

ESTTA Tracking number: **ESTTA425265**

Filing date: **08/15/2011**

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

Proceeding	91200480
Party	Defendant Interra Energy, LLC
Correspondence Address	INTERRA ENERGY, LLC INTERRA ENERGY, LLC 10385 LONDONDERRY AVE SAN DIEGO, CA 92126-3316  thomas.r.del.monte@gmail.com
Submission	Answer and Counterclaim
Filer's Name	Thomas R. Del Monte
Filer's e-mail	thomas@interraenergy.us
Signature	/Thomas R. Del Monte/
Date	08/15/2011
Attachments	Answer to Notice of Opposition 8-15-2011.pdf ( 15 pages )(125752 bytes )

Registration Subject to the filing

Registration No	2388971	Registration date	09/26/2000
Registrant	ITERA International Energy Corporation 10151 Deerwood Park Boulevard Building 100, Suite 410 Jacksonville, FL 32256 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 039. First Use: 1994/00/00 First Use In Commerce: 1994/00/00 All goods and services in the class are requested, namely: distribution of natural gas to others; public utility services, namely, supplying natural gas to others, natural gas supply services to others
---

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

**Answer to Notice of  
Opposition**

Opposition No: 91200480

**Applicant Information**

Application No	85036807	Publication date	03/15/2011
Opposition Filing Date	07/01/2011	Opposition Period Ends	07/13/2011
Applicant	Interra Energy, Inc. (pending assignment) 6456 Osler Street San Diego, CA 92111 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. Operating a solid waste biomass-to-energy system, comprised of a reactor machine that produces carbon-based soil amendment and electricity, for others; Retail electricity provider services, namely, providing a service that allows customers to purchase energy, namely, electricity.
--

**Opposer Information**

Name	Itera International Energy Corporation
Granted to Date of Previous Extension	07/13/2011
Address	9995 Gate Parkway, Suite 400 Jacksonville, FL 32246 UNITED STATES

Attorney Information	Mary Baril McGuireWoods LLP 901 E Cary St., Richmond, VA 23219 UNITED STATES mbaril@mcguirewoods.com Phone: 8047751169
----------------------	--

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2455174	Application Date	04/12/2000
Registration Date	05/29/2001	Foreign Priority Date	NONE
Word Mark	ITERA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 exchange services, namely, bartering goods for others Class 036. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 commodity brokerage and commodity trading for others Class 039. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 distribution of natural gas to others; public utility services.		
U.S. Registration No.	2388971	Application Date	04/04/1997
Registration Date	09/26/2000	Foreign Priority Date	NONE
Word Mark	ITERA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 exchange services, namely, bartering goods for others Class 036. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 commodity brokerage and commodity trading for others Class 039. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 distribution of natural gas to others; public utility services.		

## Certification of Service

I hereby certify that, pursuant to mutual agreement by the parties, the Opposer was properly served by electronic copy of this Answer on August 15, 2011.

Signature	/Thomas R. Del Monte/
Name	Thomas R. Del Monte
Date	August 15, 2011

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

In re Application of: Interra Energy, Inc.

Serial No.: 85036807

Filed: May 12, 2010

Mark: INTERRA ENERGY

Published: March 15, 2011

Itera International Energy Corporation )  
Opposer, )  
v. )  
Interra Energy, Inc. )  
Applicant. )

Answer No. 1

## ANSWER & COUNTERCLAIM

Interra Energy, Inc.<sup>1</sup> (“Applicant”), a Delaware corporation, with its principal place of business at 6456 Osler Street, San Diego, CA 92111, hereby answers Itera International Energy Corporation’s (“Opposer”) Notice of Opposition of registration of the mark shown in Serial No. 85036807.

Opposer alleges 13 claims, and Applicant answers these claims in turn and asserts counterclaim in the answer to Opposer’s claim #4:

- 1. Applicant does not contest claim #1.**
- 2. Applicant does not contest claim #2.**
- 3. Applicant does not contest claim #3.**
- 4. Applicant denies claim #4 and asserts counterclaim.**

Opposer claims:

Opposer duly adopted the trademark ITERA for the use in connection with its said services and offers these services in interstate commerce. Since adoption of said trademark, Opposer has continuously used said trade mark in connection with its services.

Applicant answers and counterclaims:

**Opposer has abandoned its mark.**

**Nonuse in commerce:** Applicant is unaware of any evidence that Opposer has engaged in the bona fide use of the ITERA mark in connection with its claimed services registered with the mark in the ordinary course of trade for three (3) consecutive years, if ever. On Opposer’s “About

---

<sup>1</sup> Interra Energy, LLC has been converted to Interra Energy, Inc., a Delaware Corporation.

Us” section of its Web site, Opposer advertises that more than three (3) years ago it shifted away from trading/exchanging activities and “developed into a U.S.-based – energy and real estate company.”<sup>2</sup>

Four (4) of Opposer’s five (5) energy activities in the United States operate under names other than Opposer’s mark. Itera lists The Archer Group, BioEnergy International, Grayson Hill Energy, and Quail Energy. Only Itera Rig, LLC uses Opposer’s mark in commerce. Itera Rig, LLC “operates drilling rigs that explore for oil and gas under contract to 3rd parties.”<sup>3</sup> Simply put, Opposer’s only use of the mark is in connection to providing to 3rd parties the service of digging deep holes. Digging or drilling holes for others in search of oil is not “exchange services, namely, bartering goods for others,” nor is it “commodity brokerage and commodity trading for others,” nor is it “distribution of natural gas to others; public utility services, namely, supplying natural gas to others, natural gas supply services to others,” as Opposer asserts. Therefore, Opposer has not, for at least three years, used its mark in commerce.

**Abandonment of mark:** Nonuse for three (3) years is prima facie evidence of abandonment. Further, Opposer’s intent to abandon the mark is made clear by its public advertisement that it “developed into a U.S.-based – energy and real estate company,” plus the shifting of all energy related activities—save one drilling activity—into companies with different names. It should also be noted as further evidence of abandonment of Opposer’s mark that soon after Opposer acquired BioEnergy International it changed its name to Myriant Technologies and trademarked that name. Use in commerce on foreign soil is not relevant in the present circumstances. For U.S. Trademark purposes, services registered with a mark must be performed under the mark continuously on U.S. soil to be counted foreign use in commerce. Similarly, advertisements in the form of a static Web site that has not been updated for over three years<sup>4</sup> does

---

<sup>2</sup>IteraUSA website, Energy Resources, Itera Rig, LLC, available at, <http://itera.com/index2.htm>.

<sup>3</sup>IteraUSA website, Energy Resources, Itera Rig, LLC available at <http://itera.com/index2.htm> (emphasis added).

<sup>4</sup> Comparison made between screenshots exhibited in Opposer’s trademark-renewal application and Opposer’s Web site

not support a finding of Opposer's use of the mark in commerce. Because Opposer abandoned its mark, Opposer has no basis for opposition

**5. Applicant denies claim #5.**

Opposer claims:

The registered mark of Opposer is valid and subsisting and is prima facie evidence of Opposer's exclusive right to use the mark in commerce in connection with the services specified in the registration.

Applicant answers:

See answer and counterclaim to Opposer's claim #4

**6. Applicant denies claim #6.**

Opposer claims:

Opposer has made a substantial investment in advertising and promoting its services as described above under the registered marks on a nationwide basis, and has developed substantial goodwill which is symbolized by Opposer's ITERA mark.

Applicant answers:

**Substantial investment sub-claim:** Applicant is unaware of the investment Opposer has made in connection to advertising and promoting its services. The only evidence found of actual spending on behalf of promoting Opposer's business are 1) the actual construction of a website and 2) a payment of \$500,000 in 2006 to be the first client of the then 29 year-old daughter of Congressman Weldon (now former Congressman) for promoting "good public relations so in the future ITERA may sell goods and services to U.S. entities."<sup>5</sup>

**Development of goodwill in the mark assertion—to the General Public:** The fact that it

---

view on Aug. 13, 2011.

<sup>5</sup> Silverstein, Neubauer and Cooper, *Lucrative Deals for Daughters of Politicians*, LA Times, Feb. 20, 2004, available at, <http://articles.latimes.com/2004/feb/20/nation/na-weldon20>. See also, Silverstein, *The Very Proactive Congressman: Curt Weldon deserves honorable mention on list of dumbest members of Congress*, Harper's Magazine, Oct. 17, 2006 available at, <http://harpers.org/archive/2006/10/sb-the-very-pr-1161110492>.

has been three (3) years, seven (7) months and seventeen (17) days since Opposer promoted a press release, plus the lack of updating or changes to Opposer's Web site for several years<sup>6</sup> suggest neglect of General Public's goodwill in the mark and abandonment of the mark, rather than promotion and development of the mark. Leaving no other information available for Applicant to base an affirmation or denial of this claim, more information as to the spending activities associated with Opposer's mark would be needed to establish this assertion.

**Development of goodwill in the mark assertion—to other customers:** Because of the Federal Bureau of Investigation scrutiny of this payment<sup>7</sup>, Applicant is unclear of whether the payment is properly characterized a payment for promotion of Opposer's services or more properly falls into a more dubious category of transactions. Leaving no other information available for Applicant to base an affirmation or denial of this claim, more information as to the spending activities associated with Opposer's mark would be needed to establish this assertion.

#### **7. Applicant denies Opposer's claim #7.**

Opposer claims:

By virtue of its substantial investment in advertising and promoting its services under the registered marks and by virtue of the excellence of its services, Opposer has gained for the marks a valuable reputation.

Applicant answers:

Applicant does not know enough information to verify Opposer's claimed excellence in service.

**Value of reputation associated with the mark:** Applicant has seen no evidence that suggests a valuable reputation in Opposer's mark. In fact, only evidence to the contrary is readily available. As further evidence of the value of Opposer's mark and its reputation as a business, the

---

<sup>6</sup> See footnote 4.

<sup>7</sup> Smith & Leonning, *Weldon's Ties to Serbian Businessman Part of Probe*, Washington Post, available at, Oct. 18, 2006, <http://www.washingtonpost.com/wp-dyn/content/article/2006/10/17/AR2006101701560.html>.

Table of Contents of Opposer's Wikipedia page reads<sup>8</sup>:

- [1 Russian scandals](#)
- [2 Italian scandals](#)
- [3 U.S. scandals](#)
- [4 References](#)
- [5 External links](#)

The reputation associated with Opposer's mark does not publically appear to be a valuable asset, rather it is damaging to Opposer. By highlighting Opposer's negative reputation in the public domain, Applicant makes no claim as to the veracity of these scandalous accusations but intends only to offer a sample of Opposer's public reputation, which Opposer brings into issue in its Notice of Opposition. Therefore, the fact that this Wikipedia article along with several other severely unflattering media stories, coupled with the fact that, as previously stated, the last press release given by the company was almost four (4) years ago, Applicant asserts that the value of Opposer's reputation is null, and may even be cumulatively negative for Opposer.

**8. Applicant denies Opposer's claim #8.**

Opposer claims:

Opposer's marks and the mark identified by Serial No. 85036807 are virtually phonetically and visually identical.

Applicant answers:

<b>Phonetic Differences</b>		
	<b>ITERA</b>	<b>INTERRA ENERGY</b>
How used in commerce	Itera USA or Itera	Interra Energy
Pronunciation	EE-tier-a <sup>9</sup>	IN- târ -a

<sup>8</sup> Itera's page on Wikipedia, available at, <http://en.wikipedia.org/wiki/Itera>.

<sup>9</sup> As confirmed by phone call to Itera USA's Florida office on Aug. 12, 2011, 5:53pm PST.

<b>Visual Differences</b>		
	ITERA	INTERRA ENERGY
Words in the mark	1	2
Number of letters	<ul style="list-style-type: none"> <li>• As registered: 5</li> <li>• As used: 5 or 8</li> </ul>	<ul style="list-style-type: none"> <li>• As registered: 13</li> <li>• As used: 7 or 13</li> </ul>
<b>Grammatical &amp; Cultural Differences</b>		
Applicant's use of the double 'r', called the Spanish letter 'erre,' further distinguishes Applicant's mark from Opposer's.		

The comparison above demonstrates Opposer's and Applicant's marks are *not* "virtually phonetically and visually identical," as Opposer claims.

**9. Applicant denies Opposer's claim #9.**

Opposer claims:

The mark used by Applicant so resembles Opposer's above identified registered marks as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive purchasers, resulting in damage to Opposer and its reputation.

Applicant answers:

**Noncompeting Services:** As the table below demonstrates, Opposer and Applicant do not compete in the market place on those goods and services registered under Opposer's mark or those other goods and services Opposer performs in commerce today under Opposer's other doing-business-as names. The only potential for competitive overlap is in the broad "energy" market—one of the largest markets globally—in which Opposer provides fossil fuel natural gas services and Applicant supplies electricity and electricity service.

Goods/ Service	Customers		Competition in market place
	ITERA	INTERRA ENERGY	
Carbon-based soil amendment (a.k.a. biochar)	N/A	Retail “home & garden” customers, agricultural customers, purchasers of activated carbon and other carbon products.	None. Itera USA does not produce, trade, transport, etc. biochar or biochar products.
Electricity, for others; Retail electricity provider services, namely, providing a service that allows customers to purchase energy, namely, electricity	N/A	Public utilities, Interra facility site hosts, adjacent properties to Interra facilities site, brokers who aggregate renewable energy producers.	None. Opposer’s only known instance of electricity <i>production</i> is that at its Grayson Hill Energy operation acquired in 2002. This plant merely “supplies a large portion of the electricity required to run plant operations.” <sup>10</sup> That is, they are not in the business of electricity production. What electricity they produce is not sold to customers.
Drilling for 3 <sup>rd</sup> party extractors of fossil fuels.	3 <sup>rd</sup> Party Clients	N/A	None. Applicant does not now, nor plans to, engage in the business of digging holes to extract fossil fuels (oil and gas) from the earth. Applicant’s technology uses none of these fossil fuel inputs at all in production, and in fact theoretically reverses Opposer’s operations by returning the carbon (in the form of biochar) that Opposer’s industry directly extracts from the ground.
Bartering goods for others	Not Known	N/A	None. Applicant does not now, nor plans to, engage in the business of bartering goods for others.
Commodity trading for others	Not Known	N/A	None. Applicant does not now, nor plans to, engage in the commodity trading for others.

<sup>10</sup> Itera USA website, [available at, http://www.itera.com/index2.htm](http://www.itera.com/index2.htm).

Distribution of natural gas to others; public utility services, namely supplying natural gas to others; natural gas supply services to others	Public utilities, Large scale power generation.	N/A	None. Applicant does not now, nor plans to, engage in the distribution of any fossil fuels to others.
---	---	-----	---

Clearly, there are no instances of direct competition; therefore, the inquiry must shift to a related goods analysis.<sup>11</sup> Regardless of which Federal Circuit test this tribunal may employ to examine the likelihood of confusion—whether the test includes four (4) factors or eleven (11)—the analysis boils down to the seven (7) essential concerns which will be briefly addressed in turn:

**1. Strength of plaintiff’s mark:** Having gone through discovery for the purposes of this Answer only, Applicant will assume Opposer’s mark is a fanciful or arbitrary mark, which connotes an inherent distinctiveness. However, on the basis of acquired distinctiveness (also known as secondary meaning), Opposer’s mark weakens in strength. This is due to several instances where Opposer’s acts of omission caused the significance of the mark to be lost as explained above. Opposer has not made a claim to fame, so discussion of whether fame and infamy are the equivalent in dilution analysis is not necessary.

**2. Marketing channels used:** Except for those channels to market referenced above, the only channel to market Applicant is aware of for Opposer’s channel to market is by the use and promotion of other names than the ITERA mark.

**3. Actual confusion:** Opposer offers evidence of instances of actual confusion. Over the roughly

---

<sup>11</sup> AMF INC. v. Sleekcraft Boats, 599 F. 2d 341 -Court of Appeals, 9th Circuit.

two years Applicant has been using the INTERRA ENERGY trade name, no such evidence of confusion with Opposer's mark was discovered.

**4. Similarity of marks used in commerce:** Applicant and Opposer's marks are not similar in meaning. See also analysis above in Applicant's answer to Opposer's claim #8. In no meaningful way, is INTERRA ENERGY similar to The Archer Group, BioEnergy International, Grayson Hill Energy, nor Quail Energy.

**5. Proximity of markets:** See Applicant's discussion in answers to Opposer's claims #s 4 and 8.

**6. Degree of consumer care:** The degree of consumer care in making purchase decisions in Opposer's and Applicant's energy related markets, is extremely high. These are sophisticated buyers representing multi-million, often multi-billion dollar, entities. The degree of care in handling the purchases in these markets are arguably as high as possible in human cognitive decision making capacity.

**7. Applicant's intent:** Applicant spent several weeks researching potential names and came up with Applicant's mark through a conversation about putting carbon back into the earth, that is 'in-tierra.'<sup>12</sup>

#### **10. Applicant denies Opposer's claim #10**

Opposer claims:

The services to which Applicant applies the INTERRA ENERGY mark and the services for which Opposer's ITERA mark is registered are purchased by and targeted at a similar category of consumers.

Applicant answers:

See the analysis in Applicant's answer to claims #s 4 and 9.

---

<sup>12</sup> [Tierra translates to Earth in several languages.](#)

**11. Applicant denies Opposer's claim #11.**

Opposer claims:

Because of the similarity between the mark used by Applicant and Opposer's marks and because the services of both parties are similar and likely to be encountered by the same customer group, Opposer's customers and the general public are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's services and misled into believing that those services are provided by, or are in some other way directly or indirectly associated with Opposer, to the damage of Opposer and its reputation.

Applicant answers:

For the reasons stated above, Applicant denies Opposer's claim #11.

**12. Applicant denies Opposer's claim #12.**

Opposer claims:

Any defects, objections or faults found with Applicant's services bearing the INTERRA mark because of false association with Opposer, would inflict serious injury upon the reputation of Opposer;

Applicant answers:

For the above stated reasons false association cannot reasonably occur.

**13. Applicant denies Opposer's claim #13.**

Opposer claims:

Opposer and its goodwill will be damaged by the registration by Applicant of the INTERRA mark in that the mark is substantially similar to, and a colorable imitation of Opposer's pleaded marks and is used in connection with services similar to Opposer's services.

Applicant answers:

Applicant's mark is substantially similar to or colorable imitations of any of Opposer's mark.

WHEREFORE, Applicant, ITERRA ENERGY, Inc., prays that the Application with Serial No. 85036807 be accepted, that registration be issued thereon to Applicant, that this Opposition be overruled in favor of Applicant, and that Opposer's word mark "ITERA" registration #: 2388971 be cancelled due to abandonment.

Respectfully Submitted,

A handwritten signature in blue ink that reads "Thomas R. Del Monte". The signature is written in a cursive, flowing style.

Thomas R. Del Monte, Esq.  
General Counsel  
Interra Energy, Inc.  
6456 Osler Street,  
San Diego, California 92111

Dated August 15, 2011