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December 15, 2020

Cancellation No. **92065427**

PEI Licensing, LLC

v.

Havana Club Holding, S.A

Before Mermelstein, Bergsman and Lykos,[1]
Administrative Trademark Judges

By the Board:

On June 30, 2020, the Board denied the parties' cross-motions for summary judgment on Petitioner's claim of no bona fide intent to use the mark in commerce but granted Respondent's cross-motion for summary judgment on Petitioner's claim of abandonment.[2] On July 30, 2020, Petitioner timely moved for reconsideration of the Board's granting of summary judgment on its claim of abandonment.[3] The motion is fully briefed.[4]

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[1] Judge Larkin sat on the panel for the motion for summary judgment. The change in composition of the panel does not necessitate a rehearing of the motion for summary judgment. *Cf. In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985); *Hunt Control Sys., Inc. v. Koninklijke Philips Elecs. N.V.*, 98 USPQ2d 1558, 1560 n.1 (TTAB 2011).

[2] 30 TTABVUE.

[3] 31 TTABVUE.

[4] 31 TTABVUE, 32 TTABVUE and 33 TTABVUE.

The purpose of a motion for reconsideration is to demonstrate that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. It should not be used as a vehicle to introduce additional evidence or to reargue points that have already been presented in the briefs on the original motion. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 518 (2020).

It is Petitioner's contention that the Board's prior order "contained both an error of law and logic" that mandates reconsideration.[5] Specifically, Petitioner argues that the order is "logically inconsistent" because "the Board found a disputed question of fact as to whether [Respondent] had *bona fide* intent to use the Marks at the time of filing [yet] the Board found no disputed question of fact that [Respondent] had a *bona fide* intent later,"[6] and legally erroneous because "the Board's Order did not mention or address the legal requirement that [Respondent] must also possess a *bona fide* intent to use the VERA CUBA Marks at the time of filing its Section 8 nonuse declaration."[7] Such argument is inapt and unpersuasive as Petitioner improperly equates the burden on Respondent in filing a Section 8 declaration with the burden on Petitioner in proving abandonment.

A claim of abandonment requires a showing that the party against whom the claim of abandonment is made "is not using the mark with its goods and services, and has no intent to resume use." *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d

[5] 31 TTABVUE 3.

[6] *Id*. at 2.

[7] *Id*. at 4.

1015, 1020 (TTAB 2018). A showing of three consecutive years of nonuse gives rise to the presumption of an intent not to resume use, *see id.*, and is sufficient to establish a *prima facie* case of abandonment. *See* Trademark Act Section 45, 15 U.S.C. § 1127; *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *15 (TTAB 2019). Here, there is no genuine dispute that the Cuban trade embargo constitutes a special circumstance that is beyond Respondent's control and therefore sufficient to excuse any nonuse arising therefrom. As Respondent's nonuse is excused, there can be no abandonment. *See Miller Brewing Co. v. Oland's Breweries (1971) Ltd.*, 548 F.2d 349, 192 USPQ 266, 268 (CCPA 1976) ("abandonment does not result from a mere temporary withdrawal from the market forced by outside causes ('excusable nonuse')"); *see also Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990) ("Intent to resume use in abandonment cases has been equated with a showing of special circumstances which excuse a registrant's nonuse. … Thus, whether one characterizes the 'intent' element of abandonment as an intent not to resume use or an intent to abandon is not significant. If a registrant's nonuse is excusable, the registrant has overcome the presumption that its nonuse was coupled with an 'intent not to resume use,' or … an 'intent to abandon.'").

Thus, there is no inconsistency between our determination of the abandonment claim and our finding of a genuine dispute of material fact on the question of Respondent's lack of a bona fide intent to use its marks at the time of filing, and Petitioner has offered nothing more than argument on the point. Indeed,

Petitioner's current position in seeking reconsideration ("If [Respondent] lacked a *bona fide* intent at the time of filing the applications, then the Board must also call into question whether [Respondent] had a *bona fide* intent seven years later, at the time it filed the Section 8 declarations")[8] appears to reverse its original position in pleading abandonment ("Even if Respondent could establish evidence of intent to use at the time of filing the applications for the VERA CUBA trademarks, Respondent has never made actual bona fide use of the VERA CUBA trademarks ….").[9]

As Petitioner has failed to demonstrate that the Board erred in granting summary judgment against Petitioner on its abandonment claim, the motion for reconsideration is **DENIED**.

Briefing on Petitioner's motion to compel is **RESUMED**. To that end, Respondent is allowed until **TWENTY DAYS** from the mailing date of this order to file a response to Petitioner's motion. A reply brief, if any, shall be due in accordance with Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a).

Proceedings remain otherwise **SUSPENDED**.

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[8] 31 TTABVUE 6.

[9] 1 TTABVUE 8.