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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
Correspondence Address	FRANK HERRERA H NEW MEDIA PO BOX 273778 BOCA RATON, FL 33427 UNITED STATES therrera@hnewmedia.com
Submission	Opposition/Response to Motion
Filer's Name	Frank Herrera
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Signature	/FH/
Date	05/07/2012
Attachments	Response to MTC and Sanctions FINAL.pdf (8 pages)(113310 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,)	
)	Cancellation
)	No.: 92052146
Petitioners,)	
)	
v.)	
)	
JUAN E. RODRIGUEZ,)	
Registrant.)	
_____)	

**REGISTRANT'S RESPONSE TO "PETITIONERS' MOTION TO COMPEL"
AND
REGISTRANT'S MOTION TO SUSPEND PROCEEDINGS**

COMES NOW Juan E. Rodriguez ("Rodriguez" or "Registrant") and hereby responds to Petitioners' Motion to Compel and files Registrant's Motion to Suspend Proceedings Pending the Outcome of Opposition No. 91152248. As grounds for such relief, Registrant offers the following factual and legal support:

As an initial matter, the undersigned takes great exception to the baseless allegations that he has engaged in wholesale discovery abuse. This is simply not the case. The undersigned has suffered ten years of *ad hominen* attacks by counsel for Petitioners, but has had enough. An unassuming reader may believe the undersigned to be some "*monstrum horrendum ... without entrails.*"¹

¹ Fidel Castro's famous characterization of Batista.

The undersigned hereby requests that the Board Suspend this proceeding pending the outcome of Corporacion Habanos v. Guantanamera Cigar Co., Opposition No. 91152248 which will be appealed shortly. The final determination of that case by the highest appellate court will certainly have a legal effect on the current case. This motion to Suspend this proceeding highlights the shortcomings of Petitioners' motion for sanctions argument.

Petitioners' attempt to combine the factual scenarios occurring in several cases to support a request for sanctions is factually and legally unsound.

Today the undersigned informed counsel for Petitioners that the undersigned would move to Suspend this current action pending the final determination of the Guantanamera case. In his response email, counsel for Petitioners responded:

I do not agree that this case or the other pending cases before the Board between our clients should be stayed pending the ultimate disposition of the *Guantanamera* case. For reasons that I will address in response to your anticipated motions, it is obvious that there are dispositive issues in these cases that do not turn on the *Guantanamera* case. In addition, I do not think there is any basis for the Board to delay reaching the merits in these separate and distinct cases.

May 7, 2012 Email from David B. Goldstein, Esq.

These cases all involve similar causes of action. Should the Board find it necessary, the undersigned is willing to supplement this response and combined motion with the Cancellation/Opposition Complaints filed by Petitioners in the Cigar King, Ltd., Guantanamera, and

Inter-America Cigar Company cases. Moreover, this case like the other cases will turn on a similar evaluation of publicly available information. Thus, counsel for Petitioners' attempt to paint the undersigned as an "obstructionist" is not well-taken. The undersigned can not obstruct Petitioners' from publicly available information. Further, the Board's recent decision in Guantanamo Cancellation No. 91152248 turned not on documents that were provided by the applicant in that case. Rather, that decision turned on the hotly debated final element of a 2(e)(3) claim. None of the discovery sought by Petitioners' in this case will support the final element of its 2(e)(3) claim.

The undersigned intends to depose Petitioners. It is anticipated that the Petitioners will object to having to sit for deposition. Moreover, if the undersigned has to depose the Petitioners via the Deposition Upon Written questions procedure, then this action will need to be suspended once again to allow for the orderly and timely process associated with that procedure.

Thus, even if this case were to proceed to trial and a final determination by the Board is reached, the decision will be appealed by the non-prevailing party. Since the final outcome of this case will be determined by the final outcome of the Guantanamo appeals, in order to conserve judicial resources, the resources of the litigants and their counsel, and to avoid inconsistent and competing opinions of the T.T.A.B., it is respectfully requested that this proceeding be suspended.

To be clear, Petitioners' motion erroneously claims that Respondent has not produced any documents. This is simply not true. Respondent has produced an invoice dated 4/16/08 of PINAR DEL RIO products to a store located in New Jersey. That invoice was produced via email to counsel for Petitioners on April 10, 2012. In that same email, Respondent also produced advertising material showing use of the mark PINAR DEL RIO, as well as several photos of product packaging bearing the subject trademark.

On April 9, 2012, the undersigned emailed counsel for Petitioners several images of the first cigar bands produced by Respondent which bear the PINAR DEL RIO trademark.

As for the Stipulated Protective Order, the undersigned has no objection to it. It can be submitted at will to the Board by the Petitioners. This delay, however, has no bearing on whether Petitioners are entitled to confidential and non-relevant information. Respondent's sales of its products have nothing to do with whether Petitioners' can prevail on their claims. Just as was the case in Guantanamo, there is no question in this case of priority of rights or any claim that Registrant has not used its mark in commerce.

As noted in Respondent's motion for extension of time to respond to the motion to compel, Respondent is still recovering from a serious medical emergency and is slowly recovering at home. Therefore, to the extent that this Board does not grant Respondent's Motion to Suspend, Respondent requests ten (10) days from the date of any Order on this matter to produce or otherwise supplement its discovery responses.

* * *

Finally, the undersigned is baffled by the argument put forth by the Petitioners' wherein they allege that Respondent has violated Fed.R.Civ.P. 26(g). What is more perplexing is Petitioners' attached email correspondence with third parties (all counsel for parties that have litigated and lost, or given up in litigation against Petitioners). How these communications have any bearing on the ultimate question of Respondent's and the undersigned's Fed.R.Civ.P. 26(g) obligations is beyond reason. The undersigned clearly met his professional obligations before putting forth the Respondent's Affirmative Defenses. Furthermore, it is telling that Petitioners never filed a Motion to Strike the Respondent's Affirmative Defenses. It appears that Petitioners are now trying to call into question those Affirmative Defenses by bootstrapping this new, and bizarre, string of emails with third parties. This guerilla tactic is creative, but sadly, legally unsound.

Petitioners fail to cite one single case, law, or other regulation that directly supports their position that Respondent can be sanctioned for failing to call, interview, or otherwise interrogate each of the litigants that it cited as parties whom may have information to support their Affirmative Defenses. Citing to cases that vaguely speak to the issues is simply not enough to support the requested sanction relief. Sanctioning a party is a serious action and only occurs in very limited circumstances. Merely attaching an attorney's declaration with attached email correspondence from non-related counsel for third parties is not enough.

MEMORANDUM OF LAW

Pursuant to the T.B.M.P., namely, Section 510.02 the Board may suspend a proceeding pending the outcome of another proceeding.

510.02 Suspension Pending Outcome of Another Proceeding; Resumption

... pursuant to 37 CFR § 2.117(a), the Board may also, in its discretion, suspend a proceeding pending the final determination of another Board proceeding in which the parties are involved [citation omitted] ... or even another proceeding in which only one of the parties is involved. [citation omitted.] Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board. [citation omitted.]

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board ...

Id.

The Guantanamo case involves at least one similar party, namely, Corporacion Habanos, S.A., and the same legal issues (at the core), i.e., whether the subject mark is barred from registration pursuant to Section 2(e)(3). To force the parties in this proceeding to continue to litigate would be an exercise in waste. Law abhors waste. Allowing this case to proceed with full knowledge that it will be appealed because of the existence of a factually and legally similar case would do nothing to serve justice.

Like stones rolling down hills, fair ideas reach their objectives despite all obstacles and barriers. It may be possible to speed or hinder them, but impossible to stop them.

Jose Marti, Cuban Poet

If Petitioners' ten plus year trademark litigation strategy is a "fair idea" then no alleged obstructionist behavior or other barriers should stand in their way.² Rather, the final outcome of the Guantanamo case (after another trip to the United State District Court for the District of Columbia, the Appeals Court, and finally, the United States Supreme Court) will dictate what party has reached their objective.³ All of these cases are inextricably intertwined, thus the junior in time cases should be suspended.

WHEREFORE, Registrant respectfully requests that the Board deny the Petitioners' Motion to Compel and for Sanctions and grant Registrant's Motion to Suspend these Proceedings Pending the Outcome of Opposition No. 91152248
May 7, 2012

/s/Frank Herrera
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² History may absolve Petitioners. Then again, it may absolve all litigants that have fought against Petitioners. Inspired by Fidel Castro's 1953 manic marathon speech to the Court (not recorded but later written/re-imagined by him).

³ Hopefully during that time the world will see the release of Alan Gross http://en.wikipedia.org/wiki/Alan_Phillip_Gross; the suspension of abuses against the Ladies In White by the Cuban government, http://en.wikipedia.org/wiki/Ladies_in_White, or even the normalization of relations between Cuba and the United States.

CERTIFICATE OF GOOD FAITH

The undersigned contacted counsel for Petitioners today in an effort to obtain his consent to the relief sought herein. Counsel for Petitioners does not agree to the relief sought herein.

/s/Frank Herrera
FRANK HERRERA

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing was served on Petitioners by mailing, postage prepaid, said copy on May 7, 2012 via US Mail, to the counsel of record, namely:

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