

ESTTA Tracking number: **ESTTA717691**

Filing date: **12/30/2015**

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

Proceeding	91221493
Party	Plaintiff Shaklee Corporation
Correspondence Address	KEVIN M HAYES KLARQUIST SPARKMAN LLP 121 SW SALMON STREET, SUITE 1600 PORTLAND, OR 97204 UNITED STATES ptotmdocket@klarquist.com, kevin.hayes@klarquist.com
Submission	Answer to Counterclaim
Filer's Name	Kevin M. Hayes
Filer's e-mail	ptotmdocket@klarquist.com, kevin.hayes@klarquist.com
Signature	/Kevin M. Hayes/
Date	12/30/2015
Attachments	ANSWER TO COUNTERCLAIM.pdf(359892 bytes)

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

Shaklee Corporation,)	
)	
Opposer/Counterclaim)	OPPOSER’S ANSWER TO
Respondent,)	APPLICANT’S COUNTERCLAIM
)	
v.)	Opposition No. 91221493
)	(Application Ser. No. 86/128507)
)	
Mannatech, Incorporated,)	
)	
Applicant/Counterclaim)	
<u>Petitioner.</u>)	

OPPOSER’S ANSWER TO APPLICANT’S COUNTERCLAIM

Opposer/Counterclaim Respondent, Shaklee Corporation (“Shaklee”) answers the Counterclaim of Applicant/Counterclaim Petitioner, Mannatech, Incorporated (“Mannatech”) as follows:

1. Admitted.
2. Admitted.
3. Shaklee admits that Exhibit A attached to the Counterclaim is the same as a specimen of use for YOUTH filed by Shaklee and that Shaklee filed a specimen of use along with a Combined Sections 8 & 15 Declaration on November 7, 2013 – that the United States Patent and Trademark Office accepted as proving use of the mark YOUTH.
4. Shaklee admits that Exhibit A attached to the counterclaim shows a page from Registrant’s website for ordering Shaklee’s products.
5. Shaklee admits that Exhibit A attached to the counterclaim advertises Shaklee’s product called ENFUSELLE Instant Firming Serum and it also shows use of YOUTH on the

goods identified in Registration No. 3,347,631 for YOUTH. Shaklee denies that Exhibit A attached to the Counterclaim sells Shaklee's product called ENFUSELLE Instant Firming Serum as a specimen does not sell a product.

6. Shaklee denies that ENFUSELLE is used to cause the alleged results.

ENFUSELLE is a mark for a product, not a product itself.

7. Shaklee denies that ENFUSELLE is a product. ENFUSELLE is a mark for a product.

8. Shaklee admits that Shaklee owns the website for which a page is http://www.shaklee.com/us/en/shop/healthybeauty/enfuselleskincare/product-_p_instant-firming-serump?g=specialtytreatments. Shaklee admits that it controls advertising on http://www.shaklee.com/us/en/shop/healthybeauty/enfuselleskincare/product-_p_instant-firming-serump?g=specialtytreatments. Shaklee is without sufficient information to admit or deny that it "sales of ENFUSELLE on the following website ..." as that allegation is not comprehensible. Shaklee denies that Exhibit B demonstrates alone that it "owns, controls advertising, and sales of ENFUSELLE" on http://www.shaklee.com/us/en/shop/healthybeauty/enfuselleskincare/product-_p_instant-firming-serump?g=specialtytreatments as Exhibit B appears to just be a screen capture from the website that does not necessarily demonstrate what is alleged.

9. Shaklee admits that the product shown in Exhibit B to the Counterclaim is offered for sale under the mark ENFUSELLE®, and notes that it would be incomplete to not also admit that the product shown in Exhibit B to the Counterclaim is offered for sale also under the mark YOUTH® as shown in Exhibit B.

10. Shaklee admits that Exhibit C appears to be packaging for Shaklee's ENFUSELLE® marked product.

11. Shaklee admits that Exhibit C appears to be packaging for Shaklee's ENFUSELLE® marked product, which is shown also in Exhibits A and B, and which is also marked YOUTH®.

12. Shaklee denies that it "does not use the term YOUTH as a trademark." Shaklee denies that ENFUSELLE is a product. ENFUSELLE is a mark for a product.

13. Shaklee denies that the word YOUTH was formerly owned by Reverta Health Solutions, LLC. A company does not own a word, it might own a word for goods or services, but not the word itself. Shaklee admits that the word YOUTH was used by Reverta Health Solutions, LLC. Shaklee lacks sufficient information to know if Reverta Health Solutions, LLC is currently a Pennsylvania limited liability company.

14. Shaklee denies that the word YOUTH was formerly owned by Reverta Health Solutions, LLC. A company does not own a word, it might own a word for goods or services, but not the word itself. Shaklee lacks sufficient information to know if Reverta Health Solutions, LLC is currently a Pennsylvania limited liability company.

15. Shaklee lacks sufficient information to know if Exhibit D attached to the Counterclaim is what the Counterclaim alleges it to be.

16. The allegation in Paragraph 16 is nonsensical as it states that "[the] specimen of use for EXHIBIT D..." Of course there is no such thing as a specimen of use for an Exhibit. Accordingly, Shaklee lacks sufficient information to respond to this allegation.

17. Denied. The United States Patent and Trademark Office has even confirmed that Shaklee uses YOUTH® as a trademark.

18. This allegation is that "the Registration" shows use of YOUTH on product packaging and that Shaklee does not so use YOUTH. A registration never shows use of a mark. Denied.

19. Denied.

20. Admitted.

21. Denied.

22. Denied.

23. Shaklee admits that it uses the term YOUTH. Shaklee denies the remainder of the allegation in paragraph 23 of the Counterclaim.

24. Shaklee admits that it does not use YOUTH on the packaging for products sold under the ENFUSELLE trademark as a trademark, but reminds that placing a mark on packaging is not the only way to use a trademark on goods and that United States Code §1127 states that use of a mark on goods includes the mark being “placed in any manner on ... displays associated [with the goods].”

25. Admitted.

26. Admitted.

27. Admitted.

28. Shaklee denies that the Statement of Use filed June 4, 2015 cited “Dates of First Use.” Shaklee otherwise admits this allegation.

29. Denied. An application does not submit a Specimen of Use.

30. Shaklee admits that Exhibit E to the Counterclaim pictures an ENFUSELLE marked skin care product. Shaklee admits that the ENFUSELLE marked skin care product shown in Exhibit E to the Counterclaim pictures an ENFUSELLE marked skin care product that might bears some similarities to the product marked with YOUTH and ENFUSELLE shown in Exhibit A.

31. Denied. Exhibit A and Exhibit E are attached to the Counterclaim. Exhibits to the Counterclaim were not submitted as samples of use of YOUTH for an “anti-age” product.

32. Shaklee is without sufficient information to admit or deny that Shaklee's Registration 4,777,591 and the Registered Mark for YOUTH are identical and are for the same goods. It is not clear whether "Registered Mark for YOUTH" refers to the mark registered in Shaklee's Registration 4,777,591 or the mark registered in Shaklee's Registration 3,347,631. Shaklee also denies that "the Application only claims a first use date of June 2, 2015." "[T]he Application" is understood to refer to Application 85/802,878.

33. Denied.

34. Denied.

35. Denied.

36. Denied.

37. It is not clear whether "Registered Mark" refers to the mark registered in Shaklee's Registration 4,777,591 or the mark registered in Shaklee's Registration 3,347,631. However, since the allegation refers to an assignment from Reverta Health Solutions LLC, Shaklee assumes that Mannatech means to refer to the mark registered in Shaklee's Registration 3,347,631. Shaklee denies that the assignment was signed July 1, 2009.

38. Shaklee denies that it "allowed" three similar applications to abandon for failure to file a Statement of Use in January 2013. Shaklee is without sufficient information to admit or deny that it submitted a specimen allegedly demonstrating use of the mark on the same goods in November 2013 as it is unclear what is meant by "the mark" or the "same goods."

39. Shaklee denies that Application 85/802,878 is identical to the Registered Mark. Shaklee denies that it claimed a first use date in Application 85/802,878. Shaklee admits that June 2, 2015, is over 5 years and 11 months from the Assignment of the mark of Registration 3,347,631 from Reverta Health Solutions, LLC to Shaklee Corporation.

40. Denied.

41. Shaklee admits that the specimen submitted to support filing the Sections 8 & 15 Affidavits is a point of sale document for Shaklee's ENFUSELLE marked product -- and also shows its use of YOUTH as a mark. Shaklee notes that the allegation regarding whether a *bona fide* use of the YOUTH Registration is shown is irrelevant. Use of a registration does not matter. What matters is use of a mark that is registered. Assuming that Counterclaimant meant to refer to a specimen showing use of a mark, and not of a registration, Shaklee denies that the specimen submitted to support filing the Sections 8 & 15 Affidavits does not show a *bona fide* use of the mark of the YOUTH Registration in connection with anti-aging cream and anti-wrinkle cream.

42. Denied.

To the extent not expressly admitted herein, the remainder of the allegations are denied.

Affirmative Defenses

1. Mannatech has been aware of Shaklee's mark YOUTH for skin care goods since at least as early as May 2013.

2. In that regard, Mannatech hired a former Shaklee distributor, Mr. Bo Short, in May 2013.

3. On information and belief, Mr. Short was familiar with Shaklee's mark YOUTH®.

4. Mannatech surely became aware of Shaklee's Registration 3,347,631 for the mark YOUTH® that it seeks to cancel on or about December 9, 2013.

5. In that regard, Shaklee sent a letter to Mannatech dated December 9, 2013, which noted and included a copy of U.S. Registration No. 3,347,631 for YOUTH® for an anti-aging cream and anti-wrinkle cream. On information and belief, Mannatech received that letter on or about December 9, 2013.

6. Mannatech responded to Shaklee's letter on December 19, 2013, arguing in part that Shaklee's product for which it uses YOUTH® "is not called 'YOUTH'."

7. Mannatech did not seek to cancel a Shaklee registration for YOUTH in 2013 or 2014.

8. Shaklee's Registration 3,347,631 for the mark YOUTH® was noted in a Letter of Protest Memorandum sent to the Examiner of Mannatech's Application No. 86/128,507 by the United States Patent and Trademark Office dated January 23, 2014.

9. On information and belief, Mannatech became aware of the Letter of Protest Memorandum by at least on or about March 14, 2014.

10. Mannatech's 10-K for the year ended December 31, 2012, that it submitted to the Securities and Exchange Commission, lists Shaklee as a competitor to Mannatech.

11. Shaklee's Registration 3,347,631 for the mark YOUTH® was also cited against registration of Mannatech's application to register UTH, No. 86128507, by the United States Patent and Trademark Office in an Office action dated March 14, 2014.

12. On information and belief, Mannatech received the Office action dated March 14, 2014, citing Shaklee's Registration 3,347,631 for the mark YOUTH® in Mannatech's application 86128507 on or about March 14, 2014.

13. In response to the Office action dated March 14, 2014, in Mannatech's application 86128507, Mannatech argued on September 4, 2014, that "[t]he product noted in the goods for the registration itself is not called 'YOUTH'."

14. Mannatech did not bring a proper claim for cancellation of Shaklee's Registration 3,347,631 and for the mark YOUTH® until November 18, 2015.

15. Mannatech bases its current cancellation ground of abandonment on the same argument that it made on December 19, 2013, *i.e.*, that Shaklee allegedly does not use YOUTH and allegedly has abandoned YOUTH.

16. Registrant has known of its alleged basis for this Cancellation since at least as early as December 19, 2013.

17. Registrant did not bring this Cancellation until November 18, 2015, despite knowing of its alleged basis for this Cancellation since at least as early as December 19, 2013.

18. Although Mannatech considers Shaklee a competitor, and knew of its alleged basis for this Cancellation since at least as early as December 19, 2013, Mannatech did not bring this Cancellation until 23 months later on November 18, 2015.

19. Mannatech did bring a Cancellation against Shaklee's Registration 3,347,631 in May 2015, but that Cancellation was dismissed by Order of the Board on October 26, 2015 (with leave to replead).

20. During the period that Mannatech was aware of Shaklee's use of the mark YOUTH®, but had not sought to cancel Shaklee's registration, Shaklee filed a Statement of Use in Application 85802878 on June 4, 2015, (which matured into Registration 4,777,591 on July 21, 2015). Thus, Shaklee took action regarding its YOUTH® mark and was prejudiced by Mannatech's inaction.

21. Accordingly, Mannatech's counterclaim for cancellation of Shaklee's Registration 3,347,631 is barred by laches and/or acquiescence to Shaklee's Registration 3,347,631.

WHEREFORE, Shaklee requests that the Cancellation be dismissed.

Dated: December 30, 2015.

Respectfully submitted,

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

KLARQUIST SPARKMAN, LLP

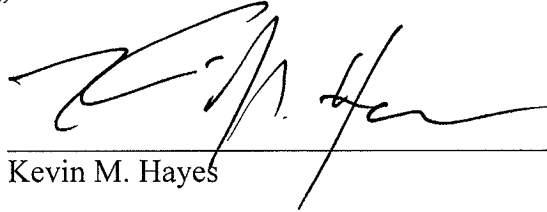
By


Kevin M. Hayes
Oregon State Bar No. 01280

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 30, 2015, a true copy of the foregoing **OPPOSER'S ANSWER TO APPLICANT'S COUNTERCLAIM** was served on Applicant by first class mail, postage prepaid, to:

Sanford E. Warren, Jr.
Warren Rhoades LLP
1212 Corporate Drive, Suite 250
Irving, Texas 75038



Kevin M. Hayes