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

Proceeding	91249683
Party	Plaintiff Koch Agronomic Services, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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KOCH AGRONOMIC SERVICES, LLC,	)	
	)	
Opposer,	)	Opposition No. 91248050
	)	Application No. 87/778,016
v.	)	
	)	Opposition No. 91249683
VERDESIAN LIFE SCIENCES U.S., LLC	)	Application Nos. 88/030304; 88/057306
	)	
Applicant.	)	
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**JOINT MOTION TO CONSOLIDATE OPPOSITION NOS. 91248050 AND 91249683  
AND TO SUSPEND PENDING RELATED DISTRICT COURT ACTION**

Opposer Koch Agronomic Services, LLC (“Opposer”) and Respondent Verdesian Life Sciences U.S., LLC (“Applicant”), jointly move the Board:

- pursuant to TBMP § 511 and Federal Rule of Civil Procedure 42(a) to consolidate Opposition Nos. 91248050 and 91249683 (together, the “Proceedings”) against Applicant;
- pursuant to 37 C.F.R. § 2.117(a) and T.B.M.P. § 510.02(a) to suspend the Proceedings pending the disposition of the civil action styled *Horizon AG-Products, LP v. Verdesian Life Sciences, U.S., LC*, Case No. 3:19-cv-00722-S, currently pending in the United States District Court for the Northern District of Texas, Dallas Division (the “Civil Action”); and
- that Applicant’s Time to Answer be extended a further 30 days to allow the Board time to consider the other motions being filed herewith.

**I. JOINT MOTION TO CONSOLIDATE**

On February 1, 2019, Opposer filed a notice of opposition, Opposition No. 91248050, to Applicant's application, Ser. No. 87/778,016, to register the mark NUE (the "NUE Mark") for "fertilizers; chemicals for use in agriculture for crop protection, except fungicides, herbicides, insecticides and parasiticides; plant growth nutrients for crops," in Class 1 and "fungicides, herbicides, insecticides and parasiticides," in Class 5. As its basis for opposition, Opposer claims that the NUE Mark is descriptive and/or generic of the goods offered under the mark.

On July 17, 2019, Opposer filed a consolidated notice of opposition, Opposition No. 91249683 to Applicant's applications, Ser. Nos. 88/057,306 and 88/030,304, to register the marks NUE UNIVERSITY and NUE CHARGE, respectively. The application for the NUE UNIVERSITY mark covers "fertilizers; plant growth nutrients for crops; chemicals for use in agriculture for crop protection, except fungicides, herbicides, insecticides and parasiticides," in Class 1 and "fungicides, herbicides, insecticides, and parasiticides," in Class 5. The application for the NUE CHARGE mark covers "fertilizers," in Class 1. In Opposition No. 91249683, Opposer claims that the "NUE" portion of the NUE UNIVERSITY and NUE CHARGE marks is descriptive and/or generic of the goods offered under the mark and accordingly the term "NUE" must be disclaimed.

The Board has the discretion to consolidate proceedings where: (1) the proceedings involve common questions of law or fact, and (2) the savings in time, effort, and expense outweigh any prejudice or inconvenience caused by consolidation. Fed. R. Civ. P. 42(a); TBMP § 511; *M.C.I. Foods Inc. v. Bunte*, 86 U.S.P.Q.2d 1044, 1046 (T.T.A.B. 2008); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 U.S.P.Q.2d 1889, 1893 (TTAB 2010). Here, the parties agree that consolidation of these Proceedings is appropriate because they involve the common question of whether the term "NUE" is descriptive and/or generic of Applicant's fertilizers and similar goods

in Classes 1 and 5. Because the Proceedings involve common questions of law or fact, consolidation of the Proceedings will save the Board and the parties time, effort, and expense, and the parties agree that consolidation will result in no prejudice or inconvenience to either party.

The parties therefore request that the Board grant their joint motion to consolidate Opposition Nos. 91248050 and 91249683.

## **II. JOINT MOTION TO SUSPEND**

The parties further agree that once consolidated, the Proceedings should be stayed pending the Civil Action. In the Civil Action, a third party, Horizon AG-Products, LP (“Horizon”), has asserted a claim for trademark infringement of Horizon’s NUE-PLEX mark based on Applicant’s use of the NUE mark. Horizon has also filed an opposition to Applicant’s application to register the NUE mark, Opposition No. 91246167, claiming that Applicant’s NUE mark causes a likelihood of confusion with Horizon’s NUE-PLEX mark (the “Horizon Opposition”). Attached as Exhibit 1 is a copy of the complaint in the Civil Action. Applicant moved to suspend the Horizon Opposition, and the Board granted the motion. *See id.* at TTABVUE 8 (a copy of such order is also attached as Exhibit 2).

“It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case.” *Black Box Corp. v. Better Box Comm’ns Ltd.*, Opp. No. 91107800, 2002 WL 484956, at \*2 (T.T.A.B. Mar. 29, 2002). The Civil Action involves Applicant’s right to use and register the NUE mark and a counterclaim on whether “NUE” is merely descriptive of fertilizers and other similar goods in Classes 1 and 5. Here, Opposer has asserted that “NUE” is descriptive and/or generic of fertilizers and other similar goods in Classes 1 and 5 and that therefore (1) NUE standing alone is

not registrable as a mark and (2) the term “NUE” must be disclaimed in Applicant’s NUE UNIVERSITY and NUE CHARGE marks. If in the Civil Action the court determines that Applicant lacks protectable rights in the mark NUE, and/or if the court determines that the term “NUE” is in fact descriptive of Applicant’s goods, such holdings will impact the Proceedings.

Because the Civil Action may have a bearing on the Proceedings, the parties respectfully request that the Board suspend the Proceedings, once consolidated, pending the outcome of the Civil Action.

### **III. CONSENT MOTION TO EXTEND TIME TO ANSWER**

On July 16, 2019, the parties filed a Joint Consent Motion to Extend, which was granted by the Board on the same day. TTABVUE 6, 7. Applicant’s Time to Answer in Opposition No. 91248050 expires on August 16, 2019. TTABVUE 7. To the extent required, the parties request that Applicant’s Time to Answer be extended a further 30 days to allow the Board time to consider the other motions being filed herewith.

Dated: August 16, 2019

Respectfully submitted,

/Alicia Grahn Jones/

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_____	)	

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing document has been served on the correspondent of record for Respondent by forwarding said copy on August 16, 2019, via email to JSneed@SneedLegal.com and Sarah@SneedLegal.com.

/Kris Teilhaber/  
Kris Teilhaber