

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500
General Email: TTABInfo@uspto.gov

WDJ

August 17, 2023

Opposition No. 91282774 (Parent)
Opposition No. 91285766

OMS Investments, Inc.

v.

SBM Life Science Corp.

William D. Jackson, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Opposer's motion, filed May 11, 2023, to suspend this proceeding pending final determination of Civil Action No. 2:23-cv-01541-EAS-EPD filed in the United States District Court for the Southern District of Ohio, or in the alternative, for an extension of time to respond to Applicant's motion to dismiss.¹ The motion is fully briefed.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or

¹ 12 TTABVUE. In this order, the Board cites to the proceeding record by the TTABVUE docket entry number and TTABVUE page number, in accordance with the guidance provided in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 702.05 and 801.01 (2023). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. The Board expects that the parties will use this method of citing to the record throughout this proceeding.

arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Sua Sponte Consolidation of Proceedings

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See Fed. R. Civ. P. 42(a); Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991).

The parties to Opposition Nos. 91282774 and 91285766 are identical, and the issues are similar or related. Accordingly, the Board sua sponte consolidates the proceedings. Opposition Nos. 91282774 and 91285766 are hereby consolidated and may be presented on the same record and briefs. *See Hilson Research Inc.*, 27 USPQ2d at 1424 n.1; *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in Opposition No. **91282774** as the “parent case.” From this point on, only a single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption all consolidated proceeding numbers, listing and identifying the parent case first. However, inasmuch as these proceedings are being consolidated prior to joinder of the issues in each proceeding, Applicant should file a separate answer in each opposition before commencing the practice of filing a single copy of all submissions in the parent case.² Each answer must be filed through ESTTA, the Board’s Electronic System for Trademark Trials and Appeals. *See* Trademark Rule 2.106(b)(1), 37 C.F.R. § 2.106(b)(1).

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

II. Motions to Dismiss

Applicant has filed motions to dismiss in each proceeding.³ We exercise our discretion to consider the legal sufficiency of Applicant’s motions to dismiss prior to full briefing of the motions.

² The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

³ 8 TTABVUE in the ‘774 opposition, filed March 22, 2023; 6 TTABVUE in the ‘776 opposition, filed August 7, 2023.

With regard to the ‘774 opposition, Applicant is the owner of application Serial No. 90218728 for the design mark BIOADVANCED SCIENCE-BASED SOLUTIONS (with “SCIENCE-BASED SOLUTIONS” disclaimed) as depicted below for use in connection with “fertilizers; plant stimulants, namely, growth stimulants for plant; soil for growing; plant growth regulating preparations” in International Class 1; “chemical herbicides, fungicides and insecticides” in International Class 5; “mulch” in International Class 31; and “lawn and garden care services; landscape design and garden design services; lawn and garden care services, namely, digital diagnostic services to identify plant, turfgrass, and soil problems and prescribe solutions” in International Class 44:⁴




With regard to the ‘766 opposition, Applicant is the owner of application Serial No. 97056366 for the design mark BIOADVANCED SCIENCE-BASED SOLUTIONS ORGANICS BRAND (with “SCIENCE-BASED SOLUTIONS ORGANICS BRAND” disclaimed) as depicted below for use in connection with “organic fertilizers; organic plant stimulants, namely, organic biostimulants being plant growth stimulants;

⁴ Filed September 28, 2020 under a Section 1(b) intent-to-use basis. The application includes the following description: “The mark consists of the stylized word "BIOADVANCED" in white with the words "SCIENCE-BASED SOLUTIONS" in white centered below. These words are contained within a red pentagon. The white rectangular background is not claimed as a feature of the mark.” The colors white and red are claimed as features of the mark.






organic soil for growing; organic plant growth regulating preparations” in International Class 1; “organic chemical herbicides, fungicides and insecticides” in International Class 5; “organic mulch” in International Class 31; and “lawn and garden care services; landscape design and garden design services; lawn and garden care consulting services, namely, providing diagnostic services to identify plant, turfgrass, and soil problems and prescribe solutions using digital technology” in International Class 44:⁵



Opposer has pleaded ownership of the following registrations in both oppositions:

Reg. No.	Mark	Goods/Services
2991191		insecticides, pesticides, fungicides, herbicides, miticides; biological insect spray concentrate for outdoor home and garden use; preparations for destroying vermin, insect repellents, flea killer, fire ant bait, fire ant granules, termite, carpenter ant and fire ant killer for domestic use; pesticide, namely, slug and snail bait for domestic use, in Class 5

⁵ Filed October 1, 2021 under a Section 1(b) intent-to-use basis. The application includes the following description: “The mark consists of the stylized word BIOADVANCED with the words SCIENCE-BASED SOLUTIONS centered below. These words are contained within a shaded pentagon shape. Below that pentagon are the stylized words ORGANICS BRAND with the word "BRAND" being centered below the words ORGANICS.” Color is not claimed as a feature of the mark.

2991195		<p>insecticides, pesticides, fungicides, herbicides, miticides; biological insect spray concentrate for outdoor home and garden use; preparations for destroying vermin, insect repellents, flea killer, fire ant bait, fire ant granules, termite, carpenter ant and fire ant killer for domestic use; pesticide, namely, slug and snail bait for domestic use, in Class 5</p>
4356627		<p>Pesticides, insecticides, herbicides, fungicides, parasiticides, rodenticides, insect bait in the nature of insecticides for pest control purposes, in Class 5</p>
4271554		<p>Rodent traps in Class 21</p>
4564703		<p>Hand-operated sprayers for applying pesticides, insecticides, herbicides and fungicides, in Class 8</p>
4564704		<p>Garden hose-end sprayers for applying [fertilizers, plant foods,] pesticides, insecticides, herbicides and fungicides, in Class 21</p>

3582553		pesticides, insecticides, fungicides, herbicides, miticides, and parasiticides for domestic use; insect repellents, in Class 5
---------	---	--

Opposer has opposed registration of Applicant’s marks, claiming likelihood of confusion under Trademark Act Section 2(d) and dilution by blurring and dilution by tarnishment under Trademark Act Sections 2 and 43(c).

On March 22, 2023, Applicant filed a motion to dismiss the opposition pursuant to Fed. R. Civ. P. 12(b)(6) in the ‘744 opposition, and on August 7, 2023 filed a similar motion to dismiss in the ‘766 opposition. In each motion, Applicant asserts that it is also the owner of Registration No. 6981944 for the mark BIOADVANCED as depicted below for use in connection with “fertilizers; plant stimulants, namely, growth stimulants for plant; soil for growing; plant growth regulating preparations” and “chemical herbicides, fungicides and insecticides”:⁶



⁶ Registered February 14, 2023. Application filed September 28, 2020 under a Section 1(b) intent-to-use basis. The registration includes the following description: “The mark consists of the stylized word "BIOADVANCED" contained within a pentagon shape.” Color is not claimed as a feature of the mark.

Applicant asserts that Opposer's notices of opposition should be dismissed because they purport to challenge its applications for a red design and a design that merely includes additional text (ORGANICS BRANDS) that each claim alleges rights narrower than the USPTO has already granted Applicant in its registered design mark that does not claim any color as a feature of the mark.⁷

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) is a test solely of the legal sufficiency of the complaint. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014). To survive a motion to dismiss, a plaintiff need only allege sufficient facts that, if proved, would establish that: (1) the plaintiff has an entitlement to a statutory cause of action; and (2) a valid ground exists for challenging the mark. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, to state a claim plausible on its face, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." *Ashcroft*, 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 555).

⁷ Applicant also asserts prior rights based upon Application Serial No. 90980053 for the design mark BIOADVANCED SCIENCE-BASED SOLUTIONS. An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value. *See Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *1 n.5 (TTAB 2019) (unpleaded application, made of record by notice of reliance, like third-party applications, are of limited probative value); TBMP § 704.03(b)(2).

For purposes of determining the motion, all of the plaintiff's well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to the plaintiff. *See Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1404-1405 (TTAB 2010).

Further, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon a motion to dismiss, but rather at final hearing or upon consideration of a motion for summary judgment, after the parties have had an opportunity to submit evidence. *See, e.g., Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1030 (TTAB 2015) ("Whether Opposer is able to prove its allegations . . . is not a matter for determination on a motion to dismiss."); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of the case..."). Accordingly, in deciding Applicant's motion, the Board has not considered arguments that go to the merits of the case or whether Opposer ultimately will be able to prove its allegations. *See Covidien*, 109 USPQ2d at 1697 n.3.

If, on a motion to dismiss for failure to state a claim upon which relief can be granted, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under Fed. R. Civ. P. 56. *See Fed. R. Civ. P. 12(b); Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1044; *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 646-47 (Fed. Cir. 1983); *Libertyville Saddle Shop Inc.*, 22 USPQ2d at 1597.

Also, a party may not obtain summary judgment on an issue that has not been pleaded. Fed. R. Civ. P. 56(a); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (no consideration given to unpleaded *Morehouse* defense on summary judgment); *James River Petroleum Inc. v. Petro Shopping Centers L.P.*, 50 USPQ2d 1702, 1703 (TTAB 1999) (same); see TEMP Section 528.07, citing Fed.R.Civ.P.56(a) and 56(b).

The prior registration, or *Morehouse*, defense is an equitable defense in the nature of laches or acquiescence. *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (citing *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969)). The proposition for which the *Morehouse* case stands is that, as a matter of law, an opposer cannot be damaged, within the meaning of Section 13 of the Trademark Act, by the issuance to an applicant of a second registration when applicant already has an existing, unchallenged registration of the same mark for the same goods. See *O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); TBMP § 311.02(b). The prior registration or *Morehouse* defense is an equitable defense, “to the effect that if the opposer can not be further injured because there already exists an injurious registration, the opposer can not object to an additional registration that does not add to the injury.” *O-M Bread*, 36 USPQ2d at 1045.

Here, Applicant’s motions to dismiss do not contest the sufficiency of Opposer’s allegations concerning its pleaded claims of likelihood of confusion or dilution. Instead, Applicant’s motions rely upon matter outside of the pleadings, in particular

its '944 registration as a basis for its purported *Morehouse* defense. In view thereof, Applicant's motions are construed as motions for summary judgment. Applicant has not pleaded a *Morehouse* defense, as it has yet to file its answer to either notice of opposition. Rather, Applicant raises the *Morehouse* defense for the first time in its motions to dismiss. As a result, Applicant may not rely upon its unpleaded *Morehouse* defense in its construed motions for summary judgment. *See Omega SA*, 118 USPQ2d at 1291 n.2; *James River Petroleum Inc.*, 50 USPQ2d at 1703.

Furthermore, summary judgment is inappropriate at this stage of the proceeding. A party may not file a motion for summary judgment until it has made its initial disclosures, unless the motion is based on issue or claim preclusion or lack of Board jurisdiction. 37 C.F.R. § 2.127(e)(1). *See Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 n.2 (TTAB 2013) (motion to dismiss amended counterclaim accompanied by evidence was not treated as a motion for summary judgment as there was nothing in the record which indicated that initial disclosures were served by opposer); TBMP § 503.04. In this case, Applicant has yet to file its answer in either proceeding, and there is no indication that it has served its initial disclosures.

Applicant's construed motions for summary judgment are premature because they are based upon an unpleaded affirmative defense. As a result, they are procedurally improper and will not be considered by the Board at this stage. In light of the foregoing, Applicant's construed motions for summary judgment filed in each action are **denied without prejudice**. Should Applicant wish to pursue a *Morehouse* defense at trial, it should properly plead this defense in its answers.

III. Motion to Suspend for Civil Action

On May 5, 2023, Opposer filed its civil action. In its complaint Opposer asserts claims against Applicant relating to its use and registration of the applied-for BIOADVANCED and Red Design mark and its use and registration of the BIOADVANCED and Design mark that is the subject of Registration No. 6981944. The complaint asserts, inter alia, claims of trademark infringement in violation of 15 U.S.C. § 1114, unfair competition in violation of 15 U.S.C. § 1125(a), and trademark dilution in violation of 15 U.S.C. § 1125(c), and seeks cancellation of the registration for Applicant's Registered Mark pursuant to 15 U.S.C. § 1119.⁸

Opposer argues that the present opposition should be suspended pending final resolution of the civil action because it will necessarily have a bearing on this proceeding, as it will address Applicant's alleged right to register the opposed mark and Applicant's continued registration of its registered mark, which Applicant asserts as the basis for its motions to dismiss addressed supra. In addition, Opposer argues that the civil action involves other matters outside of the Board's jurisdiction beyond Applicant's right to register the opposed mark, including Applicant's use of the opposed mark, Applicant's registered mark, and an infringing trade dress. As such, judicial economy will be served by a suspension of this proceeding.

Applicant counters that Opposer's motion to suspend is designed to forestall the Board's consideration of the motion to dismiss and to permit Opposer to escape a potentially unfavorable result, while at the same time securing for Opposer an unfair,

⁸ A copy of the complaint appears at 12 TTABVUE 6.

open-ended freeze on the application at issue. Applicant also argues that judicial economy would not be served by suspending this proceeding at this juncture, and that allowing Opposer's motion to suspend would unfairly reward forum shopping and encourage misuse of the opposition proceedings before the Board.

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. See Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *See also New Orleans La. Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) (civil action need not be dispositive of Board proceeding, but only needs to have bearing on issues before Board).

If, however, there is a potentially dispositive motion pending before the Board at the time the issue of suspension is raised, the potentially dispositive motion may be decided before the question of suspension is considered. Trademark Rule 2.117(b), 37 C.F.R. 2.117(b); see also TBMP § 510.02(a). Suspension of a proceeding pending a civil action is a discretionary determination.

After careful consideration, the Board finds that suspension is warranted. The civil action has a bearing on the present action, as it challenges Applicant's use and registration of both its applied-for mark in the '728 application and its registered mark asserted in both of its construed motions for summary judgement. Also, we have already disposed of Applicant's construed motions for summary judgment, so they are no longer a factor in our analysis. Applicant's assertion that Opposer's motion is a "procedural gambit" to avoid an unfavorable decision is unavailing.

In light of the foregoing, Opposer's motion to suspend pending resolution of the civil action is **granted**. Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.⁹ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties must notify the Board of any address or email address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

⁹ 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).