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

Proceeding	91165519
Party	Plaintiff Corporacion Habanos, S.A. Corporacion Habanos, S.A. Avenida 3ra, #2006, e/20 y 22Miramar Havana, CUBA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD**

CORPORACION HABANOS, S.A.,)	
)	
Opposer,)	Opposition No. 91165519
)	
v.)	
)	
ANNCAS, INC.,)	
)	
Applicant.)	
)	

**OPPOSER CORPORACION HABANOS, S.A.’s OPPOSITION TO APPLICANT’S
MOTION FOR SUMMARY JUDGMENT**

Opposer, Corporacion Habanos, S.A. (“Opposer” or “Habanos S.A.”), hereby files its Opposition to Applicant Anncas, Inc.’s (“Applicant” or “Anncas”) Motion for Summary Judgment (cited as “App.Mot. at ___.”) Opposer filed its own motion for summary judgment requesting that the Board: 1) sustain the Opposition and refuse registration of Application No. 78/363024; and 2) dismiss Applicant’s counterclaim to cancel Registration No. 2,177,837, owned by Opposer. Applicant’s motion should be denied for many of the same reasons that entitle Opposer to summary judgment. Opposer shall endeavor not to repeat the facts and legal arguments already set forth in its own motion (cited as “Opp. SJ Mot. at ___”) and supporting papers, and hereby incorporates those papers by reference, including the four Declarations and Exhibits it previously filed.

I. APPLICANT IS NOT ENTITLED TO SUMMARY JUDGMENT ON HABANOS S.A.’S OPPOSITION

Applicant has failed to show that it is entitled to summary judgment, either on the facts or law, on Opposer’s claim that the HAVANA CLUB mark is primarily geographically deceptively misdescriptive, under 15 U.S.C. § 1052(e)(3) and the controlling precedent of *In re California*

Innovations, 329 F.3d 1334, 1341 (Fed. Cir. 2003), and is deceptive and deceptively misdescriptive, under sections 2(a) and (e)(1). Applicant ignores both the controlling general legal standards,¹ and the Board’s cases and the PTO’s actions addressing composite “HAVANA ___” marks. It wholly fails to meet its burden to show “that there is an absence of evidence to support [Opposer’s] case.” *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1377 (Fed. Cir. 2002). For example, Applicant provides *no* evidence, let alone undisputed evidence, for its claim that “Cuban seed” tobacco has any relevant connection to Havana or Cuba, and it ignores the overwhelming contrary evidence, including its principal’s own admissions.

Applicant does not argue that the Board should abandon the long-settled test that inquires whether the goods “come from that place” identified in the mark, *California Innovations*, 329 F.3d. at 1341, and should substitute in its stead an impossible inquiry into whether the goods have a genetic link to the place named, however remote and irrelevant to the characteristics of the goods. Applicant purports to rely on a handful of marks that also seek to exploit the fame of genuine Havana cigars, yet it never provides any evidence of the extent of consumer exposure to such marks, if any, and makes no other legal argument based on such marks. Applicant seeks to have its cake and eat it too, making the incredible claim that consumers will not make a goods/place association between Havana and cigars, while also making the claim that such a goods/place association is not deceptive because its goods claim a remote genetic link to Cuba.

A. The Mark’s Primary Significance is a Generally Known Geographical Location

Applicant’s contention that the primary significance of the mark HAVANA CLUB is not a known geographical location – Havana, Cuba – is without merit. Applicant can make this argument only by boldly ignoring the Board’s uniform precedents that the primary significance

¹ Applicant never cites *California Innovations*, instead relying on prior formulations for the relevant legal standards. Rather than debate whether Applicant correctly states the law, Opposer will address itself to *California Innovations*, as it did in its motion for summary judgment.

of very similar composite “HAVANA ____” marks is Havana, Cuba. Opp. SJ Mot. at 22-24 (citing cases). Applicant likewise ignores prior identical findings of the PTO with respect to the identical mark, HAVANA CLUB. *Id.* Notably, the PTO made the same finding here, which Applicant chose not to challenge during the application process. *Id.* at 4-5. Nor is there anything “inherently distinctive” about combining a well-known geographical location with a term such as “Club,” which itself has no claim to “distinctiveness.” Indeed, the PTO found, in refusing a different HAVANA CLUB application, that “the geographic significance of Havana has not been diminished” by the addition of the word “Club,” in the absence of a distinct organization, clique, or alliance called “Havana Club.” Declaration of David B. Goldstein, dated Aug. 3, 2006 (“Goldstein Decl.”) Exh. 7 (Feb. 9, 2001 Office Action at 3). Applicant also does not argue, nor could it, that its “Cuban seed” amendment to its identification of goods, which is not part of the mark, could have altered the PTO’s primary significance finding. Opp. SJ Mot. at 24.

Rather than address these direct precedents, Applicant makes the frivolous, and worse than disingenuous, contentions that the mark “conveys a distinctive image of the vibrancy of Caribbean nightlife [and i]t is that imagery combined with the fame associated with the mark ‘Havana Club’ for rum, owned by a third party, that forms the primary significance to the public of Applicant’s mark.” App. SJ at 10; *see* Declaration of William Bock (“Bock Decl.”) ¶ 3 (in fact claiming “*Cuban* entertainment and social life,” not “Caribbean”) (emphasis added).

The Board specifically considered and rejected a virtually identical Cuban nightlife evocation argument in *In re Bacardi*, 48 U.S.P.Q.2d 1031, 1034 (T.T.A.B. 1997) (*Bacardi I*) (involving several composite HAVANA marks for rum and spirits), on two grounds directly applicable here: 1) an absence of *any evidence* to support this claim, and 2) any such “association

may be made precisely because of the primary significance of HAVANA as a city in Cuba.” *Id.* Applicant proffers no evidence or argument to refute an identical conclusion here.

More disturbing, both the claimed Cuban social life and HAVANA CLUB rum associations are directly contradicted by the sworn testimony of Applicant’s principal, William Bock, who “came up with the idea of using Havana Club as a cigar mark.” Goldstein Decl. Exh. 13 (Bock Dep. at 56). Bock testified that he chose the mark because he “was looking at another name, with ‘club’ in it, and it didn’t sound right. And Havana Club sounded right....

Q. Why did you choose the Havana part of Havana Club? A. No particular reason. It sounded good.” *Id.* In his declaration, ¶ 3, Bock directly contradicts this sworn testimony, stating that he chose the mark “to capture both the high quality I intended for this line of cigars and *the essence of Cuban entertainment and social life.*” (Emphasis added). Of course, a party “cannot, however, create an issue of material fact by submitting an affidavit that contradicts an earlier deposition,” *Pourghoraishi v. Flying J, Inc.*, 449 F.3d 751, 759 (7th Cir. 2006), let alone create an *undisputed* fact. *See Anchor Wall Systems, Inc. v. Rockwood Retaining Walls*, 340 F.3d 1298, 1314 (Fed. Cir. 2003) (“a party may not submit affidavits purporting to create a genuine issue of fact if they simultaneously contradict prior sworn testimony by the affiant”).

Moreover, Bock testified unequivocally that at the time he filed his application he had *never heard of* a HAVANA CLUB rum, either Cuban or otherwise; disclaimed any knowledge of the long-running dispute over the rum mark between Bacardi and a Cuban entity until after he filed his application; and had no knowledge of a registration for that mark for rum held by a Cuban entity. Bock Dep. at 59-62, 65.² Applicant does not even try to explain how the primary

² Bock testified that when he filed his application he was not “aware that there was a rum product called Havana Club....I had never seen the name Havana Club on a rum...[He was] not aware of a Bacardi product called Havana Club at the time ...It is my contention that I do not know there was a rum called Havana Club, which I prior stated.” Bock Dep. at 59-61.

significance of the mark could be derived from “the fame associated with the mark ‘Havana Club’ for rum,”³ Bock Decl. ¶ 3, if Bock had never heard of that rum when he selected the mark. That Applicant improperly would resort not once, but twice, to direct contradiction of Bock’s sworn testimony highlights the frivolousness of its argument.

Applicant’s reliance on *In re International Taste*, 53 U.S.P.Q.2d 1604 (T.T.A.B. 2000) (HOLLYWOOD FRIES), while ignoring the HAVANA composite marks cases, proves Opposer’s case. There, the Board found the mark ““has a popular significance *apart* from its geographical meaning”” because there was a “prominent significant meaning of the term ‘Hollywood’ as referring to the entertainment industry in general,” distinct from the geographical location. *Id.* at 1605 (emphasis added) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 14:28 (4th ed. 1999)). Here, by contrast, the *only* other meaning of “Havana,” as Applicant concedes, is a cigar *made* in Havana or Cuba or from Cuban tobacco. Unlike “Hollywood,” that meaning is not “*apart*” from the geographical meaning of Havana, but rather is directly and inextricably tied to its current and historical role as the manufacturing and export center for genuine Cuban cigars, as Opposer’s extensive, undisputed evidence shows. *See* Opp. SJ Mot. at 7-11 and Exhibits cited therein; App. SJ Mot. at 10.⁴

³ Although this is not the place to review the long-running, and ongoing, dispute over rights to the HAVANA CLUB rum mark in the U.S., the owner of the registered mark, Reg. No. 1,031,651, is a Cuban entity, CubaExport. The PTO has consistently refused registration to Bacardi affiliates, Declaration of Lindsey Frank, dated Sept. 22, 2006 (“Frank Decl”), Exh. 1, and no court has ever held that any Bacardi affiliate has any common law rights in the mark. Bacardi recently announced that, after a decade of no sales, it has started to sell a “Havana Club” labeled rum in Florida only; its only prior sales were fewer than 1,000 cases in 1995-96. Frank Decl. Exh. 2-4. Thus, Applicant’s assertion that Bacardi is the owner of the rum mark is not only without legal basis, but any consumer association between Applicant’s HAVANA CLUB cigar mark, and “the fame associated with the mark ‘Havana Club’ for rum,” could only refer to the world-renowned Cuban product, not a Bacardi product, and thus would only reinforce the consumer association with Havana, Cuba.

⁴ Applicant claims that its “goods will satisfy this definition as the goods ... will be made from *Cuban-
seed* tobacco.” App. SJ Mot. at 10 (emphasis added). As shown *infra*, Point I.D., whatever “Cuban seed tobacco” might be, the evidence is undisputed that it is *not* “*Cuban* tobacco.”

B. Consumers Are Likely to Believe There is a Goods-Place Association Between Havana and Cigars

Applicant's claim, on summary judgment, that consumers are not likely to make a goods/place association with Havana, Cuba is meritless. Applicant ignores the fact that it expressly waived this argument when it withdrew its Third Affirmative Defense ("lack of place/goods association") after Bock's testimony completely destroyed the defense. Opp. SJ Mot. at 6 & n.1, 24. Applicant also ignores: 1) the Board's cases finding a goods/place association between Havana and composite "HAVANA ____" marks for products for which Havana is far less well-renowned than it is for cigars; 2) PTO actions finding a goods/place association between Havana and HAVANA CLUB for clothing and rum; 3) the case law that sets a low threshold for the goods/place association test; and 4) the extensive, uncontradicted evidence of the extraordinarily powerful association between Havana and cigars among U.S. cigar consumers. Opp. SJ at 7-11, 24-26, and Exhibits cited therein; Frank Decl. Exh. 1.

Applicant chose not to challenge the PTO's goods/place association finding during the application process. It now chooses to submit *no* evidence to refute Opposer's overwhelming evidence of the goods/place association under the prevailing legal standards and precedents. Instead, it relies primarily on a conclusory assertion, unsupported by *any* evidence, that American consumers would not make a goods/place association because of their purported knowledge of the scope of the Cuban Assets Control Regulations, 31 C.F.R. Part 515. App. SJ at 11; Bock Decl. ¶ 7.⁵ The Board rejected this identical argument in *Bacardi I*, finding "no

⁵ The baselessness of Bock's unsupported allegation of what U.S. cigar consumers know about the embargo is revealed by his own deep ignorance, despite over 35 years in the cigar business. Bock admitted that he did not "have any understanding of U.S. law concerning tobacco grown from seeds that, themselves, come from Cuba," and he testified that his foreign suppliers "probably buy" their "Cuban seed," because "[t]here's no embargo between Honduras, Nicaragua and Cuba," and that "in my opinion – I do not think there is a restriction on that ["importing tobacco grown from seeds that themselves came

evidence to support applicant's contention that, in view of the U.S. trade sanctions against Cuba, purchasers will know that no product on the U.S. market could originate in Cuba.” 48 U.S.P.Q.2d at 1035 n.13; *see* Goldstein Decl. Exh. 7 (Feb. 9, 2001 Office Action at 3-4) (rejecting with detailed reasons same “embargo” argument for HAVANA CLUB for clothes).

Applicant’s argument that there is no goods/place association because the mark “suggests that the product is stylish or of high quality,” App. SJ Mot. at 11-12 (internal quotations omitted), is refuted by the very examples Applicant cites – HYDE PARK and NANTUCKET for clothes, FIFTH AVENUE for cars (citing from *In re Jacques Bernier Inc.*, 894 F.2d 389 (Fed. Cir. 1990)). In each example, including *Jacques Bernier* (RODEO DRIVE for perfume), the places named in the mark are *not* known for the production or manufacture of the goods, but rather as upscale, stylish locations. In sharp contrast, Havana *is* renowned as a place of production and manufacture of cigars, and a likely consumer goods/place association undoubtedly exists, just as it would for FIFTH AVENUE for art galleries. *See In re Hiromichi Wada*, 194 F.3d 1297, 1300-02 (Fed. Cir. 1999) (finding goods/place association for NEW YORK WAYS GALLERY). Applicant’s inability to cite a single example in which the Board or the Federal Circuit found no goods/place association based on stylishness or high quality, for a place renowned for the goods in question, itself proves Opposer’s position.

from Cuba”],” Bock Dep. at 86-87, highly dubious propositions at best. *See* 31 C.F.R. § 515.204(a) (emphasis added):

Except as specifically authorized by the Secretary of the Treasury ... no person subject to the jurisdiction of the United States may *purchase, transport, import, or otherwise deal in or engage in any transaction* with respect to *any merchandise outside the United States* if such merchandise:

- (1) Is of Cuban origin; or
- (2) Is or has been located in or transported from or through Cuba; or
- (3) Is made *or derived in whole or in part* of any article which is *the growth, produce or manufacture of Cuba*.

Applicant's reliance on *In re Venice Maid Co. Inc.*, 222 U.S.P.Q. 618 (T.T.A.B. 1984) (VENICE MAID), is likewise misplaced. There, the Board found a lack of a goods/place association because there was no evidence in the record that Venice was known for the goods at issue, and the mere fact that Venice was a large city in Italy was itself insufficient to create a goods/place association for goods associated with Italy generally, *see id.* at 618-19, a far cry from the situation here, in which Havana is so renowned for cigars that cigars from Havana are known as "Havanas." It was specifically in this context that the Board noted that the marketing of Italian-type food products under Italian names or words suggesting Italy "reinforces" its conclusion of a lack of a goods/place association. *Id.* at 620.

Applicant's claim that an unspecified customs regulation requires it to label the country of origin of its cigars, and that this will eliminate consumer association with Havana, is wrong on both counts. App. SJ. Mot. at 12. In fact, U.S. law expressly gives an importer the *choice* of labeling the country of origin or paying a 10% additional duty. 19 U.S.C. § 1304(a), (i), (j); 19 C.F.R. § 134.3(a). If a cigar importer concludes that the added value of an association with Havana is greater than 10%, it would rationally pay the duty and avoid the labeling. Moreover, the courts have consistently rejected the position that labeling cures any deception or misdescriptiveness problem. *See In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 776 (Fed. Cir. 1988); *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 789-90 (C.C.P.A. 1964); *In re Bonide Chemical Co.*, 46 F.2d 705, 708 (C.C.P.A. 1931).

Applicant also claims that the existence of a handful of other "Havana" (or "Habana/o") marks for cigars defeats a goods/place association. Although Applicant attempts to make it appear as if such marks are ubiquitous both in the U.S. marketplace and at the PTO, an examination of the evidence Applicant has submitted shows, particularly taking all inferences in

favor of Opposer, at most minimal consumer exposure. Further, it is unclear what Applicant's legal point is. It never pled an affirmative defense of genericness, or some form of estoppel or acquiescence, and makes no such argument here, which in any event would be frivolous on the facts and law. The essence of its argument appears to be that it too should be allowed to use a mark deceptive to U.S. consumers because a handful of others have also sought to deceive consumers by exploiting the fame of genuine Havana cigars. The law, however, is quite the opposite. *See In re Nett Designs Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) ("The Board must decide each case on its own merits... the PTO's allowance of [similar] prior registrations does not bind the Board or this court.").

Dispositively, Applicant has not submitted *any* evidence concerning the extent to which any of these marks are in the U.S. market or the extent or duration of consumer exposure, despite Opposer's request for such information. Frank Dec. Exh. 5 (Applicant's Response to Opposer's Requests for Production of Documents (Second Set, Nos. 1-4)). Especially revealing, Opposer has been able to muster evidence of consumer advertisements for only *five* of the active, registered "Havana" cigar marks it cites, and then just barely. *See* Frank Decl. ¶¶ 2-10 (detailing status of cited registrations and extent of Applicant's evidence of consumer advertising). Applicant also submitted a smattering of consumer advertisements for a few other unregistered "Havana/Habana" brands, but again with no evidence of the scope of sales, advertising, channels of trade or consumer exposure.⁶

⁶ Without explanation, Applicant also submits documents concerning a few brands (not registrations) that refer to Cuba, an issue not in this case. Opposer here seeks to protect the deceptive exploitation of "Havana," the internationally recognized and registered appellation of origin for genuine Cuban cigars ("Habana" and "Habanos," in Spanish). *See* Garcia Morejon Decl. ¶ 13; Exh. 2. That some in the U.S. cigar industry might seek to evoke a past association (real or imaginary) between themselves and Cuba is a different issue than branding one's non-Havana cigars with a "Havana ____" mark, the issue here.

Further, a review of the 28 registrations Applicant submitted in its C shows that, when abandoned, duplicate, non-cigar, and non-“Havana/Habana/o” marks are removed, only 13 marks remain. Frank Decl. ¶¶ 3-7, and Exh. 6. Twelve (12) of those 13 marks have been recently registered (2001 or after), with eight registered in or after 2004. Frank Decl. ¶¶ 8. In short, Applicant’s “evidence” of consumer exposure to “Havana” marks, even if relevant to some issue in this case, is grossly inadequate to establish Applicant’s entitlement to summary judgment.

C. Applicant Is Not Entitled to Summary Judgment on Whether The Goods-Place Association Will Be Material to Consumers’ Purchasing Decision

Applicant once again ignores the governing standards of *California Innovations*, misstates the law, and provides no evidence that the goods/place association will not be material to consumers’ purchasing decisions. In contrast, Opposer has shown that under governing law, if the place is well-known, or renowned, or noted for the particular goods, or the goods are a principal product of the place, then a mark for goods which do not come from that place is likely to be deceptive under sections 2(a) or 2(e)(3). Opp. SJ Mot. at 27-28 (discussing, *inter alia*, *California Innovations*, 329 F.3d at 1341).⁷ Opposer submitted substantial, and still uncontradicted, evidence of Havana’s extraordinary renown for cigars, including evidence produced by Applicant, and provided further uncontradicted proof of the obvious materiality to consumer purchasing decisions of linking one’s non-Cuban cigar products with Havana, Cuba’s renown for cigars. Opp. SJ Mot. at 7-11, 27-29, and exhibits cited therein. Indeed, the PTO found materiality here and Applicant did not challenge that finding.

Applicant has submitted no evidence that rebuts Opposer’s showing of materiality, let alone the undisputed facts that would entitle it to summary judgment. Instead, Applicant largely

⁷ Applicant argues materiality only under § 2(a), and explicitly not under § 2(e)(3), *see* App. SJ at 14-15, and, therefore, is not entitled to summary judgment on the § 2(e)(3) issue of materiality. If the Board interprets Applicant’s argument also to apply to § 2(e)(3), then Opposer’s arguments are equally applicable to that section.

reiterates its other arguments, addressed above or below, that the mark's primary significance is non-geographic; that the association with Havana would not be material to consumers because of purported consumer knowledge of the embargo; an unidentified and apparently non-existent customs regulation; the existence of a few other deceptive marks; and that the goods have a purported "connection" to Cuba based on the "Cuban seed" claim. App. SJ Mot. at 14-15. Applicant's claim that it coincidentally happened to choose "HAVANA" out of the entire universe of cigar names because it "sounded good," Bock Dep. at 56, is not only incredible on its face, but Bock then contradicts himself. Bock Decl. ¶ 3. And the evidence that a handful of other U.S. cigar companies also seek to draw a false link between their non-Cuban cigars and Havana (but not to any non-Cuban locations), far from excusing Applicant's actions, reinforces the fact that those in the U.S. cigar industry recognize that the deceptive link to Cuba will be material to consumer purchasing, else why choose a mark that makes the false linkage? See Perelman Declaration ¶¶ 19, 22-23 (noting that some in U.S. cigar industry seek to draw false or highly questionable association with Cuba through use of term "Cuban seed" for their non-Cuban tobacco); Opp. SJ Mot. at 28-29.

In re Amerise, 160 U.S.P.Q. 687 (TTAB 1969), Applicant's sole citation, is readily distinguishable. The Board there noted that the goods at issue – canned vegetables – are not particularly associated with Italy, unlike cigars and Havana. *See id.* at 688, 691-92. And, unlike here, the ITALIAN MAIDE & DESIGN mark (with a picture of a young woman) had the *double entendre* of "Italian made" and an "Italian maid," unlike the standard character mark here with the descriptive term "Club." *Id.* at 69. Nothing in the Board's recognition that goods *other* than those listed by the applicant are often sold under Italian names supports a finding that a party can register a geographical mark for goods inextricably linked to a specific place in Italy, such as

Venice for glass, merely because an applicant can point to a few others that have also sought to exploit Venice's fame for glass products. *See In re Save Venice New York*, 259 F.3d 1346, 1354 (Fed. Cir. 2001). This is precisely the situation here in which Havana is so inextricably linked to cigars that a cigar from Cuba is commonly known as a "Havana." Opp. SJ Mot. at 7-11.

D. Applicant's Cigars Will Not Come from Havana, Cuba

Nowhere does Applicant challenge the long-settled precedent that the final inquiry under section 2(e)(3) is whether "*the goods do not come from that place*" named in the mark. *California Innovations*, 329 F.3d at 1341 (emphasis added); Opp. SJ Mot. at 29-30. Applicant has admitted that neither its cigars, nor the tobacco for the cigars, nor the seeds from which the tobacco will grow will come from Havana. Nor could they under the CACR, which prohibit the importation of Cuban-origin goods in whole or in part, including goods that are "*derived in whole or in part of any article which is the growth ... of Cuba.*" 31 C.F.R. § 515.204(a)(3) & n.5, *supra* (emphasis added). Rather, Applicant makes only the unverifiable claim that his cigars will be made from tobacco that will be grown from seeds that, according to what a potential supplier in Nicaragua told Bock, are distant and remote descendants of seeds purportedly taken from Cuba almost 50 years ago. Opp SJ Mot. at 12-13, and Exhibits cited therein; App. SJ Mot. at 13 ("seeds taken from Cuba prior to the Cuban embargo" in 1962).

Opposer does not dispute the legal irrelevancy that many U.S. cigar companies sell their cigars to U.S. cigar consumers with the claim that their cigars are made from "Cuban-seed" tobacco, the apparent point of Bock Decl. Exh. A. Nor does Opposer dispute the legal irrelevancy that some such cigars may in fact be made from tobacco grown from seeds that are remote genetic descendants of seeds taken from Cuba 45 or more years ago (although it does dispute, on Applicant's motion for summary judgment here, that Applicant has submitted any

admissible evidence, as opposed to speculative hearsay, that *its* cigars will be made from such tobacco). The relevant legal fact, *and it is undisputed*, is that such cigars, tobacco and seeds “do not come from” Havana or Cuba. *California Innovations*, 329 F.2d at 1341.

Notably, Applicant does not cite a single case in support of its theory that a genetic link, let alone one as remote and unverifiable as this one, suffices to overcome what is otherwise a primarily geographically deceptively misdescriptive mark. Nor does it cite a single case that substitutes the clear and simple “goods do not come from that place” test with some other genetic connection or linkage test. Nor does Applicant advance any argument why the Board should abandon its clear test in favor of one that would either place the PTO in an impossible position or which would allow any applicant, as here, to avoid a section 2(e)(3) problem by claiming some unverifiable remote linkage to the place named in the mark. *See* Opp. SJ. at 30-32 (giving examples under such a standard).

Even if the Board were to modify its settled “goods do not come from that place” test, Applicant has not come forth with any evidence that a claimed remote genetic descent from Cuban tobacco seeds has any relevant or meaningful connection to Cuba, Havana, or Havana cigars that overcomes the bars of sections 2(a) and 2(e). Indeed, it has expressly admitted that the only connection is the remote genetic descent, and has expressly disclaimed any common characteristics, such as taste, flavor or aroma, with Havana cigars. Opp. SJ Mot. at 12-13, and exhibits cited therein. In addition, the previously filed expert affidavits of Richard B. Perelman and Eumelio Espino Marrero further establish the absence of any connection between “Cuban seed” tobacco and Havana cigars. Opp. SJ Mot. at 13-16. Even assuming the articles in Bock Decl. Exh. A that discuss “Cuban seed” tobacco are admissible, competent, non-hearsay evidence for the truth of the meaning of “Cuban seed” tobacco (which they are not), there is

simply nothing in them that establishes any connection to Havana, or Cuba, or Havana cigars, other than a claimed remote genetic link. Certainly, Applicant, the movant here, points to nothing. Simply put, there is nothing in fact or law that can turn a mark that is primarily geographically deceptively misdescriptive and deceptive for “cigars” into one that is not for “cigars made from Cuban seed tobacco.”

Applicant’s plea that the Board uphold past erroneous and mistaken PTO actions that have allowed similar “Cuban seed” registrations should be rejected. Actions based on mistakes in fact or law should be corrected, not encouraged. *See Nett Designs*, 236 F.3d at 1342, *supra*. Because the Examiner gave no explanation for reversal of the initial refusal based on the “Cuban seed” amendment, his rationale is unclear. Opposer again notes, however, that at least one prior applicant (successfully opposed by Opposer herein), in October 2001 (before registration of ten of the active cigar registrations identified by Applicant), told the same Examiner, after an initial refusal, that the seeds in fact *did* come from Cuba, which was either false or, if true, in violation of the CACR. *See* Opp. SJ at 31 n.9; Goldstein Decl. Exh. 21. The Board should give no deference to the unexplained, and factually and legally erroneous Examiner action, or to the rationale behind any other registrations, which are not in the record, particularly when Applicant failed to disclose to the PTO what it has now admitted about “Cuban seed” tobacco. Opp. SJ Mot. at 34-35; Point I.F, *infra*.

E. Applicant is Not Entitled to Summary Judgment on Opposer’s § 2(e)(1) Claim

Under section 2(e)(1), “the test for deceptive misdescriptiveness has two prongs: (i) whether the mark misdescribes the goods to which it applies; and (ii) whether consumers are likely to believe the misdescription,” with no requirement of “materiality.” *Glendale Intern. Corp. v. USPTO*, 374 F.Supp.2d 479, 485-86 (E.D.Va. 2005) (citing *In re Automatic Radio Mfg.*

Co., Inc., 404 F.2d 1391, 1396 (C.C.P.A. 1969); *Gold Seal Co. v. Weeks*, 129 F.Supp. 928, 935 (D.D.C.1955); *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (T.T.A.B. 2002). A cigar made in Cuba from Cuban tobacco is commonly known as a “Havana” or a “Havana cigar,” Opp. SJ Mot. 7-11 and Exhibits cited therein, and Bock admitted that he had no knowledge of the term having any other usage, except when used in cigar brands in the U.S. *Id.* at 10-11 & n.2; Bock Dep. at 123-25. Thus, the mark is not only primarily geographically deceptively misdescriptive, but it misdescribes a quality or characteristic of the goods, *i.e.*, a cigar from Cuba, made from Cuban tobacco. And just as the overwhelming and undisputed evidence establishes a likely consumer belief in a goods/place association, consumers are likely to believe Applicant’s misdescription of the goods.

Applicant presents no contrary evidence, and makes no arguments, other than those addressed above. App. SJ Mot. at 14. Applicant’s one citation, to *In re George Washington Ate Here*, 167 U.S.P.Q. 702 (T.T.A.B. 1970), is wholly inapposite. First, there was no deceptively misdescriptive issue in the case, only whether the mark was merely a statement of fact or an indicium of origin. *Id.* at 702. Second, consumers would readily know that it is *historically* impossible for George Washington to have eaten at a “new, counter-type establishment” in Indiana. *Id.* at 703. Here, by contrast, it may be *legally* impossible for U.S. consumers to buy genuine Havana cigars in the U.S., but if Bock, with over 35 years experience in the cigar industry, believes that he can sell cigars in the U.S. made from tobacco grown in Nicaragua from seeds purchased from Cuba, *see* Bock Dep. at 85-87, there is no reason to think consumers will not have similar misconceptions, *e.g.*, that “Havana”-branded cigars may contain genuine Cuban tobacco if manufactured elsewhere. Further, Applicant claims that consumers *will believe* there is a “connection to Cuba via the use of Cuban-seed tobacco,” App. SJ Mot. at 14, but provides no

evidence that consumers will believe the connection is merely a possible remote, unverifiable genetic link, and is otherwise meaningless as to Cuba, Havana, or genuine Cuban cigars. Indeed, Applicant plainly expects consumers to believe something quite different, and quite false.

F. Applicant Has Not Sought Summary Judgment on Opposer's Fraud Claim

In a brief paragraph, Applicant admits that it is not entitled to summary judgment on Opposer's claim of fraud on the PTO, and does nothing more than deny Opposer's claim, an action appropriate for an Answer, not a motion for summary judgment. App. SJ at 16. It submits *no* evidence, let alone undisputed evidence, and makes *no* legal argument to "show that there is no genuine issue as to any material fact and that...[it] is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). And because Applicant cannot prevail on its fraud claim on this motion, it is not entitled to dismissal of the Opposition.

Opposer additionally notes that Applicant seriously mischaracterizes the nature of Opposer's fraud claim, upon which Opposer has moved for, and is entitled to, summary judgment. *See Medinol Ltd. v. Nuero Vasx*, 67 U.S.P.Q.2d 1205, 2003 WL 21189780, *5-6 (T.T.A.B. 2003) (summary judgment finding fraud on PTO appropriate when summary judgment standard otherwise met). There is no dispute that, following the PTO's initial refusal, Applicant requested that its application be amended from "cigars" to "cigars made from Cuban seed tobacco" to overcome that refusal, *i.e.* Applicant represented to the PTO that the change from "Cuban seed tobacco" removes the geographic deception. Opposer's claim of fraud is *not* that Applicant made a false representation that it intended to use tobacco that is called "Cuban seed." *See* App. SJ Mot. at 16.⁸ Rather, Opposer's claim is that Applicant's amendment was materially

⁸ For purposes of *Opposer's* summary judgment motion only, Opposer accepts Applicant's assertion that its future HAVANA CLUB cigars will be made from tobacco grown from seeds that are remote genetic descendants of tobacco seeds that came from Cuba 45-50 years ago. Applicant has submitted *no* competent evidence that its cigars will in fact be made from such seeds, relying solely on what Bock says

misleading because in fact there is no connection between Havana, Cuba and non-Cuban cigars made from “Cuban seed” tobacco other than a possible remote and unverifiable genetic link, a fact that Applicant knew. Applicant’s failure to disclose the facts, as admitted by Applicant under oath, establishing a lack of any geographically relevant connection with Havana, Cuba, in order to overcome the initial refusal, constitutes both a material misrepresentation and material omissions in violation of Applicant’s duty of candor to the PTO. *See* Opp. SJ Mot. at 12-13, 34-35 (summarizing Applicant’s admissions and material omissions); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986); *Daesang Corp. v. Rhee Bros., Inc.*, 2005 WL 1163142, *8-9 (D. Md. May 13, 2005); Notice of Opposition ¶¶ 26-37.

II. HABANOS S.A. HAS NOT ABANDONED ITS REGISTERED MARK “HABANOS UNICOS DESDE 1492 & DESIGN”

Anncas, the petitioner on its cancellation counterclaim, has produced *no* evidence to meet its burden of establishing, on summary judgment, that respondent Habanos S.A. has abandoned its registered HABANOS UNICOS mark. Further, it has simply ignored: 1) the relevant law of excusable non-use, including the Board’s decision that the U.S. embargo of Cuban goods excuses nonuse, *Arechabala v. Havana Rum & Liquors, S.A.*, Canc. No. 22, 881 (TTAB Oct. 19, 1995) (Goldstein Decl. Exh. 22); 2) the USPTO’s uniform policy to accept section 8 Affidavits from Cuban entities based on excusable nonuse due to the embargo; 3) the embargo regulations authorizing Cuban entities to register and to renew their marks (and authorizing U.S. companies to do the same in Cuba), “to provide reciprocal protection for the intellectual property of Cuba and the United States,” Goldstein Decl. Exh. 23 (HAB00583); and 4) United States international obligations under both the Paris Convention and TRIPs to protect the registration of marks whose use is prohibited by government regulation. Because Anncas ignores these dispositive

he was told by a grower in Nicaragua that Applicant may or may not use for its future cigars. Opp. SJ Mot. at 12-13; Bock Dep. at 84-86.

legal questions, Habanos S.A. refers the Board to its summary judgment motion, particularly at 16-18, 36-41.

In addition, Habanos S.A. notes that, first, Habanos S.A. produced to Anncas in discovery a response to a USPTO Office Action, which included a copy of the *Arechabala* decision, and which is also available on TDR. HAB00129-HAB162 (*Arechabala* decision at HAB00136-154). Anncas's failure to address *Arechabala*, which is directly on point and dispositive, is inexplicable. Second, two weeks after filing its summary judgment motion, in a news article discussing the long-running dispute over ownership of the HAVANA CLUB mark for rum in the U.S., *Anncas's own attorney* acknowledged the serious reciprocity concerns in U.S.-Cuban trademark relations, including the potential for Cuban retaliation, if the United States failed to protect Cuban trademarks:

“Some day Cuba could say, ‘The heck with it, we will not honor any of these [U.S. nationals’] registrations, because you guys are not honoring ours,’” said Jesus Sanchelima, a Miami lawyer who has represented U.S. companies in trademark cases in Cuba.”

Frank Decl. Exh. 7 (Miami Herald, Aug. 20, 2006, E1, Matthew Haggman, *Bacardi's victory in the Havana Club trademark fight could spell trouble for many other U.S. businesses*).

Anncas provides no legal, evidentiary, or policy reason for the Board to put at risk over 4,000 U.S. marks registered in Cuba; to ignore and to reject the plain language of the CACR, 31 C.F.R. § 515.527(a) and the stated reciprocity-encouraging policy of the United States; to overrule *Arechabala*; and to reverse the PTO's uniform and long-standing policy of accepting Section 8 Affidavits of excusable nonuse based on the embargo. Anncas simply asserts, *ipse dixit*, that Habanos S.A.'s claim of excusable nonuse in its Section 8 Affidavit is “insufficient” to maintain its registration. App. SJ Mot. at 17. Yet, under the above considerations, precedents and obligations, nothing more should be required. Indeed, anything more would upset the *status*

quo balance that allows U.S. persons to maintain their Cuban registrations without being put to the elaborate, expensive and time-consuming proofs of future plans for their marks that Anncas now demands of Habanos S.A. here.

Remarkably, Anncas never mentions the excusable nonuse statute, 15 U.S.C. § 1058(b)(2), nor does it discuss the law of excusable nonuse generally, or specifically with respect to the Cuban embargo or other government prohibitions. Oddly, Anncas instead devotes most of its legal discussion to the meaning of the statutory term “bona fide” as used in 15 U.S.C. § 1051(b), for intent to use applications. *See* App. SJ Mot. at 17-18.⁹ Neither section 8(b)(2), nor the definition of “abandonment” in section 45, nor the governing case law on abandonment, however, use the term “bona fide” under discussion in Anncas’s citations. And even if the section 1(b) standard were the governing law, Habanos S.A. has submitted overwhelming and undisputed evidence of a “bona fide” intent to use the mark in the U.S. as soon as U.S. law permits, as discussed below, and in Opp. SJ Mot. at 16-20, 40-42, and Exhibits cited therein.

The governing legal principles for excusable nonuse and abandonment are set out in Habanos S.A.’s summary judgment motion, at 36-37, 40-41. In summary, the owner may file an affidavit “showing that [its] nonuse [of the mark] is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.” 15 U.S.C. § 1058(b)(2); *see* 37 C.F.R. § 2.161(f)(2). “Nonuse may be considered excusable where the owner of the registration is willing and able to continue use of the mark in commerce, *but is unable to do so due to a trade embargo.*” T.M.E.P. §1604.11 (emphasis added). A mark is defined as abandoned only when it has not been used in commerce for at least three years *and* “when its use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127. The registrant

⁹ Although Anncas attempts to make it appear as if it were discussing the law of excusable nonuse under section 8, all of its citations in fact refer to the statutory standard for ITU applications, and all are lifted directly from the discussion of ITU applications in 3 *McCarthy*, § 19:14, at 19-39 to 19-41.

need only come forward with evidence of intent to resume use of the mark. *See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 1025-26 (Fed Cir. 1989). “If a registrant's nonuse is excusable, the registrant has overcome the presumption that its nonuse was coupled with an ‘intent not to resume use.’” *Imperial Tobacco Ltd. v. Phillip Morris, Inc.*, 899 F.2d 1575, 1581 (Fed. Cir. 1990); *see Arechabala*, at 14-15 (“The presumption of abandonment is readily rebutted by a showing that nonuse is due to special circumstances which excuse nonuse and is not due to any intention to abandon the mark.”) Once the registrant has come forward with such evidence, the ultimate burden of proof (and production) shifts back to the petitioner to prove abandonment, *i.e.*, an intent not to resume use. *See Cerveceria*, 892 F.2d at 1026; *id.* at 1023-24 (“burden of proof is placed upon those who seek cancellation”; petitioner faces greater evidentiary burden in cancellation than in opposition proceedings, in which “the registrant benefits from a presumption of validity”).

Thus, even if it were appropriate to force Habanos S.A. to go beyond its Section 8 Affidavit, Anncas must not only show “an *absence* of evidence” that Habanos S.A. has an intent to resume use, *Celotex*, 477 U.S. 317, 325 (1986) (emphasis added), the standard when the *non-movant* has the burden of proof, but it must further show undisputed evidence of an intent not to resume use of the mark.¹⁰ Here, Anncas has both ignored Habanos S.A.’s evidence, and has submitted none of its own on its ultimate burden. In contrast, Habanos S.A. has submitted overwhelming, extensive, and unrebutted evidence of its intent to resume use that not only defeats Anncas’s motion, but which entitles Habanos S.A. to summary judgment. *See* Opp. SJ at 16-20, 40-42, and Exhibits cited thereto.

¹⁰ At his deposition, Anncas’s principal admitted he was completely unaware that Anncas’s attorneys had even filed a counterclaim; he had no idea what mark was involved; and he was not aware of any evidence that the mark had been abandoned. *See* Opp. SJ Mot. at 42; Bock Dep. at 28-29, 135-36.

First, Anncas chose not to depose a single witness, or to ask one Interrogatory concerning Habanos S.A.'s intent with respect to use of the mark in the United States. See Applicant's Exh. G. Having chosen not to seek discovery, it cannot now claim a right to summary judgment because Habanos S.A. did not respond to non-existent questions.¹¹ Notably, on its summary judgment motion, Habanos S.A. submitted the Declaration of its long-time Commercial Vice President, Manuel Garcia Morejon, who explained Habanos S.A.'s ongoing marketing strategy in the United States in preparation for lifting the embargo, which strategy includes a plan to use the HABANOS UNICOS mark in the U.S. "just as it does throughout the rest of the world"; regular advertising of the mark in the leading consumer cigar magazines; cooperation with United States cigar-related journalists and publications in the United States; and registering and maintaining the HABANOS UNICOS, and numerous other, cigar marks in the U.S. See Garcia Morejon Declaration, ¶¶ 14-20, and Exh. 3-5 thereto. Had Anncas bothered to seek discovery on this issue, it would have obtained this information prior to filing its frivolous motion.

Second, Anncas ignores the un rebutted evidence that Habanos S.A. uses the HABANOS UNICOS mark in connection with the sales, advertisement and promotion of its genuine Cuban cigars throughout the world. *Id.* ¶ 14, Exh. 3. Anncas, whose principal boasts of 35 years in the cigar business, is undeniably aware of both the size and wealth of the U.S. cigar market, and the substantial demand that would exist in the U.S. for Cuban-origin cigars. Anncas proffers no evidence, and makes no attempt to explain why Habanos S.A. would either choose not to enter the U.S. market upon the lifting of the embargo, or why it would abandon its worldwide strategy of using the HABANOS UNICOS mark in connection with the sale, advertising and promotion of its genuine Cuban cigars.

¹¹ Anncas did make three requests for admissions, that Habanos S.A. has "no plan to use," and no "bona fide intention to begin use" of the HABANOS UNICOS mark on cigar or tobacco products in U.S. commerce, each of which were denied. See Exh. G to App. SJ Mot. (Requests to Admit, Nos. 7, 8 10).

Third, Anncas ignores the unrebutted evidence that Habanos S.A. has registered and maintained numerous marks in the U.S., despite the embargo. Opp. SJ Mot. at 17; Goldstein Decl. Exh. 16. Anncas proffers no evidence, and gives no explanation why Habanos S.A. would go to the expense and effort to register these marks, including the HABANOS UNICOS mark, if it had no intent to enter the U.S. market and use the HABANOS UNICOS mark in commerce.

Fourth, Anncas ignores the unrebutted evidence that Habanos S.A. has filed several successful lawsuits and TTAB proceedings to protect its HABANOS UNICOS mark (and one in which a default motion is pending). See Opp. SJ Mot. at 19-20, Goldstein Decl. Exh. 20; Garcia Morejon Decl. Ex. 1 (Response to Int. No. 6). Anncas makes no attempt to explain why Habanos S.A. would go to the considerable expense of policing its HABANOS UNICOS mark through litigation in the U.S. courts and the TTAB if it had no intent to use the mark.

Fifth, Habanos S.A. has produced 108 advertisements for the HABANOS UNICOS mark in the leading U.S. cigar consumer magazines over the past decade, which dispositively establishes its intent to use. Garcia Morejon Decl. ¶ 18, and Exh. 5. Unable to rebut this proof of intent to use, Anncas instead draws meaningless and irrelevant distinctions concerning the advertisements. Not in dispute, however, is that *every one* of the 108 advertisements uses, always in the stylized form of the registration, “HABANOS Unicos desde 1492,” its closely related translations, “HABANOS Unique since 1492,” or “HAVANAS Unique since 1492,” or the dominant feature of the mark “HABANOS,” all of which plainly form the same commercial impression (103 of 108 ads use “HABANOS”; five use “HAVANAS”; 80 use the full mark, 75 in Spanish or the combined Spanish and English.). This use of the mark in Spanish, Spanish and English, in English, or with its dominant feature, all evidence an intent to use the mark. See *Bacardi I*, 48 U.S.P.Q.2d at 1033 n.7 (finding “HAVANA and HABANA to be equivalent”).

Anncas's claim that use of the mark in translation constitutes undisputed evidence of an intent not to resume use is not only frivolous; it directly contradicts Anncas's own reliance on marks using the Spanish "Habana/o" to claim its mark is not deceptive.

Anncas gives no explanation of the legal relevance, or even what it means, by its characterization that "many" (identifying 8 of 108, or 7.3%) advertisements "give the impression that Habanos S.A.'s designations are connected with the service of [*sic*] distribution of or the retail sale of tobacco products." App. SJ Mot. at 19. Whatever Anncas's point, it fails to rebut the fact that the use of the mark in advertisements in the U.S. are powerful evidence of Habanos S.A.'s intent to use the mark in the U.S. when U.S. law permits.

Finally, Habanos S.A. briefly responds to Anncas's "header": "Whether Opposer abandoned its mark *upon which it claims standing.*" App. SJ Mot. at 16 (emphasis added). Anncas makes no further reference or argument concerning a claim of standing based on its HABANOS UNICOS mark, and it is thus unclear what point, if any, Anncas is making. For clarification, however, Habanos S.A.'s standing is not based on that mark. Rather, it is based on its interest, as the exclusive worldwide exporter of genuine Cuban-origin Havana cigars, in preventing geographically and other deceptive uses of "Havana" for cigars not from Havana or Cuba, in order to protect the reputation of its primary product, genuine Havana cigars, including its interest in the U.S. market when U.S. law permits its entry. Habanos S.A. has not claimed interference or confusion with its registered HABANOS UNICOS mark. Rather, it pled, in connection with its claims of injury based on its interest in the reputation of genuine Havana cigars, that its ability to use its HABANOS UNICOS mark in the U.S. when law permits will be damaged by registration of HAVANA CLUB, because U.S. consumers will be deceived into believing that non-Cuban cigars are also Havana cigars. Notice of Opposition, ¶¶ 47-50.

To establish standing under sections 2(a),(e)(1) or (3), an opposer “need only plead facts sufficient to show a personal interest in the outcome of the case beyond that of the general public,” without any need to claim ownership of such a mark or to be using the term as a trademark. *Commonwealth of Aruba v. Excelsior, Inc.*, 5 U.S.P.Q.2d 1685, 1686 (T.T.A.B. 1987); *see* 15 U.S.C. § 1063(a) (standing to oppose to “[a]ny person who believes that he would be damaged.”); *Harjo v. Pro Football*, 30 U.S.P.Q.2d 1828, 1830 (T.T.A.B. 1994); 3 *McCarthy*, §§ 20:10, 20:11. Habanos easily meets the standard in *Aruba* and discussed in *McCarthy*, and thus has standing *independent* of the HABANOS UNICOS mark.

Moreover, because Anncas’s attack on the HABANOS UNICOS mark is irrelevant to Habanos S.A.’s opposition to the HAVANA CLUB mark, Anncas has no interest in canceling the mark based on abandonment that is “beyond that of the general public.” *Aruba*, 5 U.S.P.Q.2 1685. While standing in the TTAB is relaxed, it has “not been read out of the Act entirely.” 3 *McCarthy*, § 20:10, at 20-24. Because Anncas cannot base its standing to cancel the HABANOS UNICOS mark on its interest in the HAVANA CLUB mark, it is in fact nothing more than a “mere intermeddler.” *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d 1382, 1385 (T.T.A.B. 1991). Because “[t]he standing question is an initial and basic inquiry made by the Board in every inter partes case: that is to say, standing is a threshold inquiry,” *id.*, the Board should review the issue and find that Anncas lacks standing to bring its counterclaim.

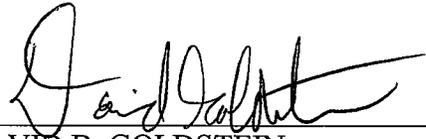
CONCLUSION

For the reasons stated herein, and on the papers submitted herewith, and on the prior papers filed by Opposer Corporacion Habanos, S.A. on its motion for summary judgment, Applicant’s motion for summary judgment: 1) dismissing Opposer’s Opposition to registration of Applicant’s mark, HAVANA CLUB, Serial No. 78/363024; and 2) granting Applicant’s

counterclaim to cancel Registration No. 2,177,837, owned by Opposer, should be denied.

Dated: New York, New York
September 22, 2006

Respectfully submitted,



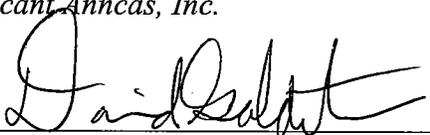
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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of Opposer Corporacion Habanos, S.A.'s OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT and Declaration of Lindsey Frank and Exhibits thereto, were served on Applicant by mailing, postage prepaid, said copy on September 22, 2006 via U.S. Express Mail to:

Henry Rodriguez, Esq.
SANCHELIMA & ASSOCIATES, P.A.
235 S.W. Le Jeune Road
Miami, FL 33 134- 1762
Counsel for Applicant Anncas, Inc.



DAVID B. GOLDSTEIN

CERTIFICATE OF ELECTRONIC FILING

The undersigned hereby certifies that he has caused a true and correct copy of Opposer Corporacion Habanos, S.A.'s OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT and Declaration of Lindsey Frank and Exhibits thereto, to be filed electronically through the ESTTA system on September 22, 2006.



DAVID B. GOLDSTEIN

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD**

CORPORACION HABANOS, S.A.,)	
)	
Opposer,)	Opposition No. 91165519
)	
v.)	
)	
ANNCAS, INC.,)	
)	
Applicant.)	
)	

DECLARATION OF LINDSEY FRANK

I, LINDSEY FRANK, state as follows:

1. I am a May 2006 graduate from Fordham Law School in New York, New York and sat for the New York State Bar in July, 2006. I am currently employed at the law firm of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., counsel for Opposer Corporacion Habanos, S.A., in this matter.

2. I have reviewed the Declaration of William Bock, dated August 3, 2006, filed by Applicant in support of its motion for summary judgment, and Exhibits A, B and C to that Declaration. Exhibits A and B purport to be cigar advertisements, articles, and industry publications. Exhibit C consists of twenty-eight (28) records from the Trademark Trial and Appeal Board's Trademark Electronic Search System ("TESS") for marks in IC 34 that include the term "Havana" or its Spanish equivalent, "Habana" or "Habano," or its adjectival form, "Habanera."

3. As an overview, of these twenty-eight (28) records there are only thirteen (13) marks that are not abandoned, pertain to cigars, and include the word 'Havana/Habana/o.' Of the remaining thirteen (13) records: ten (10) marks were registered within the

cancellation period to bring challenges under sections 2(a), (e)(1) and (e)(3); eight (8) marks have been registered in 2004 or later; and only one (1) of the marks predates 2001. Additionally, Applicant has not produced any consumer advertisements, articles, or publications concerning eight (8) of these thirteen (13) marks. Of the five (5) marks advertised to consumers, two (2) marks have only one small ad each in one 2006 catalog; one (1) mark only has one full-page ad; and the remaining two (2) marks pertain to the same company and almost uniformly appear together. More specifically:

4. Of the twenty-eight (28) records, five (5) registrations were for goods and services that did not include cigars: (i) Havana [Reg. No. 2887974] – cigarettes; (ii) H Havana. [Reg. No. 3114773] – cigarettes; (iii) Havana Blossom [Reg. No. 2588575] – chewing tobacco; (iv) Havana Blossom [Reg. No. 2594416] – chewing tobacco; (v) Havana Blossom Freshner & Tastier [Reg. No. 1358381] – chewing tobacco.

5. Of the remaining twenty-three (23) records, four (4) were duplicate records— that is, a second or third record of the same mark by the same owner for the same or similar goods: (i) Hoja de Habano [Reg. No. 2924482], the same as Hoja de Habano [Reg. No. 2957140]; (ii) La Habanera [Reg. No. 2533854], the same as La Habanera [Reg. No. 2968322]; (iii) La Habanera [Reg. No. 2958056], the same as La Habanera [Reg. No. 2968322]; (iv) Havana Honeys [Reg. No. 2548553], the same as Havana Honeys [Reg. No. 2607378].

6. Of the remaining nineteen (19) records, five (5) appear to have been abandoned, as follows. For two (2) of the marks, there is no indication on the TESS or TARR databases that the registrants filed a Section 8 Affidavit within six and one-half years of the registration dates: (i) Havana Florida Cigars [Reg. No. 2322113] – registered

2/22/2000; (ii) Havana Republic Purveyors of Premium Cigars 1834 [Reg. No. 2301203] – registered 12/21/1999. The other three (3) marks have exceeded the time to file either a Section 8 Affidavit or a combined Section 8/Section 9 Affidavit, but are still within their six-month “grace” periods: (i) Havana Reserve Don Lino [Reg. No. 2380225] – registered 8/29/2000; (ii) Havana Pride [Reg. No. 1986031] – registered 7/9/1996; (iii) Pride of Havana [Reg. No. 1981346] – registered 6/18/1996. Annexed hereto as Exhibit 6 are true and correct copies of the TARR records concerning these five marks.

7. Of the remaining fourteen (14) records, one (1) mark does not contain the word ‘Havana/Habana/o’: (i) La Habanera [Reg. No. 2968322].

8. Of the remaining thirteen (13) records, only one (1) mark was registered prior to 2001, El Rico Habano [Reg. No. 2195303] – registered 10/13/1998; and only two others were registered in 2001 -- Schimmelpenninck Cigar Havana [Reg. No. 2439869] – registered 4/3/2001; Experience the Night Havana Nights [Reg. No. 2435483] – registered 3/13/2001 -- with eight others registered from 2004-06.

9. Of these thirteen (13) marks, Applicant did not submit any consumer advertisements or articles mentioning eight (8) of these marks. Of these eight (8) marks, five (5) are not mentioned at all. The three (3) others appear only in the 2005 TOBACCO RETAILERS’ ALMANAC, ANNUAL INDUSTRY DIRECTORY, with no indication that this Industry Directory is circulated to consumers or that these brands are currently in commercial use. *See* Havana Sunrise [Reg. No. 2900059]; Habana Gold [Reg. No. 3056917]; Havana Blend [Reg. No. 2890975]. I note that Applicant has also submitted an email created by Applicant’s principal, William Bock, sent to his attorney, but there is

no evidence of what this email -- which was prepared before Bock's deposition on March 24, 2006, but not produced until afterwards -- purports to be [A000045-000046].

10. Of the remaining five (5) marks: for two (2) marks, Applicant has submitted one small ad for each mark in one 2006 cigar catalog -- El Rico Habano, at A000090 and Havana Sweets [Reg. No. 2571691], at A000088; one (1) mark has one full-page ad from 2004 -- Havana Honeys, at A000165; and the remaining two (2) marks are from the same company, and almost uniformly appear together -- Habana Cuba Cigar Company Premier Selection [Reg. No. 2824478] and Cuban Pleasures Habana Cuba [Reg. No. 2829254].

11. Annexed hereto are certain exhibits referred to in Opposer Corporacion Habanos S.A.'s Opposition to Applicant's Motion for Summary Judgment, as follows.

12. Annexed hereto as Exhibit 1 are true and correct copies of: an Office Action, dated Mar. 14, 1995, Serial No. 74/572667 for HAVANA CLUB for rum; and an Office Action, dated April 26, 2001, for the same mark.

13. Annexed hereto as Exhibit 2 is a true and correct copy of a printout of Doreen Hemlock, "A clear win for Bacardi as U.S. declares trademark on Havana Club 'expired,'" *South Florida Sun-Sentinel* (Aug. 9, 2006) at <http://www.sun-sentinel.com>.

14. Annexed hereto as Exhibit 3 is a true and correct copy of the Declaration of John Gomez, dated September 12, 2006, in support of Defendant's Motion to Transfer Venue to the Southern District of Florida, filed in *Pernod Ricard USA, LLC v. Bacardi U.S.A., Inc.*, 06-cv-505 (Dist. Del.), concerning litigation over the mark HAVANA CLUB for rum.

15. Annexed hereto as Exhibit 4 are true and correct copies of excerpts from *Galleon S.A. v. Havana Club Holding, S.A.* (Cancellation No. 92024108), dated Jan. 29,

2004, showing that Bacardi had distributed 922 cases of Galleon's HAVANA CLUB rum in the United States, which occurred in 1995-96.

16. Annexed hereto as Exhibit 5 are true and correct copies of Applicant's Responses to Opposers' Second Set of Interrogatories and Requests for Production.

17. Annexed hereto as Exhibit 7 are true and correct copies of Matthew Haggman, "Bacardi's Victory in the Havana Club Trademark Fight Could Spell Trouble for Many Others U.S. Businesses," *Miami Herald*, E1 (Aug. 20, 2006).

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct to the best of my knowledge, information and belief.

Dated this 22d day of September, 2006
New York, New York



LINDSEY FRANK

EXHIBIT 1

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 74/572667 GALLEON S.A.		PAPER NO.
APPLICANT		ADDRESS: ASSISTANT COMMISSIONER FOR TRADEMARKS 2900 Crystal Drive Arlington, Virginia 22202-3513 If no fees are enclosed, the address should include the words "Box 5." Please provide in all correspondence: <ol style="list-style-type: none">1. Filing Date, serial number, mark and Applicant's name.2. Mailing date of this Office action.3. Examining Attorney's name and Law Office number.4. Your telephone number and ZIP code.
MARK HAVANA CLUB	ACTION NO. 01	
ADDRESS William R. Golden, Jr. 101 Park Avenue New York, NY 10178	MAILING DATE 03/14/95	
REF. NO.		
FORM PTO-1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE	

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number 74/572667

The examining attorney refuses registration because the mark consists of or comprises deceptive matter in that the mark contains a geographic designation where the goods for which registration is sought are produced and the goods do not originate from that geographical location. Trademark Act Section 2(a), 15 U.S.C. Section 1052(a). See *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988); *In re Perry Mfg. Co.*, 12 USPQ2d 1751 (TTAB 1989); *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986); TMEP section 1203.02.

The primary significance of the term "Havana" is geographic. The public is likely to believe that the goods come from this place. Furthermore, this belief would materially influence consumers to purchase the goods. *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984). See TMEP sections 1210.04 and 1210.07.

If the goods, however, will not originate in Havana, the examining attorney refuses registration on the Principal Register because the mark is primarily geographically deceptively misdescriptive of the applicant's goods. Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3); TMEP section 1210.06.

A mark which, when used on or in connection with the applicant's goods or services, is primarily geographically deceptively misdescriptive of them, is registrable upon a showing of acquired

distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), only if it became distinctive of the goods or services in commerce before December 8, 1993, the date of the enactment of the North American Free Trade Agreement Implementation Act, Public Law 103-182, 107 Stat. 2057. Similarly, such a mark, capable of distinguishing the applicant's goods or services, may be registered on the Supplemental Register only if it has been in lawful use in commerce by the owner since before December 8, 1993.

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1,031,651 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.

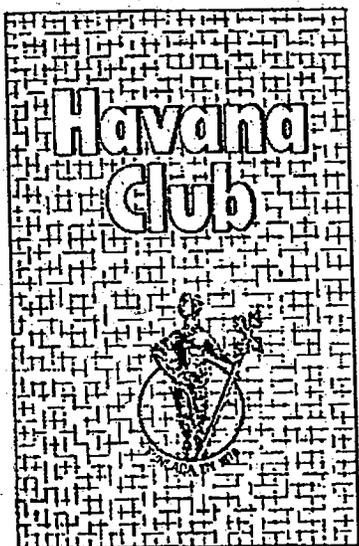
Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

The examining attorney encloses information regarding pending Application Serial No. 522,925. The filing date of the referenced application precedes the applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If the referenced application matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01. *w/d*

The wording "rum specialty drinks" in the identification of goods is unacceptable as indefinite. The applicant must amend the identification to specify the commercial name of the goods. If there is no common commercial name for the product, the applicant must describe the product and its intended uses. TMEP section 804.


David C. Reihner, Examining Attorney
Law Office 12, (703) 308-9112 ex 223

DCR



Word Mark

HAVANA CLUB

Goods/Services

IC 033; US 049; G & S: RUM; FIRST USE: 1913.11.01; FIRST USE IN COMMERCE:
1913.11.01

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code

04.01.25; 20.03.10; 26.11.21

Serial Number

73-023981

Filing Date

1974.06.12

Registration Number

1031651

Registration Date

1976.01.27

Owner Name/Address

(REGISTRANT) EMPRESA CUBANA EXPORTADORA DE ALIMENTOS Y PRODUCTOS VARIOS
DBA CUBA EXPORT COMPANY CUBA 55, 23RD ST. VEDADO HAVANA CUBA

Section 44

SECT 44

Disclaimer

*Renewed for
10 years*

APPLICANT DISCLAIMS THE WORDS "HAVANA" AND "FUDNADA EN 1878" APART FROM
THE MARK AS A WHOLE.

Description of Mark
THE DRAWING IS LINED FOR THE COLOR GOLD.

Type of Mark
TRADEMARK

Register
PRINCIPAL

Affidavit
SECT 8.

UNITED STATES PATENT AND TRADEMARK OFFICE

PAPER NO.

SERIAL NO.

APPLICANT

74/572667 GALLEON S.A.

MARK

HAVANA CLUB

ADDRESS

William R. Golden, Jr.
101 Park Avenue
New York, NY 10178

ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
www.uspto.gov

ACTION NO.

04

MAILING DATE

04/26/01

REF. NO.

If fees are enclosed, the address should include the
file "Box Responses - No Fee."

Please provide in all correspondence:

- Filing Date, serial number, mark and Applicant's name.
- 1. Mailing date of this Office action.
- 3. Examining Attorney's name and Law Office number.
- 4. Your telephone number and ZIP code.

FORM PTO-1525 (5-99)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.
For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 74/572667

This letter responds to the applicant's communication filed on March 1, 2001.

Applicant filed September 12, 1994, this trademark application to register the mark "Havana Club" for rum and rum specialty drinks. Registration was refused under Trademark Act § 2(d) based upon subsisting U.S. Trademark Registration no. 1,031,651 (owned by Empresa Cubana Exportadora De Alimentos Y Productos Varios d.b.a. Cuba Export Company, a Cuban state Enterprise) for the mark "Havana Club" and design for rum. The cited mark was registered January 27, 1976, and renewed in 1996 for a 10-year term of protection. Applicant now claims that its mark is registrable due to various decisions issued by the Federal District Court for the Southern District of New York all of which were affirmed by the Court of Appeals for the Second Circuit in the case of *Havana Club Holding S.A. v. Galleon S.A.*, 53 USPQ2d 1609 (2nd Cir. 2000). Is applicant's mark now registrable?

A cyclone of claims, counterclaims, issues, policies, regulations, licenses, and politics swirl around the trademark "Havana Club", yet it is the only constant that does not change. Cutting through all the issues and actions to the eye of this legal storm reveals a few clearly decided points. The attempt by the assignees of Cuba Export Company to assign the rights in the mark from Cuba Export Company to themselves was unsuccessful and the rights in the mark and U.S. Trademark

Registration no. 1,031,651 reside in Cuba Export Company. The attempts of the assignees of Cuba Export Company to protect their rights in the mark vis-à-vis applicant in the United States were unsuccessful because, succinctly stated, the assignees do not own the mark. Further, U.S. Trademark Registration no. 1,031,651 was neither cancelled nor determined to be the property of applicant. Finally, applicant's registration rights were unaddressed. Correspondingly, the refusal to register the mark under Trademark Act § 2(d) based upon both U.S. Trademark Registration nos. 1,031,651 and 1,956,660 is maintained.

The refusal to register the mark under Trademark Act § 2 (e)(3) is maintained.

Applicant failed to respond to paragraphs 5, 6, 7, and 8 of Office Action dated February 8, 2001. Applicant is required to address these issues: the assignment of the mark and application, a possible claim of distinctiveness, and the amendment of the identification of goods to contain fewer goods contained in the Amendment to Allege Use.



David C. Reihner, Examining Attorney
Law Office 107,
Telephone 703-308-9107 ext. 169

EXHIBIT 2



http://www.sun-sentinel.com/business/local/sfl-zrum09aug09_0,4546285.story?coll=sfla-business-headlines

A clear win for Bacardi as U.S. declares trademark on Havana Club 'expired'

By Doreen Hemlock
South Florida Sun-Sentinel

August 9, 2006

A new rum is coming to South Florida this week: the Havana Club brand -- but made in Puerto Rico, not Cuba, and clear, not dark, in color.

Bermuda-based liquor giant Bacardi Ltd. is launching its latest version of the veteran brand for the United States, nearly a decade after it halted production amid a trademark dispute with the group making rum under the same name in Cuba.

Central to the dispute is the 45-year-old U.S. trade embargo against the communist-led island that bans sales of Cuban products in the United States. The rum battle stretched far, even to the Geneva-based World Trade Organization and the U.S. Supreme Court.

The latest chapter ended this month, when the U.S. Patent and Trademark Office declared Cuba's registration of the Havana Club trademark as "canceled/expired." That means Cuba can no longer claim rights to the brand in the United States.

Bacardi had bought the brand name from the Arechabala family, who created the original Havana Club in Cuba in 1935. They exported the rum to the United States before the Castro regime seized the business in 1960, sending them into exile.

U.S. trademark law generally stems from use of a brand name, so the Cuban-European company now making the rum in Cuba faced legal hurdles for failing to use the name in the United States.

Bacardi insists its new clear rum is authentic, based on the original Havana Club recipe.

Even production in Puerto Rico is not new. During World War II, the Arechabalas made Havana Club both in Cuba and the U.S. territory of Puerto Rico to keep supplies flowing and avert higher wartime taxes on U.S. sales from Cuba.

But rum aficionados will find much changed in the clear rum sold in 750-milliliter bottles for a suggested \$19.99.

This time, Bacardi aims to tap both the U.S. craze for premium white spirits, such as Grey Goose vodka, and the recent upswing in sales of rum -- up 5 percent to 7 percent yearly, trailing only tequila in growth, spokeswoman Patricia Neal said Tuesday.

Neal said Bacardi is launching the brand in Florida because it's the top state for rum and because a debut in South Florida bars, restaurants and clubs creates celebrity "buzz" that helps sell the drink in New York and other U.S. markets.

Doreen Hemlock can be reached at dhemlock@sun-sentinel.com or 305-810-5009.

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EXHIBIT 3

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

PERNOD RICARD USA, LLC.,

Plaintiff,

v

BACARDI U.S.A., INC.,

Defendant.

C.A. No. 06-505 (\$LR)

DECLARATION OF JOHN GOMEZ

I, John Gomez, of full age, hereby declare as follows:

1 I am Vice President and Group Marketing Director of defendant Bacardi U.S.A., Inc. ("Bacardi") in this action. I make this Declaration in support of Defendant's Motion to Transfer Venue to the Southern District of Florida.

2 Bacardi's HAVANA CLUB rum is presently sold only in the state of Florida. It is not sold in the state of Delaware.

3 Bacardi's HAVANA CLUB rum is distilled in Puerto Rico, based on a recipe provided to Bacardi by the Arechabala family, which manufactured HAVANA CLUB rum both in Cuba and Puerto Rico before 1960. Bacardi's HAVANA CLUB rum is bottled in Jacksonville, Florida, and shipped only to distributors in Florida. Bacardi's product is not manufactured in, nor is it shipped through, the state of Delaware.

4 All of Bacardi's executive offices and business operations relating to the development, marketing and sale of its HAVANA CLUB rum are based out of Miami, Florida. Bacardi has no offices, business locations, or employees in Delaware that have any connection to

the development, marketing or sale of the HAVANA CLUB rum product. Substantially all of Bacardi's documents and other materials relating to its HAVANA CLUB rum are kept in Bacardi's Miami, Florida offices. Bacardi's affiliates in Jacksonville, Florida and Puerto Rico also have documents relating to the production and bottling of HAVANA CLUB rum. While Bacardi distributes certain other products to wholesalers in Delaware, transfer of title to those products occurs outside the state. Bacardi's HAVANA CLUB rum is not distributed in the state.

5 The press release attached to the Complaint in this action as Exhibit C was issued in Miami, Florida by Bacardi-Martini Inc.'s corporate communications department, and written and developed by Bacardi and its Miami-based affiliates.

6 The interview with me attached to the Complaint in this action as Exhibit D was conducted by telephone. I was in Miami, Florida, at the time I gave this interview

7 At trial, Bacardi believes it would have to rely on testimony from the following employees about the following subjects. All of them work and reside in the Miami, Florida area

A) Myself. I work and live in the Miami area and supervise the marketing of Bacardi's HAVANA CLUB rum. I would provide testimony about Bacardi's marketing of and advertising for its HAVANA CLUB rum made the statements in the interview attached to the Complaint as Exhibit D, which Plaintiff alleges are false. I would also provide testimony concerning the factual nature of the statements made during the interview and the steps taken by Bacardi to ensure that its advertising statements concerning HAVANA CLUB rum are correct. All of my files relating to HAVANA CLUB rum are located in Miami

B) Cathy Bayer, Marketing Research Director, who works and lives in the Miami area, supervised marketing research which was used in the development of Bacardi's HAVANA CLUB rum, and would provide testimony about the marketing research conducted in connection

with Bacardi's HAVANA CLUB rum. All of Ms. Bayer's files relating to HAVANA CLUB rum are located in Miami

C) Doug Landa, Vice President for Southern Division Sales, who works and lives in the Broward county area near Miami, coordinated sales of Bacardi's HAVANA CLUB rum, and would provide testimony about distributor and retailer perceptions of and reactions to the product. All of Mr. Landa's files relating to HAVANA CLUB rum are located in Miami.

D) Gonzalo Mengotti, Vice President for Promotions Services, who lives and works in the Miami area, supervised production of the promotional materials used for Bacardi's HAVANA CLUB rum, and would provide testimony concerning the development and distribution of those promotional materials. All of Mr. Mengotti's files relating to HAVANA CLUB rum are located in Miami.

E) Ken Sutter, Senior Vice President, Finance, who lives and works in the Miami/Broward county area, dealt with the financial issues associated with the development and marketing of the HAVANA CLUB rum, and would provide testimony concerning the financial expenditures incurred by Bacardi in connection with the development, production, advertising, and promotion of its HAVANA CLUB rum. All of Mr. Sutter's files relating to HAVANA CLUB rum are located in Miami

F) Alfredo Piedra, President & Chief Executive Officer of Bacardi Innovations, who lives and works in the Miami area, participated in certain segments of the launch of HAVANA CLUB rum and would provide testimony concerning the development of the product. All of Mr. Piedra's files relating to HAVANA CLUB rum are located in Miami

8. It would be disruptive to the business of Bacardi if the foregoing employees were required to travel to Delaware because of this litigation. This burden would be significantly lessened if the case were transferred to the Southern District of Florida.

9. Bacardi is also likely to rely on testimony from the following employees of Bacardi's affiliates and sister companies. Again, none of these employees work or reside in Delaware:

A) Jim Goodwin, Senior Vice President and General Manager for Bacardi-Martini New Product Development, Inc., who lives and works in the Jacksonville, Florida area, was involved in the development of a flavored rum that would be made with HAVANA CLUB rum, as well as steps taken in production and distilling of a flavored rum made with Bacardi's HAVANA CLUB rum to ensure that the product is of an appropriate quality.

B) Yousef Zaatar, Vice President of Product Manufacturing Development, The Americas, Bacardi Global Packaging, for Tradall Americas, Inc., who lives and works in the Jacksonville, Florida area, was involved in the development of packaging for HAVANA CLUB rum, and would provide testimony concerning the development and design of the HAVANA CLUB rum packaging and internal impressions of that packaging.

C) Luis Planas, Processing Director for Bacardi Corporation, who lives and works in San Juan, Puerto Rico, worked on the development of the rum sold as Bacardi's HAVANA CLUB rum, and will provide testimony concerning Bacardi's claim that its HAVANA CLUB rum is based on the same recipe used for the production of the HAVANA CLUB rum produced prior to 1960.

D) Pat Neal, Vice President, Corporate Communications for Bacardi-Martini, Inc who lives and works in the Miami area, headed up Bacardi's communications strategy for

HAVANA CLUB rum and made several of the statements which Plaintiff contends are false. She would provide testimony concerning those statements and the basis for those statements.

10. I am informed and believe that it would also be disruptive to the business of Bacardi's affiliates and sister companies for their employees to have to come to Delaware because of this litigation.

I hereby declare under penalty of perjury that all of the statements made by me herein are true and correct.



JOHN GOMEZ

Dated: September 12, 2006

UNITED STATES DISTRICT COURT
DISTRICT OF DELAWARE

CERTIFICATE OF SERVICE

I hereby certify that on September 13, 2006, I caused to be served by hand delivery the foregoing document and electronically filed the same with the Clerk of Court using CM/ECF which will send notification of such filing(s) to the following:

Jack B. Blumenfeld
Rodger D. Smith, II
MORRIS, NICHOLS, ARSHT & TUNNELL LLP
1201 N. Market Street
P.O. Box 1347
Wilmington, DE 19801

I hereby certify that on September 13, 2006, I have sent by Federal Express the foregoing document to the following non-registered participants:

Herbert F. Schwartz
Vincent N. Palladino
Pablo D. Hendler
ROPES & GRAY LLP
1251 Avenue of the Americas
New York, NY 10020



Anne Shea Gaza (#4093)
Gaza@rlf.com
Richards, Layton & Finger, P.A.
One Rodney Square
P.O. Box 551
Wilmington, Delaware 19899
(302) 651-7700

EXHIBIT 4

**DIPOSITION
IS NOT CITABLE
AS PRECEDENT
OF THE TTAB**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Zervas

Mailed: January 29, 2004

Cancellation No. 92024108

Galleon S.A., Bacardi-
Martini U.S.A., Inc., and
Bacardi & Company Limited

v.

Havana Club Holding,
S.A., dba HCH, S.A., and
Empresa Cubana
Exportadora De Alimentos
y Productos Varios, S.A.,
dba Cubaexport, joined as
a defendant

**Before Sams, Chief Administrative Trademark Judge, and
Cissel and Walters, Administrative Trademark Judges.**

By the Board.

On January 21, 2003, the Board (i) resumed proceedings and allowed the parties time to brief petitioners' motion (filed March 15, 2002) for summary judgment; (ii) joined Empresa Cubana Exportadora De Alimentos y Productos Varios, S.A. ("Cubaexport") as a defendant along with Havana Club Holding, S.A. ("HCH"); and (iii) denied HCH's "Motion Pursuant to the Government in the Sunshine Act for (A) an Order Requiring Petitioners to Show Cause Why Their Claims

Should Not be Dismissed Due to Improper Ex Parte Contacts Concerning an Adjudicatory Proceeding, (B) Full Disclosure by Petitioners, Governor Bush, USPTO Director James E. Rogan and Deputy Director Jon Dudas of the Extent and Nature of All Such Ex Parte Communications Related to This Proceeding, and (C) Suspension of This Proceeding Pending Resolution of the Foregoing" (filed September 10, 2002).

This case now comes up on the following motions:

1. Petitioners' motion (filed March 15, 2002) for summary judgment;
2. HCH's motion (filed February 19, 2003) for reconsideration of the Board's denial of HCH's "Motion Pursuant to the Government in the Sunshine Act ..."; and
3. Cubaexport's motion (filed April 25, 2003) "For an Order (1) Dismissing Bacardi's Amended Petition to Cancel; (2) In the Alternative, Directing Bacardi To Show Cause Why Its Amended Petition Should Not Be Dismissed and Compelling Disclosure of All Ex Parte Communications; and (3) Suspending All Proceedings Pending Resolution of This Dispositive Motion."

Respondents have opposed petitioners' motion and petitioners have opposed the motions filed by HCH and Cubaexport. We have exercised our discretion and considered all reply briefs filed by the parties. See Trademark Rule 2.127(a) and TBMP § 502.02(b) (2d ed. 2003) and authorities cited therein.

As requested by HCH and Cubaexport in their respective motions, we first turn to their motions before considering petitioners' motion for summary judgment.

Cancellation No. 92024108

from the date of issuance until now is null and void as to matters under the jurisdiction of the Office of Foreign Assets Control.¹⁹

Litigation Between the Parties.

Beginning in 1995, petitioner Galleon S.A. ("Galleon") produced rum in the Bahamas bearing the HAVANA CLUB name, and distributed sixteen cases of this rum in the United States. From May 1996 to August 1996, petitioners distributed an additional 906 cases of Galleon's HAVANA CLUB rum in the United States.

In December 1996, HCH and HCI filed a civil action to enjoin Galleon, Bacardi-Martini USA, Inc. and three other entities (collectively "Bacardi") from using the HAVANA CLUB trademark, alleging violations of sections 32 and 43(a) of the Trademark Act. One of Bacardi's defenses was that OFAC's specific license to HCH, authorizing the assignments of the U.S. trademark, was invalid because HCH obtained the mark by fraud. In March 1997, the District Court ruled that

¹⁹ OFAC did not provide the reasons for the revocation of the license. However, the District Court, in its opinion, stated as follows:

[T]he "facts and circumstances" which later came to the attention of OFAC apparently concerned the incorporation of Pernod into the ownership of HC Holding and HCI. Plaintiffs' October 19, 1995 application, filed by Plaintiffs' counsel, stated that "each of the assignors and assignees are nationals of Cuba." Plaintiffs' own papers indicate that Pernod, one of the parties involved in the reorganization, is not a national of Cuba.

Havana Club Holding, S.A. v. Galleon, S.A., 974 F.Supp 302, n. 7 (S.D.N.Y. 1997) ("*Havana Club II*").

Cancellation No. 92024108

U.S. Department of Commerce, do not have the authority to answer this question. Thus, petitioners have not stated a claim of misrepresentation as to source upon which we may grant relief and the claim is dismissed.

4. Summary

HCH's motion for reconsideration is denied; Cubaexport's motion is denied; and petitioners' motion for summary judgment is denied. In view thereof, HCH's motion for summary judgment; petitioners' motion to extend the time to respond to the motion for summary judgment; and petitioners' motion under Fed. R. Civ. P. 56(f), which have been pending for some time, are denied as moot. Also, we have found that none of the allegations of the supplemental and amended petition to cancel state a claim for cancellation. Therefore, the supplemental and amended petition to cancel is DISMISSED.

EXHIBIT 5

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

-----)	
CORPORACION HABANOS, S.A.,)	
)	
Opposer,)	
)	Opposition No. 91165519
v.)	
)	
ANNCAS, INC.,)	
)	
Applicant.)	
-----)	

**APPLICANT'S RESPONSES TO OPPOSERS' SECOND SET OF
INTERROGATORIES AND REQUESTS FOR PRODUCTION**

Anncas, Inc. (hereinafter Applicant), by and through its attorneys Sanchelima & Associates, P.A., hereby submits its responses to Opposer's Second Set of Interrogatories and Requests for Production to Applicant. Applicant has answered the following interrogatories separately and fully in writing under oath.

Now follows Applicant's responses to Opposers' second set of interrogatories.

INTERROGATORIES

INTERROGATORY NO. 1

If Applicant, or any person acting for or on behalf of Applicant, has consulted with or retained the services of any expert or consultant with respect to any matter concerning this proceeding, identify each such expert or consultant and describe the subject matter on which he or she has been or is being consulted or retained; provide the financial terms of such consultation or retention; state in detail the substance of the expert's or consultant's information or opinions upon which Applicant intends to or may rely, and the reasons and evidentiary support therefore; and identify all documents provided to such expert or consultant, and all documents upon which such expert or consultant intends to or may rely.

No such expert or consultant to identify.

INTERROGATORY NO. 2

State the date of creation of the document previously produced by Applicant in the above-captioned matter and identified by Applicant as 000001, and the information supporting such statement.

The date of creation of the document identified as Bates No. 000001 was at some time prior to the filing date of February 5, 2004 for the application Serial No. 78/363,024

Now follows Applicant's responses to Opposer's second set of requests for production.

REQUESTS FOR PRODUCTION OF DOCUMENTS

REQUEST NO. 1

All documents concerning Applicant's assertion in its First Set of Admissions, Request No. 12, "that the U.S. cigar-consuming public is exposed to scores of cigar brands bearing the terms 'Havana,' 'Cuba,' or variations thereof, for cigars not directly originating in Cuba."

See document Bates Nos. 45 through 47, 52, 62, 69, 83, 85, 87 through 90, 92 through 97, 100 through 102, 104 through 105, 107 through 112, 115 through 120, 123, 129, 160, through 161, 165, 167 through 170, 174, 176, 178 through 181, 184, 192 through 195, 199, 204 through 206, 213, 215,

REQUEST NO. 2

For each cigar brand identified in any documents produced in response to Request No. 1, supra, all documents concerning whether the brand is currently in use in commerce, the years the brand has been in use in commerce, and the quantity of cigars, by volume and dollar amount, sold in the United States under such brand or mark.

Applicant does not have these documents at this time.

REQUEST NO. 3

For each cigar brand identified in any documents produced in response to Request No. 1, supra, all documents concerning advertising, marketing or promotion of such brands.

Applicant objects to this Request to the extent it calls for publicly available documents.

Subject to and without waiving Applicant's general and specific objections, see documents Bates Nos. 85, 87-90, 92, 97, 100, 102, 104 through 105, 107, 110 through 111, 115 through 123, 129, 146, 158, 160 through 161, 165, 169, 174 through 176, 178 through 180, 184, 192 through 193, 199, 203 through 205, 213.

REQUEST NO. 4

All documents concerning the sworn testimony of Applicant's President, William Bock, that there are "hundreds" of cigar brands "marketed in the United States today" that use the term "Havana" as the name or part of the name of the cigar brand or mark, as stated in Mr. Bock's deposition, p. 123, ll. 5-8, of March 24, 2006.

Applicant understands this request to seek the same documents described in Request No. 1 and accordingly, as its response, incorporates its response thereto.

REQUEST NO. 5

All documents using the term "Havana" or "Havanas" to refer to a cigar or cigars that are not from Cuba, other than as used as a cigar brand or cigar mark, upon which Applicant intends to rely in this proceeding.

See document Bates No. 197, 198, 202

REQUEST NO. 6

All documents, including computer files, or other electronic information, concerning the date of creation of the document previously produced by Applicant in the above captioned matter and identified by Applicant as 000001.

See document Bates No. 222

REQUEST NO. 7

All documents concerning Applicant's assertion in its First Set of Admissions, Request No. 13, that "U.S. regulations ... require all cigar products sold in the U.S. to clearly identify the country of origin upon the product packaging."

Applicant objects to this Request to the extent it calls for publicly available documents, including documents on file with the U.S. Customs and Border Protection and the Bureau of Alcohol, Tobacco, and Firearms.

Subject to and without waiving Applicant's general and specific objections, Applicant will produce documents, if any, responsive to this request.

REQUEST NO. 8

All documents concerning Applicant's sworn statement of January 28, 2004, to the United States Patent and Trademark Office ("USPTO"), that Applicant "has a bona fide intention to use or use through the applicant's related company or licensee the mark [HAVANA CLUB] in commerce on or in connection with the identified goods and/or services," as stated in the document previously produced by Applicant in the above-captioned matter and identified by Applicant as 000002.

See document Bates Nos. 1 and 222.

REQUEST NO. 9

All documents upon which Applicant intends to rely in this proceeding concerning the sworn testimony of Applicant's President, William Bock, that Havana, Cuba is not renown for production of cigars, as stated in Mr. Bock's deposition, p. 71 l.11-p.74 l.12, of March 24, 2006.

See document Bates Nos. 187 through 191, 196.

REQUEST NO. 10

All documents, including in magazines, trade publications, or internet printouts, showing Opposer's registered mark, HABANOS UNICOS DESDE 1492, USPTO Reg. No. 2,177,837, including in its English translation (HABANOS Unique Since 1492), or in translation in any other language.

See documents Bates Nos. 177, 183, 209

REQUEST NO. 11

All documents provided to any expert or consultant identified in response to Interrogatory No. 1, supra, by Applicant, Applicant's attorneys, or any one acting on behalf of Applicant, all documents upon which such expert or consultant intends to or may rely in this proceeding, all documents concerning the retention of such expert or consultant, and all documents provided by such expert or consultant to Applicant, Applicant's attorneys, or any one acting on behalf of Applicant.

Applicant does not have these documents at this time.

Dated: Miami, Florida
May 16, 2006

Respectfully submitted,

SANCHELIMA & ASSOCIATES, P.A.
Attorneys for Applicant
235 S.W. Le Jeune Road
Miami, FL 33134-1762
Telephone: (305) 447-1617
Telecopier: (305) 445-8484

By: 
Henry Rodríguez, Esq.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true correct copy of the foregoing was served via email and U.S. First Class Mail, this 16th of May, 2006, to David B. Goldstein and Michael Krinsky, Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., Attorney for Opposer, 111 Broadway, Eleventh Floor, New York, New York 10006-1901.

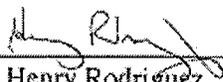
BY: 
Henry Rodriguez

EXHIBIT 6

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-09-21 17:09:05 ET

Serial Number: 75277473 Assignment Information

Registration Number: 2322113

Mark (words only): HAVANA FLORIDA CIGARS

Standard Character claim: No

Current Status: Registered.

Date of Status: 2000-02-22

Filing Date: 1997-04-18

Transformed into a National Application: No

Registration Date: 2000-02-22

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2006-05-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Havana Florida Cigar Company

Address:

Havana Florida Cigar Company
780 NW 42nd Avenue, Suite 324
Miami, FL 33126
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

GOODS AND/OR SERVICES

International Class: 034

Class Status: Active

cigars made from tobacco grown from Cuban tobacco seed

Basis: 1(a)

First Use Date: 1997-05-00

First Use in Commerce Date: 1997-05-00

ADDITIONAL INFORMATION

Disclaimer: "CIGARS"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-05-19 - Case File In TICRS

2000-02-22 - Registered - Principal Register

1999-12-13 - Allowed for Registration - Principal Register (SOU accepted)

1999-11-24 - Communication received from applicant

1999-06-10 - Non-final action mailed

1999-06-02 - Statement of use processing complete

1999-05-04 - Amendment to Use filed

1999-02-02 - Notice of allowance - mailed

1998-09-22 - Published for opposition

1998-08-21 - Notice of publication

1998-07-09 - Approved for Pub - Principal Register (Initial exam)

1998-06-08 - Communication received from applicant

1997-12-04 - Non-final action mailed

1997-12-04 - Assigned To Examiner

1997-11-13 - Assigned To Examiner

1997-11-07 - Assigned To Examiner

CORRESPONDENCE INFORMATION

Correspondent

LUIS A URIARTE (Attorney of record)

LUIS A URIARTE
CORPORATE CREATIONS INTERNATIONAL INC
941 4TH ST 2ND FL
MIAMI BEACH FL 33139-6629

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-09-21 17:09:38 ET

Serial Number: 75203904 Assignment Information

Registration Number: 2301203

Mark



(words only): HAVANA REPUBLIC PURVEYORS OF PREMIUM CIGARS 1834

Standard Character claim: No

Current Status: Registered.

Date of Status: 1999-12-21

Filing Date: 1996-11-25

Transformed into a National Application: No

Registration Date: 1999-12-21

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2006-06-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Havana Republic, Inc., The

Address:

Havana Republic, Inc., The
2101 Northeast 212th Street

Miami, FL 33179
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Colorado

GOODS AND/OR SERVICES

International Class: 034
Class Status: Active
tobacco products and smokers' articles, namely, cigars made from Havana seed tobacco, cigar cases, cigar cutters, cigar lighters not of precious metals, and matches
Basis: 1(a)
First Use Date: 1996-12-00
First Use in Commerce Date: 1996-12-00

ADDITIONAL INFORMATION

Disclaimer: "1834" and "PURVEYORS OF PREMIUM CIGARS" and "HAVANA"

Design Search Code(s):

03.01.02 - Lions (heraldic)
03.01.16 - Heads of cats, dogs, wolves, foxes, bears
05.15.02 - Laurel leaves or branches (borders or frames); Wreaths
26.11.27 - Oblongs
26.17.09 - Bands, curved; Bars, curved; Curved line(s), band(s) or bar(s); Lines, curved

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-06-01 - Case File In TICRS
1999-12-21 - Registered - Principal Register
1998-06-01 - Extension Of Time To Oppose Received
1998-05-05 - Published for opposition
1998-04-03 - Notice of publication
1998-03-03 - Approved for Pub - Principal Register (Initial exam)
1998-02-27 - Examiner's amendment mailed
1998-02-26 - Amendment to Use approved

1997-12-19 - Communication received from applicant

1997-06-26 - Non-final action mailed

1997-06-20 - Assigned To Examiner

1997-06-19 - Assigned To Examiner

1997-06-16 - Assigned To Examiner

CORRESPONDENCE INFORMATION

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MIAMI FL 33131

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-09-21 17:10:07 ET

Serial Number: 75327284 Assignment Information

Registration Number: 2380225

Mark (words only): HAVANA RESERVE DON LINO

Standard Character claim: No

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2006-08-11

Filing Date: 1997-07-19

Transformed into a National Application: No

Registration Date: 2000-08-29

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-08-11

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Miami Cigar & Co.

Address:

Miami Cigar & Co.
2533 NW 74 Ave.
Miami, FL 33122
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

GOODS AND/OR SERVICES

International Class: 034

Class Status: Active

Tobacco products, namely, cigars made from Cuban seed Tobacco

Basis: 1(a)

First Use Date: 1991-07-14

First Use in Commerce Date: 1991-07-14

ADDITIONAL INFORMATION

Disclaimer: "HAVANA"

Name Portrait Consent: Applicant's knowledge it does not refer to a living individual.

Translation: The word "DON" is a salutation term such as "Mr." and the Spanish word "LINO" translates to "linen" in the English Language.

Prior Registration Number(s):

1939998

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-08-11 - Section 8 (6-year) accepted & Section 15 acknowledged

2006-08-11 - Assigned To Paralegal

2006-05-10 - Section 8 (6-year) and Section 15 Filed

2006-05-10 - TEAS Section 8 & 15 Received

2006-02-17 - Case File In TICRS

2006-02-17 - Case File In TICRS

2000-08-29 - Registered - Principal Register

2000-06-06 - Published for opposition

2000-05-05 - Notice of publication

2000-03-23 - Approved for Pub - Principal Register (Initial exam)

2000-03-17 - Examiner's amendment mailed

1998-10-06 - Letter of suspension mailed

1998-09-04 - Communication received from applicant

1998-03-09 - Non-final action mailed

1998-03-04 - Assigned To Examiner

1998-02-24 - Assigned To Examiner

1998-02-20 - Assigned To Examiner

CORRESPONDENCE INFORMATION

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235 SW LE JEUNE RD
MIAMI FL 33134

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-09-21 17:10:31 ET

Serial Number: 74482332 Assignment Information

Registration Number: 1986031

Mark (words only): HAVANA PRIDE

Standard Character claim: No

Current Status: A Section 8 affidavit has been accepted.

Date of Status: 2003-03-27

Filing Date: 1994-01-21

Transformed into a National Application: No

Registration Date: 1996-07-09

Register: Principal

Law Office Assigned: LAW OFFICE 107

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2003-04-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Consolidated Cigar Corporation

Address:

Consolidated Cigar Corporation
5900 North Andrews Avenue
Fort Lauderdale, FL 333097098
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 034

Class Status: Active

cigars, little cigars, roll-your-own cigarette tobacco, pipe tobacco, smokeless tobacco grown from Cuban tobacco seeds from the Havana area

Basis: 1(a)

First Use Date: 1995-12-21

First Use in Commerce Date: 1995-12-21

ADDITIONAL INFORMATION

Disclaimer: "HAVANA"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

- 2003-03-27 - Section 8 (6-year) accepted
- 2003-01-09 - Section 8 (6-year) filed
- 2003-01-09 - PAPER RECEIVED
- 2002-04-12 - TEAS Change Of Correspondence Received
- 1996-07-09 - Registered - Principal Register
- 1996-05-13 - Allowed for Registration - Principal Register (SOU accepted)
- 1996-05-01 - Statement of use processing complete
- 1996-01-04 - Amendment to Use filed
- 1995-08-01 - Notice of allowance - mailed
- 1995-05-09 - Published for opposition
- 1995-04-07 - Notice of publication
- 1994-12-14 - Approved for Pub - Principal Register (Initial exam)
- 1994-12-12 - Examiner's amendment mailed
- 1994-12-12 - Assigned To Examiner
- 1994-12-08 - Previous allowance count withdrawn
- 1994-11-30 - Approved for Pub - Principal Register (Initial exam)
- 1994-10-24 - Communication received from applicant

1994-08-01 - Non-final action mailed

1994-07-14 - Assigned To Examiner

1994-06-30 - Assigned To Examiner

CORRESPONDENCE INFORMATION

Correspondent

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CHARLES W. GRIMES
GRIMES & BATTERSBY, LLP
488 Main Avenue 3rd Floor
Norwalk CT 06851-1008

Phone Number: 203-849-8300

Fax Number: 203-849-9300

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-09-21 17:10:56 ET

Serial Number: 74387107 Assignment Information

Registration Number: 1981346

Mark (words only): PRIDE OF HAVANA

Standard Character claim: No

Current Status: A Section 8 affidavit has been accepted.

Date of Status: 2003-02-28

Filing Date: 1993-05-03

Transformed into a National Application: No

Registration Date: 1996-06-18

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2003-03-04

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MAX ROHR, INC.

Address:

MAX ROHR, INC.
300 DELAWARE AVENUE
WILMINGTON, DE 19801
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 034

Class Status: Active

cigars

Basis: 1(a)

First Use Date: 1995-12-21

First Use in Commerce Date: 1995-12-21

ADDITIONAL INFORMATION

Disclaimer: "HAVANA"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

- 2003-02-28 - Section 8 (6-year) accepted
- 2003-01-10 - Response received to Post Registration action - Sections 8
- 2003-01-10 - PAPER RECEIVED
- 2002-09-04 - Post Registration action mailed - Section 8
- 2002-06-20 - Section 8 (6-year) filed
- 2002-04-11 - TEAS Change Of Correspondence Received
- 1996-06-18 - Registered - Principal Register
- 1996-04-15 - Allowed for Registration - Principal Register (SOU accepted)
- 1996-04-09 - Examiners Amendment - Written
- 1996-03-28 - Non-final action mailed
- 1996-03-27 - Previous allowance count withdrawn
- 1996-03-24 - Allowed for Registration - Principal Register (SOU accepted)
- 1996-03-21 - Assigned To Examiner
- 1996-03-16 - Statement of use processing complete
- 1996-01-04 - Amendment to Use filed
- 1995-08-22 - Notice of allowance - mailed
- 1995-05-04 - Opposition terminated for Proceeding

1995-04-25 - Opposition dismissed for Proceeding
1994-04-07 - Opposition instituted for Proceeding
1993-11-19 - Extension Of Time To Oppose Received
1993-10-19 - Published for opposition
1993-09-17 - Notice of publication
1993-08-25 - Approved for Pub - Principal Register (Initial exam)
1993-08-23 - Examiner's amendment mailed
1993-08-17 - Assigned To Examiner

CORRESPONDENCE INFORMATION

Correspondent

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Norwalk CT 06851-1008

Phone Number: 203-849-8300

Fax Number: 203-849-9300

EXHIBIT 7

8/20/06 Miami Herald E1
2006 WLNR 14428543

Miami Herald (FL)
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August 20, 2006

Section: E

**BACARDI'S VICTORY IN THE HAVANA CLUB TRADEMARK FIGHT COULD SPELL TROUBLE FOR
MANY OTHER U.S. BUSINESSES**
INTRO Foreign Trade Council BY MATTHEW HAGGMAN mhaggman@MiamiHerald.com

In 1918 the Aunt Jemima trademark was registered in Cuba, and even after Fidel Castro seized power in 1959, a steady stream of U.S. companies from Ace Hardware to United Airlines has continued to register their trademarks in the island nation.

Despite the decades-long U.S. economic embargo that precludes most trade with Cuba, more than 400 U.S. companies have registered in excess of 5,000 trademarks -- everything from McDonald's Golden Arches to Nike's famed Swoosh and Pepsi. And until recently, Cuba had no problem registering and renewing trademarks in the United States.

Now some fear the recent U.S. refusal to renew the Havana Club rum trademark claimed by a Cuban joint venture and **Bacardi's** launch of Havana Club -- a brand it also claims -- has placed the delicate balance of respecting other nations' trademarks in jeopardy. The recent developments also raise the possibility of Cuban retaliation, experts say.

Bacardi's fight with Cubaexport, a Cuban company that partnered with French liquor giant Pernod Ricard in 1993 to sell the rum around the world, has been simmering in U.S. courts, Congress and in the World Trade Organization for a decade. But the United States' recent decision to invalidate Cubaexport's Havana Club trademark registration really fanned the flames.

"Our government has done a real injustice that will come back to bite a lot of other companies," said William A. Reinsch, president of the National Foreign Trade Council. The council, which is based in Washington, represents corporate members such as Microsoft, Wal-Mart, Caterpillar and General Motors.

BRAND PROTECTION

But Patricia Neal, a **Bacardi** spokeswoman, rejected the notion that the rum company's efforts endanger other companies' trademarks in Cuba.

"All companies would fight to protect their brand," she said.

On August 3 the U.S. Patent and Trademark Office said the Havana Club trademark

would be "canceled/expired" -- although Cubaexport had filed its renewal application correctly with a \$500 fee and on time.

The Patent Office refused to accept the renewal after J. Robert McBrien, the acting director of the Office of Foreign Assets Control, wrote the office had received guidance from the U.S. State Department "informing us that it would be inconsistent with U.S. policy."

That decision stems from a provision called Section 211 that was inserted in a 1998 budget bill. Sometimes called the "**Bacardi** Bill," Section 211 has been criticized as a measure solely aimed at benefiting the rum giant.

Now the recent Havana Club denial has raised concerns that Cuba could return the favor by canceling U.S. trademark registrations based on the communist nation's own "policy" considerations.

Cuba could, for instance, cancel the trademarks for Levi's jeans or Heinz ketchup and sell its version in island stores. Those products could filter into other markets, too, harming U.S. companies that have long sought to keep fakes off store shelves abroad, said the National Foreign Trade Council.

Such a scenario could force U.S. companies to spend millions defending trademarks in many different countries and make the Cuba market ever more difficult to enter if it ultimately transitions into a market economy. And some think that day may be sooner rather than later due to leader Fidel Castro's shaky health.

'Some day Cuba could say, 'The heck with it, we will not honor any of these [U.S.] registrations, because you guys are not honoring ours,' " said Jesus Sanchelima, a Miami lawyer who has represented U.S. companies in trademark cases in Cuba.

Cuba has threatened retaliation before.

In 2001, in a heated moment during Cuba's long-standing dispute with **Bacardi**, Castro said he had given instructions to the Cuban rum industry to begin producing **Bacardi**. And he threatened that other U.S. brand names could be in jeopardy. "Here we can produce Palmolive, any toothpaste."

There's no evidence that he made good on that threat but Cuba did briefly produce its own **Bacardi** rum after the revolution.

"This decision [on the Havana Club renewal] invites retaliation by Cuba," said Reinsch. "We have been assuming that they were waiting to see the outcome of this case before doing anything. Now that there is an outcome, they will probably come to a decision."

Neal dismissed that notion, saying, "It is an old story that has never been acted upon and is a red herring."

During the 1990s there was a flurry of U.S. trademark registrations in Cuba. Among them: Playboy, Bud, Huggies, The Home Depot, Pizza Hut, Kmart, McDonald's, Tommy Hilfiger, Old Spice, Hawaiian Tropic, Starbucks Coffee, Healthy Choice, Radisson and Visa, according to the U.S.-Cuba Trade and Economic Council.

U.S. companies often sent their own representatives to register trademarks during the 1980s. But in recent years, they have hired Cuban law firms to go to the Oficina Cubana de la Propiedad Industrial in Havana to register and defend any misuse of corporate emblems.

Some now fear the decision could set a precedent that other countries can use to cancel trademarks or play politics with intellectual property law. Arab countries, for instance, could cancel trademarks for companies friendly to Israel or Pakistan could do the same with marks owned by companies working in India, said Reinsch.

"Basically, [the United States] let politics trump trademark policy," he said. "They took care of one company at the expense of a lot of others."

WHO OWNS HAVANA CLUB?

Although **Bacardi**, which has its U.S. headquarters in Miami, has claimed some victories in the fight over Havana Club, who actually owns the brand still hasn't been decided in a U.S. court.

In 1959, when Castro took power, **Bacardi** and Havana Club were both top rums in Cuba and both were nationalized. While **Bacardi** continued its business abroad, the owners of Havana Club, the Arechabala family, didn't restart their operations after going into exile in Spain.

"They had no financial means to do so because all of their assets and rum-making facilities were confiscated in Cuba," **Bacardi's** Neal said.

Meanwhile, the Cuban government started making Havana Club and selling it in communist Eastern Europe and the Soviet Union.

In 1973 the Arechabala family allowed the U.S. trademark for Havana Club to lapse. Three years later, the Cuban government jumped in and registered the U.S. trademark for the famous rum brand.

Then in 1993, the Cubaexport/Pernod Ricard joint venture started marketing the rum around the world, excluding the United States. The joint venture now distributes Havana Club in around 80 countries.

As the joint venture's sales grew steadily, **Bacardi** launched its campaign to claim the Havana Club brand in the United States. Throughout the trademark battle **Bacardi** has enlisted political heavyweights such as former U.S. Sen. Connie Mack and Florida Gov. Jeb Bush to press its case.

In 1997 **Bacardi** paid the Arechabalas for the right to Havana Club. "We purchased it from the rightful owners," Neal said.

After **Bacardi** U.S.A. launched Havana Club in the South Florida market some two weeks ago, Pernod Ricard and Cubaexport filed a lawsuit in U.S. District Court in Delaware to keep **Bacardi** from selling the rum.

For the time being, there are two Havana Clubs -- one distilled in Puerto Rico by **Bacardi** and sold in the United States and another made in Cuba and distributed around the world.

Robert Orr, Pernod Ricard's U.S. spokesman, said the joint venture also intends to appeal the patent office decision, and he contends a trademark is not formally canceled until the appeals process runs its course.

Sanchelima, the Miami trademark lawyer, said he doesn't think any trademark retaliation on the part of Cuba is imminent.

But perhaps increasing the chances of such a move, say some lawyers, is the fact that Cuba lost another high-profile U.S. trademark case in February.

In that case Cubatabaco, a Cuban government-owned tobacco company, argued that even though it had not registered the trademark for Cohiba cigars in the United States, its name was sufficiently famous that New York-based General Cigar shouldn't be allowed to use it.

Yet the U.S. 2nd Circuit Court of Appeals rejected that argument, saying Cubatabaco couldn't acquire such publicity rights while the economic embargo was in effect.

Now there are two Cohiba cigars -- the version made in Cuba and another one rolled in the Dominican Republic and distributed by General Cigar.

The Cohiba and Havana Club decisions are "two big hits in rapid succession," said Miami attorney Jorge Espinosa. "Assuming [Cuba] refocuses from [Castro's] health issues, every one of these is something that adds possibility to retaliation."

----- INDEX REFERENCES -----

COMPANY: UAL CORP; VICTORY; HJ HEINZ CO; MCDONALDS CORP; NIKE INC; BACARDI CORP; UNITED AIR LINES INC; PERNOD RICARD

NEWS SUBJECT: (Patents & Trademarks (1PA79); World Trade (1W085); Major Corporations (1MA93); Joint Ventures (1J005); Intellectual Property (1IN75); Economics & Trade (1EC26); Corporate Groups & Ownership (1X009))

INDUSTRY: (Rum (1RU61); Agriculture, Food & Beverage Regulatory (1AG56); Spirits (1SP77); Transportation (1TR48); Beverages (1BE22); Food & Beverage Regulatory (1FO94); Airlines (1AI34); Alcoholic Beverages (1AL86); Resorts (1RE44); Food & Beverage Production (1FO79); Transportation Regulatory (1TR42); Passenger Transportation (1PA35); Air Transportation (1AI53); Agriculture, Food & Beverage (1AG53))

REGION: (North America (1NO39); Latin America (1LA15); Cuba (1CU43); Europe (1EU83); Eastern Europe (1EA48); Americas (1AM92); USA (1US73); Florida (1FL79); Caribbean (1CA06))

Language: EN

OTHER INDEXING: (Fidel Castro; William A. Reinsch; Patricia Neal; J. Robert McBrien; Tommy Hilfiger; Jeb Bush; Robert Orr; Jorge Espinosa) (BACARDI; BUD; CIRCUIT COURT OF APPEALS; COFFEE; COHIBA; CONGRESS; CUBA; ECONOMIC COUNCIL; GOLDEN ARCHES; HAVANA CLUB; HAVANA CLUBS; HEINZ; HOME DEPOT PIZZA HUT; HUGGIES; KMART; MICROSOFT WAL MART CATERPILLAR; NATIONAL FOREIGN TRADE COUNCIL; NIKE; OFFICE OF FOREIGN; OFICINA CUBANA; PATENT OFFICE; PERNOD RICARD; PLAYBOY; STATE DEPARTMENT; US CUBA TRADE; US DISTRICT COURT; US PATENT AND TRADEMARK OFFICE; UNITED AIRLINES; VICTORY) (Arab; Arechabala; Assuming; Bacardi; Basically; Castro; Cigar; Connie Mack; Cubaexport; Cubatabaco; Fidel Castro; Hawaiian Tropic; Healthy Choice; J. Robert McBrien; Jeb Bush; Jesus Sanchelima; Jorge Espinosa; Levi; MATTHEW HAGGMAN; McDonald's, Tommy Hilfiger; Neal; Patricia Neal; Pepsi; Propiedad Industrial; Reinsch; Robert Orr; Sanchelima; Visa; William A. Reinsch) (Cuba; Cuba; Cuba; United States; United States; Washington; Cuba; Cuba; Cuba; Cuba; Cuba; Cuba; Miami; Cuba; Cuba; Cuba; Cuba; Cuba; Havana; Israel; Pakistan; India; United States; Miami; Cuba; Spain; Cuba; Eastern Europe; Soviet Union; United States; United States; South Florida; Delaware; Puerto Rico; United States; Cuba; Miami; Cuba; Cuba; United States; New York; Cuba; Dominican Republic; Miami; Cuba; us; usa; na;

us.fl; us.fl.miami; cu; cub; do; dom; es; esp; il; in; ind; isr; pak; pk; pr; pri;
as; asp; ca; cam; eu; eur; md; mde; nam; us.dc; us.de; us.ny; us.pr; cu..havana;
us.dc.wshdc; us.ny.nyc)

KEYWORDS: (CT/ebf); (XC/Euronext); (XC/NASDAQ-NMS); (XC/NYSE); (XC/Stockholm);
(XC/Unknown); (NT/NEC); (XC/any.company); (XC/any); (SU/business)

TICKER SYMBOL: Unknown:AHW; Unknown:BCD; Euronext:12069; NASDAQ-NMS:MSFT; NYSE:WMT;
NYSE:GM; NYSE:HD; NYSE:MCD; NASDAQ-NMS:SBUX; Stockholm:SWMA

EDITION: F1BZ

Word Count: 1723
8/20/06 MIAMIHD E1