

ESTTA Tracking number: **ESTTA1124363**

Filing date: **04/01/2021**

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

|                        |   |
|------------------------|---|
| Proceeding             | 91253873  |
| Party                  | Defendant<br>Hair Codes   |
| Correspondence Address | MARK C JOHNSON<br>111 N PINE ISLAND ROAD, SUITE103<br>PLANTATION, FL 33324<br>UNITED STATES<br>Primary Email: MJ@JohnsonDalal.com<br>954-507-4500 |
| Submission             | Reply in Support of Motion  |
| Filer's Name           | Mark C. Johnson   |
| Filer's email          | Info@JohnsonDalal.com   |
| Signature              | /Mark C. Johnson/   |
| Date                   | 04/01/2021  |
| Attachments            | Reply in Support of MET.pdf(288779 bytes )<br>Ex. A.pdf(558590 bytes )  |

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

The Procter & Gamble Company,  
  
Opposer,  
  
v.  
  
Hair Codes LLC,  
  
Applicant.

Opposition No. 91253873  
  
Mark: HAIR CODES  
  
U.S. Application Serial No. 88524984  
  
Application Filing Date: July 19, 2019

**APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO EXTEND THE CLOSE OF  
DISCOVERY AND RESET TRIAL DATES**

Applicant, Hair Codes LLC (hereinafter, “Applicant”), by and through its counsel and pursuant to 37 C.F.R. § 2.120(a)(1), TBMP § 509.01(a), and Fed. R. Civ. P. 6(b), hereby files its reply in support of its Motion to Extend the Close of Discovery [20 TTABVUE] by sixty (60) days and to reset trial dates in accordance therewith. In support thereof, Applicant states as follows.

**MEMORANDUM OF LAW AND FACT**

On February 22, 2021, Applicant filed its Motion to Extend the Close of Discovery [20 TTABVUE] by sixty (60) days and to reset trial dates in accordance therewith. Thereafter, on March 12, 2021, Opposer The Procter & Gamble Company (“Opposer”) submitted its Response in Opposition [21 TTABVUE] to Applicant’s Motion to Extend the Close of Discovery.

In support of its position, Opposer heavily relies on the decision in *National Football League v. DNH Management LLC*, 85 USPQ2d 1852 (TTAB 2008), wherein the Board denied movant’s ninety-day extension request of the discovery period. *See* 21 TTABVUE, at 4.

Opposer's case analogy, however, is inapposite and can hardly be used to draw a comparable parallel to the facts at issue in this case. First, in *National Football League*, the record indicated that "although discovery opened on April 23, 2007, [movant] did not attempt to initiate any settlement discussions with applicant until more than two months later, on July 2, 2007." In contrast, the Parties in this proceeding had begun engaging in settlement discussions well in advance of the commencement of the discovery period. By the time discovery opened on April 14, 2020, Applicant had already filed two *consented* motions for suspension pending settlement negotiations dated March 9, 2020 [4 TTABVUE] and April 8, 2020 [7 TTABVUE]. See 2 TTABVUE. Accordingly, the Parties did not delay in initiating or engaging in settlement discussions.

Second, in *National Football League*, the non-movant vehemently denied that the parties were actively engaging in settlement discussions, which was the movant's principal basis for the requested extension:

Furthermore, there is nothing in the record to establish or even suggest that applicant, by word or action, guaranteed or assured opposers that it would even consider an offer of settlement. In fact, counsel for opposers admits that despite repeated attempts to call, write and email applicant from July 2, 2007 to October 2, 2007 to discuss settlement, counsel for applicant did not respond to "any of [o]pposers' efforts at communication." In its responsive brief, applicant also denied having any interest in settlement and stated that *at no point during the proceeding did it "engage in or encourage settlement negotiations" with opposers.*

*National Football League*, 85 USPQ2d 1852, at \*5-6.

Here, the record heavily belies Opposer's suggestion that the same or similar facts are implicated in this proceeding. As reflected by the record, a total of five (5) *consented* motions for suspension pending settlement negotiations were filed with the Board, each of which was consented to by Opposer. This fact, alone, reveals the implausibility of Opposer's suggestion that Opposer never had any interest in settlement and never engaged in or encouraged settlement negotiations with Applicant. To be sure, the Parties *did* actively engage in extensive settlement discussions which, at least on Applicant's part, were conducted in good faith and with an eye towards reaching a mutually agreeable resolution of the dispute. Further, Applicant's settlement efforts were not unilateral as they were in *National Football League*, but were reciprocated by Opposer, i.e., both Applicant and Opposer made settlement offers/counteroffers throughout their settlement communications. At the time that Applicant filed its Motion for Extension [20 TTABVUE], the Parties were (and still are) engaged in settlement discussions. "[S]ettlement negotiations *alone* would provide good cause for the extension." *Fantasy Inc. v. DePond*, 2001 TTAB LEXIS 144, \*8-9 (T.T.A.B. Mar. 9, 2001) (granting motion for an extension of the discovery period).

What's more, however, is that Opposer *did* (repeatedly) assure Applicant that it would seriously consider Applicant's offer of settlement, resulting in Applicant's reasonable conclusion that it need not go forward with discovery or trial. A reasonable sampling of said written assurances is reproduced below and attached as **Exhibit A** hereto.

Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>

Tue 10/13/2020 11:55 AM

To: Jade Taylor

Cc: Veronika Balbuzanova; Davis, Govinda <Govinda.Davis@DINSMORE.COM> +2 others



Thank you Ms. Taylor and my apologies for our delay. I did discuss with my client and it is interested in pursuing resolution and had scheduled a meeting with the business team for further direction. I will follow up with my client again today and let you know where things stand by end of day.

Kind regards,  
Karen Gaunt

Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>

Wed 9/9/2020 3:27 PM

To: Jade Taylor; Veronika Balbuzanova; Davis, Govinda <Govinda.Davis@DINSMORE.COM>

Cc: Mark Johnson; Pascal Peng; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>



We can consent to another 30 day extension and I do hope to have a substantive reply to you shortly. My sincere apologies.

Thank you,  
Karen Gaunt

Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>

Mon 8/24/2020 3:37 PM

To: Veronika Balbuzanova; Jade Taylor; Davis, Govinda <Govinda.Davis@DINSMORE.COM>

Cc: Mark Johnson; Pascal Peng; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>



Dear Ms. Balbuzanova,

Thank you for this message and please accept our apologies for our delay in response. We are working on our counterproposal and will endeavor to provide this to you within the week.

Kind regards,  
Karen Gaunt

Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>

Tue 6/16/2020 10:20 AM

To: Veronika Balbuzanova; Davis, Govinda <Govinda.Davis@DINSMORE.COM>

Cc: Mark Johnson; Jade Taylor; Pascal Peng; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>



Thank you, Veronika. We appreciate your time and attention to this matter. We will review and discuss with our client and revert back to you on the substance of the below.

Best regards,  
Karen

In view of the prolonged delay on Opposer's part in providing its response to Applicant's settlement offer, undersigned even inquired, on two separate occasions, as to whether Opposer

was *seriously* considering Applicant's settlement proposal or whether Applicant's time and resources would be better spent on litigating and defending the proceeding. *See id.* and below.

**From:** Jade Taylor <JT@JohnsonDalal.com>  
**Sent:** Friday, October 9, 2020 4:38 PM  
**To:** Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>; Veronika Balbuzanova <VB@JohnsonDalal.com>; Davis, Govinda <Govinda.Davis@DINSMORE.COM>  
**Cc:** Mark Johnson <MJ@JohnsonDalal.com>; Pascal Peng <PP@JohnsonDalal.com>; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hi Ms. Gaunt

Checking in. Any update from your client? It's been about 5 months now of suspensions with the trademark board. Please indicate whether your client is *seriously considering* our settlement proposal or if our time and resources would be better spent on litigating and defending this proceeding.

Really hoping to hear from you soon. Thanks.

Jade Taylor, Paralegal to Mark C. Johnson, Esq.

**From:** Veronika Balbuzanova <VB@JohnsonDalal.com>  
**Sent:** Monday, August 24, 2020 10:44 AM  
**To:** Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>; Jade Taylor <JT@JohnsonDalal.com>; Davis, Govinda <Govinda.Davis@DINSMORE.COM>  
**Cc:** Mark Johnson <MJ@JohnsonDalal.com>; Pascal Peng <PP@JohnsonDalal.com>; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Dear Counsel:

Pursuant to your last e-mail, you indicated that a substantive response would be forthcoming to our settlement proposal during the week of July 20, 2020. It has now been over a month since that correspondence and we have yet to receive any form of substantive response on our settlement proposal and on your client's position on this matter. In fact, we have been awaiting said response **since May** to no avail. Please indicate whether your client is seriously considering our settlement proposal or if our time and resources would be better spent on litigating and defending this proceeding.

Best Regards,

Veronika Balbuzanova, Esq.

It was in response to these inquiries that Opposer's counsel explicitly assured undersigned that Opposer was seriously considering the latest settlement proposal and stated, "I did discuss with my client and *it is interested in pursuing resolution and had scheduled a meeting with the business team for further direction.*" *Id.* In view of Opposer's clear and repeated assurances, it is wholly disingenuous for Opposer to now turn around and argue that Applicant was not diligent in its litigation and settlement efforts. What further assurances was Applicant expected to obtain from Opposer's counsel before it could reasonably conclude that it need not go forward with discovery? And if there are no circumstances under which the

opposing party's assurances can reasonably be relied upon, then what purpose does this factor even serve in the Board's analysis? *See, e.g., National Football League*, 85 USPQ2d 1852, at \*5 (denying motion to extend discovery period where "there is nothing in the record to establish or even suggest that [non-movant], by word or action, guaranteed or assured [movants] that it would even consider an offer of settlement"); *Instruments SA, Inc. v. ASI Instruments, Inc.*, 1999 TTAB LEXIS 77, \*6-7, 53 U.S.P.Q.2D (BNA) 1925, 1927-28 (T.T.A.B. Mar. 8, 1999) (denying motion to extend discovery period because movant "does not establish that applicant assured [movant], by word or deed, that it would seriously consider [movant's] offer of settlement" and because movant "knew, or should have known, that settlement, or even serious talk of settlement, was unlikely").

Opposer's underhanded tactics are further evidenced by its attack on Applicant for attempting to serve its discovery requests and notice of deposition on January 27, 2021. The Reply asserts that Applicant's argument logically fails because "if Applicant believed, as it claims, that the parties would not need to engage in discovery during this period, then it is nonsensical that it would serve requests and a deposition notice on January 27, 2021 while the opposition was suspended." 21 TTABVUE, at 4. To the contrary, Applicant's actions were entirely logical. As explained above, Applicant *did* believe that it would not need to engage in discovery as a result of Opposer's repeated assurances. It was not until January 12, 2021, when Applicant was served with Opposer's initial discovery requests, that Applicant obtained some indication that the parties may need to engage in discovery. At that time, the November 25<sup>th</sup> consented suspension was in effect which provided that discovery was scheduled to close on February 12, 2021. *See* 14 TTABVUE. This meant that Applicant would have to serve its discovery requests by or before January 12, 2021, i.e., *on the exact same day that Opposer*

*served its discovery requests*. If Applicant reasonably and in good faith believed that it would not need to engage in discovery up until it was served with Opposer's discovery requests on January 12<sup>th</sup>, how can it have been reasonably expected to draft, prepare, and serve its own discovery requests that very same day? In propounding discovery on the discovery service deadline, Opposer was well-aware that Applicant would be unable to propound its own discovery that same day and would be severely prejudiced as a result thereof. Opposer should not be afforded refuge from its bad faith litigation tactics on the purported ground that it was Applicant's ultimate responsibility to timely propound discovery. It was because of Opposer's assurances that Applicant reasonably believed that discovery would not be needed. In a calculated tactic, Opposer then took advantage of Applicant's good faith belief to the detriment of Applicant.

Shortly thereafter, on January 27, 2021, Applicant drafted, prepared, and served its discovery requests. Pursuant to the January 21<sup>st</sup> consented suspension [18 TTABVUE], however, proceedings had become suspended and were not scheduled to resume until February 21, 2021, and discovery was scheduled to close on March 15, 2021. This meant that the earliest Applicant could re-serve its discovery requests was February 21<sup>st</sup> but re-serving its requests on February 21<sup>st</sup> would be procedurally improper as it would leave Opposer with less than 30 days to respond prior to the close of discovery. *See* Trademark Rule 2.120(a)(3) ("Interrogatories, requests for production of documents and things, and requests for admission must be served early enough in the discovery period, as originally set or as may have been reset by the Board, so that responses will be due no later than the close of discovery."). As a result, Applicant filed the Motion to Extend that is presently before the Board for consideration wherein said motion was filed prior to the close of discovery. Unsurprisingly, Opposer opposes the requested *extension* of the proceeding (though it is agreeable to a *suspension*) as an extension would rectify the prejudice

that Opposer clearly meant to cause Applicant when it assured Applicant that it was seriously considering Applicant's settlement proposal and then filed its discovery requests on the eve of the discovery service deadline.

Board precedent demonstrates that the factual circumstances that necessitated the filing of Applicant's motion establish good cause for granting a sixty (60) day extension of the discovery period. *See Health Sys. Int'l, Inc. v. FPA Med. Mgmt. of Mich., Inc.*, 1999 TTAB LEXIS 705, at \*14-15 (T.T.A.B. Dec. 20, 1999) (finding that both the heightened standard of excusable neglect and the lower standard of good cause had been met where the parties had discussed whether to continue settlement negotiations, the parties had previously agreed to extensions of time, and the prejudice to the non-moving party afforded by the delay was minimal); *Mattel, Inc. v. Super Duper Inc.*, 2005 TTAB LEXIS 267, at \*8-9 (T.T.A.B. June 21, 2005) (granting a contested motion to extend the discovery and testimony periods by 90 days because movant had made the minimum showing necessary to establish good cause, i.e., there was no evidence of negligence, bad faith, or abuse of the privilege of extensions); *Kaz Inc. v. Chervitz*, 2002 TTAB LEXIS 306, \*8 (T.T.A.B. May 20, 2002) (finding good cause and granting motion for extension of discovery period because movant presented "a compelling argument" showing that the parties were engaged in settlement negotiations throughout much of the discovery period and that, upon breakdown of the negotiations, movant served the opposing side with discovery requests).

As a preliminary matter, Applicant has not abused the privilege of extensions seeing as this is Applicant's first and only request for an extension of discovery and trial deadlines. *Nautica Apparel, Inc. v. Crain*, 2000 TTAB LEXIS 452, \*3-4 (T.T.A.B. July 21, 2000) (finding that movant showed good cause for extension and that movant had not abused the privilege of

extensions as this was movant's first request for an extension). Second, Applicant has not engaged in any negligent or bad faith tactics and an extension would not prejudice Opposer (indeed, Opposer's response fails to advance any argument or make any showing of purported prejudice if the extension were granted). Further, unlike those proceedings where the Board found an absence of good cause, the Parties here have continuously been engaging in settlement discussions which Opposer does not deny or dispute in its response. *See, e.g., Kellogg Co. v. Scheibner*, 1999 TTAB LEXIS 658, \*3 (T.T.A.B. Nov. 30, 1999) (finding no good cause was shown for requested extension of discovery period because "there [was] no indication that the parties believed proceedings should not go forward during negotiations" and "there [was] a dispute as to whether the parties were even actively pursuing settlement"); *Valvoline Co. v. Vortech Eng'g, Inc.*, 1996 TTAB LEXIS 166, \*7 (T.T.A.B. May 2, 1996) (finding no good cause was shown for requested extension of discovery period because all formal settlement negotiations had ended more than two and a half months prior to the close of discovery).

Lastly, Board precedent favors a liberal practice in granting extensions of time before the period to act has elapsed. *See Sysco Corp. v. Princess Paper, Inc.*, 2006 TTAB LEXIS 94, \*4-5 (T.T.A.B. Mar. 22, 2006) ("To the extent, if any, that respondent intends to suggest that extensions of time are rarely granted, respondent's interpretation of the case law is misplaced. To the contrary, the Board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.").

In view of the foregoing, Applicant respectfully submits that it has made out a sufficient showing of good cause to support its Motion to Extend the Close of Discovery [20 TTABVUE] by sixty (60) days and to reset trial dates in accordance therewith.

WHEREFORE, Applicant respectfully moves the Board to grant its Motion to Extend, to extend the close of discovery by sixty (60) days, to reset trial dates in accordance therewith, and for all other relief the Board deems just and fair.

Dated: April 1, 2021

Respectfully submitted,

/s/ Mark C. Johnson  
MARK C. JOHNSON, ESQ.  
*Florida Board Certified Expert in Intellectual Property Law*  
Fl. Bar No. 84365  
[MJ@JOHNSONDALAL.COM](mailto:MJ@JOHNSONDALAL.COM)  
**JOHNSON | DALAL**  
111 N. PINE ISLAND ROAD, SUITE 103  
PLANTATION, FL 33324  
Tel: (954) 507-4500  
Fax: (954) 507-4502  
*Attorneys for Applicant/Defendant*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing has been served on counsel of record for Opposer by forwarding said copy on April 1, 2021, via email to: Karen Gaunt, Esq., Dinsmore & Shohl LLP, 255 East Fifth Street, Suite 1900, Cincinnati, OH 45202 ([karen.gaunt@dinsmore.com](mailto:karen.gaunt@dinsmore.com), [govinda.davis@dinsmore.com](mailto:govinda.davis@dinsmore.com), [robin.bissantz@dinsmore.com](mailto:robin.bissantz@dinsmore.com), [trademarks@dinsmore.com](mailto:trademarks@dinsmore.com)).

Dated: April 1, 2021

Respectfully submitted,

/s/ Mark C. Johnson  
MARK C. JOHNSON, ESQ.  
*Florida Board Certified Expert in Intellectual Property Law*  
Fl. Bar No. 84365  
[MJ@JOHNSONDALAL.COM](mailto:MJ@JOHNSONDALAL.COM)  
**JOHNSON | DALAL**  
111 N. PINE ISLAND ROAD, SUITE 103  
PLANTATION, FL 33324  
Tel: (954) 507-4500  
Fax: (954) 507-4502  
*Attorneys for Applicant/Defendant*

**FW: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)**

Gaunt, Karen &lt;Karen.Gaunt@DINSMORE.COM&gt;

Tue 10/13/2020 11:55 AM

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Thank you Ms. Taylor and my apologies for our delay. I did discuss with my client and it is interested in pursuing resolution and had scheduled a meeting with the business team for further direction. I will follow up with my client again today and let you know where things stand by end of day.

Kind regards,  
Karen Gaunt

**Karen K. Gaunt**

Partner, Chair of Intellectual Property Litigation and Enforcement Practice Group

Immediate Past Chair, Trademark &amp; Copyright Practice Group

Dinsmore &amp; Shohl LLP • Legal Counsel

255 East Fifth Street

Suite 1900

Cincinnati, OH 45202

**T** (513) 977-8503 • **F** (513) 977-8141**E** [karen.gaunt@dinsmore.com](mailto:karen.gaunt@dinsmore.com) • [dinsmore.com](http://dinsmore.com)

---

**From:** Jade Taylor <JT@JohnsonDalal.com>**Sent:** Friday, October 9, 2020 4:38 PM**To:** Gaunt, Karen <Karen.Gaunt@DINSMORE.COM>; Veronika Balbuzanova <VB@JohnsonDalal.com>; Davis, Govinda <Govinda.Davis@DINSMORE.COM>**Cc:** Mark Johnson <MJ@JohnsonDalal.com>; Pascal Peng <PP@JohnsonDalal.com>; Bissantz, Robin <Robin.Bissantz@DINSMORE.COM>**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hi Ms. Gaunt

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Really hoping to hear from you soon. Thanks.

Jade Taylor, Paralegal to Mark C. Johnson, Esq.

**JOHNSON | DALAL****THE INTELLECTUAL PROPERTY LAW FIRM**

111 N. PINE ISLAND RD., SUITE 103

PLANTATION, FLORIDA 33324

OFFICE: (954) 507-4500  
FAX: (954) 507-4502  
[WWW.JOHNSONDALAL.COM](http://WWW.JOHNSONDALAL.COM)

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---

**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>  
**Sent:** Wednesday, September 9, 2020 3:27 PM  
**To:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
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**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

We can consent to another 30 day extension and I do hope to have a substantive reply to you shortly. My sincere apologies.

Thank you,  
Karen Gaunt

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**From:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>  
**Sent:** Wednesday, September 9, 2020 3:26 PM  
**To:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hi Ms. Gaunt,

Just touching base. Please let us know when we can expect to hear back from you with a counterproposal. The pleadings in this case resumed on 8/23/20, so please advise if you consent to another 30 day extension.

Thank you.

---

**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>  
**Sent:** Monday, August 24, 2020 3:37 PM  
**To:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
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Dear Ms. Balbuzanova,

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**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>  
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Best Regards,

Veronika Balbuzanova, Esq.  
*Associate Attorney*

Johnson | Dalal  
Patents Trademarks Copyrights  
111 N. Pine Island Road  
Suite 103  
Plantation, FL 33324  
Office: (954) 507-4500  
Fax: (954) 507-4502  
[WWW.PATENTANDTRADEMARKLAW.COM](http://WWW.PATENTANDTRADEMARKLAW.COM)

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---

**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>  
**Sent:** Thursday, July 23, 2020 12:48 PM  
**To:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Thank you, Jade.

Kind regards,  
Karen

---

**From:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>  
**Sent:** Thursday, July 23, 2020 11:34 AM  
**To:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hi Ms. Gaunt!

Thank you. We have gone ahead and submitted for the extension. Attached is a copy of the filing.

We look forward to hearing back from you soon.

Jade Taylor, Paralegal to Mark C. Johnson, Esq.

**JOHNSON | DALAL**

**THE INTELLECTUAL PROPERTY LAW FIRM**

111 N. PINE ISLAND RD., SUITE 103

PLANTATION, FLORIDA 33324

OFFICE: (954) 507-4500

FAX: (954) 507-4502

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**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>  
**Sent:** Sunday, July 19, 2020 8:39 AM  
**To:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>  
**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Dear Veronika,

Thank you very kindly for this message. Yes, we can consent to the proposed 30 day suspension. We hope to get you our response on settlement this week.

Best regards,  
Karen

---

**From:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>  
**Sent:** Friday, July 17, 2020 10:24 PM  
**To:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin

<[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>

**Subject:** Re: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hello Karen & Govinda,

As we have not yet heard back from you regarding your client's response, please advise if we have your consent to suspend the proceeding an additional 30 days to give your client time to review the settlement terms and for us to respond in turn. Thank you.

Have a wonderful weekend.

Best Regards,

Veronika Balbuzanova, Esq.

*Associate Attorney*

Johnson | Dalal

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Suite 103

Plantation, FL 33324

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Fax: (954) 507-4502

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**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>

**Sent:** Friday, July 10, 2020 3:17 PM

**To:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda

<[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>

**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>

**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Thank you, Jade. We appreciate the follow up and hope to have a substantive response to you next week.

Kind regards,  
Karen

---

**From:** Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>

**Sent:** Friday, July 10, 2020 3:12 PM

**To:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>; Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>

**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>

**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Good afternoon, Ms. Gaunt

Following up on the below. Please let us know when we can expect to hear back. 😊

Thank you.

Jade Taylor, Paralegal to Mark C. Johnson, Esq.

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**From:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>

**Sent:** Tuesday, June 16, 2020 10:20 AM

**To:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>

**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>; Bissantz, Robin <[Robin.Bissantz@DINSMORE.COM](mailto:Robin.Bissantz@DINSMORE.COM)>

**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Thank you, Veronika. We appreciate your time and attention to this matter. We will review and discuss with our client and revert back to you on the substance of the below.

Best regards,  
Karen

**Karen K. Gaunt**

Partner

Dinsmore & Shohl LLP • Legal Counsel  
255 East Fifth Street  
Suite 1900  
Cincinnati, OH 45202  
T (513) 977-8503 • F (513) 977-8141  
E [karen.gaunt@dinsmore.com](mailto:karen.gaunt@dinsmore.com) • [dinsmore.com](http://dinsmore.com)

---

**From:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>  
**Sent:** Tuesday, June 16, 2020 9:49 AM  
**To:** Gaunt, Karen <[Karen.Gaunt@DINSMORE.COM](mailto:Karen.Gaunt@DINSMORE.COM)>; Davis, Govinda <[Govinda.Davis@DINSMORE.COM](mailto:Govinda.Davis@DINSMORE.COM)>  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Pascal Peng <[PP@JohnsonDalal.com](mailto:PP@JohnsonDalal.com)>  
**Subject:** FW: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Hello Karen and Govinda,

Below is my follow-up email, as well.

Best Regards,

Veronika Balbuzanova, Esq.  
*Associate Attorney*

Johnson | Dalal  
Patents Trademarks Copyrights  
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Suite 103  
Plantation, FL 33324  
Office: (954) 507-4500  
Fax: (954) 507-4502  
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**From:** Veronika Balbuzanova  
**Sent:** Monday, May 18, 2020 11:07 AM  
**To:** [pgtrademarks.im@pg.com](mailto:pgtrademarks.im@pg.com)  
**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Genesis Prada

<[GP@JohnsonDalal.com](mailto:GP@JohnsonDalal.com)>

**Subject:** RE: Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Dear Counsel:

Following up on the below, please advise if you would be opposed to the request of another thirty (30) day suspension of Opposition Proceeding No. 91253873 for settlement purposes. Thank you in advance.

Best Regards,

Veronika Balbuzanova, Esq.

*Associate Attorney*

Johnson | Dalal

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Suite 103

Plantation, FL 33324

Office: (954) 507-4500

Fax: (954) 507-4502

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**From:** Veronika Balbuzanova <[VB@JohnsonDalal.com](mailto:VB@JohnsonDalal.com)>

**Sent:** Friday, May 15, 2020 3:53 PM

**To:** [pgtrademarks.im@pg.com](mailto:pgtrademarks.im@pg.com)

**Cc:** Mark Johnson <[MJ@JohnsonDalal.com](mailto:MJ@JohnsonDalal.com)>; Jade Taylor <[JT@JohnsonDalal.com](mailto:JT@JohnsonDalal.com)>; Genesis Prada <[GP@JohnsonDalal.com](mailto:GP@JohnsonDalal.com)>

**Subject:** Request for Suspension\_Opposition Proceeding No. 91253873 (HAIR CODES)

Dear Counsel:

As you know, the undersigned firm represents Hair Codes, LLC in Opposition Proceeding No. 91253873, currently pending before the Board. As a preliminary matter, please advise if you would be opposed to the request of another thirty (30) day suspension for settlement purposes, particularly in light of the points raised below.

We firmly believe that a coexistence agreement will provide the best resolution of the issues raised in the pending proceeding. Aside from the similarity in the literal elements of the respective marks, there are various differences between Applicant's HAIR CODES Mark and Opposer's HAIR CODE Mark which make any consumer confusion unlikely. Specifically, there are notable differences in the following:

1. The nature of the goods and services, given that our client exclusively sells hair care products, preparations, and accessories in International Classes 003, 005, 026, whereas P&G provides a computer application software which recommends a series of hair care products to consumers

- who take the quiz; actually **purchasing** the hair care products requires the consumer to be redirected to a third-party vendor website, such as Target, Walmart, Sally Beauty, or Amazon;
2. The channels of trade, given that P&G offers its quiz via its HAIR CODE website, <https://haircode.com/>, whereas Applicant sells its hair care products directly in its hair salon, not on any website or online platform;
  3. The careful and sophisticated purchasers that are being targeted, particularly when it comes to something that entails the involvement of so many different types of products (hair, scalp, and cuticle type; shampoos, conditioners, serums, creams, leave-in treatments, etc.);
  4. Use of a house mark, given that, at times (specifically, before a user takes the online quiz), a window pops up stating that "this free experience is brought to you by P&G" and stating that the P&G terms and conditions and privacy policy apply; due to this association between the house brand P&G and the HAIR CODE Mark, consumers are unlikely to be confused between the respective marks; and
  5. Weakness of the mark because HAIR is a generic term and there are countless live, registered marks with CODE for hair-related goods and services. Further thereto, there have been no reported instances of actual consumer confusion.

In light of all the foregoing, we believe that the execution of a coexistence agreement may adequately address the concerns that your client has with respect to Applicant's Mark. In the interest of reaching an amicable resolution of the underlying proceeding, our client is willing to (1) agree not to file for or use Applicant's Mark in class 009, related to providing hair care related questions to help consumers determine the type of products best suited to their individual needs and preferences; and (2) agree not to use the singular form HAIR CODE on any product packaging or as a trademark.

Please advise if your client is amenable to the foregoing terms, so we may draft a coexistence agreement embodying said terms. Thank you and I look forward to hearing from you soon.

Best Regards,

Veronika Balbuzanova, Esq.

*Associate Attorney*

Johnson | Dalal

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Suite 103

Plantation, FL 33324

Office: (954) 507-4500

Fax: (954) 507-4502

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