

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: March 30, 2004

Opposition No. 91124073

BOLLORE'

v.

THE HAVANA GROUP, INC. and  
NORTH ATLANTIC OPERATING  
COMPANY, INC., joined as party  
defendant<sup>1</sup>

**Frances S. Wolfson, Interlocutory Attorney:**

On September 14, 2001, a notice of opposition was filed against applicant's trademark application serial no. 76042035. That case was assigned Opposition No. 91124073.

On November 13, 2001, a notice of opposition was filed against applicant's trademark application serial no. 75772349. That case was assigned Opposition No. 91124506.

On September 25, 2003, opposer filed a withdrawal in Opposition No. 91124073, stating that "The application of The Havana Group, Inc. that is the subject of this

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<sup>1</sup> If the mark in an application or registration which is the subject matter of an inter partes proceeding before the Board is assigned, and the assignment is recorded in the Assignment Branch of the PTO, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. See TBMP §512.01.

Opposition has been expressly abandoned, per the enclosed attachment."

On October 27, 2003, opposer filed a withdrawal in Opposition No. 91124506, stating that "The application of The Havana Group, Inc. that is the subject of this Opposition has been expressly abandoned, per the enclosed attachment."

In both oppositions, the "enclosed attachment" was a copy of applicant's abandonment of serial no. 75772349. No showing of applicant's abandonment of serial no. 76042035 was made.

The Board dismissed both oppositions with prejudice, both applications were refused registration and both became abandoned.<sup>2</sup> However, because no abandonment of serial no. 76042035 was received by the Board, and because opposer based its withdrawal in Opposition No. 91124073 on the abandonment of the "subject" mark of Opposition No. 91124073 (which is serial no. 76042035), the Board should have made further inquiry of the parties before dismissing the action. Accordingly, that portion of the Board's October 3, 2003 order dismissing Opposition No. 91124073 is hereby vacated, proceedings are resumed, and application serial no. 76042035 is hereby returned to pending status.

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<sup>2</sup> Opposition No. 91124073 was dismissed on October 3, 2003; Opposition No. 91124506 was dismissed on December 19, 2003.

On January 16, 2004, applicant filed a combined motion to reinstate application serial no. 76042035, to amend application serial no. 76042035, to substitute new counsel for applicant, and to substitute North Atlantic Operating Company, Inc. as defendant in this proceeding. A copy of an assignment from applicant to North Atlantic Operating Co., Inc. and a power of attorney in favor of new counsel was included with applicant's combined motion.

Applicant's combined motion does not indicate proof of service of a copy of same on counsel for opposer as required by Trademark Rule 2.119. **In order to expedite this matter, a copy of said communication is forwarded herewith to opposer, but strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.**

North Atlantic Operating Company, Inc. has been joined as a party defendant in Opposition No. 91124073, and new counsel has been substituted to represent applicant.

That portion of applicant's motion requesting reinstatement of application serial no. 76042035 is moot. That portion of the motion requesting amendment of the identification of goods in the application is noted, and opposer is allowed until THIRTY DAYS from the mailing date of this order to respond thereto.

Proceedings herein are otherwise suspended.

## New Developments at the Trademark Trial and Appeal Board

- Files of TTAB proceedings can now be examined using TTAB Vue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format. Papers filed prior to January 2003 may not have been scanned. Unscanned papers remain available for public access at the TTAB. For further information on file access, call the TTAB at (703) 308-9330.
- Parties should also be aware of recent changes in the rules affecting trademark matters, including the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) ([www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf](http://www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf)); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003) ([www.uspto.gov/web/offices/com/sol/notices/68fr48286.pdf](http://www.uspto.gov/web/offices/com/sol/notices/68fr48286.pdf)).
- The second edition (June 2003) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at [www.uspto.gov/web/offices/dcom/ttab/tbmp/](http://www.uspto.gov/web/offices/dcom/ttab/tbmp/).