

Second Circuit, Federal Circuit and TTAB crossroads: Cuban embargo or Pan-American Convention?

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The Pan-American Convention interplay with Sections 17(a) and 44(h) of the Lanham Act resulted in statutory grounds for trademark cancellation when before the Trademark Trial and Appeal Board (the ‘TTAB’ or ‘board’), but did not give rise to a separate right to sue when in federal court.

Background

On 20 December 2022 the Trademark Trial and Appeal Board issued a precedential opinion in *Empresa Cubana Del Tabaco dba Cubatabaco v General Cigar Co Inc* (Cancellation No 92025859), recounting decades of litigation between the named entities.

In 1969 petitioner Empresa Cubana Del Tabaco dba Cubatabaco applied to register the mark COHIBA in Cuba (said registration issuing in 1972), and began producing COHIBA-branded cigars. Throughout the 1970s, such COHIBA cigars were gifted by Cuban political figures and government bodies to US persons. On 15 November 1977 Forbes magazine published an article on Cuban tobacco helping the US cigar industry and referenced Cubatabaco’s COHIBA brand.

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