

ESTTA Tracking number: **ESTTA349168**

Filing date: **05/24/2010**

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

Petition for Cancellation

Notice is hereby given that the following parties request to cancel indicated registration.

Petitioner Information

Name	Corporacion Habanos, S.A.		
Entity	Corporation	Citizenship	Cuba
Address	Avenida 3ra #2006 e/20 y 22 Miramar, Havana, CUBA		

Name	Empresa Cubana del Tabaco, d.b.a. Cubatabaco		
Entity	Corporation	Citizenship	Cuba
Address	O'Reilly No. 104 Havana, CUBA		

Attorney information	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. 111 Broadway Suite 1102 New York, NY 10006-1901 UNITED STATES dgoldstein@rbskl.com Phone:212-254-1111		
----------------------	---	--	--

Registrations Subject to Cancellation

Registration No	2957140	Registration date	05/31/2005
Registrant	Thompson & Co. of Tampa, Inc. 5401 Hangar Court Tampa, FL 33634 UNITED STATES		

Goods/Services Subject to Cancellation

Class 034. First Use: 2001/09/09 First Use In Commerce: 2001/09/09 All goods and services in the class are cancelled, namely: Cigars made from tobacco grown from Cuban seed

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)
Other	Articles 23-28 of the General Inter-American Convention for Trade Mark and Commercial

		Protection, 46 Stat. 2907	
Registration No	2924482	Registration date	02/01/2005
Registrant	Thompson & Co. of Tampa, Inc. 5401 Hangar Court Tampa, FL 33634 UNITED STATES		

Goods/Services Subject to Cancellation


Class 034. First Use: 2001/09/09 First Use In Commerce: 2001/09/09 All goods and services in the class are cancelled, namely: cigars made from Cuban seed tobacco
--

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77157193	Application Date	04/16/2007
Registration Date	NONE	Foreign Priority Date	04/13/2007
Word Mark	HABANOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class A. First use: cigars		

U.S. Registration No.	1970911	Application Date	09/22/1994
Registration Date	04/30/1996	Foreign Priority Date	NONE
Word Mark	LA CASA DEL HABANO		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 034. First use: raw tobacco; cigars; cigarettes; cut tobacco; rappee; manufactured tobacco of all kinds; matches; tobacco; smoking pipes; pipe-holders, not of precious metal; ashtrays, not of precious metal; match boxes, cigar cases and humidors, not of precious metal

U.S. Registration No.	2177837	Application Date	08/16/1996
Registration Date	08/04/1998	Foreign Priority Date	NONE

Word Mark	HABANOS UNICOS DESDE 1492
-----------	---------------------------

Design Mark	
-------------	---

Description of Mark	The mark consists of a black rectangle with the design of a tobacco leaf and the wording "HABANOS UNICOS DESDE 1492."
---------------------	---

Goods/Services	Class 034. First use: raw tobacco, cigars, cigarettes, cut tobacco rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays, match boxes, cigar cases, and humidors
----------------	---

Attachments	77157193#TMSN.jpeg (1 page)(bytes) 74576950#TMSN.gif (1 page)(bytes) 75151320#TMSN.gif (1 page)(bytes) Petition cancel Hoja de Habano.Final.pdf (17 pages)(48336 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/David B. Goldstein/
Name	David B. Goldstein
Date	05/24/2010

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

In the matter of trademark Registration Nos.:

2957140 (Principal Register) and 2924482 (Supplemental Register)

Mark: HOJA DE HABANO

CORPORACION HABANOS, S.A., and EMPRESA)	
CUBANA DEL TABACO, d.b.a. CUBATABACO,)	
)	
Petitioners,)	
)	
v.)	
)	
THOMPSON & CO. OF TAMPA, INC.,)	
)	
Registrant.)	

Cancellation No.

PETITION TO CANCEL

Petitioners CORPORACION HABANOS, S.A. (“Habanos, S.A.”) and EMPRESA CUBANA DEL TABACO (“Cubatabaco”) (together “Petitioners”) believe that they will be and have been damaged by registration on the Principal Register of the mark HOJA DE HABANO & DESIGN, Registration No. 2,957,140, for “Cigars made from tobacco grown from Cuban seed,” registered on May 31, 2005, and by registration on the Supplemental Register of the mark HOJA DE HABANO, Registration No. 2,924,482, for “cigars made from Cuban seed tobacco,” registered on February 1, 2005, and, by and through their undersigned attorneys, hereby petition to cancel said registrations, and aver as follows:

THE PARTIES

1. Petitioner Habanos, S.A. is a corporation organized under the laws of Cuba, with its principal place of business located at Avenida 3ra #2006 e/20 y 22, Miramar, Havana, Cuba.

2. Petitioner Cubatabaco is a state corporation with independent juridical personality and independent property established by law No. 1191, dated April 25, 1966, of the Republic of Cuba, with its principal place of business located at O'Reilly No. 104, Havana, Cuba.

3. Upon information and belief, Registrant Thompson & Co. of Tampa, Inc. ("Thompson") is a corporation incorporated in Florida and located at 5401 Hangar Court, Tampa, Florida 33634.

4. Petitioner Habanos, S.A. currently owns, among other registrations, the federal registration of the mark HABANOS UNICOS DESDE 1492, U.S. Reg. No. 2,177,837, applied for on August 16, 1996, in the United States for cigars and related products in International Class 34. Habanos, S.A. uses this mark, translated as "unique Havana cigars since 1492," throughout the world exclusively for cigars that are of 100% Cuban origin.

5. The mark HABANOS UNICOS DESDE 1492 appears regularly in advertisements for Habanos, S.A.'s 100% Cuban origin cigars in international and United States publications. This mark is used in such advertisements both in Spanish and in English translation as "Habanos Unique since 1492" and "Havanas Unique since 1492."

6. Petitioner Habanos, S.A. is engaged, *inter alia*, in the trade, marketing, and advertising of Cuban cigars throughout the world, including in Cuba, and the export of Cuban cigars throughout the world (with the exception of the United States due to the United States trade embargo). Habanos, S.A. emphasizes that its cigars are made in Cuba from 100% Cuban-grown tobacco in its promotion, marketing and advertising, including in advertisements in the United States.

7. Petitioner Cubatabaco currently owns, among other registrations, the federal registrations in the United States of the mark LA CASA DEL HABANO, U.S. Reg. No.

1,970,911, applied for on September 22, 1994, translated as "the house of the Cuban cigar," for cigars and related products in International Class 34, and of LA CASA DEL HABANO, U.S. Registration No. 2,212,119, applied for on August 16, 1996, as a service mark in International Class 35 for "retail store services featuring tobacco and smokers' accessories" and in International Class 42 for "social club services, bar services, and restaurant services."

8. Petitioner Cubatabaco's LA CASA DEL HABANO Marks regularly appear in advertisements in the United States in connection with cigars that are of 100% Cuban origin.

9. Petitioner Cubatabaco currently owns the application in the USPTO for the certification mark HABANOS, Application Serial No. 77157193, in IC A for "cigars," filed April 16, 2007. The mark certifies "that the cigars have their geographical origin in Cuba and are made from Cuban grown tobacco, 'Cuba' meaning the entire national territory of the Republic of Cuba."

10. Pursuant to section 2(d) of the Act, Thompson's HOJA DE HABANO marks have been cited by the USPTO against the registration of Petitioner Cubatabaco's HABANOS certification mark application, and the USPTO has suspended further action on that application.

11. "HABANOS," the plural of "HABANO," is the appellation of origin (also known as a denomination or indication of geographical origin) for cigars originating in the entire national territory of the Republic of Cuba, and was registered by Petitioner Cubatabaco in 1967 in accordance with the 1958 Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, as revised and amended. Under Petitioner Cubatabaco's authority, Petitioner Habanos, S.A. uses the "Habanos" geographical denomination of origin on all packages of its 100% Cuban origin cigars.

12. "HABANA," the Spanish word for HAVANA, is an appellation of origin for

Cuban-origin tobacco and tobacco products, registered by Petitioner Cubatabaco in 1967 both domestically in Cuba and pursuant to the Lisbon Agreement.

13. On September 26, 2008, the Board, in a precedential decision, refused registration of the mark HAVANA CLUB for “cigars made from Cuban seed tobacco,” on the ground that the mark was “primarily geographically deceptively misdescriptive” under section 2(e)(3) of the Lanham Act. *Corporacion Habanos, S.A. v. Annacas, Inc.*, 88 U.S.P.Q.2d 1785 (TTAB 2008).

THE APPLICATION PROCEEDINGS

14. On June 27, 2001, Thompson filed an application, Serial No. 76277020, in the USPTO under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register the mark HOJA DE HABANO on the Principal Register, in International Class 34 for “cigars.”

15. Thompson translated the mark “Hoja de Habano” as “Petal of Havana.”

16. The Examining Attorney initially refused registration under section 2(e)(1), noting that “Hoja” is more properly translated as “leaf,” and mistakenly believing that the mark was merely descriptive of the goods. The Examining Attorney did not address the “De Habano”/“of Havana” portion of the mark.

17. After the PTO issued a Final Refusal under section 2(e)(1), on August 29, 2002, Thompson sought to amend the application to seek registration on the Supplemental Register, and to claim use in commerce.

18. On October 1, 2002, the Examining Attorney refused registration on the ground that the mark is geographically deceptively misdescriptive, stating:

The primary significance of the term “HABANO” is geographic. The applicant’s goods do not come from this place. The mark is geographically deceptively misdescriptive because the public would believe that the goods do come from Havana, Cuba....Havana has long been associated and known as a premier area for tobacco growing and manufacture of hand rolled cigars.

19. Thompson responded to the Office Action refusal by amending its goods from “cigars” to “cigars made from Cuban seed tobacco.” Thompson made no argument that such “cigars made from Cuban seed tobacco” come from Cuba or Havana, Cuba, or have any connection or association with Cuba, Havana, or Cuban-origin tobacco or cigars, and did not provide any evidence as to what “Cuban seed tobacco” is, or any evidence to support its claim that its cigars were made with something that Thompson called “Cuban seed tobacco”.

20. Following the amendment, on July 16, 2003, the Examiner withdrew the “geographically misdescriptive refusal” without further explanation. In a subsequent Office Action, a new Examining Attorney, David C. Reihner, based on his misunderstanding that there was some relevant connection between “Cuban seed tobacco” and Cuba, or Havana, Cuba, or Cuban-origin cigars, stated, “the designation ‘de Habano’ is translated as ‘of Havana’. Because this wording is geographically generic for the goods, it must be disclaimed.” The Examining Attorney provided no explanation as to what he meant by “geographically generic.”

21. Thompson, which is in the cigar business, knew that its HOJA DE HABANO cigars and the tobacco used in those cigars do not come from Havana, and were not “of Havana,” and had no relationship with Cuba, Havana, or Cuban tobacco or cigars, but nevertheless adopted the proposed disclaimer with the specific intent to obtain the registration under false and fraudulent pretenses, without disclosing these facts to the Examining Attorney, who clearly believed, mistakenly, that there was some relevant connection between Thompson’s cigars and Cuba or Havana, Cuba, or Cuban cigars or tobacco.

22. The mark was registered on the Supplemental Register on February 1, 2005, Registration No. 2924482, with the mark translated as “Leaf of Havana.”

23. On February 4, 2004, Thompson filed an application, Serial No. 78362348, in the

USPTO under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), to register the mark HOJA DE HABANO & DESIGN on the Principal Register, in International Class 34 for “Cigars made from tobacco grown from Cuban seed.” The design included a tobacco leaf in the center of the mark. Thompson translated the mark as “Leaf of Havana.”

24. In a September 9, 2004 Office Action, the PTO Examiner, clearly misunderstanding the origin of Thompson’s goods based on the “Cuban seed” tobacco claim, stated:

the applicant must also disclaim the wording “Hoja de Habano” because it is merely descriptive and geographically descriptive of the goods. ... The wording is merely descriptive and geographically descriptive because the *goods are made from tobacco leaves of Cuban origin*. Havana is the capital and largest city of Cuba...

(Emphasis added).

25. Thompson, which is in the cigar business, knew that its HOJA DE HABANO cigars and the tobacco used in those cigars do not come from Havana, that its cigars are not “made from tobacco leaves of Cuban origin,” and had no relationship with Cuba, Havana, or Cuban tobacco or cigars. However, instead of correcting the Examiner’s clear misunderstanding, including that Thompson’s cigars are “made from tobacco leaves of Cuban origin,” Thompson exploited that misunderstanding, and disclaimed “Hoja de Havana” as proposed, with the specific intent to obtain the registration under false and fraudulent pretenses.

26. The mark was then published for opposition, and registered on the Principal Register on May 31, 2005, Reg. No. 2,957,140.

27. Upon information and belief Thompson ceased using in commerce its HOJA DE HABANO marks several years ago, and has abandoned its HOJA DE HABANO marks.

28. Thompson’s marks are, *inter alia*, primarily geographically deceptively

misdescriptive, deceptive and deceptively misdescriptive of the identified goods, and Thompson obtained its Registrations through fraud on the USPTO.

THE MEANING OF "HABANO"

29. The primary significance of the mark HOJA DE HABANO is a generally known geographic location – Havana, Cuba.

30. Thompson correctly translated “HABANO” into English as “of Havana.”

31. The Spanish word "Habano" is defined generally as belonging to or related to Havana, Cuba, the largest city and the capital of Cuba.

32. “Habano” also has the common and well-understood meaning of a “Havana cigar,” that is, a 100% Cuban-origin cigar, made from Cuban grown tobacco and manufactured in Cuba. Such cigars have historically been (and continue to be) manufactured in and exported from Havana, Cuba.

33. The addition of the words “Hoja de” meaning “Leaf of” or the use of a tobacco leaf, does not alter the mark’s primary geographic significance. Indeed, these additional words, and the use of the tobacco leaf, reinforce the mark’s primary geographic significance.

34. The term “Habano” (and its plural “Habanos”) has long been used, recognized, and understood throughout the world, including in the United States, by both cigar consumers and within the cigar industry, to denote Havana’s most famous export – cigars that are of 100% Cuban origin, made exclusively from tobacco grown in Cuba, and which are manufactured in Cuba, primarily in or near the city of Havana, Cuba.

35. Likewise, the English equivalent of “Habano” – “Havana” – is recognized among cigar consumers and in the cigar industry throughout the world and in the United States to denote cigars that are of 100% Cuban origin.

36. Spanish language dictionaries define "Habano" as relating to, or from, La Habana (Spanish for Havana, Cuba), or by extension the island of Cuba, or as a cigar made in Cuba from Cuban grown tobacco.

37. Numerous English language dictionaries and encyclopedias, including those published in the United States, define the word "Havana" to mean a cigar made in Cuba and/or from Cuban tobacco, in addition to denoting the largest and capital city of Cuba.

38. The leading English-language cigar books, including in book titles, consumer guides, and cigar magazines sold in the United States, and news and feature stories appearing in general circulation magazines, newspapers, and other publications directed to the general public in the U.S use the terms "Habano(s)" and "Havana(s)" to denote a 100% Cuban-origin cigar.

39. "Habana" (Havana) was the term historically used internationally, including in the United States, to identify cigars made in Cuba, and derived from the name of the port from which the cigars were shipped. The term "Habanos" began to be used in Spanish speaking countries at the beginning of the 20th century to denote Cuban cigars.

40. For decades prior to Thompson's June 27, 2001 and February 4, 2004, applications, or its claimed first use, and first use in commerce date of September 9, 2001, the term "Habano" has been used to mean a Cuban-origin cigar.

41. For many years prior to Thompson's applications, or claimed first use date, Petitioners consistently have promoted the term "Habanos" as a geographic indication for Cuban cigars, including in advertisements in the United States, and Habanos, S.A. incorporates the word "Habanos" as a geographic indication into the trade dress of all its packages of Cuban-origin cigars.

42. United States and international publications directed to the cigar-consuming

public and to the trade, including the United States cigar-consuming public and trade, refer to a "Habano," or a "Havana," that is, a 100% Cuban-origin cigar, as a different type of cigar from those cigars that are not of Cuban origin.

43. Cuba is internationally recognized, including in the United States, as the most renowned country in the world for the growth of tobacco for cigars, and for the production and manufacture of cigars, including cigars of the highest quality, and Havana is internationally recognized, including in the United States, as the city and province most renowned for the manufacture and export of the highest quality cigars.

44. No other country is as renowned for cigars as Cuba; no geographic location is as renowned for cigars as Havana, Cuba; and no denomination of geographic origin is as renowned for cigars as "Habanos".

45. Cuban-origin cigars are desired by cigar smokers throughout the world, including in the United States, because of their Cuban origin.

46. Consumers in the United States and elsewhere in the world associate cigars with Cuba and particularly with Havana, Cuba. This association is one of the strongest goods/place associations of any consumer product with a particular geographic region in the world.

47. Thompson's mark denotes, is, and will be understood by United States consumers as denoting, that cigars bearing that mark are manufactured in Cuba, or are made from tobacco grown in Cuba and manufactured elsewhere.

48. Thompson's goods do not come from, or otherwise originate in, Havana, Cuba or elsewhere in Cuba, and are not "Habanos," that is, cigars from Cuba.

49. Thompson, a Florida corporation, has no lawful means of obtaining or selling Cuban-origin cigars or Cuban-origin tobacco, nor any lawful means of obtaining or selling cigars

or other tobacco products that are made anywhere in the world if they are made or derived in whole or in part of any article which is the growth, produce or manufacture of Cuba. Without limitation, the United States' Cuban Assets Control Regulations, including specifically 31 C.F.R. § 515.201, 515.204, prohibit any such activity.

50. The cigar-consuming public is likely to believe that the place identified by Thompson's mark – Havana, Cuba – describes Thompson's goods, and their geographic origin, or the geographic origin of the good's main ingredients (tobacco), when neither the goods nor the ingredients (tobacco) in fact come from Havana or Cuba.

51. Consumers' mistaken belief that Thompson's cigars come from Havana or Cuba, or are comprised in whole or in part of tobacco grown in Cuba, would be a material factor in such consumers' purchasing decision.

52. By use of the word "Habano," and the phrase "Hoja de Habano" ("Leaf of Havana"), Thompson's mark misdescribes a quality, characteristic, or feature of the goods, *i.e.*, Cuban-origin cigars (or cigars made from tobacco from Havana or Cuba), because the goods are not cigars from Havana or Cuba, or made from Cuban tobacco.

53. Consumers are likely to believe, mistakenly, that Thompson's goods share the same characteristics, such as taste, aroma, quality, and construction, as cigars made in Havana or Cuba from genuine Cuban tobacco.

54. By use of the word "Habano," which is widely used and understood in the United States to refer to cigars manufactured in Cuba from Cuban-origin tobacco, cigar consumers in the United States are likely to believe Thompson's misdescription of the goods.

THOMPSON'S MEANINGLESS CLAIM THAT ITS GOODS ARE "MADE FROM CUBAN SEED TOBACCO" OR "TOBACCO GROWN FROM CUBAN SEED"

55. Upon information and belief, Thompson represented to the USPTO that its cigars

are “made from Cuban seed tobacco” (or “made from tobacco grown from Cuban seed”) solely to avoid having the USPTO refuse registration on the ground that the use of “Habano” is primarily geographically deceptively misdescriptive, as determined by the Examiner, although Thompson in fact knew that its cigars do not come from Havana or Cuba, do not have their origin in Cuba, are *not* made from tobacco leaves of Cuban origin, and have no relevant connection or association with Havana or Cuba, with Cuban cigars or tobacco, or with Petitioners.

56. When used in the United States to refer to tobacco grown outside of Cuba, “Cuban seed tobacco” is merely a name given to a type of tobacco that is grown outside of Cuba from seeds that do not themselves come from Cuba, but are claimed, without any means of verification, to be distant descendants of seeds of tobacco plants grown in Cuba generations ago.

57. Upon information and belief, the type of non-Cuban tobacco that Thompson refers to as “Cuban seed tobacco” either: 1) is a very distant descendant from plants or seeds that were taken from Cuba sometime between 45 and almost 100 years ago, but not more recently than that; *or* 2) is not even a distant descendant from seeds or plants that were taken from Cuba many decades ago, but is merely a type of tobacco, grown outside of Cuba, and generically referred to as “Cuban seed tobacco”; *or* 3) is not even the type of tobacco generically referred to as “Cuban seed,” but Thompson may have made such misrepresentation to the USPTO solely to obtain registration of its mark through such misrepresentation.

58. It is not possible to verify whether Thompson’s cigars are made from tobacco grown from seeds that are descendants of tobacco seeds that came from Cuba.

59. Cigars allegedly made from tobacco grown from seeds that are descendants of seeds that came from Cuba are different from cigars made from Cuban-origin tobacco in terms of

quality, characteristics, taste and aroma.

60. The change in identification of the goods from “cigars” to “cigars made from Cuban seed tobacco” or “cigars made from tobacco grown from Cuban seed,” does not, and cannot, change the primarily geographically deceptively misdescriptive, deceptive, and deceptively misdescriptive nature of Thompson’s mark.

61. The use of the term “Cuban seed tobacco” cannot overcome the above statutory bars to registration of “HOJA DE HABANO”.

62. Upon information and belief, the USPTO would not have registered the mark had it known that neither “Cuban seed tobacco,” nor the seeds generating the plants that yield the tobacco, come from Havana, Cuba, or anywhere else in Cuba; and that “Cuban seed tobacco” does not have any connection or association with Cuba, Havana, or Cuban-origin cigars, other than the unverifiable possibility of a distant genetic descent.”

63. Upon information and belief, the USPTO would not have registered the mark had it known that Thompson’s HOJA DE HABANO cigars are *not* made from tobacco leaves of Cuban origin, and are not “of Havana.”

INJURY TO PETITIONERS

64. Petitioners believe that they will be and have been damaged by the registration of Thompson’s HOJA DE HABANO marks upon the Principal and Supplemental Registers, including by Thompson’s use of that mark on cigars of non-Cuban origin, which will damage and have damaged the reputation that *Habanos*, that is, genuine Cuban-origin cigars, have in the United States. Such registrations and use also will deceive and have deceived consumers into believing that Cuban cigars, or cigars made from Cuban tobacco, are presently available for purchase in the United States.

65. Petitioner Cubatabaco believes that it will be and has been damaged by the registration of Thompson's HOJA DE HABANO marks upon the Principal and Supplemental Registers, including because, under section 2(d) of the Act, the USPTO has cited those two registrations against Petitioner Cubatabaco's certification mark application for HABANOS, and has suspended further consideration of that application.

66. Petitioners' success in marketing 100% Cuban-origin cigars to U.S. consumers as soon as U.S. law permits, including through use of the registered marks HABANOS UNICOS DESDE 1492 & DESIGN and LA CASA DEL HABANO; the applied-for certification mark HABANOS; and "HABANOS" as a geographic indication, will be and has been damaged and diminished by the registration of Thompson's marks, which include the term "Habano," which deceptively suggests that Thompson's cigars are of Cuban origin, as the PTO Examiner herself mistakenly believed.

67. Petitioners' current ability to use the above-identified registered trademarks and "Habanos" as a geographic indication and certification mark in advertisements it currently places in the United States in connection with 100% Cuban-origin cigars will be and has been damaged by the registration of Thompson's marks.

FIRST GROUND FOR CANCELLATION

68. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 67 of this Petition to Cancel as if fully set forth herein.

69. The HOJA DE HABANO marks, as used on or in connection with Thompson's identified goods, are deceptive and primarily geographically deceptively misdescriptive within the meaning of Section 2(a), (e)(3) of the Lanham Act, 15 U.S.C. § 1052(a), (e)(3), for lack of the requisite nexus with Havana, Cuba or Cuba, and, therefore, the registrations of the marks

should be cancelled.

SECOND GROUND FOR CANCELLATION

70. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 67 of this Petition to Cancel as if fully set forth herein.

71. Thompson's HOJA DE HABANO marks, as used on or in connection with Thompson's identified goods, are deceptive and deceptively misdescriptive within the meaning of Section 2(a), (e)(1) of the Lanham Act, 15 U.S.C. § 1052(a), (e)(1), and, therefore, the registrations of the marks should be cancelled.

THIRD GROUND FOR CANCELLATION

72. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 67 of this Petition to Cancel as if fully set forth herein.

73. "Habano" is an indication of geographical origin or source within the meaning of Articles 23-28 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907 ("IAC"), to which both Cuba and the United States are parties, and which treaty is in force between the United States and Cuba.

74. "Habano" does not correspond to the place in which Thompson's identified goods are, will be, or lawfully could be, fabricated, manufactured, produced or harvested.

75. "Habano" has not through constant, general and reputable use in commerce come to form the name or designation itself of Thompson's identified goods.

76. To the consuming public, the quality and reputation of cigars depend on the place of production or origin.

77. Articles 23-28 of the IAC prohibit Thompson's use and registration in the United States of the term "Habano" in connection with non-Cuban origin cigars.

78. Under the aforesaid provisions of the IAC and also pursuant to Section 44(b), (h)

of the Lanham Act, 15 U.S.C. § 1126(b), (h), the registrations of the marks should be cancelled.

FOURTH GROUND FOR CANCELLATION

79. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 67 of this Petition to Cancel as if fully set forth herein.

80. Upon information and belief, Thompson has discontinued use of the HOJA DE HABANO marks more than three years ago, with intent not to resume use of the marks.

81. Upon information and belief, Thompson has abandoned the HOJA DE HABANO marks and, therefore, the registrations of the marks should be cancelled.

FIFTH GROUND FOR CANCELLATION

82. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 67 of this Petition to Cancel as if fully set forth herein.

83. With specific intent to obtain registration of its HOJA DE HABANO marks through false and fraudulent pretenses, Thompson made material misrepresentations of fact and material omissions of fact when it identified its cigars as “made from Cuban seed tobacco,” and as “made from tobacco grown from Cuban seed,” without disclosing the following facts to the USPTO, of which Thompson was aware at the time: that such identification of the goods does not mean that the original source of its cigars or its cigar tobacco is Cuba, or Havana, Cuba; or that its cigars “are made from tobacco leaves of Cuban origin”; or that its cigars are “of Havana”; or that its cigars or tobacco have any connection or relation to Havana or Cuba, or Cuban-origin cigars or tobacco, other than the possibility of a remote genetic descent; and without informing the USPTO that the “Cuban seed tobacco” claim is itself unverifiable.

84. When Thompson knowingly made these material misrepresentations and omissions, it knew that the USPTO Examiners were deceived and confused into mistakenly

believing that cigars claimed to be “made from Cuban seed tobacco” or “from tobacco grown from Cuban seed” had their geographic origins in Cuba, including the mistaken belief that Thompson’s cigars “are made from tobacco leaves of Cuban origin” and are “of Havana.”

85. Instead of correcting the Examiners’ misunderstandings, Thompson exploited those misunderstandings, and knowingly made the aforesaid material misrepresentations and omissions with the specific intent and purpose of having the USPTO rely on them in order to obtain registrations of the marks, which Thompson knew would otherwise be refused on the ground that the marks are deceptive and geographically deceptively misdescriptive.

86. Upon information and belief, but for Thompson’s aforesaid intentional material misrepresentations and omissions, the USPTO would have refused registration of the marks.

87. Because of Thompson’s aforesaid intentional material misrepresentations and omissions to the USPTO, the registrations of the marks should be cancelled.

WHEREFORE, Petitioners pray that Registration Nos. 2,957,140 (Principal Register), and 2,924,482 (Supplemental Register) for the mark HOJA DE HABANO, be cancelled pursuant to 15 U.S.C. § 1064, and that this Petition be granted in favor of the Petitioners.

Dated: May 24, 2010

Respectfully submitted,

By: /David B. Goldstein/
DAVID B. GOLDSTEIN
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.
111 Broadway – Suite 1102
New York, New York 10006-1901
212-254-1111
dgoldstein@rbskl.com
*Attorneys for Petitioners Corporacion Habanos,
S.A. and Empresa Cubana del Tabaco*

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Petition to Cancel Registration Nos. 2,957,140 (Principal Register), and 2,924,482 (Supplemental Register) for the mark HOJA DE HABANO, is being filed electronically today, May 24, 2010, on the Electronic System for Trademark Trials and Appeals for the United States Patent and Trademark Office.

/David B. Goldstein/
David B. Goldstein

CERTIFICATE OF SERVICE

The undersigned certifies that true and correct copies of the foregoing Petition to Cancel Registration Nos. 2,957,140 (Principal Register), and 2,924,482 (Supplemental Register) for the mark HOJA DE HABANO, were served on the Registrant by mailing, postage prepaid, said copies on May 24, 2010 via U.S. Certified Mail, return receipt requested, to the Registrant's address of record and to the attorney and correspondent listed for Registration Nos. 2,957,140 and 2,924,482:

Thompson & Co. of Tampa, Inc.
5401 Hangar Court
Tampa, FL 33634

David W. Pettis, Jr.
David W. Pettis, Jr., P.A.
1210 Millennium Parkway Suite 2010
Brandon FL 33511-0833

/David B. Goldstein/
David B. Goldstein