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

Proceeding	92058848
Party	Defendant Corporacion Habanos, S.A.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GUANTANAMERA CIGAR CO., INC.,)	
)	
Petitioner-Counterclaim-Respondent,)	
)	
v.)	Cancellation No. 92058848
)	Registration No. 4464150
CORPORACION HABANOS, S.A.,)	Registration No. 3377574
)	
Respondent-Counterclaimant.)	
)	

**COUNTERCLAIMANT’S REPLY IN SUPPORT OF MOTION FOR
RECONSIDERATION OR MODIFICATION AND FOR LEAVE TO AMEND**

Pursuant to Fed. R. Civ. P. 15(a)(2), 37 C.F.R. §§ 2.115, 2.127(b), and TBMP §§ 3.09.03(d), 315, 503.03, 507, 518, Counterclaimant Corporacion Habanos, S.A. (“Habanos, S.A.”) herewith files its Reply in further support of its motion for reconsideration or modification of the Board’s *sua sponte* Order of October 2, 2014, issued without notice to, or an opportunity for briefing by, Habanos, S.A., and for leave to amend.

I. THE IAC CLAIM IS NOT TIME-BARRED

The only counterclaim that the Board dismissed as time-barred, and for which Habanos, S.A. seeks reconsideration, is the Eighth Counterclaim, for cancellation under Article 8 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907 (“IAC”). As Habanos, S.A. showed, the IAC claim is plainly not time-barred under controlling authority. *See* Habanos, S.A. Brief (“HSA Br.”) at 6-8 (citing, *inter alia*, *British-American Tobacco Co. v. Phillip Morris, Inc.*, 55 USPQ2d 1585, 1588-90 (TTAB 2000), *recon. denied*, 2001 WL 256142, at *2 (TTAB Feb. 27, 2001); TBMP § 307.02(a)).

Counterclaim-Respondent Guantanamera Cigar Co., Inc. (“GCC”) makes no argument whatsoever that the IAC claim is time-barred; indeed, it never even addresses the IAC claim.

Further, GCC's assertion, in the face of Habanos, S.A.'s IAC argument, that "Habanos did not, and can not cite to a single legal authority that stands for the proposition that the Board's dismissal of several of its counterclaims was not proper," GCC Br. at 1, is, at best, untrue.

Habanos, S.A. further showed that reconsideration is appropriate because the Board clearly overlooked directly controlling and uncontradicted authority in finding that the IAC Article 8 claim is time-barred, HSA Br. at 5-8, and GCC never argues otherwise.

II. LEAVE TO AMEND SHOULD BE GRANTED

Habanos, S.A. has shown that it should be granted leave to amend its Sixth Counterclaim alleging fraud and its Ninth Counterclaim pursuant to the Board's statutory authority to determine the right to registration, and to add a Tenth Counterclaim pursuant to 15 U.S.C. § 1068, as each of these claims states a proper claim for cancellation. *See* HSA Br. at 8-17. As also shown, and which GCC does not contest, the Board's practice, even in contested dismissals, is to grant leave to amend; notably, the Board's *sua sponte* dismissal, without notice or opportunity to be heard, did not state that the dismissal was with prejudice. *See id.* at 5, 9.

In response, GCC makes no argument that any of the three proposed amended claims fail to state a claim for relief. Indeed, GCC nowhere even specifically addresses any of the proposed amended claims. Thus, GCC fails to challenge any of Habanos, S.A.'s extensive specific factual allegations in its amended fraud claim, primarily based on GCC's principal's own sworn statement, or to argue that these allegations fail to plead fraud with the requisite specificity. *See id.* at 9-12. GCC likewise fails to challenge Habanos, S.A.'s showing that the Board can grant relief under the Ninth Claim, either as originally pled or as amended, nor does it dispute Habanos, S.A.'s showing that the Board misunderstood the claim as one based upon "examining attorney error." *Id.* at 12-15. Again, GCC makes no argument that the Tenth Counterclaim fails

to state a claim for partial cancellation. *See id.* at 15-17.

Rather, GCC's entire argument against amendment is that "the interlinear amendments, and the additional counterclaim that Habanos seeks to add would be futile," GCC Brief at 3, but with no argument or explanation whatsoever how or why any of the proposed amendments would be futile. Finally, neither the Board nor any court, to Habanos, S.A.'s knowledge, has ever suggested, let alone held, that either the existence of other valid claims, or the possibility that viable claims could lead to "intensive litigation," justifies dismissal of a valid claim or denial of leave to amend, particularly at this preliminary pleading stage. *Id.* Nor does GCC, in fact, assert otherwise.

In the absence of any argument or explanation that any of the proposed amendments are futile, leave to amend should be granted for the reasons previously shown.

CONCLUSION

For the reasons stated herein, and on the prior papers and proceedings had herein, the Motion of Counterclaimant Habanos, S.A. For Reconsideration or Modification of the Board's October 2, 2014 Order, and for Leave to Amend Counterclaims should be granted.

Dated: December 1, 2014

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Counterclaimant's Reply in Support of Motion for Reconsideration or Modification and for Leave to Amend was served on Petitioner by mailing, postage prepaid, said copy on December 1, 2014, via U.S. first-class mail, to:

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