

01-17-2002

Form PTO-1594  
(Rev. 03/01)  
OMB No. 0651-0027 (exp. 5/31/2002)



U.S. DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office

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101938054

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

- Individual(s)
- General Partnership
- Corporation-State
- Other U.S. District Court for SONY
- Association
- Limited Partnership

Additional name(s) of conveying party(ies) attached?  Yes  No

3. Nature of conveyance:

- Assignment
- Security Agreement
- Other COURT order
- Merger
- Change of Name

Execution Date: 10/30/97

2. Name and address of receiving party(ies)

Name: EMPRESA CUBANA EXPORTADA  
Internal DE ALIMENTOS Y PRODUCTOS  
Address: VARIOS T/A CUBAEXPORT

Street Address: 55 23RD ST  
City: Vedado HAVANA State: CUBA Zip: \_\_\_\_\_

- Individual(s) citizenship \_\_\_\_\_
- Association \_\_\_\_\_
- General Partnership \_\_\_\_\_
- Limited Partnership \_\_\_\_\_
- Corporation-State CUBA
- Other \_\_\_\_\_

If assignee is not domiciled in the United States, a domestic representative designation is attached:  Yes  No  
(Designations must be a separate document from assignment)  
Additional name(s) & address(es) attached?  Yes  No

4. Application number(s) or registration number(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s)

1,031,651

Additional number(s) attached  Yes  No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: EMPRESA CUBANA EXPORTADA T/A  
CUBAEXPORT

Internal Address: \_\_\_\_\_

Street Address: 55-23RD ST.

Vedado  
City: HAVANA State: CUBA Zip: \_\_\_\_\_

6. Total number of applications and registrations involved: \_\_\_\_\_

1

7. Total fee (37 CFR 3.41).....\$ \_\_\_\_\_

- Enclosed
- Authorized to be charged to deposit account

8. Deposit account number: \_\_\_\_\_

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Lynne Beresford  
Name of Person Signing

Lynne Beresford  
Signature

01/17/02  
Date

Total number of pages including cover sheet, attachments, and document: 1

Mail documents to be recorded with required cover sheet information to:  
Commissioner of Patent & Trademarks, Box Assignments  
Washington, D.C. 20231

TRADEMARK  
REEL: 002398 FRAME: 0855

UNITED STATES PATENT AND TRADEMARK OFFICE

HAVANA CLUB HOLDING, S.A. )  
 HAVANA CLUB, INTERNATIONAL, S.A. )  
 )  
 Plaintiffs-Counter-Defendants-Appellants, )  
 )  
 vs. )  
 )  
 GALLEON, S.A., )  
 BACARDI-MARTINI, USA, INC. )  
 )  
 Defendants-Appellees. )

NOTICE

On October 20, 1997, the United States District Court for the Southern District of New York entered a Partial Judgment which concerns U.S. trademark registration No. 1,031,651, for the trademark "HAVANA CLUB & DESIGN" for use on rum. The Partial Judgment and accompanying opinion were certified to the Director of the United States Patent and Trademark Office pursuant to 15 U.S.C. § 1119. However, the district court ordered that the operation and enforcement of the Partial Judgment be stayed pending appeal from the final judgment in the case. On October 26, 2001, pursuant to a request from one of the parties, the United States Patent and Trademark Office (USPTO) issued an Order to Show Cause why the Director of the United States Patent and Trademark Office should not now rectify the records of the USPTO pursuant to 15 U.S.C. § 1119 to reflect the district court's order invalidating the following recorded assignments of the entire interest and goodwill in U.S. Registration No. 1,031,651 (Serial No. 73/023981):

- (1) Reel: 1104 Frame: 0046
- Assignor: Empresa Cubana Exportadora De Alimentos y Productos Varios, S.A. DBA Cubaexport
- Assignee: Havana Rum and Liquors, S.A.

(2) Reel: 1129 Frame: 0428

Assignor: Havana Rum and Liquors, S.A.

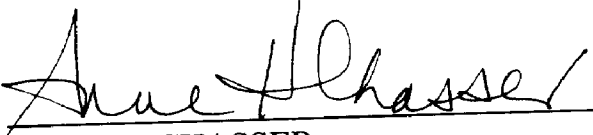
Assignee: Havana Club Holdings, S.A. DBA HCH, S.A.

Having considered the initial submissions and replies from each party and the arguments therein, the Director of the United States Patent and Trademark Office hereby gives notice that pursuant to 15 U.S.C. § 1119, the records of the USPTO will be rectified to reflect the district court's order invalidating the recorded assignments set forth above. Accordingly, the USPTO's registration records will also be rectified to conform with the assignment records.

This Notice shall be served upon:

- (1) Plaintiffs, by service upon counsel Charles S. Sims, Esq., Proskauer Rose, LLP, 1585 Broadway, New York, N.Y. 10036, and by service upon Michael Krinsky, Esq., Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., 740 Broadway, New York, N.Y. 10003; and
- (2) Defendants, by service upon counsel William R. Golden, Jr., Esq. Kelley, Drye & Warren, LLP, 101 Park Avenue, New York, N.Y. 10178.

Dated: 1/15/02

  
ANNE H. CHASSER  
Commissioner for Trademarks

UNITED STATES PATENT AND TRADEMARK OFFICE

HAVANA CLUB HOLDING, S.A. )  
 HAVANA CLUB, INTERNATIONAL, S.A. )  
 )  
 Plaintiffs-Counter-Defendants-Appellants, )  
 )  
 vs. )  
 )  
 GALLEON, S.A., )  
 BACARDI-MARTINI, USA, INC. )  
 )  
 Defendants-Appellees. )

ORDER TO SHOW CAUSE

On October 20, 1997, the United States District Court for the Southern District of New York entered a Partial Judgment (Attachment 1) which concerns U.S. trademark registration No. 1,031,651 for the trademark "HAVANA CLUB & DESIGN" for use on rum (Attachment 2). Office records indicate that the registration was issued to Empresa Cubana Exportadora De Alimentos Y Productos Varios trading as Cubaexport. An assignment of the registration to Havana Rum and Liquors, S.A. (HR&L, S.A.) was recorded on January 10, 1994. On September 13, 1994, an assignment of the registration to Havana Club Holdings, S.A. DBA HCH, S.A. was recorded.

With regard to this registration, the district court states in pertinent part:

5. As a result, the status quo ante as of the October 29, 1993 date of said abortive original transfer agreement is restored, and Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers.
6. Neither Havana Rum & Liquors, S.A., Havana Club Holding, S.A., nor its licensee, Havana Club International, S.A. ever obtained any rights to the HAVANA CLUB mark in the United States by transfer.

7. Plaintiffs Havana Club, S.A. and Havana Club International, S.A. have no rights to the registered trademark HAVANA CLUB for 'rum' in the United States.

8. Any rights that Havana Club Holding, S.A. may have had, may have or claims to have had in the Registration of the HAVANA CLUB trademark (U.S. Reg. No. 1,031,651) from forever until today are hereby canceled.

Havana Club Holding, S.A. v. Galleon S.A., No. 96 Civ. 9655, slip op. at 2 (S.D.N.Y. filed Oct. 20, 1997) (Partial Judgment) (Attachment 1, ¶¶ 5-8).

The district court certified the order and an accompanying order and opinion dated August 8, 1997, to the Director of the United States Patent and Trademark Office pursuant to 15 U.S.C. § 1119. However, the district court ordered that the operation and enforcement of the partial judgment be stayed pending appeal from the final judgment in the case. *Id.* at 3, ¶ 12. The district court subsequently entered a final judgment for the defendants, which was affirmed by the Court of Appeals for the Second Circuit. (Attachment 3); *see also*, Havana Club Holding, S.A. v. Galleon S.A., 203 F.3d 116, 135 (2d Cir.2000).

On August 17, 2001, William Golden, Jr., counsel for Galleon, S.A. and Bacardi-Martini USA Inc., sent correspondence concerning this case to the Office of the Commissioner for Trademarks at the United States Patent and Trademark Office (USPTO). Mr. Golden's letter suggests that the stay pending the appeal from the Final Order is now lifted (Attachment 4).

Accordingly, the parties are hereby given 14 days from the date of this Order to show cause why the Director of the United States Patent and Trademark Office should not now rectify the records of the USPTO pursuant to 15 U.S.C. § 1119 to reflect the district court's order invalidating the following recorded assignments of the entire interest and goodwill in U.S. Reg. No. 1,031,651

(Serial No. 73/023981):

(1) Reel: 1104 Frame: 0046

Assignor: Empresa Cubana Exportadora De Alimentos y Productos Varios, S.A. DBA  
Cubaexport

Assignee: Havana Rum and Liquors, S.A.

(2) Reel: 1129 Frame: 0428

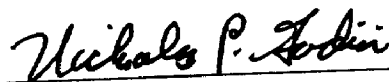
Assignor: Havana Rum and Liquors, S.A.

Assignee: Havana Club Holdings, S.A. DBA HCH, S.A.

This Order shall be served upon:

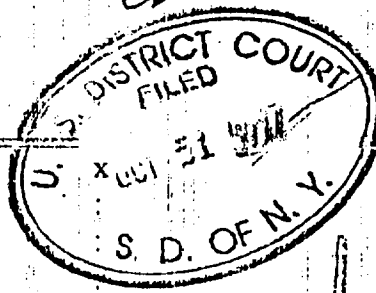
- (1) Plaintiffs, by service upon counsel Charles S. Sims, Esq., Proskauer Rose, LLP, 1585 Broadway, New York, N.Y. 10036, and by service upon Michael Krinsky, Esq., Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., 740 Broadway, New York, N.Y. 10003; and
- (2) Defendants, by service upon counsel William R. Golden, Jr., Esq., Kelley Drye & Warren, LLP, 101 Park Avenue, New York, N.Y. 10178.

Dated: OCT 26 2001



NICHOLAS P. GODICI  
Acting Under Secretary of Commerce for Intellectual  
Property and Acting Director of the United States  
Patent and Trademark Office

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK



OCT 20 1997

HAVANA CLUB HOLDING, S.A. and  
HAVANA CLUB INTERNATIONAL, S.A.,

Plaintiffs,

- against -

96 Civ. 9655 (SAS)

PARTIAL JUDGMENT

GALLEON S.A., BACARDI-MARTINI USA,  
INC., GALLO WINE DISTRIBUTORS,  
INC., G.W.D. HOLDINGS, INC.  
and PREMIER WINE AND SPIRITS,

Defendants.

WHEREAS, the Plaintiffs initiated this action alleging, inter alia, infringement of the registered mark HAVANA CLUB for rum; and

WHEREAS, this Court issued its opinion dated August 8, 1997, in connection with certain motions therein;

NOW, THEREFORE, IT IS ORDERED, ADJUDGED AND DECREED:

1. The Cuban Asset Control Regulations ("CACR") implemented in 1963 under Section 5(b) of the Trading With The Enemy Act of 1917, as amended, 50 U.S.C. App. 1-44, prohibit transfers of property, including trademarks, in which a Cuban entity has an interest except when authorized by the Office of Foreign Assets Control ("OFAC") acting on behalf of the Secretary of the Treasury.

-3:00 PM

OCT 21 1997

2. In 1976, the trademark HAVANA CLUB for "rum" was registered in the United States Patent and Trademark Office ("related U.S. Registration") by Empresa Exportadora de Alimentos y Productos Varios ("Cubaexport"), a Cuban state enterprise.

3. On October 29, 1993, Cubaexport entered into an agreement transferring the U.S. rights to the HAVANA CLUB trademark and the related U.S. Registration to Havana Rum & Liquors, S.A. On or about November 22, 1993, Havana Rum & Liquors, S.A. entered into an agreement transferring the aforesaid mark and the related U.S. Registration to Havana Club Holding, S.A.

4. Those provisions of the original transfer agreement relating to transfers of the U.S. rights to the HAVANA CLUB mark and the related U.S. Registration were rendered null and void by the CACR, § 515.201(b)(1), and the attempted assignment of said HAVANA CLUB mark and the related U.S. Registration were invalid and of no force and effect and void ab initio.

5. As a result, the status quo ante as of the October 29, 1993 date of said abortive original transfer agreement is restored, and Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers.

6. Neither Havana Rum & Liquors, S.A., Havana Club Holding, S.A. nor its licensee, Havana Club International, S.A. ever obtained any rights to the HAVANA CLUB mark in the United States by transfer.

7. Plaintiffs Havana Club Holding, S.A. and Havana Club International, S.A. have no rights to the registered trademark HAVANA CLUB for "rum" in the United States.

8. Any rights that Havana Club Holding, S.A. may have had, may have or claims to have had in the Registration of the HAVANA CLUB trademark (U.S. Reg. No. 1,031,651) from



forever until today are hereby canceled.

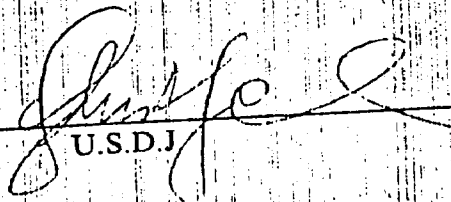
9. ✓ Count I for infringement of a federally registered trademark under Section 32 of the Lanham Act is dismissed with prejudice.

10. / Nothing herein shall prevent Cubaexport, if it so chooses, from asserting or seeking to enforce rights in the trademark HAVANA CLUB rum in the United States and nothing herein shall prevent the defendants or others from contesting those rights or contending that said rights were lost as a result of acts or omissions by Cubaexport.

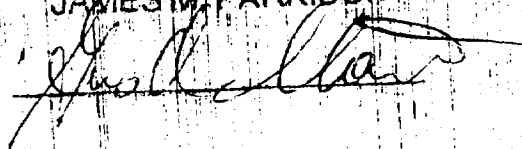
11. / The Court certifies the instant Order and its Opinion and Order dated August 8, 1997 to the Commissioner of Patents and Trademarks pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119.

12. / The operation and enforcement of this Judgment, including modification of or entry upon the records of the United States Patent and Trademark Office pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, are stayed pending appeal from the final judgment in this action.

Dated at New York, New York, this 20 day of Oct October, 1997.

  
U.S.D.J.

**CERTIFIED**  
JAMES M. PARKISON



THIS DOCUMENT WAS ENTERED  
ON THE DOCKET ON 10-22-97