

TTAB

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

In re Application No. 76//291959  
Published September 10, 2002



United Industries Corporation  
Opposer,

11-19-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

v.

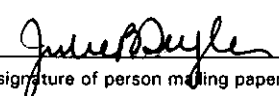
OppositionNo. 91155808

OMS Investments, Inc.  
Applicant.

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

APPLICANT'S MOTION TO DISMISS  
THE AMENDED NOTICE OF OPPOSITION  
FOR FAILURE TO STATE A CLAIM

Applicant is seeking to register the mark MIRACLE for lawn and garden fertilizer, plant food, fertilizer in the form of spikes for houseplants, outdoor plants, trees and shrubbery; peat, compost, humus, loan and manure; potting soil, soil conditioners, soil amendments, and growing media for plants all for domestic use; herbicides for domestic use; mechanical spreaders for seed; fertilizer mixers and sprayers attached to garden hoses; and live plants.

**CERTIFICATE OF MAILING**  
**Date of Deposit : November 17, 2003**  
 I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.  
**JULIE B. SEYLER**  
  
 (signature of person mailing paper or fee)

Applicant is the owner of the famous trademark MIRACLE-GRO, (Registration Nos. 2,235,973; 1,223,038; 1,223,038, and 668,868), copies attached. MIRACLE-GRO has been used in commerce for over 50 years. Applicant also owns the following trademarks that include the word MIRACLE for identical or related goods:

Trademark	Goods	Registration No.
KEEP THE MIRACLE GROWING ALL SEASON	Fertilizer for domestic use	2,580,976
EVERY OTHER WEEK MAKES MIRACLES	Fertilizer for domestic use	2,584,488
MIRACLE EARTH	Growing media for plants and soilconditioners for domestic use; compost	2,513,436 and 1,978,641
FOR MIRACLE GARDEN RESULTS	Fertilizer for domestic use	2,418,043

The trademarks are registered on the Principal Register. The word MIRACLE has not been disclaimed. The registrations constitute evidence as to the validity of the marks. 15 U.S.C. 1057 (b).

Opposer is requesting that the Trademark Trial and Appeal Board refuse registration of the mark MIRACLE on the ground that "Opposer believes that the mark is descriptive and therefore not registrable under Section 2(e)(1)." Paragraph 3 of the Amended Notice of Opposition. It is submitted that despite the fact that Opposer alleges Section 2(e)(1) as a basis to oppose registration of the mark MIRACLE, Opposer has failed to set forth a well-pleaded cause of action. It is requested that the Motion to Dismiss be granted.

Applicant's Brief in support of this Motion follows.

**BRIEF**

It is well-settled that a descriptive mark is one that describes an ingredient, quality, characteristic, function, feature, purpose or use of Applicant's goods. *See In re Gyulay*, 820 F.2d

1216, 3USPQ2d 1009 (Fed. Cir. 1987); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Opposer alleges that registration of the term MIRACLE will be detrimental to Opposer, but fails to allege how the word MIRACLE describes an ingredient of fertilizers, potting soil, herbicides, mechanical spreaders, live plants or any of the goods set forth in Application No. 76/291959. Nor does Opposer plead how the mark MIRACLE describes a quality of these goods and/or a characteristic of these goods and/or a function of these goods and/or a feature of these goods and/or a purpose of these goods, and/or the use of these goods. Opposer is silent on this point, and its silence underscores its failure to state a cause of action.

Rather, given that Opposer has failed to insert a short and plain statement explaining the descriptive significance of MIRACLE, coupled with the fact that the Notice of Opposition, as originally filed, failed to state a claim for relief, it appears that Opposer is attempting to “create” a cause of action. However, it is respectfully submitted that absent a statement as to how the word MIRACLE describes Applicant’s goods, the Amended Notice of Opposition is defective on its face.

Opposer asserts in Paragraph 4 of the Opposition “that Applicant’s registration of the single term MIRACLE...will be detrimental to Opposer’s right to use the term in conjunction with other terms or as part of slogans for the same or related products.” This allegation does not support refusal of the application on the grounds of descriptiveness. Opposer has failed to set forth a ground stating why the mark describes the goods, and by this substantive defect Opposer fails to explain how registration of this mark is detrimental to Opposer.

Further, simply requesting refusal under Section 2(e)(1) without a claim as to the descriptive significance of the mark, is prejudicial and burdensome to Applicant. It places Applicant in the position of having to guess why MIRACLE is descriptive. In fact, the pleading is so vague as to

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make it impossible for Applicant to respond. This is especially burdensome given the fact that the U.S. Patent and Trademark Office has never raised a descriptiveness issue with respect to the word MIRACLE.

Opposer's Amended Notice of Opposition is legally insufficient for the same reasons that the originally filed Notice of Opposition was insufficient. Opposer has failed to set forth a valid ground for denying registration

Applicant respectfully requests that the Board grant Applicant's Motion to Dismiss and deny Opposer the opportunity leave to amend its pleading. Opposer has now had two opportunities to set forth a clear and concise basis why registration should be refused. It has not done so. It is therefore apparent that the Opposition has no basis in fact or law. FRCP 15(a); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 221 USPQ 151 (TTAB 1983), *aff'd*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984), (amendment would serve no useful purpose); TBMP 507.02.

The purpose of Rule 12(b)(6) "is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038, 1041, (Fed. Cir. 1993). The Opposition is fatally flawed.

WHEREFORE, it is requested that the above Motions be granted and the Opposition refused with prejudice.

Respectfully submitted

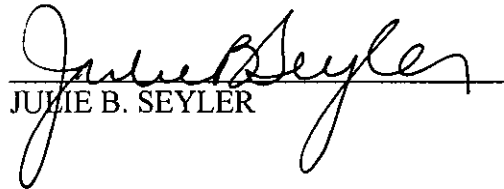
  
\_\_\_\_\_  
JULIE B. SEYLER

ABELMAN FRAYNE & SCHWAB  
150 East 42nd Street  
New York, New York 10017  
212-949-9022

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **APPLICANT'S MOTION TO DISMISS  
FOR FAILURE TO STATE A CLAIM** was served by first class mail; postage prepaid this  
17<sup>th</sup> day of November 2003 upon the following:

Annette P. Heller  
UNITED INDUSTRIES CORPORATION  
14323 South Outer Forty Drive  
Suite 512 S  
Town & Country, MO. 63017

  
JULIE B. SEYLER



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### Check Status

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### Typed Drawing

<b>Word Mark</b>	KEEP THE MIRACLE GROWING ALL SEASON
<b>Goods and Services</b>	IC 001. US 001 005 006 010 026 046. G & S: FERTILIZER FOR DOMESTIC USE. FIRST USE: 19990800. FIRST USE IN COMMERCE: 19990800
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76068823
<b>Filing Date</b>	June 12, 2000
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	March 26, 2002
<b>Registration Number</b>	2580976
<b>Registration Date</b>	June 18, 2002
<b>Owner</b>	(REGISTRANT) OMS Investments, Inc. CORPORATION DELAWARE 1105 North Market Street Wilmington DELAWARE 19899
<b>Attorney of Record</b>	Lawrence E. Abelman
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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### Typed Drawing

**Word Mark** EVERY OTHER WEEK MAKES MIRACLES

**Goods and Services** IC 001. US 001 005 006 010 026 046. G & S: FERTILIZER FOR DOMESTIC USES. FIRST USE: 19990800. FIRST USE IN COMMERCE: 19990800

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 76068805

**Filing Date** June 12, 2000

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** April 2, 2002

**Registration Number** 2584488

**Registration Date** June 25, 2002

**Owner** (REGISTRANT) OMS Investments, Inc. CORPORATION DELAWARE 1105 North Market Street Wilmington DELAWARE 19899

**Attorney of Record** Lawrence E. Abelman

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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<b>Word Mark</b>	MIRACLE EARTH
<b>Goods and Services</b>	IC 001. US 001 005 006 010 026 046. G & S: GROWING MEDIA FOR PLANTS AND SOIL CONDITIONERS FOR DOMESTIC USE. FIRST USE: 19991220. FIRST USE IN COMMERCE: 19991220
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75980842
<b>Filing Date</b>	May 10, 1999
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	October 10, 2000
<b>Registration Number</b>	2513436
<b>Registration Date</b>	November 27, 2001
<b>Owner</b>	(REGISTRANT) OMS Investments, Inc. CORPORATION DELAWARE 1105 North Market Street Wilmington DELAWARE 19899
<b>Attorney of Record</b>	Melville Owen
<b>Prior Registrations</b>	1978641





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### Typed Drawing

**Word Mark** MIRACLE EARTH  
**Goods and Services** IC 001. US 001 005 006 010 026 046. G & S: compost. FIRST USE: 19950130. FIRST USE IN COMMERCE: 19950130  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 74371380  
**Filing Date** March 22, 1993  
**Current Filing Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** August 31, 1993  
**Registration Number** 1978641  
**Registration Date** June 4, 1996  
**Owner** (REGISTRANT) Old Fort Financial Corp. CORPORATION DELAWARE  
 14111 Scottslawn Road Marysville OHIO 43041  
  
 (LAST LISTED OWNER) OMS INVESTMENTS, INC. CORPORATION BY  
 ASSIGNMENT DELAWARE 1105 NORTH MARKET STREET  
 WILMINGTON DELAWARE 19899

**Assignment Recorded** ASSIGNMENT RECORDED  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR).  
**Live/Dead Indicator** LIVE

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### Typed Drawing

<b>Word Mark</b>	FOR MIRACLE GARDEN RESULTS
<b>Goods and Services</b>	IC 001. US 001 005 006 010 026 046. G & S: Fertilizers for domestic use. FIRST USE: 19890831. FIRST USE IN COMMERCE: 19890831
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	75532221
<b>Filing Date</b>	August 6, 1998
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	October 26, 1999
<b>Registration Number</b>	2418043
<b>Registration Date</b>	January 2, 2001
<b>Owner</b>	(REGISTRANT) OMS INVESTMENTS, INC. CORPORATION DELAWARE 1105 NORTH MARKET STREET C/O DELAWARE CORPORATE MANAGEMENT WILMINGTON DELAWARE 19899
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	LAWRENCE E. ABELMAN
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL

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Indicator**      LIVE

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