

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GMM/LTS

May 6, 2019

Opposition No. 91246167

Horizon AG-Products, L.P.

v.

Verdesian Life Sciences U.S., LLC

Geoffrey M. McNutt, Interlocutory Attorney:

On April 15, 2019, Opposer filed a motion to dismiss Applicant's counterclaim to cancel Opposer's pleaded Registration No. 4795520. On April 29, 2019, Applicant filed a motion to suspend proceedings pending the final determination of a civil action between the parties in federal court. Responses to both motions remain due. Nevertheless, the Board, in its discretion, has elected to first consider whether suspension is warranted without awaiting a response from Opposer. *See* Trademark Rule 2.127(a); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 510.01 (2018) (Board is empowered to stay proceedings upon its own initiative).

1. Background

On January 31, 2019, Opposer filed a notice of opposition against Applicant's application Serial No. 87778016 for the mark NUE for

Fertilizers; chemicals for use in agriculture for crop protection, except fungicides, herbicides, insecticides and parasiticides; plant growth nutrients for crops, in International Class 1; and

Fungicides, herbicides, insecticides and parasiticides, in International Class 5.¹

1 TTABVUE.

As grounds for opposition, Opposer alleges likelihood of confusion under Trademark Section 2(d), 15 U.S.C. § 1052(d), based on its prior registration and use of the standard character mark NUE-PLEX (Registration No. 4795520) for “Soil applied fertilizer for agricultural use, and excluding chemicals for use in industry and science,” in International Class 1.² *Id.* at ¶¶ 3–4.

On March 13, 2018, Applicant filed an answer and counterclaims, denying the salient allegations of the notice of opposition and seeking to cancel Opposer’s pleaded registration on the grounds of descriptiveness and abandonment. 4 TTABVUE. On April 15, 2019, Opposer filed a motion to dismiss Applicant’s counterclaims under Fed. R. Civ. P. 12(b)(6). 6 TTABVUE.

On April 29, 2019, Applicant filed a motion to suspend this proceeding pending final disposition of a civil action between the parties pending in the United States District Court for the Northern District of Texas, Dallas Division, captioned *Horizon*

¹ Filed on January 31, 2018, based Applicant’s allegation of intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

² Issued on August 18, 2015, based on Opposer’s declared use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and claiming February 25, 2015, as both the date of first use of the mark and in commerce.

AG-Products, LP v. Verdesian Life Sciences, U.S., LLC, C.A. No. 3:19-cv-00722-S (“Civil Action”). 7 TTABVUE 5-17.

2. Applicant’s Motion to Suspend

“Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.” Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). “[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.” *New Orleans Louisiana Saints LLC v. Who Dat?*, 99 USPQ2d 1550, 1552 (TTAB 2011). Suspension of a Board proceeding pending the outcome of another proceeding is solely within the discretion of the Board. *See* TBMP § 510.02; *see also Other Tel. Co. v. Conn. Nat’l Tel. Co.*, 181 USPQ 125, 126-27 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm’r 1974).

In the Civil Action, Opposer pleads, among other things, ownership of Registration No. 4795520 and common law rights in the mark NUE-PLEX for fertilizer for agricultural use and that Applicant’s use of the marks NUE and NUE CHARGE in connection with its fertilizer-related products infringes Opposer’s rights in its NUE-PLEX mark. 7 TTABVUE 13–15. Opposer’s prayer for relief in the Civil Action includes a request that Applicant be enjoined from using the mark NUE CHARGE or “any mark containing the term ‘NUE’ similar to [Opposer’s] ‘NUE-plex’ mark in connection with the promotion or sale of goods or services.” *Id.* at 15.

The Civil Action involves the same parties and marks at issue in the opposition proceeding, and the same issues, namely, which party has priority and whether there is a likelihood of confusion between the parties' marks. In addition, if the District Court enjoins Applicant from using the NUE mark as Opposer has requested, this may have a bearing on Applicant's ability to establish standing to challenge Opposer's pleaded registration, i.e., that it has a direct and personal stake in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999). Accordingly, proceeding here prior to termination of the Civil Action would be inefficient and pose a risk of inconsistent judgments.

In view of the foregoing, Applicant's motion to suspend is **granted**, and proceedings are **suspended** pending final disposition of the Civil Action. Within **twenty days** after the final determination of the Civil Action,³ the parties shall notify the Board so that this case may be called up for appropriate action.⁴

3. Opposer's Motion to Dismiss

In view of the suspension order herein, and in view of the fact that Opposer's motion to dismiss Applicant's counterclaim is not potentially dispositive of the entire opposition proceeding, Opposer's motion to dismiss is **denied without prejudice**. If the Civil Action does not resolve this proceeding or render moot Opposer's motion to dismiss, then upon resumption of proceedings Opposer may re-file the motion.

³ A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. *See* TBMP § 510.02(b).

⁴ During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys.