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ESTTA Tracking number: **ESTTA908957**

Filing date: **07/12/2018**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Prime Direct Brands, LLC		
Entity	Limited Liability Corporation	Citizenship	Massachusetts
Address	1075 Main Street, 4th Floor Waltham, MA 02451 UNITED STATES		

Attorney information	Michael J. Hickey Lewis Rice LLC 600 Washington Ave, Ste. 2500 BOX IP Dept St. Louis, MO 63101 UNITED STATES Email: ipdept@lewisrice.com Phone: 314-444-7600

Registration Subject to Cancellation

Registration No.	4152902	Registration date	06/05/2012
Registrant	IQ Products Company 16212 State Highway 249 Houston, TX 77086 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 1994/06/01 First Use In Commerce: 1994/06/01
Goods and services in the class that are subject to cancellation: hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, * and * hair sprays; nail care preparations, namely, nail polishenamel driers; shavingpreparations, namely, shaving creams, shaving gels

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Attachments	Petition for Cancellation of 4152902.pdf(3604046 bytes)

Signature	/Michael J. Hickey/
Name	Michael J. Hickey

Date	07/12/2018

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

PRIME DIRECT BRANDS, LLC, Petitioner, v. IQ PRODUCTS COMPANY, Respondent.	)	Cancellation No.

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION OF REGISTRATION NO. 4,152,902

Pursuant to 15 U.S.C. §§ 1064, 1068, 37 C.F.R. § 2.111(b), and TBMP § 309.03(d) and applicable law, Petitioner Prime Direct Brands, LLC hereby petitions to cancel Registration No. 4,152,902 for the trademark ENVI issued to Respondent IQ Products Company.

As grounds for the Petition, it is alleged that:

1. Petitioner Prime Direct Brands, LLC ("Petitioner") is a Massachusetts limited liability corporation, with a place of business at 1075 Main Street, 4th Floor, Waltham, Massachusetts 02451.

2. On March 8, 2018, Petitioner filed an application on the Principal Register for its ENVIE Mark for the following goods: "Hair care products, namely, hair conditioners, hair gels, hair mousses, hair pomades, hair relaxers, hair shampoo, hair shampoos and conditioners, hair sprays, hair straightening preparations, non-medicated hair serums, and oils for hair conditioning, hair thermal protectants, hair curling lotions and conditioners" in International Class 003. This application was assigned Serial Number 87/826,185 ("the Application").

3. Petitioner has been, and continues to be, damaged in that Trademark Registration No. 4,152,902 ("the Registration") has been cited against Petitioner's Application as a basis for refusal of registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

4. Respondent IQ Products Company ("Respondent") is a Texas corporation with a last-known place of business at 16212 State Highway 249, Houston, Texas 77086, with a listed phone number of 281-444-6454.

5. Respondent's Registration was initially issued on June 5, 2012.

6. On May 30, 2018, Respondent filed a Combined Declaration of Use and Incontestability under Sections 8 & 15, signed by "J M Gilbreth, Atty of record, TX bar member". See Exhibit 1 submitted herewith.

7. In said Declaration, Respondent declared under oath that the registered mark "has been in continuous use in commerce for five consecutive years after the date of registration" with respect to the following goods: "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels." See id.

8. In said sworn Declaration, Respondent further stated that the specimen (which consisted of two website printouts of pictures of Envi Hair Sprays (3 orange cans), Envi Nail Enamel Dryer (1 pink/purple can), Envi Super Shave Cream (3 dark blue cans with razor), Envi Shave Gel (1 pink can), Envi Shampoo and Conditioner (1 blue and 1 pink container)) showed "the mark as currently used in commerce on or in connection with the goods." See id.

9. Upon information and belief, Respondent has abandoned the ENVI mark shown in Respondent's Registration pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3).

10. Upon information and belief, Respondent is not currently using the ENVI mark as shown in Respondent's Registration in connection with "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels."

11. Upon information and belief, Respondent discontinued use of the ENVI mark as shown in Respondent's Registration in connection with "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels" many years ago.

12. Upon information and belief, for at least the last three consecutive years, Respondent has not used the ENVI mark as shown in Respondent's Registration in connection with "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels," thereby constituting primae facie evidence of abandonment of the ENVI mark as shown in Respondent's Registration.

13. Although Respondent filed a Section 8 & 15 Declaration to renew Respondent's Registration on May 30, 2018 ("2018 Renewal"), see Exhibit 1, upon information and belief, Respondent had, at the time of the 2018 Renewal, previously discontinued and abandoned use of the ENVI mark as shown in Respondent's Registration in connection with "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels." The specimen submitted to support such Renewal was a website printout that does not demonstrate bona fide use of the ENVI mark in connection with "hair care

products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels." Compare Exhibit 1 with Exhibit 2 submitted herewith (a printout of Respondent's website dated July 12, 2018). The website does not show that the products are available for sale through the website nor does it identify any retailers through whom the products can be purchased.

14. Upon information and belief, "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels" were not being provided to any consumers by Respondent under the ENVI mark as shown in Respondent's Registration at the time of the 2018 Renewal.

15. In fact, on June 1, 2017, Respondent was contacted at the phone number listed on its website and in the official USPTO records regarding products sold under the ENVI mark as shown in Respondent's Registration. At that time, Respondent's representative (identifying herself as Lynn) informed the caller that Respondent had neither manufactured nor sold any hair products under the ENVI name in years and could not identify any retailers where the ENVI hair products could be purchased.

16. Moreover, on June 29, 2018, even after the 2018 Renewal, Respondent was again contacted at the phone number listed on its website (281-444-6454) and in the official USPTO records. At that time, Respondent's representative (identifying herself as Lynn Carlson) informed the caller that Respondent had not made the ENVI hair products in years, that the pictures are just up on the website, and that the caller could not buy the ENVI hair products anywhere.

17. In view of Respondent's non-use and abandonment of the ENVI mark shown in U.S. Registration No. 4,152,902, Respondent is not entitled to continued registration of the mark pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), and, as such, Respondent's Registration should be cancelled.

18. Further, Respondent's false representations regarding continued usage at the time of the 2018 Renewal constitute a fraud further justifying cancellation of the Registration under Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3).

19. The obligation which the Trademark Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration. This obligation to refrain from knowingly making false, material statements applies with equal force to renewal applications. See, e.g., Torres v. Cantine Torresella S.r.l., 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986).

20. Upon information and belief, Respondent knowingly made a false and material representation with the intent to deceive the Trademark Office when, among other things, Respondent declared under oath in connection with the 2018 Renewal that the registered mark "has been in continuous use in commerce for five consecutive years after the date of registration" with respect to the following goods: "hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels" and that the submitted specimen showed "the mark as currently used in commerce on or in connection with the goods."

21. Therefore, in view of Respondent's fraud with respect to the 2018 Renewal of the ENVI mark shown in U.S. Registration No. 4,152,902, Respondent is not entitled to continued

registration of the mark pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), and, as such, Respondent's Registration should be cancelled.

22. As Petitioner's attempt to register the mark as shown in Petitioner's Application will be impaired by the continued registration of said abandoned and fraudulently renewed mark of Respondent, and as Petitioner believes that Respondent has abandoned and fraudulently obtained renewal of the mark shown in U.S. Registration No. 4,152,902, said registration should be canceled.

23. Petitioner reserves the right to amend this Petition to allege other claims in the event discovery of other information indicates they are appropriate.

WHEREFORE, Petitioner Prime Direct Brands, LLC believes that it is being and will continue to be damaged by the continued existence of Registration No. 4,152,902, and prays that said Registration No. 4,152,902 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Please recognize as attorneys for Petitioner in the proceeding Michael J. Hickey, Frank B. Janoski, Kirk A. Damman, Bridget G. Hoy, Benjamin J. Siders, and Michael H. Durbin (members of the Bar of the State of Missouri) and the firm of Lewis Rice LLC, Box IP Department, 600 Washington Avenue, Suite 2500, St. Louis, Missouri 63101.

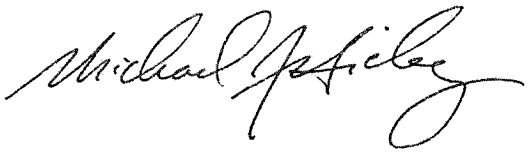
Please address all correspondence and telephonic communication concerning this Petition for Cancellation to:

Michael J. Hickey, Esq.
Lewis Rice LLC
Box IP Department
600 Washington Avenue, Suite 2500
St. Louis, Missouri 63101

Dated: July 12, 2018

Respectfully submitted,

LEWIS RICE LLC



By: _____

Michael J. Hickey, Missouri Bar #47136
Box IP Department
600 Washington Avenue, Suite 2500
St. Louis, Missouri 63101
(314) 444-7600

Attorneys for the Petitioner Prime Direct Brands, LLC

EXHIBIT 1

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1583 (Rev 05/2006)
OMB No. 0651-0055 (Exp 07/31/2018)

Combined Declaration of Use and Incontestability under Sections 8 & 15

The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	4152902
REGISTRATION DATE	06/05/2012
SERIAL NUMBER	85317728
MARK SECTION	
MARK	ENVI (see, https://tmng-al.uspto.gov/resting2/api/img/85317728/large)
CORRESPONDENCE SECTION (current)	
NAME	J. M. (MARK) GILBRETH
FIRM NAME	GILBRETH ROEBUCK, PC
STREET	16212 STATE HWY 249
CITY	HOUSTON
STATE	Texas
POSTAL CODE	77086
COUNTRY	United States
PHONE	281-444-6454
FAX	281-586-3223
EMAIL	johnbrogan@iqproducts.org
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
CORRESPONDENCE SECTION (proposed)	
NAME	IQ Products Company
STREET	16212 State Highway 249
CITY	HOUSTON
STATE	Texas
POSTAL CODE	77086
COUNTRY	United States
PHONE	281-444-6454
FAX	281-586-3223
EMAIL	jmark@gilbreth.org; JohnBrogan@iqproducts.org
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	003

GOODS OR SERVICES TO BE DELETED	hair bleaches, hair colorants, hair gels, hair lighteners, hair mousses, hair pomades, hair relaxers, hair straightening preparations, hair wax, hydrogen peroxide for use on the hair, non-medicated hair serums, and oils for hair conditioning; depilatory preparations; nail gels, nail polish removers, and nail hardeners; shaving foam, after shave balms, baby oils; non-medicated diaper rash preparations in the nature of ointments, lotions, creams, and gels; and baby wipes
GOODS OR SERVICES IN USE IN COMMERCE	hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels
SPECIMEN FILE NAME(S)	
ORIGINAL PDF FILE	SPN0-2167424398-20180530190427986576_._Envi_pic_1.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT17\IMAGEOUT17\853\177\85317728\xml3\8150002.JPG
ORIGINAL PDF FILE	SPN0-2167424398-20180530190427986576_._Envi_pic_2.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT17\IMAGEOUT17\853\177\85317728\xml3\8150003.JPG
SPECIMEN DESCRIPTION	pics 1 and 2 show Envi Hair Sprays (3 orange cans), Envi Nail Enamel Dryer (1 pink/purple can), Envi Super Shave Cream (3 dark blue cans with razor), Envi Shave Gel (1 pink can), Envi Shampoo and Conditioner (1 blue and 1 pink container).
OWNER SECTION (current)	
NAME	IQ Products Company
STREET	16212 State Highway 249
CITY	Houston
STATE	Texas
ZIP/POSTAL CODE	77086
COUNTRY	United States
PHONE	281-444-6454
FAX	281-586-3223
EMAIL	johnbrogan@iqproducts.org
LEGAL ENTITY SECTION (current)	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Texas
PAYMENT SECTION	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
COMBINED §§ 8 & 15 FILING FEE PER CLASS	325
TOTAL FEE PAID	325
SIGNATURE SECTION	
SIGNATURE	/ J M GILBRETH /
SIGNATORY'S NAME	J M GILBRETH
SIGNATORY'S POSITION	Atty of record, TX bar member

DATE SIGNED	05/30/2018
SIGNATORY'S PHONE NUMBER	7136671200 x 102
PAYMENT METHOD	DA
FILING INFORMATION	
SUBMIT DATE	Wed May 30 19:31:46 EDT 2018
TEAS STAMP	USPTO/S08N15-XXX.XX.XXX.X X-20180530193146193228-41 52902-6105bbaba9c7dfcbbf6 50bc88cdebaf7243809337efa c28bf90d6beede8de3c-DA-57 75-20180530190427986576

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1583 (Rev 09/2006)
OMB No. 0651-0055 (Exp 07/31/2018)

Combined Declaration of Use and Incontestability under Sections 8 & 15
To the Commissioner for Trademarks:

REGISTRATION NUMBER: 4152902
REGISTRATION DATE: 06/05/2012

MARK: ENVI

The owner, IQ Products Company, a corporation of Texas, having an address of
16212 State Highway 249
Houston, Texas 77086
United States
281-444-6454
281-586-3223
johnbrogan@iqproducts.org (not authorized)
is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 003, this filing does **NOT** cover the following goods or services for this specific class listed in the registration, and these goods or services are to be permanently **deleted** from the registration: hair bleaches, hair colorants, hair gels, hair lighteners, hair mousses, hair pomades, hair relaxers, hair straightening preparations, hair wax, hydrogen peroxide for use on the hair, non-medicated hair serums, and oils for hair conditioning; depilatory preparations; nail gels, nail polish removers, and nail hardeners; shaving foam, after shave balms, baby oils; non-medicated diaper rash preparations in the nature of ointments, lotions, creams, and gels; and baby wipes

The mark is in use in commerce on or in connection with the following goods or services listed in the existing registration for this specific class: hair care products, namely, hair conditioners, hair shampoo, hair shampoos and conditioners, and hair sprays; nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels

For the remaining goods or services, the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with these goods or services. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one(or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) pics 1 and 2 show Envi Hair Sprays (3 orange cans), Envi Nail Enamel Dryer (1 pink/purple can), Envi Super Shave Cream (3 dark blue cans with razor), Envi Shave Gel (1 pink can), Envi Shampoo and Conditioner (1 blue and 1 pink container)..

Original PDF file:
SPN0-2167424398-20180530190427986576_._Envi_pic_1.pdf
Converted PDF file(s) (1 page)
Specimen File1
Original PDF file:
SPN0-2167424398-20180530190427986576_._Envi_pic_2.pdf
Converted PDF file(s) (1 page)
Specimen File1
The registrant's current Correspondence Information: J. M. (MARK) GILBRETH of GILBRETH ROEBUCK, PC
16212 STATE HWY 249
HOUSTON, Texas 77086
United States
The phone number is 281-444-6454.
The fax number is 281-586-3223.
The email address is johnbrogan@iqproducts.org. (authorized)

The registrant's proposed Correspondence Information: IQ Products Company
16212 State Highway 249

HOUSTON, Texas 77086
United States
The phone number is 281-444-6454.
The fax number is 281-586-3223.
The email address is jmark@gilbreth.org; JohnBrogan@iqproducts.org. (authorized)

A fee payment in the amount of $325 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

Declaration

Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods/services or to indicate membership in the collective membership organization identified above, as evidenced by the attached specimen(s).

Unless the owner has specifically claimed excusable nonuse, the specimen(s) shows the mark as currently used in commerce on or in connection with the goods/services/collective membership organization.

The mark has been in continuous use in commerce for five consecutive years after the date of registration, or the date of publication under 15 U.S.C. § 1062(c), and is still in use in commerce on or in connection with all goods/services, or to indicate membership in the collective membership organization, listed in the existing registration.

There has been no final decision adverse to the owner's claim of ownership of such mark for such goods/services, or to indicate membership in the collective membership organization, or to the owner's right to register the same or to keep the same on the register.

There is no proceeding involving said rights pending and not finally disposed of either in the United States Patent and Trademark Office or in a court.

To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of this submission and the registration, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: / J M GILBRETH / Date: 05/30/2018
Signatory's Name: J M GILBRETH
Signatory's Position: Atty of record, TX bar member
Signatory's Phone: 7136671200 x 102

Serial Number: 85317728
Internet Transmission Date: Wed May 30 19:31:46 EDT 2018
TEAS Stamp: USPTO/S08N15-XXX.XX.XXX.XX-2018053019314
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ENVI
HAIR SPRAY
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NAIL ENAMEL
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ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 4152902

Serial Number: 85317728

RAM Sale Number: 4152902

RAM Accounting Date: 20180531

Total Fees: $325

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

Transaction	Fee Code	Transaction Date	Fee per Class	Number of Classes	Number of Classes Paid	Total Fee
§8 affidavit	7205	20180530	$125	1	1	$125
§15 affidavit	7208	20180530	$200	1	1	$200

Physical Location: MADCD- ALEX. CENTRAL DOCKET

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20180530

EXHIBIT 2

IQ Products Company

www.iqproducts.com/beautygroomingcare.html

quick access, place your bookmarks here on the bookmarks bar. Import bookmarks now...

IQ Products Company

HOME COMPANY PRODUCTS SUSTAINABILITY SERVICES NEWS & MEDIA

Brands

Beauty & Grooming Care

It's simple to make life easier with the wide range of Beauty & Grooming products from IQPC. With complete head-to-toe coverage, the Envi and NuPiel lines of personal care products includes hypoallergenic offerings in the Shave, Hair, Nail, and Skin Care categories.

- Beauty & Grooming Care
- Household Care
- Automotive Care
- Electronic Equipment Care

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IQ Products Comp...

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7/12/2