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

Proceeding	91221493
Party	Defendant Mannatech, Incorporated
Correspondence Address	SANFORD E WARREN JR WARREN RHOADES LLP 1212 CORPORATE DR STE 250 IRVING, TX 75038 UNITED STATES Email: ipdocketing@wriplaw.com, swarren@wriplaw.com, srhoades@wriplaw.com, nlevenson@wriplaw.com
Submission	Reply in Support of Motion
Filer's Name	Sanford E. Warren, Jr.
Filer's email	ipdocketing@wriplaw.com, swarren@wriplaw.com, srhoades@wriplaw.com, nlevenson@wriplaw.com, Kevin.Hayes@klarquist.com
Signature	/Sanford E. Warren, Jr./
Date	08/21/2017
Attachments	Reply in Support of Cross-Motion for Abandonment.pdf(238758 bytes) Declaration of Nathan L. Levenson in Support of Reply.pdf(35666 bytes) Exhibit A final.pdf(517269 bytes) Exhibit B final.pdf(563477 bytes)

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

SHAKLEE CORPORATION	:	
	:	
Opposer/ Counter-respondent,	:	Opposition No. 91221493 (parent case)
	:	(Application Ser. No. 86/128,507)
v.	:	
	:	Opposition No. 91223820
MANNATECH, INCORPORATED	:	(Application Ser. No. 86/128,470)
	:	
Applicant/Counterclaimant.	:	Opposition No. 91223821
	:	(Application Ser. No. 86/128,560)

**APPLICANT’S REPLY BRIEF IN SUPPORT OF CROSS MOTION FOR SUMMARY
JUDGMENT ON ITS COUNTERCLAIM FOR ABANDONMENT**

Pursuant to Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 528 and Federal Rule of Civil Procedure 56, Applicant, Mannatech, Incorporated (hereinafter “Mannatech”), by and through its undersigned counsel, hereby files this Reply Memorandum in support of its Cross Motion for Summary Judgment on its Counterclaim for Abandonment [Record Entry 38] (hereinafter “Mannatech’s Cross Motion”).

I. INTRODUCTION

The undisputed facts establish that that Mannatech is entitled to summary judgement on its counterclaim for abandonment with respect to Shaklee Corporation’s (hereinafter “Opposer”) YOUTH mark under Registration No. 3,347,631 (“’631 YOUTH mark”). It is undisputed that Opposer did not use its ’631 YOUTH mark, on any, let alone all, of the goods identified in its ’631 Registration since its acquisition on July 1, 2009 through at least September 27, 2013—a period of non-use for 4 years, 2 months and 20 days. Opposer’s nonuse for over three (3) consecutive years demonstrates a *prima facie* case of abandonment.

Moreover, the record is simply devoid of any evidence showing a specific and consistent plan, let alone specific activities, to resume use of the ’631 YOUTH mark during the relevant

period of over four (4) years. Specifically, none of Opposer's documents produced pursuant to the Board's Order, give rise to the reasonable inference that between July 1, 2009 and September 27, 2013, Opposer had any intent to resume the use of its '631 YOUTH mark.

Having failed to produce any competent evidence of an intent to resume use during the period of abandonment, Opposer attempts to hide behind arguments of unfounded technicalities to avoid a finding of abandonment. Opposer's contentions, however, are nothing more than red herrings to attempt to obfuscate the issue of abandonment.

For the reasons set forth herein, Mannatech respectfully requests that the Board issue summary judgment in Mannatech's favor with respect to its counterclaim for abandonment with respect to Opposer's YOUTH mark under Registration No. 3,347,631.

II. SUMMARY OF ARGUMENTS

A. Mannatech's Cross Motion Complies with 37 C.F.R. § 2.127(a)

Opposer attempts to mislead this Board into believing that Mannatech's Cross Motion fails to comply with 37 C.F.R. § 2.127(a). Opposer's Response, however, fails to state that its argument revolves entirely and solely around counsel's signature block and certificate of service. 37 C.F.R. § 2.127(a) provides "Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, **including** table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary. Here, Mannatech's Cross Motion does **not** contain a table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument or summary that exceeds the twenty-five (25) page limit.

Inc. v. Kraft Inc., 812 F.2d 1531, 1 USPQ 2d 1161, 1177-78 (11th Cir. 1986); *Parfums Nautee Ltd.*

v. American International Industries, 22 USPQ2d 1310 (TTAB 1992). It is undisputed that the relevant period of non-use by Opposer of the '631 YOUTH mark is from July 1, 2009 until September 27, 2013. Mr. Hall's Declaration, however, references Opposer's activities with respect to the '631 YOUTH mark **beginning in 2015**, over one (1) year and three (3) months after the statutory period of non-use had ended.

There is simply no evidence in the record to demonstrate that Opposer took active steps towards resuming use of the '631 YOUTH mark within the crucial three-year period of non-use. See Part IV.C.3. At best, Opposer's activities in 2015 and 2016, with respect to the '631 YOUTH mark, represent a new and separate use of the '631 YOUTH mark by the Opposer and cannot serve to cure Opposer's abandonment. Accordingly, Opposer cannot rely upon its re-adopting of the '631 YOUTH mark in connection with its ENFUSELLE Instant Firming Serum product to cure its abandonment as a matter of law.

V. CONCLUSION

In light of the foregoing, Mannatech respectfully requests that Opposer's Motion for Summary Judgment be denied in its entirety. Additionally, Mannatech respectfully requests that the Board grant summary judgment in its favor with respect to Mannatech's Counterclaim for abandonment of the '631 YOUTH mark.

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Dated: June 29, 2017

Respectfully submitted,

/Sanford E. Warren, Jr./
Sanford E. Warren, Jr.
Texas State Bar No. 20888690
R. Scott Rhoades
Texas State Bar No. 90001757
Nathan L. Levenson
Texas State Bar No. 24097992
WARREN RHOADES LLP
1212 Corporate Drive, Suite 250
Irving, Texas 75038
Telephone: 972-550-2955
Facsimile: 469-422-0091
Email: ipdocketing@wriplaw.com
swarren@wriplaw.com
srhoades@wriplaw.com
nlevenson@wriplaw.com
ATTORNEYS FOR
APPLICANT/COUNTERCLAIMANT

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 29th day of June, 2017 service of **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT ON APPLICANT'S COUNTERCLAIM FOR ABANDONMENT AND APPLICANT'S CROSS MOTION FOR SUMMARY JUDGMENT ON ITS COUNTERCLAIM FOR ABANDONMENT** was made to the following attorney for Opposer *via* First Class Mail:

Kevin M. Hayes
Klarquist Sparkman, LLP
121 SW Salmon Street, Suite 1600
Portland, Oregon 97204

By: /Sanford E. Warren, Jr./
Sanford E. Warren, Jr.

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Put simply, Mannatech's Cross Motion does not exceed the page limit set forth by 37 C.F.R. § 2.127(a). This page limit rule is silent as to counsel's signature block and certificate of service, for obvious reasons.

Moreover, the only case cited by Opposer does not support its contention that Mannatech's Cross Motion should not be considered because counsel's signature block and certificate of service appear on page number twenty-six (26). See Opposer's Response at p. 3. In *Saint-Gobain Corp. v. 3M*, the Board refused to consider a twenty-six (26) page brief because it contained twenty-three (23) pages of argument and a table of contents consisting of three (3) pages. See *Saint-Gobain Corp. v. 3M*, 66 U.S.P.Q.2D (BNA) 1220 (T.T.A.B. Feb. 20, 2003). 37 C.F.R. § 2.127(a) explicitly includes the table of contents as well as the argument as parts of the brief that fall within the page limit. Quite to the contrary, as discussed above, that is not the issue here. Accordingly,

Mannatech's Cross Motion complies with 37 C.F.R. § 2.127(a).

B. Mannatech's Service Complies with 37 C.F.R. § 2.119

Opposer attempts to mislead the Board into believing that Mannatech failed to properly serve its Cross Motion by serving it via First Class Mail. 37 C.F.R. § 2.119(b) provides, in part, "Service of submissions filed with the Board . . . must be made by email, unless otherwise stipulated . . ." Opposer, however, intentionally fails to mention that Opposer's counsel explicitly stipulated against service by email on August 1, 2016. *See* Levenson Decl. ¶ 2, Exhibit A. On July 29, 2016, Mannatech's counsel emailed Opposer's counsel requesting to serve all documents via electronic mail. *Id.* In response, Opposer's counsel stated "We would prefer not to." *See* Levenson Decl. ¶ 3, Exhibit B. No further communications regarding this stipulation has occurred to date. Instead, Opposer waited until twenty-nine (29) days after Mannatech served its Cross Motion to raise its objection to Mannatech's method of service.¹ *See* Levenson Decl. ¶ 4. In light of Opposer's stipulation to forego email service and no further communication to the contrary, Mannatech has served all submissions filed with Board, to date, via First Class Mail. *See* Levenson Decl. ¶ 5.

To the extent Opposer suffered any prejudice, which is denied, any such prejudice was cured by Mannatech's consent to a six (6) day extension for Opposer's Response. *See* Record Entry 38, Consent Motion for Extension. Accordingly, Mannatech's service of its Cross Motion complies with 37 C.F.R. § 2.119(b) pursuant to the parties' stipulation set forth by Opposer's email dated August 1, 2016.

¹ Mannatech notes Opposer failed to object to Mannatech's method of service with respect to the Consent Motion to Extend served via First Class Mail on May 19, 2017. To the extent Opposer allegedly had an issue with Mannatech's method of service, Opposer should have raised its objection then rather than waiting until one (1) day before its Response was due.

C. Mannatech Is Entitled to Summary Judgment on its Counterclaim of Abandonment to Cancel Opposer's YOUTH Trademark under Registration No. 3,347,631

1. Opposer Improperly Contends that Mannatech Must Prove that Opposer Lacked an Intent to Resume Use.

Opposer's Response erroneously contends that Mannatech must prove that Opposer lacked an intent to resume use. *See* Opposer's Response, at p. 4 n.1. Quite to the contrary, Mannatech's *prima facie* case of abandonment eliminates Mannatech's burden of establishing the intent element of abandonment and creates a rebuttable presumption that Opposer abandoned its '631 YOUTH mark without any intent to commence or resume use. *See Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998).

It is undisputed that Opposer made no use of its '631 YOUTH mark since its acquisition on July 1, 2009 through at least September 27, 2013—a period of non-use for 4 years, 2 months and 20 days. *See* Mannatech's Opposition and Cross Motion at pp. 7-12, 15-16, 19-20; Opposer's Response at p. 4 (admitting non-use its '631 YOUTH mark for at least three consecutive years). Nonuse for three (3) consecutive years demonstrates a *prima facie* case of abandonment. *See* 15 U.S.C. § 1127. A *prima facie* case of abandonment eliminates the challenger's burden to establish the intent element of abandonment and creates a rebuttable presumption that the registrant abandoned the mark without any intent to commence or resume use under the statute. *See Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998). It is therefore Opposer's burden to produce evidence of an intent to resume use during the period of abandonment, July 1, 2009 through September 27, 2013.

2. Opposer Failed to Rebut Presumption of Abandonment

- a. *Opposer failed to demonstrate that it took active steps towards resuming use of the '631 YOUTH mark within the crucial three-year period of non-*

use.

It is undisputed that that Opposer's non-use of the '631 YOUTH mark for at least three consecutive years demonstrates a *prima facie* case of abandonment of the '631 YOUTH mark for all the goods listed in the Registration. A showing of a *prima facie* case creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use. In order to rebut the presumption of abandonment, Opposer must present evidence and build a record with respect to either specific activities undertaken during the period of non-use or what outside events occurred from which an intent to resume use during the non-use period may be reasonably inferred. *See Warren Publ'g Co. v. Spurlock*, 645 F. Supp. 2d 402, 436 (E.D. Pa. 2009).

Here, the record is simply devoid of any evidence showing a specific and consistent plan to resume use of the '631 YOUTH mark during the relevant period of over four (4) years. *See* Mannatech's Cross Motion at pp. 21-24. Specifically, it is undisputed that Opposer is not in possession, custody, or control of marketing plans, business plans, financial plans, development plans, budgetary plans or research plans that mention the '631 YOUTH mark or the specific "YOUTH" branded products. Instead, Opposer attempts to overcome the presumption of abandonment by relying on a single internal email, dated November 11, 2010, in which only the PowerPoint attachment² mentions the '631 YOUTH mark. *See* Opposer's Response at p. 5; Baldwin Decl. ¶ 7, Exhibit A. Opposer's reliance on this single internal email is insufficient to demonstrate an intent to resume use. Specifically, neither the internal email nor the attached PowerPoint document makes any mention of a plan to resume use of the '631 YOUTH mark during the relevant period of abandonment. *See* Opposer's Response, Declaration of Nancy Baldwin ¶ 7, Exhibit A.

² For a further discussion on Opposer's confidential PowerPoint documents, *see* Mannatech's Cross Motion at pp. 21-22.

At best, the internal discussion and the attached PowerPoint document amount to nothing more than vague references concerning the potential use of the '631 YOUTH mark at some unknown point in the future. Vague references concerning the potential use of a mark at some unspecified time in the future are insufficient, as a matter of law, to show an intent to resume use. *See Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998); *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531 (4th Cir. 2000). Accordingly, the cited internal email and the attached PowerPoint document do not give rise to a reasonable inference that, between July 1, 2009 and September 27, 2013, Opposer had any intent to resume the use of its '631 YOUTH mark.

b. Conclusory statements on the ultimate issue do not create a genuine issue of material fact.

Opposer's Response is also accompanied by the Declaration of Nancy Baldwin ("Ms. Baldwin") in which Opposer attempts to rely on Ms. Baldwin's Declaration to overcome the presumption of abandonment. Specifically, Ms. Baldwin avers that Opposer has intended to resume use of the '631 YOUTH mark since its acquisition in 2009. *See* Opposer's Response, Baldwin Decl. ¶ 5. However, to support a finding of intent to resume use of the mark, the owner must do more than simply assert a vague, unsubstantiated intent to make use of the mark at some unspecified time in the future. *See Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998). In order to show an intent to resume use "one must ... proffer more than conclusory testimony or affidavits." *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1581 (Fed. Cir. 1990).

In support of Ms. Baldwin's conclusory statement, Ms. Baldwin further asserts that Opposer has had internal discussions about the use of the '631 YOUTH mark for skincare products since at least 2009. *See* Opposer's Response, Baldwin Decl. ¶ 6. This statement, however, is uncorroborated. Specifically, Opposer failed to produce, let alone cite, any internal discussions that mention the '631 YOUTH mark prior to November 4, 2010. *See* Opposer's Response at pp.

1-8. Accordingly, Ms. Baldwin's conclusory statements are not only unsupported by any documentary or corroborating evidence but also are insufficient to preclude summary judgment on the issue of abandonment.

c. Subsequent re-adoption of the '631 YOUTH mark within Opposer's 2016 Product Guide cannot serve to cure abandonment as a matter of law

In further support to overcome the presumption of abandonment, Ms. Baldwin's Declaration states that Opposer used the '631 YOUTH mark within its 2016 Product Guide. *See* Opposer's Response, Baldwin Decl. ¶ 9. It is well established that abandonment of a registered mark cannot be reversed by subsequent re-adoption of the mark or subsequent intent to resume use. *See AmBRIT Inc. v. Kraft Inc.*, 812 F.2d 1531, 1 USPQ 2d 1161, 1177-78 (11th Cir. 1986); *Parfums Nautee Ltd. v. American International Industries*, 22 USPQ2d 1310 (TTAB 1992). It is undisputed that the relevant period of non-use by Opposer of the '631 YOUTH mark is from July 1, 2009 until September 27, 2013. Ms. Baldwin's Declaration, however, references Opposer's activities with respect to the '631 YOUTH mark **beginning in December of 2015**, over two (2) years and two (2) months after the statutory period of non-use had ended. At best, Opposer's activities in 2015 and 2016, with respect to the '631 YOUTH mark, represent a new and separate use of the '631 YOUTH mark by the Opposer and cannot serve to cure Opposer's abandonment. Accordingly, Opposer cannot rely upon its re-adopting of the '631 YOUTH mark within its 2016 Product Guide to cure its abandonment as a matter of law.

III. CONCLUSION

In light of the foregoing, Mannatech respectfully requests that the Board grant summary judgment in its favor with respect to Mannatech's Counterclaim for abandonment of the '631 YOUTH mark.

Dated: August 21, 2017

Respectfully submitted,

/Sanford E. Warren, Jr./
Sanford E. Warren, Jr.
Texas State Bar No. 20888690
R. Scott Rhoades
Texas State Bar No. 90001757
Nathan L. Levenson
Texas State Bar No. 24097992
WARREN RHOADES LLP
1212 Corporate Drive, Suite 250
Irving, Texas 75038
Telephone: 972-550-2955
Facsimile: 469-422-0091
Email: ipdocketing@wriplaw.com
swarren@wriplaw.com
srhoades@wriplaw.com
nlevenson@wriplaw.com

**ATTORNEYS FOR
APPLICANT/COUNTERCLAIMANT**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 21st day of August, 2017 service of **APPLICANT'S REPLY BRIEF IN SUPPORT OF CROSS MOTION FOR SUMMARY JUDGMENT ON ITS COUNTERCLAIM FOR ABANDONMENT** was made to the following attorney for Opposer *via* email and First Class Mail:

Kevin M. Hayes
Kevin.Hayes@klarquist.com
Klarquist Sparkman, LLP
121 SW Salmon Street, Suite 1600
Portland, Oregon 97204

By: /Sanford E. Warren, Jr./
Sanford E. Warren, Jr.

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

SHAKLEE CORPORATION	:	
	:	
Opposer/ Counter-respondent,	:	Opposition No. 91221493 (parent case)
	:	(Application Ser. No. 86/128,507)
v.	:	
	:	
MANNATECH, INCORPORATED	:	Opposition No. 91223820
	:	(Application Ser. No. 86/128,470)
	:	
Applicant/Counterclaimant.	:	Opposition No. 91223821
	:	(Application Ser. No. 86/128,560)

**DECLARATION OF NATHAN L. LEVENSON IN SUPPORT OF APPLICANT'S
REPLY BRIEF IN SUPPORT OF CROSS MOTION FOR SUMMARY JUDGMENT ON
ITS COUNTERCLAIM FOR ABANDONMENT**

I, Nathan L. Levenson, declare:

1. I am an associate at Warren Rhoades LLP, counsel of record for Applicant/Counterclaimant, Mannatech, Incorporated ("Mannatech"), in connection with the above-captioned matter. I have personal knowledge of the following facts set forth in this Declaration and can testify competently to those facts.
2. Attached to this Declaration as Exhibit A is a true and correct copy of Mannatech's email to Opposer's counsel, dated July 28, 2016.
3. Attached to this Declaration as Exhibit B is a true and correct copy of Opposer's email response to Mannatech's, dated August 1, 2016.
4. On July 28, 2017, Opposer's counsel raised its first objection to Mannatech's method of service.
5. Pursuant to Opposer's stipulation to forego email service, Mannatech has served all submissions filed with Board via First Class Mail.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on August 21, 2017 in Irving, Texas.

A handwritten signature in black ink, appearing to read 'N. Levenson', written over a horizontal line.

Nathan L. Levenson
Texas State Bar No. 24097992

Exhibit A

Nathan Levenson

From: Laura Dail
Sent: Thursday, July 28, 2016 7:07 PM
To: Kevin M. Hayes
Cc: Sean M. Briggs; Nathan Levenson; Sanford Warren; IP Docketing; Scott Rhoades
Subject: Shaklee v. Mannatech TTAB Oppositions

Importance: High

Mr. Hayes,

We are writing to request you agreement to serve all documents via electronic mail.

Our list of addresses are as follows:

Sanford E. Warren, Jr. – swarren@wriplaw.com

R. Scott Rhoades – srhoades@wriplaw.com

Nathan Levenson – nlevenson@wriplaw.com

Laura Dail – ldail@wriplaw.com

Docketing – ipdocketing@wriplaw.com

If you agree, please let us know your preferred email addresses to serve documents.

Best regards,

Laura

Laura Dail - Paralegal

WARREN | RHOADES

1212 Corporate Drive, Suite 250, Irving, Texas 75038

Main: (972) 550-7500 | Direct: (972) 550-9003 | Mobile: 972-571-3018

Facsimile: (469) 442-0091 | ldail@wriplaw.com | www.wriplaw.com

Exhibit B

Nathan Levenson

From: Kevin M. Hayes <kevin.hayes@klarquist.com>
Sent: Monday, August 01, 2016 10:00 PM
To: Laura Dail
Cc: Sean M. Briggs; Nathan Levenson; IP Docketing; Scott Rhoades; Sanford Warren
Subject: RE: Shaklee v. Mannatech TTAB Oppositions

Dear Ms. Dail: We would prefer not to.

Best regards, Kevin
Kevin Hayes
Klarquist Sparkman, LLP
Main 503-226-7391
Direct 503-473-0863

From: Kevin M. Hayes
Sent: Friday, July 29, 2016 11:01 AM
To: Laura Dail <ldail@wriplaw.com>
Cc: Sean M. Briggs <Sean.Briggs@klarquist.com>; Nathan Levenson <NLevenson@wriplaw.com>; Sanford Warren <swarren@wriplaw.com>; IP Docketing <ipdocketing@wriplaw.com>; Scott Rhoades <srhoades@wriplaw.com>
Subject: RE: Shaklee v. Mannatech TTAB Oppositions

We will let you know on Monday.

Best regards, Kevin
Kevin Hayes
Klarquist Sparkman, LLP
Main 503-226-7391
Direct 503-473-0863

From: Laura Dail [<mailto:ldail@wriplaw.com>]
Sent: Thursday, July 28, 2016 5:07 PM
To: Kevin M. Hayes <kevin.hayes@klarquist.com>
Cc: Sean M. Briggs <Sean.Briggs@klarquist.com>; Nathan Levenson <NLevenson@wriplaw.com>; Sanford Warren <swarren@wriplaw.com>; IP Docketing <ipdocketing@wriplaw.com>; Scott Rhoades <srhoades@wriplaw.com>

Subject: Shaklee v. Mannatech TTAB Oppositions

Importance: High

Mr. Hayes,

We are writing to request your agreement to serve all documents via electronic mail.

Our list of addresses are as follows:

Sanford E. Warren, Jr. – swarren@wriplaw.com

R. Scott Rhoades – srhoades@wriplaw.com

Nathan Levenson – nlevenson@wriplaw.com

Laura Dail – ldail@wriplaw.com

Docketing – ipdocketing@wriplaw.com

If you agree, please let us know your preferred email addresses to serve documents.

Best regards,

Laura

Laura Dail - Paralegal

WARREN | RHOADES

1212 Corporate Drive, Suite 250, Irving, Texas 75038

Main: (972) 550-7500 | Direct: (972) 550-9003 | Mobile: 972-571-3018

Facsimile: (469) 442-0091 | ldail@wriplaw.com | www.wriplaw.com