



## **Bacardi Advances Havana Club Trademark Case in U.S. District Court**

### ***Bacardi files new complaint; Asks court to strike the Havana Club mark from the register***

Coral Gables, Fla., March 15, 2016 – In an ongoing effort to defend its rights and ownership of the Havana Club rum brand and trademark in the United States, Bacardi has filed an amended complaint with the U.S. District Court for the District of Columbia. This filing amends the original complaint Bacardi filed in March 2004 under the Lanham Act (also known as the Trademark Act of 1946), the federal statute that governs trademarks, service marks, and unfair competition. The Defendants in the complaint are Cubaexport, an agency of the Cuban government, and Havana Club Holding S.A., the joint venture company between the Government of Cuba and Pernod Ricard – the second largest spirits company in the world.

With this filing, Bacardi asks the Court – presided over by District Judge Emmet Sullivan – for the cancellation of the Cuban government’s Havana Club trademark registration in the U.S Patent & Trademark Office (“PTO”) based on, among other things, the Administration’s fraud in obtaining the original filing. Bacardi also seeks a declaration that it has common law rights in the mark based on distribution and sales of Havana Club branded products in the United States. Bacardi obtained the rights to the mark through a lawful and U.S. Office of Foreign Assets Control (“OFAC”)-licensed transaction with the brands original owner and creator Jose Arechabala S.A.

“We are extremely disappointed to have to resort to using the precious time and resources of the U.S. justice system due to the failure of the U.S. government in following established legal and public policy protecting the rights of those who have suffered confiscations of property,” says Rick Wilson, senior vice president for external affairs for Bacardi in the U.S. “A ‘let the courts decide’ mentality is not the way to go when, for decades, the Cuban government and its business partner intentionally and knowingly concealed and misrepresented to the PTO the pertinent facts that have undermined its claims as the lawful owner of the mark in order to deceive the PTO and maintain the registration.”

In the filing, Bacardi outlines the elaborate, misleading, fraudulent and deceptive activities employed by the Cuban government and its joint venture partner Pernod Ricard concerning the obtaining, maintenance and renewal of the Havana Club trademark in the U.S. Among other things, Bacardi states that Section 211 prohibits any U.S. court from recognizing, enforcing or otherwise validating the Cuban government’s assertion of rights in a mark incorporating the words Havana Club because the mark was associated with a business that was illegally confiscated by the Cuban government in 1960.

“The United States has a long history of upholding the law and non-recognition of foreign confiscations so we are confident Bacardi will once again prevail in this decades-long matter,” says Eduardo Sánchez, senior vice president and general counsel for Bacardi. “No company or government should be able to profit from stolen property.”

Bacardi seeks four specific actions from the Court:

- 1) Reversal of the PTO decision by striking the Havana Club registration from the principal register on the grounds that the Cuban government failed to file the mandatory renewal application and declaration prior to the end of the statutory period in 1996, and failed to file a legally adequate renewal application in 2006, or alternatively, canceling that registration on the grounds that the U.S. Havana Club registration was fraudulently obtained, maintained, and renewed; that the registered mark was abandoned; and that the registered mark misrepresents the source of goods;

- 2) A declaration that Bacardi owns the common law rights in the Havana Club mark for rum, and that the Defendants has no common law or other rights in any mark incorporating or consisting of the words Havana Club;
- 3) A declaration that Bacardi's use of the Havana Club mark does not infringe on any mark owned by the Cuban government or its joint venture partner or otherwise violate any enforceable rights of the Cuban government or a state-owned entity, because longstanding U.S. public policy and Section 211 of the Omnibus Consolidated and Emergency Supplemental Appropriations Act, passed by a bi-partisan Congress on Oct. 21, 1998, preclude recognition and enforcement of purported rights in a trademark or registration that are founded on the Cuban government's expropriation of assets; and
- 4) An injunction prohibiting the Defendants from using or registering in the U.S. any mark incorporating or consisting of the words Havana Club and from interfering with Bacardi's use and registration of the Havana Club mark.

"Following the U.S. government's failure to uphold the protection of confiscated properties, the U.S. courts will now need to step in and recognize the rights of legitimate owners whose properties have been expropriated," adds Sánchez.

On August 3, 2006, the PTO issued an office action that stated that the Cuban government's registration of the Havana Club mark will be "cancelled / expired." Because cancellation of the registration would provide equivalent relief that was sought in this matter, the D.C. District Court stayed the entire case on May 24, 2007, pending final resolution of the PTO office action. In January of this year, the PTO suddenly and unexpectedly reversed course and permitted the Cuba government to renew its Havana Club registration retroactively. Thus, Bacardi has no choice but to continue its efforts in the D.C. District Court to obtain cancellation of the Cuban government's registration and protect Bacardi's rights in the Havana Club mark in the United States.

### **About Bacardi**

Bacardi, the largest privately held spirits company in the world, produces and markets internationally recognized spirits and wines. The company boasts a portfolio of some of the most iconic and top-selling spirits brands including BACARDÍ® rum, GREY GOOSE® vodka, DEWAR'S® blended Scotch whisky, BOMBAY SAPPHIRE® gin, CAZADORES® 100% blue agave tequila, MARTINI® vermouth and sparkling wines, and other leading and emerging brands.

Bacardi U.S.A., Inc. and Bacardi North America Corp. are headquartered in Coral Gables, Florida. Bacardi North America and affiliated companies house nearly 300 people in the headquarters office. Added to other Bacardi operations in the North America, Bacardi employs more than 800 in the U.S. and Canada.

Founded 154 years ago in Santiago de Cuba on February 4, 1862, family-owned Bacardi manufactures its brands at 29 facilities and sells in more than 160 countries. Based in Hamilton, Bermuda, Bacardi Limited refers to the Bacardi group of companies, including Bacardi International Limited. [www.BacardiLimited.com](http://www.BacardiLimited.com)

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