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

Proceeding	92064326
Party	Defendant Clientele, Inc.
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Date	11/29/2017
Attachments	Motion to strike exhibits reply brief PDF.pdf(302186 bytes)

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

EQUIBAL, INC.

Petitioner,

v.

CLIENTELE, INC.

Registrant.

Cancellation No.: 92064326

Registration No. 4,715,718

Trademark: BLEMISH FREE

Registered: April 7, 2015

**REGISTRANT’S MOTION TO STRIKE EXHIBITS E-G TO PETITIONER’S REPLY
IN FURTHER SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

Registrant Clientele, Inc. (“Clientele”) moves to strike Exhibits E, F, and G to Petitioner Equibal, Inc.’s (“Equibal”) reply in further support of motion for summary judgment on mere descriptiveness and strike all argument or reliance upon those exhibits in the reply brief and states:

1. Clientele moves to strike three exhibits from Equibal’s reply in further support of motion for summary judgment on mere descriptiveness and all citations to or reliance upon these exhibits in the reply brief because it is improper to file and rely upon new exhibits for the first time in a reply brief.

2. The exhibits in question are Exhibit E (Clientele’s interrogatory answers served May 1, 2017, prior to the filing of the motion for summary judgment), Exhibit F (Webster’s dictionary definitions), and Exhibit G (a New York Times article). See ttabvue-92064326-CAN-28, p. 2, 7-9, ex. E-G.

3. On May 6, 2017, Equibal moved for summary judgment and argued that

Clientele's mark for BLEMISH FREE[®] for skin creams in international class 003 is merely descriptive. It is Equibal's burden of proving there is no genuine issue of material fact as to mere descriptiveness. TBMP § 528.01; *Olde Tyme Foods v. Roundy's*, 961 F.2d 200, 202 (Fed. Cir. 1992).

4. A party moving for summary judgment is not allowed to introduce or rely upon exhibits for the first time in a reply brief. For example, in *Florists' Transworld Delivery v. Fresh Intellectual Properties*, 2001 TTAB LEXIS 138, *4-5, cancellation no. 92029650 (TTAB 2001) (non-precedential), the Board denied summary judgment and granted a motion to strike exhibits filed for the first time in a reply:

Exhibits B and C, however, were not submitted with the summary judgment motion, so we have not considered them. These exhibits, submitted for the first time in reply to respondent's response to the motion, were untimely submitted and have accordingly not been considered. Respondent did not have the opportunity to address them in its response to the summary judgment motion. If petitioner had wanted the Board to consider them, it should have submitted properly authenticated copies with its summary judgment motion. The Board may permit subsequent authentication of exhibits submitted with the original motion, in essence correcting an error of the movant, but we will not allow new evidence to be submitted with the movant's reply to the response filed by the non-movant. Such piecemeal prosecution is not permitted. See Trademark Rule 2.127(e)(1). Respondent's motion to strike the attachment to petitioner's motion for summary judgment is therefore denied as to the affidavit itself and Exhibit A thereto, but is granted as to Exhibits B and C.

Id. (emphasis added); *Kelman v. Mindee K. Hardin d/b/a Nose Better*, 2017 TTAB LEXIS 120, *15-16, opposition no. 91224275 (denying summary judgment and holding "the submission of evidence with a reply brief which should have been filed with the brief on the motion is improper and will not be considered.") (non-precedential); *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) ("Thus, any other evidentiary materials 'identified,' i.e., relied upon, as supporting a motion for

summary judgment usually must be submitted with the motion.”); *Seay v. Tenn. Valley Authority*, 339 F.3d 454, 481 (6th Cir. 2003) (when new submissions or arguments are included in a reply brief on summary judgment, a non-movant's ability to respond to the new evidence has been vitiated).

5. Other examples are *Stamps.com v. Endicia*, 437 Fed. App'x. 897, 908-909 (Fed. Cir. 2011) (“Additionally, Stamps.com argues that the district court abused its discretion in not considering evidence in a reply brief to cross-motions for summary judgment that it had submitted on October 5, 2009. This evidence included a second declaration by Pagel (“Second Pagel Declaration”) and a corroborating declaration (“Desai Declaration”) by Manish Desai, an engineer who was supervised by Pagel at Stamps.com's predecessor company. Because these declarations were raised for the first time in a reply brief to which Endicia did not have an opportunity to respond, we hold that the district court acted within its discretion when it did not consider these supplementary declarations.”), *Zamani v. Carnes*, 491 F.3d 990, 997 (9th Cir. 2007) (“The district court need not consider arguments raised for the first time in a reply brief.”), and *TAS Distrib. Co. v. Cummins Engine Co.*, 491 F.3d 625, 630 (7th Cir. 2007) (“TAS submits, for the first time in its reply brief, that, in a breach of contract case, damages are presumed. We cannot consider this argument; it is well-settled that arguments first made in the reply brief are waived.”).¹

6. Equibal argued in its motion for summary judgment that there is no acquired distinctiveness for BLEMISH FREE[®] but did not attach any evidence or cite any legal authority.

¹ Not every federal district allows reply briefs. For example, the Southern District of Florida, which covers the Miami area, allows replies (S.D. Fla. L.R. 7.1(c) <http://www.flsd.uscourts.gov/wp-content/uploads/2016/12/December-2016-Local-Rules.pdf> - page 21) but the Middle District of Florida, which covers Tampa, Orlando, and Jacksonville, does not permit replies without leave (M.D. Fla. L.R. 3.1(c) <https://www.flmd.uscourts.gov/forms/USDC-MDFL-LocalRules12-2009.pdf> - page 22).

Instead, all that Equibal did was state that Clientele's sales and advertising figures contained in the interrogatory answers as being too low but *did not file* the interrogatory answers or anything else or list the numbers in the motion. See ttabvue-92064326-CAN-15, p. 8.

7. In response, Clientele pointed out that Equibal failed to meet its summary judgment burden, in particular because Equibal must prove throughout the entire case (a burden only heightened at summary judgment) that there is no acquired distinctiveness since BLEMISH FREE[®] was registered based inherent distinctiveness. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577 (Fed. Cir. 1988).

8. Equibal then filed the interrogatory answers as Exhibit E and relied upon those answers in its reply. See ttabvue-92064326-CAN-28, p. 7-9; ex. E. Since Equibal was in possession of and was clearly aware of the interrogatory answers when it filed the initial motion but chose not to file them, Equibal cannot now file or rely upon the interrogatory answers in the reply brief.

9. As to Exhibit F, there is no doubt that Equibal could have filed the Webster's dictionary definitions of "blemish" and "free" with the initial motion, since Equibal's motion argues that BLEMISH FREE[®] is merely descriptive and dictionary definitions are often cited.

10. Finally, the New York Times article attached as Exhibit G is not even relevant to whether the mark is merely descriptive since it has nothing to do with the terms "blemish" and "free" and is unauthenticated hearsay under Fed. R. Evid. 901 and 802 because the article is offered for its truth of the matter asserted. In any event, there is no reason why Equibal should be allowed to avoid the rule against filing exhibits for the first time in a reply brief.

11. Prior to filing this motion, Clientele requested Equibal to withdraw the exhibits but Equibal did not agree to do so.

Wherefore, Registrant Clientele, Inc. respectfully requests the Board to strike Exhibits E, F, and G to Petitioner Equibal, Inc.'s ("Equibal") reply in further support of motion for summary judgment on mere descriptiveness and strike all argument or reliance upon those exhibits in the reply brief.

Date: November 29, 2017

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served on Counsel for Petitioner by forwarding said copy on November 29, 2017, via email PDF to:

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/s/ James Stepan