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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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Date	10/31/2005
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD**

In the matter of trademark application
Serial No. 78/363024
Filed February 5, 2004
For the mark HAVANA CLUB
Published in the *Official Gazette* on December 14, 2004

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CORPORACION HABANOS, S.A.,)	
)	
Opposer,)	
)	
v.)	
)	
Anncas, Inc.,)	
)	
Applicant.)	
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Opposition No. 91165519

REPLY TO COUNTERCLAIM

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Now comes Opposer, Counter-Respondent CORPORACION HABANOS, S.A. (hereinafter "Habanos, S.A"), a Cuban corporation with its principal place of business at Avenida 3ra, No. 2006 Miramar, Havana, Cuba, by and through its undersigned attorney, and hereby Replies to the Counterclaim for Cancellation filed by Applicant ANNCAS, INC. (hereinafter "Anncas"), against U.S. Registration No. 2,177,837 for HABANOS UNICOS DESDE 1492 and DESIGN, owned by Habanos, S.A., as follows:

1. Habanos, S.A. denies the allegations contained in paragraph 1, except admits that Anncas filed a trademark application with the USPTO on or about February 5, 2004 for the mark HAVANA CLUB for cigars, in international class 034, which was assigned serial number 78/363024.

2. Habanos, S.A. admits the allegations in paragraph 2, except that the registered mark is HABANOS UNICOS DESDE 1492 and DESIGN.

3. Habanos, S.A. admits the allegations in paragraph 3, except denies that the Notice of Opposition was filed on June 14, 2005, which was in fact filed on June 10, 2005.

4. Habanos, S.A. denies the allegations in paragraph 4, except insofar as it is alleged that Habanos, S.A. does not make sales within the United States utilizing the trademark HABANOS UNICOS DESDE 1492 and DESIGN.

5. Habanos, S.A. denies the allegations in paragraph 5.

AFFIRMATIVE DEFENSES

1. Anncas has failed to state a claim upon which relief can be granted.

2. The counter-claim is frivolous, and Anncas has intentionally interposed the counterclaim for improper purposes, including to harass and burden Habanos, S.A.

3. The United States embargo of trade with Cuba, including the Cuban Assets Control Regulations, 31 C.F.R. Part 515 (“CACR”), excuses non-use of a mark in the United States, as this Board and the USPTO have repeatedly recognized.

4. Habanos, S.A. uses the mark throughout the world, except that it is prohibited by United States law from selling products that utilize the mark in the United States. Habanos, S.A. intends to use the mark, including through sales of products that utilize the mark, in the United States as soon as it is legally possible to do so.

5. It is the policy of the United States, as set out in the CACR, and otherwise, to permit Cuban nationals to register and to maintain trademarks in the USPTO in the absence of use in commerce, as well as to permit United States nationals to register and to maintain trademarks in Cuba in the absence of use in Cuba.

6. United States obligations under treaties and international agreements, including the Paris Convention for the Protection of Industrial Property, 21 U.S.T. 1583, the General Inter-American Convention for Trademark and Commercial Protection, 46 Stat. 2907, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), require United States recognition of rights of Cuban nationals to register and to maintain trademarks in the United States, notwithstanding the United States trade embargo of Cuba.

7. Under international principles of reciprocity, during the pendency of the United States embargo of Cuba, United States nationals are permitted to register and to maintain their marks in Cuba, which marks number in the thousands, and Cuban nationals have been permitted to register and to maintain their marks in the United States.

WHEREFORE, Opposer, Counter-Respondent Habanos, S.A. prays that the Counterclaim be dismissed with prejudice, that appropriate sanctions be imposed on Anncas for its frivolous and harassing Counterclaim, that registration of Application Serial No. 78/363024 be refused, and that the OPPOSITION be sustained in favor of Opposer Habanos, S.A.

Dated: October 31, 2005

Respectfully submitted,

By:

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Corporacion Habanos, S.A.*

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Reply to Counterclaim in Opposition No. 91165519 is being filed electronically on behalf of Corporacion Habanos, S.A., today, October 31, 2005 on the Electronic System for Trademark Trials and Appeals for the United States Patent and Trademark Office.

David B. Goldstein