Legal Opinion Letter

WLF Washington Legal Foundation

Advocate for freedom and justice®
2009 Massachusetts Avenue, NW
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Vol. 17 No. 21 October 5, 2007

CONGRESS SHOULD NOT TREAD ON COURTS' RESOLUTION OF TRADEMARK DISPUTES

by
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An important debate has emerged in the last few years over the proper role of the courts in our constitutional democracy. Some elected officials have decried rulings which, in their opinion, tread on Congress's authority. For instance, bills are currently pending in Congress to overturn two 2007 U.S. Supreme Court rulings, *Ledbetter v. Goodyear Tire* (Lilly Ledbetter Fair Pay Act, H.R. 2831, passed House of Representatives on July 31) and *Rockwell v. United States* (The False Claims Correction Act). Often overlooked in the role of the courts debate is legislators' failure to recognize that it is the courts', not Congress's, responsibility "to determine actual controversies arising between litigants, duly instituted in courts of proper jurisdiction." *Muskrat v. United States*, 219 U.S. 346, 361 (1911). An ongoing dispute involving the ownership of a federal trademark provides one timely example of Congress's lack of respect for constitutional separation of powers.

The dispute involves the ownership, under laws and treaties of the United States, of the trademark "Havana Club" in the U.S. The product at issue is "Cuban" rum. In 1953, a Cuban company, Jose Arechabalas S.A. (JASA), registered the "Havana Club" trademark in the U.S., providing it with legal protection for that name for a twenty year period. Upon seizing power in 1960, the Castro regime nationalized JASA's distillery and assets in Cuba and the company stopped producing rum. This action did not affect JASA's ownership of the "Havana Club" mark in the U.S. However, in 1973, JASA, perhaps under the misimpression that it had to be selling rum in the U.S. in order to renew its U.S. trademark, *see* James Cox, *Rum Rivals Fight Castro on U.S. Trademark Turf*, USA TODAY, Aug. 11, 1999, allowed its registration for "Havana Club" to expire.

In 1976, the U.S. Patent and Trademark Office granted a trademark, without opposition, for "Havana Club" to state-owned Cuban company, Cubaexport. Cubaexport in 1993 entered into a joint venture with a foreign partner, and transferred worldwide holdings of the "Havana Club" mark to Havana Club Holdings (HCH), and HCH renewed its U.S. trademark rights to "Havana Club" for another ten years in 1996. The Arechabalas family sold whatever rights it held to the original "Havana Club" mark to Bacardi in 1996, which then produced and distributed its Havana Club rum in the U.S. In December of 1996, HCH sued Bacardi in federal district court. Just before trial in October 1998, the U.S. Senate, without any debate or attendant legislative history, adopted an amendment to the Department of Commerce and Related Agencies Appropriations

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Act. The amendment, known as Section 211, in effect prohibits U.S. courts from recognizing, enforcing, or otherwise validating any assertion of rights of trademarks used in connection with any business that was nationalized by the Cuban government. Section 211 had its intended effect, as on June 28, 1999, the federal district court, relying on that law, dismissed HCH's claims. *Havana Club Holdings, S.A. v. Galleon, S.A.*, 62 F. Supp. 2d 1085 (S.D.N.Y. 1999). The U.S. Court of Appeals for the Second Circuit, also relying on Section 211, affirmed the district court. *Havana Club Holdings S.A. v. Galleon, S.A.*, 203 F.3d 116 (2d Cir. 2000).

Legal wrangling in the trademark dispute continued, and has intensified over the past two years. In December 2005, Cubaexport submitted an application to the U.S. Patent and Trademark Office (PTO) to renew the "Havana Club" mark for another ten years. As it was required to, Cubaexport advised the Office of Foreign Assets Control (OFAC) of its intention to seek an extension. OFAC refused to provide Cubaexport with a formal license allowing it to pay the $100 application fee to the PTO, and the PTO in return refused to accept Cubaexport's application. In August 2006, Bacardi moved forward with marketing of its Havana Club rum, and Cubaexport's foreign partner filed a federal false advertising lawsuit against Bacardi. In September 2006, Cubaexport sued OFAC for denial of substantive and procedural due process. Both suits are still pending, and the PTO has put Cubaexport's appeal of its decision on the trademark extension on hold.

Although the language of Section 211 is clearly broad, the highly political nature of the Bacardi-HCH dispute leaves little doubt that the amendment was targeted at least in part at the ongoing court disputes. The main criticisms of 211 are that it completely ignores several long-standing principles of trademark law and stripped the courts' ability to apply them. As one trademark expert has pointed out, "The effect of Section 211 . . . was and is to oust abandonment – in the specific context of U.S. rights purportedly held by Cuban entities – from the normal, critical role it has long played in U.S. Trademark Law." Testimony of Professor Kenneth B. Germain, U.S. Senate Committee on the Judiciary, July 13, 2004. A key tenet of trademark law is demonstrated use of the mark, and HCH sought to prove in its 1996 suit that JASA abandoned its use of "Havana Club," and failed to avail itself of special exceptions federal law provides for non-use. Bacardi has particular counterarguments to HCH's abandonment defense. Rather than allow the courts to resolve the factual dispute over use of the mark, Congress dictated that use was irrelevant, and set in stone what federal law seeks to avoid – the existence of unused, "deadwood" marks which collect on the federal trademark rolls and potentially stoke consumer confusion. *See id*. Both the district and appellate courts explicitly held that there is no abandonment "exception" to Section 211. For at least this reason, the World Trade Organization ruled that Section 211 violates basic principals of the Trade-Related Aspects of Intellectual Property Rights agreement.

Section 211's proponents argue that the Congress needed to ensure that U.S. law did not advance the interests of those who arguably benefited from Castro's expropriation actions over the interests of those whose property was seized. In fact, U.S. courts have addressed such a situation. As the U.S. Court of Appeals for the Fifth Circuit stated in *Maltina Corp. v. Cawy Bottling Co., Inc*., "it is settled by a long line of cases that 'our courts will not give 'extraterritorial effect' to a confiscatory decree of a foreign state, even where directed against its own nationals.' [citations omitted]. Thus, 'foreign confiscatory decrees purporting to divest nationals and corporations of the foreign sovereign property located in the United States uniformly have been denied effect in our courts.'" 462 F.2d 1021, 1025 (5th Cir), *cert. denied*, 409 U.S. 1060 (1972). Rather than allow the federal courts to determine whether JASA could benefit from the presumption spelled out in *Maltina*, Section 211 created perpetual legal rights for one trade name or trademark owner who may have never even used that property in the U.S.

Given the history underlying the "Havana Club" ownership dispute, it is not surprising that politicians would demonstrate an interest in its outcome. But how they demonstrated that interest – by quietly stripping a court of jurisdiction to hear the dispute – did a disservice to intellectual property law and the courts that are constitutionally tasked with applying it. No matter how popular such an action may be with a certain constituency, Congress owes it to all litigants who come before federal courts seeking impartial justice to show more respect for the separation of powers.

ISBN 1056 3059