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Filing date: **02/29/2024**

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
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Signature	/Kerianne A. Strachan/
Date	02/29/2024
Attachments	21345-150426 Reply Brief in Support of Motion to Extend - 2-29-2024.p df(2194614 bytes)

21345-150426

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 Corrected Reply Brief in Support of Motion to Extend Proceeding Deadlines
for Consideration of Potential Settlement**

Mija Clean, LLC (“Petitioner”), by its undersigned counsel, respectfully submits the following reply in response to Mija, LLC’s (“Registrant”) Opposition to Petitioner’s Motion to Extend Proceeding Deadlines.

Section 509.01(a) of the Trademark Trial and Appeal Board Manual of Procedure provides that “a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party’s own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor.” Here, Petitioner has demonstrated that its request for an extension of time is not due to its lack of diligence or any unreasonable delay, but for the purposes of settlement negotiations. More specifically, on January 8, 2024, the parties discussed via telephone conference certain settlement terms that Registrant’s counsel agreed to discuss with Registrant. However, contrary to the parties’ settlement discussions on January 8, 2024, Registrant’s counsel sent to Petitioner’s counsel, on January 11, 2024, an email delineating terms more restrictive in nature than those previously discussed. Registrant’s counsel also neglected to provide any further details regarding the settlement terms discussed between the parties on January 8, 2024, which Petitioner’s counsel anticipated receiving in furtherance of settlement negotiations. Thus, based on Registrant’s proposal of entirely new settlement terms and

resulting delay in the resolution of this matter, Petitioner has moved to extend the proceeding deadlines to afford it a reasonable amount of time to consider Registrant's unanticipated counteroffer.

Furthermore, pursuant to Fed. R. Civ. P. 6(b)(1)(A), made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), the appropriate standard for allowing an extension of a specified time period prior to the expiration of that period is "good cause." In the case at hand, Petitioner filed its motion to extend its time to properly consider Registrant's newly proposed settlement terms and prepare a response to Registrant's counsel. Registrant's argument that Petitioner "has had ample time to consider Registrant's settlement proposal" is unpersuasive. 22 TTABVUE 4. Registrant's settlement proposal, which contained terms contrary to those discussed on January 8, 2024, was sent to Petitioner's counsel on January 11, 2024, eleven days prior to the close of Petitioner's trial period. Eleven days is not a reasonable time for Petitioner's counsel to consider entirely new settlement terms and advise Petitioner on responding to Registrant's offer. Therefore, in an effort to afford the parties a reasonable opportunity to negotiate Registrant's new settlement proposal, Petitioner contacted Registrant's counsel on January 15, 2024 to request Registrant's consent to a 60-day extension of deadlines. Although Registrant claims that Petitioner did not provide a substantive reply in its January 15, 2024 email to Registrant's counsel regarding its settlement proposal, Petitioner asserts that a period of four days to consider new terms and respond substantively is insufficient and unreasonable.

Moreover, Petitioner refutes Registrant's claim that due to the impending close of Petitioner's trial period, Petitioner now possesses a "sudden interest in settling this matter" which is entirely groundless and inaccurate. 22 TTABVUE 3. As demonstrated in the attached Exhibit A, Petitioner's counsel has demonstrated an ongoing interest in settling this matter since at least as early as November 3, 2022. For example, in an email to Registrant's counsel dated November 3, 2022, Petitioner's counsel stated the following: "To resolve this matter amicably, we would like to set up a call with you to discuss the potential for a settlement agreement outlining terms of use for both parties." *See Exhibit B.* Petitioner's ongoing interest in settling this matter has continued since November 3, 2022, as recently as January 3, 2024 when Petitioner's counsel contacted Registrant's counsel via email to schedule a call to

discuss potential settlement. *See Exhibit C.* Such efforts to discuss and negotiate settlement demonstrates Petitioner's desire to resolve this matter.

Petitioner also disagrees with Registrant's claim that it "has been the sole party actively pushing for progress in this matter" and "diligently cooperating and seeking resolution." 22 TTABVUE 5. Firstly, throughout the course of the proceedings, Petitioner has adhered to the trial schedule and pushed for progress, as well as diligently sought resolution in its continuous efforts to settle this matter. Additionally, contrary to Registrant's arguments, Registrant's counsel was unresponsive to Petitioner's second set of discovery requests served on August 17, 2023. Due to Registrant's counsel's failure to cooperate, Petitioner filed a motion to compel Registrant's responses to Petitioner's discovery requests on September 28, 2023, thus prompting Registrant to provide its untimely responses to such requests on October 3, 2023. Registrant's failure to provide a timely response to Petitioner's discovery requests does not demonstrate Registrant's claimed push for progress, diligent cooperation, or a desire for a resolution.

Therefore, based on the record, Petitioner has demonstrated the requisite good cause to warrant its requested extension of the proceeding deadlines. Thus, Petitioner respectfully requests that its Motion to Extend be GRANTED.

Dated: February 29, 2024

/Joseph T. Nabor/
Joseph T. Nabor
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Chicago, IL 60603
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CERTIFICATE OF SERVICE

I, Kerianne A. Strachan, Attorney for the Petitioner, hereby certify that a copy of the foregoing Petitioner's Corrected Reply Brief in Support of Motion to Extend Proceeding Deadlines for Consideration of Potential Settlement 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: February 29, 2024

/Kerianne A. Strachan/

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Attorneys for Petitioner

EXHIBIT A

Kerianne A. Strachan

From: Kerianne A. Strachan
Sent: Thursday, November 3, 2022 5:21 PM
To: JAMIE SHELDEN
Cc: Joseph Nabor
Subject: RE: Response to Discovery Requests - Cancellation No. 92079337

Hello Jamie,

Thank you for your emails. At this time, we think it may be in the best interests of both parties to set up a call to discuss the potential for settlement.

Based on our review of Mija, LLC's responses to our discovery requests, we believe our claim of fraud is substantiated as it does not appear that your client demonstrated a bona fide intention to use the MIJA mark in connection with all of the goods identified in its Statement of Use filed on July 28, 2021. We have identified various TTAB cases, including precedential decisions, that support our position and cancellation of a trademark registration based on fraud and/or non-use.

To constitute fraud on the U.S. Patent and Trademark Office, a statement made in connection with an application must be (1) false, (2) a material representation and (3) made knowingly. *Standard Knitting, Ltd. v. Toyota Jidosha*, 2006 TTAB Lexis 9 (TTAB 2006).

Here, Mija, LLC falsely stated that its MIJA mark was in use in connection with all of the goods identified in its Statement of Use filed on July 28, 2021. Our position is further supported by Mija, LLC's admission that its mark was not in use in connection with "perfumery; hair care products, namely, shampoos, conditioners, hair cleaning preparations, hair styling spray, hair styling gels and sprays, hair coloring and dyeing preparations; beauty care preparations, namely, non-medicated balms for use on skin, lips, hair, body lotions; face toner; face gels, face creams, face mist, skin lotions; makeup, lip balms, lip sticks, body washes, body scrubs, skin toners, beauty creams; body creams" at the time that its Statement of Use was filed on July 28, 2021. Although your client filed a Section 7 Request to correct the listing of goods in the Statement of Use, such an amendment does not cure the fraud.

Moreover, Mija, LLC's false statements were made knowingly. The Lanham Act imposes an obligation on the applicant not to make knowingly inaccurate or misleading statements in the verified declaration forming part of the application. See *Fuji Medical Instruments v. American Crocodile Int'l*, 2021 USPQ2d (BNA) 831 (TTAB 2021). Here, in its response to Request No. 19 of our request for admissions, Mija, LLC has admitted that it authorized its then attorney of record to file the Statement of Use. Although Mija, LLC's attorney signed the declaration which accompanied the Statement of Use, Mija, LLC is not relieved of its duty to state the truth. The Board in *Smith Int'l v. Olin Corp.* stated, "[e]ven if the affidavit was prepared by its attorney, Smith must be held accountable for any false or misleading statements made therein." 209 USPQ (BNA) 1033, 1047 (TTAB 1981).

In addition to the foregoing, we note that the materials provided in in Mija, LLC's response to our requests for document production are substantially limited to its superfood supplement and face oil products. Therefore, based on your client's admissions and in the absence of additional evidence, we believe our claim of fraud is substantiated.

Based on our analysis and TTAB case law, we maintain that our claim of fraud is substantially supported at this stage of the proceeding. To resolve this matter amicably, we would like to set up a call with you to discuss the potential for a settlement agreement outlining terms of use for both parties. Please advise whether you are available for a call tomorrow, November 4th or any time next week.

EXHIBIT B

Kerianne A. Strachan

From: Kerianne A. Strachan
Sent: Thursday, November 3, 2022 5:21 PM
To: JAMIE SHELDEN
Cc: Joseph Nabor
Subject: RE: Response to Discovery Requests - Cancellation No. 92079337

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Based on our analysis and TTAB case law, we maintain that our claim of fraud is substantially supported at this stage of the proceeding. To resolve this matter amicably, we would like to set up a call with you to discuss the potential for a settlement agreement outlining terms of use for both parties. Please advise whether you are available for a call tomorrow, November 4th or any time next week.

EXHIBIT C

Kerianne A. Strachan

From: Kerianne A. Strachan
Sent: Wednesday, January 3, 2024 12:40 PM
To: Jamie Shelden
Cc: Alexander Thimons
Subject: RE: Petitioner's Pretrial Disclosures

Hi Jamie,

Apologies for the delay. In response to your question, we intend to take testimony from Ms. Sara Koszyk.

Prior to proceeding with any testimony, please advise whether you are available for another call to discuss the possibility of settlement at this point of the proceedings. We are available any time early next week.

Thank You,
Kerianne

[Kerianne Strachan](#) | Associate

FITCH EVEN

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From: Jamie Shelden <jamie@justtrademarks.com>
Sent: Tuesday, January 2, 2024 11:18 AM
To: Kerianne A. Strachan <KStrachan@fitcheven.com>
Cc: Alexander Thimons <ATHimons@fitcheven.com>
Subject: Re: Petitioner's Pretrial Disclosures

Hi Kerianne,

I haven't had a reply to my message below. If you intend to take testimony from my client, please note that I will out of the country on vacation and unavailable from January 13 - 22.

Best,
Jamie