

ESTTA Tracking number: **ESTTA171933**

Filing date: **10/31/2007**

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

Notice of Opposition

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

Opposer Information

Name	Cuban Cigar Brands, N.V.
Granted to Date of previous extension	10/31/2007
Address	5900 North Andrews Avenue Fort Lauderdale, FL 33309 UNITED STATES

Attorney information	Charles W. Grimes Grimes & Battersby, LLP 488 Main Avenue Norwalk, CT 06851 UNITED STATES schlesinger@gandb.com, grimes@gandb.com Phone:203-849-8300
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Applicant Information

Application No	79023900	Publication date	07/03/2007
Opposition Filing Date	10/31/2007	Opposition Period Ends	10/31/2007
International Registration No.	0597190	International Registration Date	02/10/1993
Applicant	MAGLIFICIO LILIANA DI; LORENZONI ANDREA E C. S.N.C. Via Madonnina, 18/24 I-25018 MONTICHIARI ITALY		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Brassieres, corsets, singlets, petticoats, nightgowns, pajamas, dressing gowns, pullovers, bath robes, bathing suits, bathing caps, gloves and muffs for wear, cardigans, jerseys, neckties, neckerchiefs, scarves, sweaters, socks, stockings, tights, trousers, leggings, skirts, jackets, jerkins, shirts, vests, waistcoats, jumpers, track suits, blouses, jeans, panties, pants, bermuda shorts, T-shirts, sweat-shirts, suits and dresses, overcoats, anoraks, coats, raincoats, babies' pants, dance clothing namely leotards, belts and sashes for wear, suspenders, boots, ski boots, snow board boots, shoes, sport shoes, slippers, hats, berets

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1435633	Application Date	05/24/1985
Registration Date	04/07/1987	Foreign Priority Date	NONE
Word Mark	MONTE CRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1960/10/01 First Use In Commerce: 1960/10/01 MEN'S CLOTHING, NAMELY, SUITS, TOPCOATS, OVERCOATS, SLACKS, AND SPORT JACKETS		

U.S. Registration No.	332324	Application Date	08/22/1935
Registration Date	02/11/1936	Foreign Priority Date	NONE
Word Mark	MONTE CRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U017 (International Class 034). First use: First Use: 1935/07/25 First Use In Commerce: 1935/07/25 CIGARS, CIGARETTES, AND CUT TOBACCO		

U.S. Registration No.	1173547	Application Date	02/27/1978
Registration Date	10/13/1981	Foreign Priority Date	NONE
Word Mark	MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1935/07/25 First Use In Commerce: 1935/07/25 Cigars		

U.S. Registration No.	2236889	Application Date	03/03/1992
Registration Date	04/06/1999	Foreign Priority Date	NONE
Word Mark	MONTE CRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1998/05/14 First Use In Commerce: 1998/05/14 Cologne, after-shave lotion Class 014. First use: First Use: 1998/05/14 First Use In Commerce: 1998/05/14 Cuff links Class 018. First use: First Use: 1998/05/14 First Use In Commerce: 1998/05/14 Wallets		

	Class 025. First use: First Use: 1998/02/18 First Use In Commerce: 1998/02/18 Bathrobes, scarves, headwear		
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U.S. Registration No.	2304416	Application Date	03/03/1992
Registration Date	12/28/1999	Foreign Priority Date	NONE
Word Mark	MONTE CRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1998/05/28 First Use In Commerce: 1998/05/28 desk sets; desk pads; pens; stands for pens and pencils Class 028. First use: First Use: 1998/05/28 First Use In Commerce: 1998/05/28 golf balls Class 034. First use: First Use: 1998/05/28 First Use In Commerce: 1998/05/28 cigar cases not of precious metal		

U.S. Registration No.	2396980	Application Date	12/10/1998
Registration Date	10/24/2000	Foreign Priority Date	NONE
Word Mark	MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 026. First use: First Use: 1998/02/00 First Use In Commerce: 1998/02/00 HAT ORNAMENTS NOT OF PRECIOUS METAL Class 034. First use: First Use: 1997/08/00 First Use In Commerce: 1997/08/00 ASHTRAYS NOT OF PRECIOUS METAL Class 036. First use: First Use: 1997/09/00 First Use In Commerce: 1997/09/00 CREDIT CARD SERVICES		

U.S. Registration No.	2623858	Application Date	03/05/2001
Registration Date	09/24/2002	Foreign Priority Date	NONE
Word Mark	MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2000/10/31 First Use In Commerce: 2000/10/31 cocktail lounge, bar and restaurant services; night clubs		

U.S. Registration No.	2594564	Application Date	04/14/1998
Registration Date	07/16/2002	Foreign Priority Date	NONE
Word Mark	MONTECRISTO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2002/02/01 First Use In Commerce: 2002/02/01 ALCOHOLIC BEVERAGES

U.S. Registration No.	2855557	Application Date	07/03/2002
Registration Date	06/22/2004	Foreign Priority Date	NONE
Word Mark	MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2002/01/00 First Use In Commerce: 2002/01/00 Ground and whole bean coffee		

U.S. Registration No.	2555239	Application Date	08/11/2000
Registration Date	04/02/2002	Foreign Priority Date	NONE
Word Mark	THE WORLD OF MONTECRISTO MONTE CRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1999/08/15 First Use In Commerce: 1999/08/15 Cigars, little cigars, pipe tobacco, roll-your-own cigarette tobacco and smokeless tobacco		

U.S. Registration No.	2673772	Application Date	08/11/2000
Registration Date	01/14/2003	Foreign Priority Date	NONE
Word Mark	WORLD OF MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1999/08/15 First Use In Commerce: 1999/08/15 Cigars, little cigars, pipe tobacco, roll-your-own cigarette tobacco and smokeless tobacco		

U.S. Registration No.	2872359	Application Date	11/26/2002
Registration Date	08/10/2004	Foreign Priority Date	NONE
Word Mark	MONTECRISTO CASINO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2003/05/13 First Use In Commerce: 2003/05/13		

	Cigars		
U.S. Application No.	78600270	Application Date	04/01/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CASA DE MONTECRISTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: Cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco		

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Signature	/cwg/
Name	Charles W. Grimes
Date	10/31/2007

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

In the Matter of Application Serial No. 79/023,900
Published in the *Official Gazette* on July 3, 2007

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Cuban Cigar Brands, N.V.,	:
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Opposer,	:
	:
v.	:
	:
Maglificio Liliana Di;	:
Lorenzoni Andrea E C. S.N.C.,	:
	:
Applicant.	:
-----X	

Opposition No.:

NOTICE OF OPPOSITION

Cuban Cigar Brands, N.V. (“Opposer” or “CCB”) believes that it will be damaged by registration of the mark shown in trademark application serial number 79/023,900 in International Class 34 and hereby opposes the same. The grounds for opposition are as follows:

COUNT I

1. Opposer is a corporation organized and existing under the laws of the Netherlands Antilles, having an office at 5900 North Andrews Avenue, Fort Lauderdale, Florida 33309.
2. Altadis U.S.A. Inc. (“Altadis U.S.A.”) is a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 5900 North Andrews Avenue, Fort Lauderdale, Florida 33309.
3. Opposer is a wholly-owned subsidiary of Altadis U.S.A. Opposer brings this Opposition on behalf of itself and Altadis U.S.A. (collectively, “Altadis”).

4. Opposer is the owner of the following valid and subsisting trademarks and U.S. federal trademark registrations:

(a) The MONTE CRISTO trademark and U.S. federal trademark registration number 1,435,633 for “men’s clothing, namely, suits, topcoats, overcoats, slacks, and sport jackets” in International Class 25;

(b) The MONTE CRISTO & Crossed-Sword Design trademark and U.S. federal trademark registration number 332,324 for “cigars, cigarettes and cut tobacco” in International Class 34;

(c) The MONTECRISTO trademark and U.S. federal trademark registration number 1,173,547 for “cigars” in International Class 34;

(d) The MONTE CRISTO trademark and U.S. federal trademark registration number 2,236,889 for “cologne, after shave lotion” in International Class 3, for “cuff links” in International Class 14, for “wallets” in International Class 18 and for “bathrobes, scarves, headwear” in International Class 25;

(e) The MONTE CRISTO trademark and U.S. federal trademark registration number 2,304,416 for “desk sets, desk pads, pens, stands for pens and pencils” in International Class 16, for “golf balls” in International Class 28 and for “cigar cases not of precious metal” in International Class 34;

(f) The MONTECRISTO trademark and U.S. federal trademark registration number 2,396,980 for “hat ornaments not of precious metal” in International Class 26, for “ashtrays not of precious metal” in International Class 34 and for “credit card services” in International Class 36;

(g) The MONTECRISTO trademark and U.S. federal trademark registration number 2,623,858 for “cocktail lounge, bar and restaurant services; night clubs” in International Class 42;

(h) The MONTECRISTO trademark and U.S. federal trademark registration number 2,594,564 for “alcoholic beverages” in International Class 33 on the Principal Register;

(i) The MONTECRISTO trademark and U.S. federal trademark registration number 2,855,557 for “ground and whole bean coffee” in International Class 30 on the Principal Register;

(j) The THE WORLD OF MONTECRISTO AND DESIGN trademark and U.S. federal trademark registration number 2,555,239 for “cigars, little cigars, pipe tobacco, roll-your-own cigarette tobacco and smokeless tobacco” in International Class 34;

(k) The WORLD OF MONTECRISTO trademark and U.S. federal trademark registration number 2,673,772 for “cigars, little cigars, pipe tobacco, roll-your-own cigarette tobacco and smokeless tobacco” in International Class 34;

(l) The MONTECRISTO CASINO trademark and U.S. federal trademark registration number 2,872,359 for “cigars” in International Class 34; and

(m) The CASA DE MONTECRISTO trademark and trademark application number 78/600,270 for “cigars, little cigars, roll-your-own tobacco, pipe tobacco and smokeless tobacco” for which a Notice of Allowance has issued. (These trademarks are hereinafter referred to collectively as the “MONTECRISTO Trademarks”).

5. The MONTECRISTO Trademarks were developed and first used by Opposer's predecessor, Menendez Garcia y Compania Limitada ("Menendez Garcia"), a Cuban limited liability company. Upon information and belief, Menendez Garcia commenced use of the MONTECRISTO Trademarks in the United States at least as early as July 25, 1935 in connection with premium cigars. From their inception, Menendez Garcia's MONTECRISTO cigars were considered among the finest premium cigars in the world.

6. Opposer is the successor-in-interest to Menendez Garcia, having purchased Menendez Garcia's U.S. rights in the MONTECRISTO Trademarks in 1976.

7. Upon information and belief, Opposer's predecessors-in-interest used the MONTECRISTO Trademarks in the U.S. continuously until some time after the Castro government nationalized the Cuban cigar industry in 1960, following the Cuban revolution. Upon information and belief, after an excusable period of non-use, Opposer reintroduced the MONTECRISTO brand after its predecessor Menendez Garcia successfully litigated with the Cuban government over the ownership of the U.S. rights in the marks.

8. The MONTE CRISTO trademark for clothing in International Class 25 has been in use in commerce since at least as early as October 1, 1960.

9. Use of the MONTECRISTO Trademarks and associated trademarks, trade names, trade dress, service marks and brand names is effected by Altadis and its licensees.

10. Since the inception of their use, the MONTECRISTO Trademarks have been used by Altadis and their predecessors-in-interest only in connection with the finest quality premium cigars and licensed merchandise. Altadis' MONTECRISTO cigars are considered to be among the finest premium cigars available in the United States and are sold throughout the United States. Altadis' MONTECRISTO cigars have been extensively advertised and are among the

most prestigious cigar brands available in the United States, are highly coveted by cigar aficionados and are used by the media as a symbol of luxury and excellence.

11. Opposer's MONTECRISTO Trademarks are used on its MONTECRISTO packaging, in advertisements, on the Internet and in other forums.

12. Opposer's MONTECRISTO Trademarks are inherently distinctive to the public and the trade and serve primarily as designators of origin of Opposer's products.

13. Altadis is actively engaged in the development of MONTECRISTO merchandise and in selective licensing of the MONTECRISTO Trademarks.

14. As a result of the widespread use and display of Opposer's MONTECRISTO brand cigars: (a) the public and the trade use the MONTECRISTO Trademarks to identify and refer to Opposer's MONTECRISTO brand; (b) cigars marked with the MONTECRISTO Trademarks are recognized by the trade and the public as high quality premium cigars emanating from a single source; and (c) the MONTECRISTO Trademarks have built up secondary meaning and extensive goodwill.

15. Through long-term use and controlled marketing, the MONTECRISTO Trademarks have become highly distinctive and strongly associated in the United States with cigars, tobacco products and other licensed merchandise of the highest quality emanating from a single source, namely, Opposer.

16. Altadis has adopted an aggressive, worldwide policy for maintaining the integrity, goodwill and fame associated with their MONTECRISTO Trademarks by eliminating potential third parties from usage of marks that trade off of their renowned MONTECRISTO Trademarks.

17. Upon information and belief, Maglificio Liliana Di; Lorenzoni Andrea E C. S.N.C. (“Applicant”) filed a trademark application, serial number 79/023,900 on a 66(a) basis, for MONTECHIARO and Design as a mark for “brassieres, corsets, singlets, petticoats, nightgowns, pajamas, dressing gowns, pullovers, bath robes, bathing suits, bathing caps, gloves and muffs for wear, cardigans, jerseys, neckties, neckerchiefs, scarves, sweaters, socks, stockings, tights, trousers, leggings, skirts, jackets, jerkins, shirts, vests, waistcoats, jumpers, track suits, blouses, jeans, panties, pants, bermuda shorts, T-shirts, sweat-shirts, suits and dresses, overcoats, anoraks, coats, raincoats, babies' pants, dance clothing namely leotards, belts and sashes for wear, suspenders, boots, ski boots, snow board boots, shoes, sport shoes, slippers, hats, berets” in International Class 25 (“Applicant’s Mark”).

18. Applicant’s Mark is confusingly similar in sound, appearance and commercial impression to Opposer’s registered and well-known MONTECRISTO Trademarks. Applicant’s Mark begins with the “MONTE” word portion which translates to “mountain.” Opposer’s MONTECRISTO Trademarks begin with the “MONTE” word portion which translates to “mountain.” Applicant’s “MONTE” word portion has the exact same sound and appearance as Opposer’s “MONTE” word portion. Further, both Applicant’s “MONTE” word portion and Opposer’s “MONTE” word portion have the same meaning. In addition, the “CHIARO” word portion of Applicant’s Mark and the “CRISTO” word portion of Opposer’s MONTECRISTO Trademarks both begin with the letter “c,” contain the letters “r” and “i,” and end with the letter “o.” Moreover, Applicant’s Mark includes a design element of a castle which is reminiscent of the imagery of Alexandre Dumas’ *The Count of Monte Cristo*. Accordingly, Applicant’s Mark creates an overall confusingly similar sound, appearance and commercial impression to Opposer’s MONTECRISTO Trademarks.

19. Applicant's goods are exactly the same as and/or are related to the goods sold and provided in connection with Opposer's MONTECRISTO Trademarks and/or represent a natural zone of expansion for Altadis. Applicant's goods would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of purchasers. Therefore, it is highly likely that distributors, retailers and consumers will assume that Applicant's MONTECHIARO goods are associated with Altadis' MONTECRISTO brand.

20. Applicant's use of MONTECHIARO as a mark is likely to cause confusion, mistake or deception as to the source of origin of Applicant's products in that the public, the trade and others are likely to believe that Applicant's products are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Altadis' MONTECRISTO brand.

COUNT II

21. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 20 as though fully set forth herein.

22. Opposer's MONTECRISTO Trademarks are distinctive and famous and had become famous prior to the acquisition of any rights Applicant may claim in using Applicant's Mark.

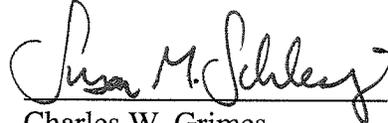
23. Use of the Applicant's Mark by Applicant will cause dilution of the distinctive quality of Opposer's famous MONTECRISTO Trademarks.

24. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the use of Applicant's Mark and thereby dilute Opposer's rights in its distinctive and famous MONTECRISTO Trademarks.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Applicant's application to register MONTECHIARO and Design as a mark be denied in all respects.

Dated: October 31, 2007

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Susan M. Schlesinger", written over a horizontal line.

Charles W. Grimes

Russell D. Dize

Susan M. Schlesinger

Attorneys for Opposer

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Attorney Docket No.: CB007USL139