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

Proceeding	91211873
Party	Plaintiff Green Ivy Educational Consulting, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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GREEN IVY EDUCATIONAL CONSULTING, LLC, :  
Opposer, : Opposition No. 91211873  
-against- : Serial Nos.: 85775379, 85775380  
and 85775382  
GREEN IVY HOLDINGS LLC, :  
Applicant. : Marks: GREEN IVY, GREEN  
IVY SCHOOLS and GREEN  
IVY LEARNING

**OPPOSERS' REPLY MEMORANDUM IN  
SUPPORT OF ITS MOTION FOR RECONSIDERATION**

Green Ivy Educational Consulting, LLC (“Opposer” or “GIEC”), submits this memorandum in further support of its motion, pursuant to 37 C.F.R. §127(b) for reconsideration of its motion under 37 C.F.R. § 2.127 and Rule 56 of the Federal Rules of Civil Procedure (“FRCP”) for summary judgment in favor of Opposer refusing registration of GREEN IVY, Serial No. 85775379, GREEN IVY SCHOOLS, Serial No. 85775380, and GREEN IVY LEARNING, Serial No. 85775382 (collectively, the “Marks Under Application”), filed by Green Ivy Holdings LLC (“GIH” or “Applicant”).

**PRELIMINARY STATEMENT**

Opposer has identified several errors in the Board’s November 5, 2014, order denying GIEC’s motion for summary judgment, including the failure properly to consider evidence and the misapplication of the burden of proof regarding the relatedness of the services at issue. In its opposition to this motion, Applicant does not dispute the facts or standards cited by Opposer, but instead argues that such a motion is not properly made and that GIEC “attempts to shirk its burden of proof.” Applicant’s Response in Opposition to Request for Reconsideration (“Opp.”) 4 (Dec. 23, 2014). Of course, GIEC in no way wishes to avoid its burden – it simply respectfully

requests the Board’s reconsideration of its application of that burden based on an accurate statement of the relevant standard. Moreover, regardless of Applicant’s distracting arguments regarding certain exhibits, the Homayoun Declaration alone is sufficient evidence to meet GIEC’s burden for purposes of summary judgment, and GIEC has relied not only on the Declaration, but also on Ms. Homayoun’s sworn deposition testimony. Opposer has provided undisputed evidence of both its seniority of use of GREEN IVY and the relatedness of its services to those of GIH – the only issues on which the Board based its ruling – and is entitled to summary judgment.

## **ARGUMENT**

### **I. OPPOSER’S MOTION FOR RECONSIDERATION IS PROPER, AND SUMMARY JUDGMENT SHOULD HAVE BEEN GRANTED**

Applicant spends much of its response arguing that Opposer’s motion for reconsideration is improper, yet admits that TBMP provides for such a motion when “based on the facts before [the Board] and the applicable law; the Board’s ruling is in error and requires appropriate change.” TBMP § 518. This is precisely the case at issue here, as summary judgment should have been granted for the Opposer based on the facts and law before the Board.

#### **A. The Uncontroverted Evidence Demonstrates That There Are No Disputed Material Issues of Fact**

GIEC has presented uncontroverted evidence that meets its burden of establishing the elements of its claim under the relevant standards. Ms. Homayoun’s Declaration and the transcript submitted by Applicant with its opposition to the motion for summary judgment establish both Opposer’s priority of use and the likelihood of confusion given that GIH not only intends to use marks featuring the dominant element GREEN IVY, which GIEC has been using since 2004, but also intends to use it in connection with the same or similar educational services provided by GIEC. While Applicant emphasizes that the Board ruled that these issues were not

“necessarily the only issues that remain for trial,” Applicant has not disputed any other fact or issue, nor could it.<sup>1</sup>

With respect to Opposer’s prior use, the Board ruled that there is a dispute as to the date when Opposer began to offer “each of its educational services,” and questioned whether GIEC’s “mark was used in connection with *all of the relevant services* on a date prior to the filing date of the opposed application.” (Opinion at 3). However, GIEC had no obligation to prove use of *all the services* prior to the date of Applicant’s filing – just *one* service related to those proposed to be offered by Applicant is sufficient to establish a likelihood of confusion. Opposer has clearly met this burden, as it is undisputed that Opposer began using the GREEN IVY mark (or at a minimum, the mark GREEN IVY EDUCATIONAL CONSULTING, which is identical to the mark GREEN IVY aside from additional descriptive language<sup>2</sup>) in 2004, and continued adding services to those provided under that mark in the following years. *See, e.g.*, Homayoun Decl. ¶¶ 8-9, 14, 17 (GIEC began offering tutoring in 2004, newsletters with information on education, schools, and professional development in 2009, and consulting on curriculum development in 2010); Homayoun Tr. 81:12-18 (first use date was March 30, 2004); *see also id.* at 13:22 – 18:13 (discussing press highlighting Opposer’s work with students under the GREEN IVY and

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<sup>1</sup> Instead Applicant continues to focus on what it perceives as a distinction between Ms. Homayoun as an individual and GIEC as a company, in an effort to suggest that GIEC has not used GREEN IVY in commerce. However this is not supported by the facts, since the record clearly shows GIEC has used GREEN IVY in connection with its services. Surely it is obvious that GIEC cannot as a company take action without a human being taking that action – Ms. Homayoun has provided sworn testimony that states that she is the Founder and Director of GIEC, Homayoun Decl. ¶ 1, that she adopted the marks at issue in order to designate the source of her educational and consulting services in 2004, *id.* at ¶8, and that – for example – even when she herself is presenting GIEC’s work at conferences throughout the United States, she distributes materials including the GREEN IVY mark, *id.* at ¶¶ 15, 19; *see also* Homayoun Tr. at 84:25-86:1 (payment for speaking engagements deposited in GIEC account, materials used at speaking engagement will bear GREEN IVY mark).

<sup>2</sup> Instead of disputing whether Opposer is a prior user, Applicant has attempted to argue that it is unclear whether GREEN IVY EDUCATIONAL CONSULTING or GREEN IVY is the Opposer’s mark or that GREEN IVY EDUCATIONAL CONSULTING rather than GREEN IVY is the mark used by Opposer. Regardless, even if GIEC’s mark could be determined to be GREEN IVY EDUCATIONAL SERVICES, “green ivy” is the dominant portion, and there was clearly use in one form or the other, or both, well in advance of Applicant’s registration date. In light of this, which mark was used is immaterial.

GREEN IVY EDUCATIONAL CONSULTING marks from 2008 through the present). The only *material* fact at issue here is Opposer’s first use in connection with a relevant service (namely, educational services), and in this case that date is indisputably prior to the intent to use application filed by Applicant on November 9, 2012. There is thus no dispute of material fact sufficient to avoid summary judgment on the question of Opposer’s prior use.<sup>3</sup>

With respect to the likelihood of confusion between GIH and GIEC’s GREEN IVY marks, the Board found a disputed issue with respect to only the relatedness of the services offered by these two entities. Especially where, as here, the Applicant does not dispute the conceptual strength of “green ivy,” the dominant element of all marks at issue (not to mention the channels of trade or the similarity of the marks), the evidence in the record is more than sufficient to show that the services are sufficiently related to establish a likelihood of confusion. *See, e.g., Hilson Research, Inc. v. Society for Human Resource Mgmt.*, 27 U.S.P.Q. 2d 1423, at \*9 (TTAB 1993) (given similarity of marks, both of which “comprise the letters “HR”, with a common right leg of the ‘H’ and left leg of the ‘R,’” still a likelihood of confusion even where the Board “readily acknowledge[d] that Hilson’s testing services are different from Society’s association services” as the services need only be “related in some manner”). This evidence includes Ms. Homayoun’s statement in her Declaration (as well as her sworn testimony) that GIEC provides tutoring services, including teaching or instructing of students.<sup>4</sup> Homayoun Decl. ¶9 (Since its inception, GIEC has worked with elementary and secondary school students

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<sup>3</sup> Ms. Homayoun submitted her declaration on personal knowledge, and as the founder and CEO of GIEC she is clearly in a position to know when GIEC commenced use of the mark. As set out more fully in Opposer’s motion for reconsideration, the statements made in her declaration alone are sufficient to establish this fact for purposes of summary judgment pursuant to Federal Rule of Civil Procedure 56(c) (as is her sworn testimony, which was put into the record by Applicant).

<sup>4</sup> Applicant acknowledged that GIEC provides these services. *See, e.g., Applicant’s Response in Opposition to Opposer’s Motion for Sanctions and For Summary Judgment (“SJ Opp.”) Sect. III(e) (July 23, 2014)* (acknowledging evidence shows GIEC provides tutoring and consulting services).

during school hours and after school to provide tutoring and learning support services and programs focused on helping students improve their academic performance). This service is directly related to GIH's purported "classroom instruction" "after school educational and enrichment programs." *See, e.g.*, Application of GIH for the GREEN IVY Mark at 2 (Nov. 9, 2012). Moreover, Applicant acknowledges that it is "undisputed" that "Applicant seeks registration for, *inter alia*, "curriculum development." SJ Opp. Sect. III(e). The "curriculum development" to be offered by GIH is the *exact same service* as the "curriculum development" that GIEC has offered since 2010. Homayoun Decl. ¶¶ 11, 14, 22 (discussing GIEC's consulting services); Homayoun Dep. Tr. 22:7-11 ("We perform *curriculum development* in schools, so schools hire us, and we help them with organization, time management and a wide range of curriculum development" (emphasis added)). On summary judgment, Applicant admitted that Opposer provides these services, but relabeled them "consultant" services in an effort to draw a meaningless distinction. SJ Opp. Sect. III(e).

Tellingly, Applicant does not dispute the similarity of the services provided by GIH and GIEC in its opposition to this motion, instead arguing that Opposer's request for reconsideration should be denied because it is attempting to rely on additional evidence in the form of the dictionary definition of "tutoring." Of course, Opposer's motion for reconsideration is not based solely on that definition – the motion is based on the undisputed facts in the record as outlined above and in the motion for reconsideration. Should the Board wish to take notice of the definition, however, it is entitled to do so under the TBMP. Indeed as Applicant acknowledges, "[t]he Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute... whether or not it is requested to do so." Opp. 5 (quoting TBMP sect. 704.12(b)).

It appears that the November 5, 2014, decision also misapplied the legal standard in assessing Opposer's burden with respect to the services offered. Opposer need only prove "that the respective goods of the parties be related *in some manner*, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or *could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source.*" See *Hilson Research, Inc. v. Society for Human Resource Mgmt.*, 27 U.S.P.Q. 2d 1423 (TTAB 1993) (citation omitted) (emphasis added); *In re Int'l Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910 (TTAB 1978). Particularly here, where the marks and channels of trade are identical, this burden has certainly been met – indeed Opposer cited instances of *actual* confusion between GIH and GIEC's services that have already occurred. Motion for Summary Judgment 22-24 (June 18, 2014).

Opposer's tutoring and consulting services are certainly related (if not exactly the same) to the services that GIH intends to offer, including before and after school enrichment services and consulting and curriculum development services. *All* of the services offered by both GIH and GIEC are educational in nature. There can be no that Opposer has met is burden as to the relatedness of the services. Since Opposer has met its initial burden, the burden shifts to GIH to demonstrate that there is a genuine issue of material fact, and GIH has in no way established a specific genuinely disputed facts as to the relatedness of the services offered by GIH and GIEC under these nearly identical marks. See, e.g., *Marquez Bros. Int'l, Inc. v. Zucrum Foods, L.L.C.*, 2009 WL 4956033, at \*2 (TTAB Dec. 11, 2009).

**CONCLUSION**

For the foregoing reasons, summary judgment should have been granted and GIEC requests reconsideration of the denial of summary judgment.

Dated: January 21, 2015  
New York, New York



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**CERTIFICATE OF SERVICE**

I hereby certify on this 21<sup>st</sup> day of January 2015, I caused to be served a true and correct copy of the foregoing OPPOSERS' REPLY MEMORANDUM IN SUPPORT OF ITS MOTION FOR RECONSIDERATION via U.S. first class mail, postage prepaid, on the following parties:

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