

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

Baxley

Mailed: August 14, 2012

Opposition No. 91199752

Evonik Degussa GmbH

v.

Afgritech Ltd.

Opposition No. 91200334

Afgritech Ltd.

v.

Evonik Degussa GmbH

Before Holtzman, Wellington, and Kuczma,
Administrative Trademark Judges:

By the Board:

In Opposition No. 91199752, Evonik Degussa GmbH ("Evonik") filed a notice of opposition to Afgritech Ltd.'s ("Afgritech") application to register the mark AMINOGREEN in standard character form for "animal feed supplement" in International Class 5 and "livestock feed" in International Class 31¹ under Trademark Act Section 2(d), 15 U.S.C.

¹ Application Serial No. 85096047, filed July 29, 2010, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

On June 27, 2006, Afgritech filed intent to use application Serial No. 78917849 to register the mark AMINOGREEN in standard character form for "animal feed supplement" in International

Section 1052(d), based on likelihood of confusion with Evonik's previously applied-for mark AMINORED for goods and services in International Classes 1, 9, 31, 41, and 42, including "[f]oodstuffs for animals; additives to fodder, not for medical purposes" in International Class 31.²

In Opposition No. 91200334, Afgritech opposes registration of Evonik's AMINORED mark under Trademark Act Section 2(d) based on likelihood of confusion with its previously used and registered mark AMINOMAX for "animal feed supplement" in International Class 5 and "livestock feed" in International Class 31.³ The Board consolidated the above-captioned proceedings in an August 11, 2011 order.

This case now comes up for consideration of: (1) Evonik's motion (filed April 17, 2012) for leave to file an amended notice of opposition in Opposition No. 91199752 to

Class 5 and "livestock feed" in International Class 31. However, that application was abandoned on June 7, 2010 after Afgritech did not file a statement of use.

² Application Serial No. 79083600, filed April 10, 2010, under Trademark Act Section 66(a), 15 U.S.C. Section 1141f, with a December 8, 2009 priority date.

³ The AMINOMAX mark is the subject of Registration No. 3905808, which was issued on January 11, 2011, and matured from an intent-to-use application with a June 27, 2006 constructive use filing date. See Trademark Act Section 7(c), 15 U.S.C. Section 1057(c). Thus, Afgritech's application for the AMINOMAX mark and its first application for the AMINOGREEN mark were filed on the same day.

add a claim that Afgritech's involved application is void under Trademark Act Section 1(b) because Afgritech did not have a bona fide intent to use the AMINOGREEN mark in commerce on the identified goods when Afgritech filed its involved application; and (2) Evonik's motion (also filed April 17, 2012) for summary judgment on the ground that Afgritech's involved application is void under Trademark Act Section 1(b) because Afgritech did not have a bona fide intent to use the AMINOGREEN mark in commerce on the identified goods when Afgritech filed its involved application.

Afgritech stated in response to the motion for leave to file an amended notice of opposition that it "does not object" to such motion, but that it "reserves the right ... to supplement its initial disclosures, discovery responses as necessary, and to discover information about the factual allegations contained therein and does not waive its right to dispute those allegations." Accordingly, the motion for leave to file an amended notice of opposition is granted as uncontested. See Trademark Rule 2.127(a). The amended notice of opposition is the operative complaint in this proceeding. Afgritech's time to answer is set *infra*.

Regarding the motion for summary judgment, summary judgment is an appropriate method of disposing of cases in

which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "in the ordinary course of trade, ... and

not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. Section 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988)). In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). Nonetheless, the Board has held, that where there is no evidence of an applicant's bona fide intent to use the mark at issue on the claimed goods or services, entry of summary judgment on a claim that the applicant had no bona fide intent to use the mark in commerce when he filed his involved application

may be warranted. See *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660 (TTAB 2009).

The record herein indicates that the USPTO issued an abandonment of Afgritech's earlier intent-to-use application Serial No. 78917849 for the AMINOGREEN mark for the same goods as in the involved application after Afgritech received five extensions of time to file its statement of use in support of the earlier application. Afgritech filed the involved intent-to-use application less than two months after such abandonment.

Notwithstanding the lack of documentary evidence regarding Afgritech's bona fide intent to use the AMINOGREEN mark in commerce, Afgritech submitted the declarations of Afgritech chairman Christopher N.C. Holmes, Afgritech LLC (Afgritech's wholly owned subsidiary) general manager Richard Wark, Agricultural Modeling and Training Systems, LLC President and CEO Thomas Tylutki regarding Afgritech's intentions in connection with the AMINOGREEN mark. In those declarations, the declarants explain that Afgritech, a United Kingdom corporation, was formed in 2006 and is engaged in the animal feed and feed supplement manufacturing industry; that Afgritech decided to file applications for the AMINOMAX and AMINOGREEN marks for feed supplement and animal feed in June 2006 with AMINOGREEN

being intended to reflect Afgritech's commitment to environmentally friendly products; that Afgritech planned to develop goods to be sold under the AMINOGREEN mark for manufacture in the United States only; that goods sold under the AMINOGREEN mark were going to embody a new concept and was going to be developed for the United States market; that development and testing of prototype products required that Afgritech have its own operational United States production facility; that, while Dr. Tylutki worked on developing formulations for goods to be sold under the AMINOGREEN mark, delays in acquiring a Watertown, New York plant and constructing production facilities there thwarted even prototype product production; and that marketing of goods under the AMINOGREEN mark cannot commence until the goods are produced and tested.

Based on the entirety of the circumstances, as revealed by the evidence of record, and bearing in mind that the factual question of intent is particularly unsuited to disposition on summary judgment, we find that there is a genuine dispute as to whether or not Afgritech had a bona fide intent to use the AMINOGREEN mark when it filed its second intent-to-use application to register that mark and that disposition of this proceeding by summary

judgment is therefore inappropriate. In view thereof, Evonik's motion for summary judgment is denied.

Proceedings herein are resumed. Afgritech is allowed until **September 15, 2012** to file an answer to the amended notice of opposition in Opposition No. 91199752. Under the circumstances herein, the Board deems it appropriate to reopen the discovery period for the limited purpose of taking discovery in connection with Evonik's Section 1(b) claim in Opposition No. 91199752. Dates herein are reset as follows.

Expert disclosures due:	September 15, 2012
Discovery closes:	October 15, 2012
Evonik's pretrial disclosures due:	November 29, 2012
Evonik's 30-day testimony period as plaintiff in Opposition No. 91199752 to close:	January 13, 2013
Afgritech's pretrial disclosures due:	January 28, 2013
Afgritech's 30-day testimony period as defendant in Opposition No. 91199752 and as plaintiff in Opposition No. 91200334 to close:	March 14, 2013
Evonik's pretrial disclosures for rebuttal in Opposition No. 91199752 and as defendant in Opposition No. 91200334 due:	March 29, 2013
Evonik's 30-day testimony period as defendant in Opposition No. 91200334 and for rebuttal as plaintiff in Opposition No. 91199752 to close:	May 13, 2013
Afgritech's rebuttal disclosures as plaintiff in Opposition No. 91200334 due:	May 28, 2013

Afgritech's 15-day rebutal testimony period as plaintiff in Opposition No. 91200334 to close:	June 27, 2013
Brief for Evonik as plaintiff in Opposition No. 91199752 due:	August 26, 2013
Brief for Afgritech as defendant in Opposition No. 91199752 and as plaintiff in Opposition No. 91200334 due:	September 25, 2013
Brief for Evonik as defendant in Opposition No. 91200334 and reply brief, if any, as plaintiff in Opposition No. 91199752 due:	October 25, 2013
Reply brief, if any, for Afgritech as plaintiff in Opposition No. 91200334 due:	November 9, 2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.