

ESTTA Tracking number: **ESTTA1259663**

Filing date: **01/12/2023**

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

Proceeding no.	92079337
Party	Plaintiff Mija Clean, LLC
Correspondence address	JOSEPH T NABOR FITCH EVEN TABIN & FLANNERY LLP 120 S. LASALLE STREET SUITE 2100 CHICAGO, IL 60603 UNITED STATES Primary email: trademark@fitcheven.com Secondary email(s): jtnabo@fitcheven.com 312-577-7000
Submission	Reply in Support of Motion
Filer's name	Kerianne A. Strachan
Filer's email	jtnabo@fitcheven.com, kstrachan@fitcheven.com, trademark@fitcheven.com
Signature	/Kerianne A. Strachan/
Date	01/12/2023
Attachments	21345-150426 - Reply Brief - MIJA.pdf(136692 bytes)

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

Mija Clean, LLC)	
)	
Petitioner,)	Cancellation No.: 92079337
)	
v.)	Serial Nos. 90263714 and 90452598
)	
Mija, LLC)	Filed: March 28, 2022
)	
Registrant.)	Marks: MIJA and MIJA
)	

Petitioner’s Reply Brief in Support of Motion for Summary Judgment

Mija Clean, LLC (“Petitioner”), by undersigned counsel, respectfully submits the following reply in response to Mija, LLC’s (“Registrant”) Response to Petitioner’s Motion for Summary Judgment.

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment is appropriate only if the pleadings, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law. The moving party has the initial burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car Inc.*, 62 USPQ2d 1857 (TTAB 2002) (citations omitted).

In its Response to Petitioner’s Motion for Summary Judgment, Registrant has asserted

that Petitioner has not met its burden of proving that there are no genuine issues of material fact regarding Registrant's intent to defraud the U.S. Patent and Trademark Office (the "Office"). Petitioner maintains that no genuine issues of material fact exist as the record clearly demonstrates that Registrant committed fraud upon the Office.

Firstly, in support of its response, Registrant provides a declaration of Sarah Koszyk which states that Ms. Koszyk "did not sign, review or even see the Statement of Use prior to Attorney Vaidya submitting it to the USPTO, nor was [she] aware that a Statement of Use was being filed." (Response, Exhibit C). Despite Ms. Koszyk's alleged lack of knowledge regarding the Statement of Use, Petitioner maintains that Registrant received an acknowledgement from the Office that the Statement of Use was accepted for all the goods identified in the Notice of Allowance. Additionally, the Statement of Use became available and accessible to the public upon its filing on July 28, 2021. Therefore, Registrant could have easily accessed the Office database to see the Statement of Use and the goods delineated therein. It is beyond merely ironic that the Registrant asks us to rely on this declaration to repudiate its earlier declaration in the Statement of Use. Even if entirely true, this does not excuse the lies contained in the Statement of Use. The fact remains and is now attested to by the Registrant that the Statement of Use was a lie. And it was on the basis of that lie that the subject Registration was granted.

Furthermore, Registrant claims that it was not aware of the goods that its attorney "mistakenly" listed in the Statement of Use until it received a letter dated March 17, 2022 from Petitioner's counsel notifying of the fraud and the intent to file this Petition to Cancel the Registration. Subsequent to Registrant's receipt of the letter, Registrant's attorney of record filed a Section 7 amendment to correct the erroneous Statement of Use on March 23, 2022. Based on this timeline, Petitioner notes that for nearly eight (8) months, Registrant's Statement of Use,

with the inclusion of the incorrect goods, was available on the public record. Such an extensive period of time demonstrates more than an “inadvertent error” as Registrant took no action to notify the Office of any mistakes, despite the fact that Registrant knew or should have known it was not using the mark in connection with the listed goods. This newest declaration of the Registrant never identifies that it did not receive a copy of the Statement of Use post filing nor does it claim it never received the Certificate of Registration that issued with the fraudulent goods included. This is not a slight inadvertent error but goes to the very integrity of the Registration itself.

Lastly, contrary to Registrant’s arguments, Petitioner asserts that it has introduced evidence that Registrant’s statements to the Office in the filing of its Statement of Use were fraudulent. It is clear from the record that Registrant engaged its attorney to file the Statement of Use which included its attestation that its MIJA mark was in use in commerce in connection with all the goods provided therein. Yet, based on Registrant’s responses to Petitioner’s discovery requests, Registrant admitted that its mark, in fact, was not in use in connection with all the goods listed in the Statement of Use. Thus, Registrant’s attestation to the Office at the time of filing the Statement of Use was fraudulent. In *Medinol Ltd. v. Neuro Vasx Inc.*, the Board granted summary judgment on fraud grounds and cancelled the subject registration because registrant admitted it had not used the mark in connection with all the goods identified in its statement of use. 67 U.S.P.Q.2d 1205 (TTAB 2003). Here, Registrant has also admitted to not using the mark in connection with all the goods specified in its Statement of Use although it falsely attested to such use. Therefore, based on the evidence of record, there is no dispute and no genuine issue of material fact that when filing its Statement of Use, Registrant committed fraud upon the Office for which the only appropriate action is cancellation of the erroneous

Registration. It should be noted that the Registrant is not foreclosed from later seeking registration via a new application of the appropriate goods. However, the existing Registration cannot stand.

Petitioner, therefore, respectfully requests that its Motion for Summary Judgment be GRANTED.

Dated: January 12, 2023

/Joseph T. Nabor/
Joseph T. Nabor
Kerianne A. Strachan
Fitch, Even, Tabin & Flannery LLP
120 South LaSalle Street, Suite 2100
Chicago, IL 60603
Telephone: 312-577-7000
Fax: 312-577-7007
jtnabo@fitcheven.com
kstrachan@fitcheven.com
trademark@fitcheven.com

CERTIFICATE OF SERVICE

I, Kerianne A. Strachan, Attorney for the Petitioner, hereby certify that a copy of the foregoing Petitioner's Motion for Summary Judgment has been served via email upon:

Jamie Shelden
Law Office of Jamie Shelden
1760-F Airline Highway, PMB 220
Hollister, CA 95023
Telephone: 831.261.5444
jamie@justtrademarks.com

Attorney for Registrant

Dated: January 12, 2023

/Kerianne A. Strachan/

Joseph T. Nabor
Kerianne A. Strachan
Fitch, Even, Tabin & Flannery LLP
120 South LaSalle Street, Suite 2100
Chicago, IL 60603
312-577-7000 Telephone
312-577-7007 Fax
jtnabo@fitcheven.com
kstrachan@fitcheven.com
trademark@fitcheven.com

Attorneys for Petitioner