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

Proceeding	92052146
Party	Defendant Juan E. Rodriguez
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Attachments	ANSWER and AFF DEFENSES FINAL.pdf (11 pages)(150125 bytes)

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

In the Matter of Trademark Registration No. 3,542,236
Registered: December 2, 2008
Mark: PINAR DEL RIO

CORPORACION HABANOS, S.A., and)
EMPRESA CUBANA DEL TABACO,)
d/b/a CUBATABACO,)
)
Petitioners,)
)
v.)
)
JUAN E. RODRIGUEZ,)
Registrant.)
_____)

Cancellation No.: 92052146

REGISTRANT’S ANSWER AND AFFIRMATIVE DEFENSES

COMES NOW Juan E. Rodriguez (“Respondent”) and hereby files his Answer and Affirmative Defenses as follows:

1. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 1 and therefore denies same.
2. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 2 and therefore denies same.
3. Admitted.
4. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 4 and therefore denies same.
5. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 5 and therefore denies same.

6. Admitted that it appears that Petitioner Cubatabaco currently owns a federal trademark application Serial No. 77/157,193, but Respondent denies that the mark “certifies ‘that the cigars have their geographical origin in Cuba...’”. That application is pending and has received several Office Actions from the United States Patent and Trademark Office. At this time, the trademark application is suspended (see File History). The June 19, 2009 Office Action issued during the prosecution of that trademark is most telling. Namely, the Examiner stated:

Exercise of Legitimate Control Over Use of the Certification Mark

The application states that the applicant intends to exercise legitimate control over the use of the certification mark in commerce on or in connection with the goods. However, the existence of five (5) current U.S. Registrations for alcoholic beverages that include the proposed mark raises some doubt as to the existence of the applicant’s control over use of the mark.

Therefore, the applicant must provide additional information for the record regarding how it exercises control over the use of the mark. The explanation should include a detailed disclosure of all relevant facts, and be supported by documentation, where appropriate. 37 C.F.R. §2.61(b); TMEP 1306.06(g)(iii). The examining attorney will reconsider the above refusals and potential refusals to register if the applicant can show that they exercise legitimate control over the above stated registrations and potential registrations.

The applicant must also indicate whether all of the prior registrations and applications for cigars and tobacco that include the term HABANO or HABANOS in the mark are owned by authorized users of the applicant’s mark whose goods have been certified by the applicant as meeting the requirements of the certification standard included in this application. If the prior registrants are authorized users of the term HABANO or HABANOS in the United States but are not subject to the certification standards included in the application, the applicant must supplement the application with the certification standards that are actually applicable to the authorized users in the United States.

Trademark Rule 2.61(b) states, “The examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.” The Trademark Trial and Appeal Board has upheld a refusal of registration based on the applicant’s failure to provide information requested under this rule. *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990)(failure to submit patent information regarding configuration).

Pending proper response, registration is refused under Section 4 of the Trademark Act, 15 U.S.C. §1054, on the ground that applicant does not exercise legitimate control over the mark sought to be registered.

Again, in its January 22, 2010 Office Action, the Trademark Office renewed its objection that the mark does not operate as a “certification mark.” For instance, in issuing a Notice of Suspension the Trademark Office stated:

The following refusal(s)/requirement(s) is/are continued and maintained: The refusal to register the mark under Section 2(d) of the Trademark Act (as to all cited marks) and the requirement to show an Exercise of Legitimate Control over the use of Certification Mark. As for applicant’s statement that RN 2177837 is owned by an “authorized user” of the Applicant’s proposed certification mark, it is not clear if the mark has been certified by the applicant or if there is some other agreement in place.

Thus, the Trademark Office is well aware that “HABANOS” does not operate as a “certification mark” in the United States. As such, Petitioner’s allegation regarding same is misleading.

7. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 7 and therefore denies same.

8. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 8 and therefore denies same.

9. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 9 and therefore denies same.

10. The allegations contained in paragraph 10 do not require an admission or denial from the Respondent in so much as the allegations appear to be legal in nature. To the extent that a response is required, Respondent denies same. In any event, the existence of another case has absolutely no bearing on this instant case since the Board has a strong policy that all cases should be decided upon their own facts since

they involve “a different defendant, a different mark and/or different goods.” TTAB Order, p. 4, dated March 29, 2011 in Cancellation No. 92051672, Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d/b/a Cubatabaco v. Inter America Cigar Company.

11. The allegations contained in paragraph 10 do not require an admission or denial from the Respondent in so much as the allegations appear to be legal in nature. To the extent that a response is required, Respondent denies same. In any event, the existence of another case has absolutely no bearing on this instant case since the Board has a strong policy that all cases should be decided upon their own facts since they involve “a different defendant, a different mark and/or different goods.” TTAB Order, p. 4, dated March 29, 2011 in Cancellation No. 92051672, Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d/b/a Cubatabaco v. Inter America Cigar Company. Finally, the allegations set forth in paragraph 11 are misleading in so much as the referenced ruling was appealed to the United States District Court for the District of Columbia which resulted in a new ruling which favored Guantanamera Cigars Company. Guantanamera Cigar Co. v. Corporacion Habanos, S.A., 2010 WL 3035750 (D.D.C. Aug. 5, 2010), rev’g and remanding 86 U.S.P.Q.2d 1473 (T.T.A.B. 2008)(precedential). That court remanded the matter to the Trademark Trial and Appeal Board. At present, the matter is fully briefed at the TTAB and awaiting a decision.

12. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 12 and therefore denies same. Moreover, Respondent contends that Petitioners do not have standing to bring this action. While at least one

District Court has recognized standing for Petitioners to bring such cases, the Supreme Court has not yet considered standing in this regard. Until such time, Respondent will continue to protest Petitioners' standing.

13. Admitted.

14. Admitted. In any event, "while the file of the application underlying the subject registration is of record, the statements made therein are not considered admissions against interest, but rather are 'merely illuminative of shade and tone in the total picture confronting the decision maker [and do not] relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.'" TTAB Order, p. 5, dated March 29, 2011 in Cancellation No. 92051672, Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d/b/a Cubatabaco v. Inter America Cigar Company (citing Speciality Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 U.S.P.Q. 1281, 1283 (Fed. Cir. 1984), quoting Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 U.S.P.Q. 151, 154 (CCPA 1978)).

15. Admitted. In any event, "while the file of the application underlying the subject registration is of record, the statements made therein are not considered admissions against interest, but rather are 'merely illuminative of shade and tone in the total picture confronting the decision maker [and do not] relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.'" TTAB Order, p. 5, dated March 29, 2011 in Cancellation No. 92051672, Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d/b/a Cubatabaco v. Inter America Cigar Company (citing Speciality Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223

U.S.P.Q. 1281, 1283 (Fed. Cir. 1984), quoting Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 U.S.P.Q. 151, 154 (CCPA 1978)).

16. Admitted. See also response to paragraph 15 above.

17. Upon information and belief, Respondent believes that the tobacco used in its cigars is grown from seeds that do originate from Cuba.

18. Denied.

19. Admitted. See also response to paragraph 15 above.

20. Admitted.

21. Denied.

22. The phrase “pinar del rio” translates into English as “pine of the river.” Therefore, Respondent denies that the “primary” meaning of same is that as alleged by Petitioners.

23. Denied.

24. Respondent denies that Pinar Del Rio is currently “renowned throughout the world, including the United States, as the finest tobacco growing region ... throughout the world.” While this statement may have been true 20 years ago, it is has not been the case since then as non-Cuban cigar growing regions in Estelli, Nicaragua, Danli, Honduras, and Santiago, Dominican Republic have surpassed Cuba’s cigar growing regions. This is evidenced by the consistently high reviews/ratings found in Cigar industry publications (both print and electronic). Respondent is without information sufficient to admit or deny the allegation that “Pinar Del Rio ... is the main source of tobacco for the famed Cuban-origin premium hand-made cigars that are sold both in

Cuba and throughout the world” and therefore denies same. Respondent admits that these cigars can not be sold in the United States.

25. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 25 and therefore denies same.

26. Denied. See generally Respondent’s response to paragraph 24 above.

27. Admitted but Respondent denies that the existence of same has any bearing on this matter.

28. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 28 and therefore denies same.

29. Denied. See generally Respondent’s response to paragraph 24 above.

30. Denied. See generally Respondent’s response to paragraph 24 above.

31. Denied. See generally Respondent’s response to paragraph 24 above.

32. Denied. Respondent requires strict proof of this allegation.

33. Admitted to the extent that Respondent’s finished cigar products do not come from Cuba. Denied to the extent that Respondent’s finished goods are in fact grown from tobacco grown from seeds that recently originated from Cuba.

34. Admitted.

35. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 35 since it is unknown what Petitioners mean by “main ingredients or components” and therefore Respondent denies same.

36. Respondent does not have sufficient information to admit or deny the allegations contained in paragraph 36 and therefore denies same as it relates to seeds. Admitted as it relates to tobacco.

37.Denied.

38.Denied.

39.Denied.

40.Denied.

41.Denied.

42.Denied.

43.Denied.

44.Denied.

45.Denied.

46.Denied.

47.Denied.

48.Denied. In any event, Petitioners' "intent to market and sell 100% Cuban-origin cigars ... to U.S. consumers as soon as U.S. law permits ..." is illusory in so much as the embargo has lasted for 50 years with no end in sight. Thus, any such "intent" creates no real immediate interest or corresponding legal standing to seek cancellation of Respondent's trademark registration which was lawfully obtained after strict examination by the United States Patent and Trademark Office.

49.Denied. See generally Respondent's response to paragraph 48 above.

50.Respondent responds to the repetition of paragraphs 1-49 as if fully set forth herein.

51.Denied.

52.Respondent responds to the repetition of paragraphs 1-49 as if fully set forth herein.

53.Respondent is without information sufficient to admit or deny the allegations contained in paragraph 53 and therefore denies same.

54. Respondent is without information sufficient to admit or deny the allegations contained in paragraph 54 and therefore denies same.

55. Denied.

56. Respondent denies this overreaching and generalized statement of the United States cigar consuming public's mindset. Respondent admits the place of production or origin of cigars plays a role in the quality and reputation of cigars, but denies the implication that it plays the only roll or even a substantial role.

57. Denied.

58. Denied.

59. Respondent responds to the repetition of paragraphs 1-49 as if fully set forth herein.

60. Denied.

61. Denied.

62. Denied.

63. Denied.

64. Denied.

WHEREFORE, Repondent respectfully requests that the Petition to Cancel be dismissed in its entirety for its failure to state a cause of action and for Petitioners' lack of standing.

AFFIRMATIVE DEFENSES

Laches

Petitioners claim is barred by the equitable doctrine of laches. Namely, Petitioners have no strong trademark rights or other cognizable value in any mark that is being asserted. In fact, Petitioners have been legally barred from selling their Cuban

made goods in the United States for over 50 years; 2) Petitioners have unreasonably delayed and displayed no diligence in pursuing their claims against Respondent; 3) significant harm will befall Respondent if Petitioners prevail; and 4) there will be very little harm to Petitioners if Respondent's trademark continues to be registered.

Unclean Hands

Petitioners have engaged in a campaign to oppose and seek cancellation of a vast number of trademarks that have been properly approved by the Trademark Office or otherwise granted registration. A brief survey of the Trademark Trial and Appeal Board records will reveal that Petitioners, either on their own, or jointly have sought to oppose or cancel numerous trademarks. While this alone is no cause for concern, Petitioners' campaign is usually directed to Applicants or Registrants that have very little financial means to defend themselves. Moreover, Petitioners seek opposition or cancellation of these marks in spite of the fact that Petitioners can not legally sell their cigars in the United States. While Petitioners may rely upon their claim that they have standing to file such opposition or cancellation proceedings, standing alone is not sufficient good cause to engage in the pattern of aggressive litigation. Upon information and belief, Petitioners are aware that their products are illegally sold in the United States through European and Canadian websites that target the United States cigar consuming public. Principals of Petitioners are aware of this direct violation of the embargo and supply said websites with product which they know will end up in the United States. Petitioners website located at <http://www.habanos.com> contains an "Authenticity Check" page that allows consumers to enter the Barcode found on Petitioners' products. Upon information and belief, discovery will reveal that most of the

users' IP address of their computers which have entered a Barcode will be found to originate in the United States. See <http://www.habanos.com/Sellos/Info/VerificaSelloCajon>

Standing

Petitioners' lack standing to bring this Petition for Cancellation.

Failure to State a Claim

Petitioners have failed to state a cause of action upon which relief could be granted.

Dated: October 11, 2011

/s/Frank Herrera
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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing REGISTRANT'S ANSWER AND AFFIRMATIVE DEFENSES was served on Petitioners by mailing, postage prepaid, said copy on October 11, 2011 via US Mail, to the counsel of record, namely:

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