

ESTTA Tracking number: **ESTTA512689**

Filing date: **12/21/2012**

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

Proceeding	91200105
Party	Defendant Cleary Chemicals, LLC
Correspondence Address	TAMA L DRENSKI RENNER KENNER GREIVE BOBAK TAYLOR ET AL FIRST NATIONAL TOWER , FL 4 AKRON, OH 44308- 1456 UNITED STATES pto@rennerkenner.com, tldrenski@rennerkenner.com
Submission	Other Motions/Papers
Filer's Name	Tama L. Drenski
Filer's e-mail	pto@rennerkenner.com
Signature	/Tama L. Drenski/
Date	12/21/2012
Attachments	12-10-2012 motion for relief from suspension.pdf ( 4 pages )(114422 bytes )

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.	)	
	)	

**MOTION FOR RELIEF FROM SUSPENSION TO FILE MOTION TO AMEND  
COUNTERCLAIM, AMENDED COUNTERCLAIM AND CROSS MOTION FOR  
SUMMARY JUDGMENT THAT OPPOSER’S REGISTRATION IS VOID *AB INITIO***

Now comes Applicant, Cleary Chemical LLC (“Cleary”), and moves the Board for relief from the suspension of the proceedings. The grounds for this motion are as follows:

1. Opposer, Novozymes Bioag, Inc. (“Novozyms”), filed a motion for summary judgment on Cleary’s counterclaim for fraud, which filing caused the Board to suspend these proceedings.
2. Cleary moved the Board for discovery under Rule 56(d), which motion the Board granted in part, allowing Cleary time in which to serve written discovery requests.
3. From Novozymes’ responses to Cleary’s written discovery requests, Cleary has learned and/or confirmed certain facts that show that Novozymes’ registration is void *ab initio*.

These facts include:

- a. Merck KGaA (“Merck”) filed the application to register TORQUE, which issued as U.S. Registration No. 3,511,124.
- b. The application filed by Merck was a use-based application.
- c. An application based on use in commerce must be filed by the party who is the owner of the mark as of the application filing date. 15 U.S.C. §1051(a).
- d. Merck did not use the mark TORQUE prior to or on the filing date of the application.
- e. Merck failed to claim ownership of the mark TORQUE through use by a related company, and such claim, if made, would have been invalid.
- f. A claim of ownership may be based on use by a related company whose use inures to the benefit of the applicant, but to the extent that a claim of ownership is based on use by a related company, such facts must be alleged in the application. 37 C.F.R. §2.38(b).
- g. Such facts were not alleged by Merck in the application.
- h. If the application is void, it will be unnecessary for the parties and the Board to spend time and resources deciding Novozymes’ motion for summary judgment on Cleary’s claim for fraud or any other grounds presented in Cleary’s counterclaims for cancellation.

Should the Board grant Cleary relief from the suspension, Cleary attaches for entry: (1) its motion to amend its counterclaim, (2) its amended counterclaim and (3) its cross motion for

summary judgment for cancellation on the ground that Novozymes' registration is void *ab initio* are attached.

### **BRIEF IN SUPPORT**

The general rule is that a party should not file any paper once the Board has suspended proceedings in a case pending a determination of a potential dispositive motion. The exception to that rule is that a party may file a paper "germane" (i.e., relevant) to a pending summary judgment motion.

The proposed filings are clearly relevant to the pending summary judgment motion. If the application that issued as Registration No. 3,511,124 is void *ab initio*, then Novozymes owns a registration that is void *ab initio*, and the issue of cancellation for fraud becomes moot. *See, ShutEmDown Sports, Inc. v. Carl Dean Lacy*, 102 U.S.P.Q. 2d 1036, 2012 WL 684464 (Trademark Tr. & App. Bd. 2012) ("We need not discuss the remaining elements of the fraud claim or render a decision on it, as we have already determined that the registration must be cancelled in its entirety both on the abandonment claim and because of the application's voidness.")

Further, under prior Rule 56, one cross motion that was considered a "germane paper" was a cross motion for summary judgment. *Nestle Co. v. Joyva Corp.*, 227 U.S.P.Q. 477, 478, note 4 (TTAB 1985). Present Rule 56(f) broadens the discretion of the Board, for it provides that after giving notice and a reasonable time to respond, the Board may grant summary judgment for a nonmovant or consider summary judgment on its own after identifying for the parties those material facts that may not be genuinely in dispute.

WHEREFORE, the Board is respectfully requested to find that the requested filings (Cleary's motion to amend its counterclaim, its amended counterclaim and its motion for

summary judgment that Novozymes' registration is void *ab initio*) are "germane," grant Cleary relief from the suspension and accept them for filing.

Dated: December 21, 2012      /Tama L. Drenski/

Tama L. Drenski (Reg. No. 50,323)  
Renner, Kenner, Greive, Bobak, Taylor & Weber  
106 S. Main Street, Suite 400  
First National Tower  
Akron, Ohio 44308-1412  
Telephone: (330) 376-1242  
FAX: (330) 376-9646  
Attorney for Applicant