

ESTTA Tracking number: **ESTTA35425**

Filing date: **06/10/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Corporacion Habanos, S.A.
<b>Granted to Date of previous extension</b>	06/12/2005
<b>Address</b>	Avenida 3ra, #2006, e/20 y 22Miramar Havana, CUBA

<b>Attorney information</b>	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & 740 Broadway -- Fifth Floor New York, NY 10003 UNITED STATES dgoldstein@rbskl.com Phone:212 254 1111 x 103
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#### Applicant Information

<b>Application No</b>	78363024	<b>Publication date</b>	12/14/2004
<b>Opposition Filing Date</b>	06/10/2005	<b>Opposition Period Ends</b>	06/12/2005
<b>Applicant</b>	Anncas, Inc. 16112 N.W. 13th Avenue, Suite E Miami, FL 33169		

UNITED STATES
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**Goods/Services Affected by Opposition**

Class 034.

All goods and services in the class are opposed, namely: cigars made from Cuban seed tobacco

<b>Attachments</b>	hc opp.pdf ( 14 pages )
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<b>Signature</b>	/David B. Goldstein/
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<b>Name</b>	David B. Goldstein
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<b>Date</b>	06/10/2005
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Class 34 for “cigars made from Cuban seed tobacco.”

2. Habanos, S.A. is a company with legal personality organized under the laws of Cuba. Habanos, S.A. has its principal place of business at Avenida 3ra, No. 2006 Miramar, Havana, Cuba. Habanos, S.A. is in the Cuban cigar business and, under Cuban law, is authorized to export Cuban cigars from Cuba. Habanos, S.A. exports, advertises and otherwise deals in cigars that are of 100% Cuban origin, both in tobacco and in manufacture.

3. Habanos, S.A. has registered the mark, HABANOS UNICOS DESDE 1492 and DESIGN, U.S. Reg. No. 2,177,837, among others, in the United States for cigars and related products in International Class 34. Habanos, S.A. uses this mark exclusively for cigars that are of 100% Cuban origin, and brands many of its products with this mark.

4. The mark HABANOS UNICOS DESDE 1492 translates into English as "unique Havana cigars since 1492."

5. On January 11, 2005, Habanos, S.A. filed a timely request for a 30-day extension of time to file an opposition to the Application. The request was granted until February 12, 2005 by the Trademark Trial and Appeal Board (“TTAB”). On February 10, 2005, Habanos, S.A., filed a timely request for a 60-day extension of time to file an opposition to the Application. The request was granted until April 13, 2005. On April 11, 2005, Habanos, S.A., filed a timely request for a 60-day extension of time to file an opposition to the Application. The request was granted until June 12, 2005.

#### **THE MEANING OF THE WORD "HAVANA"**

6. The applied-for mark, HAVANA CLUB, has as its predominant feature, the word "HAVANA." This word is recognized throughout the world and in the United States to denote *both* the capital city of Cuba *and* Havana cigars, that is, cigars that are of 100% Cuban origin.

7. The primary significance of the applied-for mark is Havana, Cuba, a generally known geographic location.

8. The word "Havana," in addition to denoting the largest and capital city of Cuba, is defined in dictionaries as a cigar made in Cuba. *See The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000) ("2. A cigar made in Cuba, especially one of fine quality."); *Webster's New Twentieth Century Dictionary Unabridged* (1974) ("a cigar made in Havana, or in Cuba, or of Cuban tobacco"); *Merriam-Webster Online Dictionary* (visited 4/1/05) ("1. a cigar made from Cuban tobacco; 2. a tobacco originally grown in Cuba"); *The Random House Dictionary of the English Language Unabridged* (2d ed. 1987) ("2. a cigar made in Cuba or of Cuban tobacco"); *Random House Webster's Dictionary* (4<sup>th</sup> ed. 2001) ("2. A cigar made in Cuba.").

9. Numerous books and expert guides on cigars published or distributed in the United States define "Havana" as a Cuban cigar, and the term is commonly used in such publications to denote a 100% Cuban origin cigar. *See e.g.*, H. Paul Jeffers & Kevin Gordon, *The Good Cigar: A Celebration of the Art of Cigar Smoking*, at 196 (1996) (defining "Havana (Habana) [as] 'A Cuban cigar.'"); *id.* at 44 (stating that Havana is "[s]o powerfully associated with the best tobacco in the world" that it is "synonymous worldwide with a fine cigar"); Joel Sherman, Nat Sherman's *A Passion for Cigars*, 23-24 (1996) (Cuban cigars "[n]icknamed 'Havanas' at least by the 1920's; 'Calvin Coolidge was so possessive of his Havanas'; German Blitz of London in 1941 destroyed a tobacco shop where a portion of Winston Churchill's 'treasured cache of Havanas' were stored); R. Perelman, *Perelman's Pocket Cyclopedia of Havana Cigars passim* (1997) (referring to "Havana" cigars as products grown and manufactured in Cuba; "Havana" synonymous with "Cuban"); A. Bati & S. Chase, *The Cigar Companion: A*

Connoisseur's Guide at 15 (bad weather in Cuban tobacco fields led to sharp drop in "production of Havanas" in 1991-93); *id.* at 16 (Habanos, S.A. "took over most of the marketing responsibilities for Havanas from the state-owned Cubatabaco" in 1994); *id.* at 45 (referring to Cuba's 42 different sizes of "handmade Havanas," distinguishing from non-Cuban, "[n]on-Havana brands"); P. Garmiriam, *The Gourmet Guide to Cigars* 12 (1990) (referring to Cuban cigars as "Havanas"); T. Gage, *The Complete Idiot's Guide to Cigars* 78 (1997) ("Havana" cigar tobacco synonymous with "Cuban" cigar tobacco, and distinguished from tobacco grown "outside Cuba"); *id.* at 82 ("Havanas" are "truly a Cuban product"); *id.* at 84 ("The Least You Need to Know: Havana cigars feature only Cuban tobacco."); S. Weiss, *The Cigar Enthusiast* 18 (1997) (1962 trade embargo "meant neither Cuban tobacco nor Havana cigars could be legally imported" into United States).

10. The use of the term "Havana" to refer to cigars from Cuba frequently appears in the titles of cigar books. *See, e.g.,* M. Nee & A. Martinez Rius, *An Illustrated Encyclopedia of Post-Revolution Havana Cigars*; *id.* at 193 (quoting 1928 American Fair Trade Association bulletin on "Havana Misbranding:" "'Havana' as a trade name for cigars is with little doubt the oldest trade name in America as it has been used since the days of Columbus to describe tobacco grown on the Island of Cuba."); Gerard Pere et Fils, *The Connoisseur's Guide to Havana Cigars* (S. Johnston, transl., 1992); Gerard Pere et Fils, *Havana Cigars* (1997); C. Del Todesco, *The Havana Cigar: Cuba's Finest* (English transl., 1997).

11. The term "Havana" is regularly and consistently used to refer to Cuban-origin cigars in news and feature stories appearing in magazines, newspapers, and other publications, directed both to the cigar-consuming public, to the cigar trade, and to the general public in the United States.

12. The term "Havana" has been used and understood throughout the world, including in the United States, by both cigar consumers and cigar experts, to denote:

- a. cigars made exclusively from tobacco grown in Cuba; and
- b. cigars manufactured in Cuba, primarily in the city of Havana.

13. The term "Havana" is understood by United States cigar consumers to denote "Havana cigars," *i.e.*, a cigar of 100% Cuban origin, whether the word is used as a noun meaning "Havana cigars"; or as an adjective meaning "from Havana" in connection with cigars or tobacco products.

14. The term "HABANA," the French word for HAVANA, is an appellation of origin for Cuban-origin tobacco and tobacco products registered in accordance with the 1958 Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, as revised and amended.

15. United States and international publications directed to the cigar-consuming public and to the trade, including the United States cigar-consuming public and trade, consistently refer to "Havana cigars" as a distinctive and different type of cigar from non-Cuban origin cigars.

16. The applied-for mark denotes, is, and will be, understood by consumers to denote a Havana cigar, that is, a cigar of 100% Cuban origin.

17. Cuba is recognized in the United States and internationally as the most renowned country in the world for the production and manufacture of cigars. Havana is recognized in the United States and internationally as the city most renowned for the manufacture of cigars. The applied-for mark HAVANA CLUB would be understood by United States consumers as indicating that cigars bearing this mark are made exclusively from tobacco grown in Cuba and/or

are manufactured in Cuba.

18. Neither Havana nor Cuba is the place of origin of any cigar of the Applicant labeled "HAVANA CLUB," nor are any such cigars made with any tobacco grown in Cuba or Havana, or grown from seeds that are themselves from Cuba.

19. Applicant has no lawful means of obtaining or selling Havana cigars, nor any lawful means of obtaining or selling cigars that are made anywhere in the world if they are made or derived in whole or in part of any article which is the growth, produce or manufacture of Cuba. Without limitation, this is so because the United States' Cuban Assets Control Regulations, including specifically 31 C.F.R. §§ 515.201, 515.204, prohibit any such activity.

20. The cigar-consuming public is likely to believe the place identified by the applied-for mark -- Havana, Cuba -- indicates the origin of the goods bearing the applied-for mark, when in fact the goods do not come from that place.

21. Consumers mistaken belief that Applicant's HAVANA CLUB cigars come from Cuba would be a material factor in such consumers' purchasing decision.

### **THE APPLICATION PROCEEDINGS**

22. In response to Applicant's application, and based on the geographic significance of Havana, Cuba, including as "a place where cigars are produced," on September 1, 2004, the Examining Attorney of the United States Patent and Trademark Office ("USPTO"), David C. Reihner, Esq., issued an Office Action, which found that the "primary significance of the term 'Havana' is geographic." Because the Applicant's goods do not come from Havana, Cuba, the Examining Attorney refused registration on the ground that the applied-for mark "*consists of or comprises geographically deceptively misdescriptive matter.*" (Emphasis added, citing 15 U.S.C. § 1052(e)(3)).

23. More specifically, the Examining Attorney found:

Registration is refused because the proposed mark consists of or comprises geographically deceptively misdescriptive matter in relation to the identified goods.

The primary significance of the term “Havana” is geographic. The public is likely to believe that applicant’s goods come from this place because Havana, Cuba, is a place where cigars are produced. Furthermore, this belief would materially influence consumers to purchase the goods because Havana, Cuba, a location where cigars are produced, is renown for the production of cigars and purchasers would base the purchase of these goods upon the misconception that applicant’s goods originate from Havana, Cuba.

Although applicant’s proposed mark contains the term “Club,” under Trademark Act Section 2(e)(3) the geographically deceptively misdescriptive matter need not be the entire mark, or even the dominant portion of the mark. It is sufficient if some portion of the proposed mark is geographically deceptively misdescriptive with respect to the goods and/or services in question.

Applicant cannot avoid a geographically deceptively misdescriptive refusal by disclaiming the geographically deceptively misdescriptive term pursuant to Trademark Act Section 6(a).

(Citations omitted).

24. According to the USPTO file, on September 15, 2004, Applicant authorized the Examining Attorney to amend the identification of goods from “cigars” to “cigars made from Cuban seed tobacco.”

25. Applicant authorized such amendment in response to the September 1, 2004 Office Action refusing registration on the ground that the applied-for mark is primarily geographically deceptively misdescriptive.

26. Applicant represented to the USPTO that its cigars were “made from Cuban seed tobacco” for the purpose of overcoming the USPTO’s refusal to register, by, upon information and belief, claiming and/or representing that “Cuban seed tobacco” was tobacco from Cuba, or tobacco grown from seeds that are from Cuba.

27. Following the above-cited amendment to the identification of goods, a Notice of Publication for the applied-for mark issued on November 24, 2004, and the mark was published for opposition on December 12, 2004.

28. In fact, the seeds and plants from which Applicant's tobacco comes, or will come, do not, and cannot lawfully, originate from Cuba.

29. Upon information and belief, Applicant knew that it made a false and misleading material misrepresentation to the USPTO when it authorized amendment of its application to state, "cigars made from Cuban seed tobacco," in response to the USPTO's refusal of registration, because the seeds and plants from which Applicant's tobacco comes, or will come, do not, and cannot lawfully, originate from Cuba.

30. In making this material misrepresentation to the USPTO, however, Applicant correctly recognized that the consuming public would believe (erroneously, in fact) that Applicant's "HAVANA CLUB"-marked cigars do come from Havana, Cuba.

31. "Cuban seed tobacco" is a generic name for a type of tobacco that is grown in countries *other* than Cuba, such as the Dominican Republic. "Cuban seed tobacco" does not come from a seed or a plant that itself comes from Cuba.

32. The type of non-Cuban tobacco that Applicant refers to as "Cuban seed tobacco" is either a very distant descendant from plants or seeds that were taken from Cuba sometime between more than 40 and almost 100 years ago, but not more recently than that; *or* is not even a distant descendant from seeds or plants that were taken from Cuba many decades ago, but is merely a type of tobacco, grown in the Dominican Republic or elsewhere outside of Cuba, and referred to as "Cuban seed tobacco"; *or* Applicant may have made the material misrepresentation to the USPTO that its cigars were "made from Cuban seed tobacco" without regard to whether

the tobacco it uses or intends to use with the HAVANA CLUB mark in fact is of the generic type referred to as “Cuban seed tobacco,” solely for the purpose of obtaining registration of its applied-for mark through such material misrepresentation.

33. The identification of goods as “cigars made from Cuban seed tobacco” does not make the consumer’s likely goods-place association with Havana and/or Cuba any less geographically deceptively misdescriptive.

34. Tobacco grown from seeds that are 40 or more generations removed from seeds or plants that came from Cuba are distinctive from cigars made from Cuban-origin tobacco, in terms of quality, characteristics, taste and aroma. Even if the seeds that Applicant claims to use, or claims will use, were themselves from Cuba, cigars made from the tobacco from such seeds would not be Havana cigars, and would be distinctive from Cuban-origin cigars, made from tobacco grown in Cuba, in terms of quality, characteristics, taste, and aroma.

35. Use of “Cuban seed tobacco” does not, and cannot, support the use of the word “Havana” in connection with products made from such tobacco.

36. An applicant whose mark is otherwise primarily geographically deceptively misdescriptive because of its use of the term “Havana” does not, and cannot, overcome that statutory bar to registration by claiming that its cigars are made from “Cuban seed tobacco.”

37. The USPTO would not have issued the mark for publication in the *Official Gazette* had it known that neither “Cuban seed tobacco,” nor the seeds generating the plants that yield the tobacco come from Havana, Cuba, or anywhere else in Cuba.

**THE REPUTATION OF CIGARS MADE OF TOBACCO GROWN EXCLUSIVELY IN CUBA AND MANUFACTURED IN CUBA**

38. Havana cigars are recognized throughout the world, including the United States,

as cigars of highest quality, and distinctive and unique. Cuban cigars are ranked by United States and international cigar publications as the best or among the very best in the world in the various categories of cigars. No other region of the world is as renowned as Cuba for cigars.

39. Havana cigars are desired by cigar smokers throughout the world, including in the United States, because of their Cuban origin.

40. Consumers in the United States and elsewhere in the world associate cigars with Cuba. This association is one of the strongest -- and perhaps the strongest -- goods/place association of any consumer product with a particular geographic region in the world.

41. United States and international publications directed to the cigar consuming public and trade, including the United States cigar consuming public and trade, consistently depict and describe Havana cigars as a type of cigar distinctive and different from any other cigar, and consumers around the world, including the United States, understand Havana cigars to be the type of cigar that is distinctive and different from any other cigar.

42. Tens of thousands of United States persons who have legally traveled to Cuba over the past decade have become familiar with Havana cigars by sampling such cigars in Cuba. A substantial number of additional United States consumers have obtained such familiarity through the legal importation of such cigars into the United States by returning United States visitors to Cuba for personal consumption or to give as gifts.

43. If the applied-for mark is applied to Applicant's goods, consumers will be deceived into believing that such cigars are of Cuban origin, and consumers would base their decision to purchase cigars sold under the applied-for mark by their mistaken belief that such cigars are of Cuban origin.

44. Habanos, S.A. markets cigars made exclusively of Cuban tobacco and

manufactured in Cuba throughout the world, with the exception of the United States, due to the trade embargo.

45. In marketing these cigars, Habanos, S.A. emphasizes that such cigars are of 100% Cuban origin.

46. Habanos, S.A. intends to sell Havana cigars in the United States as soon as it is permitted to do so by United States law.

47. Registration and use by Applicant of the applied-for mark on cigars of non-Cuban origin will damage the reputation Havana cigars have in the United States, and will deceive consumers into believing that Havana cigars are presently available for purchase in the United States.

48. As a result of such damage to the reputation of Havana cigars in the U.S., and of such consumer deception that Cuban-origin cigars are available for purchase in the U.S., United States persons lawfully in Cuba will be less likely to make lawful purchases of Habanos's genuine Cuban-origin cigars.

49. The success of Habanos, S.A. in marketing 100% Cuban-origin Havana cigars to United States consumers as soon as U.S. law permits will be damaged and diminished if Applicant is permitted to register a mark including the term "Havana," which would deceptively suggest that cigars bearing that mark are also Havana cigars, when they are not.

50. The ability of Habanos, S.A. to use its registered mark HABANOS UNICOS DESDE 1492 & Design ("unique Havana cigars since 1492") in connection with the sale of Cuban-origin Havana cigars in the United States as soon as U.S. law permits will be damaged and diminished if Applicant is permitted to register a mark including the term "Havana," which would deceptively suggest that non-Cuban cigars bearing that mark are also Havana cigars, when

they are not.

### **FIRST GROUND FOR OPPOSITION**

51. Habanos, S.A. repeats and realleges each and every allegation set forth in paragraphs 1 through 50 of this Notice of Opposition as if fully set forth herein.

52. The applied-for mark, as used on or in connection with Applicant's identified goods, namely "cigars made from Cuban seed tobacco," is primarily geographically deceptively misdescriptive within the meaning of Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3), and deceptively misdescriptive within the meaning of Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

### **SECOND GROUND FOR OPPOSITION**

53. Habanos, S.A. repeats and realleges each and every allegation set forth in paragraphs 1 through 50 of this Notice of Opposition as if fully set forth herein.

54. Use of the HAVANA CLUB mark by Applicant in connection with cigars that are not from Havana or Cuba, is deceptive within the meaning of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

### **THIRD GROUND FOR OPPOSITION**

55. Habanos, S.A. repeats and realleges each and every allegation set forth in paragraphs 1 through 50 of this Notice of Opposition as if fully set forth herein.

56. Applicant knew that it made a false, material misrepresentation to the USPTO when it authorized amendment of its identification of goods from "cigars" to "cigars made from Cuban seed tobacco," in response to the USPTO's September 1, 2004 Office Action refusing registration of the mark as primarily geographically deceptively misdescriptive.

57. Because of Applicant's false, material misrepresentations to the USPTO,

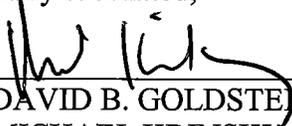
registration of the applied-for mark must be refused.

WHEREFORE, Opposer Habanos, S.A. prays that Application Serial No. 78/363024 be rejected, that registration be refused, and that this OPPOSITION be sustained in favor of the Opposer.

Dated: June 10, 2005

Respectfully submitted,

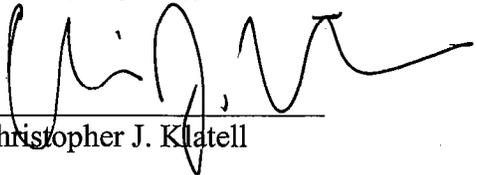
By: \_\_\_\_\_

  
DAVID B. GOLDSTEIN  
MICHAEL KRINSKY  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.  
740 Broadway -- Fifth Floor  
New York, New York  
212-254-1111

*Attorneys for Opposer  
Corporacion Habanos, S.A.*

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Notice of Opposition to the registration of the mark HAVANA CLUB, No. 78/363024 is being filed electronically today, June 10, 2005 on the Electronic System for Trademark Trials and Appeals for the United States Patent Office.



Christopher J. Klatell