made of record.

SER. NO. 86-416,115, FILED 10-06-2014
JESSICA ANN LUDEMAN, EXAMINING ATTORNEY



Michelle K. Lee

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CARLOS SANTANA

Reg. No. 5,059,982

Registered Oct. 11, 2016

Int. Cl.: 30

Trademark

Principal Register

Santana Tesoro, LLC (NEVADA LIMITED LIABILITY COMPANY)
6000 S. Eastern Ave, Suite 6A
Las Vegas, NV 89119

CLASS 30: Sauces, salsas, mole sauces; Mexican and Latin American style foods for human consumption, namely, salsas, and mole sauces

FIRST USE 5-19-2015; IN COMMERCE 5-20-2015

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

The name(s), portrait(s), and/or signature(s) shown in the mark identifies "Carlos Santana", whose consent(s) to register is made of record.

SER. NO. 86-329,711, FILED 07-07-2014
RUSS HERMAN, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
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United States of America

United States Patent and Trademark Office

SANTANA BY CARLOS SANTANA

Reg. No. 5,680,855

Registered Feb. 19, 2019

Int. Cl.: 9

Trademark

Principal Register

Santana Tesoro, LLC (NEVADA LIMITED LIABILITY COMPANY)
6000 S. Eastern Ave., Suite 6a
Las Vegas, NEVADA 89119

CLASS 9: Eyewear

FIRST USE 9-14-2016; IN COMMERCE 9-14-2016

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

OWNER OF U.S. REG. NO. 3817056, 4008938, 3782893

The name(s), portrait(s), and/or signature(s) shown in the mark identifies "CARLOS SANTANA", whose consent(s) to register is made of record.

SER. NO. 86-633,806, FILED 05-18-2015



Andrei Iancu

Director of the United States
Patent and Trademark Office