UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: June 30, 2015

Opposition No. 91211873

Green Ivy Educational Consulting, LLC

v.

Green Ivy Holdings LLC

Before Seeherman, Ritchie, and Masiello,
Administrative Trademark Judges.

By the Board:

By way of background, on February 20, 2014, the Board granted Opposer's motion to compel as conceded, and ordered Applicant to serve full and complete responses, without objection, to Opposer's requests for production of documents and first set of interrogatories. On June 18, 2014, Opposer filed a combined motion for summary judgment and motion for discovery sanctions. The Board, in its order mailed June 23, 2014, advised Opposer that its combined motion would be treated solely as one for summary judgment and, after deciding the summary judgment motion, allowed Opposer to file a motion for sanctions. This case now comes up for consideration of Opposer's contested motion (filed March 6, 2015) for discovery sanctions in the nature of judgment against Applicant.[1]

[1] Applicant's consented motion to extend its time until April 6, 2015 to file a response to Opposer's motion for sanctions is granted. *See* Trademark Rule 2.127(a).

Opposer argues essentially that Applicant has exhibited a pattern of dilatory tactics and willful disregard for the Board's rules and Applicant's duty to cooperate, improperly limited its search for responsive documents, served only 24 responsive documents in response to Opposer's requests for production of documents, never provided verified interrogatory responses, and is deficient with respect to nine of Opposer's discovery requests. For these reasons, Opposer asserts that it has been unable to obtain the discovery it has requested, in particular, as to Applicant's representations regarding its intended use of its GREEN IVY marks and the channels of trade for its products and services. Opposer requests that Applicant's answer be stricken and default judgment be entered against Applicant. Opposer also argues that a lesser sanction, such as precluding Applicant's reliance on materials it has not produced, would be insufficient and would reward Applicant for withholding materials.

In response, Applicant responds to the nine discovery requests enumerated by Opposer, as follows:

1) Opposer requests information on Applicant's investors; Applicant states that it will provide[2] the identity of "any investor" to Opposer;

2) Opposer requests financial records regarding Applicant's annual sales and annual expenditures for advertising and promoting goods and services offered

[2] Regarding numbers 1, 2, 5 and 8, Applicant states that it "will provide" or "is producing" certain documents or materials to Opposer. In addition, Jennifer Jones states in her declaration that she will supplement Applicant's responses with annual financial statements (see *infra*). However, Ms. Jones also states that Applicant is not withholding any responsive documents to Opposer's discovery requests. Therefore, it appears as if Applicant may have served its additional responsive documents or materials on Opposer along with its response to Opposer's motion for sanctions. To the extent Applicant has not already served its additional responses on Opposer, a time limit to do so will be set forth at the conclusion of this order.

under the marks; Applicant states it is producing its annual sales figures to Opposer, and also states that its inappropriate limit on its search of its records was rectified when Applicant served additional documents on Opposer on May 22, 2014;

3) Opposer requests copies of advertising and promotional materials in connection with goods or services offered or intended to be offered under the marks; Applicant states it only developed one brochure for soliciting teachers, not for advertising to potential customers, and that additional documents were provided electronically to Opposer;

4) Opposer requests information regarding Applicant's outside public relations firm; Applicant states it is not using a publicist for the purposes of selecting and promoting its marks, but for the development of Applicant's schools, including enrichment programming;

5) Opposer requests information on Applicant's domain names; Applicant states that it will provide a copy of its "http://www.bpmpreschool.com" web page to Opposer;

6) Opposer requests Applicant's emails bearing the Green Ivy mark that were sent to Applicant's email list; Applicant states that none of the emails to Applicant's mailing list using the Green Ivy mark was retained by Applicant;

7) Opposer requests open house materials; Applicant essentially states that there are no other documents to produce;

8) Opposer requests application and sign-up materials; Applicant explains that Applicant's sign-up materials refer to the school where it provides its services, not to "Green Ivy School" or the like, and that it will provide copies of its on-line applications to Opposer;

9) Opposer requests all name selection spreadsheets; Applicant states that prior versions of Applicant's name selection spread sheets do not exist.

Additionally, Applicant argues that default judgment is not a proper remedy in this instance where there has been no repeated failure to obey Board orders and Applicant timely complied with the Board's order compelling production of information and materials. In support of its response, Applicant has submitted the declaration of its managing member, Jennifer Jones, who states that Applicant is

not withholding any relevant, responsive documents to Opposer's discovery requests (¶3); that Applicant has provided all documentation it has in its care, custody, or control related to the selection of its marks (¶¶5-8); that at the time Applicant received Opposer's discovery requests, there were no annual statements to provide, but that it will supplement its discovery responses with annual financial statements (¶9); and that Applicant has provided to Opposer all advertisements, email 'blasts,' open house materials, and the like, which Applicant has in its custody, care or control (¶10).

Under Trademark Rule 2.120(g)(1), if a party fails to comply with a Board order compelling discovery, the Board may order appropriate sanctions, including any provided in Fed. R. Civ. P. 37(b)(2). *See MHW Ltd. v. Simex, Aussenhandelsgesellschaft Savelsberg KG,* 59 USPQ2d 1477 (TTAB 2000), *cited in HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1904 (TTAB 2008). The sanctions which may be entered include striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. *See* TBMP Section 527.01(a) (2014).

Opposer has not contested Applicant's assertions that it has provided additional responsive materials to Opposer since the filing of the present motion. Applicant has also clarified that certain information sought by Opposer does not exist. Additionally, we do not find that Applicant's actions are at a level that default

judgment should be entered. In view of the foregoing, Opposer's motion for sanctions in the nature of default judgment is **denied**. Nonetheless, inasmuch as Opposer was forced to file a motion to compel and a motion for sanctions to obtain appropriate responses to its discovery requests, we find the following sanction to be appropriate:

> To the extent that Applicant failed to respond fully to Opposer's discovery requests prior to the filing of Opposer's motion for sanctions, we impose the estoppel sanction. Specifically, Applicant is advised that **it cannot submit or make of record at trial any information or documents in existence prior to the filing of Opposer's motion for sanctions that were the subject of Opposer's discovery requests but were not served on Opposer prior to the filing of Opposer's motion for sanctions**.[3]

See Fed. R. Civ. P. 37(c)(1). *See also National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer's exhibits identified in applicant's brief as within the scope of documents requested by applicant but not produced by opposer during discovery, excluded from consideration); and TBMP § 527.01(e) (2014).

Applicant is also reminded that parties have a continuing duty to supplement discovery responses "in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or

[3] To be clear, Applicant's responsive documents and/or materials served on Opposer in response to Opposer's motion for sanctions, including annual financial statements referenced in Ms. Jones' declaration, are subject to the estoppel sanction. Other documents and/or materials properly supplemented in accordance with Fed. R. Civ. P. 26(e)(1) are not subject to the estoppel sanction.

corrective information has not otherwise been made known to the other parties during the discovery process or in writing." Fed. R. Civ. P. 26(e)(1)(A). *See, e.g., Hunter Indus., Inc. v. The Toro Company*, 110 USPQ2d 1651 (TTAB 2014); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750 (TTAB 2013); and TBMP § 408.03 (2014). Therefore, should Applicant find additional information or materials that are responsive to Opposer's previously served discovery requests, Applicant should promptly supplement its responses.

Finally, it is unclear from the record whether Applicant has served on Opposer properly verified responses to interrogatories or documents and/or materials responsive to request numbers 1, 2, 5 and 8 *supra*. If Applicant has not done so, Applicant must serve verified responses to interrogatories and all responsive documents and/or materials on Opposer no later than **TEN DAYS** from the mailing date of this order.

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Plaintiff's 30-day Trial Period Ends	**8/29/2015**
Defendant's Pretrial Disclosures Due	**9/13/2015**
Defendant's 30-day Trial Period Ends	**10/28/2015**
Plaintiff's Rebuttal Disclosures Due	**11/12/2015**
Plaintiff's 15-day Rebuttal Period Ends	**12/12/2015**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN**

THIRTY DAYS after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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