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

Proceeding	91251302
Party	Defendant Verdesian Life Sciences U.S., LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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_____)	
Horizon AG-Products, L.P.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91251302
)	
Verdesian Life Sciences U.S., LLC,)	
)	
Applicant.)	
_____)	

MOTION TO SUSPEND

Respondent, Verdesian Life Sciences U.S., LLC (“Verdesian” or “Applicant”), respectfully moves to suspend this Opposition proceeding in view of *Horizon AG-Products, LP v. Verdesian Life Sciences, U.S., LLC*, No. 3:19-cv-0722-S (N.D. Tex., Dallas Div.), which was filed on March 22, 2019 (the “District Court Case”). The District Court Case involves the same parties as this Opposition proceeding, and Opposer’s claims for trademark infringement are based on the term “NUE,” which forms a part of Applicant’s NUE UNIVERSITY mark. A copy of the Complaint is attached hereto as Exhibit A.

Factual Background

On January 31, 2019, Opposer Horizon AG-Products, L.P. filed a Notice of Opposition against Applicant’s NUE application (Serial No. 87/778,016) [Opposition No. 91246167, TTABVUE 1] (the “NUE Opposition”). On March 13, 2019, Applicant/Defendant filed an Answer and Counterclaim in the NUE Opposition (Opposition No. 91246167, TTABVUE 4). On March 22, 2019, Opposer filed suit in the US District Court for the Northern District of Texas (Dallas Division) claiming, *inter alia*, federal trademark infringement and unfair competition based on an alleged likelihood of confusion with Opposer’s Reg. No. 4,795,520 (NUE-plex),

which is also asserted in this Opposition proceeding. *See* Exhibit A. On April 29, 2019 Applicant filed a Motion to Suspend pending resolution of the Federal District Court Litigation, which was granted by the TTAB on May 6, 2019.

On August 20, the TTAB granted a Motion to Consolidate and Suspend other opposition proceedings against Applicant's NUE CHARGE and NUE UNIVERSITY marks brought by Koch Agronomic Services LLC, pending resolution of the District Court Case. *See* Opposition No. 91248050, TTABVUE 9.

Opposer subsequently filed the Notice of Opposition in this Opposition proceeding on October 1, 2019, along with a Notice of Opposition against Applicant's NUE CHARGE mark (Opposition No. 91251300). Applicant does not believe that Opposer notified the TTAB of the related District Court Case when filing its Notice of Opposition.

Applicable Law and Argument

“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.” *Ara Ohanian v. Tekno Products, Inc.*, 2019 WL 367659, at *1 (T.T.A.B. Jan. 25, 2019); *see also* 37 C.F.R. § 2.117(a); *New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011) (civil action need not be dispositive of Board proceeding, but only needs to have bearing on issues before Board).

Here, the District Court Case involves the same parties, and Opposer's infringement claim is predicated on NUE element, which forms a part of the NUE UNIVERSITY mark that is at issue in this Opposition proceeding. Thus, the outcome of the District Court Case will necessarily have a bearing on this Opposition proceeding. Applicant respectfully requests that

the Opposition proceeding be suspended pending resolution of Civil Action No. 3:19-cv-00722-S
(N.D. Tex.).

Dated: October 9, 2019

Respectfully submitted,

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Certificate of Filing and Service

The undersigned counsel of record certifies that a copy of the foregoing **MOTION TO SUSPEND** has been filed through the Electronic System for Trademark and Trial Appeals, and served upon Applicant via email, on October 9, 2019, to the following counsel of record:

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