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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**Brown**

Mailed: November 17, 2008

Opposition No. 91178943

Corporation Cimex, S.A.

v.

DM Enterprises & Distributors  
Inc.

**Before Holtzman, Cataldo and Ritchie de Larena,  
Administrative Trademark Judges.**

**By the Board:**

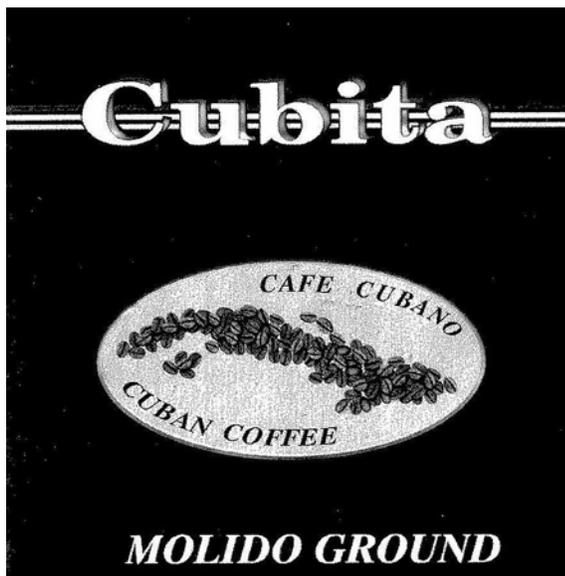
**DM Enterprises & Distributors, Inc.** ("applicant") has filed an application seeking registration on the Principal Register of the mark shown below for "coffee" in International Class 30. The application was filed on May 14, 1999, alleging February 13, 1994, as both the date of first use anywhere and the date of first use in commerce.<sup>1</sup>



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<sup>1</sup> The term CUBITA has been translated in the application as "little Cuba."

**Corporacion Cimex, S.A.** ("opposer"), a Cuban company, has opposed registration of applicant's mark. In its notice of opposition, opposer has alleged that it has a pending application in the United States to register the mark shown below on the Principal Register for "roasted coffee" in International Class 30, and that its ability to register this mark will be "interfered" with if applicant is allowed to register its mark.



Opposer's application Serial No. 77252382 was filed on August 10, 2007 under Section 44(e) of the Trademark Act, and the involved application has been cited by the trademark examining attorney as a potential bar to registration of opposer's mark. As grounds for opposition, opposer has alleged that it has priority over applicant based upon Article 7 of the General Inter-American

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Convention for Trademark and Commercial Protection of Washington, 1929 ("Pan American Convention"), 46 Stat. 2907, and since applicant's mark has "interfered with" opposer's ability to register its mark, opposer can prevail as a matter of law. Additionally, opposer alleges that applicant's mark is primarily geographically deceptively misdescriptive within the meaning of Trademark Act §2(e)(3) and deceptive within the meaning of Trademark Act §2(a).

Applicant answered the amended notice of opposition by denying the salient allegations contained therein.

After a number of stipulated requests to extend the discovery and trial dates, opposer filed a timely motion for summary judgment on the ground that applicant's mark is an "interfering mark" and that opposer has priority over applicant based on Article 7 of the Pan American Convention. Applicant filed a cross-motion for summary judgment based upon opposer's alleged lack of standing to bring this opposition proceeding in light of the on-going, United States embargo with Cuba, the terms of which, according to applicant are "embodied in the Cuban Asset Control Regulations, 31 C.F.R. § 515.201 *et. seq.*" The motions for summary judgment have been fully briefed.

Summary judgment is an appropriate method of disposing of cases at the Board in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Based on the instant record and the arguments of the parties in this case, we find that, as discussed below, opposer has met its burden of demonstrating that there are no genuine issues of material fact regarding opposer's standing to oppose registration of application Serial No. 75697908 or as to its right to prevail under Article 7 of the Pan American Convention.

**I. Background:**

By way of background, the United States is a party to the Pan American Convention with several Latin American nations, including Cuba. As defined, the Pan American Convention pertains to trademarks, trade names, unfair competition, and false indications of geographical origin or source. The beneficiaries under the Pan American Convention are defined as (1) nationals of contracting states, and (2) domiciled foreigners who own a manufacturing or commercial establishment or an agricultural development in any of the contracting states. See *British American Tobacco Co. v. Phillip Morris Inc.*, 55 USPQ2d 1585 (TTAB 2000).

Consistent with the Supreme Court's decision in *Bacardi Corporation of America v. Domenech*, 311 U.S. 150, 161, 47 USPQ 350, 355 (1940), the Board notes that the Pan American Convention is self-executing, and therefore became U.S. law upon ratification, requiring no special implementing legislation. Moreover, since the Pan American Convention has the same force as a federal statute and provides remedies independent of the Lanham Act, the Board remains an appropriate forum for opposer to assert priority under Article 7 in this proceeding. See *Diaz v. Servicios*

*De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1328 (TTAB 2007).

**II. Summary Judgment as to Opposer's Standing:**

Having once again recognized the Board as an appropriate forum to bring such matters, we now consider the issue of opposer's standing. In considering opposer's standing, which we note forms the basis for applicant's cross-motion for summary judgment, it is well-settled that to establish standing, opposer must show that it has a "real interest" in the outcome of the proceeding; that is, that it has a direct and personal stake in the outcome of the opposition. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Thus, standing only requires that a party opposing registration has a good faith belief that it is likely to be damaged by the registration. See *Lipton, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Opposer, with its motion for summary judgment, submitted evidence that it filed an application, now suspended, for the mark **CUBITA** and design with the U.S. Patent and Trademark Office for "roasted coffee" in International Class 30. That evidence included a copy of an Office action in which applicant's mark was cited as a potential basis for refusal of opposer's application,

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Serial No. 77252382. Alone, the fact that applicant's mark was cited as a potential bar to registration of opposer's pending application, supported by a copy of the attached Office action, clearly provides an adequate basis to find that there is no genuine issue as to opposer's standing. See *Hartwell Co. Shane*, 17 USPQ2d 1569 (TTAB 1990).

Nevertheless, applicant argues in its motion for summary judgment that opposer is a Cuban entity and given the existing embargo between the United States and Cuba, opposer lacks standing to pursue an opposition proceeding at the Board. In support, applicant cites the decision in *Havana Club Holdings, S.A. v. Galleon, S.A.*, 203 F.3d 116, 53 USPQ2d 1609, 1618 (2d Cir. 2000). However, in that case, which involved a false designation of geographic origin claim, the Court clearly held that Section 211(b) of the Omnibus Consolidated and Emergency Supplemental Appropriations Act of 1999<sup>2</sup> did not apply to that case because the involved claim was not based on the ownership

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<sup>2</sup> In pertinent part, Section 211(b) provides as follows: No U.S. court shall recognize, enforce or otherwise validate any assertion of treaty rights by a designated national or its successor-in-interest under sections 44(b) or (e) of the Trademark Act of 1946 (15 U.S.C. 1126(b) or (e)) for a mark, trade name, or commercial name that is the same as or substantially similar to a mark, trade name, or commercial name that was used in connection with a business or assets that were confiscated unless the original owner of such mark, trade name, or commercial name, or the bona fide successor-in-interest has expressly consented.

of a mark that had been confiscated by the Cuban government. Here, none of opposer's claims are based on the ownership of a confiscated mark, and since Section 211(b) therefore has no applicability in the matter currently before the Board, applicant's argument is without merit. See *Corporacion Habanos, S.A. v. Anncas, Inc.*, \_\_\_ USPQ2d \_\_\_ (Serial No. 78363024) (TTAB September 26, 2008) ("So as to be perfectly clear, opposer has standing, although it does not and cannot engage in any business in the United States due to the embargo on Cuban goods.").

Moreover, and consistent with the facts in *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473 (TTAB 2008), opposer has also provided a copy of a letter from the Department of Treasury, attached with the declaration of counsel for opposer, David B. Goldstein, confirming that Cuban entities such as opposer, **Corporacion Cimex, S.A.**, are indeed permitted under Section 515.527 of the Cuban Assets Control Regulations, 31 C.F.R. Part 515, to "file an opposition to the registration of a new trademark ... where these actions relate to the protection of a trademark in which Cuba ... has an interest." In view thereof, we find that opposer has demonstrated that there is no genuine issue of material fact that opposer has a "real interest" in the outcome of this proceeding and as a

Cuban entity, has established standing to pursue this opposition at the Board.

**III. Summary Judgment Under Article 7:**

In pertinent part, the relevant provision of Article 7 of the Pan American Convention reads as follows:

Any owner of a mark protected in one of the contracting states in accordance with its domestic law, who may know that some other person is using or applying to register or deposit an interfering mark in any other of the contracting states, shall have the right to oppose such use, registration or deposit and shall have the right to employ all legal means, procedure or recourse provided in the country in which such interfering mark is being used or where its registration or deposit is being sought, and upon proof that the person who is using such mark or applying to register or deposit it, had knowledge of the existence and continuous use in any of the Contracting States of the mark on which opposition is based upon goods in the same class, the opposer may claim for himself the preferential right to use such mark in the country where the opposition is made or priority to register or deposit in such country, upon compliance with the requirements established by the domestic legislation in such country and by this Convention.

Thus, in order for opposer to prevail under Article 7 of the Pan American Convention, it must establish that there is no genuine dispute (1) that opposer is the owner of a **CUBITA** mark protected in Cuba; (2) that applicant is using or applying to register an "interfering mark" in the

United States; (3) that applicant had knowledge of the existence and continuous use in Cuba of opposer's **CUBITA** mark in connection with goods in the same class prior to its use of the **CUBITA** mark in the United States; and (4) that opposer has complied with the requirements set forth in the domestic legislation in the United States and the requirements of the Pan American Convention -- that is, filing for protection of its mark under Section 44 of the Lanham Act. Notably, opposer sets forth the factual support for these elements on pages 2-13 of its motion for summary judgment under the caption "Statement of Undisputed Material Facts." As discussed below, applicant specifically "affirms" that these facts are undisputed (Appl's Brief, pp. 2-3).

Given the material facts which are not in dispute and the evidence submitted by opposer in its motion for summary judgment, as a well as applicant's failure to submit any evidence which would raise a genuine issue of material fact, the Board finds that opposer has satisfied the requisite elements of Article 7 of the Pan American Convention. Per the following discussion, opposer is therefore entitled to judgment as a matter of law.

***A. Opposer's Ownership of a Foreign Protected Mark***

First, opposer has demonstrated that there is no genuine issue of material fact that opposer is the owner of a mark containing the term **CUBITA** and that the mark, currently in use in Cuba, has been registered and renewed in accordance with Cuban law. As proof, opposer has made of record a copy of a valid and subsisting Cuban registration for its mark for use in connection with "roasted coffee."<sup>3</sup> As such, opposer's ownership of a mark protected in a contracting state to the Pan American Convention, in this instance Cuba, is not at issue.

***B. That Applicant Is Using or Applying to Register an "Interfering Mark" in the United States***

The evidence of record also establishes that there is no genuine issue of material fact that applicant has applied to register an "interfering mark" in the United States. Indeed, opposer has submitted records to show that opposer filed an application to register its **CUBITA** mark for "roasted coffee" in International Class 30 in the U.S. Patent and Trademark Office and that applicant's prior

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<sup>3</sup> Along with the declaration of David B. Goldstein, opposer attached a "true and correct copy" of a registration renewal certificate for its **CUBITA** mark, issued by the General Director of the Cuban Office of Industrial Property. According to the certificate, the mark was registered to Kave Coffee, S.A., and the registration renewal was subsequently issued in opposer's name at Resolution No. 1966/2002 in Cuba, with the renewal effective until September 4, 2011.

pending application for **CUBITA** for "coffee" in International Class 30 was cited as a potential bar to registration of opposer's mark; and that opposer's application has been suspended pending the outcome of the instant opposition against applicant's involved application. Moreover, it is undisputed that the respective marks prominently display the identical term "**CUBITA**" in the same stylized lettering, set against virtually the same background design of horizontal lines, and applicant does not dispute that its mark has "interfered" with the registration of opposer's mark in the United States. Thus, there is no genuine issue of material fact that applicant's mark constitutes an "interfering mark" under Article 7 of the Pan American Convention. See, e.g., *Diaz*, 83 USPQ2d at 1329.

***C. Applicant's Knowledge of the Existence and Continuous Use in Cuba of the Mark in Connection with Goods in the Same Class Prior to Applicant's Use in the United States***

In the Board's view, opposer has also established that there is no genuine issue that applicant had knowledge of the existence and continuous use in Cuba by opposer of its **CUBITA** mark in connection with "roasted coffee" prior to applicant's use of its **CUBITA** mark in the United States for "coffee." For example, as stated in the declaration of applicant's attorney, Mr. Reynol Sampedro Vazquez, as well

as a November 23, 1998 letter from applicant's attorney at the time, Mr. Jesus Sanchelima, applicant was aware that opposer's **CUBITA** mark had been used to identify coffee in Cuba prior to applicant's first use of its mark; that efforts had been made by applicant's predecessor-in-interest to obtain the right to "market various coffee brands, some for ethnic markets (Cuban, Haiti, etc.)" such as **CUBITA** in the United States; and that applicant was aware of "discussions" about such matters between Kave Coffee, S.A., the original owner of opposer's mark, and Miguel Angel, one of the individuals from whom applicant purportedly purchased the right to use its **CUBITA** mark in the United States in 1999. Moreover, in response to opposer's motion for summary judgment and in its cross-motion for summary judgment, applicant conceded these facts and confirmed for the record that it indeed had knowledge of the existence and continuous use of **CUBITA** in Cuba by opposer and opposer's predecessor-in-interest, Kave Coffee, S.A.

***D. Opposer's Compliance with U.S. Domestic Legislation***

Furthermore, in submitting its application for registration with the U.S. Patent and Trademark Office and filing for protection under Section 44(e) of the Lanham Act, opposer has complied with the domestic, statutory

filing requirements of the United States and as a result, has satisfied this element. In further support, opposer submitted the declaration of Juan Antonio Gonzalez Alvarez, "Head of the Cubita Coffee Department of Corporacion Cimex, S.A.," wherein he stated that opposer "intends and expects to use in commerce in the United States its Cubita-marked Cuban origin coffee as soon as U.S. law permits." As applicant has also conceded this fact, the Board finds no genuine issues of material fact that opposer satisfied the requirements set forth in Section 44(e), namely that opposer has a bona fide intent to use its mark in commerce.

As we noted earlier, applicant, has expressly conceded the majority of opposer's "undisputed material facts" enumerated in opposer's motion for summary judgment.

(App's Brief, pp. 2-3.) In particular, applicant "affirms" that "all facts" listed therein were true with respect to the requisite elements of priority under Article 7 of the Pan American Convention "with the exception and/or addition of the following facts": 1) that applicant filed its application with the U.S. Patent and Trademark Office in 1999; 2) that applicant's use of the **CUBITA** mark began in 1999; 3) that the Board previously considered the issue of misdescriptiveness and held that applicant's mark was not misdescriptive in another proceeding; 4) that applicant did

not intend to "feed off" of opposer's good will; and 5) that any implication that applicant knew or participated in a "scam" concerning the **CUBITA** mark is not accurate.

However, none of these facts is material to the specific claim presented by opposer under Article 7 of the Pan American Convention in its motion for summary judgment. Therefore, consideration of any of them, even collectively, fails to generate a genuine issue of material fact for trial.

Continuing, the Board notes that applicant has failed to make any legal arguments against opposer's claim of priority under the Pan American Convention. Moreover, as in this case, when a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine issue of material fact and the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of at least one genuine issue of material facts that requires resolution at trial.

The nonmoving party, however, may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. Consequently, factual

assertions, without evidentiary support, are insufficient to defend against a motion for summary judgment. See *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987). Thus, even if the factual assertions of opposer that were argued by applicant to be in dispute were material to the issue of priority under Article 7 of the Pan American Convention which they are not, insofar as applicant has not offered evidentiary support for those assertions, it has failed to demonstrate the existence of any genuinely-disputed, material fact for trial.

**IV. Applicant's Unpleaded Defenses**

With respect to applicant's assertion of a genuine issue of material fact on the unpleaded defenses of acquiescence and abandonment, since a party may not obtain or defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to unpleaded defenses, applicant's assertion of abandonment and acquiescence, now raised for the first time in its motion for summary judgment, are untimely and will be given no further consideration in this proceeding. See *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1477 (TTAB 1992).

We also note that the availability of the defense of acquiescence is severely limited in opposition proceedings

because this defense, in Board proceedings, starts to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use and that the involved application was not published for opposition until April 17, 2007. See *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005). See also *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Viewing all doubt and inferences in a light most favorable to applicant, we conclude that there are no genuine issue of material fact with respect to opposer's standing as well as opposer's priority over applicant to register its mark under Article 7 of the Pan American Convention for "roasted coffee" in International Class 30. Opposer, on that basis alone, is therefore entitled to judgment as a matter of law. Accordingly, opposer's motion for summary judgment is granted, and applicant's cross-motion for summary judgment is denied.

Nevertheless, while opposer pleaded other grounds for opposition in its notice of opposition, it moved for summary judgment on only one basis. Opposer, therefore, is allowed **thirty (30) days** from the mailing date of this

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order to advise the Board whether it wishes to go forward on its other pleaded grounds for opposition, failing which the opposition will be sustained pursuant to Article 7 of the Pan American Convention only, registration to applicant of application Serial No. 75697908 will be refused, and the opposition will be dismissed without prejudice as to the remaining issues.