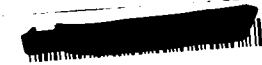


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of	)	
	)	
HERBAN AVENUES, L.L.C.	)	Opposition No. 91157596
	)	
Opposer,	)	Application No. 78/138,031
v.	)	
	)	
HERBANCOWBOY.COM, INC.	)	Mark: <b>HERBANCOWBOY</b>
	)	
Applicant.	)	

  
11-06-6203  
U.S. Patent & TMOtc/TM Mail Rcpt Dt. #78

**OPPOSER'S MOTION AND SUPPORTING MEMORANDUM  
TO DISMISS AND/OR STRIKE, IN PART, APPLICANT'S COUNTERCLAIM**

HerbanCowboy.com, Inc. ("HerbanCowboy") in "Applicant's Answer and Defenses to Notice of Opposition and Counterclaim Petition for Cancellation of Opposer's Registration" (the "Petition") appears to contend that the registration of HERBAN AVENUES should be cancelled due to alleged misuse of the statutory notice for goods *not* identified in the registration. Herban Avenues, L.L.C. ("Herban Avenues") moves respectfully for the dismissal and/or striking of the claim.

**A.  
Background**

In its Petition, HerbanCowboy contends it is being damaged by the registration of HERBAN AVENUES (Registration No. 2,499,364), which is owned by Herban Avenues. HerbanCowboy requests the cancellation of the registration, in part, on allegations contained in paragraph numbered 29 of the Petition, which states:

On information and belief, it is further asserted that, based upon a review of the goods and products offered on the Opposer's website, Herban Avenues is using the mark HERBAN AVENUES along with the "®" symbol in connection with insect repellent, bug bite salve, scarves, sunburn relief, rhus tox pills, poison ivy salve, hand and baby care lotion, menopause symptom relief, loofah slippers and sponge, cold and sinus relief, salt rub, aroma pillows, herbal playdough, waterless

wash, bed warmers, freezer pouches, nature candy, teas, herb tinctures, cleansing herbal powder, deodorant stones, soy nuts snack and dried herbs. None of these goods are set forth in the identification of goods for Opposer's registration on the mark HERBAN AVENUES, evidencing further improper marking of goods.

**B.**

**Any Claim for Improper Marking of Goods or  
Misuse of Statutory Notice Should Be Dismissed**

Paragraph numbered 29 of the Petition should be stricken and any claim based upon improper marking or misuse of statutory notice should be dismissed. Noticeably absent from the provisions of 15 U.S.C. § 1064 is any basis upon which to cancel a registration due to the improper marking of goods *not* identified in the registration.

It is clear that “[t]he improper use of a registration notice in connection with an unregistered mark, if done, with intent to deceive the purchasing public or others in the trade into believing the mark is registered, is a ground for denying the registration of an otherwise registerable mark.”<sup>1</sup> However, and critically, there is no allegation (nor can there be) that Herban Avenues: (1) improperly used the registration symbol with the goods listed in paragraph numbered 29 of the Petition *prior* to registration, (2) improperly used the registration symbol *prior* to registration for the goods listed in its registration, or (3) that any misuse of the symbol was borne of an intent to deceive the purchasing public or the Office into believing that the mark was registered as to such goods prior to actual registration.<sup>2</sup> Simply stated, HerbanCowboy's allegations of improper marking of goods *not* identified in any registration are not relevant as to whether to cancel registration for goods that *are* identified in the registration.<sup>3</sup> According to the

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<sup>1</sup> *Copeland's Enter., Inc. v. CNV, Inc.*, 20 U.S.P.Q.2d 1295, 945 F.2d 1563, 1566 (Fed. Cir. 1991)

<sup>2</sup> *See Johnson Controls, Inc. v. Concorde Battery Corp.*, 228 USPQ 39, 44 (TTAB 1985).

<sup>3</sup> *See Knickerbocker Toy Co., Inc. v. Faultless Starch Co.*, 175 U.S.P.Q. 417, 467 F.2d 501, 509 (C.C.P.A. 1972).

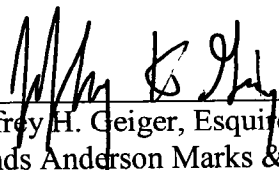
Petition, there exists no registration for the goods mentioned in paragraph numbered 29—  
because none exists, there can be no cancellation of any such registration.<sup>4</sup>

WHEREFORE Herban Avenues, L.L.C. requests respectfully that (1) its motion to  
dismiss be granted and the claim for misuse or improper marking dismissed with prejudice, and  
(2) its motion to strike be granted and paragraph numbered 29 of the Petition stricken.

Respectfully submitted,

**HERBAN AVENUES, L.L.C.**

By Counsel



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Jeffrey H. Geiger, Esquire  
Sands Anderson Marks & Miller, P.C.  
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Richmond, Virginia 23218-1998  
804-783-7248  
804-783-7291 (facsimile)  
jgeiger@sandsanderson.com  
Attorney for Herban Avenues, L.L.C.

Dated: November 5, 2003

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<sup>4</sup> See *Helene Curtis Indus., Inc. v. The Milo Corp. et al.*, 1985 WL 1282, \*2 (N.D. Ill. 1985) (rejecting trademark misuse theory based on overextending trademark rights as a ground for cancellation).

**Certificate of Mailing**

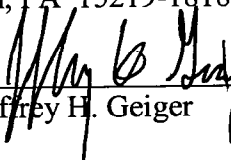
I certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on November 5, 2003.

  
\_\_\_\_\_  
Jeffrey H. Geiger

**Certificate of Service**

I certify that a true and correct copy of the above was served by first class mail, postage pre-paid, this 5<sup>th</sup> day of November 2003, to counsel for HerbanCowboy.com, Inc:

Richard L. Byrne, Esquire  
Nathan J. Prepelka, Esquire  
Webb Ziesenheim Logsdon Orkin & Hanson, PC  
700 Koppers Building  
436 Seventh Avenue  
Pittsburgh, PA 15219-1818.

  
\_\_\_\_\_  
Jeffrey H. Geiger

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of )  
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Opposer, )  
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HERBANCOWBOY.COM, INC. )  
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Applicant. )

Opposition No. 91157596

Application No. 78/138,031

Mark: **HERBANCOWBOY**

11-06-6203

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

**OPPOSER'S ANSWER AND DEFENSES TO APPLICANT'S COUNTERCLAIM  
PETITION FOR CANCELLATION OF OPPOSER'S REGISTRATION**

Herban Avenues, L.L.C. ("Herban Avenues") sets forth the following answer and defenses to the counterclaim asserted by HerbanCowboy.com, Inc. ("HerbanCowboy") in "Applicant's Answer and Defenses to Notice of Opposition and Counterclaim Petition for Cancellation of Opposer's Registration" (the "Petition").

**A.**

**Answer**

1. Whenever in this Answer Herban Avenues states that it is unable to either admit or deny any allegation by reason of lack of knowledge and/or information or otherwise, such statement shall be deemed a denial of such allegation and a demand for strict proof of it.

2. In response to paragraph numbered 24 of the Petition, Herban Avenues states (a) it is without sufficient information to admit or deny the allegations as to the business address and corporate status of HerbanCowboy, but has no present reason to doubt them; (b) it is the owner of the registration for HERBAN AVENUES (Registration No. 2,499,364); and (c) it denies the remaining allegations.

3. In response to paragraph numbered 25 of the Petition, Herban Avenues (a) restates and reaffirms the corresponding statements contained in paragraphs numbered 1 through 17 of its Notice of Opposition in response to paragraphs numbered 1 through 17 of the Petition, (b) neither admits nor denies those allegations contained in paragraphs numbered 18 through 23 of the Petition requesting of it to make certain legal conclusions as to HerbanCowboy's defenses it is not required to make, (c) refers HerbanCowboy to paragraph numbered 2 above as and for its response to paragraph numbered 24 of the Petition, and (d) denies any remaining allegations.

4. Herban Avenues admits the allegations contained in paragraphs numbered 26 and 27 of the Petition.

5. Herban Avenues denies the allegations contained in paragraphs numbered 28, 30, 31 of the Petition.

6. In response to paragraph numbered 29 of the Petition, Herban Avenues denies that it is improperly marking goods, but admits that it is in the process of modifying its advertising materials to further delineate those goods for which there exists a registration.

#### **Affirmative Defenses**

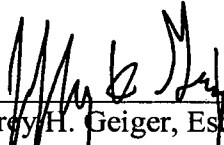
7. The claims asserted in the Petition are barred and precluded, in whole or in part, by the doctrines of laches, acquiescence and equitable estoppel. With a first use date in commerce of November 11, 1998, Herban Avenues filed for registration of HERBAN AVENUES under the bath, body and skincare products category (International Class 3) on January 21, 1999. Herban Avenues received registration for HERBAN AVENUES on October 23, 2001 (Registration No. 2,499,364). This mark was subject to application, publication and registration, all without any opposition by HerbanCowboy.

WHEREFORE Herban Avenues, L.L.C. requests respectfully that HerbanCowboy's Counterclaim Petition for Cancellation be dismissed with prejudice.

Respectfully submitted,

**HERBAN AVENUES, L.L.C.**

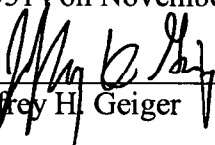
By Counsel

  
\_\_\_\_\_  
Jeffrey H. Geiger, Esquire  
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jgeiger@sandsanderson.com  
Attorney for Herban Avenues, L.L.C.

Dated: November 5, 2003

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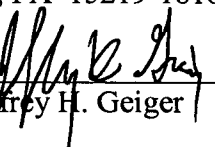
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Jeffrey H. Geiger

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Webb Ziesenheim Logsdon Orkin & Hanson, PC  
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\_\_\_\_\_  
Jeffrey H. Geiger

TTAB

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November 5, 2003

Box TTAB No Fee  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Re: Herban Avenues, L.L.C. v. HerbanCowboy.com, Inc.  
Opposition No. 91157596  
Our File No. 008914/056435

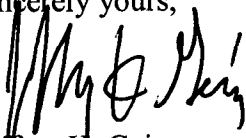
  
11-06-6203  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

Dear Sir:

On behalf of **Herban Avenues, L.L.C.**, I am enclosing (1) "Opposer's Answer and Defenses to Applicant's Counterclaim Petition for Cancellation of Opposer's Registration," and (2) "Opposer's Motion and Supporting Memorandum to Dismiss and/or Strike, in Part, Applicant's Counterclaim."

Thank you for your consideration and please do not hesitate to contact me if you have any questions.

Sincerely yours,

  
Jeffrey H. Geiger

Enclosures

cc: Richard L. Byrne, Esquire (w/encl.)  
Nathan J. Prepelka, Esquire  
Webb Ziesenheim Logsdon Orkin & Hanson, PC  
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