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

Proceeding	91200105
Party	Plaintiff EMD Crop BioScience Inc.
Correspondence Address	EDWARD M PRINCE ALSTON & BIRD LLP 950 F STREET NW, THE ATLANTIC BUILDING WASHINGTON, DC 20004 UNITED STATES edward.prince@alston.com
Submission	Other Motions/Papers
Filer's Name	Edward M. Prince
Filer's e-mail	edward.prince@alston.com
Signature	/Edward M. Prince/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

EMD CROP BIOSCIENCE INC,.	)	
Opposer,	)	
v.	)	Opposition No. 91200105
CLEARY CHEMICALS, LLC,	)	
Applicant.	)	

OPPOSER'S REPLY IN SUPPORT OF MOTION TO STRIKE AND MOTION FOR JUDGMENT ON THE PLEADINGS

It is the position of Applicant, Cleary Chemicals, LLC, that it does not have to file a motion to amend the application in the absence of Opposer's consent to the amendment. It is Opposer's position that the Trademark Trial and Appeal Board Rules of Practice require a motion by Applicant in the absence of consent of the Opposer, although admittedly one rule is unclear.

The amendment of an application subject to an opposition is governed by 37 C.F.R. § 2.133(a) which states:

> "An application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, 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."

The Opposer has not consented to the amendment because it does not change the issue of likelihood of confusion. Applicant has declined to file a motion to amend its recitation of goods. Rather, Applicant wants to follow a procedure which will allow it to argue for registrability of the goods as currently presented in

the application and simultaneously argue for the registrability of another definition of goods which, if it lost on the first definition, Applicant would agree to substitute as the goods in the application. Thus, Opposer would have to take discovery and present testimony and arguments on two alternative definitions. In the absence of a consent, 37 C.F.R. § 2.133(a) does not provide this alternative way of proceeding. The only way that the goods can be amended in the absence of the consent of the Opposer is to file a motion before the Board.

At page 3 of its Reply Brief, Applicant argues that a request to restrict the identification of goods may be made either by way of an affirmative pleading in the answer or by way of motion. Applicant has relied upon the language of TBMP 311.02(b) in the second edition of the Trademark Manual of Board Procedure, adopted in 2003 and revised in 2004. Apparently unknown to Applicant is the fact that the Second Edition of the Manual has been replaced by the Third Edition, adopted in 2007. As stated in the preface to the Third Edition, "Since then [2004], practice before the Trademark Trial and Appeal Board ("Board") has significantly changed. This third edition of the TBMP incorporates these many and varied changes in a revised format."

The corresponding section of TBMP § 311.02(b), as revised in 2007, now reads:

> A request by defendant to restrict its identification of goods or services under Trademark Act § 18, 15 U.S.C. § 1068, must be made by way of motion under 37 C.F.R. § 2.133 although the ground must also be raised as an affirmative defense in the answer (as originally filed, as amended, or as deemed amended), by way of an allegation that sets forth the proposed restriction in detail and alleges that the restriction will avoid a likelihood of confusion and

> that plaintiff is not using the mark on products or services being excluded from the registration.

There is no "either-or" recitation in this revised section. Rather, the word "must" is used in each instance. The request to restrict must be made by motion and must be raised as an affirmative defense. No motion has been made.

In fairness to Applicant's position, TBMP § 514.03 states that the "defense" should be raised either in the defendant's answer to the complaint or by way of a timely motion to amend the application to include the restrictions. The support for this statement is 37 C.F.R. §§ 2.133(a) and 2.133(b).

37 C.F.R. §§ 2.133(a) and 2.133(b) require that a motion must be made if the application is amended in substance and no consent is granted. Certainly, an amendment to the recitation of goods is an "amendment in substance." TBMP § 311.02(b) interprets 37 C.F.R. § 2.133(a) correctly and thus requires that a request by the defendant to restrict its identification of goods must be made by way of motion and must also be raised as an affirmative defense. TBMP § 514.03 is plainly erroneous and inconsistent with 37 C.F.R. § 2.133(a) to the extent that this rule eliminates the necessity of applicant filing a motion to amend the recitation of goods. TBMP § 311.02 was revised in 2007 to be consistent with 37 C.F.R. § 2.133(a). Since TBMP § 514.03 was not revised, it clearly should not be followed in this case to the extent that it permits applicant to avoid filing a motion to amend its goods.

Opposer fully expects to be able to show that there is likelihood of confusion when the identical mark is used (a) for natural molecule or bacteria for plant growth enhancement in agriculture crops (Opposer's goods) and (b)

fungicides for domestic use and fungicides for agricultural use (Applicant's goods). The proposed amendment by Applicant does little to change the issue of likelihood of confusion. The reference to outdoor terrestrial turf and ornamental agriculture fungicides still comes under the broad category of "fungicides for agricultural use" which is likely to cause confusion with Opposer's natural molecule or bacteria for plant growth enhancement in agriculture crops.

It is not for the Board to tell Applicant how to proceed. This is a decision that has to be made by Applicant, and Opposer is prepared to proceed with its opposition, regardless of what definition is presented by Applicant in the application. Nevertheless, it is Opposer's position that it does not have to oppose the actual definition of goods and simultaneously oppose a hypothetical definition of goods, which is not presently in the case.

As for the fraud claim, it is readily apparent that this claim is baseless. It will have no effect on the likelihood of confusion claim since Opposer has been using its mark since 2007, long prior to Applicant's adoption and use of the mark TORQUE in 2010. When Opposer's specimen was filed in 2008, it was the same specimen as used in 2007 for all intents and purposes. The 2007 bag had been replaced by the larger 2008 bag, but size did not change how the mark was being used. The 2008 bag showed how the mark was being used in 2007 and obviously in 2008.

For the above reasons, Opposer respectfully requests that its Motion to Strike the Counterclaim be granted and that its Motion for Judgment on the fraud claim also be granted.

Respectfully submitted,

EMD Crop Bioscience Inc.
By its Attorneys

By: Edward M. Prince

Edward M. Prince
Alston & Bird LLP
The Atlantic Building
950 F Street, NW
Washington, DC 20004
(202) 239-3358

Date: October 21, 2011

Certificate of Service

I hereby certify that on October 21, 2011 a true and correct copy of the foregoing Opposer's Reply in Support of Motion to Strike and Motion for Judgment on the Pleadings was mailed by first-class mail, postage prepaid, to:

Tama L. Drenski
Renner, Kenner, Greive, Bobak, Taylor & Weber
Fourth Floor, First National Tower
Akron, Ohio 44308-1456
Email: tldrenski@rennerkenner.com

By: Edward M. Prince
Edward M. Prince