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

Proceeding	92052146
Party	Plaintiff Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d.b.a. Cubatabaco
Correspondence Address	DAVID B GOLDSTEIN RABINOWITZ BOUDIN STANDARD KRINSKY & LIEBERMAN PC, 45 BROADWAY SUITE 1700 NEW YORK, NY 10006-3791 UNITED STATES dgoldstein@rbskl.com
Submission	Motion to Compel Discovery
Filer's Name	David B. Goldstein
Filer's e-mail	dgoldstein@rbskl.com, dreich@rbskl.com
Signature	/David B. Goldstein/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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CORPORACION HABANOS, S.A., and EMPRESA )  
CUBANA DEL TABACO, d.b.a. CUBATABACO, )  
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Petitioners, )  
 )  
v. )  
 )  
RODRIGUEZ, JUAN E., )  
 )  
Respondent. )

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Cancellation No. 92052146

**MOTION TO COMPEL DISCOVERY, FOR SANCTIONS, AND TO SUSPEND  
PROCEEDINGS**

Pursuant to 37 CFR § 2.120(e), and TBMP §§ 408, 411, 510, 523, Petitioners Corporacion Habanos, S.A. and Empresa Cubana Del Tabaco, d.b.a. Cubatabaco (“Petitioners”) hereby move to compel discovery from Respondent Juan E. Rodriguez (“Respondent”); for sanctions for violation of Fed. R. Civ. P. 26(g) and for failure to cooperate in the discovery process; and to suspend the instant proceeding with respect to all matters not germane to the motion pending disposition of the motion to compel, and to reset the deadlines for close of discovery, pretrial disclosures and testimony periods after disposition of the motion. As set forth in more detail below, and in the Declaration of David B. Goldstein (“Goldstein Decl.”), filed herewith, Petitioners made a good faith effort to resolve the issues raised by this Motion, without success. *See* 37 C.F.R. § 2.120(e)(1); TPMP § 523.02.

Petitioners seek to compel complete responses to Document Requests 2-7, 18-21, 22, 26-27, 29-34, and to Interrogatories 3-4, 6-14, 16, 20-22, and in support thereof state as follows:

## Background Facts

Respondent obtained a registration for PINAR DEL RIO, Registration No. 3,542,236 for “cigars” on December 2, 2008. Petitioners filed a timely petition to cancel on March 1, 2010, asserting that the PINAR DEL RIO mark is, *inter alia*, deceptive and primarily geographically deceptively misdescriptive pursuant to sections 2(a), (e)(3) of the Lanham Act; and Respondent made material misrepresentations and omissions of fact when it represented to the USPTO, “Our tobacco seeds come from Pinar del Rio Cuba” and that its “goods have an association with Pinar del Rio, Cuba,” following the Examiner’s initial refusal. Petition ¶¶ 50-64 (D.E. 1).

Respondent filed a motion to dismiss the Petition for lack of standing, which the Board denied on August 1, 2011 (D.E. 16). After Respondent failed to file a timely Answer, on September 27, 2011, Petitioners filed a motion for default judgment (D.E. 17). On October 9, 2011, Frank Herrera was substituted as counsel for Respondent, and “advise[d] the Board that [Respondent] fully intends to press forward with a defense in this matter.” (D.E. 19, at 3.) On October 11, 2011, Respondent filed its Answer (D.E. 20).<sup>1</sup>

Petitioners served their Initial Disclosures on Respondent’s counsel on November 16, 2011, at one of his many addresses, and re-served the Initial Disclosures on January 27, 2012 to another address of Respondent’s counsel. Goldstein Decl. ¶ 3.

On January 31, 2012, Petitioners served by mail their First Request for Production of Documents and Things (“Document Requests”) calling for production of documents at the offices of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., in New York, and their First Set of Interrogatories (“Interrogatories”). Goldstein Decl. Exs. A, B. Respondent’s deadline to respond to the document requests and interrogatories was March 6, 2012.

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<sup>1</sup> Petitioners then withdrew, without prejudice, their motion for default judgment (D.E. 21), and on November 30, 2011, the Board reset disclosure, discovery and trial dates (D.E. 22).

On March 6, 2012, Respondent served unsworn Interrogatory Responses and Document Responses, but failed to produce any documents. *Id.* ¶ 11, Exs. C, D.<sup>2</sup> Respondent stated, without objection, including to the stated place of production, that it would produce documents for Requests 2-7, 18-21, 27, 29-34. To date, however, Respondent has continued to fail and to refuse to produce any documents. *Id.* ¶ 11. Respondent objected only to: Document Request 22 and Interrogatory 16 (claiming “highly confidential” or “proprietary information”); Document Request 26 (“assumes facts not in evidence”); and Interrogatory 6 (claiming attorney-client privilege for communications that were not sought by the Interrogatory).

**Petitioners’ Good Faith Efforts to Resolve the Discovery Dispute and Respondent’s Counsel’s Obstructionist Conduct**

Prior to bringing this motion to compel, Petitioners made extensive good faith efforts, through email correspondence and by telephone, to resolve the issues presented in this motion, but the parties have not been able to reach agreement, as Respondent’s counsel has failed and refused even to respond to any of Petitioners’ efforts.

On March 12, 2012, Petitioners’ counsel emailed Respondent’s counsel (“March 12 Email”), requesting that Respondent confirm it will produce the responsive documents no later than March 20. Goldstein Decl. Ex. E. Counsel also attached a proposed Protective Order executed by Petitioner’s counsel to address Respondent’s confidentiality objections to Request 22 and Interrogatory 16, *id.* Ex. F, which is identical to the Protective Order filed in *Corporacion Habanos, S.A., et al. v. Cigar King, Ltd.*, Canc. No. 92053245 (TTAB), in which the parties are represented by the same attorneys as here, *id.* ¶ 10. Petitioners asked Respondent’s counsel to execute and file the Protective Order, or to return the executed Protective Order to Petitioners’

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<sup>2</sup> Because Respondent failed to follow the Board’s stated preference that a responding party reproduce each discovery request immediately preceding the answer or objection thereto, TBMP § 405.04(b), Petitioners are filing both the discovery requests and the responses (Exs. A-D to Goldstein Decl.).

counsel for filing; or to give Petitioners' counsel any comments. In response to Respondent's (baseless) objection and request that Document Request 26 be amended, Petitioners also proposed an amendment to that request, deleting what appeared to be the offending language.

Having heard nothing from Respondent, on March 22, 2012, Petitioners' counsel sent another email to Respondent's counsel ("March 22 Email"), stating, *inter alia*, that Respondent had "no basis to continue: to refuse to produce responsive documents and things...; to refuse to agree to a Protective Order; to refuse to respond to my proposal to amend Document Request 26...; or to completely ignore my March 12 email." The email further stated, "Please agree to the Protective Order or propose changes immediately, and produce the responsive documents immediately, including those that you claim are confidential."<sup>3</sup> Goldstein Decl. Ex. E.

The email also identified and addressed in detail the specific deficiencies in the responses to Interrogatories 3, 4, 6-14, 16(a), (c), (d), 20-22, and requested that Respondent provide full and complete responses, and the missing sworn statement to the Interrogatory Responses. *Id.*

The email also stated that counsel "ha[s] no desire to burden the Board with a motion to compel," but that "seems to be the only way to get a response from you," and that Respondent "should expect that [Petitioners] will file a motion to compel in the first week of April if [Respondent has] not agreed to a Protective Order; produced all responsive documents; and provided full and complete responses to the Interrogatories[.]" *Id.*<sup>4</sup>

Still having no response, on March 28, 2012, Petitioners' counsel telephoned Respondent's counsel and left a voice message asking counsel to return the call in order to

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<sup>3</sup> The email also noted that, according to Interrogatory Response No. 2, Abe Flores of Respondent's company had already collected responsive documents and things no later than March 6, 2012.

<sup>4</sup> Counsel also stated, "I do not want to bring a motion to compel, but if your past conduct in other matters is any guide, it appears that you will simply refuse to produce documents or provide other responsive information until after I file a motion to compel. I reiterate my view that this conduct of yours in this case and in others between us is improper, and subject to sanctions." Goldstein Decl. Ex. E.

discuss outstanding discovery issues in this case and to avoid a motion to compel. Respondent never responded to this voice message. Goldstein Decl. ¶ 12.

As of the date of this motion, Respondent has refused and failed to produce any documents whatsoever, to provide any further Interrogatory Responses, to respond to the proposed Protective Order, or to respond in any way to the March 12 Email, the March 22 Email, or the March 28 voice message, all contrary to Respondent's counsel's representation to the Board that Respondent "fully intends to press forward with a defense in this matter." D.E. 19.

TBMP § 408.01 provides, "The Board expects ... attorneys ... to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not. Each party and its attorney ... has a duty ... to make a good faith effort to satisfy the discovery needs of its adversary." *See also Panda Travel Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009) ("Each party has a duty to make a good faith effort to satisfy the reasonable and appropriate discovery needs of its adversary."). Continuing failure to cooperate in the discovery process may subject a party to sanctions. *See Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1721 n.4 (TTAB 1989) (finding counsel's behavior to be "deliberately uncooperative and evasive"; Board warned counsel, and stated, "[i]f the Board perceives further such behavior by opposer's counsel, then sanctions in the form of precluding opposer from introducing evidence on certain issues... or, if warranted, judgment against opposer, will be considered by the Board"). The Board also has inherent authority to enter appropriate sanctions. *See* TBMP § 527.03 ("Flowing from the Board's inherent authority to manage the cases on its docket is the inherent authority to enter sanctions against a party. The Board's exercise of this authority is clearly permitted in a variety of situations where the conduct in question does not fall within the reach of other sanctioning provisions of the rules.").

Petitioners recognize that the Board addresses each proceeding on its own merits, but they contend that the obstructionist discovery tactics employed here by Respondent's counsel, Frank Herrera, should not be viewed in isolation, and that the Board's attention should be drawn to his almost identical refusal to cooperate in discovery in other very similar pending matters involving Petitioners, which are fully set out in pending motions to compel in those matters.

Mr. Herrera is also counsel for the respondent in *Corporacion Habanos, S.A., et al. v. Cigar King, Ltd.*, Canc. No. 92053245 (TTAB) (a petition to cancel the marks HABANA LEON and HAVANA SOUL for "cigars made with Cuban seed tobacco," primarily on the grounds of geographic deceptiveness, in which undersigned counsel represents the same Petitioners as here).<sup>5</sup> As set out in Petitioners' motion to compel discovery in that proceeding, exactly as here, for months Mr. Herrera failed and refused: to produce documents; even to respond to numerous efforts by Petitioners to address the discovery disputes; and even to respond to a proposed Protective Order. Only after Petitioners finally filed a motion to compel, and not until the day that the respondent's response to the motion was due, did the respondent (three and a half months late), produce a handful of documents (a woefully incomplete production) and agree to the Protective Order exactly as presented months earlier. The respondent provided no explanation for the failure to produce documents or to respond to Petitioners repeated efforts to address the issues. *See* Canc. No. 92053245, D.E. 17-24.

Mr. Herrera is also the attorney for the respondent in *Corporacion Habanos, S.A., et al. v. Inter-America Cigar Co.*, Canc. No. 92051672 (TTAB) (a petition to cancel the mark HAVANA SUNRISE for "cigars composed of Cuban seed tobacco," and related products, primarily on the

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<sup>5</sup> In that matter, Mr. Herrera entered an appearance after the Board issued a Notice of Default and the time to respond had run, claiming that he was one of "only a handful of attorneys in the United States hav[ing] experience litigating against Petitioners and their counsel," and "Registrant stand [sic] ready, willing, and able to defend this matter with its current counsel." Canc. No. 92053245, D.E. 8.

grounds of geographic deceptiveness, again in which undersigned counsel represents the same Petitioners as here). Again, after over three months of fruitless efforts to obtain discovery compliance as set forth in Petitioners' motion papers, Petitioners brought a motion to compel discovery, which is currently pending. *See* Canc. No. 92051672, D.E. 34, 37. As in *Cigar King*, the respondent's counsel, in his opposition to the motion, gave no explanation for his refusal to respond to Petitioners' efforts to resolve the matter without motion practice. Instead, in blatant disregard of his discovery obligations, Mr. Herrera merely asserted that he would produce documents, which were due four months earlier, "shortly" or "prior to the Board's resolution of this motion," *id.* D.E. 36 (Respondent's Brief at 4-5, filed September 12, 2011), with no explanation why the documents were not previously produced. In fact, the respondent has not produced any documents subsequent to September 12, 2011, almost seven months ago.<sup>6</sup>

Given these facts and circumstances, Petitioners request that the Board consider and impose an appropriate sanction on Respondent and its counsel, including precluding it from presenting evidence supporting its representation to the USPTO that its "tobacco seeds come from Pinar del Rio Cuba," or supporting its affirmative defenses.

## ARGUMENT

### **I. The Board Should Compel Respondent to Produce Responsive Documents and to Provide Complete Interrogatory Responses**

Respondent has waived any objections not made to Petitioners' Document Requests and Interrogatories when it served its responses. *See No Fear, Inc. v. Rule*, 54 USPQ2d 1551, 1555 (TTAB 2000) (where applicant failed to file timely objections, it waived its right to object to discovery requests on their merits); *Crane Co. v. Shimano Industrial Co.*, 184 USPQ 691 (TTAB

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<sup>6</sup> Respondent's counsel also represented to the Board that it mailed samples of things responsive to discovery requests on September 12, 2011 (D.E. 36, Respondent's Br. at 6), but Petitioners' counsel has received nothing, which Petitioners had noted in their Reply (D.E. 37, Reply at 1).

1975) (where no timely objections made to interrogatories, “applicant has waived its right to object to the interrogatories on their merits and must reply to them as put”); TBMP §§ 405.04(a), 406.04(a), 410.

Given Respondent’s and its counsel’s obstructionist conduct, Respondent should now be ordered to produce the requested documents and information forthwith, with a specific deadline; and Respondent’s counsel should be ordered within that deadline: 1) to provide a written certification that he has conducted a complete and thorough search of hard copy and electronic documents and things in Respondent’s *possession, custody or control*, and that there are no further responsive documents or things to be produced; and 2) to provide an explanation with respect to any Requests for which Respondent stated that responsive documents would be produced in its Responses, and for which it certifies that no responsive documents exist. *See Corporacion Habanos, S.A. v. Finck Cigar Co.*, Canc. No. 92051542 (TTAB Oct. 5, 2010).<sup>7</sup>

**1. Request 2-7, 18-21, 27, 29-34:** Respondent stated, without any objection, that responsive documents for these requests “will be produced,” but to date, Respondent has refused to produce *any* documents or things. Respondent has acknowledged that documents and things responsive to these Requests exist, and these requests unquestionably seek documents and things relevant to this proceeding. Thus, the Board should compel Respondent to produce forthwith any and all responsive documents to these Requests in its possession, custody, or control. *See Pioneer Kabushiki Kaisha v. Hitachi High Technologies America, Inc.*, 74 USPQ2d 1672, 1679 (TTAB 2005); Fed. R. Civ. P. 34(a).

**2. Request 22 and Interrogatory 16:** Respondent’s only objection to these discovery requests is that they seek “highly confidential” and “proprietary” information. As

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<sup>7</sup> Petitioners will move to preclude Respondent from introducing or otherwise relying on any responsive documents or information not provided in response to their discovery requests.

noted, on March 12, Petitioners proffered a Protective Order, identical to the terms agreed upon by Respondent's counsel in another matter, which includes both "Highly Confidential" and "Attorneys-Eyes-Only" categories of protection. Respondent cannot refuse to produce responsive documents and information as purportedly confidential, and then refuse even to respond to a proposed Protective Order. The Board should enter the proposed Protective Order (or the Board's Standard Protective Order) and compel Respondent to produce forthwith any and all responsive information and documents in its possession, custody, or control.

**3. Request 26:** This Request seeks "[d]ocuments sufficient to disclose any tobacco products that Respondent purchases, produces, distributes, or sells under marks or names that include the name of a geographic location in addition to products under the PINAR DEL RIO mark." Goldstein Decl. Ex. A. Respondent objected to this Request solely on the ground that it "assumes facts not in evidence" because "[t]here is nothing in the record that confirms that PINAR DEL RIO is a geographic term." *Id.* Ex. C. The objection is baseless, and at best highly disingenuous. Respondent explicitly represented to the USPTO, in order to overcome the refusal to register, that "our tobacco seeds come from Pinar del Rio Cuba," and "the goods have an association with Pinar Del Rio, Cuba," thereby explicitly acknowledging that Pinar del Rio is a geographic term. The Application File, of course, is part of the record in this proceeding.

Nevertheless, in their March 12 Email, Petitioners proposed to amend Request 26 "in order to try to avoid an unnecessary dispute, and to receive the documents that are clearly and obviously requested by Request 26, and in response to Respondent's specific request that 'Petitioners' [sic] amend this request[,]'" by deleting "in addition to products under the PINAR DEL RIO mark."<sup>8</sup> Goldstein Decl. Ex. E. As noted, Respondent never responded or objected.

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<sup>8</sup> The obvious point of excluding "products under the PINAR DEL RIO mark," was so the Request would capture *only* documents for cigar products using *other* geographic names, and to avoid duplicate

Therefore, the Board should compel Respondent to produce forthwith any and all documents responsive to Request 26 in its possession, custody, or control.

**4. Interrogatories 3-4:** Interrogatory 3 asks, *inter alia*, that Respondent “state the reasons for adopting or selecting the mark.” Interrogatory 4 asks, *inter alia*, that Respondent “state when such sales [under the PINAR DEL RIO] began.” As set forth in the March 22 Email, Respondent failed to “state the reasons for adopting or selecting the mark,” or when sales under the mark began. Respondent made no objection to these Interrogatories, and the Board should order full and complete responses.

**5. Interrogatory 6:** This Interrogatory asks, *inter alia*, that Respondent “state with particularity the contents of” “communications between Respondent and the USPTO concerning the PINAR DEL RIO mark.” Respondent failed to provide a response, instead making the non-responsive objection that communications between Abe Flores and attorney Christopher J. Day (which were not sought by the Interrogatory) are privileged. “Communications between Respondent and the USPTO concerning the PINAR DEL RIO mark,” as requested by the Interrogatory, are plainly not privileged, even if made by Mr. Day, and the Board should order a complete and full response to this Interrogatory.

**6. Interrogatories 7-14:** These Interrogatories seek information concerning or arising from Respondent’s representation to the USPTO that its “tobacco seeds come from Pinar del Rio Cuba.” As set forth in the March 22 Email, Respondent’s responses are completely non-responsive to these Interrogatories, because none of the responses make any reference to Pinar del Rio or respond in any way to the Interrogatories’ request for information concerning the basis for Respondent’s representation to the USPTO that its “tobacco seeds come from Pinar del Rio

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production. The notion that a party can avoid producing documents for a cigar product, for example *Flor de Nicaragua*, by claiming this would somehow concede that Pinar del Rio is a geographic term is frivolous (and Respondent’s own representations to the USPTO establish that it is a geographic term).

Cuba.” As an alternative to Respondent properly responding to these Interrogatories, Petitioners, in the March 22 Email, offered not to “pursue this matter further” if Respondent agreed to one of two proposed stipulations, to which Respondent never responded. Petitioners are plainly entitled to the information sought in Interrogatories 7-14, and Respondent should be compelled to provide complete responses to these Interrogatories, specifically directed to Respondent’s representation that Respondent’s tobacco seeds come from Pinar del Rio, Cuba.

## **II. Respondent’s Responses to Interrogatories 20-22 Violate Fed. R. Civ. P. 26(g)**

Interrogatories 20-22 sought the identities of persons with information concerning Respondent’s Affirmative Defenses of “laches,” “unclean hands” and “standing.” In its Responses, Respondent listed 34 persons (individuals and entities), none of whom are principals or employees of Respondent, or are identified as having anything to do with Respondent. Instead, these 34 persons appear to be nothing more than a list pulled off of TTABVUE of every person against whom Petitioners, over the last 15 years: 1) sought an extension of time to file a Notice of Opposition, without filing a Notice (9 persons); 2) filed a Notice of Opposition (17 persons); 3) filed a Petition to Cancel (7 persons); or 4) in one case, filed both a Notice of Opposition and a Petition to Cancel (for different marks).

It is now clear that, with the possible exception of 3 clients of Respondent’s counsel’s on the list<sup>9</sup>, neither Respondent nor its counsel made any effort whatsoever to determine if any of these third parties in fact had any information relevant to Respondent’s Affirmative Defenses, in blatant violation of Fed. R. Civ. P. 26(g)’s requirement that a party’s Interrogatory responses shall be made only “after a reasonable inquiry.” Moreover, it is all but certain that virtually none of these persons has any knowledge relevant to *Respondent’s* Affirmative Defenses.

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<sup>9</sup> Cigar King, Ltd.; Guantanamera Cigars, Inc.; Inter-America Cigar Company.

Respondent's identification of almost three dozen third parties spread about the country, with no connection to this proceeding, without any inquiry, let alone a reasonable one, as to whether they have any relevant information, is pure discovery abuse, plainly interposed for the purpose of needlessly increasing the cost of litigation and causing unnecessary delay, is unreasonable, and is unduly burdensome and expensive, *see* Rule 26(g)(1)(B)(ii), (iii). In addition, given that *Respondent* must know whatever facts purportedly support its Affirmative Defenses, it is plainly unduly burdensome, expensive, and harassing to these third party witnesses, even if they conceivably had some possible relevant information.

In the March 22 Email, Petitioners directly addressed this issue, stating, "It appears that you simply copied out a list of almost every proceeding brought by Petitioners in the TTAB, as well as numerous requests for extensions of time in which no proceeding was initiated, without any effort to determine if the nearly three dozen persons and entities listed (other than perhaps the three you represent), have any responsive information." Petitioners also questioned, and stated several reasons for doing so, "whether, in compliance with FRCP 26(g), you listed these three dozen persons or entities only 'after a reasonable inquiry,'" and noting that "it appears highly improbable that most, if any, of the identified persons, have responsive information to the claims or defenses in this case." Petitioners, therefore, "request that you conduct the requisite reasonable inquiry of the persons and entities on your list, and provide an amended response, or otherwise confirm that you have contacted each of the persons and entities on your list, and that they have advised you that they have information responsive to Interrogatories 20-22." As noted, Respondent has not responded to this email.

On March 22, Petitioners' counsel contacted attorneys for seven of the persons identified by Respondent and inquired whether they had information relevant to the Respondent's three

Affirmative Defenses. Six have responded that they were previously unaware of this TTAB proceeding and of Respondent, that neither the non-party nor its counsel had been contacted by Respondent or its counsel, and that the clients did not have any information relevant to this proceeding (one attorney has responded that his client is out of the country). Goldstein Decl. ¶ 13, Ex. G (email correspondence with third party counsel). These responses from third party counsel demonstrate, without more, Respondent's blatant violation of Rule 26(g)'s duty of "reasonable inquiry" *before* serving discovery responses. *See* Fed. R. Civ. P. 26 Advisory Committee's notes (1983 Amendment Rule 26, Subdivision (g)) ("The duty to make a 'reasonable inquiry' is satisfied if the *investigation* undertaken by the attorney and the conclusions drawn therefrom are reasonable under the circumstances.") (emphasis added). Plainly, if there was *no* investigation, the "reasonable inquiry" duty could not be satisfied.

In addition, as noted, Petitioners merely sought extensions of time against 9 persons on the list, several of which did not even involve cigars, and it is highly improbable that any of these persons would have knowledge of Respondent's Affirmative Defenses, including any knowledge not directly available to Respondent. Likewise, several of the identified persons defaulted without even filing an Answer, and again, it is highly improbable that they have any information concerning Respondent's laches and other defenses.

Fed. R. Civ. P. 26(g)(3) provides, "If a certification violates this rule without substantial justification, the court, on motion or on its own, *must* impose an appropriate sanction on the signer, the party on whose behalf the signer was acting, or both[.]" (emphasis added). TBMP § 408.01(c) states, "Provision is made, in Fed. R. Civ. P. 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule," and cites to TBMP § 106.02, which incorporates the non-exclusive list of sanctions in 37 CFR § 11.18. *See Miss Am. Pageant v.*

*Petite Prods., Inc.*, 17 USPQ2d 1067, 1069 (TTAB 1990) (“[Fed. R. Civ. P. 26(g)] provides for the imposition of appropriate sanctions for a certification made in violation of the rule.”). Here, it would be an appropriate sanction for the Board to “[p]reclud[e] [Respondent] from ... presenting or contesting an issue,” to wit, its affirmative defenses of laches, unclean hands and standing. 37 CFR § 11.18(c)(3). Alternatively, it would be appropriate for the Board to sanction Respondent by ordering that he may support these affirmative defenses only with testimony of: 1) persons who have been identified to date in the Responses to Interrogatories 20-22; *and* 2) who also provide sworn affidavits or declarations that they were contacted by Respondent or his counsel *before* being so identified; *and* that they had informed Respondent or his counsel *at that time* that they have information relevant to Respondents’ affirmative defenses.

Even if not prepared to sanction Respondent for violating Rule 26(g), the Board should order Respondent to comply with the Rule by amending its responses to Interrogatories 20-22, and to provide a written certification that: 1) Respondent or its attorney has contacted all the persons (or their attorneys) that it identifies in its amended responses to each of those three Interrogatories; 2) each of the persons identified in the amended Interrogatory responses has advised Respondent or its attorney that that person has information responsive to the specific affirmative defense; and 3) Respondent is not identifying that person for any improper purpose, including to harass, to cause unnecessary delay, or needlessly to increase the cost of litigation, including through unnecessarily duplicative or cumulative testimony.

### **III. The Board Should Suspend Proceedings and Reset Deadlines**

“When a party files a motion for an order to compel...the case *will be* suspended by the Board with respect to all matters not germane to the motion.” 37 CFR § 2.120(e)(2) (emphasis added); *see* TBMP §§ 510.03(a), 523.01. Petitioners also request that, upon disposition of the

motion, the Board reset the deadlines for discovery, including expert disclosure, and trial periods. *See* 37 CFR §§ 2.120(a)(2), 2.121(a); *Jain v. Ramparts Inc.*, 49 USPQ2d 1429 (TTAB 1998) (proceedings deemed suspended as of the filing of the motion and relevant deadlines reset). Because of the persistent delays caused by Respondent's refusal to produce *any* documents, or to provide complete Interrogatory Responses, or to cooperate to resolve the discovery issues, discovery cannot fairly be completed within the period established by the current discovery schedule, which provides for completion by July 3, 2012. In particular, Petitioners have been unable to prepare their expert disclosure, or to prepare for depositions of individuals identified by Respondent. Petitioners, therefore, request that all forthcoming dates in the discovery and disclosure schedule be extended so that the discovery period closes 120 days after the determination of this motion, with the trial schedule extended accordingly.

### CONCLUSION

For the reasons stated herein, Petitioners' Motion to Compel, For Sanctions, and to Suspend Proceedings should be granted.

Dated: New York, New York  
April 5, 2012

Respectfully submitted,

RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.

By:           /David B. Goldstein/          

DAVID B. GOLDSTEIN

DANIEL S. REICH

45 Broadway, Suite 1700

New York, New York 10006-3791

(212) 254-1111

[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)

*Attorneys for Petitioners Corporacion Habanos,  
S.A. and Empresa Cubana del Tabaco*

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing MOTION TO COMPEL DISCOVERY, FOR SANCTIONS, AND TO SUSPEND PROCEEDINGS was served on Respondent by mailing via U.S. first-class mail, postage prepaid, said copy on April 5, 2012, to:

Frank Herrera  
H New Media  
P.O. Box 273778  
Boca Raton, FL 33427-3778  
*Address of Record for Attorney for Respondent Juan E. Rodriguez*

Frank Herrera  
Herrera New Media Law  
1405 N. Congress Ave.  
Suite 10  
Delray Beach, Florida 33445  
*Address used by Attorney for Respondent in discovery responses*

\_\_\_\_\_  
/s/  
Daniel S. Reich

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

CORPORACION HABANOS, S.A., and EMPRESA )  
CUBANA DEL TABACO, d.b.a. CUBATABACO, )  
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Petitioners, )  
 )  
v. )  
 )  
RODRIGUEZ, JUAN E., )  
 )  
Respondent. )  
 )

Cancellation No. 92052146

**DECLARATION OF  
DAVID B. GOLDSTEIN**

DAVID B. GOLDSTEIN, an attorney duly admitted to the practice of law,  
declares under penalty of perjury that the following is true and correct:

1. I am a member of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., counsel for petitioners Corporacion Habanos, S.A. and Empresa Cubana Del Tabaco, d.b.a. Cubatabaco (“Petitioners”), and a member of the bar of the State of New York.
2. I make this declaration in connection with Petitioners’ Motion To Compel Discovery, For Sanctions, and To Suspend Proceedings, dated April 5, 2012, filed herewith.
3. Petitioners served their Initial Disclosures on Juan E. Rodriguez’s (“Respondent”) counsel on November 16, 2011, at one of his many addresses, and re-served the Initial Disclosures on January 27, 2012 to another address of Respondent’s counsel.
4. Attached hereto as Exhibit A is a true and correct copy of Petitioners’ First Request for Production of Documents and Things, served on January 31, 2012.
5. Attached hereto as Exhibit B is a true and correct copy of Petitioners’ First Set of Interrogatories to Respondent, served on January 31, 2012.
6. Attached hereto as Exhibit C is a true and correct copy of Respondent’s Response and Objections to Request for Documents, dated March 6, 2012.

7. Attached hereto as Exhibit D is a true and correct copy of Respondent's unsworn Responses to Interrogatories, dated March 6, 2012. Respondent has never served a sworn copy.

8. On behalf of Petitioners, I have made good faith efforts through email correspondence and by telephone to Respondent's counsel, Frank Herrera, to resolve the issues presented in this motion, but the parties have not been able to reach agreement, including because Mr. Herrera has never responded to my emails or voicemail.

9. Attached hereto as Exhibit E is a true and correct copy of an email chain containing an email dated March 6, 2012, from Mr. Herrera, attaching Respondent's discovery responses, and emails from me dated March 12, 2012 ("March 12 Email") and March 22, 2012 ("March 22 Email").

10. Attached hereto as Exhibit F is a true and correct copy of the Protective Order that I prepared and executed, and attached to my March 12 Email. This Protective Order is identical in substance to a Protective Order agreed to by Mr. Herrera and entered by the Board in a similar proceeding involving Petitioners and a client of Mr. Herrera's, *see Corporacion Habanos, S.A., et al. v. Cigar King, Ltd.*, Canc. No. 92053245 (TTAB), D.E. 22, 23.

11. As of the date of this Declaration, Respondent has not provided any response to my March 12 Email or March 22 Email. I have not received any documents whatsoever, any additional interrogatory responses, a *sworn* interrogatory response, or any response to the Protective Order I sent on March 12, 2012.

12. On March 28, 2012, at or about 2:45 PM, I attempted to reach Respondent's counsel by telephone and left a voice message asking counsel to return my call in

order to discuss outstanding discovery issues in this case and to avoid the need for Petitioners to file a motion to compel. Respondent never responded to this voice message.

13. On March 22, 2012, I contacted by email attorneys for seven of the persons identified by Respondent in Responses to Interrogatories 20-22 and inquired whether they had information relevant to Respondent's three Affirmative Defenses. Six have responded that they were previously unaware of this TTAB proceeding and of Respondent, that neither the non-party nor its counsel had been contacted by Respondent or its counsel, and that the clients did not have any information relevant to this proceeding (one attorney has responded that his client is out of the country). Attached hereto as Exhibit G is a true and correct copy of email correspondence between me and counsel for seven of the persons listed by Respondent in its Responses to Interrogatories 20-22.

Executed this 5th day of April, 2012 in New York, New York.

  
David B. Goldstein

**EXHIBIT A**

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

<u>CORPORACION HABANOS, S.A., and EMPRESA</u>	)	
<u>CUBANA DEL TABACO, d.b.a. CUBATABACO,</u>	)	
	)	
Petitioners,	)	
	)	
v.	)	Cancellation No.92052146
	)	
RODRIGUEZ, JUAN E.,	)	
	)	
Respondent.	)	
<hr/>	)	

**PETITIONERS' FIRST REQUEST FOR PRODUCTION OF  
DOCUMENTS AND THINGS**

Pursuant to Rules 26 and 34 of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120, and the Order of the Trademark Trial and Appeal Board dated November 30, 2011, Petitioners Corporacion Habanos, S.A. and Empresa Cubana del Tabaco d.b.a. Cubatabaco ("Petitioners") hereby request that Respondent Juan E. Rodriguez ("Rodriguez" or "Respondent") respond to the written document requests and produce all documents called for herein at the offices of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., 45 Broadway, Suite 1700, New York, NY 10006, within 30 days of the date hereof. The responses to each of the following Requests for Production of Documents and Things are to be supplemented in accordance with Rule 26(e) of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120.

**DEFINITIONS**

1. "Petitioners" means Corporacion Habanos, S.A. and Empresa Cubana del Tabaco d.b.a. Cubatabaco.
2. "Respondent" or "you" means Juan E. Rodriguez, his current and former affiliates, subsidiaries, parents, predecessors and successors in interest, and each of their present

and former principals, partners, officers, directors, executives, employees, agents, attorneys and licensees, and all other persons acting or purporting to act on his behalf.

3. The term “communication” means the transmittal of information in the form of facts, ideas, inquiries or otherwise.

4. The term “document” is defined to be synonymous in meaning and equal in scope to the usage of this term in Fed. R. Civ. P. 34(a), including, without limitation, electronic, digital, or computerized data compilations, emails, voicemails, phone records, drafts, translations, and non-identical copies.

5. The term “including” means “including, but not limited to;” the term “concerning” means relating to, referring to, describing, evidencing, or constituting; the terms “all” and “each” shall be construed as “all and each;” the connectives “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the Request all documents that might otherwise be construed to be outside of its scope; and the use of the singular form of a word shall include the plural and vica versa.

6. The terms “mark PINAR DEL RIO” or “PINAR DEL RIO mark” refer to Registration No. 3542236, in the United States Patent and Trademark Office (“USPTO”).

#### **GENERAL INSTRUCTIONS**

The following General Instructions apply to each of the document production requests (hereinafter “Request(s)”) set forth herein:

1. In responding to the following Requests, you are required to furnish all documents that are available to you, including documents in the possession, custody or control of your attorneys, accountants, agents, advertising agencies, design firms, employees, principals,

representatives, or any other persons directly or indirectly employed or connected with you or your attorneys, or anyone else subject to your control.

2. If any document requested is withheld because you claim that such document is privileged, provide the information for such document required by Rule 26(b)(5) of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120.

3. If you object to any Request on grounds other than privilege, state the precise grounds upon which your objection is based.

4. Each Request is to be answered separately and in order.

5. If any documents responsive to the following Requests have been lost, destroyed, transferred voluntarily or involuntarily to others not subject to the control of Respondent, or otherwise disposed of, or if any documents responsive to the following Requests exist but are not available, furnish a list identifying each such document, and setting forth the following information with respect to each document: its date, author(s), sender(s), addressee(s) and recipient(s), and the subject matter of the document. In each instance, explain the circumstances surrounding each disposition or why such document is unavailable, including, in the event of such a disposition, the authorization therefor and the date thereof.

6. If a document is produced in redacted form, state with particularity the reason(s) it was not produced in full, and describe generally those portions of the document that are not being produced in a manner sufficient to identify the document for purposes of a motion to compel discovery.

7. If production of any requested document is objected to on the ground that it is burdensome and oppressive, identify: (i) the precise reason why production poses a special

burden; (ii) the approximate number of documents/pages that have been called for; and (iii) the location(s) of the document(s) that have been called for.

8. Pursuant to Rule 34(b) of the Federal Rules of Civil Procedure, the documents produced shall be produced as they are kept in the ordinary course of business or shall be organized and labeled to correspond to the specific paragraph(s) of this Request to which they are responsive.

9. If, after providing the requested information, you obtain or become aware of any further information or documents responsive to these Requests, you are required to produce to Petitioners such additional information or documents as required by Fed R. Civ. P. 26(e).

#### **REQUESTS FOR PRODUCTION**

1. All documents concerning Respondent's adoption or selection of the mark PINAR DEL RIO for use in connection with any of its products, including cigars.

2. All documents concerning the use, design, or development and creation of any design, lettering, text, trade dress, or packaging, used or considered for use by Respondent in connection with the mark PINAR DEL RIO.

3. All documents concerning the meaning of "Pinar del Rio" including as that term relates to cigars, or tobacco, or as used in the U.S. cigar industry.

4. All documents concerning Pinar del Rio, Cuba.

5. All documents concerning Respondent's application for and registration of the mark PINAR DEL RIO in the USPTO, including all documents prepared, reviewed, or submitted in support of that trademark application and registration and all documents concerning any communications with the USPTO regarding the application for or registration of the mark PINAR DEL RIO.

6. Documents sufficient to show when Respondent began to sell cigars under the PINAR DEL RIO mark.

7. Documents sufficient to show Respondent's use in commerce of the mark PINAR DEL RIO for "cigars" at the time Respondent filed an Amendment to Allege Use on or about August 20, 2008.

8. All documents concerning Respondent's statement to the USPTO in a Response to Office Action on or about August 21, 2008, in connection with the PINAR DEL RIO mark, that "[o]ur tobacco seeds come from Pinar del Rio Cuba[,]" including all documents that were reviewed, considered, or prepared by Respondent, or any investigation, study or analysis conducted by Respondent, on or before August 21, 2008, concerning the claim to the USPTO that tobacco used in PINAR DEL RIO cigars is grown from "tobacco seeds [that] come from Pinar del Rio Cuba."

9. All documents concerning any investigation, study or analysis conducted by Respondent after August 21, 2008 concerning its claim that tobacco used in PINAR DEL RIO cigars is grown from "tobacco seeds [that] come from Pinar del Rio Cuba."

10. To the extent not already produced in response to the foregoing requests, all documents concerning Respondent's claim that the tobacco used in PINAR DEL RIO cigars is grown from "tobacco seeds [that] come from Pinar del Rio Cuba."

11. All documents concerning what Respondent meant by the statement "[o]ur tobacco seeds come from Pinar del Rio Cuba" at the time it filed its Response to Office Action on or about August 21, 2008.

12. All documents concerning the "tobacco seeds...from Pinar del Rio Cuba" that Respondent claims are used to grow tobacco used in Respondent's PINAR DEL RIO cigars.

13. All documents concerning tobacco seeds from Pinar del Rio, Cuba, including any reference to seeds from Pinar del Rio, Cuba in the United States cigar industry.

14. All documents concerning the seeds that are used to grow tobacco used in cigars bearing the mark PINAR DEL RIO, including all documents concerning the country of origin of the seeds, and how, where, when, and from whom such seeds have been obtained by Respondent or its suppliers or manufacturers.

15. All documents concerning when, if ever, the “tobacco seeds...from Pinar del Rio Cuba” that Respondent claims are used to grow tobacco used in cigars bearing the mark PINAR DEL RIO came from Pinar del Rio, Cuba, and where in Pinar del Rio, Cuba the original seeds came from.

16. All documents concerning whether the “tobacco seeds...from Pinar del Rio Cuba” that Respondent claims are used to grow tobacco used in cigars bearing the mark PINAR DEL RIO are descendants of tobacco seeds that originally came from Pinar del Rio, Cuba, and if so, when the seeds came from Pinar del Rio, Cuba.

17. All documents concerning how many generations the seeds used to grow the tobacco used in cigars bearing the mark PINAR DEL RIO are descended from the original seeds Respondent claims were taken from Pinar del Rio, Cuba.

18. All documents, including marketing reports, business plans, and internal memoranda, concerning Respondent’s actual or intended market, customers and users for cigars bearing the mark PINAR DEL RIO.

19. All documents concerning Respondent’s or third parties’ marketing, promotion and advertisement of cigars bearing the mark PINAR DEL RIO, including examples or copies of

each and every advertisement, display and item of promotional material, including on the Internet, and any and all drafts of same, whether used or not.

20. Documents concerning the manufacture by or on behalf of Respondent of cigars bearing the mark PINAR DEL RIO, sufficient to identify all former or current manufacturers and places of manufacture of the tobacco of any such cigars.

21. Documents sufficient to identify the characteristics, varietal, location and country of origin, and region of origin within that country, of any tobacco used in Respondent's cigars bearing the mark PINAR DEL RIO, including whether any of the identified tobacco is grown from "tobacco seeds...from Pinar del Rio Cuba."

22. Documents sufficient to show the blend used in Respondent's cigars bearing the mark PINAR DEL RIO by frontmark, vitola, size or type of cigar, including the binder, filler, and wrapper, and any changes to the blend at any point in time, and the percentage of each type of tobacco used, including the percentage of tobacco grown from "tobacco seeds...from Pinar del Rio" used.

23. All documents concerning any product of Cuban origin claimed to be used as an ingredient or component of Respondent's cigars bearing the mark PINAR DEL RIO.

24. All documents concerning any alleged connection between Respondent's cigars bearing the mark PINAR DEL RIO and Cuba or Pinar del Rio, Cuba, including any alleged connection between tobacco grown from "tobacco seeds...from Pinar del Rio Cuba" as used in Respondent's PINAR DEL RIO cigars and Cuba.

25. All documents concerning consumers' or potential consumers' perceived country of origin of Respondent's cigars bearing the mark PINAR DEL RIO, any perceived geographic association with Respondent's cigars bearing the mark PINAR DEL RIO, or any association by

consumers or potential consumers between Respondent's cigars bearing the mark PINAR DEL RIO and Cuba or Pinar del Rio, Cuba, or Petitioners, including any actual or planned survey, study, test, market research, or analysis concerning same.

26. Documents sufficient to disclose any tobacco products that Respondent purchases, produces, distributes, or sells under marks or names that include the name of a geographic location in addition to products under the PINAR DEL RIO mark.

27. One sample of each of Respondent's products that is packaged or has ever been packaged using the mark PINAR DEL RIO, including one sample of each of the packaging or shipping materials, trade dress, text, labels, cigar bands, and boxes or containers.

28. Samples of the "tobacco seeds...from Pinar del Rio Cuba" that Respondent uses in Respondent's cigars bearing the mark PINAR DEL RIO.

29. All reviews, reports and mentions in any publication or media, including on the Internet, or by any third party of Respondent's cigars bearing the mark PINAR DEL RIO.

30. All documents concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including all documents concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.

31. All documents concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.

32. All documents concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

33. All documents concerning Respondent's denial and other allegations set forth in paragraphs 24, 33, 38-44, and 60-63 of Respondent's Answer.

34. To the extent not produced in response to the forgoing requests, all documents that Respondent intends to rely upon in this proceeding.

Dated: New York, New York  
January 26, 2012

RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.

By: 

DAVID B. GOLDSTEIN  
DANIEL S. REICH  
45 Broadway, Suite 1700  
New York, New York 10006  
(212) 254-1111  
[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)  
[dreich@rbskl.com](mailto:dreich@rbskl.com)

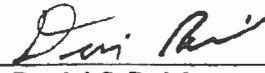
*Attorneys for Petitioners Corporacion Habanos,  
S.A. and Empresa Cubana del Tabaco*

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing PETITIONERS' FIRST REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS was served on Respondent by mailing via U.S. first-class mail, postage prepaid, said copy on January 31st, 2012, to:

Frank Herrera  
H New Media  
P.O. Box 273778  
Boca Raton, FL 33427  
*Attorney for Respondent Juan E. Rodriguez*

Frank Herrera  
Herrera New Media Law  
1405 N. Congress Ave.  
Suite 10  
Delray Beach, Florida 33445

  
\_\_\_\_\_  
Daniel S. Reich

**EXHIBIT B**

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

CORPORACION HABANOS, S.A., and EMPRESA CUBANA DEL TABACO, d.b.a. CUBATABACO,	)	
	)	
Petitioners,	)	
	)	
v.	)	Cancellation No.92052146
	)	
RODRIGUEZ, JUAN E.,	)	
	)	
Respondent.	)	
	)	

**PETITIONERS' FIRST SET OF INTERROGATORIES TO RESPONDENT**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120, and the Order of the Trademark Trial and Appeal Board dated November 30, 2011, Petitioners Corporacion Habanos, S.A. and Empresa Cubana del Tabaco d.b.a. Cubatabaco ("Petitioners") hereby request that Respondent Juan E. Rodriguez ("Rodriguez" or "Respondent") serve written answers, in accordance with the definitions and instructions contained herein, upon Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., 45 Broadway, Suite 1700, New York, NY 10006, within 30 days of the date hereof. The responses to each of the following Interrogatories are to be supplemented in accordance with Rule 26(e) of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120.

**DEFINITIONS**

1. "Petitioners" means Corporacion Habanos, S.A. and Empresa Cubana del Tabaco d.b.a. Cubatabaco.

2. “Respondent” or “you” means Juan E. Rodriguez, his current and former affiliates, subsidiaries, parents, predecessors and successors in interest, and each of their present and former principals, partners, officers, directors, executives, employees, agents, attorneys and licensees, and all other persons acting or purporting to act on his behalf.

3. The term “communication” means the transmittal of information in the form of facts, ideas, inquiries or otherwise.

4. The term “document” is defined to be synonymous in meaning and equal in scope to the usage of this term in Fed. R. Civ. P. 34(a), including, without limitation, electronic, digital, or computerized data compilations, emails, voicemails, phone records, drafts, translations, and non-identical copies.

5. When referring to a person, to “identify” means to give, to the extent known, the person’s full name, present or last known address, and when referring to a natural person, additionally, the present or last known place of employment.

6. When referring to documents, to “identify” means to give, to the extent known, the (i) type of document; (ii) general subject matter; (iii) date of the document; and (iv) author(s), addressee(s) and recipient(s).

7. The term “including” means “including, but not limited to;” the term “concerning” means relating to, referring to, describing, evidencing, or constituting; the terms “all” and “each” shall be construed as “all and each;” the connectives “and” and “or” shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the Request all documents that might otherwise be construed to be outside of its scope; and the use of the singular form of a word shall include the plural and vica versa.

8. The terms “mark PINAR DEL RIO” or “PINAR DEL RIO mark” refer to Registration No. 3542236, in the United States Patent and Trademark Office (“USPTO”).

#### GENERAL INSTRUCTIONS

The following General Instructions apply to each of the Interrogatories set forth herein:

1. Each Interrogatory is to be answered separately and in order.
2. These Interrogatories are continuing in character so as to require further and supplemental production if additional responsive information is obtained between the time of initial response and the close of briefing, and Respondent is reminded of the duty to supplement and/or correct any disclosures or responses as required by Rule 26(e) of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120.
3. If an Interrogatory cannot be answered in full after exercising due diligence to secure the necessary information to do so, please so state and answer the Interrogatory to the extent possible, specifying and stating whatever information or knowledge is presently available concerning the unanswered portion of said interrogatory.
4. If an Interrogatory is objected to, the reason for the objection must be stated with specificity in lieu of an answer. If any part of an Interrogatory is objected to, any unobjectionable portion must be answered.
5. If you contend that any requested information is subject to any privilege (such as attorney/client) or protection (such as attorney work-product) and you intend to assert such privilege or protection, provide the information required by Rule 26(b)(5) of the Federal Rules of Civil Procedure and Title 37 of the Code of Federal Regulations Section 2.120, including (i) the general subject matter of the information you claim to be privileged or protected; (ii) the nature

of the privilege or protection being claimed; and (iii) the date, author and recipient of any allegedly privileged or protected communications or documents.

### **INTERROGATORIES**

1. Identify each person who prepared or assisted in the preparation of any response to these Interrogatories, and identify which Interrogatories each person participated in preparing or answering.

2. Identify each person who provided or collected documents or things in response to Petitioners' First Request for Production of Documents and Things, and state the responsibilities of each person.

3. Identify each person with information concerning Respondent's adoption or selection of, or any application or registration proceedings at the USPTO for, the mark PINAR DEL RIO used in connection with any of Respondent's products, including cigars, and state the reasons for adopting or selecting the mark.

4. Identify each person with information concerning when Respondent began to sell cigars under the PINAR DEL RIO mark, and state when such sales began.

5. Identify each person employed by or associated with Respondent who has knowledge of Respondent's sales of cigars under the mark PINAR DEL RIO.

6. Identify each person with information concerning any communications between Respondent and the USPTO concerning the PINAR DEL RIO mark, and state with particularity the contents of such communications.

7. Identify each person with information, including knowledge of any investigation, study, or analysis conducted by Respondent, concerning the claim made by Respondent to the USPTO concerning the mark PINAR DEL RIO that tobacco used in the cigars sold under the

mark is grown from “tobacco seeds [that] come from Pinar del Rio Cuba”; and state with particularity the basis for this claim, including the specific steps Respondent took to verify the claim.

8. To the extent not already answered in response to the foregoing interrogatories, identify each person with information concerning Respondent’s claim that tobacco used in PINAR DEL RIO cigars is grown from “tobacco seeds [that] come from Pinar del Rio Cuba,” and state with particularity the basis for that claim

9. State with particularity what Respondent meant by the statement “[o]ur tobacco seeds come from Pinar del Rio Cuba[.]” as used in its communication with the USPTO on or about August 21, 2008, including whether Respondent claims that the seeds used to grow the tobacco used in PINAR DEL RIO cigars come from Pinar del Rio, Cuba, or are descendants of seeds that Respondent claims are from Pinar del Rio, Cuba.

10. State whether Respondent uses tobacco grown from “tobacco seeds...from Pinar del Rio Cuba” in cigars bearing the mark PINAR DEL RIO.

11. If Respondent claims that it uses tobacco grown from “tobacco seeds...from Pinar del Rio Cuba” in cigars bearing the mark PINAR DEL RIO, then identify the person(s) from whom that tobacco is obtained and the persons who obtain and/or obtained the tobacco on behalf of Respondent, and state with particularity the country(ies) of origin of that tobacco, the location in each country where that tobacco was grown, and the varietal of that tobacco.

12. If Respondent claims that it uses tobacco grown from “tobacco seeds...from Pinar del Rio Cuba” in cigars bearing the mark PINAR DEL RIO, then state with particularity how, where, when, and from whom such seeds were obtained by Respondent or its suppliers or manufacturers.

13. If Respondent claims that it uses the term “tobacco seeds [that] come from Pinar del Rio Cuba” to refer to tobacco grown directly from seeds claimed to be taken from Pinar del Rio, Cuba, state: when those original seeds came from Pinar del Rio, Cuba; who took the original seeds out of Pinar del Rio, Cuba and out of Cuba; and where in Pinar del Rio, Cuba the tobacco was grown from which the original seeds were taken, and by whom.

14. If Respondent uses the term “tobacco seeds [that] come from Pinar del Rio Cuba” to refer to tobacco seeds descended from seeds claimed to be taken from Pinar del Rio, Cuba, then identify the country of origin of the actual tobacco seeds used to grow that tobacco, and state: how many generations the tobacco seeds are descended from seeds claimed to be taken from Pinar del Rio, Cuba; when those original seeds came from Pinar del Rio, Cuba; who took the original seeds out of Pinar del Rio, Cuba; where in Pinar del Rio, Cuba the tobacco was grown from which the original seeds were taken, and by whom; and specify the location, country, and region where the preceding generations of tobacco were grown, and by whom.

15. Identify each variety, frontmark, vitola, size, or type of cigar bearing the PINAR DEL RIO mark currently or formerly produced, promoted, distributed or sold by or on behalf of Respondent.

16. For each item identified in response to Interrogatory 15:

- a) describe with particularity the blend used, including the binder, filler, and wrapper, and the percentage of tobacco claimed to be grown from “tobacco seeds...from Pinar del Rio Cuba”;
- b) identify the place of manufacture, and identity of each person with information concerning the place of manufacture;

- c) identify all countries in which the tobacco, including but not limited to tobacco grown from “tobacco seeds...from Pinar del Rio Cuba,” is grown, and identify in what region of each country the tobacco is grown; and
- d) identify the growers and suppliers of any tobacco used, including but not limited to tobacco grown from “tobacco seeds...from Pinar del Rio Cuba,” and all persons with whom Respondent has consulted, negotiated or contracted to supply tobacco or tobacco seeds or to manufacture PINAR DEL RIO cigars.

17. Identify each person with information concerning any design, development, or creation of the design, lettering, text, packaging or trade dress used by Respondent in connection with the mark PINAR DEL RIO.

18. Identify each person with information concerning the advertising, promotion, marketing strategy, consumer preferences, and sales solicitation by Respondent of the mark PINAR DEL RIO.

19. Identify each person with knowledge of any actual or planned survey, study, test, market research, or analysis concerning the perceived country of origin of Respondent’s cigars bearing the mark PINAR DEL RIO, any perceived geographic association with Respondent’s cigars bearing the mark PINAR DEL RIO, or any association by consumers or potential consumers between Respondent’s cigars bearing the mark PINAR DEL RIO and Cuba or Pinar del Rio, Cuba, or Petitioners.

20. Identify each person with knowledge of the facts concerning Respondent’s Affirmative Defense that Petitioners’ claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.

21. Identify each person with knowledge of the facts concerning Respondent’s

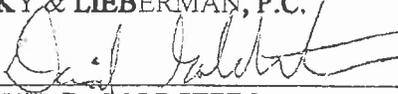
Affirmative Defense that Petitioners' claims are barred by unclean hands.

22. Identify each person with knowledge of the facts concerning Respondent's

Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Dated: New York, New York  
January 26, 2012

RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.

By: 

DAVID B. GOLDSTEIN

DANIEL S. REICH

45 Broadway, Suite 1700

New York, New York 10006

(212) 254-1111

[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)

[dreich@rbskl.com](mailto:dreich@rbskl.com)

*Attorneys for Petitioners Corporacion Habanos,  
S.A. and Empresa Cubana del Tabaco*

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing PETITIONERS' FIRST SET OF INTERROGATORIES TO RESPONDENT was served on Respondent by mailing via U.S. first-class mail, postage prepaid, said copy on January 31st, 2012, to:

Frank Herrera  
H New Media  
P.O. Box 273778  
Boca Raton, FL 33427  
*Attorney for Respondent Juan E. Rodriguez*

Frank Herrera  
Herrera New Media Law  
1405 N. Congress Ave.  
Suite 10  
Delray Beach, Florida 33445



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Daniel S. Reich

**EXHIBIT C**

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

In the Matter of Trademark Registration No. 3,542,236  
Registered: December 2, 2008  
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and	)	
EMPRESA CUBANA DEL TABACO,	)	
d/b/a CUBATABACO,	)	
	)	Cancellation No.: 92052146
Petitioners,	)	
	)	
v.	)	
	)	
JUAN E. RODRIGUEZ,	)	
Registrant.	)	

**REGISTRANT'S RESPONSE AND OBJECTIONS TO REQUEST FOR DOCUMENTS**

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant") and hereby serves his response to Petitioners' First Request For Production of Documents as follows:

**RESPONSES**

**2-7, 18-21, 27, 29-34:** All documents thought to be responsive will be produced.

**1, 8-17, 23, 24, 25, 28:** None.

**22:** This request calls for documents that contain highly confidential and proprietary information.

**26: Objection:** This request assumes facts not in evidence. Namely, the request seeks documents "sufficient to disclose any tobacco products ... that include the name of a geographic location in addition to products under the PINAR DEL RIO mark." There is nothing in the record that confirms that PINAR DEL RIO is a geographic term. Thus, the request unfairly attempts to cause Registrant to produce documents that are not appropriately

defined at this time. Should Petitioners' amend this request Registrant will attempt to respond appropriately.

Dated: March 6, 2012

/s/Frank Herrera  
FRANK HERRERA  
H New Media Law  
1405 N. Congress Avenue  
Suite 10  
Delray Beach, Florida 33445  
T: (305) 965-5148  
F: (480) 247-5698  
[fherrera@hnewmedia.com](mailto:fherrera@hnewmedia.com)  
Attorney for Registrant/  
Respondent

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S RESPONSES TO PETITIONERS' FIRST REQUEST FOR PRODUCTION was served on Petitioners by mailing, postage prepaid, said copy on March 6, 2012 via US Mail, to the counsel of record, namely:

DAVID GOLDSTEIN, Esq.  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY Y LIEBERMAN, P.C.  
45 Broadway, Suite 1700  
New York, New York 10006-1901  
(212) 254-1111  
[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)

/s/Frank Herrera  
FRANK HERRERA

**EXHIBIT D**

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

In the Matter of Trademark Registration No. 3,542,236  
Registered: December 2, 2008  
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and	)	
EMPRESA CUBANA DEL TABACO,	)	
d/b/a CUBATABACO,	)	
	)	Cancellation No.: 92052146
Petitioners,	)	
	)	
v.	)	
	)	
JUAN E. RODRIGUEZ,	)	
Registrant.	)	
	)	

**REGISTRANT'S RESPONSE TO INTERROGATORIES**

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant") and hereby serves his response and objections to Petitioners' First Set of Interrogatories as follows:

1. Frank Herrera counsel for Registrant (as to objections). Juan Rodriguez (all responses). Abraham "Abe" Flores (all responses).
2. Abe Flores. Mr. Flores has ultimate responsibility for all things related to the PINAR DEL RIO brand.
3. Abe Flores. Juan Rodriguez. Christopher J. Day (attorney that assisted Mr. Rodriguez with filing of trademark application).
4. Abe Flores. Juan Rodriguez. Luis Rodriguez. Ysidro Rodriguez. The cigars where first sold at Don Leoncio Cigar Store in New Orleans, Louisiana.
5. Abe Flores. Juan Rodriguez. Luis Rodriguez. Ysidro Rodriguez. Various sales representatives.

6. Juan Rodriguez communicated with his attorney Christopher J. Day about his intention to file a federal trademark application for PINAR DEL RIO. **OBJECTION:** All such communications are protected by the Attorney/Client Privilege or Work Product Doctrine. Abe Flores and Juan Rodriguez discussed the federal trademark application process before, during, and after the application process.
7. No investigation, study, or analysis was conducted by Registrant. Rather, Registrant has relied upon tobacco suppliers for the principal that much of its tobacco is derived from Cuban tobacco seed grown in the Dominican Republic, Nicaragua, Brazil, and elsewhere. Moreover, Registrant's cigar factory is located in Santiago, Dominican Republic. The Dominican Republic has no trade barrier with Cuba. Thus, there is no barrier to obtaining tobacco grown in the Dominican Republic, Nicaragua, Brazil, or elsewhere that was grown from Cuban tobacco seeds.
8. See response to number 7 above.
9. See response to number 7 above.
10. See response to number 7 above.
11. See generally response to number 7 above.
12. See response to number 11 above.
13. See response to number 11 above.
14. See response to number 11 above.
15. Registrant chooses to refer Petitioners' to Registrant's website located at <http://www.pdrcigars.com> for a listing of each variety, frontmark, vitola, size, or type of cigar bearing the PINAR DEL RIO mark. In particular, Petitioners are directed to follow the "Cigars" link on that website.

16. **OBJECTION:** much of the information sought in Interrogatory No. 16 is highly confidential. Registrant will provide non-proprietary responses as follows:

a. Highly confidential trade secrets. However, the general blends are disclosed at <http://www.pdrcigars.com> under the "Cigars" link. To assist Petitioners, Registrant states that the general blends are identified on that page as: W: is wrapper, B: is binder, F: is filler.

b. Santiago de los Caballeros, Dominican Republic. Abe Flores and Juan Rodriguez have information about the place of manufacture of Registrant's products.

c. See generally <http://www.pdrcigars.com>. Otherwise, the specific regions are highly confidential trade secrets.

d. Highly confidential trade secrets.

17. Abe Flores and Juan Rodriguez.

18. Abe Flores.

19. None. This is Petitioners' burden, not Registrant's burden.

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

- Benjamin Gomez of Inter-America cigar company.

  - TTAB Proceeding No. 92051642

- Cigar King

  - TTAB Proceeding No. 92053245

- Xikar, Inc.

  - TTAB Proceeding No. 91186534

- Alex Goldman

  - TTAB Proceeding No. 92053597

- Henry J. Slaughter  
Serial No. 85087592
- G&R Brands, Inc.  
Serial No. 77417467
- Havana International, Inc. d/b/a Havana  
TTAB Proceeding No. 92052877
- Thompson & Co. of Tampa, Inc.  
TTAB Proceeding No. 92052502
- Thompson & Co. of Tampa, Inc.  
TTAB Proceeding No. 92051333
- Reinaldo Estobar  
TTAB Proceeding No. 92052053
- Levy Cafe, Inc.  
TTAB Proceeding No. 92051869
- Finck Cigar Company  
TTAB Proceeding No. 92051542
- Santa Clara, Inc.  
Serial No. 77599183
- Santa Clara, Inc.  
Serial No. 77976362
- Santa Clara, Inc.  
Serial No. 77976373
- Jonathan Drew, Inc.  
TTAB Proceeding No. 92050354
- David Garofalo  
TTAB Proceeding No. 91186535
- Danli Tobacco Shop, Inc.  
TTAB Proceeding No. 91186233
- Lazaro Tejera Rodriguez  
TTAB Proceeding No. 91186003
- Cultivated Cigars, Inc.

- Serial No. 77159903
- McCracken Investments, Inc.  
Serial No. 77279585
  - Mike's Cigars Distributors, Inc.  
Serial No. 77174231
  - Acapa International, LTD.  
TTAB Proceeding No. 91184657
  - Havana Joe's Restaurant Concepts, LLC.  
TTAB Proceeding No. 91184516
  - Hemingway Cigars, Inc.  
TTAB Proceeding No. 91183432
  - Grand Havana Enterprises, Inc.  
TTAB Proceeding No. 91180595
  - La Vega Special Cigars Corp.  
TTAB Proceeding No. 91179320
  - Pedro Martinez-Fraga  
Serial No. 78844258
  - Superior Cigars USA, Inc.  
TTAB Proceeding No. 91170189
  - Anncas, Inc.  
TTAB Proceeding No. 91165519
  - Cubacaney Enterprises  
Serial No. 76523647
  - Reel Smokers Cigar Distributors  
TTAB Proceeding No. 91158932
  - Havana Cuba Cigar Company  
Serial No. 76424613
  - Havana Cuba Cigar Company  
Serial No. 76423643
  - Consolidated Cigar Corporation  
TTAB Proceeding No. 91104731

• Don Rivera, Inc.  
TTAB Proceeding No. 91152898

• Guantanamera Cigars, Inc.  
TTAB Proceeding No. 91152248

• Seissil D/B/A JM Tobacco Company  
TTAB Proceeding No. 91105102

21. See response to number 20 above.

22. See response to number 20 above.

March 6, 2012

/s/Frank Herrera  
FRANK HERRERA  
H New Media Law  
1405 N. Congress Avenue  
Suite 10  
Delray Beach, Florida 33445  
T: (305) 965-5148  
F: (480) 247-5698  
[fherrera@hnewmedia.com](mailto:fherrera@hnewmedia.com)  
Attorney for Registrant/  
Respondent

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONERS' FIRST SET OF INTERROGATORIES was served on Petitioners by mailing, postage prepaid, said copy on March 6, 2012 via US Mail, to the counsel of record, namely:

DAVID GOLDSTEIN, Esq.  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY Y LIEBERMAN, P.C.  
45 Broadway, Suite 1700  
New York, New York 10006-1901  
(212) 254-1111  
[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)

/s/Frank Herrera  
FRANK HERRERA



**EXHIBIT E**

## David Goldstein

---

**From:** David Goldstein  
**Sent:** Thursday, March 22, 2012 1:42 PM  
**To:** 'Frank Herrera'  
**Subject:** FW: Corp. Habanos et al. v. Rodriguez (TTAB Canc. No. 92052146, PINAR DEL RIO)

Frank:

Pursuant to 37 CFR § 2.120(e) and TBMP § 523.02, I make yet another good faith attempt to obtain discovery from Respondent in the above-referenced matter, and to resolve discovery disputes, without the necessity of Board intervention. I do not want to bring a motion to compel, but if your past conduct in other matters is any guide, it appears that you will simply refuse to produce documents or provide other responsive information until after I file a motion to compel. I reiterate my view that this conduct of yours in this case and in others between us is improper, and subject to sanctions.

I have had no response to my below email sent ten days ago, on March 12, 2012. Nor have I received any documents, which were due to be produced on March 6, 2012. I note that, pursuant to Respondent's Interrogatory Response No. 2, by no later than March 6, 2012, Mr. Abe Flores had already provided or collected documents and things in response to Petitioners' Document Requests.

There is no basis to continue: to refuse to produce responsive documents and things, as identified in Respondent's Response to Document Requests; to refuse to agree to a Protective Order; to refuse to respond to my proposal to amend Document Request No. 26, despite the lack of any valid objection to that Request; or to completely ignore my March 12 email. Please agree to the Protective Order or propose changes immediately, and produce the responsive documents immediately, including those that you claim are confidential.

Regarding Respondent's Interrogatory Responses, I note the following deficiencies. Please respond forthwith, including by providing the missing information:

Interrogatory No. 3: Respondent failed to respond to the Interrogatory request that Respondent "state the reasons for adopting the mark."

Interrogatory No. 4: Respondent failed to respond to the Interrogatory request that Respondent "state when such sales [under the PINAR DEL RIO mark] began."

Interrogatory No. 6: Respondent failed to respond to the Interrogatory request that Respondent "state with particularity the contents of such communications" between Respondent and the USPTO. Neither those communications, nor communications between Messrs. Flores and Rodriguez are privileged.

Interrogatory Nos. 7-14: Respondent's responses are blatantly and completely non-responsive to these Interrogatories. Each of these Interrogatories sought information concerning or arising from Respondent's representation to the USPTO that its "tobacco seeds come from Pinar del Rio Cuba." None of Respondent's responses so much as make reference to Pinar del Rio, or respond in any way to the Interrogatories' request for information concerning Respondent's Pinar del Rio tobacco seeds claim.

If Respondent agrees to stipulate to either of the following, Petitioners will not pursue this matter further. If Respondent refuses to so stipulate, then Petitioners are plainly entitled to the information sought in Interrogatory Nos. 7-14 concerning the claim that Respondent's tobacco seeds come from Pinar del Rio, Cuba, given that Respondent made the

above-quoted representation to the USPTO in order to overcome the PTO's refusal to register pursuant to section 2(a), (e)(3):

Proposed Stipulation 1: "Respondent's tobacco seeds do not come from Pinar del Rio, Cuba."

Proposed Stipulation 2: "Respondent has no information whether or not its tobacco seeds come from Pinar del Rio, Cuba, including no information concerning the basis for its claim to the USPTO that 'our tobacco seeds come from Pinar del Rio Cuba.'"

Interrogatory No. 16 (a), (c), (d): Per Respondent's representation to the USPTO, Petitioners are entitled to discover the percentage of tobacco in Respondent's PINAR DEL RIO cigars claimed to be grown from "tobacco seeds ... from Pinar del Rio Cuba," where the tobacco for these cigars are grown, and the sources of the tobacco and seeds, and Respondent does not claim otherwise. As noted, on March 12, I sent you a Protective Order that fully addresses any confidentiality concerns, and which is identical to a prior Protective Order to which you have agreed. Respondent cannot refuse to provide this information via your refusal even to respond to a proposed Protective Order.

Interrogatory Nos. 20-22: It appears that you simply copied out a list of almost every proceeding brought by Petitioners in the TTAB, as well as numerous requests for extensions of time in which no proceeding was initiated, without any effort to determine if the nearly three dozen persons and entities listed (other than perhaps the three you represent), have any responsive information. I strongly question whether, in compliance with FRCP 26(g), you listed these three dozen persons or entities only "after a reasonable inquiry," particularly as it appears that several of the listed entities no longer exist, several of the marks were abandoned unrelated to any proceeding brought by Petitioners, many involved nothing more than requests for extensions of time, and others concerned Opposition proceedings. Further, it appears highly improbable that most, if any, of the identified persons, have responsive information to the claims or defenses in this case. Therefore, I request that you conduct the requisite reasonable inquiry of the persons and entities on your list, and provide an amended response, or otherwise confirm that you have contacted each of the persons and entities on your list, and that they have advised you that they have information responsive to Interrogatory Nos. 20-22.

Please provide the requisite sworn statement to the Interrogatory Responses from Respondent's representative.

As I stated at the beginning, I have no desire to burden the Board with a motion to compel. However, that seems to be the only way to get any kind of a response from you. Given my schedule, you should expect that we will file a motion to compel in the first week of April if you have not agreed to a Protective Order; produced all responsive documents; and provided full and complete responses to the Interrogatories, as addressed herein. If you do produce documents through a remote server, please let me know, as you will recall that when you previously did this in a different case, the remote server emails got caught in my spam filter.

We reserve all rights, including to seek appropriate sanctions.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
www.rbskl.com

-----Original Message-----

From: David Goldstein

Sent: Monday, March 12, 2012 1:17 PM

To: 'Frank Herrera'

Cc: Daniel Reich

Subject: RE: Corp. Habanos et al. v. Rodriguez "PINAR DEL RIO"

Frank:

Regarding your document and interrogatory responses in the above-referenced matter:

1. Pursuant to your objections on the basis of confidential, proprietary or trade secret information, and without conceding the validity of such objections, I attach a Protective Order, executed by me, which is identical to the PO filed in the Habana Leon/Havana Soul matter, other than the name and date changes. Please execute and file with the Board, or execute and return to me for filing, or give me any comments forthwith.
2. I don't understand the basis for your objection to Document Request No. 26, which is quite simple and straightforward, and was intended to avoid asking Respondent to produce documents concerning the mark PINAR DEL RIO, of which the parties are already aware. Nothing in the request asks anyone to "assume facts not in evidence." Moreover, given that the Application File is part of the record, including Respondent's representation to the PTO that "Our tobacco seeds come from Pinar del Rio Cuba," it is difficult to understand your statement that "nothing in the record confirms that PINAR DEL RIO is a geographic term." Nevertheless, in order to try to avoid an unnecessary dispute, and to receive the documents that are clearly and obviously requested by Request No. 26, and in response to Respondent's specific request that "Petitioners' [sic] amend this request," Petitioners amend Request No. 26 as follows:

Request No. 26, amended: "Documents sufficient to disclose any tobacco products that Respondent purchases, produces, distributes, or sells under marks or names that include the name of a geographic location."

If you still object to the request, please state your objection. If not, please provide your response, including production of responsive documents.

3. No documents have been produced in response to the document requests, served on January 31, 2012, nor have you provided a date for their production, although on March 6, Respondent stated that all documents "thought to be responsive" to Requests Nos. 2-7, 18-21, 27, 29-34 will be produced. Please confirm that you will produce the responsive documents no later than March 20 (two weeks after they were due). If your position is that you will not produce until I make a motion to compel, as was the case with Cigar King, please let me know, although my view is that position is inappropriate. I would like to avoid a motion to compel, but if you refuse to respond to my request, or refuse to produce the documents without a motion, I will not have any other options.

Petitioners reserve all rights with respect to their discovery requests, and Respondent's responses, and will address deficiencies in those responses upon receipt of responsive documents, or upon Respondent's refusal or failure to produce documents or to respond to this email.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103

(F)212-674-4614  
www.rbskl.com

-----Original Message-----

From: Frank Herrera [mailto:fherrera@hnewmedia.com]  
Sent: Tuesday, March 06, 2012 5:16 PM  
To: David Goldstein  
Cc: Frank Herrera  
Subject: Corp. Habanos et al. v. Rodriguez "PINAR DEL RIO"

David:

See attached Registrant's Response to Interrogatories and Registrant's Response and Objections to Petitioners' First Request for Production. Registrant is currently seeking a Notary in order to sign the Interrogatories. It will follow shortly.

**EXHIBIT F**

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

CORPORACION HABANOS, S.A., and EMPRESA )  
CUBANA DEL TABACO, d.b.a. CUBATABACO, )

Petitioners, )

v. )

RODRIGUEZ, JUAN E., )

Respondent. )

Cancellation No. 92052146

**STIPULATED PROTECTIVE ORDER**

Information disclosed by any party or non-party witness during this proceeding may be considered confidential, a trade secret, or commercially sensitive by a party or witness. To preserve the confidentiality of the information so disclosed, the parties have agreed to be bound by the terms of this order, in its standard form as modified herein. As used in this order, the term "information" covers both oral testimony and documentary material.

Agreement of the parties is indicated by the signatures of the parties' attorneys at the conclusion of this order. The terms of this Protective Order are binding from the date the attorneys sign the order, in standard form as modified herein.

**TERMS OF ORDER**

**1) Classes of Protected Information.**

The Rules of Practice in Trademark Cases provide that all inter partes proceeding files, as well as the involved registration and application files, are open to public inspection. The terms of this order are not to be used to undermine public access to files. When appropriate, however, a party or witness, on its own or through its attorney, may seek to protect the confidentiality of information by employing one of the following designations.

**Confidential** - Material to be shielded by the Board from public access.

**Highly Confidential** - Material to be shielded by the Board from public access and subject to agreed restrictions on access even as to the parties and/or their attorneys.

**Attorneys-Eyes-Only** - Material to be shielded by the Board from public access and access limited to the parties' attorneys, unless otherwise agreed, or so ordered by the Board.

**Trade Secret/Commercially Sensitive** - Material to be shielded by the Board from public access, restricted from any access by the parties, and available for review by outside counsel for the parties and, subject to the provisions of paragraph 4 and 5, by independent experts or consultants for the parties.

## **2) Information Not to Be Designated as Protected.**

Information may not be designated as subject to any form of protection if it (a) is, or becomes, public knowledge, as shown by publicly available writings, other than through violation of the terms of this document; (b) is acquired by a non-designating party or non-party witness from a third party lawfully possessing such information and having no obligation to the owner of the information; (c) was lawfully possessed by a non-designating party or non-party witness prior to the opening of discovery in this proceeding, and for which there is written evidence of the lawful possession; (d) is disclosed by a non-designating party or non-party witness legally compelled to disclose the information; or (e) is disclosed by a non-designating party with the approval of the designating party.

## **3) Access to Protected Information.**

The provisions of this order regarding access to protected information are subject to modification by written agreement of the parties or their attorneys, or by motion filed with and approved by the Board.

Judges, attorneys, and other employees of the Board are bound to honor the parties' designations of information as protected but are not required to sign forms acknowledging the terms and existence of this order. Court reporters, stenographers, video technicians or others who may be employed by the parties or their attorneys to perform services incidental to this proceeding will be bound only to the extent that the parties or their attorneys make it a condition of employment or obtain agreements from such individuals, in accordance with the provisions of paragraph 4.

- **Parties** are defined as including individuals, officers of corporations, partners of partnerships, and management employees of any type of business organization.
- **Attorneys** for parties are defined as including **in-house counsel** and **outside counsel**, including support staff operating under counsel's direction, such as paralegals or legal assistants, secretaries, and any other employees or independent contractors operating under counsel's instruction.
- **Independent experts or consultants** include individuals retained by a party for purposes related to prosecution or defense of the proceeding but who are not otherwise employees of either the party or its attorneys.
- **Non-party witnesses** include any individuals to be deposed during discovery or trial, whether willingly or under subpoena issued by a court of competent jurisdiction over the witness.

**Parties and their attorneys** shall have access to information designated as **confidential or highly confidential**, subject to any agreed exceptions.

**Outside counsel, but not in-house counsel**, shall have access to information designated as **trade secret/commercially sensitive**.

**Independent experts or consultants , non-party witnesses , and any other individual** not otherwise specifically covered by the terms of this order may be afforded access to **confidential or highly confidential** information in accordance with the terms that follow in paragraph 4. Further, **independent experts or consultants** may have access to **trade secret/commercially sensitive** information if such access is agreed to by the parties or ordered by the Board, in accordance with the terms that follow in paragraph 4 and 5.

Only **attorneys** shall have access to information designated **Attorneys-Eyes-Only**, unless otherwise agreed or so Ordered by the Board.

#### **4) Disclosure to Any Individual.**

Prior to disclosure of protected information by any party or its attorney to any individual not already provided access to such information by the terms of this order, the individual shall be informed of the existence of this order and provided with a copy to read. The individual will then be required to certify in writing that the order has been read and understood and that the terms shall be binding on the individual. No individual shall receive any protected information until the party or attorney proposing to disclose the information has received the signed certification from the individual. A form for such certification is attached to this order. The party or attorney receiving the completed form shall retain the original.

#### **5) Disclosure to Independent Experts or Consultants.**

In addition to meeting the requirements of paragraph 4, any party or attorney proposing to share disclosed information with an independent expert or consultant must also notify the party which designated the information as protected. Notification must be personally served or forwarded by certified mail, return receipt requested, and shall provide notice of the name, address, occupation and professional background of the expert or independent consultant.

The party or its attorney receiving the notice shall have ten (10) business days to object to disclosure to the expert or independent consultant. If objection is made, then the parties must negotiate the issue before raising the issue before the Board. If the parties are unable to settle their dispute, then it shall be the obligation of the party or attorney proposing disclosure to bring the matter before the Board with an explanation of the need for disclosure and a report on the efforts the parties have made to settle their dispute. The party objecting to disclosure will be expected to respond with its arguments against disclosure or its objections will be deemed waived.

#### **6) Responses to Written Discovery.**

Responses to interrogatories under Federal Rule 33 and requests for admissions under Federal Rule 36, and which the responding party reasonably believes to contain protected information shall be prominently stamped or marked with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

#### **7) Production of Documents.**

If a party responds to requests for production under Federal Rule 34 by making copies and forwarding the copies to the inquiring party, then the copies shall be prominently stamped or marked, as necessary, with the appropriate designation from paragraph 1. If the responding party makes documents available for inspection and copying by the inquiring party, all documents shall be considered protected during the course of inspection. After the inquiring party informs the responding party what documents are to be copied, the responding party will be responsible for prominently stamping or marking the copies with the appropriate designation from paragraph 1. Any inadvertent disclosure without appropriate designation shall be remedied as soon as the disclosing party learns of its error, by informing all adverse parties, in writing, of the error. The parties should inform the Board only if necessary because of the filing of protected information not in accordance with the provisions of paragraph 12.

#### **8) Depositions.**

Protected documents produced during a discovery deposition, or offered into evidence during a testimony deposition shall be orally noted as such by the producing or offering party at the outset of any discussion of the document or information contained in the document. In addition, the documents must be prominently stamped or marked with the appropriate designation.

During discussion of any non-documentary protected information, the interested party shall make oral note of the protected nature of the information.

The transcript of any deposition and all exhibits or attachments shall be considered protected for 30 days following the date of service of the transcript by the party that took the deposition. During that 30-day period, either party may designate the portions of the transcript, and any specific exhibits or attachments, that are to be treated as protected, by electing the appropriate designation from paragraph 1. Appropriate stampings or markings should be made during this time. If no such designations are made, then the entire transcript and exhibits will be considered unprotected.

#### **9) Filing Notices of Reliance.**

When a party or its attorney files a notice of reliance during the party's testimony period, the party or attorney is bound to honor designations made by the adverse party or attorney, or non-party witness, who disclosed the information, so as to maintain the protected status of the information.

#### **10) Briefs.**

When filing briefs, memoranda, or declarations in support of a motion, or briefs at final hearing, the portions of these filings that discuss protected information, whether information of the filing party, or any adverse party, or any non-party witness, should be redacted. The rule of reasonableness for redaction is discussed in paragraph 12 of this order.

#### **11) Handling of Protected Information.**

Disclosure of information protected under the terms of this order is intended only to facilitate the prosecution or defense of this case. The recipient of any protected information disclosed in accordance with the terms of this order is obligated to maintain the confidentiality of the information and shall exercise reasonable care in handling, storing, using or disseminating the information.

#### **12) Redaction; Filing Material With the Board.**

When a party or attorney must file protected information with the Board, or a brief that discusses such information, the protected information or portion of the brief discussing the same should be redacted from the remainder. A rule of reasonableness should dictate how redaction is effected.

Redaction can entail merely covering a portion of a page of material when it is copied in anticipation of filing but can also entail the more extreme measure of simply filing the entire page under seal as one that contains primarily confidential material. If only a sentence or short paragraph of a page of material is confidential, covering that material when the page is copied would be appropriate. In contrast, if most of the material on the page is confidential, then filing the entire page under seal would be more reasonable, even if some small quantity of non-confidential material is then withheld from the public record. Likewise, when a multi-page document is in issue, reasonableness would dictate that redaction of the portions or pages containing confidential material be effected when only some small number of pages contain such material. In contrast, if almost every page of the document contains some confidential material, it may be more reasonable to simply submit the entire document under seal. **Occasions when a whole document or brief must be submitted under seal should be very rare .**

Protected information, and pleadings, briefs or memoranda that reproduce, discuss or paraphrase such information, shall be filed with the Board under seal. The envelopes or containers shall be prominently stamped or marked with a legend in substantially the following form:

#### **CONFIDENTIAL**

*This envelope contains documents or information that are subject to a protective order or agreement. The confidentiality of the material is to be maintained and the envelope is not to be opened, or the contents revealed to any individual, except by order of the Board.*

#### **13) Acceptance of Information; Inadvertent Disclosure.**

Acceptance by a party or its attorney of information disclosed under designation as protected shall not constitute an admission that the information is, in fact, entitled to protection. Inadvertent disclosure of information which the disclosing party intended to designate as protected shall not constitute waiver of any right to claim the information as protected upon discovery of the error.

#### **14) Challenges to Designations of Information as Protected.**

If the parties or their attorneys disagree as to whether certain information should be protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. If the parties are unable to resolve their differences, the party challenging the designation may make a motion before the Board seeking a determination of the status of the information.

A challenge to the designation of information as protected may be made at any time.

The party designating information as protected will, when its designation is timely challenged, bear the ultimate burden of proving that the information should be protected.

#### **15) Board's Jurisdiction; Handling of Materials After Termination.**

The Board's jurisdiction over the parties and their attorneys ends when this proceeding is terminated. A proceeding is terminated only after a final order is entered and either all appellate proceedings have been resolved or the time for filing an appeal has passed without filing of any appeal.

The parties may agree that archival copies of evidence and briefs may be retained, subject to compliance with agreed safeguards. Otherwise, within 30 days after the final termination of this proceeding, the parties and their attorneys shall return to each disclosing party the protected information disclosed during the proceeding, and shall include any briefs, memoranda, summaries, and the like, which discuss or in any way refer to such information. In the alternative, the disclosing party or its attorney may make a written request that such materials be destroyed rather than returned.

#### **16) Other Rights of the Parties and Attorneys.**

This order shall not preclude the parties or their attorneys from making any applicable claims of privilege during discovery or at trial. Nor shall the order preclude the filing of any motion with the Board for relief from a particular provision of this order or for additional protections not provided by this order.



**EXHIBIT G**

**David Goldstein**

---

**From:** Thomas Bailey [TBAiley@bpslaw.com]  
**Sent:** Tuesday, March 27, 2012 5:21 PM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Goldstein- As we discussed and as you have requested, I can confirm on behalf of Santa Clara, Inc. and on behalf of my firm, as outside trademark counsel, that no one had ever contacted Santa Clara or Bleakley Platt concerning the PINAR DEL RIO cancellation proceeding, prior to receiving your email of March 22. We were previously unaware of the proceeding, and have no direct knowledge of the facts and circumstances underlying the dispute with Respondent Juan Rodriquez.

In the event that we are ever contacted by counsel for Juan Rodriquez, or are made aware of discoverable evidence relevant to your proceeding, we will promptly advise you. Thank you for your courtesy, Tom Bailey

Thomas G. Bailey, Jr.  
Bleakley Platt & Schmidt, LLP  
One North Lexington Avenue  
White Plains, New York 10601  
(914) 287-6127 (Direct)  
(914) 949-2700 (General)  
(914) 683-6956 (Fax)  
[tbailey@bpslaw.com](mailto:tbailey@bpslaw.com)

---

**From:** David Goldstein [<mailto:dgoldstein@rbskl.com>]  
**Sent:** Thursday, March 22, 2012 11:14 AM  
**To:** Thomas Bailey  
**Subject:** FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Bailey:

This law firm represents Corporacion Habanos, S.A. and Cubatabaco in the above-referenced TTAB proceeding. As you may know, your client, Santa Clara, Inc., has been identified by the Respondent in the above-referenced proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Santa Clara. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Santa Clara and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.
21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.
22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

- Santa Clara, Inc.  
Serial No. 77599183
- Santa Clara, Inc.  
Serial No. 77976362
- Santa Clara, Inc.  
Serial No. 77976373

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

## David Goldstein

---

**From:** Sean McMahon [SMcMahon@ostrolenk.com]  
**Sent:** Tuesday, March 27, 2012 1:52 PM  
**To:** David Goldstein  
**Cc:** Robert Faber  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146) (Our Ref.: 7/4440-33)

David:

Mr. Goldman, myself or Mr. Faber have not been contacted by Rodriguez or his counsel about this matter. Up until we contacted our client about your correspondence below our client had never heard of Mr. Rodriguez, his mark or any TTAB proceeding between your client and Mr. Rodriguez. Mr. Goldman has no information about any of the matters discussed in your e-mail below.

If you have any questions, please call me.

Sincerely yours,

**Sean P. McMahon**  
Ostrolenk Faber LLP  
1180 Avenue of the Americas  
New York, NY 10036-8403  
Phone: (212) 382-0700  
Fax: (212) 382-0888  
[smcmahon@ostrolenk.com](mailto:smcmahon@ostrolenk.com)

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---

**From:** David Goldstein [mailto:dgoldstein@rbskl.com]  
**Sent:** Monday, March 26, 2012 5:45 PM  
**To:** Sean McMahon  
**Cc:** Robert Faber  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146) (Our Ref.: 7/4440-33)

Sean:

Thanks. I look forward to your response.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

---

**From:** Sean McMahon [mailto:SMcMahon@ostrolenk.com]  
**Sent:** Monday, March 26, 2012 5:43 PM  
**To:** David Goldstein

**Cc:** Robert Faber

**Subject:** Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146) (Our Ref.: 7/4440-33)

David:

Bob is out of the office until later this week. I am investigating this matter and will get back to you shortly.

Sincerely yours,

**Sean P. McMahon**  
Ostrolenk Faber LLP  
1180 Avenue of the Americas  
New York, NY 10036-8403  
Phone: (212) 382-0700  
Fax: (212) 382-0888  
[smcmahon@ostrolenk.com](mailto:smcmahon@ostrolenk.com)

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---

**From:** David Goldstein [<mailto:dgoldstein@rbskl.com>]

**Sent:** Thursday, March 22, 2012 10:36 AM

**To:** Robert Faber

**Subject:** FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Faber:

As you may recall, we represented Corporacion Habanos, S.A. and Cubatabaco in TTAB proceedings involving your client, Alex Goldman. ("Goldman"). As you may know, Goldman has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Goldman. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Goldman and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.

21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.

22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

- Alex Goldman  
TTAB Proceeding No. 92053597

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

**David Goldstein**

---

**From:** Gundersen, Glenn [glenn.gundersen@dechert.com]  
**Sent:** Monday, March 26, 2012 3:24 PM  
**To:** David Goldstein  
**Subject:** Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146) -- Levy Cafe

David,

I forwarded this information to Levy Cafe, and they indicated that they are not familiar with this proceeding or with Juan Rodriguez.

---

**From:** David Goldstein [mailto:dgoldstein@rbskl.com]  
**Sent:** Thursday, March 22, 2012 2:01 PM  
**To:** Gundersen, Glenn  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Gunderson:

Just to clarify, Levy Café (Dechert's client), is not a party to this proceeding. My clients, Petitioners, are 2 Cuban tobacco companies that brought a proceeding in the TTAB to cancel the registration of PINAR DEL RIO (nothing to do with Levy) on grounds of geographic deceptiveness. The Respondent asserted affirmative defenses, including the three addressed in the Interrogatories below (laches, unclean hands, standing). I don't know anything more about these affirmative defenses, other than what is stated in the Affirmative Defenses in the Answer I sent you. The best I can gather is that Respondent is claiming that your client has information about these defenses because it was a party to an unrelated TTAB proceeding with my clients concerning a petition to cancel your client's mark JOYA DE HAVANA, also on grounds of geographic deceptiveness, which ended with a default judgment.

As I said, I am skeptical as to why Levy would have any responsive information, or why Respondent would think it does, but I am following up. Please feel free to call me, if that will help simplify this. (I know this was several sentences).

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

---

**From:** Gundersen, Glenn [mailto:glenn.gundersen@dechert.com]  
**Sent:** Thursday, March 22, 2012 1:43 PM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

I know nothing about this, and can't tell from your email what information your opponent Levy Café supposedly has. Rather than having me parse through these documents, can you put into one sentence what the issue is?

---

**From:** David Goldstein [mailto:dgoldstein@rbskl.com]  
**Sent:** Thursday, March 22, 2012 10:54 AM

**To:** Gundersen, Glenn  
**Subject:** FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Gunderson:

This law firm represents Corporacion Habanos, SA and Cubatabaco in the above-referenced TTAB proceeding. I sent the below email to Mr. Jay Johnston, who had handled a TTAB matter between my clients and Levy Café, Inc. (identified below). I understand that Mr. Johnston is no longer at Dechert, and I noticed that you are listed as the Correspondent for Levy Café for several of their marks. Please review my below email, and please let me have your prompt response.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

---

**From:** David Goldstein  
**Sent:** Thursday, March 22, 2012 10:42 AM  
**To:** 'jay.johnston@dechert.com'  
**Subject:** FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Johnston:

As you may recall, we represented Corporacion Habanos, S.A. and Cubatabaco in TTAB proceedings involving your client, Levy Café, Inc. ("Levy"). As you may know, Levy has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Levy. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Levy and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.
21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.
22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay

in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

- Levy Cafy, Inc.  
TTAB Proceeding No. 92051869

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
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## David Goldstein

---

**From:** Pat Weese [weese\_fisher@msn.com]  
**Sent:** Monday, March 26, 2012 2:56 PM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Good Afternoon David-  
Nothing at this end.  
The opposition appears to be blowing smoke.  
Let us know if we can aid further.  
Art

Office of: Arthur W. Fisher, III  
5555 W Waters Avenue, Ste 609  
Tampa, Florida 33634  
Phone: (813) 885-2006 Fax: (813) 888-6275

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**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)  
**Date:** Thu, 22 Mar 2012 11:15:57 -0400  
**From:** [dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)  
**To:** [weese\\_fisher@msn.com](mailto:weese_fisher@msn.com)

Art:

Thank you for your response. I look forward to hearing from you further.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

---

**From:** Pat Weese [[mailto:weese\\_fisher@msn.com](mailto:weese_fisher@msn.com)]  
**Sent:** Thursday, March 22, 2012 11:11 AM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Good Morning David-  
Am not informed. Will contact client to flush out.  
Thank you for the heads-up.  
Will advise.  
Art

Office of: Arthur W. Fisher, III  
5555 W Waters Avenue, Ste 609  
Tampa, Florida 33634  
Phone: (813) 885-2006 Fax: (813) 888-6275

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Subject: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)  
Date: Thu, 22 Mar 2012 10:27:23 -0400  
From: [dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)  
To: [mail@tampaiplaw.com](mailto:mail@tampaiplaw.com); [weese\\_fisher@msn.com](mailto:weese_fisher@msn.com)

Mr. Fisher:

As you may recall, we represented Corporacion Habanos, S.A. and Cubatabaco in TTAB proceedings involving your client, Thompson & Co. of Tampa, Inc. ("Thompson"). As you may know, Thompson has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Thompson. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Thompson and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.
21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.
22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

•Thompson & Co. of Tampa, Inc. TTAB  
Proceeding No. 92052502

•Thompson & Co. of Tampa, Inc.  
TTAB Proceeding No. 92051333

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.  
David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791

212-254-1111 x103  
(F)212-674-4614  
[www.rbski.com](http://www.rbski.com)

**David Goldstein**

---

**From:** MEcker@eckertseamans.com  
**Sent:** Wednesday, March 28, 2012 5:30 PM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

This will confirm I spoke with Jonathan Drew. He has not been contacted by Mr. Rodriguez or his counsel about this matter, was unaware of it until I asked him about it and does not have any information relevant to this proceeding, nor do I.

MDE

---

Michael D. Ecker, Esquire  
Eckert Seamans Cherin & Mellott, LLC  
Two Liberty Place  
50 S. 16th Street, 22nd Floor  
Philadelphia, PA 19102  
mecker@eckertseamans.com  
(215) 851-8507 (direct dial)  
(215) 851-8383 (facsimile)  
(215) 284-9649 (cell)

"David Goldstein"  
<dgoldstein@rbskl  
.com>

03/28/2012 05:12  
PM

Michael D Ecker/ESCM@ESCM

To

cc

Subject

RE: Corp. Habanos, S.A. et al v.  
Juan E. Rodriguez (TTAB Canc. No.  
92052146)

Michael:

As we discussed last week, can you send me an email confirming the substance of that conversation regarding the above-referenced matter, to wit, that neither your client or its counsel were ever contacted by Mr. Rodriguez or his counsel, and that your client was not aware of this TTAB proceeding until I brought the matter to your and Mr. Foret's attention, and further that your client does not believe it has any information relevant to this proceeding. Thank you for your attention.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
www.rbskl.com

-----Original Message-----

From: MEcker@eckertseamans.com [mailto:MEcker@eckertseamans.com]  
Sent: Thursday, March 22, 2012 11:49 AM  
To: David Goldstein  
Cc: Foret, Philip J. (PHL)  
Subject: RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

We will respond shortly.

MDE

---

Michael D. Ecker, Esquire  
Eckert Seamans Cherin & Mellott, LLC  
Two Liberty Place  
50 S. 16th Street, 22nd Floor  
Philadelphia, PA 19102  
mecker@eckertseamans.com  
(215) 851-8507 (direct dial)  
(215) 851-8383 (facsimile)  
(215) 284-9649 (cell)

"David Goldstein"  
<dgoldstein@rbskl.com>

03/22/2012 11:27  
AM

Michael D Ecker/ESCM@ESCM

"Foret, Philip J. (PHL)"  
<pforet@dilworthlaw.com>

Subject  
RE: Corp. Habanos, S.A. et al v.  
Juan E. Rodriguez (TTAB Canc. No.  
92052146)

To

cc

Mr. Ecker:

Per the below, and a phone call I just had with Mr. Foret, he asked that I ask you directly for a response to my below email. Please feel free to call me if you want further information.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
www.rbskl.com

From: Foret, Philip J. (PHL) [mailto:pforet@dilworthlaw.com]  
Sent: Thursday, March 22, 2012 11:15 AM  
To: David Goldstein  
Cc: 'MEcker@eckertseamans.com'  
Subject: RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

David,

I have cc'd Michael Ecker, Drew's corporate counsel. Please reach out to Michael for your request.

Sincerely,

Phil

Philip Foret | Dilworth Paxson LLP  
1500 Market Street | Suite 3500E | Philadelphia, PA 19102  
Tel: (215) 575-7046 | Fax: (215) 575-7200 pforet@dilworthlaw.com | www.dilworthlaw.com

From: David Goldstein [mailto:dgoldstein@rbskl.com]  
Sent: Thursday, March 22, 2012 11:03 AM  
To: Foret, Philip J. (PHL)  
Subject: FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)  
Mr. Foret:

As you may recall, we represented Corporacion Habanos, S.A. and Cubatabaco in TTAB proceedings involving your client, Jonathan Drew, Inc. ("Drew"). As you may know, Drew has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Drew. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Drew and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction

of Petitioners.

21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.

22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

Jonathan Drew, Inc.  
TTAB Proceeding No. 92050354

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
www.rbskl.com

www.DilworthLaw.com

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## David Goldstein

---

**From:** David Grace [dgrace@loeb.com]  
**Sent:** Wednesday, March 28, 2012 2:18 PM  
**To:** David Goldstein  
**Subject:** Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146) - 205469-10045

Greetings David –

I learned of this from your email.

I have not spoken with Mr. Rodriguez or his attorney about this and I do not believe that my client has either.

Best regards, Dave

*David W. Grace*  
*Loeb & Loeb LLP*  
*10100 Santa Monica Boulevard, Suite 2200*  
*Los Angeles, California 90067*  
*Tel. 1-310-282-2000*  
*Direct 1-310-282-2108*  
*Fax 1-310-282-2200*  
[dgrace@loeb.com](mailto:dgrace@loeb.com)  
[www.loeb.com](http://www.loeb.com)

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**From:** David Goldstein [mailto:dgoldstein@rbskl.com]  
**Sent:** Thursday, March 22, 2012 8:45 AM  
**To:** David Grace  
**Subject:** FW: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

Mr. Loeb:

As you may recall, we represented Corporacion Habanos, S.A. and Cubatabaco in TTAB proceedings involving your client, Grand Havana Enterprises, Inc. (“Grand Havana”). As you may know, Grand Havana has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Grand Havana. Nevertheless, Respondent’s claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Grand Havana and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.

21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.

22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

- Grand Havana Enterprises, Inc.  
TTAB Proceeding No. 91180595

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

## David Goldstein

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**From:** Wharton, J. David [DWharton@stinson.com]  
**Sent:** Wednesday, April 04, 2012 11:53 AM  
**To:** David Goldstein  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

David

Kurt is out of the country and it will likely be at least another week before I can discuss this with him.

David

**J. David Wharton** | Partner | Stinson Morrison Hecker LLP  
1201 Walnut Street, Suite 2900 | Kansas City, MO 64106-2150  
T: 816.691.3460 | F: 816.412.9366 | M: 816.896.4576  
[dwharton@stinson.com](mailto:dwharton@stinson.com) | [www.stinson.com](http://www.stinson.com)

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**From:** David Goldstein [<mailto:dgoldstein@rbskl.com>]  
**Sent:** Friday, March 30, 2012 8:51 AM  
**To:** Wharton, J. David  
**Subject:** RE: Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

David:

I am following up on my below email. As I note, I am not interested in pursuing wasteful discovery if your client, Xikar, Inc., is without relevant information concerning the above-referenced matter, including Respondent's alleged Affirmative Defenses.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)

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**From:** David Goldstein  
**Sent:** Wednesday, March 21, 2012 4:26 PM  
**To:** 'Wharton, J. David'  
**Subject:** Corp. Habanos, S.A. et al v. Juan E. Rodriguez (TTAB Canc. No. 92052146)

David:

As you may know, your client, Xikar, Inc., has been identified by the Respondent in the above-referenced TTAB proceeding as having relevant information in that proceeding, as specifically identified below, and I presume Respondent or its counsel has discussed this matter with you or your client prior to its identification of Xikar. Nevertheless, Respondent's claim strikes me as questionable, and I do not want to engage in unnecessary discovery if in fact your client has no relevant knowledge concerning this matter. Therefore, please advise me whether your client has information concerning the below matters, including if Respondent were to subpoena Xikar, Inc., and to compel its testimony. Specifically, Petitioners served the following Interrogatories on Respondents:

20. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by laches, including any facts concerning any alleged prejudice to Respondent as a result of any alleged action or inaction of Petitioners.

21. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners' claims are barred by unclean hands.

22. Identify each person with knowledge of the facts concerning Respondent's Affirmative Defense that Petitioners lack standing to bring this Petition for Cancellation.

Respondent responded as follows to Interrogatory No. 20:

20. Each person or persons employed by entities that have been involved in litigation against Petitioners would have knowledge of Registrant's basis for its laches defense. Namely, each of these persons would have knowledge of Petitioners' legal actions and delay in bringing legal actions in the United States. Namely, the following persons or companies would have such knowledge:

\*\*\*\*

Xikar, Inc. TTAB Proceeding No. 91186534

\*\*\*\*

In response to both Interrogatories 21 and 22, Respondent stated, in its entirety, "See response to number 20 above."

For your convenience, I have attached Respondent's Answer, which is also available on TTABVUE, as Docket No. 20 in the above-referenced matter.

Your prompt response is greatly appreciated.

David B. Goldstein  
Rabinowitz, Boudin, Standard, Krinsky, & Lieberman, P.C.  
45 Broadway, Suite 1700  
New York, NY 10006-3791  
212-254-1111 x103  
(F)212-674-4614  
[www.rbskl.com](http://www.rbskl.com)