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

Proceeding	91199752
Party	Plaintiff Evonik Degussa GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial Nos. 85/096,047 and 79/083,600

Evonik Degussa GmbH)	
)	
v.)	Opposition No. 91199752
)	(parent)
)	Opposition No. 91200334
)	
Afgritech Ltd.)	
)	
)	
)	

EVONIK DEGUSSA GMBH'S REPLY MEMORANDUM
IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

In 1988, Congress passed the Trademark Law Revision Act which provided for the filing of trademark applications based on a *bona fide* intent to use, and proscribed applications to register trademarks "for the shelf:"

A person who has a *bona fide* intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark.

* * *

The term "use in commerce" means the bona fide use of the mark in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. §§ 1051(b) and 1127. In its motion for Summary Judgment and Supporting Memorandum, Opposer demonstrated that Applicant had produced no documents supporting its claimed bona fide intent to use, as a result of which the burden shifted to Applicant to come forward with objective evidence which would adequately explain or outweigh its failure to have documentary evidence of its intent. Applicant has not done so. Instead, Applicant's Response demonstrates that if it had an intention at all, it was an intention to obtain a registration for the

shelf which is proscribed by the 1988 Amendments. Consequently, the Opposition must be sustained, and Application Serial No. 85/096,047 must be refused.

I. Applicant's Conduct with Regard to Its AMINOMAX Mark and It's Conduct with Regard to It's Purported AMINOGREEN Mark Demonstrates the Absence of It's Bona Fide Intent to Use.

Applicant filed intent to use applications to register its AminoMax and AminoGreen marks on June 27, 2006. Yet, Applicant's development, production, and marketing of an animal feed product to be identified by the marks were fundamentally and tellingly different.

REDACTED

REDACTED

In November 2011, five years after Applicant filed its first intent to use application to register the AminoGreen mark, the Watertown, N.Y. plant opened. Applicant officially announced the November 17, 2011 Grand Opening of the plant in the Syracuse Post-Standard newspaper as follows:

The grand opening on the new AminoMax Manufacturing plant in Watertown was conducted Thursday, Nov. 17. . . . The company's brochure states "AminoMax is designed to consistently meet your cows' amino acid requirements and allow your nutritionist to reduce the amount of crude protein in the diet, maximizing use of forages and fermentable carbohydrates. University research has shown that when dairy rations are properly formulated with AminoMax, herd economics can be improved and farm odors can be reduced due to lower levels of nitrogen in the urine, making it your dairy farm more environmentally friendly."

[Exhibit 7 to the Holmes Declaration, referenced in the Holmes Declaration, ¶ 14.] There is no mention of the AminoGreen mark or the product allegedly to be identified by the AminoGreen mark in the official announcement.

REDACTED

REDACTED

II. Applicant Intended Only To Obtain A Registration For The Shelf.

Usually, when one has a bona fide intention to adopt a mark, one has an existing product or a product that at least has been developed in the laboratory. Not here. Although superficially enticing to Applicant's arguments, a closer examination of the language used in the Holmes and

Declarations to describe the "development" of the purported AminoGreen product demonstrates that Applicant has not had a bona fide intent to use the mark. Rather, Applicant's intention has been to obtain a registration for the shelf.

REDACTED

the event that a future product is produced. This is not a bona fide intent to use within the meaning of the Lanham Act.

REDACTED

III. Applicant's Excuses Ring Hollow.

Applicant filed its first intent to use application to register the AminoGreen mark almost six years ago. Yet, it has no documents in its possession, custody, or control which contain the word "AminoGreen," and is yet to engage in actual (as contrasted to conceptual and theoretical) product formulation or product development activities. As an excuse for these deficiencies,

REDACTED

As Applicant's supporting affidavits emphasize, however, Applicant is a UK entity which has its office in the U.K. [Holmes Declaration, ¶2.] Applicant is 50% owned by a UK entity and 50% owned by a South African entity. [Holmes Declaration, ¶4.] Applicant's AminoMax product is produced in the U.K., in South Africa, and in Argentina, and product produced there is imported into the United States. [Holmes Declaration, ¶6.] Are the British, South African and Argentinean employees of Applicant and its parents so untrustworthy that they cannot be given at least some responsibility for the formulation, development, and production of Applicant's purported AminoGreen product?

REDACTED

Mr. Holmes, in addition to being Chairman of Applicant, is Chairman of Animal Feed Supplement, Inc., a subsidiary of one of Applicant's parents. The subsidiary has plants in Belle Fourche, South Dakota and in Poteau, Oklahoma, and Applicant has used the animal feed product and animal feed expertise of the subsidiary in connection with its plan to sell such

products in the U.S. [Holmes Declaration, ¶3.] If Applicant so utilized the animal feed product and animal feed expertise of Animal Feed Supplement, why did Applicant not use the facilities of Animal Feed Supplement to actually formulate, develop, and production test Applicant's purported AminoGreen product?

REDACTED

Applicant filed its first intent to use application to register the AminoGreen mark almost six years ago, yet it has no objective evidence to support a bona fide intent to use the mark. To excuse the absence of such objective evidence of a bona fide intent, it has relied on the purportedly necessary heightened secrecy required to protect such product and the purportedly necessary U.S. facility in which to actually formulate, develop, and produce the product. In view of Applicant's U.K, South African, and Argentinean plants, and its access to the U.S. facilities of Agricultural Modeling and Training Systems, LLC and Animal Feed Supplement, Inc., Applicant's excuses do not justify the six year absence of objective evidence of a bona fide intent to use and, therefore, ring hollow.

IV. Applicant's Admissions.

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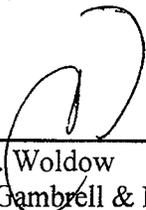
IV. Conclusion.

The mere fact that an applicant has filed an intent-to-use application cannot alone establish its bona fide intent to use a mark. *E.g., SmithKline Beecham Corp. v. Omnisource DDS LLC*, 97 U.S.P.Q.2d 1300, 1304 (T.T.A.B. 2010). The filing of successive intent-to-use applications to replace applications which have lapsed because no timely statement of use was filed casts doubt on the bona fide nature of an applicant's stated intent to use. *Research in Motion Ltd. v. NBOR Corp.*, 92 U.S.P.Q.2d 1926, 1931 (T.T.A.B. 2009). An applicant's mere subjective statement that it intends to use a mark cannot overcome an absence of objective evidence supporting such a claim. *SmithKline Beecham Corp.*, 97 U.S.P.Q.2d at 1304; *Saul Zaentz Co. v. Bumb*, 95 U.S.P.Q.2d 1723, 1727 (T.T.A.B. 2010); *Research in Motion Ltd.*, 92 U.S.P.Q.2d at 1930; *Boston Red Sox Baseball Club LP v. Sherman*, 88 U.S.P.Q.2d 1581, 1587

(T.T.A.B. 2008); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1507 (T.T.A.B. 1993).

Applicant has absolutely no objective evidence to substantiate or corroborate its supposed intent to use the AminoGreen mark, and it's asserted excuses for the absence of the same ring hollow. Opposer met its initial burden on its summary judgment motion, and the burden shifted to Applicant to rebut Opposer's *prima facie* case by offering objective evidence of its bona fide intent to use the AminoGreen mark. It has not done so because it cannot do so. For the reasons set forth in Opposer's Motion and Supporting Memorandum and for the reasons set forth above, Opposer is entitled to a summary judgment that Applicant does not possess the requisite bona fide intent to use the AminoGreen mark. Opposition No. 91199752 should be sustained.

Respectfully submitted, this 7th day of June, 2012.



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