

ESTTA Tracking number: **ESTTA1250690**

Filing date: **11/29/2022**

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

Proceeding no.	91281307
Party	Defendant Tabacalera Palma, Ltd.
Correspondence address	FRANK HERRERA H NEW MEDIA LAW 113 SOUTH MONROE STREET, 1ST FLOOR TALLAHASSEE, FL 32301 UNITED STATES Primary email: fherrera@hnewmedia.com Secondary email(s): g.ruiz-arthur@hnewmedia.com, tmdocket@hnewmedia.com 561-861-6380
Submission	Answer and Counterclaim
Filer's name	Gustavo Sardina
Filer's email	g.sardina@hnewmedia.com
Signature	/Gustavo Sardina/
Date	11/29/2022
Attachments	88866282#TMSN.png( bytes ) Answer FINAL 11-29-22.pdf(539302 bytes )

Registration subject to the submission

Registration no.	5998883	Registration date	02/25/2020
Register	Supplemental		
Registrant	J.C. Newman Cigar Company 2701-03 SIXTEEN STREET TAMPA, FL 33605 UNITED STATES		

Goods/services subject to the submission

Class 034. First Use: May 31, 2019 First Use In Commerce: May 31, 2019  
All goods and services in the class are requested, namely: cigars

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 23(a) and 2(d)
--------------------------------------	---------------------------------------

Mark cited by petitioner as basis for cancellation

U.S. application no.	88866282	Application date	04/09/2020
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	AMERICAN STOGIES		

Design mark	<p data-bbox="483 289 1307 367">AMERICAN STOGIES</p>
Description of mark	NONE
Goods/services	Class 034. First use: First Use: Jun 11, 2001 First Use In Commerce: Jun 11, 2001 Cigars

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

J.C. Newman Cigar Company

Opposer,

v.

Tabacalera Palma, Ltd.

Opposition No. 91281307  
Opposition to Serial No. 88866282  
Cancellation of Registration No. 5998883

Applicant.

---

**ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM**

Applicant, Tabacalera Palma, Ltd. (“Tabacalera Palma” or “Applicant”), by and through undersigned counsel, hereby files this Answer and Affirmative Defenses to the Opposition against registration of Tabacalera Palma’s Trademark Application No. 88866282 for “AMERICAN STOGIES” filed by J.C. Newman Cigar Company (hereinafter “J.C. Newman”), and Counterclaims seeking cancellation of JC Newman’s Trademark Registration No. 5998883 for “THE AMERICAN” as follows:

**ANSWER**

1. Applicant lacks knowledge sufficient to form a belief about the truth of the allegations of paragraph 1 of the Notice of Opposition and therefore denies the same.
2. Applicant lacks knowledge sufficient to form a belief about the truth of the allegations of paragraph 2 of the Notice of Opposition and therefore denies the same.
3. Applicant lacks knowledge sufficient to form a belief about the truth of the allegations of paragraph 3 of the Notice of Opposition and therefore denies the same.
4. Admitted.
5. Admitted.

6. Admitted.
7. Admitted.
8. Admitted.
9. Admitted.
10. Admitted.

11. Applicant admits that the Board concluded as described but denies that the conclusions were correct as to the first and second prong. The Board's conclusion as to the first prong was contradictory on its face. Specifically, the Board said that:

We acknowledge that the dictionary definitions of record define 'AMERICAN' to include '[o]f, or pertaining to, or in North, Central or South America,' which encompasses the country of Nicaragua (the country of origin of Applicant's goods). That being said, we note that there is no evidence of record that relevant U.S. consumers would view the term 'AMERICAN,' when used as part of a trademark or source indicator of goods, to indicate that these goods originated in countries other than the United States.

The Board cannot have it both ways, 1) acknowledging the dictionary definitions that support Applicant's position as to the first prong (i.e. evidence including <https://www.merriam-webster.com/dictionary/American>), and 2) then claim that there is no evidence supporting Applicant's position. The Board also plainly erred when incorrectly saying that "the first or primary definitions of 'American' refer to the United States." Instead, the very first definition in the very exhibit offered by the Examiner in the record defined "American" as "an American Indian of North or South America." The second definition offered by the Examiner defined "American" as "a native or inhabitant of North or South America." See <https://www.merriam-webster.com/dictionary/American>. These first/primary definitions came from none other than Merriam-Webster Dictionary, the oldest dictionary company in the United States of America. See <https://en.wikipedia.org/wiki/Merriam-Webster>.

12. Admitted.

13. Denied.

14. Admitted in part. Specifically, Applicant admits that the primary significance of the word “American” is a generally known geographic location, namely, America (i.e. a landmass comprising the totality of North and South America including the Caribbean islands. See <https://en.wikipedia.org/wiki/Americas>).<sup>1</sup> Applicant further admits that “[t]here is no dispute that ‘American’ refers to people or things from ‘America,’ and that ‘America’ is a generally known geographic location” subject to the above definition of “America” as a landmass comprising the totality of North and South America including the Caribbean island. Id.

15. Admitted in part. Applicant admits that the addition of the disclaimed “STOGIES” portion of the mark does not alter the mark’s descriptiveness.

16. Denied.

17. Admitted.

18. Admitted.

19. Denied.

20. Denied.

21. Denied.

22. Denied.

23. Applicant admits that Applicant and Opposer are in the same industry. Applicant admits that Opposer owns a trademark registration for “THE AMERICAN” for use in connection

---

<sup>1</sup> Most people in the United States learned as children that “Columbus discovered America in 1492”. Applicant takes no issue with this. Applicant simply reminds the Board and Opposer that Columbus’s discovery of America occurred in the Bahamas, and not anywhere that is today part of the United States *of* America. See <https://en.wikipedia.org/wiki/Guanahani>. That is, of course, because “America” is not limited to the United States *of* America. Rather, the United States *of* America is part of and included in America, as are all of the countries and territories running from Canada to Chile.

with cigars. Applicant lacks knowledge sufficient to form a belief about the truth of the remaining allegations of paragraph 23 of the Notice of Opposition and therefore denies the same.

24. Admitted. However, and as described in the Counterclaims below, Opposer's "THE AMERICAN" trademark is not entitled to trademark protection and registration thereof should be cancelled.

25. Denied.

26. Denied.

### **AFFIRMATIVE DEFENSES**

1. Opposer fails to state a claim upon which relief can be granted.
2. Opposer lacks standing to pursue the opposition and/or has failed to plead a basis for standing.

### **COUNTERCLAIMS**

1. Tabacalera Palma and/or its predecessor(s) in interest including Anncas Inc. have continuously used the trademark "AMERICAN STOGIES" in connection with cigars since 2001.

2. Through its long and continuous use of the "AMERICAN STOGIES" trademark, Tabacalera Palma has acquired considerable goodwill and the mark has acquired secondary meaning such that consumers of cigars identify "AMERICAN STOGIES" as a source indicator of high-quality cigars originating with Tabacalera Palma.

3. As such, Tabacalera Palam filed *United States* Trademark Application No. 88866282 for "AMERICAN STOGIES" for use in connection with cigars in class 34. The application matured to publication on September 20, 2022.

4. J.C. Newman opposed registration of Tabacalera Palma's "AMERICAN STOGIES" mark on October 20, 2022.

5. J.C. Newman owns *United States* Trademark Registration No. 5998883 on the Supplemental Register for “THE AMERICAN” for use in connection with cigars.

6. J.C. Newman has asserted its rights in the “THE AMERICAN” trademark as the basis, at least in part, of its opposition to registration of Tabacalera Palma’s “AMERICAN STOGIES” trademark.

7. However, Tabacalera Palma’s use of its “AMERICAN STOGIES” mark long predates J.C. Newman’s use of “THE AMERICAN”.

8. Tabacalera Palma and J.C. Newman’s respective “AMERICAN STOGIES” and “THE AMERICAN” mark are confusingly similar in that both marks share the same dominant element (i.e. “AMERICAN”), the goods offered under the respective marks are the same (i.e. cigars), the consumers of the parties respective goods are the same (i.e. cigar smokers), and the channels of trade of the parties respective goods are the same.

9. During a recent episode of the Cigar Authority, a leading podcast and vodcast in the cigar industry, J.C. Newman’s President, Eric Newman, was a participant, and the host brought up Tabacalera Palma’s trademark application to register “AMERICAN STOGIES” and Tabacalera Palma’s successful appeal of the Examiner’s refusal to register the same. During the conversation, a producer off camera was heard asking “isn’t Nicaragua in Central America” to which the hosts responded “[host 1] he makes a good point, central America. [host 2] ah...Central America, it’s still America.” See <https://thecigarauthority.com/vodcast-the-cigars-that-built-america-with-eric-newman/> beginning at about 43:40. The hosts then turned to Mr. Newman and asked whether J.C. Newman had any issues getting “THE AMERICAN” registered and Mr. Newman incorrectly stated “no.” *Id.* at about 44:45. Of course, J.C. Newman did have difficulty registering “THE AMERICAN”. The application was refused registration on the Principal Register and after an

unsuccessful response in opposition to the Office Action, J.C. Newman retreated to the Supplemental Register.

10. The above-described interview is a clear example of commonality of promotion of Tabacalera Palma and J.C. Newman’s respective “AMERICAN STOGIES” and “THE AMERICAN” cigars. Such close proximity of such similar marks in connection with identical goods is likely to create consumer confusion.

11. Because Tabacalera Palma has prior use and superior trademark rights in and to its “AMERICAN STOGIES” mark, and because the parties’ respective marks are likely to be confused, continued registration of *United States* Trademark Registration No. 5998883 on the Supplemental Register for “THE AMERICAN” for use in connection with cigars is likely to harm Tabacalera Palma.

WHEREFORE, and based on the above, Tabacalera Palma asks that *United States* Trademark Registration No. 5998883 on the Supplemental Register for “THE AMERICAN” for use in connection with cigars be cancelled.

Dated: November 29, 2022

Respectfully submitted,

By: s/GUSTAVO SARDIÑA  
Frank Herrera, Esq.  
Florida Bar No. 494801  
[fherrera@hnewmedia.com](mailto:fherrera@hnewmedia.com)  
Gustavo Sardiña, Esq.  
Florida Bar No. 31162  
[g.sardina@hnewmedia.com](mailto:g.sardina@hnewmedia.com)  
H NEW MEDIA LAW  
1110 Brickell Avenue, Suite 506  
Miami, Florida 33131  
Telephone: (561) 841-6380  
Facsimile: (561) 421-0453



**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing has been served on:

Sarah P. Harrell, Esq.

[sharrell@btlaw.com](mailto:sharrell@btlaw.com)

Michelle M. Mikol, Esq.

[mmikol@btlaw.com](mailto:mmikol@btlaw.com)

BARNES & THORBURG LLP

11 S. MERIDIAN ST.

INDIANAPOLIS, IN 46204

[tmindocket@btlaw.com](mailto:tmindocket@btlaw.com)

[sherry.martin@btlaw.com](mailto:sherry.martin@btlaw.com)

by email on November 29, 2022

By: s/GUSTAVO SARDIÑA  
Gustavo Sardiña