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

Proceeding	91211873
Party	Defendant Green Ivy Holdings LLC
Correspondence Address	JOSEPH R ENGLANDER SHUTTS & BOWEN LLP 1100 CITYPLACE TOWER, 525 OKEECHOBEE BOULEVARD WEST PALM BEACH, FL 33401 UNITED STATES ptomail@shutts.com, dbarsky@shutts.com, mlerner@ssbb.com, jm-cardle@ssbb.com
Submission	Opposition/Response to Motion
Filer's Name	Daniel J. Barsky
Filer's e-mail	dbarsky@shutts.com, aarce@shutts.com
Signature	/daniel j. barsky/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GREEN IVY EDUCATIONAL
CONSULTING, LLC,

Opposer,

v.

GREEN IVY HOLDINGS LLC,

Applicant.

Opposition No. 91211873

Serial Nos.: 85775379, 85775380, and
85775382

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

APPLICANT’S RESPONSE TO OPPOSER’S MOTION FOR SANCTIONS

Applicant, Green Ivy Holdings LLC, responds in opposition to Opposer, Green Ivy Educational Consulting, LLC’s, Second Motion for Sanctions. Contrary to the contentions of the Motion, there are not ‘continued failings’ on the Part of Applicant, only one mistake, which was promptly remedied. Applicant has not violated any orders issued by the Board and its discovery mistakes have been harmless and unintentional. For these reasons, the extreme sanction of entry of Default Judgment against Applicant is improper and the Motion for Sanctions should be denied.

STATEMENT OF FACTS

Opposer sets forth its version of the facts in the Motion for Sanctions in a series of nine categories of complaints. Applicant will respond to each category of facts in turn. Applicant’s statement of facts is supported by the Declaration of Jones, annexed hereto as Exhibit A.

1. Information Regarding Applicant’s Investors.

First, any accidental failure to provide full and complete discovery on this subject is completely harmless as the identity of the investors, if any, in Applicant is completely irrelevant

to whether there is any risk of confusion between Applicant's marks and Opposer's alleged marks. For this reason alone, the imposition of the extreme remedy of default judgment is improper.

Second, Opposer drastically overstates the situation. Ms. Jones stated that there were investors but had no knowledge of how many, who, how much they had invested, the structure of the investment, or anything else with respect to any investment in Applicant. Jones Dep. Tr. 17:11-20:20. Ms. Jones directed Opposer to Mr. Jonathan Sanchez-Jaimes, who had been offered for deposition to Opposer, an opportunity that Opposer declined. However, Applicant will provide Opposer with the identity of any investor in Applicant.

2. Applicant's Financial Records.

Opposer again overstates its position. Opposer is relying on the fact that the Marks were used in commerce on or before November 28, 2012 yet no annual financial figures existed as of March 24, 2014 (the date of the discovery responses). What Opposer ignores is the fact that documents provided to Opposer in discovery, some of which are included in Opposer's Motion for Sanctions, clearly state that the first school year for the first school operated by Applicant (which is how Applicant generates revenue) did not begin until September 2013. Thus, as of the date of the discovery answers, there were no annual financial figures from operations of the Applicant using the Marks because Applicant had not completed a full year of revenue generating business. Ms. Jones testimony was not incorrect, Applicant does maintain financial information as it must legally do so, but Ms. Jones could not have known the annual revenue for the single school because, at the time of her deposition (April 22, 2014), the school had not been open for a year (it opened in September 2013). Now that the school has been open for more than a year, and has thus produced revenue for more than a year, annual and periodic financial figures

do exist and have been compiled, and, as set forth in the Declaration of Jones, Applicant is producing those figures to Opposer. Applicant has committed no discovery violation with respect to its financial records. Opposer ignores the fact that Applicant is a start-up operation and did not have fully formed financial figures at the time of Opposer's discovery requests in an attempt to induce the Board to enter judgment against Applicant so Opposer does not have to meet its burden of proof.

3. Applicant's Advertisements.

Regrettably, Opposer is correct that Applicant, without knowledge of undersigned counsel, unilaterally limited the time period for which it collected the advertising materials Applicant had in its care, custody, or control. Immediately after the deposition of Jennifer Jones – which Opposer correctly states was the first time undersigned counsel learned of Applicant's mistake – undersigned counsel explained to Applicant why what they did was wrong and how they must immediately search for all documents and not unilaterally limit their search. Applicant responded with the additional materials on May 22, 2014, *see* Exhibit B. Applicant can do nothing more than admit its mistake and sincerely apologize for its actions.

The remainder of Opposer's complaints regarding this category of documents appears to be limited to the fact that there are not many additional documents, that the documents are undated, and that an image of a postcard contains only the front of the document. These complaints are again illustrative of Opposer's true motive of trying to avoid proving its case. After Applicant provided the additional documents to Opposer on May 22, 2014, Opposer never complained or asked any questions of Applicant and, instead, simply filed its first Motion for Sanctions combined with its Motion for Summary Judgment. If Opposer was uncertain whether there were any additional documents they could have simply asked. Opposer should not be

surprised that there are not many advertising materials; as Ms. Jones testified in her deposition, Applicant had only ever developed one brochure for use in advertising, and that brochure was for the recruitment of employees, specifically teachers, and *not* for the solicitation of business. *See* Jones Dep. Tr. 78:21 – 79:9. Though the additional documents were provided as electronic files, if Opposer was uncertain as to the specific date of any document, again, a simple phone call or email was all that was necessary.

Applicant cannot deny that it made a mistake, and for that it again apologizes. However, the mistake was innocent and harmless, and the sanction of default judgment is not warranted.

4. Outside Public Relations Firm Information.

Opposer is incorrect in its belief there are documents prepared by an outside marketing group that are relevant, responsive, and have not been provided to Opposer. Opposer uses selective editing of Ms. Jones' deposition testimony to make it appear that Applicant has engaged in substantive marketing research and analysis but refused to provide documents responsive to discovery requests. This is simply not the case.

Opposer cites to multiple pages of Ms. Jones' deposition transcript to support its allegations, but begins the citation too late and ends it too early. Opposer excludes the opening question and response for the cited line of questioning:

Q. Has GIH ever used a publicist?

A. We haven't used a publicist yet. We do have a PR firm.

Jones Dep. Tr. 72:23-25. Thus, immediately, it is clear that there is no publicist and therefore no discovery relating to publicity practices and targeting by Applicant.

While Ms. Jones does state there is a PR firm – Cooper Katz – she clarifies that their work is *not* for the areas of sought-after documents: types and classes of consumers, markets and

channels of trade, intent to use the marks, and research and surveys for any mark using the term ‘green ivy’. Specifically, Cooper Katz provided advice,

A. Well, the services to date were media training for me, help in developing the messaging, what we would say about our brands, about our services and products, our schools. They have helped us with development of our focus and targets for enrichment programming, who we would seek out and what kinds of programs we would offer. They arranged an interview for me with a local – another local newspaper, it’s called the Downtown Express.

Jones Dep. Tr. 73:8-17. Ms. Jones continued to specify what she meant by ‘targeting’,

A. When I said targeting I was talking about thinking specifically about our enrichment programs. When we came to them to ask for help with that we didn’t have a focus. We had a general idea about what we wanted the programming to be. And it needed to be focused and pared down. So they helped us identify areas of enrichment programming that we should focus on and target. That’s what I meant by that.

Q. What were those areas that you decided to focus on?

A. The arts, athletics. I should remember this. Science. And what we sort of refer to internally as soft academics. So after school and summer break programming that has an academic quality to it but with a lighter feel.

Id. at 76:7-23. Thus, it is clear from Ms. Jones’ testimony that there is no publicist and the Cooper Katz firm works with Applicant not for purposes related to the selection and promotion of the Marks, but for the development of the schools themselves, including their educational programming. Applicant has not withheld any relevant documents and the Motion for Sanctions should be denied.

5. Information on Applicant’s Domain Names.

While it is true that Applicant currently owns three URL domain names, only one of those domains was used for the marketing and sale of Applicant’s school at the time of the discovery requests – <http://www.greenivyschools.com>. At that time, <http://www.greenivy.com>

was registered but blank. Finally, as part of the process of responding to the Motion for Sanctions, Applicant again reviewed the produced materials and potentially relevant materials, and noticed that a single image on the website <http://www.bmpreschool.com> previously contained the words “Green Ivy” and could possibly be very liberally construed as a ‘marketing material’. Thus, while Applicant does not have in its possession a copy of the historic webpage, Applicant will retrieve a copy from the public records and provide same to Opposer. However, as is clear from the documents produced, greenivyschools.com was the marketing and sales website. Again, Applicant does not believe any discovery violation has occurred, and if one has occurred it is a minor violation consisting of a single image used on a single webpage, and does not rise to the level of the extreme sanctions sought by Opposer.

6. Emails Sent to the GIH Email List.

As set forth in the Declaration of Jones (Exhibit A), all responsive documents in the care, custody, and control of Applicant have been produced. Applicant did re-review its files to see if it had maintained any of the subject emails that contained the Green Ivy mark, but there were none. Again, a simple phone call or email from Opposer’s counsel to Applicant’s counsel would have obviated the need for the Motion for Sanctions.

7. Open House Materials.

Opposer’s complaint seems to be that there should be more documents than have been produced. Quite simply, there are not, as set forth in the Declaration of Jones (Exhibit A). If Opposer had questions about the differences between the documents originally and subsequently produced, or questions about the dates of the documents, they could have asked and had the issue clarified by Applicant. Again, there is no basis for discovery sanctions.

8. Applicant and Sign-Up Materials.

The application and sign-up materials for the Applicant's school did not use the Marks and therefore were not responsive to this group of discovery requests. This is part of the common theme that Applicant refers to their schools by name – Battery Park Montessori and Pine Street School – and not as “Green Ivy School” or something similar. Again, had Opposer contacted Applicant instead of filing a motion for sanctions, Applicant would have provided the non-responsive documents to Applicant as a sign of good faith. Nevertheless, the applications are freely available online at Applicant's website and Applicant will provide copies of the non-responsive documents to Opposer.

9. Name Selection Spreadsheets.

Finally, Opposer complains that prior versions of a name selection spreadsheet that was previously produced were not produced by Applicant. The prior version were not produced because they were overwritten and no longer exist. Because the documents do not exist they cannot be produced and there is no basis for entry of discovery sanctions.

ARGUMENT

Opposer's argument that “Applicant has again and again delayed or failed to respond to GEIC's discovery requests and has willfully ignored its obligations under the TBMP and FRCP” is substantially overstated. Regrettably, Applicant cannot deny that it did not timely respond to Opposer's discovery request or that Applicant, without counsel's knowledge, unilaterally limited the timeframe within which it searched for documents. For these transgressions the Applicant profusely apologizes and has acted with haste to remedy the deficiencies. However, Opposer has not “again and again” delayed or failed to respond, and it has not repeatedly violated orders of the Board. As set forth above, there was only one delay, that resulted in a single order, Applicant

promptly complied with that Order and, when it was noticed that Applicant made a mistake in compliance with that order, Applicant acted quickly to remedy that mistake.

Applicant does not disagree with the cases cited as they pertain to stating the law on the issue of discovery sanctions. Applicant disagrees with Opposer's position that the harshest sanction possible should be applied. As TBMP § 527.01(a) states "[d]efault judgment is a harsh remedy . . ." Even the cases cited by Opposer support the position that default judgment is the harshest remedy and is only used sparingly as Opposer's cited cases all involve *repeated failures to comply with orders, patters of dilatory conduct indicating willful disregard of Board order, and failure without justification to comply with a Board order*. See Motion for Sanctions at p. 19. There has been no repeated failure to comply with a Board order; only one order has been issued on discovery and Applicant timely complied with that Order. Admittedly, as noted above, Applicant unilaterally limited the time frame within which it searched for responsive documents, but as soon as Applicant's counsel learned of that mistake he directed Applicant to redo its document search and provided the responsive documents to Opposer, without the need for a new motion or order from the Board. Likewise, there is no pattern of dilatory conduct, Applicant failed to timely respond to Opposer's first discovery requests only; Applicant has made its witnesses available and promptly remedied its discovery deficiency when it was discovered. These facts do not rise to the level of the cases cited by Opposer and do not support the sanction of entry of default judgment against Opposer.

Moreover, Opposer has suffered no harm. Despite the alleged systemic discovery violations, Opposer was able to move for summary judgment. That motion was denied, not because Opposer lacked any discovery from Applicant but because Opposer could not prove the extent of its own use of its own alleged marks. To the extent Opposer may claim it has been

harmful by having to file a Motion to Compel and the instant Motion for Sanctions, as to the Motion for Sanctions, as noted above, most, if not all, of the issues raised in that motion could have been resolved had counsel for Opposer simply spoken or corresponded with counsel for Applicant. Opposer contends that “[a]t no time has Applicant proffered any explanations or justifications”, but Applicant would not try to proffer an explanation or justification when it has produced the responsive documents it has in its care, custody, or control

Opposer may not like the fact there are not many documents, but the documents Opposer thinks must exist simply do not. *See* Exhibit A. Opposer has never inquired *why* Applicant has used the Marks sparingly. Instead, Opposer assumed that Applicant is simply being obstructionist, and is now trying to use that faulty assumption to induce the Board to enter a default judgment against Applicant so Opposer does not have to meet its burden of proving its case. For these reasons, Opposer’s Motion for Sanctions should be denied.

CONCLUSION

Applicant admits that it made a mistake by delaying in its responses to Opposer’s first discovery requests and when it limited the time frame within which it searched for documents. Applicant cannot fix or change those facts and apologizes for its mistakes. However, there is not a repeated failure to provide discovery or to comply with Board orders. When ordered, Applicant timely provided discovery responses and immediately fixed the deficiency within those responses. These facts, and the facts set forth above, do not rise to the level that supports entry of the harshest of sanctions: entry of default judgment. Opposer’s Motion for Sanctions should be denied.

WHEREFORE, Applicant requests the Board enter an Order denying Opposer’s Motion for Sanctions, and for such other and further relief as the Board deems reasonable.

Dated: April 6, 2015

SHUTTS & BOWEN LLP
Counsel for Applicant
Green Ivy Holdings LLC
1100 CityPlace Tower
525 Okeechobee Boulevard
West Palm Beach, FL 33401
561-835-8500(ph)/561-650-8530(fax)

By: /s/ Daniel J. Barsky
Daniel J. Barsky
Florida Bar No. 25713

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served this 6th day of April, 2015, via e-mail and United States First Class Mail, postage prepaid, on:

Mark Lerner, Esq.
Jennifer Philbrick McArdle, Esq.
Satterlee Stephens Burke & Burke LLP
Attorneys for Opposer
230 Park Avenue
New York, NY 10169
mlerner@ssbb.com
jmcardle@ssbb.com

 /s/ Daniel J. Barsky
Daniel J. Barsky

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85775382

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

DECLARATION OF JENNIFER JONES

I, JENNIFER JONES, declare, pursuant to 28 U.S.C. § 1746, the following:

1. I am a managing member of Applicant, Green Ivy Holdings LLC.
2. I have reviewed the discovery requests made by Opposer, Green Ivy Educational Consulting, LLC, in the above-captioned matter and the answers thereto. I was the individual that prepared and provided the documents responsive to the discovery requests made by Opposer.
3. Applicant is not withholding any relevant, responsive documents to Opposer's discovery requests.
4. The Marks sought to be registered were filed as "Intent to Use" marks. At the time of filing, Applicant was not actively in business though Applicant is currently actively conducting business.
5. Applicant has provided all documentation it has in its care, custody, or control related to the selection of the Marks. There were prior version of a spreadsheet that has been

provided to Opposer, but those prior versions were overwritten and not saved. The final version of the spreadsheet was provided to Opposer.

6. There were no marketing analysis, focus groups, consultants, strategists, or the like involved in picking the Marks. Applicant simply had a brainstorming session with various employees to pick a name they liked the best. All documents related to that process have been provided to Opposer and were provided some time ago.

7. While Applicant has employed marketing and PR consultants, those entities were not involved in the selection of, or decision to use, the Marks. They are retained to advise on other parts of Applicant's business.

8. In sum, the selection of, and decision to use, the Marks was as simple as it appears from the documents that have been produced. No document in Applicant's care, custody, or control relating to the creation and selection of the Marks has been withheld.

9. Similarly, Applicant was not intentionally withholding financial documents from Opposer. When Opposer requested annual financial statements, Applicant had not been operating for a year and thus there were no annual statements to provide. Applicant will supplement its discovery responses with annual financial statements.

10. Applicant has provided all advertisements, e-mail 'blasts', open house materials, and other, similar materials it has in its care, custody, and control. Applicant did not save copies of all these documents and has provided what it did save. Indeed, Applicant actively sought out, from third parties, materials that were not in Applicants care, custody, or control to attempt to provide those materials to Opposer. Again, Applicant has provided all documents it has in its care, custody, or control.

I declare under penalty of perjury that the foregoing is true and correct. Executed on
April 6, 2015.

A handwritten signature in black ink, appearing to read "J. Jones", written in a cursive style.

Jennifer Jones
Managing Member
Green Ivy Holdings LLC

Daniel J. Barsky

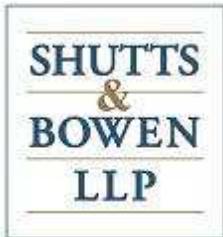
From: Daniel J. Barsky
Sent: Thursday, May 22, 2014 9:19 AM
To: 'Mark Lerner'
Cc: Jennifer P. McArdle; Susan D. Miller
Subject: RE: Green Ivy Educational Consultanting, LLC v. Green Ivy Holdings LLC, Opposition No. 91211873
Attachments: BPM POSTCARD FRONT + BACK.PSD; Parent Info Session .pdf; PSS Packet Handouts.pdf; PSS PRESENTATION FOR CB1 DEC 4 2013.pdf

Mark and Jennifer-

Our client has finished searching for additional documents. The results are attached. The one document we haven't attached is the Facebook page. Since you have access, and your client has obviously reviewed, do you really want us to print the digital document out, scan it, and then email it to you? I'm happy to do that if you so require, but it seems like a waste.

REDACTED SETTLEMENT DISCUSSIONS

Best,
Dan



Founded 1910

Daniel J. Barsky
*Partner, Admitted in Florida and Minnesota
and the United States Patent and Trademark Office*

Shutts & Bowen LLP

CityPlace Tower, 525 Okeechobee Blvd, Suite 1100 | West Palm Beach, FL 33401

Direct: (561) 650-8518 | Fax: (561) 822-5527

[E-Mail](#) | [Biography](#) | [V-Card](#) | [Website](#)

From: Mark Lerner [<mailto:mlerner@ssbb.com>]
Sent: Wednesday, May 07, 2014 6:34 PM
To: Daniel J. Barsky
Cc: Jennifer P. McArdle
Subject: Green Ivy Educational Consultanting, LLC v. Green Ivy Holdings LLC, Opposition No. 91211873

REDACTED SETTLEMENT DISCUSSIONS

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Mark Lerner
Satterlee Stephens Burke & Burke LLP
230 Park Avenue
New York, New York 10169
Direct Dial: (212) 404-8714
General: (212) 818-9200
Fax: (212) 818-9606
Email: mlerner@ssbb.com

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