ESTTA Tracking number: **ESTTA422752**
Filing date: **08/01/2011**

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

Proceeding	91200105
Party	Defendant Cleary Chemicals, LLC
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Submission	Answer and Counterclaim
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Date	08/01/2011
Attachments	DOC080111-008.pdf (14 pages)(434163 bytes)

Registration Subject to the filing

Registration No	3511124	Registration date	10/07/2008
Registrant	EMD CROP BIOSCIENCE INC. 13100 WEST LISBON AVENUE SUITE 600 BROOKFIELD, WI 53005 UNITED STATES		

Goods/Services Subject to the filing

Class 001. First Use: 2007/06/25 First Use In Commerce: 2007/06/25 All goods and services in the class are requested, namely: Natural molecule or bacteria for plant growth enhancement in agriculture crops

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

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

ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM

Applicant, CLEARY CHEMICALS, LLC, hereby answers, asserts its affirmative defenses and counterclaims with respect to the Notice of Opposition No. 91200105 as follows:

I. ANSWER

Applicant, CLEARY CHEMICALS, LLC ("Cleary"), hereby answers Notice of Opposition No. 91200105 as follows:

Paragraph 1:

EMD Crop BioScience Inc. and its predecessors (hereinafter collectively referred to as "Opposer") are manufacturers of chemical and biochemical preparations for use in the agriculture and horticulture fields, including natural and artificial manure for the earth, fertilizers, plant growth inoculants and bacteria plant growth promoters and enhancers to improve plant health and enhance growth of agriculture and horticulture crops.

Response:

Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 1.

Paragraph 2:

Since long prior to the filing date of the intent-to-use application opposed herein, opposer has used the mark TORQUE for one of its plant growth enhancement products – namely, natural molecule or bacteria for plant growth enhancement in agriculture crops (hereinafter "opposer's goods") and is the owner of United States Registration No. 3,511,124 for the mark TORQUE for natural molecule or bacteria for plant growth enhancement in agriculture crops, a copy of which is attached.

Response:

Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 2.

Paragraph 3:

On information and belief, Cleary Chemicals, LLC (hereinafter "Applicant") is a manufacturer of chemical preparations for use in agricultural and horticultural fields including fungicides.

Response:

Cleary admits only that it markets the following products for the turf and ornamental industries: fungicides, limestone, aminal repellants, insecticides, colorants, tank cleaners, defoamers, soil decontaminators, and anti-transpirants. Otherwise denies.

Paragraph 4:

On information and belief, applicant has adopted the mark TORQUE for fungicides and has filed an intent-to-use application on the mark TORQUE for fungicides for agricultural use and fungicides for domestic use.

Response:

Cleary admits only that it has adopted the mark TORQUE for Turf and Ornamental Fungicide, and has filed an intent-to-use trademark application, U.S. Serial No. 77/942162, on the mark TORQUE for Turf and Ornamental Fungicide. Otherwise denies.

Paragraph 5:

On information and belief, applicant made no use of the mark TORQUE prior to the filing date of its application, namely, February 23, 2010.

Response:

Denies.

Paragraph 6:

On information and belief, applicant has made no use of the mark TORQUE prior to (a) the filing date of opposer's application, namely, October 19, 2007 and (b) the issue date of opposer's Registration No. 3,511,124 - namely, October 7, 2008.

Response:

As presently advised, Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 6.

Paragraph 7:

On information and belief, applicant is now using the mark TORQUE for fungicides for agricultural use.

Response:

Admits only that Cleary is using the mark "TORQUE" and affirmatively states that it is using the mark "TORQUE" for Turf and Ornamental Fungicide. Otherwise denies.

Paragraph 8:

On information and belief, applicant is now using the mark TORQUE for fungicides for domestic use.

Response:

Admits only that Cleary is using the mark "TORQUE" and affirmatively states that it is using the mark "TORQUE" for Turf and Ornamental Fungicide. Otherwise denies.

Paragraph 9:

On information and belief, applicant's fungicides are compatible with, and can be used in conjunction with, plant growth enhancement products.

Response:

Clearly lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 9.

Paragraph 10:

On information and belief, applicant's fungicides are compatible with opposer's natural molecule or bacteria for plant growth enhancement in the agriculture crops.

Response:

Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 10.

Paragraph 11:

On information and belief, applicant's fungicides are sold through distributors who also handle plant growth enhancement products.

Response:

Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 11.

Paragaph 12:

Opposer's chemical and biochemical products, including opposer's goods sold under the mark TORQUE, are distributed through Ag distributors also handling applicant's fungicide products.

Response:

Cleary lacks knowledge or information sufficient to form a belief about the truth of the allegations of Paragraph 12.

Paragraph 13:

On information and belief, applicant's goods and opposer's goods are sold or are likely to be sold through the same channels of trade and by the same distributors and/or to the same end customers.

Response:

Denies.

Paragraph 14:

On information and belief, Crop Production Services, Loveland Product Division, is a customer of applicant's TORQUE fungicides.

Response:

Admits only that Cleary is a supplier for Agrium Advanced Technologies, and that Agrium Advanced Technologies supplies Crop Production Services' Turf & Ornamental business east of the Rockies. Otherwise denies.

Paragraph 15:

On information and belief, Wilber Ellis is a customer of applicant's TORQUE fungicides.

Response:

Admits only that Wilbur Ellis is a customer or a supplier of Clearly in the Turf + Ornamental Market Segment. Cleary denies that its TORQUE product is supplied to or marketed by Wilbur Ellis.

Paragraph 16:

On information and belief, Cardinal Chemical is a customer of applicant's TORQUE fungicides.

Response:

Denies.

Paragraph 17:

On information and belief, Simplot is a customer of applicant's TORQUE fungicides.

Response:

Admits only that Cleary is a supplier for Simplot Partners Turf & Horticulture, which provides products to golf courses, landscapers, nurseries, municipalities and athletic field managers. Otherwise denies. Denies that Cleary Chemicals is a customer or supplier of Simplot Agra Business.

Paragraph 18:

On information and belief, Van Diest Supply Company is a customer of applicant's TORQUE fungicides.

Response:

Admits only that Cleary is a supplier for the Specialty Products Eivision of Van Diest Supply Company, which offers products for the turf, tree and ornamental market, the vegetation management market, the mosquito control market and the aquatics market. Denies that Cleary Chemicals is a supplier or customer of Van Diest Ag Distribution.

Paragraph 19:

On information and belief, Helena Chemical is a customer of applicant's TORQUE fungicides.

Response:

Admits only that Cleary Chemicals is a supplier for Helena Chemicals Specialty Division, which offers a variety of turf and ornamental professional products, forestry and vegetative management chemicals, fertilizers, turf seed and related products. Denies that Cleary Chemicals is a supplier and customer of Helena Products Group, which markets products that fall under the crop protection and crop production categories.

Paragraph 20:

Turf use restrictions and precautions on applicant's TORQUE fungicide label include warnings reading in part "Do not use on home lawns, Not for homeowner use, and Do not use clippings for animal feed."

Response:

Denies.

Paragraph 21:

Opposer is damaged or will be damaged by the sale or offering for sale of applicant's goods bearing the mark TORQUE since applicant's mark, as used in connection with applicant's goods, falsely suggests a connection with opposer's goods and/or falsely suggests that applicant is associated with, or sponsored by, opposer.

Response:

Denies.

Paragraph 22:

The mark TORQUE so resembles opposer's mark TORQUE, previously used in interstate commerce by opposer, and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake or to deceive.

Response:

Denies.

II. AFFIRMATIVE DEFENSES

23. The agricultural chemicals market is highly segmented such that Applicant's goods and Opposer's goods are not sold nor are they likely to be sold through the same channels of trade or by the same distributors or to the same end customers. By way of examples, Wilbur

Ellis is comprised of at least three divisions, with the Agribusiness Division further sub-divided based upon Market Segment, including Turf + Ornamental (See Exhibit A). Wilbur Ellis Products are not available online, or through retail outlets, but must be purchased through Wilbur-Ellis professionals; J.R. Simplot Company is made up of a number of divisions, and the Agricultural Division is completely separate from the Turf and Horticultural Division (See Exhibit B). The Simplot Partners®TurF & Horticulture Headquarters office is in Palm Desert, California. In contrast, the Simplot Agra Business Headquarters is in Boise, Idaho; the Van Diest Supply Company consists of three major divisions, Ag Distribution, Specialty Products and Formulation/Bulk Terminalling. The Specialty Products Division Headquarters is located in McCook, Nebraska, while the Ag Distribution Headquarters is in Webster City, Iowa (See Exhibit C); and the Helena Chemical Company has at least two distinct business units, the Helena Products Group and the Specialty Division. The Helena Products Group markets crop protection and crop production products from Memphis, Tennessee. The Specialty Division has other locations separate and apart from Memphis, Tennessee (Exhibit D). As such, Applicant is at least entitled to a registration with a restriction in the identification of goods as follows: fungicides for domestic use, and fungicides for agricultural use, namely outdoor terrestrial turf and ornamental agricultural fungicides.

24. Opposer's mark is weak, and is only entitled to a narrow scope of protection against closely related goods or services.

25. On information and belief, Opposer's mark was fraudulently obtained. The original application was filed under Section 1(a) of the Trademark Act. No specimen was

provided. No date of first use anywhere was provided. The application was not signed and verified as required therefore, the initial application was not complete. In response to an Office Action, Opposer submitted a specimen dated 2008, and fraudulently stated that the specimen had been in use at least as early as the filing date of the application, which was October 19, 2007. The described acts of EMD were done knowingly and with the intent to induce the Trademark Examiner to rely thereon and grant said registration. Reasonably relying upon the truth of said false statement, and as a consequence thereof, the U.S. Patent and Trademark Office did, in fact, grant said registration to EMD.

In view of the foregoing, Applicant contends that this opposition is groundless and baseless in fact; that Opposer has not shown where it will be or is likely to be damaged by the registration of Applicant's trademark. Therefore, Applicant requests that the Opposition be overruled, and that Applicant's mark that is the subject of Application Serial No.77/942,162 be placed on the Principal Register.

III. COUNTERCLAIMS

Applicant CLEARY CHEMICAL COMPANY ("Cleary") asserts the following counterclaims:

REQUEST TO RESTRICT IDENTIFICATION OF GOODS

1. Clearly has applied to register the mark TORQUE for "fungicides for agricultural use; fungicides for domestic use" (Application Serial No. 77/942,162).

2. EMD Crop BioScience Inc. ("EMD") is the purported owner of Registration No. 3,511,124 for the mark TORQUE for "natural molecule or bacteria for plant growth enhancement

in agriculture crops."

3. EMD has filed the within opposition alleging that the parties respective goods travel through the same channels of trade and are sold by the same distributors to the same end customers.

4. The agricultural chemicals market is highly segmented such that Cleary's goods and EMD's goods are not sold nor are they likely to be sold through the same channels of trade or by the same distributors or to the same end customers. By way of examples, Wilbur Ellis is comprised of at least three divisions, with the Agribusiness Division further sub-divided based upon Market Segment, including Turf + Ornamental (See Exhibit A). Wilbur Ellis Products are not available online, or through retail outlets, but must be purchased through Wilbur-Ellis professionals; J.R. Simplot Company is made up of a number of divisions, and the Agricultural Division is completely separate from the Turf and Horticultural Division (See Exhibit B). The Simplot Partners®TurF & Horticulture Headquarters office is in Palm Desert, California. In contrast, the Simplot Agra Business Headquarters is in Boise, Idaho; the Van Diest Supply Company consists of three major divisions, Ag Distribution, Specialty Products and Formulation/Bulk Terminalling. The Specialty Products Division Headquarters is located in McCook, Nebraska, while the Ag Distribution Headquarters is in Webster City, Iowa (See Exhibit C); and the Helena Chemical Company has at least two distinct business units, the Helena Products Group and the Specialty Division. The Helena Products Group markets crop protection and crop production products from Memphis, Tennessee. The Specialty Division has other locations separate and apart from Memphis, Tennessee (See Exhibit D).

5. Because the agricultural chemicals market is highly segmented and the parties' goods are not sold nor are they likely to be sold through the same channels of trade or by the same distributors or to the same end customers, Cleary is at least entitled to a registration with a restriction in the identification of goods as follows: fungicides for domestic use, and fungicides for agricultural use, namely, outdoor terrestrial turf and ornamental agricultural fungicides.

In view of the foregoing allegations, Cleary is entitled to a registration with the requested restriction in the identification of goods. As such, Cleary prays that its counterclaim for restriction be sustained in its favor and Cleary's mark that is the subject of Application Serial No. 77/942,162 be placed on the Principal Register.

CANCELLATION

1. Cleary believes that it has been and will be damaged by Registration No. 3,511,124 for the mark TORQUE for "natural molecule or bacteria for plant growth enhancement in agriculture crops," owned in the name of EMD Crop BioScience Inc. ("EMD"), and pursuant to 15 U.S.C. §1064 et seq. and 37 C.F.R. §2.111 et seq., hereby petitions to cancel the same.

2. Cleary markets the following products for the turf and ornamental industries: fungicides, limestone, animal repellants, insecticides, colorants, tank cleaners, defoamers, soil decontaminators, and anti-transparent.

3. Since at least February 23, 2010, Cleary has used the mark TORQUE in connection with its sales of Turf and Ornamental Fungicide.

4. EMD has opposed Cleary's registration of the mark TORQUE, and has objected and is likely to continue to object Cleary's continued use of the mark.

5. On information and belief, EMD's mark was fraudulently obtained. The original application was filed under Section 1(a) of the Trademark Act. No specimen was provided. No date of first use anywhere was provided. The application was not signed and verified as required therefore, the initial application was not complete. In response to an Office Action, Opposer submitted a specimen dated 2008, and fraudulently stated that the specimen had been in use at least as early as the filing date of the application, which was October 19, 2007. The described acts of EMD were done knowingly and with the intent to induce the Trademark Examiner to rely thereon and grant said registration. Reasonably relying upon the truth of said false statement, and as a consequence thereof, the U.S. Patent and Trademark Office did, in fact, grant said registration to EMD.

In view of the foregoing allegations, EMD is not entitled to continued registration of its mark since upon information and belief, EMD committed fraud in the procurement of the subject registration. As such, Cleary prays that Registration No. 3,511,124 for the mark TORQUE for natural molecule or bacteria for plant growth enhancement in agriculture crops issued October 7, 2008 be cancelled, and that its Counterclaim for Cancellation be sustained in favor of Cleary.

Respectfully Submitted,

Date August 2, 2011

Tama Drenski

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Attorney for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Answer, Affirmative Defenses and Counterclaim 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, *EMD Crop Bioscience, Inc.,* on the 1 day of Aug., 2011

Tama L. Drenski

Tama L. Drenski