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

Proceeding	92068992
Party	Defendant IQ Products Company
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Signature	/J M GILBRETH/
Date	02/21/2019
Attachments	Response To Motion To Compel - As Filed Feb 21 2019.pdf(99429 bytes) Response To Motion To Compel Exhibits Only - As Filed Feb 21 2019.pdf(4024135 bytes)

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

In the matter of Registration Number 4152902 Registered June 5, 2012, for the mark "ENVI"		
Prime Direct Brands, LLC, Petitioner/Plaintiff	§	Cancellation No. 92068992
v.	§	
IQ Products Company, Registrant/Defendant	§	

REGISTRANT IQ PRODUCTS'RESPONSE TO

PETITIONER'S MOTION TO COMPEL DISCOVERY

Pursuant to TBMP § 502.02(b) and 37 C.F.R. § 2.127(a), IQ Products Company ("Registrant") hereby responds to Petitioner Prime Direct Brands' Motion To Compel.

BACKGROUND

Did Petitioner Fail To Conduct *An Inquiry Reasonable Under The Circumstances*?

Petitioner instituted this Cancellation Proceeding based on two phone calls with "Respondent's representative" ("Lynn" or "Lynn Carlson"), in which "Respondent's representative" allegedly informed Petitioner that "*Respondent had neither manufactured nor sold any hair products under the ENVI name in years and could not identify any retailers where ENVI hair products could be purchased*", and that "*Respondent had not made the ENVI hair products in years, that the pictures are just up on the website, and that [Petitioner] could*

not buy ENVI hair products anywhere". See, Petition For Cancellation at ¶¶ 15 & 16.

Petitioner embellishes this "story" in this Motion To Compel by now having Ms. Carlson speak to not only "hair products" in general, but to each species of the "hair care products" exactly as listed in the registration, and further to "nail care preparations, namely nail polish enamel driers; shaving preparations, namely shaving creams and shaving gels"… that is, Petitioner now conveniently has Ms. Carlson speaking about lack of sales for each and every good that is listed in the registration. See, Petition to Compel at page 2, 2nd full paragraph.

HOWEVER, what Petitioner **does not ever reveal** is that Ms. Carlson is a part-time clerical employee, does not fully understand Registrant's business and is not empowered to be "Respondent's representative", and that Ms. Carlson was grossly mistaken as to what products Registrant had sold and was selling.

Registrant's attorney Mark Gilbreth informed Petitioner's attorney Mr. Hickey of this as early as August 28, 2018 both in a teleconference and in an email:

> *As we also discussed,* ***Lynn Carlson is a part time clerical employee who does not understand or appreciate all that IQ does, is certainly not a representative of IQ, and certainly is not empowered to speak on behalf of IQ****. My client believes that prior to the filing of this Petition, that an inquiry reasonable under the circumstances required confirmation of Ms. Carlson's alleged comments with my client's sales and marketing department.*
>
> See, Exhibit 1, Gilbreth Email of Aug 28, 2018.

In the August 28, 2018, teleconference with Mark Gilbreth, Petitioner's attorney Mr. Hickey confirmed that Petitioner did not know Ms. Carlson's position when Petitioner deemed her to be Registrant's "representative", and confirmed that Petitioner did not attempt to confirm Ms. Carlson's comments with Registrant's sales/marketing department, and confirmed that Petitioner failed to contact any of Registrant's sales/marketing representatives regarding Registrant's products, but rather filed the instant Petition For Cancellation based on Ms. Carlson's alleged statements.

Prior To Any Discovery, Registrant <u>Voluntarily</u> Provided Two Examples of Uses In Commerce To Petitioner That Shows There Was No Abandonment of the ENVI Mark

In an effort to show the Petitioner that it should have done more due diligence, and that Petitioner's careless reliance on Ms. Carlson's statements were a mistake, and that Ms. Carlson was clearly mistaken, Registrant provided Petitioner with two uses in commerce, one for 10/1/2013, and the other for 9/7/2017. See, Exhibit 2, Bills of Lading.

The 9/7/2017 Bill of Lading shows shipment of 1,330 cases each being a 24 pack case of ENVI products (i.e., **31,920 units**), with the total shipping weight being **7,682 lbs**. This is no small shipment.

<u>**NOTICE**, that this 9/7/2017 shipment of 7,682 lbs. of 31,920 units of ENVI products occurs a mere 9½ months prior to Ms. Carlson's alleged 6/29/2018 statement relied upon by Petitioner to bring this Petition that</u>:

"*Respondent had not made the ENVI hair products in years, that the pictures are just*

up on the website, and that [Petitioner] could not buy ENVI hair products anywhere".

See, Petition For Cancellation at ¶¶ 15 & 16.

Clearly, Ms. Carlson was **mistaken**, and **Petitioner relied on a statement from a part-time clerical employee**, and without conducting an *inquiry reasonable under the circumstances* regarding her position, and without further inquiry to Registrant's sales/marketing department, and files this Petition to Cancel.

Please notice, that Petitioner's sole basis for alleging non-use and abandonment is Petitioner's mistaken reliance on Ms. Carlson's mistaken statements, on which Petition never conducted *inquiry reasonable under the circumstances* regarding her position, and without further inquiry to Registrant's sales/marketing department.

Clearly, Registrant did not and has not abandoned its ENVI registration.

Fraud on the USPTO?

Based on these same mistaken Ms. Carlson statements, Petitioner also is alleging that Registrant committed fraud with respect to the 2018 Renewal.

Without discussion of Registrant's decisions behind deciding which goods were to be deleted and which goods were not to be deleted, Registrant notes that the publically available Section 8/15 Declaration as found in TESS online shows that twenty-one (21) goods were deleted by Registrant in the filing of the Section 8/15 with only 7 goods remaining. In other

words, to any casual viewer it would appear that Registrant examined the description of goods, and made good faith effort to decide which goods to delete or not. In fact, Registrant deleted 75% of the goods that were listed in the Registration. See, following, as taken from the Section 8/15 on file in PAIR:

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

Registrant reminds Petitioner that in order to succeed on its fraud allegation, Petitioner bears a "heavy burden of proof", and Petitioner will have to prove it "to the hilt" with clear and convincing evidence.[1]

Please notice, that Petitioner's sole basis for alleging fraud is Petitioner's mistaken reliance on Ms. Carlson's mistaken statements, on which Petition never conducted *inquiry reasonable under the circumstances* regarding her position, and without further inquiry to Registrant's sales/marketing department.

Clearly, Registrant did not commit fraud.

[1] See, *In re Bose Corp*., 580 F. 3d 1240, 1243 (Fed.Cir. 2009) (A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co., 54 C.C.P.A. 1442, 377 F.2d 1001, 1004 (1967). Indeed, "the very nature of the charge of fraud requires that it be proven `to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." Smith Int'l, Inc. v. Olin Corp., 209 USPQ 1033, 1044 (T.T.A.B.1981)).

STATEMENT BY COUNSEL REGARDING ATTEMPT TO RESOLVE

It is true that Mr. Hickey reached out to me to "meet and confer" which I took to be in good faith, but accompanying that invitation was the threat of filing a Motion to Compel.

> *If we are unable to resolve our differences, we will be forced to file a motion to compel.*
>
> See, Exhibit 3, Hickey Email 1/17/2019 @ 740PM.

I quickly decided that I needed to discuss the proposed "meet and greet" and the threatened motion to compel with my client IQ, so I responded:

> *Michael,*
>
> *I will discuss with my client and let you know.*
>
> See, Exhibit 3, Gilbreth Email 1/17/2019 @ 7:51PM.

Surprisingly, Mr. Hickey sent me the following one minute later:

> *Mark,*
>
> *What do you need to discuss with your client? I'm asking for your availability to discuss your client's responses. When are you available? You don't need to talk to your client to check your own schedule.*
>
> See, Exhibit 3, Hickey Email 1/17/2019 @ 7:52PM (emphasis in original).

I responded and tentatively set up a 2pm teleconference for the next day.

> *Michael,*
>
> *I fully understand you[r] question. You are correct.*
>
> *However I will need to confirm that they want me to speak with you.*

I will speak with them in the morning. Unless they instruct me otherwise you/I can talk at 2pm.

See, Exhibit 3, Gilbreth Email 1/17/2019 @ 8:01PM.

The next morning after receiving Registrant's instructions, I emailed the following:

Michael,

IQ does not see a reason for us to talk ***today.***

See, Exhibit 3, Gilbreth Email 1/18/2019 @ 9:10AM (emphasis added).

Certainly, Registrant did not mean the message to foreclose all discussion related to the Requests for Production.

Discussion of the Document Requests

NOTE 1: Registrant maintains the general objections, and specific responses and objections as made in the Response filed, with those to be considered incorporated herein.

NOTE 2: Registrant has used the Mark "ENVI" since 1994 with a wide variety of goods, including goods not listed in the registration. Registrant conservatively estimates sales of ENVI products in the neighborhood of 40 million units. Thus, Requests that seek "all" documents that are not time limited and limited to the products of the registration, are burdensome to Registrant.

NOTE 3: Petitioner is a business competitor who is attempting to enter the hair products business in which Registrant has conducted business for over 25 years. By adopting the mark "ENVIE" it is clear that Petitioner is attempting to ride on the fame of Registrant's mark "ENVI". While the only grounds for cancellation currently plead are for Abandonment and Fraud in the filing of the Section 15 Declaration, Petitioner's document request are not limited to those grounds of cancellation, but rather appear to be directed at gathering strategic and business confidential information from Registrant in order to benefit its own business. For example, Petitioner is seeking pricing information when price of goods has nothing to do with the plead Abandonment or Fraud grounds. Registrant's view is that even documents produced under a "confidentiality agreement" are at risk of being exposed. Thus, it is critical that Petitioner's requests be very narrowly restricted to only those documents and things that relate to the plead grounds of Abandonment and Fraud in the filing of the Section 15 Declaration.

NOTE 4: Registrant currently has a Document Handling Policy company-wide to purge unneeded documents after three years. This includes written (hardcopy) documents, as well as electronic correspondence. Some of the Requests may be affected by this policy.

NOTE 5: The only currently pleaded grounds for cancellation are **ABANDONMENT** and **FRAUD IN THE FILING OF THE SECTION 15 DECLARATION**. It is Registrant's position that Requests for production must be related to those two grounds for cancellation.

Request No. 36. *All files relating to Lynn Carlson, including any records relating to Ms. Carlson kept by Registrant and including any human resources files, personnel files, disciplinary files, or employment review files*.

Ms. Carlson is a part-time clerical employee of Registrant. Registrant fails to see how Ms. Carlson's human resources files, personnel files, disciplinary files, or employment review files relate to any of the issues of this proceeding. Registrant assumes that this Request also encompasses payroll information, medical insurance information, and the like. None of these documents are relevant to the pleaded grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. The issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? Ms. Carlson's "files" are irrelevant to any of those three issues. Regarding those issues, it really doesn't matter what Ms. Carlson has said, the evidence will speak for itself in spite of anything Ms. Carlson may or may not have said. Ms. Carlson is not an officer, manager, agent, spokesperson, representative, or director of Registrant. "All files relating to Lynn

Carlson" is clearly too broad on its face, and very intrusive into Ms. Carlson's privacy.

Request No. 25. *Copies of price lists or other Documents showing the price of the Products used in connection with the Mark from June 6, 2012, to May 30, 2018.*

The prices of Registrant's Products are clearly not relevant to any issue in this Proceeding regarding the grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. Again, the issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? The price of Registrant's goods does not prove or disprove any issue in this Proceeding the issue is whether or not Registrant's goods were sold or transported in commerce.

Request No. 6. *All documents related to businesses other than Petitioner and Registrant that use and have used formatives of "ENVY," "ENVIE," and "ENVI" in their trademarks and trade names, including as identified in Registrant's Initial Disclosures.*

This request appears to relate to the issue of genericness or perhaps the issue of likelihood of confusion, neither issue of which is currently being plead as a ground for cancellation by Petitioner. None of these documents are relevant to the pleaded grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. Again, the issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? Documents that relate to third parties who use *formatives of "ENVY,"*

"ENVIE," and "ENVI" in their trademarks and trade names are not relevant to any ground for cancellation currently in this Proceeding.

Du Pont Factors -- Request Nos. 4, 5, 7, 28, 30 and 33

Not relevant as Petitioner is not alleging "likelihood of confusion

Request No. 4. *All documents related to the relevant channels of trade in which Registrant's Mark is used, including as identified in Registrant's Initial Disclosures*;

Request No. 5. *All documents related to the sophistication of Petitioner's customers and Registrant's customers, including as identified in Registrant's Initial Disclosures*;

Request No. 7. *All documents related to other evidence of likelihood of confusion or lack thereof, including as identified in Registrant's Initial Disclosures*;

Request No. 28. *Documents sufficient to show the types and classes of consumers to which Registrant marketed and sold the Products bearing the Mark from June 6, 2012, to May 30, 2018*;

Request No. 30. *Documents relating or referring to the channels of trade for Registrant's Products bearing the Mark, including without limitation documents indicating the chain of distribution from Registrant through any intermediary, the marketing of the Products bearing the Mark and ultimate sale to the consumer from June 6, 2012, to May 30, 2018*; and,

Request No. 33. *Documents relating or referring to instances of actual confusion between Registrant's use of the Mark and Petitioner's use of its ENVIE mark.*

These Requests appear to relate to the "***du Pont Factors***" for likelihood of confusion. **Petitioner has made no allegation, and is not seeking to cancel the Registration by alleging that Registrant's mark so resembles a mark registered in the Office, or a**

mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. TBMP § 309.03(c)(1). "Likelihood of Confusion" is currently not an issue in or grounds for cancellation in this Proceeding. None of these documents are relevant to the plead grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. Again, the issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? These Requests relating to the du Pont factors are not relevant to the issues in this Proceeding, nor the grounds for cancellation of abandonment and fraud.

Request No. 3. *All documents related to the renewal of Registrant's Mark, including as identified in Registrant's Initial Disclosures*.

Petitioner may easily and readily obtain from public sources (i.e. www.uspto.gov) the documents related to the renewal as filed in the Trademark Office. To the extent that there might be documents passing between Registrant and its attorney regarding the renewal, or created by its attorney in the preparation of the Renewal, those are clearly immune from and/or protected from discovery by the attorney-client privilege and/or work product doctrine.

Request No. 26. *Documents relating or referring to, or comprising, any assignments, licensing agreements, consent agreements, or other contractual agreements between Registrant and third parties which relate to the use, registration, or ownership of the Mark.*

This Request appears to be directed to issues regarding ownership, control of the Mark, and/or allowing the Mark to be used incorrectly. However, Registrants notes that Petitioner has not plead as grounds for cancellation, that Registrant does not own the Mark, that Registrant either does not, or cannot, control the trademark, or that Registrant is allowing the mark to be used incorrectly. None of these documents are relevant to the pleaded grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. Again, the issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? The Requested documents are not relative to any issues relating to the currently plead grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration.

Request Nos. 2 and 8

Request No. 2. *All documents related to the use of Registrant's Mark, including as identified in Registrant's Initial Disclosures*; and,

Request No. 8. *All documents relating to the use or intended use of the Mark in connection with Registrant's business in interstate commerce or any other use of the Mark.*

First, the "use" in these Requests is not limited to the goods listed in the registration, nor is it limited to the relevant time period starting with the issue date of the Registration (6/5/2012) and ending with the filing of the Section 8/15 (May 30, 2018). It is open ended on time, and includes ENVI goods not listed in the Registration. To understand the burden on Registrant, Registrant has used the Mark "ENVI" since 1994, and conservatively estimates 25 years of sales of ENVI products on the order of 40 million

units. Thus, the request for "all documents related to the use of Registrant's Mark" is burdensome and will require an inordinate amount of research. Registrant is not required to prove up "all" uses or intended uses of its Mark. Only relevant uses would be those uses sufficient to prevent abandonment, and to show continuous use.

Request No. 1. *All documents related to the selection of Registrant's Mark, including as identified in Registrants Initial Disclosures*.

The Petition currently only pleads grounds for cancellation of Abandonment and Fraud (relating to the §15 Declaration), with the issues being (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? Petitioner is not currently pleading cancellation related to the selection of Registrant's Mark. The requested documents are not relevant to the pleaded grounds of Abandonment and Fraud in the filing of the Section 15 Declaration.

Request Nos. 34 & 35 (stores and retail establishments)

Request No. 34. *Documents sufficient to identify all stores and retail establishments (whether on- line or brick-and-mortar) that sold Registrant's Products bearing the Mark from June 6, 2012, to May 30, 2018*; and,

Request No. 35. *Documents sufficient to identify all stores and retail establishments (whether on- line or brick-and-mortar) that sold Registrant's Products bearing the Mark from May 31, 2018, to the present*.

The identity of "all" stores and retail establishments that sold Registrant's Products is not relevant to any issue in this Proceeding. Again, the issues are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration? Registrant is not required to prove up all of its sales nor is it required to prove up all of its customers. In addition for Request No. 35, the request is for documents after the filing of the Section 8/15 Declaration, which is not relevant to any issue in this proceeding. The requested documents are not relevant to the pleaded grounds of Abandonment and Fraud in the filing of the Section 15 Declaration.

Request No. 29. *All invoices, purchase orders, or documents showing the sale of Products bearing the Mark from June 6, 2012, to May 30, 2018.*

This is clearly too broad and burdensome as Registrant is not required to prove up all of its sales. Only relevant sales would be those sufficient to prevent abandonment, and to show continuous use.

Request Nos. 9, 10, 15 & 16 (Samples)

Request No. 9. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between June 6, 2012, and December 31, 2012*;

Request No. 10. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce in 2013*;

Request No. 15. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between January 1, 2018, to May 30, 2018*; and,

Request No. 16. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between May 31, 2018 and the present.*

Registrant explains, Envi Shampoo and Envi Conditioner products are hypoallergenic and made without preservatives. The shelf life for these custom-made, non-aerosol products is less than one year. In comparison, aerosol products that Registrant manufactures and currently possesses over one million units of finished goods under various brands are vacuum packaged in an anaerobic environment, giving these products a multi-year shelf life. Registrant offers Envi Shampoo and Envi Conditioner products for sale and manufactures them only when orders are received, and does not maintain unsold inventory. In addition, Request No. 16 calls for Samples after the filing of the Section 8/15 Declaration, which are not relevant to any issue in this proceeding.

Request Nos. 11-14 (Samples)

Request No. 11. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between 2014*;

Request No. 12. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between 2015*;

Request No. 13. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between 2016*; and,

Request No. 14. *Samples of the Products bearing the Mark that were offered for sale or sold in interstate commerce between 2017.*

Request Nos. 11-14 above are vague and indefinite, and Registrant invited Petitioner to rewrite them and present them in a second set of document requests. In addition, Registrant explains,

Envi Shampoo and Envi Conditioner products are hypoallergenic and made without preservatives. The shelf life for these custom-made, non-aerosol products is less than one year. In comparison, aerosol products that we manufacture and currently possess over one million units of finished goods under various brands are vacuum packaged in an anaerobic environment, giving these products a multi-year shelf life. Registrant offers Envi Shampoo and Envi Conditioner products for sale and manufactures them only when orders are received, and does not maintain unsold inventory.

Request No. 32. *Documents sufficient to identify all sales and marketing personnel who were responsible for sales and marketing of Products bearing the Mark from June 2012 to May 30, 2018.*

This Request is too broad in that it subjects sales and marketing personnel to having their entire records turned over to Petitioner. Documents responsive to this request do not address the issues in question, which are (1) did Registrant abandon the mark? (2) did Registrant lack continuous use? and (3) did Registrant commit fraud with respect the Section 15 Declaration?

Request No. 31. *Documents relating or referring to trade shows, exhibitions, and similar events that Registrant exhibited at or participated in between June 6, 2012, to May 30, 2018, and at which Registrant promoted the Products bearing the Mark.*

These requests for [all] documents relating to or referring to trade shows, exhibitions, and similar events as requested for nearly the entire life of the Registration are unduly burdensome

as unnecessary as it relates to the grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. It is true that should Petitioner establish three years of non-use, then these documents and things can be used to show intent to resume use during that time. However, at this time, Petitioner has merely alleged *for at least the last three consecutive years, Respondent has not used the ENVI mark . . .* See, Petition at §12. Until such time as Petitioner has identified a defined period of time of non-use (of at least 3 consecutive years), Respondent should not be required to produce such documents, and at such time as Petitioner does, production should be limited to that specific defined timeframe of non-use.

Request Nos. 17-24

Request No. 17. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce between June 6, 2012, and December 31, 2012*;

Request No. 18. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce in 2013*;

Request No. 19. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce in 2014*;

Request No. 20. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce in 2015*;

Request No. 21. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce in 2016*;

Request No. 22. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce in 2017*;

Request No. 23. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce between January 1, 2018, to May 30, 2018*; and,

Request No. 24. *Specimens of advertising for the Products used in connection with the Mark that were offered for sale or sold in interstate commerce between May 31, 2018, and the present.*

These requests for [all] specimens of advertising for the Products used in connection with the Mark for the entire life of the Registration are unduly burdensome as unnecessary as it relates to the grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. It is true that should Petitioner establish three years of non-use, then these specimens can be used to show intent to resume use during that time. However, at this time, Petitioner has merely alleged *for at least the last three consecutive years, Respondent has not used the ENVI mark . . .* See, Petition at §12. Until such time as Petitioner has identified a defined period of time of non-use (of at least 3 consecutive years), Respondent should not be required to produce advertising specimens, and at such time as Petitioner does, production should be limited to that specific defined timeframe of non-use.

Request No. 27. *Documents and things relating or referring to Registrant's marketing and promotion of its Products bearing the Mark from June 6, 2012, to May 30, 2018.*

These requests for [all] documents and things relating to or referring to Registrant's marketing and promotion of its products for nearly the entire life of the Registration are unduly burdensome as unnecessary as it relates to the grounds for cancellation of Abandonment and Fraud in the filing of the Section 15 Declaration. It is true that should Petitioner establish three years of non-use, then these documents and things can be used to show intent to

resume use during that time. However, at this time, Petitioner has merely alleged *for at least the last three consecutive years, Respondent has not used the ENVI mark . . .* See, Petition at §12. Until such time as Petitioner has identified a defined period of time of non-use (of at least 3 consecutive years), Respondent should not be required to produce the requested documents, and at such time as Petitioner does, production should be limited to that specific defined timeframe of non-use.

Respectfully submitted,

Date: February 21, 2019

/J. M. (MARK) GILBRETH/
J. M. (Mark) Gilbreth
Attorney for Registrant
Member of Texas Bar

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REGISTRANT IQ PRODUCTS' RESPONSE TO PETITIONER'S MOTION TO COMPEL DISCOVERY has been served on all attorneys of record for Petitioner, including Mr. Michael J. Hickey, as well as on the Lewis Rice "IP Dept" email, by forwarding said copy on February 21, 2019, via email as shown:

mhickey@lewisrice.com
ipdept@lewisrice.com
fjanoski@lewisrice.com
kdamman@lewisrice.com
bhoy@lewisrice.com
bsiders@lewisrice.com
mdurbin@lewisrice.com

LEWIS RICE LLC
600 Washington Ave Ste 2500, Box IP Dept
St. Louis, MO 63101

/J. M. (MARK) GILBRETH/
J. M. (Mark) Gilbreth

Gmail

EXHIBIT 1

Jmark Gilbreth <jmark77001@gmail.com>

Re: TTAB Cancellation 92068992 (ENVI)

1 message

Mark Gilbreth <jmark@gilbreth.org> Tue, Aug 28, 2018 at 4:46 PM
To: mhickey@lewisrice.com

Michael,

Nice speaking with you today.

Thanks for agreeing to accept email service. You will receive an Answer later today.

As we also discussed, Lynn Carlson is a part time clerical employee who does not understand or appreciate all that IQ does, is certainly not a representative of IQ, and certainly is not empowered to speak on behalf of IQ. My client believes that prior to the filing of this Petition, that an *inquiry reasonable under the circumstances* required confirmation of Ms. Carlson's alleged comments with the my client's sales and marketing department.

As we further discussed, IQ is gathering sales documents to prove that it has not abandoned the mark.

J. M. (Mark) Gilbreth
Gilbreth Roebuck, P.C.
6750 West Loop South, Suite 920
Bellaire, TX 77401
Offc: 713 667 1200 x 102
Cell: 713 503 5051
Secretary: joann.garcia@gilbreth.org

On Tue, Aug 28, 2018 at 1:18 PM, Mark Gilbreth <jmark@gilbreth.org> wrote:

> Mr. Hickey,
>
> A heads up that I will be filing an Answer today in Cancellation No. 92068992 (ENVI).
>
> Will you agree that service is effective by email for filings by either of us?
>
> My email is jmark@gilbreth.org. It's easiest to reach me by cell at 713 503 5051.
>
> If you agree, please let me know the email(s) at which you wish to receive service.

J. M. (Mark) Gilbreth
Gilbreth Roebuck, P.C.
6750 West Loop South, Suite 920
Bellaire, TX 77401
Offc: 713 667 1200 x 102
Cell: 713 503 5051
Secretary: joann.garcia@gilbreth.org

EXHIBIT 2

STRAIGHT BILL OF LADING

DATE: 09/07/2017 | BILL OF LADING #: 0123456 | LOAD #:

SHIP FROM: IQ PRODUCTS COMPANY
16212 STATE HIGHWAY 249
HOUSTON, TEXAS 77086-1014
TEL: (281) 444-6454
FAX: (281) 444-0155

SOLD TO:

SHIP TO:

VENDOR SHIP POINT #:

FREIGHT TERMS: PPD ☐ COL ☒

CARRIER:

TRAILER #:

MASTER BILL OF LADING: ☐

☐ SLSC ☐ SLDC SEAL #

CARRIER ARRIVAL DATE: / / TIME: : AM PM

MERCHANDISE DEPARTURE DATE: / / TIME: : AM PM

PO #:	ITEM #:	HM X	SHIPPING DESCRIPTION: CONSUMER COMMODITY ORM-D	ENTER AMOUNT OF EACH CASES	PALLETS	WEIGHT (LBS.)
	118709		ENVI U-FIRM HOLD HS 2.1 OZ, 24PK	369	3	1993
	118754		ENVI DRY MIST TRV A&D 2.1 OZ, 24PK	545	4	2943
	118446		ENVI/M COOL SS 2.1 OZ, 24PK	416	3	2246
			TOTAL PALLETS:		10	500

THIS SHIPMENT IS: PARTIAL COMPLETE | TOTALS: 1330 | 10 | 7682

RECEIVED, subject to classifications and tariffs in effect on the date of the issue of this Bill of Lading.
the property described above, in apparent good order, except as noted (contents and condition of contents of packages unknown), marked, consigned, and destined as indicated below, which said carrier (the word carrier being understood throughout this contract as meaning any person or corporation in possession of the property under the contract) agrees to carry to its usual place of delivery at said destination, if on its route, otherwise to deliver to route to destination, and as to each party at anytime interested in all or any of said property, that every service to be performed hereunder shall be subject to all the terms and conditions of the Uniform Domestic Straight Bill of Lading set forth (1) in the Uniform Freight Classifications in effect on the date hereof, if this is a rail or a rail-water shipment, or (2) in the applicable motor carrier classification or tariff if this is a motor carrier shipment.

SHIPPER hereby certifies that he is familiar with all the terms and conditions of the said bill of lading set forth in the classification or tariff which governs the transportation of this shipment, and the said terms and conditions are hereby agreed to by the shipper and accepted for himself and his assigns.

This is to certify that the above-named materials are properly classified, described, packaged, marked and labeled, and are in proper condition for transportation according to the applicable regulations of the Department of Transportation.

SPECIAL INSTRUCTIONS:

PLEASE MAKE SURE PACKING SLIP IS ATTACHED

SHIPPER SIGNATURE: [signature] DATE: 9-11-17

DRIVER SIGNATURE: [signature] DATE: 9/11/17

ORIGINAL

EXHIBIT 2

STRAIGHT BILL OF LADING

DATE: 10/01/13 | BILL OF LADING #: 999912 | LOAD #:

SHIP FROM: IQ PRODUCTS COMPANY
16212 STATE HIGHWAY 249
HOUSTON, TEXAS 77086-1014
TEL: (281) 444-6454
FAX: (281) 444-0135

SOLD TO:

SHIP TO:

VENDOR SHIP POINT #:

FREIGHT TERMS: PPD ☐ COL ☒

TRAILER #: 5835

MASTER BILL OF LADING: ☐

☐ SLSC ☐ SLDC SEAL #

CARRIER ARRIVAL DATE: / / TIME: : AM PM

MERCHANDISE DEPARTURE DATE: / / TIME: : AM PM

PO #:	ITEM #:	HM X	SHIPPING DESCRIPTION:	ENTER AMOUNT OF EACH CASES	PALLETS	WEIGHT (LBS.)
			CONSUMER COMMODITY ORM-D			
	154533		CLEANING COMPOUNDS, NOI, NMFC #48580 CS FOAMING LTHR & VINYL CLNR	652		
	154530		CLEANING COMPOUNDS, NOI, NMFC #48580 CS FOAMING RUG & CRPT CLNR 1	120		
	154536		CLEANING COMPOUNDS, NOI, NMFC #48580 CS FOAMING MULTI-PURPOSE FUR	921		
	108234		ENVI WASHES TOILET PREPARATIONS, NMFC #60000 ENVI BABY WASH 5 FL OZ	267		
	118236		TOILET PREPARATIONS, NMFC #60000 ENVI STYLING MSE 48 x 2 OZ	99		
	118236		TOILET PREPARATIONS, NMFC #60000 ENVI STYLING MSE 48 x 2 OZ	169		
	118196		TOILET PREPARATIONS, NMFC #60000 ENVI STYLING HS UH 4x6x2 OZ	542		

THIS SHIPMENT IS: PARTIAL COMPLETE | TOTALS:

RECEIVED, subject to classifications and tariffs in effect on the date of the issue of this Bill of Lading, the property described above, in apparent good order, except as noted (contents and condition of contents of packages unknown), marked, consigned, and destined as indicated below, which said carrier (the word carrier being understood through-out this contract as meaning any person or corporation in possession of the property under the contract) agrees to carry to its usual place of delivery at said destination, if on its route, otherwise to deliver to route to destination, and as to each party at anytime interested in all or any of said property, that every service to be performed hereunder shall be subject to all the terms and conditions of the Uniform Domestic Straight Bill of Lading set forth (1) in the Uniform Freight Classifications in effect on the date hereof, if this is a rail or a rail-water shipment, or (2) in the applicable motor carrier classification or tariff if this is a motor carrier shipment.

SHIPPER hereby certifies that he is familiar with all the terms and conditions of the said bill of lading set forth in the classification or tariff which governs the transportation of this shipment, and the said terms and conditions are hereby agreed to by the shipper and accepted for himself and his assigns.

This is to certify that the above-named materials are properly classified, described, packaged, marked and labeled, and are in proper condition for transportation according to the applicable regulations of the Department of Transportation.

SPECIAL INSTRUCTIONS:

THIS IS ACTUALLY A BABY SHAMPOO

PLEASE MAKE SURE PACKING SLIP IS ATTACHED

SHIPPER SIGNATURE: [signature] DATE: 10/01/13

DRIVER SIGNATURE: [signature] DATE: 10-1-13

ORIGINAL

Gmail

EXHIBIT 3

Jmark Gilbreth <jmark77001@gmail.com>

Re: IQ's Response to First Set of Document Requests

1 message

Mark Gilbreth <jmark@gilbreth.org> Fri, Jan 18, 2019 at 9:10 AM
To: "Hickey, Michael J." <MHickey@lewisrice.com>
Cc: "Hoy, Bridget" <bhoy@lewisrice.com>
Bcc: "P. Yohanne Gupta" <Gupta@iqproducts.org>, John Brogan <JohnBrogan@iqproducts.org>

Michael,

IQ does not see a reason for us to talk today.

On Thu, Jan 17, 2019, 8:13 PM Hickey, Michael J. <MHickey@lewisrice.com wrote:

> Mark,
>
> Let me know if your client does not want you to talk with me. Otherwise, I will plan on calling you at 2pm tomorrow on your cell.
>
> Two additional questions that you can also ask your client is (1) whether your client will agree to the default protective order that we first sent to you on September 27, 2018, more than 3 ½ months ago; and (2) whether, pursuant to this Protective Order, your client is willing to produce any documents responsive to my client's document requests. In other words, the Protective Order should resolve any confidentiality, proprietary, or trade secret objections, and thereby make those documents available to produce, unless your client is going to continue to rely upon on other objections and refuse to produce anyway.
>
> You might also advise your client that its recalcitrance and refusal to cooperate in basic discovery will only make my client more suspicious of your client's purported continuous use over the 5 year period in question. If your client is truly able to prove its continuous use, they should simply produce the documents requested.
>
> LEWIS RICE Michael J. Hickey
> mhickey@lewisrice.com
>
> 600 Washington Avenue
> Suite 2500
> St. Louis, Missouri 63101-1311
> 314.444.7630 (direct)
> 314.612.7630 (fax)
> www.lewisrice.com
>
> **From:** Mark Gilbreth <jmark@gilbreth.org>
> **Sent:** Thursday, January 17, 2019 8:01 PM
> **To:** Hickey, Michael J. <MHickey@lewisrice.com>
> **Cc:** Hoy, Bridget <bhoy@lewisrice.com>
> **Subject:** Re: IQ's Response to First Set of Document Requests
>
> Michael,
>
> I fully understand you question. You are correct.
>
> However I will need to confirm that they want me to speak with you.
>
> I will speak with them in the morning. Unless they instruct me otherwise you/I can talk at 2pm.
>
> On Thu, Jan 17, 2019, 7:52 PM Hickey, Michael J. <MHickey@lewisrice.com wrote:
>
> > Mark,

What do you need to discuss with your client? I'm asking for your availability to discuss your client's responses. When are you available? You don't need to talk to your client to check your own schedule.

EXHIBIT 3

LEWIS RICE Michael J. Hickey
mhickey@lewisrice.com

600 Washington Avenue
Suite 2500
St. Louis, Missouri 63101-1311
314.444.7630 (direct)
314.612.7630 (fax)
www.lewisrice.com

From: Mark Gilbreth <jmark@gilbreth.org>
Sent: Thursday, January 17, 2019 7:51 PM
To: Hickey, Michael J. <MHickey@lewisrice.com>
Cc: Hoy, Bridget <bhoy@lewisrice.com>
Subject: Re: IQ's Response to First Set of Document Requests

Michael,

I will discuss with my client and let you know.

On Thu, Jan 17, 2019, 7:40 PM Hickey, Michael J. <MHickey@lewisrice.com wrote:

> Mark,
>
> Since your client is refusing to produce any documents responsive to my client's document requests, please let me know when you are available for a meet and confer regarding these requests. If we are unable to resolve our differences, we will be forced to file a motion to compel.
>
> Regards,
>
> Michael

LEWIS RICE Michael J. Hickey
mhickey@lewisrice.com

600 Washington Avenue
Suite 2500
St. Louis, Missouri 63101-1311
314.444.7630 (direct)
314.612.7630 (fax)
www.lewisrice.com

From: Mark Gilbreth <jmark@gilbreth.org>
Sent: Thursday, January 17, 2019 7:26 PM
To: Hickey, Michael J. <MHickey@lewisrice.com>; IPDEPT <IDept@lewisrice.com>; Janoski, Frank B. <fjanoski@lewisrice.com>; Damman, Kirk A. <KDamman@lewisrice.com>; Hoy, Bridget <bhoy@lewisrice.com>; Siders, Benjamin J. <bsiders@lewisrice.com>; Durbin, Michael H. <MDurbin@lewisrice.com>
Subject: IQ's Response to First Set of Document Requests

Michael,

Attached please find REGISTRANT IQ PRODUCTS'RESPONSES AND OBJECTIONS TO PETITIONER PRIME DIRECT BRAND'S FIRST SET OF DOCUMENT REQUESTS.

EXHIBIT 3

J. M. (Mark) Gilbreth

Gilbreth Roebuck, P.C.

6750 West Loop South, Suite 920

Bellaire, TX 77401

Offc: 713 667 1200 x 102

Cell: 713 503 5051

Secretary: joann.garcia@gilbreth.org

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