

ESTTA Tracking number: **ESTTA552146**

Filing date: **08/05/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Green Ivy Educational Consulting, LLC		
Entity	limited liability company	Citizenship	California
Address	302 Main Street, Suite 201 Los Altos, CA 94022 UNITED STATES		

Attorney information	Brian M. Davis VLP Law Group LLP 5960 Fairview Road; Suite 400 Charlotte, NC 28210 UNITED STATES bdavis@vlplawgroup.com, trademarks@vlplawgroup.com Phone:704-245-6515		
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Applicant Information

Application No	85775379	Publication date	07/30/2013
Opposition Filing Date	08/05/2013	Opposition Period Ends	08/29/2013
Applicant	Green Ivy Holdings LLC 108 West 13th Street Wilmington, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Educational services, namely, providing pre-kindergarten through 12th grade classroom instruction; educational services, namely, developing curriculum for others; providing after school educational programs for children in pre-kindergarten through 12th grade; providing live and online educational services, namely, providing classes, workshops and seminars in the field of primary education for grades pre-kindergarten through 12th grade
Class 042. All goods and services in the class are opposed, namely: Testing, analysis and evaluation of the goods and services of others for the purpose of certification, namely, software, toys, books, classroom materials and lesson plans in the fields of education and parenting

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Application No	85775380	Publication date	07/30/2013
Opposition Filing Date	08/05/2013	Opposition Period Ends	08/29/2013
Applicant	Green Ivy Holdings LLC 108 West 13th Street		

Wilmington, DE 19801 UNITED STATES

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Applicant Information

Application No	85775382	Publication date	07/30/2013
Opposition Filing Date	08/05/2013	Opposition Period Ends	08/29/2013
Applicant	Green Ivy Holdings LLC 108 West 13th Street Wilmington, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85915217	Application Date	04/25/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GREEN IVY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2004/03/30 First Use In Commerce: 2004/03/30		

	Career and educational counseling, namely, providing advice concerning the college application process and education options; Consultation for K-12 educational systems in the field of student organization, student time management, and education technology options; Education services, namely, providing K-12 classroom instruction in the field of organization and time management; Educational services, namely, conducting workshops and courses for parents, educators and students in the fields of education, time management, college and post graduate program admission and educational assessment test preparation and distribution of training materials in connection therewith; Educational services, namely, developing curriculum for educators
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Attachments	GREEN IVY Notice of Opposition.pdf(54289 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brian M. Davis/
Name	Brian M. Davis
Date	08/05/2013

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

In the Matter of US Serial

Nos. 85/775,379, 85/775,380 and 85/775,382

Marks: GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING

Green Ivy Educational Consulting, LLC,
Opposer

v.

Opposition No. _____

Green Ivy Holdings LLC,
Applicant

NOTICE OF OPPOSITION

Green Ivy Educational Consulting, LLC ("Opposer"), a limited liability company organized under the laws of the state of California with a place of business at 302 Main Street, Suite 201, Los Altos, California 94022, believes that it will be damaged by the registration of the marks GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING described in U.S. Trademark Application Serial Nos. 85/775,379, 85/775,380 and 85/775,382 filed by Green Ivy Holdings LLC ("Applicant"), a limited liability company organized under the laws of the state of Delaware with a listed address at 108 West 13th Street Wilmington Delaware 19801. Opposer hereby opposes the registration of said mark, and as grounds for its opposition, alleges that:

1. Opposer is a well known provider of various education services, including academic coaching, test preparation counseling, curriculum development, workshops and consultation services relating to the implementation of its organizational and time management program into school curriculums and home environments. Opposer has offered these services to students, parents, teachers and school administrators under its

GREEN IVY mark and trade name since at least as early as 2004 (“Opposer’s GREEN IVY Mark”).

2. By reason of the adoption and continuous use of Opposer’s GREEN IVY Mark in the United States, that designation has acquired special and particular significance and very valuable goodwill as identifying Opposer and its services. Through such usage and recognition, Opposer has acquired common law rights in and to Opposer’s GREEN IVY Mark as a proprietary service mark.
3. In addition to its common law rights, Opposer is the owner of the following pending application for the GREEN IVY mark (“Opposer’s GREEN IVY Application”):

Trademark & Logo	GREEN IVY
Serial/Reg. No.	85-915217
Filing Date	April 25, 2013
Filing Basis	Section 1(a) - Use in Commerce
First Use Date	March 30, 2004
Goods/Services	41 - Career and educational counseling, namely, providing advice concerning the college application process and education options; Consultation for K-12 educational systems in the field of student organization, student time management, and education technology options; Education services, namely, providing K-12 classroom instruction in the field of organization and time management; Educational services, namely, conducting workshops and courses for parents, educators and students in the fields of education, time management, college and post graduate program admission and educational assessment test preparation and distribution of training materials in connection therewith; Educational services, namely, developing curriculum for educators

4. Opposer’s GREEN IVY Application was filed based on Opposer’s use of the above GREEN IVY mark in commerce for the identified services in International Class 41 at least as early as March 30, 2004.

5. Opposer is informed and believes, and therefore alleges, that Applicant filed U.S. Trademark Application Serial Nos. 85/775,379, 85/775,380 and 85/775,382 on November 9, 2012, to register the word marks GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING for “Office administration services for schools” in Int. Class 35; “Educational services, namely, providing pre-kindergarten through 12th grade classroom instruction; educational services, namely, developing curriculum for others; providing after school educational programs for children in pre-kindergarten through 12th grade; providing live and online educational services, namely, providing classes, workshops and seminars in the field of primary education for grades pre-kindergarten through 12th grade” in Int. Class 41 and “Testing, analysis and evaluation of the goods and services of others for the purpose of certification, namely, software, toys, books, classroom materials and lesson plans in the fields of education and parenting” in Int. Class 42 (“Applicant’s GREEN IVY Applications”). Applicant filed each of its applications under Section 1(b) of the Trademark Act based on its alleged intent-to-use the mark in interstate commerce in connection with such services.
6. Opposer is informed and believes, and therefore alleges, that Applicant made no use of Applicant’s GREEN IVY, GREEN IVY SCHOOLS or GREEN IVY LEARNING marks in the United States prior to the filing of Applicant’s GREEN IVY Applications.
7. Opposer’s first use of Opposer’s GREEN IVY Mark precedes Applicant’s filing date of November 9, 2012 by over eight (8) years.
8. By virtue of Opposer’s long and extensive use of Opposer’s GREEN IVY Mark in connection with its services, and its marketing, advertising and promotion of such services under this mark in interstate commerce, Opposer’s GREEN IVY Mark has

become well-known, and was well-known prior to the filing date for Applicant's GREEN IVY Applications.

9. Applicant's GREEN IVY mark is identical to the Opposer's GREEN IVY Mark in meaning, pronunciation and appearance. Further, the dominant, non-descriptive portions of Applicant's GREEN IVY SCHOOLS and GREEN IVY LEARNING marks are identical to Opposer's GREEN IVY mark in meaning, pronunciation and appearance and the descriptive words SCHOOLS and LEARNING in those marks creates a direction association with the parties' overlapping educational services.
10. Moreover, the services set forth in the Applicant's GREEN IVY Applications in Int. Classes 41 and 42 are either identical or highly related to the educational services in connection with which Opposer's GREEN IVY Mark has been used and will travel in the same channels of trade and be marketed to the same consumers as the services that are the subject of the Opposer's GREEN IVY Application.
11. Thus, Applicant's GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING marks, when used in connection with the services described in Int. Classes 41 and 42 of the subject applications, are likely to deceive or cause consumer confusion or mistake among members of the public and potential purchasers of the companies' respective services as to the source or sponsorship of Applicant's services in relation to Opposer's services. Such confusion will damage Opposer and injure its reputation in the trade and with the public.
12. Therefore, U.S. Trademark Application Serial Nos. 85/775,379, 85/775,380 and 85/775,382 should be refused and denied registration on the basis that, pursuant to 15 U.S.C. § 1052(d), each of Applicant's GREEN IVY, GREEN IVY SCHOOLS and

GREEN IVY LEARNING marks consists of or comprises a mark:

which so resembles a mark registered in the Patent and Trademark 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.

13. Accordingly, Opposer alleges, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for Applicant's GREEN IVY, GREEN IVY SCHOOLS and GREEN IVY LEARNING marks as sought in U.S. Trademark Application Serial Nos. 85/775,379, 85/775,380 and 85/775,382.

WHEREFORE, Opposer prays that U.S. Trademark Application Serial Nos. 85/775,379, 85/775,380 and 85/775,382 be denied, that no registration be issued thereon to Applicant, that Applicant be required to answer to the allegations set forth in this Notice of Opposition and that this opposition be sustained in favor of Opposer.

The undersigned Opposer in the above-entitled cause hereby appoints Brian M. Davis and Scott R. Austin, members of the bar in the states of North Carolina and Florida, respectively, its attorneys with full power of substitution and revocation to prosecute this Opposition and to transact all business in the United States Patent and Trademark Office in connection therewith.

Respectfully submitted,

/Brian M. Davis/

Brian M. Davis
Attorney for Opposer
VLP Law Group LLP
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Suite 400
Charlotte, NC 28210
(704)245-6515
bdavis@vlplawgroup.com

CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that this correspondence is being filed via electronic means through the Electronic System for Trademark Trial and Appeals on August 5, 2013. A copy of the foregoing *Notice of Opposition* was served by placing a copy in U.S. Mail, postage prepaid, on this same date and addressed to the following attorney of record:

Joseph R. Englander
Shutts & Bowen LLP
200 E Broward Blvd Ste 2100
Fort Lauderdale, Florida 33301-1972

/Brian M. Davis/
Brian M. Davis
VLP Law Group LLP
Attorney for Opposer
Date of Signature: August 5, 2013