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

Proceeding	91233591
Party	Plaintiff Bacardi & Company Limited and Bacardi USA, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	05/25/2017
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**IN THE MATTER OF TRADEMARK APPLICATION
SERIAL NO. 87/084,544 PUBLISHED IN THE
OFFICIAL GAZETTE ON NOVEMBER 22, 2016**

MARK: HAVANA REAL

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BACARDI & COMPANY LIMITED	:	
and BACARDI U.S.A., INC.	:	
	:	
Opposers,	:	
	:	
v.	:	OPPOSITION NO. 91233591
	:	
HAVANA CLUB HOLDING, S.A.	:	
	:	
Applicant.	:	
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AMENDED NOTICE OF OPPOSITION

BACARDI & COMPANY LIMITED, a Liechtenstein corporation, with a place of business at 267 Route de Meyrin, 1217 Meyrin, Switzerland ("BACO") and BACARDI U.S.A., INC., a Delaware corporation with a place of business at 2701 Le Jeune Road, Coral Gables, Florida 33134 ("BUSA") (collectively "Opposers" or "Bacardi") believe that they will be damaged by the registration of the mark HAVANA REAL for "Cuban rum" in International Class 33 covered by the above-identified application (the "Application") and hereby oppose the same.

The grounds for opposition are as follows:

1. Opposer BACO, through its affiliates, licensees, and distributors, produces and markets distilled spirits worldwide. BACO is the owner in the United States and worldwide of the renowned name and mark BACARDI, together with the registrations of that name and mark and the related business and goodwill, including for a wide variety of alcoholic beverages (including

rum) and related goods and services. BACO is also the owner in the United States of the trademark HAVANA CLUB for rum.

2. Jose Arechabala S.A. (“JASA”) was a *sociedad anónima* organized and existing under the laws of the Republic of Cuba. JASA’s headquarters and principal place of business were in Cárdenas, Cuba, until its assets in Cuba were confiscated by the Cuban government in 1960. Thereafter, JASA’s principal place of business was in Vaduz, Principality of Liechtenstein. JASA was the creator and the original owner of the HAVANA CLUB trademark in Cuba, the United States, and other countries, and the trademark registrations associated therewith. JASA was owned substantially by members of the Arechabala family. In 1997, JASA went through the process of voluntary corporate liquidation, by decision of its shareholders, who have formed a substantially mirror-image company, Jose Arechabala International Ltd., to carry on the family’s business.

3. Jose Arechabala International Ltd. (“JAI”) is a joint-stock company organized and existing under the laws of the Principality of Liechtenstein, having its principal place of business in Vaduz, Liechtenstein. JAI is owned substantially by the same persons who were shareholders of JASA.

4. JASA conveyed to JAI all right, title, and interest in and to the HAVANA CLUB trademark worldwide and certain associated assets and goodwill, including the secret family formula for the HAVANA CLUB rum (the “HAVANA CLUB Assets”). At the same time, persons comprising substantially all of the shareholders and holders of undivided equity interests in JASA conveyed to JAI any and all right, title, and interest that each of them might hold in and to the HAVANA CLUB Assets. JAI in turn sold to BACO all right, title, and interest in and to the HAVANA CLUB Assets worldwide (including the United States), including the secret family formula for the HAVANA CLUB rum. BACO is accordingly the successor in interest to the

original owners of the HAVANA CLUB trademark and the other HAVANA CLUB Assets worldwide.

5. Opposer BUSA is a related company of BACO, and is now and has for many years, promoted, distributed and sold rum in the United States under the trademark HAVANA CLUB, pursuant to the authorization and quality control of BACO.

6. Bacardi is currently using the mark HAVANA CLUB for the promotion, sale and/or distribution of rum in the United States. Bacardi and its predecessors in interest have used the mark HAVANA CLUB for the promotion, sale and/or distribution of rum in the United States for many years.

7. Bacardi and its predecessors in interest adopted and used the mark HAVANA CLUB for the promotion, sale and/or distribution of rum in United States in interstate commerce long prior to the priority date claimed in the Application.

8. Bacardi has used and is using the HAVANA CLUB mark on products, package materials, advertisements, and product literature for rum that is promoted, sold and distributed in U.S. interstate commerce by BUSA. The HAVANA CLUB mark has come to be and is famous and of great value to Bacardi. The relevant trade and public identifies the HAVANA CLUB mark with Bacardi's goods and distinguishes them from the goods and services of others.

9. BACO owns the exclusive right at common law in the HAVANA CLUB trademark for rum in the United States, together with all of the business and goodwill symbolized thereby and associated therewith.

10. As a result of long standing use and extensive advertising and promotion of rum in connection with the HAVANA CLUB mark in the United States by Bacardi and its predecessors in interest, and the excellence of the product itself, Bacardi's HAVANA CLUB mark has attained

an enviable reputation and goodwill that is exclusively associated with Bacardi by the consuming public, signifying goods of the highest quality. As a result, Bacardi's HAVANA CLUB mark and the goodwill symbolized by this mark are of inestimable value to Bacardi.

11. Applicant seeks to register the HAVANA REAL mark for goods that are identical or closely related to Bacardi's HAVANA CLUB branded rum product.

12. Upon information and belief, Applicant has not commenced use of the mark HAVANA REAL in U.S. interstate commerce.

13. Applicant filed the Application on the basis of Section 1(b) and Section 44(d) on June 27, 2016 and asserted a claim of priority based on Benelux application number 1334355, filed on June 15, 2016. The Application was amended on October 15, 2016 to assert a basis under Section 44(e). The Application was published in the November 22, 2016 issue of the Official Gazette.

14. On December 22, 2016, the Board granted BACO an extension of time to oppose the Application, until March 22, 2017. BUSA is a related company of BACO and is and has been promoting, distributing and selling products bearing the HAVANA CLUB mark in the United States under the authority and quality control of BACO. Therefore, BUSA is in privity with BACO and may take advantage of the extension of time to oppose the Application that was granted to BACO.

15. Bacardi's first use of its HAVANA CLUB mark in the United States is long prior to the priority claimed in the Application.

16. HAVANA REAL is confusingly similar in appearance, sound and meaning to Bacardi's HAVANA CLUB trademark. Applicant proposes to use and register the HAVANA REAL mark in connection with goods that are identical or closely related to the goods for which

Bacardi uses the HAVANA CLUB mark. Upon information and belief, Applicant's products will be marketed through the same or similar channels of trade as Bacardi's products.

17. Given the close resemblance, meaning and commercial impression of the HAVANA REAL mark to Bacardi's HAVANA CLUB mark, the use of the HAVANA REAL mark in connection with the advertising, offering for sale and sale of identical or closely related goods is likely to cause confusion or to cause mistake, or to deceive actual or potential purchasers into believing that Applicant's goods originate with or are in some way sponsored, licensed, approved or otherwise authorized or connected with Bacardi.

18. Applicant's registration and use of the HAVANA REAL mark is also likely to dilute Bacardi's famous HAVANA CLUB mark as a source designation for Bacardi's goods.

19. The HAVANA CLUB mark was used in the United States by Bacardi and its predecessors in interest, and acquired fame in the marketplace, long before the priority date claimed in the Application.

20. Bacardi will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's purported trademark and would give to Applicant color of exclusive statutory rights to such designation in violation and derogation of the prior and superior rights of Bacardi. Any faults or defects which might be found in Applicant's goods would reflect adversely upon and seriously injure the valuable reputation and goodwill of Bacardi.

21. By reason of the foregoing, Bacardi will be damaged by the registration of the HAVANA REAL mark.

WHEREFORE, Opposers believe they would be damaged by registration of Applicant's mark and pray that this opposition be sustained and registration of the mark HAVANA REAL be denied.

Dated: May 25, 2017
New York, New York

Respectfully submitted,

KELLEY DRYE & WARREN LLP
Attorneys for Opposers

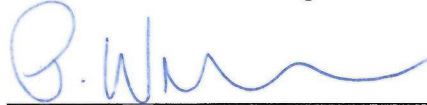


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CERTIFICATE OF SERVICE

I, Patricia L. Werner, am an attorney at Kelley Drye & Warren LLP, attorneys for Opposers BACARDI & COMPANY LIMITED and BACARDI U.S.A., INC., and hereby affirm under the penalties of perjury, that on May 25, 2017, I caused a true and correct copy of the foregoing Notice of Opposition to be served by email upon counsel of record for Havana Club Holding, S.A. at the following address of record:

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