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

Proceeding no.	92079337
Party	Defendant Mija, LLC and Mija LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mija Clean, LLC,	)	
	)	Cancellation no.: 92079337
Petitioner,	)	
	)	Mark: MIJA
v.	)	
	)	Registration no.: 6532271
	)	
Mija LLC,	)	
	)	
Respondent.	)	

RESPONDENT'S BRIEF ON THE MERITS

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Respondent Mija LLC ("Mija LLC) submits the following Brief on the Merits in response to Petitioner, Mija Clean, LLC's Trial Brief.

I. INTRODUCTION

Petitioner, Mija Clean LLC carries the burden of proving that Respondent, Mija LLC knowingly made a false material statement with the willful intent to deceive USPTO for purposes of obtaining the MIJA Registration. But there is no evidence – let alone clear and convincing evidence – that Mija's submission of an Amendment to Allege Use was the result of anything other than an inadvertent mistake resulting from inexperience on the part of Respondent's then counsel. This clear lack of intent to deceive is evidenced by the fact that, upon learning of Counsel's mistake, Mija immediately corrected the registration by filing a Section 7 amendment deleting the goods for which it did not have use at the time of filing of the Amendment to Allege Use.

II. STATEMENT OF THE ISSUES

Has Petitioner met its burden of proving, by clear and convincing evidence, that Mija LLC knowingly made a false statement with the willful intent to deceive the USPTO when its then counsel filed an inaccurate Amendment to Allege Use indicating that the MIJA trademark was in use in connection with not some, but not all of the goods listed in the Notice of Allowance?

III. DESCRIPTION OF THE RECORD

Respondent incorporates by reference Petitioner's Description of the Record herein.

IV. STATEMENT OF THE RELEVANT FACTS

A. Mija LLC and the MIJA Mark

Respondent, Mija LLC is a wellness company focused on personal care products including skin and hair care, energy and mood and the functional wellness of the body. Mija LLC first began using the MIJA trademark in the summer of 2019 for the company's ingestible supplement products. Later that year, Respondent introduced a face oil product as a cross promotion with the supplements. 29 TTABVUE 2.

B. The MIJA Trademark Application

Mija LLC, filed intent-to-use application serial number 90/263,714 for the MIJA trademark covering "Face oils; perfumery; essential oils; 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; non-medicated skin care preparations and serums, namely, face gels, face creams, face mist, skin oils, skin lotions; non-medicated anti-wrinkle skin care preparations and serums; Topical skin care preparation, namely, non-medicated preparation for the treatment of fine lines and wrinkles and skin surface irregularities; skin moisturizers used as cosmetics; beauty care products, namely, make-up, skin moisturizers, lip balms, lip sticks, body washes, body scrubs, skin toners, beauty creams; body creams" on October 18, 2020. 28 TTABVUE 2. After issuance of a Notice of Allowance, Mija LLC's then counsel prepared, signed and filed an Amendment to Allege Use. 29 TTABVUE 4. Without Mija LLC's knowledge, Mija

LLC's counsel declared that the mark was in use in connection with all of the goods listed in the Notice of Allowance. 29 TTABVUE 4.

C. Section 7 Correction of the MIJA Registration

Approximately eight months later, after issuance of the registration and after the Respondent was made aware of the inadvertent error, Respondent retained new counsel to immediately correct the record by filing a Section 7 Amendment to the registration. 29 TTABVUE 2. The Section 7 Amendment was filed on March 23, 2022, six (6) days after receipt of Petitioner's counsel's letter on March 17, 2022 informing Respondent of Respondent's counsel's mistake. 29 TTABVUE 5,6.

V. ARGUMENT

A. Petitioner's Evidence Fails to Establish that Mija LLC Knowingly Made a False, Material Representation with the "Willful Intent to Deceive" the USPTO in Order to Obtain its Registration

A trademark is obtained or maintained fraudulently and can be cancelled under the Lanham Act only if (1) the registrant made a false representation to the USPTO; (2) the false representation is material to the registrability of the mark; (3) the defendant had knowledge of the falsity of the representation; and (4) the defendant made the representation with intent to deceive the USPTO. *In re Bose Corp*., 580 F.3d 1240, 1245 (Fed. Cir. 2009). A party seeking cancellation of a trademark registration for fraudulent procurement "bears a heavy burden of proof." *Id*. at 1243 (citing *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 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." *Id*. (quoting *Smith Int'l, Inc. v. Olin Corp*., 209 USPQ 1033, 1044 (T.T.A.B. 1981)).

Petitioner has failed to present any evidence that Mija LLC knowingly made an inaccurate statement in the Amendment to Allege Use *with the intent to deceive* the USPTO. Indeed, there is no evidence that Mija LLC's Amendment to Allege Use was the result of anything other than a inadvertent error on the part of the company's inexperienced counsel.

At no time did Respondent have an intent to deceive the USPTO. Mija LLC acknowledged that its incorrectly filed Amendment to Allege Use contained a false declaration of use in connection with all of the goods listed in the application. However, that inadvertently false declaration was in no way fraudulent.

The Federal Circuit in *In re Bose*, established a strict standard for proving fraud. Specifically, fraud requires a false statement made with the specific intent to deceive the USPTO. Reckless disregard alone does not satisfy the *In re Bose* standard unless it is accompanied by evidence clearly and convincingly showing intent to deceive. The *Bose* decision explicitly rejects negligence or even gross negligence as sufficient to prove fraud, raising the threshold for proving intent to deceive. "Merely making a false statement is not sufficient to cancel a mark." *L.D. Kichler Co. v. Davoil, Inc*., 192 F.3d 1349, 1351 (Fed. Cir. 1999) (citing *Metro Traffic Control, Inc. v. Shadow Network Inc*., 104 F.3d 336, 340 (Fed. Cir. 1997). Rather, a "[s]ubjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis." *In re Bose Corp*. at 1245; *Metro Traffic Control*, 104 F.3d at 340. "[A]bsent the requisite intent to mislead the PTO, even a material

misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation." *In re Bose Corp.* at 1243.

B. Petitioner's Evidence Fails to Establish "Reckless Disregard for the Truth"

Petitioner cites *Chutter, Inc. v. Great Mgmt. Grp.,* USPTO. 2021 TTAB LEXIS 365, *16 (TTAB 2019) for the proposition that reckless disregard for the truth is tantamount to intent to deceive. While *Chutter, Inc.* introduced "reckless disregard" as a possible basis for fraud, this does not alter the clear and convincing evidence requirement for proving intent to deceive. The "reckless disregard" language in *Chutter* should be interpreted in light of *Bose*'s holding. Reckless conduct alone does not equate to the specific intent to deceive required under *Bose*. Opposing counsel has selectively cited *Chutter* without adequately addressing the requirement that intent must still be proven clearly and convincingly.

Several district courts have rejected the *Chutter* standard for intent to deceive for fraud as including "reckless disregard", citing *Weems Industries, Inc. v. Teknor Apex co.* 2023 WL 2333901, *8, n.10 (N.D. Iowa 2023) (rejecting TTAB's "reckless disregard" theory where "both the Federal Circuit and the Eighth Circuit have held that an intent to deceive must be willful"); *Florida Virtual School, v. K12, Inc.* 2023 WL 8357735, *5 (M.D. Fla. 2023) (finding TTAB's "reckless disregard" standard contrary to the Eleventh Circuit); and *La Terra Fina USA, LLC v. Reser's Find Foods, Inc.* 2024 WL 1973468, *3 (N.D. Cal. 2024) ("The Trademark Trial and Appeal Board cannot set a new legal standard.").

These rulings collectively affirm that reckless disregard, without clear and convincing evidence of specific willful intent to deceive, fails to satisfy the stringent fraud standard established by *Bose*.

Further, in *Ruifei (Shenzhen) Smart Technology Co., Ltd. v. Shenzhen Chengyan Science and Technology Co., Ltd.* Cancellation no. 92077931 (TTAB July 2, 2024), the Board dismissed the fraud claim and denied the petition for cancellation where the "indispensable element of the analysis" of the fraud claim – the subjective intent to deceive or reckless disregard of the truth – were not proven because the record contained no testimony of the persons who signed the Statement of Use. With no deposition or cross-examination testimony, the Board refused to infer subjective intent to deceive or reckless disregard for the truth. *Id.*

Petitioner has provided no testimony of Respondent or Respondent's Attorney who signed the declaration containing false statements. Without this testimony from the declarant as to his state of mind when making false statements to the USPTO, there can be no finding of subjective intent to deceive.

C. Mija LLC's Section 7 Correction of the MIJA Registration Shows Lack of Intent to Deceive and Lack of Reckless Disregard for the Truth

In *Chutter, Inc.*, the finding of fraud relied heavily on evidence of specific actions and circumstances demonstrating conscious awareness and intentional disregard of the truth. Absent similar evidence in the present case, the claim of fraud fails. Mere "reckless disregard" cannot stand alone as a substitute for the required specific intent to deceive, and no direct evidence of such intent has been provided in this matter.

Rather, direct evidence of a *lack of* intent to deceive has been provided. In *Chutter,* the Respondent failed to take *any* action to correct its false Section 15 affidavit. Conversely, Mija LLC took swift action to correct the false statements made by its then attorney. Within six days of learning of the mistake, Respondent engaged new counsel to immediately file the Section 7 amendment to the MIJA registration. Petitioner's claim that "Respondents did not demonstrate any desire to immediately rectify their erroneous Statement of Use and allowed an unexplained period of time to pass prior to taking any action" is erroneous. Respondent received a letter from Petitioner's counsel on March 18, 2022 notifying Respondent that they believed there were false declarations in the Amendment to Allege Use filed for the MIJA trademark application. 29 TTABVUE 5. Respondent contacted its current counsel the very same day and the Section 7 amendment was filed the following Thursday, March 24, 2022. 29 TTABVUE 5.

VI. CONCLUSION

Petitioner has not met its burden of proving that Respondent had the requisite intent to deceive or reckless disregard for the truth to maintain a fraud claim. Accordingly, the petition to cancel should be dismissed with prejudice. Respondent requests that this Cancellation be DISMISSED WITH PREJUDICE.

November 29, 2024

Respectfully Submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing:

RESPONDENT'S TRIAL BRIEF

is being served upon Opposer by email to Joseph T Nabor, jtnabo@fitcheven.com this 29th day of November 2024.

Jamie Shelden

Jamie R. Shelden