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Filing date: **06/17/2010**

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

Proceeding	92051672
Party	Plaintiff Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d.b.a Cubatabaco
Correspondence Address	DAVID B. GOLDSTEIN RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN 111 BROADWAY, SUITE 1102 NEW YORK, NY 10006-1901 UNITED STATES dgoldstein@rbskl.com
Submission	Opposition/Response to Motion
Filer's Name	David B. Goldstein
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Signature	/David B. Goldstein/
Date	06/17/2010
Attachments	Havana Sunrise response susp.pdf ( 6 pages )(81991 bytes )

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

CORPORACION HABANOS, S.A., and EMPRESA	)	
CUBANA DEL TABACO, d.b.a. CUBATABACO,	)	
	)	
Petitioners,	)	
	)	
v.	)	Cancellation No. 92051672
	)	Registration No. 2,900,059
INTER AMERICA CIGAR COMPANY,	)	
	)	
Registrant.	)	
	)	

**PETITIONERS’ RESPONSE TO REGISTRANT’S MOTION TO SUSPEND PENDING  
DEPOSITION UPON WRITTEN QUESTIONS AND ORAL DEPOSITION IN FOREIGN  
COUNTRY**

Petitioners CORPORACION HABANOS, S.A. ("Habanos, S.A.") and EMPRESA CUBANA DEL TABACO ("Cubatabaco") (together "Petitioners") hereby file their Response to Registrant’s Motion To Suspend Pending Deposition Upon Written Questions And Oral Deposition In Foreign Country ("Registrant’s Motion to Suspend"). Petitioners agree with Registrant Inter America Cigar Company ("Registrant") that proceedings should be suspended (but for additional reasons and for a different order of consideration of outstanding matters than proposed by Registrant), and advised Registrant of its position, including that proceedings should be suspended, prior to Registrant filing the instant motion. *See* Exhibit A, annexed hereto. In support of this Response, Petitioners state as follows:

On June 11, 2010, Petitioners filed a Motion for Judgment on the Pleadings and to Suspend Proceedings [Dkt. No. 16 ("Motion for Judgment")], seeking judgment on Petitioners’ claim under section 2(e)(3) of the Act, 15 U.S.C. § 1052(e)(3). If granted, the Motion for Judgment will eliminate the need for Registrant’s proposed deposition on written questions of foreign residents in a foreign country, which, as Registrant concedes, is cumbersome, expensive

and time-consuming. Registrant's Motion at 1. Granting of the Motion for Judgment will also eliminate the anticipated motion practice over Registrant's noticing an oral deposition of Petitioner Cubatabaco in Havana, Cuba, to which Cubatabaco has objected. Further, granting the motion will obviate the extremely burdensome fishing expedition document requests that Registrant has served upon Petitioners, most of which have nothing to do with the issues in this case. Even if the Motion for Judgment is granted in part, that result will likely substantially narrow the issues for litigation, including discovery.

Therefore, in connection with their Motion for Judgment, Petitioners simultaneously moved to suspend all other proceedings pending resolution of their dispositive motion, including any obligation to respond to Registrant's proposed discovery, including the deposition on written questions, the oral deposition noticed for Havana, Cuba, and document requests.

In the Motion for Judgment, Petitioners explained the reasons for the motion to suspend, including the procedural history, with which the Interlocutory Attorney is fully familiar, and the legal basis for the suspension request, and showed good cause not to respond to Registrant's discovery requests. *See* Motion for Judgment, Point I (pp. 4-7); 37 C.F.R. §§ 2.117(b), 2.127(d); TBMP § 510.03. In addition, Petitioners noted that Registrant has agreed that all proceedings should be immediately suspended other than for the depositions, and so it has waived any objection to suspension of responding to document requests. Petitioners also showed that Registrant's Motion to Suspend was obvious bad faith, and futile, gamesmanship to attempt to prevent Petitioners from filing their dispositive Motion for Judgment, which had been specifically discussed with the Interlocutory Attorney during the parties' May 18, 2010 teleconference. *See* May 18, 2010 Order (Dkt. No. 13).

Rather than burden the Board with a repetition of those facts and arguments, Petitioners incorporate herein that discussion by reference.

### CONCLUSION

For the reasons stated herein, and on all the prior papers and proceedings had herein, all further proceedings in this matter should be suspended pending determination of Petitioners' dispositive Motion for Judgment on the Pleadings, including any obligation of Petitioners to respond to any outstanding discovery requests of Registrant, as the need for any such discovery will be eliminated upon granting of the Motion for Judgment on the Pleadings. In the event that the Motion for Judgment on the Pleadings is denied, the Board should reset the discovery schedule, including for responding to document requests and for the orderly taking of the deposition on written questions, and any objections or motions for protective order thereto.

Dated: June 17, 2010

By:           /David B. Goldstein/            
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KRINSKY & LIEBERMAN, P.C.  
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*Attorneys for Petitioners Corporacion Habanos,  
S.A. and Empresa Cubana del Tabaco*

**CERTIFICATE OF SERVICE**

The undersigned certifies that a true and correct copy of the foregoing Petitioners' Response To Registrant's Motion To Suspend Pending Deposition Upon Written Questions And Oral Deposition In Foreign Country was served on Registrant by mailing, postage prepaid, said copy on June 17, 2010, via U.S. first-class mail, to:

Frank Herrera  
QUINTAIROS, PRIETO, WOOD & BOYER, P.A.  
9300 South Dadeland Boulevard, Fourth Floor  
Miami, Florida 33156  
*Attorneys for Registrant*

/David B. Goldstein/  
\_\_\_\_\_  
David B. Goldstein

## **EXHIBIT A**

## David Goldstein

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**From:** David Goldstein  
**Sent:** Thursday, June 03, 2010 2:16 PM  
**To:** 'Frank Herrera'  
**Subject:** RE: ESTTA. Other Motions/Papers confirmation receipt ID: ESTTA348118

Frank:

As I advised you and the Board's Interlocutory Attorney during the conference call, we intend to move to dismiss, which will suspend all proceedings. So I have no objection to an agreement to suspend proceedings other than for an orderly determination of that motion and, if that motion is denied, for an orderly process of discovery, including for a deposition on written questions.

David B. Goldstein  
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-----Original Message-----

**From:** Frank Herrera [mailto:fherrera@qpwbllaw.com]  
**Sent:** Wednesday, June 02, 2010 5:08 PM  
**To:** Frank Herrera; David Goldstein  
**Cc:** Suzanne M. Tatham  
**Subject:** RE: ESTTA. Other Motions/Papers confirmation receipt ID: ESTTA348118

David:

I have not heard back from you on your position regarding suspension. Please respond so that I can properly reflect that I conferred with you on the matter.

Frank Herrera  
Partner  
Intellectual Property and Internet Law  
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-----Original Message-----

**From:** Frank Herrera  
**Sent:** Tuesday, May 18, 2010 3:35 PM  
**To:** 'David Goldstein'  
**Cc:** Suzanne M. Tatham  
**Subject:** FW: ESTTA. Other Motions/Papers confirmation receipt ID: ESTTA348118

David:

See attached. Please let me know if you oppose a suspension of this action in order to allow for the orderly process of taking such deposition.

Frank Herrera