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Filing date: **12/06/2012**

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 Tabaca, dba Cubatabaco		
Entity	Corporation	Citizenship	Cuba
Address	O'Reilly No. 104 Havana, CUBA		

Attorney information	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. 45 Broadway Suite 1700 New York, NY 10006 UNITED STATES dgoldstein@rbskl.com Phone:212-254-1111		
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Registration Subject to Cancellation

Registration No	4175844	Registration date	07/17/2012
Registrant	G & R Brands, LLC 6525 South Bruce Street Las Vegas, NV 89119 UNITED STATES		

Goods/Services Subject to Cancellation

Class 034. First Use: 2012/04/11 First Use In Commerce: 2012/04/11 All goods and services in the class are cancelled, namely: cigar and cigarette boxes not of precious metal; cigar cutters; cigar humidifiers; cigarette ash receptacles; cigarette cases, not of precious metal; non-electric cigar lighters not of precious metal
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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)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)
Other	void ab initio for no use in commerce

Attachments	Petition to Cancel Havana Time.pdf (13 pages)(858921 bytes)
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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	12/06/2012

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

In the matter of trademark Registration No. 4,175,844
Registered: July 17, 2012
Mark: HAVANA TIME

CORPORACION HABANOS, S.A. and EMPRESA)	
CUBANA DEL TABACO, d.b.a. CUBATABACO,)	
)	
Petitioner,)	
)	
v.)	Cancellation No.
)	
G & R BRANDS, LLC,)	
)	
Respondent.)	
)	

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 HAVANA TIME, Registration No. 4,175,844, for “cigar and cigarette boxes not of precious metal; cigar cutters; cigar humidifiers; cigarette ash receptacles; cigarette cases, not of precious metal; non-electric cigar lighters not of precious metal,” registered on July 17, 2012, and, by and through their undersigned attorneys, hereby petition to cancel said Registration, and aver as follows:

THE PARTIES

1. Respondent G & R Brands, LLC is a limited liability corporation located in Las Vegas, Nevada, and incorporated in Nevada.
2. Petitioner Habanos, S.A. is a corporation organized under the laws of Cuba, with its principal place of business in Havana, Cuba.

3. 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 in Havana, Cuba.

4. Petitioner Habanos, S.A. currently owns, among others, 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 “raw tobacco, cigars, cigarettes, cut tobacco rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays, match boxes, cigar cases, and humidors” 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, and related cigar accessories.

5. The mark HABANOS UNICOS DESDE 1492 appears in advertisements for Habanos, S.A.'s 100% Cuban-origin cigars in international and United States publications. This mark has been 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 and related products, including cigar and other tobacco accessories, 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 U.S. 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 U.S.

7. Petitioner Cubatabaco currently owns, among others, 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 “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” in International Class 34, and for 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 appear in advertisements in the United States in connection with cigars that are of 100% Cuban origin, and related products.

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. The term “HABANA,” the Spanish word for HAVANA, is an appellation of origin (also known as a denomination or indication of geographical origin) for Cuban-origin tobacco and tobacco products 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.

11. The term “HABANOS” is the appellation of origin for cigars originating in the entire national territory of the Republic of Cuba, and was registered by Petitioner Cubatabaco in 1967 pursuant to the Lisbon Agreement. 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. On November 13, 2012, the Board refused registration of the mark HAVANA COLLECTION for “cigar cutters; non-electric cigar lighters not of precious metal; humidors; and cigar carrying cases not of precious metal,” as primarily geographically deceptively misdescriptive under section 2(e)(3) of the Lanham Act. *Corporacion Habanos, S.A. v. Xikar, Inc.*, Opp. No. 91186534 (TTAB) (non-precedential). On September 26, 2008, the Board, in a precedential decision, refused registration of the mark HAVANA CLUB for “cigars made from Cuban seed tobacco,” under section 2(e)(3). *Corporacion Habanos, S.A. v. Amncas, Inc.*, 88 U.S.P.Q.2d 1785 (TTAB 2008); *see also In re Jonathan Drew, Inc.*, 97 USPQ2d 1640 (TTAB 2011) (precedential, refusing registration of the mark KUBA KUBA for “cigars, tobacco, and related [tobacco and cigar accessory] products,” pursuant to section 2(e)(3)).

THE APPLICATION PROCEEDINGS

13. On March 10, 2008, Respondent filed an application in the PTO under Section 1(b) of the Lanham Act to register the standard character mark HAVANA TIME in IC 34 for “cigars,” “cigarettes,” “pipe tobacco”, other tobacco products, and 22 specifically identified cigar and other tobacco accessories (“Application”).

14. On June 18, 2008, the Examiner issued an Office Action refusing registration of the mark for all the goods under section 2(a) of the Act, finding the mark “geographically deceptive” of Havana, Cuba, which “is world-renowned for its tobacco products,” including “because Cuban tobacco products, cigars in particular, are highly sought after.”

15. Respondent then amended its identification of goods by inserting the words “made” or “grown” “from Cuban seed tobacco” after each tobacco product identified in its Application, and by disclaiming the word “Havana.”

16. Following this amendment, on December 17, 2010, the Examiner refused registration for all the identified goods as “geographically deceptive and primarily geographically deceptively misdescriptive” under sections 2(a) and 2(e)(3) of the Act.

17. On January 27, 2009, the Examiner issued a final refusal under section 2(e)(3) for all the identified goods; the Examiner denied a request for reconsideration on September 2, 2009.

18. Respondent brought an *ex parte* appeal. During the *ex parte* appeal, the Examiner withdrew the refusal to register the identified cigar and other tobacco accessories, without considering, *inter alia*, application of the related goods test.

19. On June 14, 2010, the Board affirmed the refusal to register HAVANA TIME for the identified tobacco products “made” or “grown” “from Cuban seed tobacco” under section 2(e)(3), and did not otherwise address whether the mark HAVANA TIME for the identified tobacco accessories was geographically deceptive or primarily geographically deceptively misdescriptive” under sections 2(a) or 2(e)(3), because of the Examiner’s withdrawal of the refusal to register as to those goods.

20. On October 12, 2010, the Application was published for opposition for the following 20 goods, all cigar and other tobacco accessories: “Tobacco filters; tobacco grinders; tobacco pipe cleaners; cigar and cigarette boxes not of precious metal; cigar cutters; cigar humidifiers; cigar tubes; cigarette ash receptacles; cigarette cases, not of precious metal; cigarette holders; cigarette holders, not of precious metal; cigarette papers; cigarette rolling machines; cigarette rolling papers; cigarette tubes; hookahs; non-electric cigar lighters not of precious metal; smoking pipe cleaners; smoking pipes; and tobacco pipes.”

21. On April 12, 2012, Respondent filed a Statement of Use; amended its identification of goods to the following six (6) goods: “cigar and cigarette boxes not of precious

metal; cigar cutters; cigar humidifiers; cigar ash receptacles; cigarette cases, not of precious metal; non-electric cigar lighters not of precious metal”; claimed first use in commerce of all the amended identified goods as of April 11, 2012; and submitted specimens purporting to show the mark in use on the various identified goods, as amended.

22. After the PTO rejected the specimens, and after Respondent filed a new specimen purporting to show the mark in use on one of the goods – cigarette ash receptacles – the mark was registered on the Principal Register on July 17, 2012.

23. Upon information and belief, the mark was not in use in commerce on the identified goods, as amended, when the Statement of Use was filed on April 12, 2012, and Respondent was aware of that fact at the time the Statement of Use was filed.

24. Upon information and belief, the mark was not in use in commerce on at least some of the identified goods, as amended, when the Statement of Use was filed on April 12, 2012, and Respondent was aware of that fact at the time the Statement of Use was filed.

25. Upon information and belief, the mark has not been in use in commerce on the identified goods since the Statement of Use was filed on August 24, 2011.

26. Respondent’s mark is, *inter alia*, primarily geographically deceptively misdescriptive, and geographically deceptive of the identified goods; registration of the mark was void *ab initio* for non-use of the identified goods; and the mark was obtained through fraud on the USPTO.

THE MEANING OF "HAVANA" AND THE MARK’S FALSE ASSOCIATION WITH HAVANA

27. The word "Havana" primarily refers to the largest city and the capital of Cuba.

28. The primary significance of the mark, HAVANA TIME, is a generally known geographic location – Havana, Cuba.

29. The addition of the common word “time” does not alter the mark’s primary geographic significance.

30. In addition to its primary meaning as the city of Havana, Cuba, “Havana” is 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 manufactured in Cuba, primarily in or near the city and province of Havana, Cuba.

31. Likewise, the Spanish word “Habano” (and its plural, “Habanos”) 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.

32. 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.

33. 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 tobacco.

34. 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 “Havana(s)” and “Habano(s)” to denote a 100% Cuban-origin cigar.

35. For decades prior to Respondent’s March 10, 2008 Application, the term “Havana” has been used to mean a Cuban-origin cigar.

36. Cigar accessories, including at least some of the goods identified in Respondent’s

amended Statement of Use and Registration, are produced in Havana, Cuba, and are known to be produced there by consumers in the United States.

37. Havana, Cuba is renowned, including in the United States, for the production, sale and export of high-quality cigar humidors.

38. It is common for manufacturers or distributors of cigars and other tobacco products in the United States and elsewhere, as with Petitioners, also to produce or distribute cigar and other tobacco accessories using the same marks as their tobacco marks, in connection with the sale and promotion of their tobacco products, and to market their tobacco accessories as related to their cigars and other tobacco products.

39. Respondent initially sought to register both cigars, cigarettes and other tobacco products under the same mark – HAVANA TME – as its cigar and other tobacco accessories.

40. Cigar and tobacco consumers are also cigar and tobacco accessories consumers, and commonly associate cigars and other tobacco products with cigar accessories and other tobacco accessories, including as to the source and location of the cigars and accessories.

41. Cigars and cigar accessories are closely related goods.

42. Tobacco products and tobacco accessories are closely related goods.

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. Consumers in the United States and elsewhere in the world strongly associate cigars and tobacco with Cuba and particularly with Havana, Cuba.

45. The cigar and tobacco consuming public is likely to believe that the place identified by the mark – Havana, Cuba – describes Respondent’s goods, and their geographic origin, when the goods in fact do not come from Havana or Cuba.

46. Because of the powerful goods/place association between cigars and tobacco and Havana, Cuba, and the common consumer association of cigars and other tobacco products with cigar and tobacco accessories, consumers are likely to believe that Respondent’s goods come from Havana, Cuba, or Cuba, when in fact they do not.

47. The mark denotes, is, and will be understood by United States consumers as denoting, that the cigar and other tobacco accessories bearing that mark are manufactured, or otherwise originate, in Havana, Cuba, or Cuba.

48. Respondent’s goods do not come from, or otherwise originate in, Havana, Cuba or elsewhere in Cuba.

49. Consumers’ mistaken belief that Respondent’s goods come from Havana or Cuba would be a material factor for a substantial portion of consumers in their purchasing decision.

INJURY TO PETITIONERS

50. Petitioners believe that they have been and will be damaged by the registration of Respondent’s HAVANA TIME mark upon the Principal Register, including by Respondent’s use of that mark on cigar and other tobacco accessories of non-Cuban origin. Such registration and use will deceive consumers into believing that Cuban-origin cigar-related and other tobacco-related products are presently available for purchase in the U.S.

51. Petitioners’ success in marketing 100% Cuban-origin cigars and other tobacco products, and related cigar and other tobacco accessories to U.S. consumers as soon as U.S. law permits, including through use of the registered marks HABANOS UNICOS DESDE 1492 &

DESIGN, LA CASA DEL HABANO, and the applied-for certification mark HABANOS, will be and has been damaged and diminished by the registration of Respondent's mark that includes the term "Havana" for cigar-related and other tobacco-related accessories, which deceptively suggests that Respondent's goods are of Cuban origin.

52. Petitioners' current and ongoing ability to use the above-identified registered trademarks and "Habanos" as a geographic indication and certification mark in advertisements in the United States in connection with 100% Cuban-origin cigars, and related goods, will be and has been damaged by the registration of Respondent's HAVANA TIME mark.

53. Petitioner Cubatabaco believes that it will be and has been damaged by the registration of Respondent's HAVANA TIME mark because that registration may interfere with Petitioner Cubatabaco's efforts to register its certification mark HABANOS, which is pending before the USPTO.

FIRST GROUND FOR CANCELLATION

54. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 53 of this Petition to Cancel as if fully set forth herein.

55. Respondent's HAVANA TIME mark, as used on or in connection with Respondent's identified goods, is geographically 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 Registration should be cancelled.

SECOND GROUND FOR CANCELLATION

56. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 53 of this Petition to Cancel as if fully set forth herein.

57. Upon information and belief, Respondent was not using in commerce the

HAVANA TIME mark on or in connection with the identified goods when it filed its sworn Statement of Use, or thereafter, including at the time the registration issued.

58. The registration of Respondent's HAVANA TIME mark was void *ab initio*, because the mark was not in use in commerce when the Statement of Use was filed, and the Registration should be cancelled.

THIRD GROUND FOR CANCELLATION

59. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 53 of this Petition to Cancel as if fully set forth herein.

60. Upon information and belief, Respondent was not using in commerce the HAVANA TIME mark on or in connection with all the identified goods when it filed its sworn Statement of Use, or thereafter, including at the time the registration issued.

61. The registration of the HAVANA TIME mark was void *ab initio* as to those identified goods that were not in use in commerce when the Statement of Use was filed, and the Registration should be cancelled for said goods.

FOURTH GROUND FOR CANCELLATION

62. Petitioners repeat and reallege each and every allegation set forth in paragraphs 1 through 53 of this Petition to Cancel as if fully set forth herein.

63. Upon information and belief, Respondent made a material misrepresentation of fact when it declared in its sworn Statement of Use that it was using the HAVANA TIME mark in commerce on or in connection with all the identified goods, because the mark was not in use in commerce on all the goods so identified at that time, or previously.

64. Upon information and belief, the USPTO relied upon Respondent's misrepresentation that the HAVANA TIME mark was in use in commerce on all the listed goods

at the time the Statement of Use was filed in issuing the registration.

65. Respondent knew that its material misrepresentation was false when made, and made such knowingly false misrepresentation with the intent to deceive the USPTO in order to obtain the registration through such false statement.

66. Because Respondent's aforesaid misrepresentation was material, false, and made with intent to deceive the USPTO, the Registration should be cancelled.

WHEREFORE, Petitioners pray that Registration No. 4,175,844, for the mark HAVANA TIME, be cancelled pursuant to 15 U.S.C. § 1064, and that this Petition be granted in favor of the Petitioners.

Dated: December 6, 2012

Respectfully submitted,

By: /David B. Goldstein/
DAVID B. GOLDSTEIN
RABINOWITZ, BOUDIN, STANDARD,
KRINSKY & LIEBERMAN, P.C.
45 Broadway – Suite 1700
New York, New York 10006-3791
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 foregoing Petition to Cancel Registration No. 4,175,844 is being filed electronically today, December 6, 2012, 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 a true and correct copy of the foregoing Petition to Cancel Registration No. 4,175,844 was served on Respondent by mailing, postage prepaid, said copy on December 6, 2012, via U.S. Certified Mail, return receipt requested, to the address of record for the listed Owner, and also that a copy was mailed, postage prepaid, via U.S. Certified Mail, return receipt requested, to the address of the Attorney of Record and Correspondent of Registration No. 4,175,844 on the USPTO's TSDR database:

G & R Brands, LLC
6525 South Bruce Street
Las Vegas, NV 89119

Dana B. Robinson
P.O. Box 1416
La Jolla, CA 92038-1416

/David B. Goldstein/
David B. Goldstein