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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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Submission	Request for Reconsideration of Final Board Decision
Filer's Name	Catherine F. Hoffman
Filer's email	trademarks@mayback.com, jstepan@mayback.com
Signature	/catherine f hoffman/
Date	05/07/2018
Attachments	M Reconsideration final.pdf(4950777 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 CLIENTELE, INC.'S REQUEST FOR RECONSIDERATION OF THE
BOARD'S ORDER DATED APRIL 6, 2018 FINAL DECISION**

Now comes Clientele, Inc. ("Respondent" or "Clientele"). by and through its attorneys, to Request Reconsideration under 37 C.F.R. § 2.129(c) and TBMP § 543 of the Trademark Trial and Appeal Board's ("Board") order of April 6, 2018 granting summary judgment for Equibal, Inc. ("Petitioner" or "Equibal"). Clientele submits that the Board erred in this Order because (1) the Board should have considered Clientele's defense of misuse of the ® symbol, which can be a complete bar to any relief; and (2) it incorrectly determined that Cleintele's BLEMISH FREE mark was descriptive.

A Request for Reconsideration should be granted if, "based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued." TBMP § 543. The request is "limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change." *Id.*; *see also In re Squaw Valley Development Co.*, 80 U.S.P.Q.2d 1264, 1268 (T.T.A.B. 2006).

Clientele seeks reconsideration of the order granting summary judgment for Equibal because the Board should have considered Clientele's defense of misuse of the ® symbol, which can be a complete bar to any relief. Equibal claims ownership of the mark BLEMFREE and argued that Clientele's mark BLEMISH FREE is merely descriptive. Further, the Board erred in granting summary judgment based on descriptiveness as a matter of law.

BACKGROUND

Clientele served discovery to Equibal on February 24, 2017. See ttabvue-92064326-CAN-22, Ex. A-B. After some agreed extensions, Clientele produced documents to Equibal (some of which were used in the summary judgment motion) in early May, but Equibal did not produce any discovery responses or documents. See ttabvue-92064326-CAN-22, p. 1-8. Instead of responding to any discovery requests, Equibal moved for summary judgment just after midnight on May 12, 2017 on the grounds of mere descriptiveness and to suspend all proceedings pending the outcome of that motion. See ttabvue-92064326-CAN-18; ttabvue-92064326-CAN-22 and Declaration of James Stepan in support.

Equibal also moved to suspend which was granted on June 21, 2017 and barred the parties from filing any other paper during the pendency of the motion. See ttabvue-92064326-CAN-24. Clientele filed two motions seeking discovery to respond to the summary judgment motion [see ttabvue-92064326-CAN-22; see ttabvue-92064326-CAN-17] and one motion was granted on August 25, 2017 that required Equibal to produce documents relating to standing. See ttabvue-92064326-CAN-25.

In early September of 2017, over six months after Clientele issued its discovery requests, Equibal produced some document. See Exhibit A, a true and correct copy of the declaration of Catherine F. Hoffman ("C. Hoffman Decl."). Included in the documents received on or around

September 6, 2017, were documents Bates stamped EQUIBAL000148-EQUIBAL000155, EQUIBAL000210- EQUIBAL000212, EQUIBAL000224, and EQUIBAL000249-EQUIBAL000250, which were used as Exhibit T to the Declaration of J. Dahlgard in support of Clientele's Response to Equibal's Motion for Summary Judgment filed November 16, 2017. See C. Hoffman Decl. Although Clientele sought discovery back in February 2017, Clientele was unaware of Equibal's misuse of the ® symbol for BLEMFREE before it received the documents from Equibal in September 2017, else it would have added an affirmative defense earlier. See C. Hoffman Decl.; *also see* Declaration of James Stepan : ttabvue-92064326-CAN-22.

On November 16, 2017, Clientele responded to Equibal's summary judgment motion arguing, *inter alia*, that Equibal's use of the ® symbol for the mark BLEMFREE was improper because Equibal did not have a U.S. registration for BLEMFREE and provided evidence demonstrating such misuse. [see ttabvue-92064326-CAN-26, ex. 2, ex. T-U, p. 222-239], which are re-attached as Ex. B. Equibal filed its reply brief on November 26, 2017 arguing that the misuse evidence was a red herring, but not objecting to Clientele's inclusion of this argument in any way. See ttabvue-92064326-CAN-28, p. 9.

On April 6, 2018, the Board issued its Order on Summary Judgment and held that the misuse of the registration argument "is an unpled issue not properly raised as a defense of this motion for summary judgment." See ttabvue-92064326-CAN-33, fn. 6. The Board also granted summary judgment to Equibal based on descriptiveness. Thus, this reconsideration followed as the Board erred in not considering Clientele's defense of misuse of the ® symbol, which can be a complete bar to any relief and also erred in granting summary judgment based on descriptiveness.

A. Misuse of the registration symbol was properly before the Board and Equibal waived any right to object

As demonstrated in the above background section, although Clientele served its discovery requests back in February of 2017, Equibal did not provide any documents until September of 2017. See C. Hoffman Decl. Further, when Clientele argued in its response to the motion for summary judgment that the misuse of the registration symbol on BLEMFREE was a bar to the summary judgment, Equibal did not object to the argument, it merely argued that the issue was a red herring. See ttavvue-92064326-CAN-28, p. 9. Therefore, pursuant to Fed.R.Civ.P. 15(b), Equibal has conceded by implied consent that the issue of the defense was properly before the Board and tried by implied consent.

B. The Board Erred By Deeming the evidence merely “Attorney Argument”

The Board Order stated that Clientele’s misuse of registration symbol argument was “attorney argument” not properly raised in defense and not considered as part of the ruling on the summary judgment. See ttavvue-92064326-CAN-33, p. 13, fn.6. As Clientele has presented evidence in the record in opposition to the summary judgment of documents produced by Equibal, this case is not about mere “attorney argument.” Equibal produced the documents in Exhibit B which were put in evidence as part of Clientele’s opposition motion. The misuse of the registration symbol was an issue and defense in the case and should have barred summary judgment at a minimum as an issue of fact.

C. The Board Erred in Not Considering Clientele’s Defense of Misuse of the Registration Symbol and Barring Clientele from Pursuing Any Discovery on the Defense

As set forth in Clientele’s opposition to Equibal’s summary judgment, the improper use of the ® symbol, if done with intent to deceive the purchasing public or others in the trade into believe that the mark is registered, may constitute a form of “unclean hands” so as to bar a petitioner from

obtaining the relief it seeks. *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 1566 (Fed. Cir. 1991); *Wells Fargo & Co. v. Lundeen & Associates*, 20 USPQ2d 1156, 1157 (TTAB 1991); *Tapmaster, Inc. v. Perfect Water Technologies*, 2012 TTAB LEXIS 515 *12-13, opposition no. 91199561 (TTAB 2012); TMEP § 906.04.

The Board incorrectly did not consider the merits of the misuse of the ® symbol defense – in particular since the application of the defense created at a minimum a fact issue that precludes summary judgment – because Clientele did not have a procedural opportunity to pled the defense due to the suspension order. The Board’s Order unfairly prejudiced Clientele’s ability to develop the record with respect to this defense.

D. Summary Judgment was Improper on the Descriptiveness Claim

The Board erred in granting summary judgment based on descriptiveness. As to the term “FREE,” the Board erred in finding as a matter of law that the term is descriptive and not merely suggestive. The evidence cited on Clientele’s own website does not establish that the mark is merely descriptive as the wording to “keep skin clear and radiant.” There are numerous other terms that are equally or better suited to describe the products such as “clear” “clearing” “treatment” “remove” “disappear” which were ignored by the Board. Further there are many definitions of the term “FREE” that it was improper for the Board to focus on just a few and ignore Clientele’s definitions. The fact that Clientele has been in the business since 1979 and used the present product for many years was not properly taken into consideration. Additionally, the fact that Clientele inadvertently was unable to file the renewal and Section 8 resulting in the cancellation of Clientele’s Registration 4,715,718 and the forced refiling was the only reason Equibal was able to raise the descriptiveness issue at all. Summary Judgment on descriptiveness should not be entered.

Date: May 7, 2018

By: /s/ Catherine F. Hoffman
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James A. Stepan, Esq.
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E-mail: jstepan@mayback.com
Attorneys for Registrant

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 May 7, 2018, via email to:

Michael E Zall Law Firm
Two Yorkshire Drive
Suffern, NY 10901
Mike@Zall-Law.com

/s/ Catherine F. Hoffman

EXHIBIT A

**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

DECLARATION OF CATHERINE HOFFMAN

I, Catherine Hoffman, being of legal age and pursuant 28 U.S.C. §1746, hereby declare as follows, based on my own personal knowledge.

1. I am a Partner at the firm Mayback & Hoffman, P.A. (hereinafter “Mayback & Hoffman”) and I am authorized and licensed to practice law in Florida. I am authorized to execute this declaration on behalf of Respondent/Registrant, Clientele, Inc. (“Clientele”) in this Cancellation proceeding No. 92064326. This Declaration is submitted in support of Registrant Clientele Inc.’s Request for Reconsideration of the Board’s Order Dated April 6, 2018 Final Decision under Trademark Rule 37 C.F.R. § 2.129(c) and TBMP § 543. I have personal knowledge of the facts as stated herein; if called to testify I would and could competently testify thereto.

2. On or around September 6, 2017, our firm received a Federal Express package from counsel for Petitioner, Equibal, Inc. (“Equibal”) with a flash drive with documents stamped EQUIBAL000001 - EQUIBAL000286.

3. Included in the documents received on or around September 6, 2017, were documents Bates stamped EQUIBAL000148-EQUIBAL000155, EQUIBAL000210-

EQUIBAL000212, EQUIBAL000224, and EQUIBAL000249-EQUIBAL000250, which were used as Exhibit T to the Declaration of J. Dahlgard in support of Clientele's Response to Equibal's Motion for Summary Judgment filed November 16, 2017.

4. Therefore, our firm did not have documents Bates stamped EQUIBAL000148-EQUIBAL000155, EQUIBAL000210-EQUIBAL000212, EQUIBAL000224, and EQUIBAL000249-EQUIBAL000250 before September 6, 2017.

5. Although Clientele sought discovery back in February 2017, Clientele was unaware of Equibal's misuse of the ® symbol for BLEMFREE before it received the documents from Equibal in September 2017, else it would have added an affirmative defense earlier and Clientele was barred from adding any affirmative defense due to the suspension by the Board. Also see Declaration of James Stepan : ttabvue-92064326-CAN-22.

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

Executed on May 7, 2018, in Cooper City, Florida

/catherine f hoffman/
Catherine F. Hoffman
Attorney for Registrant
Clientele, Inc.

EXHIBIT B

EXHIBIT T to
Declaration of J. Dahlgard
In support of
Clientele's Response to Motion
for Summary Judgment

BlemFree®

Acne Treatment

That's Safe & Natural



0:02 / 1:31

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Acne Treatment Ask Norma

34 views

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thebodyperfect

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Safe effective acne treatment. Get your Blemfree today by visiting thebodyperfect.com or calling 1-800-247-2405..

Up next

AUTOPLAY

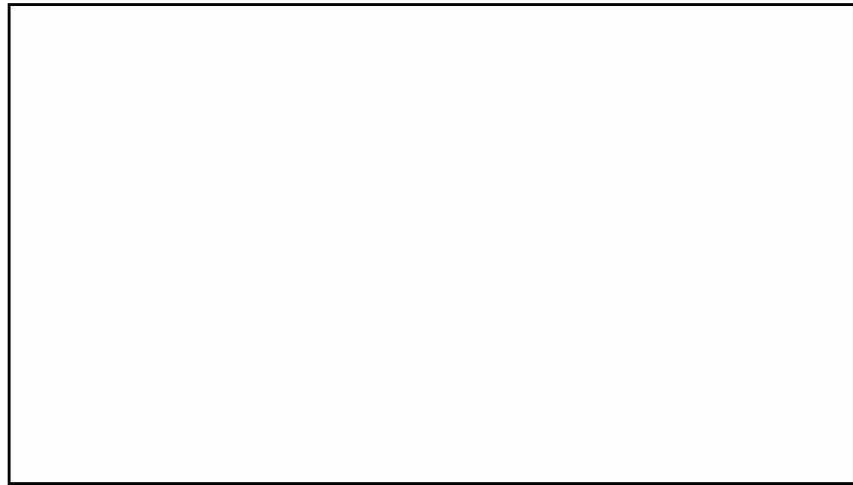


A true miracle- How I got rid of my acne. Daily skin-care routine.

MamiChula8153

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EQUIBAL000148



Acne Treatment Ask Norma

34 views



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Safe effective acne treatment. Get your Blemfree today by visiting thebodyperfect.com or calling 1-800-247-2405..

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AUTOPLAY

A true miracle- How I got rid of my acne. Daily skin-care routine.

MamiChula8153

12M views



12:37

**Step 2:**

Balance Your Skin's PH with:

Blemfree® Toner/Balancer

Blemfree® Toner/Balancer keeps bacteria at bay by cleansing your pores and balancing your skin PH.

1:38

BlemFree YouTube 0001

thebodyperfect

107 views



You Can Shave Too! kills 99% of surface bacteria with our patented formula Snip100, preventing infection and inflammation.

Its rich, hydrating formula soothes your beard and soothes irritated skin.

1:31

Shave without Irritation, Razor Burn, Ingrowns, or Bumps!

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825 views



Houston Cosmetic Dermatology
Acne Treatment with Lasers

EQUIBAL000149



Acne Solution Remedies And Best Acne Solution Treatments

carlcramer44

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New Acne Treatment

dcdermdocs

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IntermountainMoms

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AnswersToPrayer

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Carb Loaded

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Dr Teeth

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Registered Nurse Michelle loves her Venus Legacy treatment

The Global Beauty Group

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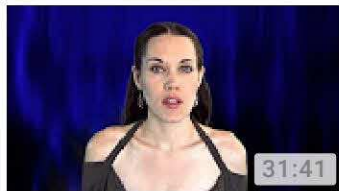


Eternal Youth Eye Serum Duo AutoShip

HSNtv

37 views

7:17



The Divine Masculine (How To Awaken The Divine Masculine)

Teal Swan ✓

172K views

31:41



How to Clean Your Pillows! Easy Bedroom Cleaning Ideas That Save

Clean My Space ✓

925K views

6:51



JOY True Perfection BleachResistant Luxurious Towels

HSNtv

929 views

34:50



Pink Lipstick For Dark Pigmented Lips

Shruti Arjun Anand ✓

113K views

6:36

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Let's keep it simple! TBP4Men® was developed to meet the needs of today's busy, active man who wants his grooming products to be highly effective and uncomplicated. To achieve optimum results, CLEANSE, TONE, and NOURISH with TBP4Men® products. Our products contain high concentrations of extracts like Chamomile, Hamamelis and Goldenseal, which kills bacteria naturally. These active ingredients clean and fortify your skin, and after using our products for just one week, your skin will have a healthy, revitalized glow.

Get the TBP4Men® Primary System to achieve these optimum results. The TBP4Men® system contains: TBP4Men® Body Wash, TBP4Men® Splash/Toner, and Equibal's You Can Shave, Too!®.

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Be blemish free! The Blemfree® Primary system is a powerful combination of products scientifically formulated to work together to CLEANSE, TONE, and NOURISH your skin without the harmful side effects of acids. Our patented formula kills 99.9% of acne causing bacteria in 7 seconds, and after using the Blemfree® system for just one week, you will notice a reduction in breakouts, and with continued use, you will have blemish free skin because our powerful products work hard to eliminate acne before it starts.

Get the Blemfree® Primary system today to achieve your acne free skin. The Blemfree® Primary system contains: Blemfree® Foaming Scrub & Beads, Blemfree® Toner, Blemfree® All Day Lotion, and Blemfree® Overnight Cream.

Want Blemish Free Skin In As Little As 7 DAYS?



patent pending

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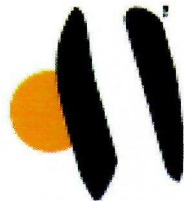


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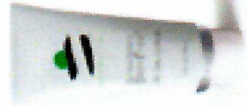


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EQUIBAL000155

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ORDER FORM

Please send me the Blemfree® Primary System including the Blemfree® Foaming Scrub and Beads, Toner/Balancer, All Day Lotion and Overnight Cream. I understand the system comes with a 30-day money back guarantee. All I need to do is return the unused portion along with the original dated packing slip and I will receive a full refund minus any shipping charges.



Please take **\$10 OFF** the cost of the system when I order by November 30th, 2003. (an additional savings of over 10%)



Please include a **sterling flashlight & key chain** as a special **FREE gift** when I order by November 15th, 2003.



Please Print

Name: _____

Address: _____

City: _____

State: _____

Zip: _____

Phone: _____

e-mail: _____

☐ My check or money order for \$86.50, payable to Equibal, Inc. is enclosed (\$89.00 less the \$10 discount, plus \$7.50 shipping and handling) plus sales tax if applicable.

☐ Please charge the amount indicated above to the credit card checked below

☐ VISA

☐ MASTERCARD

☐ DISCOVER

☐ AMERICAN EXPRESS

Account Number _____

Expiration Date _____

Signature _____

Equibal Inc.
63-65 Jersey Avenue
Unionville, NY 10988



Phone: 800-247-2405
Fax: 845-726-3739
www.blemfree.com

EQUIBAL000210

Blẽmfree®

ORDER FORM

Please send me the Blẽmfree® Primary System including the Blẽmfree® Foaming Scrub and Beads, Toner/Balancer, All Day Lotion and Overnight Cream. I understand the system comes with a 30-day money back guarantee. All I need to do is return the unused portion along with the original dated packing slip and I will receive a full refund minus any shipping charges.

Please take **\$10 OFF** the cost of the system when I order by November 30th, 2003. (an additional savings of over 10%)

Please include a **sterling flashlight & key chain** as a special **FREE gift** when I order by November 15th, 2003.



Please Print

Name: _____

Address: _____

City: _____ State: _____ Zip: _____

Phone: _____ e-mail: _____

- ☐ My check or money order for \$86.50, payable to Equibal, Inc. is enclosed (\$89.00 less the \$10 discount, plus \$7.50 shipping and handling) plus sales tax if applicable.
- ☐ Please charge the amount indicated above to the credit card checked below

☐ VISA ☐ MASTERCARD ☐ DISCOVER ☐ AMERICAN EXPRESS

Account Number _____

Expiration Date _____ Signature _____

Equibal Inc.
63-65 Jersey Avenue
Unionville, NY 10988

equibal labs



Phone: 800-247-2405
Fax: 845-726-3739
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EQUIBAL000212



BlemFree[®]

with finipil[®]

for acne

All Day Lotion

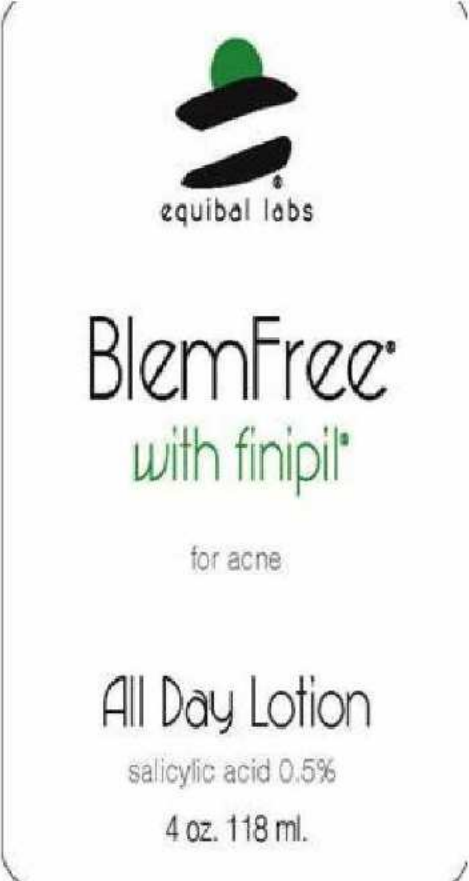
salicylic acid 0.5%

4 oz. 118 ml.

EQUIBAL000224



Firm Name	Facility Establishment Identifier	Data Universal Numbering System Number	Address	Expiration Date
Equibal, Inc.	3003440513	144679883	63 Jersey Avenue, Unionville, New York (NY) 10988, United States (USA)	12/31/2016



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Drug Facts

Active Ingredient	Purpose
Salicylic Acid 0.5% w/w.....	Acne

Use(s)
• acne • fine lines • discoloration • large pores • blackheads

Directions
• cleanse with Blemfree Scrub & Beads. Rinse several times.
• apply Blemfree Toner.
• cover the entire affected area with a thin layer of Blemfree All Day Lotion.
• because excessive drying of the skin may occur, start with one application daily, then gradually increase to two or three times daily if needed or as directed by a doctor.
• if bothersome dryness or peeling occurs, reduce application to once a day or every other day.
Sensitivity Test for a New User: Apply product sparingly to one or two small affected areas during the first 3 days. If no discomfort occurs, follow the directions stated above.

Warnings

For external use only

Ask doctor if pregnant or breastfeeding

When using this product do not get into eyes.
If contact occurs, rinse eyes thoroughly with water

Stop use and ask a doctor if irritation and redness become severe

Do not use in conjunction
with other products containing acids

Keep out of reach of children
If swallowed, get medical help or contact a Poison Control Center right away

Inactive Ingredients

Behentrimonium Methosulfate, Benzethonium Chloride, Bisabolol, Butylene Glycol, Cetyl Alcohol, Chlorhexidine Gluconate, Dimethicone, Chamomile (*Matricaria recutita*) Extract, Menthyl Lactate, Octyldodecanol, Phenoxyethanol, Polyquaternium-37, Stearic Acid, Water, Witch Hazel (*Hamamelis virginiana*) Extract

equibal labs
800-247-2405
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Made in USA



BLEMFREE (salicylic acid) lotion

NDC Code(s): 53228-002-01

Packager: Equibal, Inc.