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Filing date: **02/11/2008**

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

| | |
|---------------------------|--|
| Proceeding | 91165519 |
| Party | Plaintiff Corporacion Habanos, S.A. |
| Correspondence Address | David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman 111 Broadway, 11th Floor New York, NY 10006-1901 UNITED STATES dgoldstein@rbskl.com, cobrien@rbskl.com |
| Submission | Motion to Strike |
| Filer's Name | David B. Goldstein |
| Filer's e-mail | dgoldstein@rbskl.com |
| Signature | /David B. Goldstein/ |
| Date | 02/11/2008 |
| Attachments | Opp.Mot.Strike HC.pdf (11 pages)(408619 bytes) |

**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’S MOTION TO STRIKE APPLICANT’S NOTICE OF RELIANCE AND
EXHIBITS LISTED THEREIN**

Pursuant to 37 C.F.R. § 2.127, and TBMP § 707.02(b)(1), Opposer Corporacion Habanos, S.A. (“Opposer”), through undersigned counsel, hereby files its within MOTION TO STRIKE APPLICANT’S NOTICE OF RELIANCE AND EXHIBITS LISTED THEREIN, for failure of Applicant to serve the exhibits listed in said Notice of Reliance, and for untimely filing of said exhibits, and states the following in support thereof:

1. Applicant has never served on Opposer the 61 exhibits listed in its Notice of Reliance, which were required to be served on Opposer no later than November 30, 2007. Further, Applicant filed said exhibits with the Board on December 11, 2007, eleven days after the close of Applicant’s testimony period. Applicant’s Notice of Reliance and Exhibits that are listed therein should be stricken for failure to serve the exhibits on Opposer and for late filing.

2. Applicant electronically filed with the Board its 13-page Notice of Reliance, *without* any of the 61 exhibits referenced therein, on November 30, 2007, the day Applicant’s testimony period closed. (Docket No. 43). In its filing, Applicant claimed in its certificate of service that on November 26, 2007, “the foregoing Applicant’s Notice of Reliance” was “served

by electronic mail and first class mail” on counsel for Opposer. The certificate of service made no claim that the exhibits listed in the Notice of Reliance were served on Opposer.

3. According to the TTAB docket sheet and on page 1 of the filed document itself, the 61 exhibits listed in the Notice of Reliance were separately filed, apparently by mail, on December 11, 2008, eleven (11) days after the close of Applicant’s testimony period. (Docket No. 45). *See* Exhibit A annexed hereto (TTABVUE Docket Sheet, and first and last page of Docket No. 45).

4. Opposer received a copy of the 13-page Notice of Reliance by U.S. mail, *without* any of the 61 exhibits listed therein, but has never received from Applicant the Notice of Reliance exhibits themselves.

5. Parenthetically, neither the Notice of Reliance nor the listed exhibits were received by email by Opposer’s counsel. The certificate of service did not include counsel’s email address. In any event, in Fall 2007, Opposer had proposed to Applicant’s counsel that the parties agree to email service for future filings, as permitted by the TTAB’s recent Rule amendments, *see* 37 C.F.R. § 2.119(b)(6), but Applicant’s counsel rejected that request, so that email would not constitute service, even if the documents had been emailed.

6. Opposer ultimately obtained the 61 exhibits (approximately 180 pages) from the Board’s TTABVUE database after December 11, 2007, printing them out at its own expense, while checking that database for the exhibits referenced in the Notice of Reliance, but never served upon Opposer.

7. C.F.R. § 2.119(a) provides: “Every paper filed in the [USPTO] in inter partes cases ... must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office.” Applicant has failed to comply with both quoted

sentences. *See also* TBMP § 113.01 (“Every document filed ... must be served by the filing party”).

8. Applicant *filed* the 61 exhibits, but it never served them on Opposer. There is no basis to interpret “every paper filed” or “every document filed” to mean anything other than that. Nor is there any basis to interpret “must” to mean “may, in the discretion of the filer.” The rule does not carve out an exception for exhibits to a Notice of Reliance that are filed with the Board. Indeed, such exhibits are often at the heart of a case, and can be, as in this case, extensive.

9. Nor do the Board’s rules provide that, when a party files documents, but fails to serve them, the other party is then obligated to search and to obtain papers filed on TTABVUE from that database.

10. Applicant has also not made proof of service of the exhibits. This absence of proof of service not only verifies that the exhibits were in fact not served, but separately precludes consideration of the exhibits, because “[p]roof of service must be made before the paper will be considered by the Office.” C.F.R. § 2.119(a). *See also* TBMP § 113.02.

11. As a separate ground to strike Applicant’s Notice of Reliance and exhibits, the notice was untimely filed on December 11, 2007, eleven days late.

12. 37 C.F.R. § 2.197(a)(1)(i)(A) provides in pertinent part:

(a) ... correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in §2.190 and deposited with the U.S. Postal Service with sufficient postage as first class mail;

37 C.F.R. § 2.190(a) provides in pertinent part: “All trademark-related documents filed on paper ... should be addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.”

13. According to the documents on file on the TTABVUE database, Docket No. 45, it would appear that the 61 exhibits were improperly mailed, and thus were not filed in compliance with 37 C.F.R. §§ 2.190(a), 2.197(a)(1)(i)(A). *See* Exhibit A hereto. Thus, the date of filing of the exhibits is “[t]he actual date of receipt,” December 11, 2007, eleven days after the close of Applicant’s testimony period.

14. Opposer notes that Applicant filed a motion to strike Opposer’s Supplemental Rebuttal Notice of Reliance (consisting of *one* exhibit) (Docket No. 50), claiming that Applicant had been unfairly prejudiced by the serving and filing of that single exhibit three days after the close of Opposer’s Rebuttal period, and 87 days before Applicant’s brief on the merits is due. By contrast, Applicant *never* served its 61 exhibits on Opposer, and filed them 11 days late, reducing Opposer’s time to prepare its rebuttal from 45 to 34 days (which included the Christmas-New Year holiday period). Plainly, if Applicant was prejudiced by the one exhibit served and filed three days late, Opposer is far more severely prejudiced by Applicant’s acts and omissions with respect to 61 exhibits.

15. Opposer anticipates that Applicant may try to excuse its acts and omissions by claiming that the 61 un-served and late filed exhibits are similar to or the same as many of the 70 exhibits attached to the trial testimony of Applicant’s principal, William Bock. Even if that is the case, that does not relieve Applicant of its service and filing obligations. Further, a party should not be left to guess whether its adversary has filed (well out of time, no less) similar, the same or different documents than those proffered with trial testimony, particularly when there

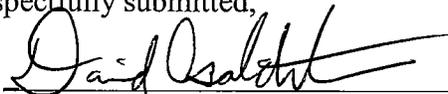
are 70 of one and 61 of another. Moreover, Applicant did not make the claim to Opposer at the time it filed the exhibits that these documents were similar to others previously filed, nor did it request that Opposer waive the service and timely filing requirements. It is not for a party unilaterally to decide whether or not to serve purported evidence filed during or after its testimony period, on the ground that Opposer has seen the same or similar evidence in connection with other proceedings in the matter.

16. At the time Opposer files its brief on the merits, Opposer intends to object to the admissibility of each of the 61 exhibits (which consist solely of TESS printouts of non-party registrations or applications), on various evidentiary grounds, and whether proffered in connection with the Notice of Reliance or trial testimony, in addition to the procedural grounds stated herein, and reserves all rights to make such objections at that time. *See* TBMP §§ 707.01-.03.

WHEREFORE, Opposer requests that its Motion to Strike Applicant's Notice of Reliance and Exhibits Listed Therein be granted.

Dated: New York, New York
February 11, 2008

Respectfully submitted,



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Attorneys for Opposer Corporation Habanos, S.A.

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of Opposer Corporacion Habanos, S.A.'s MOTION TO STRIKE APPLICANT'S NOTICE OF RELIANCE AND EXHIBITS LISTED THEREIN was emailed to, and served upon, Applicant by mailing, postage prepaid, first class United States mail, on February 11, 2008 to:

Jesus Sanchelima, Esq.
SANCHELIMA & ASSOCIATES, P.A.
235 S.W. Le Jeune Road
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Counsel for Applicant Anncas, Inc.



DAVID B. GOLDSTEIN

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

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

**EXHIBIT A TO OPPOSER'S MOTION TO STRIKE APPLICANT'S NOTICE OF
RELIANCE AND EXHIBITS LISTED THEREIN**



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TTABVUE. Trademark Trial and Appeal Board Inquiry System

v1.4

Opposition

Number: 91165519**Filing Date:** 06/10/2005**Status:** Pending**Status Date:** 06/14/2005**Interlocutory Attorney:** LINDA M SKORO**Defendant****Name:** Anncas, Inc.**Correspondence:** JESUS SANCHELIMA, ESQ.
SANCHELIMA & ASSOCIATES, P.A.
235 S.W. LE JEUNE ROAD
MIAMI, FL 33134-1762**Serial #:** 78363024[Application File](#)**Application Status:** Opposition Pending**Mark:** HAVANA CLUB**Plaintiff****Name:** Corporacion Habanos, S.A.**Correspondence:** David B. Goldstein
Rabinowitz, Boudin, Standard, Krinsky & Lieberman
111 Broadway, 11th Floor
New York, NY 10006-1901
dgoldstein@rbskl.com, cobrien@rbskl.com**Granted To Date:** 06/12/2005**Prosecution History**

| # | Date | History Text | Due Date |
|----|------------|--|----------|
| 53 | 02/08/2008 | <u>P'S OPPOSITION/RESPONSE TO MOTION</u> | |
| 52 | 12/13/2007 | <u>DUPLICATE OF ENTRY NO. 49 (DEFENDANT'S NOTICE OF TAKING TESTIMONY PART 2 OF 2)</u> | |
| 51 | 12/13/2007 | <u>DUPLICATE OF ENTRY NO. 48 (DEFENDANT'S NOTICE OF TAKING TESTIMONY PART 1 OF 2)</u> | |
| 50 | 01/25/2008 | <u>D'S MOTION TO STRIKE</u> | |
| 49 | 12/13/2007 | <u>DEFENDANT'S NOTICE OF TAKING TESTIMONY PART 2 OF 2</u> | |
| 48 | 12/13/2007 | <u>DEFENDANT'S NOTICE OF TAKING TESTIMONY PART 1 OF 2</u> | |
| 47 | 01/17/2008 | <u>PLAINTIFF'S NOTICE OF RELIANCE</u> | |
| 46 | 01/14/2008 | <u>PLAINTIFF'S NOTICE OF RELIANCE</u> | |
| 45 | 12/11/2007 | <u>DEFENDANT'S NOTICE OF RELIANCE</u> | |
| 44 | 11/26/2007 | <u>PL'S NOTICE OF FILING TESTIMONY</u> | |
| 43 | 11/30/2007 | <u>DEFENDANT'S NOTICE OF RELIANCE</u> | |
| 42 | 11/20/2007 | <u>P's NOTICE OF TRIAL TESTIMONY</u> | |
| 41 | 10/17/2007 | <u>P's Consel Notice of Unavailability</u> | |
| 40 | 10/01/2007 | <u>PLAINTIFF'S NOTICE OF RELIANCE</u> | |
| 39 | 09/28/2007 | <u>TESTIMONY FOR PLAINTIFF</u> | |
| 38 | 08/31/2007 | <u>EXTENSION OF TIME GRANTED</u> | |

37 05/29/2007 PL'S NOTICE OF COMPLETION OF DEPOSITION
36 04/10/2007 STIPULATION FOR AN EXTENSION OF TIME
35 04/02/2007 PLAINTIFF'S NOTICE OF TAKING TESTIMONY
34 03/30/2007 EXTENSION OF TIME GRANTED
33 02/06/2007 PLAINTIFF'S NOTICE OF TAKING TESTIMONY
32 01/09/2007 STIPULATION FOR AN EXTENSION OF TIME
31 11/29/2006 MOT. FOR SUMMARY JUDGMENT GRANTED
30 10/12/2006 P'S REPLY IN SUPPORT OF MOTION
29 10/11/2006 P's REPLY to EXCEED PAGE LIMIT
28 09/27/2006 D's OPPOSITION TO P's Request to EXCEED PG LIMIT
27 09/27/2006 D's OPPOSITION to P's MSJ
26 09/22/2006 P's OPPOSITION TO D's MSJ
25 09/22/2006 P's MOTION to EXCEED PAGE LIMIT on MSJ Brief
24 09/05/2006 STIPULATION FOR AN EXTENSION OF TIME
23 08/21/2006 Executed copy of P's Morejon Declaration
22 08/07/2006 OPPOERS' MOT FOR S.J. PT. 4 OF 4
21 08/04/2006 OPPOERS' MOT FOR S.J. PT. 3 OF 4
20 08/04/2006 OPPOERS' MOT FOR S.J. PT. 2 OF 4
19 08/04/2006 OPPOERS' MOT FOR S.J. PT. 1 OF 4
18 08/07/2006 APPLICANT'S MSJ - Part 2 of 2
17 08/07/2006 APPLICANTS MOT FOR SUMMARY JUDGMNET
16 07/12/2006 STIPULATION FOR AN EXTENSION OF TIME
15 06/02/2006 STIPULATION FOR AN EXTENSION OF TIME
14 05/11/2006 STIPULATED PROTECTIVE ORDER
13 05/10/2006 STIP TO WITHDRAW MOTIONS
12 04/21/2006 D'S MOTION TO QUASH
11 04/14/2006 P'S MOTION FOR AN EXTENSION OF TIME
10 11/01/2005 PL'S/CC DEF'S PROOF OF SERVICE FOR ANSWER TO COUNTERCLAIM
9 10/31/2005 ANSWER TO COUNTERCLAIM
8 10/18/2005 NOTICE SENT; ANSWER DUE (DUE DATE) 11/27/2005
7 09/29/2005 CHANGE OF CORRESPONDENCE ADDRESS
6 08/03/2005 ANSWER AND COUNTERCLAIM (FEE)
5 07/26/2005 EXTENSION OF TIME GRANTED; ANSWER DUE 8/3/05
4 07/22/2005 D'S MOT FOR EXTEN. OF TIME W/ CONSENT
3 06/14/2005 PENDING, INSTITUTED
2 06/14/2005 NOTICE AND TRIAL DATES SENT; ANSWER DUE: 07/24/2005
1 06/10/2005 FILED AND FEE

Results as of 02/11/2008 03:42 PM

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

CORPORACION HABANOS, S.A.,)
)
)
) **Opposer,**)
)
)
) **v.**)
)
) ANNCAS, INC.,)
)
)
) **Applicant.**)

Opposition No. 91165519

78/363,024

APPLICANT'S NOTICE OF RELIANCE

Applicant intends to rely on the attached public records pursuant to Trademark Rule of Practice 2.122(e) and Rule 803(8) of The Federal Rules of Evidence:

1. USPTO (TESS) printout for Trademark "HABANA GOLD", Registration No. 2202978. This document is relevant to the subject controversy, in that, it demonstrates how the word "HABANA" and the descriptive phrase "Cigars produced from Cuban seed tobacco" for identification of the goods, have been widely accepted in the Patent and Trademark office with regards to the cigar industry/market.

2. USPTO (TESS) printout for Trademark "HABANA HABANA CUBA", Registration No. 2202488. This document is relevant to the subject controversy, in that, it demonstrates how the word "HABANA" for identification of the goods, has been widely accepted in the Patent and Trademark office with regards to the cigar industry/market.

3. USPTO (TESS) printout for Trademark "SAN CRISTOBAL DE LA HABANA", Serial No. 78538391. This document is relevant to the subject controversy, in that, it demonstrates how the word "HABANA" for identification of the goods, has been widely accepted in the Patent and Trademark office with regards to the cigar industry/market.



12-11-2007

Sanchelima & Associates, P.A.

ATTORNEYS AT LAW
PATENTS, TRADEMARKS & COPYRIGHTS

Pablo Perez
Paralegal

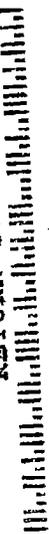
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TO:

COMM900* 222022004 1B06 16 12/05/07
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ALEXANDRIA VA 22314-5790

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*This was sent to previous address,
but notice was timely filed electronically*