

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

)	In re Matter of Trademark
)	Application No. 77/942162
NOVOZYMES BIOAG, INC.,)	Filed: Feb. 23, 2011
Opposer,)	
)	Opposition No. 91200105
v.)	
)	
)	
CLEARY CHEMICALS, LLC,)	
Applicant.)	
)	

**BRIEF IN OPPOSITION TO MOTION TO STRIKE AND/OR FOR
JUDGMENT ON THE PLEADINGS UNDER F.R.C.P. 12(C) WITH RESPECT TO
APPLICANT’S COUNTERCLAIM ENTITLED “REQUEST TO RESTRICT
IDENTIFICATION OF GOODS”¹**

Now comes Applicant, Cleary Chemicals, LLC (“Cleary”), and opposes the motions of Opposer, Novozymes Bioag, Inc. (“Novozymes”), as follows:

1. Novozymes’ motion to strike Cleary’s amended counterclaim should be denied as Section 18 of the Trademark Act (15 U401S.C. §1068) provides that the Board may amend the registration of an opposer, and therefore, contrary to Novozymes, Cleary’s counterclaim is neither impermissible nor insufficient; and

2. Novozymes’ alternative motion for judgment on the pleadings under Fed. R. Civ. P. 12(c) with respect to Cleary’s counterclaim entitled “Request to Restrict Identification of Goods” should be denied. In its referenced counterclaim, Cleary states facts which if proven,

¹ Novozymes joined these alternative motions with a third motion for summary judgment with respect to Cleary’s separate and distinct counterclaim for fraud. Contemporaneously herewith, Cleary is filing a motion and declaration under Fed.R.Civ.P. 56(d) for discovery and a brief in support in response to Novozymes’ motion for summary judgment on Cleary’s claim for fraud.

would entitle it to the relief it seeks, and the Board has the authority to restrict the description of goods of Novozymes' registration under Section 18 of the Trademark Act (15 USC§ 1068).

The legal and factual bases for Cleary's opposition are set forth with particularity below.²

I. Novozymes' Motion to Strike.

Novozymes argues that Cleary's amended counterclaim seeking to restrict Novozymes' description of its goods must be stricken for the reason that "there is no provision in the Lanham Act, 15 USC 1051§ et seq., to support the relief sought by Cleary (i.e., the restriction of the description of goods of Novozymes' registration to exclude fungicides for agricultural use, namely outdoor terrestrial turf and ornamental agricultural fungicides)." (Doc. 19, page 2). Novozymes further argues that "15 USC§ 1064 provides the only basis by which a third party can attack a registration granted to another." (Doc. 19, page 3).

As expressly recognized by the Board in its earlier opinion in these proceedings (Doc. 17), however, pursuant to Section 18 of the Trademark Act (15 USC §1068), the Board "may modify the application *or registration* by limiting the goods or services specified therein", and "equitable relief under Trademark Act 18 may be sought separate and apart from any other ground". (Doc. 17, page 5, citing TBMP 309.03(d) (3d ed 2011) and *Eurostar Inc. v. Euro-Star Reitmoden GmbH & Co. KG*, 34 USPQ 2d 1266, 1271 (TTAB 1995), in which the Board stated in pertinent part, "[W]e overrule *Alberto-Culver and Procter & Gamble* (and any of our subsequent decisions that relied on one or both of these precedents), to the extent that those cases hold that ... (ii) Section 18 may be invoked by the Board only when tied to a properly pleaded ground for opposition or cancellation (e.g., abandonment)").

² Cleary's primary defense continues to be that there is no likelihood of confusion between the marks; the goods as currently described are unrelated and the channels of trade and circumstances of marketing avoid any likelihood of confusion.

Here, Cleary has satisfied the requirements in *Eurostar* by pleading that the proposed restriction would serve to avoid any likelihood of confusion with respect to Cleary's applied-for mark for "fungicides for agricultural use, namely outdoor terrestrial turf and ornamental agricultural fungicides," and that Novozymes has not used its registered mark on the goods which would be excluded from the registration.

Novozymes' motion to strike must be denied.

II. Novozymes' Alternative Motion for Judgment on the Pleadings.

Judgment on the pleadings will be granted only if the moving party clearly establishes that no genuine issue of material fact remains to be resolved and that it is entitled to judgment as a matter of law. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ 2d 1048, 1049 (TTAB 1992). For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn from them are to be viewed in a light most favorable to the nonmoving party. *Id.*

Here, Cleary has satisfied the requirements in *Eurostar* by pleading that the proposed restriction would serve to avoid any likelihood of confusion with respect to Cleary's applied-for mark for "fungicides for agricultural use, namely outdoor terrestrial turf and ornamental agricultural fungicides," and that Novozymes has not used its registered mark on the goods which would be excluded from the registration. If these facts are proven, Section 18 of the Trademark Act provides that the Board may modify Novozymes' description of goods as requested.

Judgment on the pleadings is not appropriate, and Novozymes' alternative motion must be denied.

III. Conclusion.

Novozymes has failed to meet the standard for the grant of either of its alternative motions made with respect to Cleary's counterclaim to restrict the description of goods of Novozymes' registration. Therefore, both Novozymes's motion to strike and alternative motion for judgment made with respect to said counterclaim should be denied.

Respectfully Submitted,

Dated: February 10, 2012

/Tama L. Drenski/
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing BRIEF IN OPPOSITION TO MOTION TO STRIKE AND/OR FOR JUDGMENT ON THE PLEADINGS UNDER F.R.C.P. 12(C) WITH RESPECT TO APPLICANT'S COUNTERCLAIM ENTITLED "REQUEST TO RESTRICT IDENTIFICATION OF GOODS" has been sent by first class mail, postage prepaid, to:

Edward M. Prince, Esq.
Alston & Bird LLP
950 F Street NW, The Atlantic Building
Washington, DC 20004

Attorney for Opposer, Novozymes Bioag, Inc., on the 10th day of February 2012.

/Tama L. Drenski/
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