

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

emy/dmd/apb

Mailed: August 7, 2014

Cancellation No. 92055208

Industria Farmaceutica Andromaco,
S.A. de C.V.

v.

Laboratorios Andromaco S.A.

By the Trademark Trial and Appeal Board:

On March 27, 2014, as part of Respondent's Declaration under Trademark Act Section 8, 15 U.S.C. Section 1058, in involved Registration No. 3462243, Respondent amended that registration to delete International Class 3 in its entirety and "lotions, and creams, skin lotions, skin ointments, skin creams, diaper rash lotions, and diaper rash creams; bandages for skin wounds; medical plasters; first aid kits; capsules, tablets, gel capsules, and pills sold empty for pharmaceutical purposes" from the identified goods in International Class 5.

Because such deletion pertains to on this proceeding, a copy of that Section 8 declaration should have been filed in the Board file for this proceeding. *See* Trademark Rule 2.193(g). In addition, a registration that is subject to a cancellation proceeding cannot be amended except with the consent of the other party or parties and the approval of the Trademark Trial

and Appeal Board, or upon motion granted by the Board. *See* Trademark Rule 2.133(a). Accordingly, the proposed amendment should have also been raised by way of a motion to amend in this proceeding.

In a cancellation proceeding against any registration having multiple classes, if the respondent permits an entire class which is the subject of the cancellation proceeding to be cancelled under Trademark Act Section 8, the cancellation with respect to that class is governed by Trademark Rule 2.134(b). *See* TBMP Section 602.02(b) (2014). Respondent is allowed until **thirty days** from the mailing date set forth in this order to show cause why the cancellation of the involved registration in International Class 3 should not be deemed to be the equivalent of a cancellation by request of Respondent without the consent of Petitioner and should not result in entry of judgment against Respondent as provided by Trademark Rule 2.134(a) with regard to that class. *See* Trademark Rule 2.134(b); TBMP Section 602.02(b).

Regarding the deleted goods in International Class 5, the Board allows unconsented deletions from identification of goods during *inter partes* proceedings where the defendant consents to entry of judgment with regard to the broader identification of goods. *See Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013); *International Harvester Co. v. International Telephone and Telegraph Corp.*, 208 USPQ 940, 941 (TTAB 1980). Respondent is allowed until **thirty days** from the mailing date set

forth in this order to file its consent to entry of judgment with regard to those deleted goods in International Class 5.

In view of the foregoing, further briefing on respondent's motion (filed July 30, 2014) for summary judgment is tolled, and consideration of petitioner's withdrawal of the petition to cancel (filed August 1, 2014) is deferred.