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Filing date: **01/11/2016**

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

Proceeding	91224990
Party	Plaintiff Scandinavian Tobacco Group Eersel B.V. and General Cigar Co. Inc.
Correspondence Address	JANET F SATTERTHWAITE POTOMAC LAW GROUP 1300 PENNSYLVANIA AVENUE NW SUITE 700 WASHINGTON, DC 20004 UNITED STATES tm@potomaclaw.com, jsatterthwaite@potomaclaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Janet F. Satterthwaite
Filer's e-mail	jsatterthwaite@potomaclaw.com, tm@potomaclaw.com, ereese@potomaclaw.com
Signature	/Janet F. Satterthwaite/
Date	01/11/2016
Attachments	FAOPP.pdf(106143 bytes)

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

In re Serial No. 86602243
to register: INSPIRADA
Filed: April 19, 2015
Published: September 22, 2015

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GENERAL CIGAR COMPANY,	:	
INC. and	:	
	:	
SCANDINAVIAN TOBACCO	:	
GROUP EERSEL, BV,	:	
	:	Opposition No. 91224990
Opposers,	:	
	:	
v.	:	
	:	
DAVID CASTRO,	:	
	:	
Applicant.	:	
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FIRST AMENDED NOTICE OF OPPOSITION

General Cigar Company Inc. (“GCC”) is a corporation organized and existing under the laws of Delaware, with an address of 10900 Nuckols Road, Suite 100 Glen Allen Virginia 23060, and Scandinavian Tobacco group Eersel BV (“STGBV”) is a Corporation organized and existing under the law of the Netherlands with an address at Nieuwstraat 75, 5521 CB Eersel, Netherlands. (Collectively, “Opposers,”) hereby oppose registration of the captioned application.

For the reasons set forth below, Opposers will be damaged by Registration of Serial No. for the 86602243 mark INSPIRADA owned by David Castro.

Opposers’ grounds for opposition are as follows:

A. Priority

1. Opposer STGBV owns the mark MACANUDO INSPIRADO for cigars in numerous countries.
2. GCC owns the mark MACANUDO in the United States, including, *inter alia*, Reg. No. 4018450.
3. GCC and STGBCV are sister companies with the common Parent Scandinavian Tobacco Group A/S (“STG”).
4. GCC is STG’s flagship subsidiary in the United States with respect to marketing and distribution of cigars.
5. Opposers intend for GCC to be the owner of the mark MACANUDO INSPIRADO in the United States.
6. GCC is the owner of Application Serial No. 86827304 for MACANUDO INSPIRADA for “cigars” in the United States.
7. Prior to Applicant’s filing date of April 19, 2015, Opposers took steps preparatory to use in commerce extending the brand MACANUDO INSPIRADO into the United States market by introducing the brand at cigar events.
8. For example, GCC prominently displayed MACANUDO INSPIRADO cigars as a “soon to be released” product at a 2014 trade show in Las Vegas, Nevada, the large annual trade show of the International Premium Cigar & Pipe Retailers (“IPCPR”). MACANUDO INSPIRADO was also displayed at a cigar event in Nashville, TN, prior to Applicant’s filing date in April 2015.
9. Prior to Applicant’s filing date of April 19, 2015, Opposers’ MACANUDO INSPIRADO brand had a reputation in the United States among cigar consumers and professionals in the industry.

Bad Faith

10. Upon information and belief, Applicant is a principal of Davidus Cigars.
11. Davidus Cigars is a cigar retailer and smoking lounge in Maryland.
12. Davidus Cigars is a customer of GCC, purchasing and reselling GCC’s cigars; for example, in 2014 and 2015 Davidus cigars regularly purchased approximately ten thousand dollars’ worth of cigars from Opposers.
13. Opposers’ MACANUDO INSPIRADO brand is well known around the world among consumers of cigars.

14. The MACANUDO INSPIRADO brand is featured in cigar-industry publications such as Cigar Magazine, Cigar World, and halfwheel.com.

15. Upon information and belief, professionals in the cigar industry such as Applicant are familiar with these publications.

16. Upon information and belief, Applicant would have read about MACANUDO INSPIRADO in such publications.

17. Furthermore, according to the IPCPR website, Davidus Cigars is a member of IPCPR, the sponsor of the trade show where Opposers displayed the MACANUDO INSPIRADO brand in Las Vegas in 2014.

18. Opposers believe that Applicant filed the subject application in bad faith with intent to trade upon the reputation of MACANUDO INSPIRADO and to falsely suggest a connection to Opposers, or to create an opportunity to ransom the mark back to Opposers.

19. Since Opposer GCC already owns one or more registrations for MACANUDO in the United States, such as Reg. No. 4018450, Applicant could seize an opportunity only with respect to the latter portion of the MACANUDO INSPIRADO mark.

20. Subsequent to the filing of the Notice of Opposition, counsel for Applicant advised counsel for Opposers that his client had not done anything with the mark and would let it go abandoned. A few days later, however, *he demanded \$100,000* for a co-existence agreement.

21. Opposers will be damaged by registration of the INSPIRADA mark because it will pose a threat to their use and registration of their mark MACANUDO INSPIRADO in the United States.

False Connection

22. Because Opposers' mark is well known by the relevant consuming public, the subject mark falsely suggests a connection with Opposers, and registration is prohibited under Section 2(a) of the Lanham Act.

23. Applicant intended to cause such a false association by choosing a similar trademark.

24. Opposers will be further damaged because consumers familiar with the MACANUDO INSPIRADO brand will be confused as to whether there is an association or sponsorship by Opposers, under Section 2(d) of the Lanham Act.

Lack of *Bona Fide* Intent

25. Based on statements made by Counsel for Applicant subsequent to the filing of the Notice of Opposition that his client had little interest in the mark and/or had not done anything with the

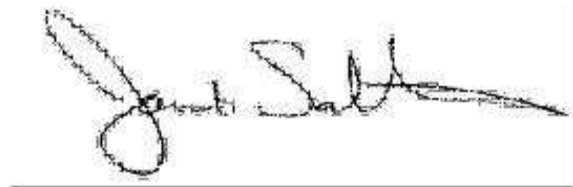
mark, upon information and belief, Applicant had no *bona fide* intent to use the INSPIRADA mark in commerce in the United States as of the time the Notice of Opposition was filed.

Therefore, Opposers respectfully request that the subject application be refused.

Petitioner appoints Janet F. Satterthwaite, Elissa Reese, and Bonny Plosker, along with the Potomac Law Group PLLC, to transact all business on its behalf in connection with this cancellation action.

Please conduct all correspondence with Janet F. Satterthwaite by email jsatterthwaite@potomaclaw.com, tm@potomaclaw.com and ereese@potomaclaw.com

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Janet Satterthwaite", written over a horizontal line.

Date: January 11, 2016

Janet F. Satterthwaite
Elissa Brockbank Reese

Attorneys for Opposers

Potomac Law Group
1300 Pennsylvania Ave NW
Suite 700
Washington, DC 20004
202-486-1578
jsatterthwaite@potomaclaw.com,
tm@potomaclaw.com,
ereese@potomaclaw.com

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v.	:	
	:	
DAVID CASTRO,	:	
	:	
Applicant.	:	
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CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing First Amended Notice of Opposition to be served by email, per agreement this 11th day of January, 2016 on counsel for Applicant:

David Greber
75-E Thomas Johnson Drive
Frederick, MD 21702
dsgreber@gblaw.us
cldattilio@gblaw.us



Janet F. Satterthwaite