

ESTTA Tracking number: **ESTTA42388**

Filing date: **08/17/2005**

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

Notice of Opposition

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

Opposer Information

Name	CUBAN CIGAR BRANDS, N.V.
Granted to Date of previous extension	08/17/2005
Address	5900 North Andrews Avenue Fort Lauderdale, FL 33309 UNITED STATES

Attorney information	Charles W. Grimes GRIMES & BATTERSBY, LLP 488 MAIN AVENUE, 3RD FLOOR NORWALK, CT 06851-1008 UNITED STATES schlesinger@gandb.com, grimes@gandb.com Phone:203-849-8300
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Applicant Information

Application No	76565632	Publication date	04/19/2005
Opposition Filing Date	08/17/2005	Opposition Period Ends	08/17/2005
Applicant	Cuban Cigar Factory, Inc. 419 19th Street San Diego, CA 92102		

UNITED STATES

Goods/Services Affected by Opposition

Class 034. First Use: 19920100First Use In Commerce: 19920100 All goods and services in the class are opposed, namely: cigars made from Cuban seed tobacco

Attachments	Notice of Opposition Cuban Cigar Factory 081705.pdf (9 pages)
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Signature	/cwg/
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Name	Charles W. Grimes
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Date	08/17/2005
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/565,632
Published in the *Official Gazette* on April 19, 2005

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Cuban Cigar Brands, N.V.,	:	
Opposer,	:	
v.	:	Opposition No.:
Cuban Cigar Factory, Inc.	:	
Applicant.	:	
-----X	:	

NOTICE OF OPPOSITION

Cuban Cigar Brands, N.V. (“Opposer” or “CCB”) believes that it will be damaged by registration of the mark shown in Application Serial No. 76/565,632 and hereby opposes the same. The grounds for opposition are as follows:

COUNT I

1. Opposer CCB is a corporation organized and existing under the laws of the Netherlands Antilles, having an office at 5900 North Andrews Avenue, Fort Lauderdale, Florida 33309.

2. Altadis U.S.A. Inc. (“Altadis U.S.A.”) is a corporation organized and existing under the laws of the State of Delaware, having its principal place of business at 5900 North Andrews Avenue, Fort Lauderdale, Florida 33309. Opposer has granted Altadis U.S.A. an exclusive license to use the trademarks, trade names, trade dress, service marks and brand names associated with MONTECRISTO including the MONTECRISTO Crossed-Sword Design in the United States.

3. Opposer is a wholly-owned subsidiary of Altadis U.S.A. Opposer brings this Opposition on behalf of itself, its licensee, Altadis U.S.A., and its parents Altadis U.S.A. and Altadis Holdings U.S.A. (collectively, “Altadis U.S.A. Group”).

4. Upon information and belief, Applicant, Cuban Cigar Factory, Inc. (“Applicant”), filed a use-based trademark application, serial number 76/565,632, for the mark CUBAN CIGAR FACTORY EXPERIENCE THE TRADITION with Triangle and Crossed Corner Design for “cigars made from Cuban seed tobacco” in International Class 34 on December 17, 2003.

5. Opposer is the owner of the MONTE CRISTO & Crossed-Sword Design trademark and U.S. Trademark Registration No. 332,324 for “cigars,” in International Class 34 on the Principal Register. A true and correct copy of Opposer’s trademark registration certificate for this mark is attached to this Notice of Opposition as Exhibit A and incorporated herein by reference.

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

(a) The MONTECRISTO trademark and U.S. federal trademark registration number 1,173,547 for “cigars” in International Class 34 on the Principal Register. This mark is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065;

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

(c) The MONTE CRISTO trademark and U.S. federal trademark registration number

2,304,416 for “desk sets, desk pads, pens, stands for pens and pencils” in International Class 16, for “golf balls” in International Class and for “cigar cases not of precious metal” in International Class 34 on the Principal Register;

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

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

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

(g) The MONTECRISTO trademark and U.S. federal trademark registration number 2,855,557 for “ground and whole bean coffee” in International Class 30 on the Principal Register. (These trademarks are hereinafter referred to collectively as the “MONTECRISTO Trademarks”).

7. MONTECRISTO cigars are manufactured in the Dominican Republic by Altadis U.S.A.’s subsidiary Tabacalera de Garcia (“TdG”), pursuant to a license granted by Opposer. The cigars are imported, promoted and distributed by Altadis U.S.A.

8. The MONTECRISTO Trademarks were developed and first used by Opposer’s predecessor, Menendez Garcia y Compania Limitada (“Menendez Garcia”), a Cuban limited liability company. Upon information and belief, Menendez Garcia commenced use of the MONTECRISTO Trademarks in the United States at least as early as July 25, 1935 in

connection with premium cigars. From their inception, Menendez Garcia MONTECRISTO cigars were considered among the finest premium cigars in the world.

9. Opposer CCB is the successor-in-interest to Menendez Garcia, having purchased Menendez Garcia's U.S. rights in the MONTECRISTO Trademarks and Crossed-Sword Design in 1976.

10. Upon information and belief, Opposer's predecessors-in-interest used the MONTECRISTO Trademarks and Crossed-Sword Design in the U.S. continuously until some time after the Castro government nationalized the Cuban cigar industry in 1960, following the Cuban revolution. Upon information and belief, Opposer reintroduced the MONTECRISTO brand after its predecessor Menendez Garcia successfully litigated with the Cuban government over the ownership of the U.S. rights in the marks. The MONTECRISTO Trademarks were reintroduced in 1978.

11. Since the inception of their use, the MONTECRISTO Trademarks and Crossed-Sword Design have been used by the Altadis U.S.A. Group and their predecessors-in-interest only in connection with the finest quality premium cigars and licensed merchandise. Opposer's MONTECRISTO cigars are considered to be among the finest premium cigars available in the United States and are sold throughout the United States. Opposer's MONTECRISTO cigars have been extensively advertised and are among the most prestigious cigar brands available in the United States, are highly coveted by cigar aficionados and are used by the media as a symbol of luxury and excellence.

12. Opposer's MONTECRISTO Trademarks and Crossed-Sword Design are used on its MONTECRISTO packaging, in advertisements, on the Internet and in other forums.

13. Opposer's MONTECRISTO Trademarks and Crossed-Sword Design are

inherently distinctive to the public and the trade and serve primarily as designators of origin of Opposer's products. Moreover, Opposer's Crossed-Sword Design forms a triangular shape with crossed corners which the public and the trade associate with the MONTECRISTO brand.

14. Opposer is actively engaged in the development of MONTECRISTO merchandise and in selective licensing of the MONTECRISTO Trademarks and Crossed-Sword Design.

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

16. Through long-term use and controlled marketing, the MONTECRISTO Trademarks and Crossed-Sword Design have become highly distinctive and strongly associated in the United States with cigars of the highest quality emanating from a single source (namely, Opposer CCB). Therefore, it is highly likely that distributors, retailers and consumers will assume that cigars with Applicant's Triangle and Crossed Corner Design are associated with Opposer's MONTECRISTO brand.

17. Applicant's goods are related to the goods sold and provided in connection with Opposer's MONTECRISTO Trademarks and Crossed-Sword Design and/or represent a natural zone of expansion for Opposer. Such goods would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of purchasers.

18. Applicant's mark with the Triangle and Crossed Corner Design is confusingly similar in appearance and commercial impression to Opposer's registered and well-known MONTECRISTO Trademarks and Crossed-Sword Design. Opposer's Crossed-Sword Design forms a triangle with crossed corners. Each leg of Opposer's triangle is defined by parallel lines. Between those parallel lines are the words components of Opposer's MONTECRISTO Trademarks. Applicant's mark has the exact same design components and lay out. Moreover, the words in Applicant's mark were obviously purposefully selected to make a connection with Opposer's renowned MONTECRISTO Trademarks and their Cuban heritage.

19. Thus, Applicant's use of the Triangle and Crossed Corner Design as a mark for "cigars made from Cuban seed tobacco" is likely to cause confusion, mistake or deception as to the source of origin of Applicant's products in that the public, the trade and others are likely to believe that Applicant's products are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to the Opposer's MONTECRISTO brand cigars.

COUNT II

20. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 19 as though fully set forth herein.

21. Opposer's MONTECRISTO Trademarks and Crossed-Sword Design are distinctive and famous and had become famous prior to the acquisition of any rights Applicant may claim in using its mark.


22. Use of the opposed mark by Applicant will cause dilution of the distinctive quality of Opposer's famous MONTECRISTO Trademarks and Crossed-Sword Design.

23. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in use of the mark and thereby dilute Opposer's rights in its distinctive and famous MONTECRISTO Trademarks with the Crossed-Sword Design.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Applicant's application to register CUBAN CIGAR FACTORY EXPERIENCE THE TRADITION with Triangle and Crossed Corner Design as a mark for "cigars made from Cuban seed tobacco" in International Class 34 be denied in all respects.

Dated: August 17, 2005

Respectfully submitted,



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EXHIBIT A

Int. Cl.: 34

Prior U.S. Cl.: 17

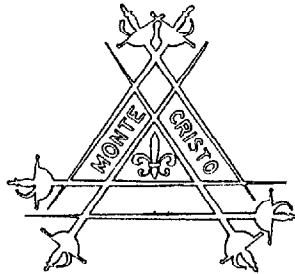
United States Patent and Trademark Office
10 Year Renewal

Reg. No. 332,324

Registered Feb. 11, 1936

Renewal Term Begins Feb. 11, 1996

TRADEMARK
PRINCIPAL REGISTER



CUBAN CIGAR BRANDS N.V. (NETHERLAND ANTILLES CORPORATION)
5900 NORTH ANDREWS AVENUE
FORT LAUDERDALE, FL 33309, BY ASSIGNMENT AND ASSIGNMENT FROM PARTICULARES, S.A. (CUBA CORPORATION) VEDADO, HABANA, CUBA

OWNER OF CUBA REG. NO. 51094, DATED 8-5-1935.

FOR: CIGARS, CIGARETTES, AND CUT TOBACCO, IN CLASS 17 (INT. CL. 34).

FIRST USE 7-25-1935; IN COMMERCE 7-25-1935.

SER. NO. 71-368,577, FILED 8-22-1935.

In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Apr. 9, 1996.

COMMISSIONER OF PATENTS AND TRADEMARKS