UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: March 19, 2009

Cancellation No. 92045172

Herbaceuticals, Inc.

v.

Xel Herbaceuticals, Inc.

Andrew P. Baxley, Interlocutory Attorney:

On March 12, 2009, respondent/counterclaim plaintiff Xel Herbaceuticals, Inc. ("Xel") filed a combined motion for summary judgment, wherein it asks that the Board cancel petitioner/counterclaim defendant Herbaceuticals, Inc.'s ("HCI") pleaded Registration No. 2585974 and and its unpleaded Registration No. 2822094 on the ground that the component word HERBACEUTICALS is generic,[1] and to suspend pending disposition of that motion.

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[1] Both registrations are for the mark HCI HERBACEUTICALS, INC. and design in the following form,

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Registration No. 2585974 is for "cosmetics, namely body and facial skin lotions, creams and powders, body and facial skin cleansers, bath oils and beads, shampoos and conditioners" in

A review of the pleadings in this case indicates that Xel's counterclaim consists solely of a compulsory counterclaim for cancellation of the pleaded registration. Xel has neither amended, nor sought leave to amend, its answer and counterclaim so as to add a permissive counterclaim for cancellation of the unpleaded registration. Because Xel has not pleaded and submitted a filing fee for a counterclaim to cancel Registration No. 2822094, the Board will not entertain a motion for summary judgment for cancellation of that registration. See Fed. R. Civ. P. 56(a) and (b); TBMP Section 528.07(a) (2d ed. rev. 2004).

Further briefing on Xel's motion for summary judgment on the counterclaim to cancel HCI's Registration No. 2585974 is suspended pending resolution of the following order to show cause. Any submission filed during the pendency of this order which is not relevant thereto will be given no consideration. See Trademark Rule 2.117(c).

It has come to the attention of the Board that HCI has permitted such registration to be cancelled under Trademark

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International Class 3. This registration issued on June 25, 2002 and was cancelled on March 19, 2009 under Trademark Act Section 8, 15 U.S.C. Section 1058.

Registration No. 2822094 is for "retail and wholesale distributorship services in the field of homeopathic preparations, cosmetics, dietary supplements and wellness products" in International Class 35. This registration issued on March 16, 2004 and alleges December 31, 1986 as the date of first use anywhere and December 31, 1987 as the date of first use in commerce. The registration includes a disclaimer of INC. and statement under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), with regard to the word HERBACEUTICALS.

Act Section 8, 15 U.S.C. Section 1058.[2] Accordingly, HCI is allowed until twenty days from the mailing date set forth in this order to show cause why such cancellation should not be deemed to be the equivalent of a cancellation by request of HCI without the consent of Xel, and should not result in entry of judgment against HCI as provided by Trademark Rule 2.134(a) on the counterclaim.

In the absence of a showing of good and sufficient cause, judgment may be entered against HCI on the counterclaim. See Trademark Rule 2.134(b). If, in response to this order, HCI submits a showing that its failure to file a Section 8 declaration was the result of inadvertence or mistake, judgment will not be entered against it on the counterclaim. In that case, Xel will be given time in which to elect whether it wishes to go forward with the counterclaim, or to have the counterclaim dismissed without prejudice as moot. See *C. H. Guenther & Son Inc. v. Whitewing Ranch Co.,* 8 USPQ2d 1450 (TTAB 1988); TBMP Section 602.02(b) (2d ed. rev. 2004).

Proceedings herein are otherwise suspended.

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[2] Although HCI could not properly file a declaration under Trademark Act Section 15, U.S.C. Section 1065, in Registration No. 2585974, while the counterclaim is pending, the pendency of the counterclaim did not relieve HCI of its duty to file its Section 8 declaration for that registation. See *Checkers Drive-In Restaurants Inc. v. Comm'r of Patents and Trademarks*, 34 USPQ2d 1574 (D.C. Cir. 1995).