

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: August 4, 2017

Opposition No. 91230351

CF Dominicana Cigars, Inc.

v.

Cigar Bella

By the Board:

On June 27, 2017, Applicant filed a motion for summary judgment in which it stated that Opposer CF Dominicana Cigars, Inc. (“CF Dominicana”) had filed a complaint against Applicant’s principal in the District Court of Nevada (the “civil action”). On June 30, 2017, the Board ordered CF Dominicana to provide the Board, within fifteen days, the status of the civil action as well as a copy of the operative complaint and answer in the civil action so that the Board could determine whether suspension of this case pending disposition of that civil action would be appropriate.

On July 10, 2017, the United States Patent and Trademark Office (“USPTO”) received a **paper** submission from CF Dominicana containing its response to the Board’s June 30th order, including a copy of the operative complaint in the civil action, as well as what appears to be its response to Applicant’s motion for summary judgment. *See* 19 TTABVUE. However, CF Dominicana’s submission was not properly filed inasmuch as it was not submitted by means of the Electronic System

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for Trademark Trials and Appeals (“ESTTA”), as required by Trademark Rules 2.126(a) and 2.191. Nor did the submission include a “*written* explanation of [the] technical problems or extraordinary circumstances” that necessitated the paper submission, as required for a paper submission by Trademark Rule 2.126(b). Further, CF Dominicana’s submission also fails to include proof of service of a copy of the submission upon Applicant, as required by Trademark Rule 2.119(a) (“[p]roof of such service must be made before the submission will be considered by the Office”). Accordingly, CF Dominicana’s July 10, 2017, filing cannot receive any consideration. The Board, however, does note, *sua sponte*, the complaint in the civil action and has determined that the civil action does not have a bearing on this proceeding, inasmuch as it does not involve the subject application or the mark appearing therein. *See* Trademark Rule 2.117(a). Nor does CF Dominicana’s submission indicate that the civil action challenges the validity of Reg. Nos. 4710849 and 4637190, and Serial No. 86465049, or use of the marks appearing therein. Accordingly, this proceeding will not be suspended in light of the civil action, but will move forward as discussed below.

Standing

Addressing the matters discussed above has necessitated the Board’s review of the Notice of Opposition. In doing so, the Board notes, *sua sponte*, an issue with the Notice of Opposition to be resolved before moving forward in this case. On June 28, 2016, the Board received CF Dominicana’s first ninety-day request for an extension of time to oppose the subject application, for good cause, and granted the request on June 29, 2016. On September 28, 2016, CF Dominicana timely filed a notice of

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opposition, alleging a likelihood of confusion on the basis of Reg. Nos. 4710849 and 4637190, and Serial No. 86465049. The notice of opposition, however, lists both CF Dominicana and Royal Flush Events, Inc. (“Royal Flush”) as plaintiff. Inasmuch as Royal Flush did not timely file an extension of time or otherwise indicate that it is in privity with CF Dominicana, Royal Flush is not a party to this proceeding. *See* Trademark Rule 2.102(b); TBMP §§ 206.01, 303.05 (an opposition filed during an extension of time to oppose ordinarily must be filed **in the name of the party to which the extension was granted**) (June 2017) (emphasis added).¹

CF Dominicana apparently bases its standing to bring this opposition on its alleged ownership rights in Reg. Nos. 4710849 and 4637190, and Serial No. 86465049 and in the marks thereof. However, Royal Flush, not CF Dominicana, is listed on the registrations and application and in the U.S. Patent and Trademark Office records as the owner of the asserted registrations and application.² Therefore, the Notice of Opposition does not clearly explain, or provide evidence to establish, why CF

¹ Moreover, while two or more parties **in a privity relationship** may file a notice of opposition jointly, the required fee must be submitted for *each party joined as opposer* for each class in the application for which registration is opposed. Trademark Rule 2.101. The USPTO’s fee records indicate that on September 28, 2016, the filing date of this opposition, a total of \$300 was received as a filing fee. The fee for an opposition at that time was \$300 per class, per opposer; therefore Opposer’s payment was sufficient payment for only one opposer and, for this reason as well, Royal Flush is not a party to this proceeding. *Id.*; *see also Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009). The fee for each opposer must be submitted at the time of filing of the notice of opposition, and cannot be supplied for any opposer thereafter. In other words, if a fee is not paid for an entity at the time of filing the notice of opposition, it cannot be supplied thereafter and applied retroactively to the earlier filed notice of opposition.

² Although CF Dominicana also alleges ownership and use of the marks appearing in Reg. Nos. 4710849 and 4637190 (*see* 1 TTABVUE 5, ¶¶4-5), this assertion also appears to conflict with the registrations on their face, which specifically list Royal Flush as owner.

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Dominica rather than Royal Flush can be considered the owner of the registrations, application or marks cited in the Notice of Opposition. Nor does the notice of opposition explain, or provide evidence to establish, that CF Dominicana is in privity with the owner of record, Royal Flush.³ Even under the Board's liberal standing rules, a party cannot allege standing for a likelihood of confusion ground by asserting the rights of unrelated third parties. *See Colony Foods, Inc. v. Sagemark, Ltd.* 735 F.2d 1336, 222 USPQ 185, 187 (Fed. Cir. 1984).

Because CF Dominicana has not properly pleaded its standing to bring this proceeding, CF Dominicana is allowed **twenty days** from the mailing date of this order to file and serve an amended notice of opposition that clearly sets forth CF Dominicana's own real interest in the proceeding, independent of the interest of Royal Flush as the owner of the pleaded registrations and application, and a reasonable basis for the belief that it will be damaged by the issuance of a registration, failing which, this proceeding will be dismissed with prejudice. CF Dominicana is also allowed **twenty-seven days** from the mailing date of this order to properly file and serve a response to Applicant's motion for summary judgment, failing which

³ It is not sufficient that two separate legal entities have common shareholders or a common interest in an opposition to establish a privity relationship. Such a relationship may be established by successive ownership interest in pleaded registrations, or by a showing that one party owns and controls the operations of the other, for example that the named opposer owns and controls the operations of the owner of pleaded registrations. See authorities collected in TBMP § 303.05(b).

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Applicant's motion will be granted as conceded and this proceeding will be dismissed with prejudice.⁴ *See* Trademark Rule 2.127(a).

Business to be Conducted with Decorum and Courtesy; No Further Phone Calls

On February 24, 2017, Dennis Briganti notified the Board that, as president of Opposer CF Dominicana, he is representing the Opposer in these proceedings. Proceeding pro se is not recommended and CF Dominicana will have to comply with all applicable rules and case law regardless of whether it has counsel. Opposer should reconsider the wisdom of attempting to carry the burden of a plaintiff in this proceeding without the assistance of counsel.

Inasmuch as decisions of the Board are based exclusively on the written record before it, all business with the Board should be transacted in writing unless the Board orders otherwise. Trademark Rule 2.191. Moreover, all parties to proceedings before the Board, whether represented by counsel or not, are required to conduct their business with decorum and courtesy. Trademark Rule 2.192. Mr. Briganti's repeated abusive telephone calls to Board attorneys and clerical personnel have been conducted with precisely the opposite of decorum and courtesy. In addition, Mr. Briganti's repeated *ex parte* telephone calls to Board attorneys attempting to discuss the merits of this case also are in contravention of Patent and Trademark Rule 11.305(b). *See* TBMP § 105. **Such telephone calls must stop.** Accordingly, unless expressly permitted otherwise by the Board in writing and in advance, Mr. Briganti is ordered to refrain from any further attempt to communicate with any

⁴ As noted above, submissions must be made to the Board via ESTTA: <http://estta.uspto.gov/>. Trademark Rule 2.126.

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Board personnel by any means other than electronic filings through ESTTA for the remainder of the pendency of these proceedings. **Any further attempt by Mr. Briganti to communicate in any other manner with any Board personnel during the pendency of these proceedings may result in entry of sanctions, including dismissal of the notice of opposition.** See TBMP § 527.03.

Proceedings otherwise remain **suspended**.

Recent Rules Change

CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE BECAME EFFECTIVE JANUARY 14, 2017

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, at 81 Fed. Reg. 69950. It sets forth several amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website:
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- A chart summarizing the affected rules and changes:
<http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf>

For all proceedings, including those already in progress on January 14, 2017, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190, and 2.191.

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- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123, and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.

This is only a summary of the significant content of the Final Rule. All parties involved in a Board proceeding should read the entire Final Rule.