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

Proceeding	91157596
Party	Plaintiff HERBAN AVENUES, L.L.C.
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Submission	Applicant's Reply to Opposer's Motion to Dismiss and/or Strike, in part, Applicant's Counterclaim
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Date	03/02/2004
Attachments	w0108574.txt (3 pages)

In the matter of :
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HERBAN AVENUES, L.L.C., : Opposition No. 91157596
: :
Opposer, : Applicat
ion No. 78/138,031 :
: :
v. : :
: :
HERBANCOWBOY.COM, INC., : Mark: HERBANCOWBOY
: :
Applicant. :

: :
APPLICANT'S REPLY TO OPPOSER'S MOTION TO DISMISS
AND/OR STRIKE, IN PART, APPLICANT'S COUNTERCLAIM
Applicant/Petitioner HerbanCowboy.com, Inc. ("Applicant"), by an

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through its counsel, hereby replies to and answers Opposer's Motion and
Supporting Memorandum to Dismiss and/or Strike, in part, Applicant's
Counterclaim ("Opposer's Motion") which was submitted by
Opposer/Respondent Herban Avenues, L.L.C. ("Opposer").

INTRODUCTION

Opposer seeks to strike paragraph 29 of Applicant's/Petitioner's
Counterclaim Petition for Cancellation. Paragraph 29 asserts that,
based upon a review of the goods and products offered on the Opposer's
website, Opposer is using the mark HERBAN AVENUES along with the "(r)"
symbol in connection with goods not set forth in the identification of
goods for Opposer's registration. Applicant maintains that this
paragraph should not be stricken from the Petition, and further that
the allegations contained in this paragraph are relevant to the issues
of fraud, bad faith, misrepresentation and improper marking of goods.

ARGUMENT

Opposer initially notes that the improper marking of goods not
identified in a registration is not a basis for canceling a
registration under 15 U.S.C. Section 1064. Opposer's Motion, p. 2.
Instead, Opposer notes that the allegation must be that Opposer
improperly used the registration symbol with the goods listed in
paragraph 29 prior to registration for the goods listed in the
registration. Id. First and foremost, without discovery, it is
difficult for Applicant to definitively establish whether Opposer
improperly used the registration symbol before or after registration of
the mark HERBAN AVENUES. Accordingly, Applicant, at this point, has
only alleged the improper use of the registration symbol in connection
with goods that is verifiable from Opposer's website. Similarly,
without discovery, it is also difficult for Applicant to definitively
establish whether any misuse of the symbol was borne of intent to
deceive the purchasing public. Therefore, discovery must be conducted,
and striking of paragraph 29 is unwarranted at this time.

With respect to Opposer' assertion that 15 U.S.C. Section 1064 d

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not provide for the cancellation of a registration based upon improper marking and misrepresentation after issuance of the registration, Section 1064(3) states that the misrepresentation of "the source of goods or services on or in connection with which the mark is used" is a basis for cancellation. Opposer's use of the mark HERBAN AVENUES and the registration symbol in connection with goods not included in or covered by the registration may be reasonably interpreted as such a misrepresentation to the consuming public. Further, such improper marking is an attempt by Opposer to artificially "stretch" the coverage of the mark HERBAN AVENUES and place others, including the consuming public, on notice that it has protectable rights in the term "herban avenues" with respect to the improperly marked goods/products. Accordingly, such acts may be the basis of a cancellation proceeding.

It is important to note that Applicant's allegations in paragraph h 29

do not solely or exclusively set forth the reasons that Applicant seeks the cancellation of the registration of the mark HERBAN AVENUES. In particular, and as discussed in remaining paragraphs 24-28, 30 and 31, Applicant believes that the registration should also be cancelled on the basis of fraud, which must be specifically plead in the Petition and also serves as a proper basis for cancellation of a registration. 15 U.S.C. Section 1064(3). The facts and allegations contained in paragraph 29 are indicative of misrepresentation and fraudulent behavior and are supportive of Applicant's claim. Still further, the allegations in paragraph 29 assist in establishing the "bad faith" of Opposer with respect to the mark HERBAN AVENUES. Opposer has attempted to improperly "add on" to the registered mark in an attempt to further reserve the mark for goods that are not included in the description. This demonstrates Opposer's bad faith. See, e.g., Stern Elecs., Inc. v. Kaufman, 669 F.2d 852, 312 USPQ 443 (2d Cir. 1982) (attaching a label in a bad faith attempt to reserve a mark is improper).

Applicant respectfully submits that paragraph 29 should not be stricken from the Counterclaim/Petition since: (1) discovery is required in establishing the acts, misrepresentation and fraudulent behavior of Opposer; (2) misrepresentation as to the source of goods is a proper basis for cancellation of a registration; and (3) the bad faith acts of Opposer are supportive of the claim of fraud, which must be specifically plead. Further, while Opposer has moved for dismissal of the entire counterclaim, there is no support or reason whatsoever in Opposer's Motion as to why the entire counterclaim should be dismissed. Instead Opposer only addresses the allegations in paragraph 29, which make up only a part of the counterclaim and should not be construed or read exclusive of the remaining counts and allegations.

For all of the above reasons, Applicant HerbanCowboy.com, Inc. respectfully requests that the Board DENY Opposer's Motion and Supporting Memorandum to Dismiss and/or Strike, in part, Applicant's Counterclaim.

Dated: November 14, 2003

/S/ Nathan J. Prepelka
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