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

GALLEON S.A., BACARDI-MARTINI U.S.A., INC., and BACARDI & COMPANY LIMITED, Petitioners, -against- HAVANA CLUB HOLDING, S.A., dba HCH, S.A., and EMPRESA CUBANA EXPORTADORA DE ALIMENTOS Y PRODUCTOS VARIOS, S.A., dba CUBAEXPORT, Respondents.	Cancellation No. 24,108

PETITIONERS' MEMORANDUM OF LAW IN OPPOSITION TO
RESPONDENT HAVANA CLUB HOLDING'S MOTION FOR RECONSIDERATION

I. INTRODUCTION

Petitioners ("Bacardi") hereby respond to the Motion of Respondent Havana Club Holding, S.A. ("HCH") for Reconsideration of the Board's Decision Dated January 21, 2003, denying HCH's motion under the Government in the Sunshine Act (the "Sunshine Act"). The instant motion merely rehashes the arguments made in HCH's original papers and improperly attempts to introduce new evidence in flagrant violation of TBMP §518. Accordingly, HCH's motion should be denied in its entirety.

II. ARGUMENT

A. HCH's Motion Is A Flagrant Abuse of TBMP §518

On September 10, 2002, HCH made a motion in which it alleged that correspondence between Florida Governor Jeb Bush to James E. Rogan, Undersecretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("PTO"), inquiring as to the status of the PTO's action on a final judgment entered by the federal district court was in violation of the Sunshine Act.[1]

In its Order dated January 21, 2003 (the "Order"), the Board denied outright HCH's tawdry Sunshine Act motion, resumed proceedings "for the limited purpose of considering petitioners' motion for summary judgment" and set a briefing schedule for that motion. *See* Order at pp. 18-20. The Board held that the Sunshine Act had no application to TTAB proceedings, *id.* at pp. 11-13, and further held that even if the Sunshine Act did apply, neither Governor Bush's nor Director Rogan's letters were *ex parte* communications relevant to the merits of this proceeding. *Id.* at pp. 14-17. [2]

HCH's motion must be denied as it does not satisfy TBMP §518 which provides, in pertinent part, that:

> Generally, the premise underlying a motion for reconsideration . . . under 37 CFR §2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or

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1 The irony of making a motion under the Sunshine Act as proxy for an entity owned by the Castro government which has violated international law precepts in seizing American assets in Cuba and which has denied its own citizens any semblance of "Due Process" was lost on HCH's counsel.

2 After the Board issued the Order, Cubaexport's new counsel sought yet another extension of Cubaexport's time to respond. The Board, in its Order dated February 12, 2003, ruled that proceedings were suspended "pending a decision by OFAC on Fish & Neave's application for a specific license to represent Cubaexport in this proceeding." *See* February 12, 2003 Order at p. 5. One week later, HCH filed the instant motion to further delay the proceedings.

decision it issued. *Such a motion may not properly be used to:*

1) introduce additional evidence,

2) nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. (emphasis added).

A cursory review of HCH's motion demonstrates that it fails both prongs of TBMP §518. HCH raises no new arguments or authority in its brief. Furthermore, to the extent that HCH's motion does raise new argument, that argument is improperly based on a packet of "hearsay" documents acquired -- under dubious circumstances -- *after* HCH's initial motion had been fully briefed. Accordingly, HCH's motion for reconsideration must be denied in its entirety.

1. HCH's Motion Improperly Seeks to Introduce New Evidence

HCH's motion improperly seeks to introduce nearly 150 pages of new documents purportedly obtained for HCH by Mr. Ryan Banfill, Communications Director for the Democratic Party, and by Mr. Thomas Edsall, a reporter for *The Washington Post.* HCH's counsel, Mr. Charles Sims, offers no explanation in either HCH's brief or in his Declaration as to how and why he just happened to learn of the existence of these documents in the hands of third parties with no apparent stake whatsoever in the instant proceedings. Both the Board's Rules and the case law expressly preclude HCH from putting new evidence before the Board on reconsideration. *See* TBMP §518; *see also In re Cosmetically Yours, Inc.*, 171 U.S.P.Q. 563 (TTAB 1971); *Amoco Oil Co. v. Amerco, Inc.*, 201 U.S.P.Q. 126 (TTAB 1978).

Even if HCH could somehow properly introduce this after-acquired evidence, those documents provide no support for HCH's claim that Bacardi violated the Sunshine Act. Nor does the fabricated "Chronology of Events" attached to Mr. Sims' Declaration. The 150 pages of new documents appended to HCH's motion papers are nothing more than duplicates and drafts of the letters at issue in HCH's original motion (*see* FOIA 0001-0011; 0016-18; 0103; 0105; 0108-0109; 0144), a USTR press release (*see* FOIA 0112-0113), a copy of Bacardi's

summary judgment motion papers and excerpts thereof (*see* FOIA 0047-0068), printouts from the USPTO website (FOIA 0114-0120) and other documents from the USPTO not relevant here (FOIA 0121-0128). The vast majority of the remainder of the documents are e-mails between and among Governor Bush, his staff and Bacardi which merely discuss and precede the letters attached to HCH's original motion which the Board explicitly held did not violate the Sunshine Act.[3] *See* Order at pp. 14-17.

None of the documents submitted with the instant motion by HCH were before the Board when it issued its Order. Accordingly, the Board may not consider them now. "Material which was not presented prior to the Board's decision is not proper for consideration at this time. . . [R]econsideration must be made on the basis of the record at the time of the Board's decision. *See In re Cosmetically Yours, Inc.*, 171 U.S.P.Q. 563, 565 (TTAB 1971). For this reason alone, the Board must deny HCH's motion.

2. HCH's Motion Merely Rehashes Prior Arguments

A motion for reconsideration "should [not] be devoted simply to a reargument of the points presented in a brief on the original motion." *See* TBMP §518. HCH's motion does exactly that. Point I of HCH's brief on this motion relies heavily on a rehash of the very same arguments made using the same authority cited in footnote 4 of HCH's original moving papers, namely, *Professional Air Traffic Controllers Organization v. Federal Labor Relations Authority*, 672 F.2d 109 (D.C. Cir. 1982), *Portland Audubon Soc'y v. Endangered Species Comm.*, 984 F.2d 1534 (9th Cir. 1993) and *North Carolina Envtl. Policy Inst. v. EPA*, 881 F.2d 1250 (4th Cir. 1989). *See* HCH's Br. at pp. 3-11. The remainder of Point I, and all of Point II of HCH's brief,

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[3] Inexplicably, HCH has also attached e-mails to Governor Bush concerning the Florida citrus industry which have absolutely no bearing on any issue herein (*see* FOIA 0083-0084).

is based on the improper evidence acquired after the original motion had been fully briefed, as discussed above. *Id.* at pp. 2, 4-5, 9 n.3, 11-14. Accordingly, HCH's motion violates TBMP §518 and must be denied.

III. CONCLUSION

Based on the foregoing, HCH's motion for reconsideration should be denied in its entirety.

Date: May 30, 2003

Respectfully submitted,

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CERTIFICATE OF MAILING

EXPRESS MAIL LABEL NO.: EU 947769436

DATE OF DEPOSIT: May 30, 2003

The undersigned hereby certifies that on May 30, 2003 a copy of the foregoing PETITIONERS' MEMORANDUM OF LAW IN OPPOSITION TO RESPONDENT HAVANA CLUB HOLDING'S MOTION FOR RECONSIDERATION is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

Mary Rose Amistad

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 30, 2003 a copy of the foregoing PETITIONERS' MEMORANDUM OF LAW IN OPPOSITION TO RESPONDENT HAVANA CLUB HOLDING'S MOTION FOR RECONSIDERATION has been served upon:

(A) Charles S. Sims, Esq. of Proskauer Rose LLP, counsel for respondent Havana Club Holding, S.A., by causing a true and correct copy thereof to be delivered by First Class mail addressed to the aforesaid attorney at 1585 Broadway, New York, New York 10036, the address designated by said attorney for that purpose; and

(B) Herbert F. Schwartz, Esq. of Fish & Neave, counsel for respondent Empresa Cubana Exportadora de Alimentos y Productos Varios, S.A. by causing a true and correct copy thereof to be delivered by First Class mail addressed to the aforesaid attorney at 1251 Avenue of the Americas, New York, New York 10020, the address designated by said attorney for that purpose.

Dated: May 30, 2003

Mary Rose Amistad

Mary Rose Amistad

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May 30, 2003

06-02-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #76

VIA EXPRESS MAIL

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Re: Galleon, S.A. et al. v. Havana Club Holding, S.A., et al.,
Cancellation No. 24,108

Dear Sir or Madam:

In connection with the above-captioned cancellation proceeding, we enclose PETITIONERS' MEMORANDUM OF LAW IN OPPOSITION TO RESPONDENT HAVANA CLUB HOLDING'S MOTION FOR RECONSIDERATION.

Kindly acknowledge receipt of same by stamping and returning the enclosed self-addressed postcard.

Sincerely,

Michelle M. Graham

Michelle M. Graham

Enclosures

NY01/GRAHM/838654.1