

ESTTA Tracking number: **ESTTA737157**

Filing date: **03/31/2016**

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

Proceeding	91226194
Party	Defendant Greenheart Creative
Correspondence Address	MATTHEW H. SWYERS ESQ. THE TRADEMARK COMPANY 344 MAPLE AVE W # 151 VIENNA, VA 22180-5612  mswyers@thetrademarkcompany.com
Submission	Answer
Filer's Name	Kelly Greenheart
Filer's e-mail	kelly.greenheart@gmail.com
Signature	/Kelly V Greenheart/
Date	03/31/2016
Attachments	Answer to Notice of Opposition 3.31.16.pdf(63814 bytes )

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

In the Matter of:

Notice of Opposition to Trademark Application Serial No. 86501859

Published: December 29, 2015

Mark: Greenheart TV

GREENHEART INTERNATIONAL	)	
	)	
Opposer,	)	
vs.	)	
	)	
GREENHEART CREATIVE.	)	OPPOSITION NO. 91226194
	)	
Applicant	)	

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Commissioner of Trademarks  
Post Office Box 1451  
Alexandria, VA 22313-1451

Applicant, Greenheart Creative, is a Texas Limited Liability Company with its principal place of business currently located at 4836 Trail Crest Circle, Austin, Texas 78735 (“Applicant”) that believes the grounds for opposition are mistaken by the opposer, Greenheart International, with its principal place of business located at 712 N. Wells Street, Chicago, Illinois 60654 (“Opposer”). Furthermore, the applicant is without knowledge or information sufficient to form a belief as to the truth of some averments made by the opposer, thus having the effect of a denial. The applicant also mounts a defense attacking the validity of the registration of trademark application no. 86582865 and no. 86582893 pleaded in the opposition, in effect making a motion for a compulsory counterclaim.

Applicant hereby pleads and avers as follows:

1. Answering Paragraph 1 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly denies the allegations.
2. Answering Paragraph 2 of the Notice of Opposition, Applicant admits the allegations thereof, that opposer is the owner of the U.S. Reg. No. 4587123 for the design mark.
3. Answering Paragraph 3 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.
4. Answering Paragraph 4 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.

5. Answering Paragraph 5 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.

6. Answering Paragraph 6 of the Notice of Opposition, Applicant admits the allegations thereof.

7. Answering Paragraph 7 of the Notice of Opposition, Applicant admits the allegations pertaining to filing date of Application Serial No. 86501859. Applicant denies first use anywhere and first use in commerce dates alleged by Opposer. The opposer is mistaken in citing the applicant's "first anywhere as January 11, 2014 and in commerce as May 11, 2014." The applicant has dismissed their legal counsel on grounds of untimely response, poor counsel related to and resulting in the improper filing of first use related to the registration of the word mark's web domain name, instead of the actual first use which pre-dates disputed relation with "Greenheart Transforms". The applicant has evidence of a first use in commerce in 08/00/2009, and a first anywhere that the applicant believes may precede any claim from the opposer.

8. Answering Paragraph 8 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.

9. Answering Paragraph 9 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.

10. Answering Paragraph 10 of the Notice of Opposition, the opposer is mistaken in citing first use dates of the applicant as factual information, as cited in the aforementioned answer (7).

11. Answering Paragraph 11 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to verify or form a belief as to the allegations contained therein and accordingly denies the allegations.

12. Answering Paragraph 12 of the Notice of Opposition, Applicant admits the allegations thereof, though the applicant believes the opposer to be mistaken in assuming the applicant needs consent or authorization from the opposer in order to file registration for the mark GREENHEART TV.

13. Answering Paragraph 13 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

14. Answering Paragraph 14 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

15. Answering Paragraph 15 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

16. Answering Paragraph 16 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

17. Applicant further affirmatively alleges that the primary services offered by the opposer, namely “foreign exchange programs” for which they are most well-known for in the trade, are distinctively different than the services offered by the applicant, namely, ‘video production and providing live and on-going television programming’, for which the applicant’s owner has a history of performing in the television & entertainment industry since as early as 1999. The applicant’s clients, namely networks including The Discovery Channel, ESPN, and other commercial clients are significantly different than the opposer’s primary customer-base, which are comprised of foreign-exchange students.

18. Applicant further affirmatively alleges that the opposer filed for trademark application no. 86582865 and no. 86582893 on 03/31/15 and no. 86905466 on 2/11/16 as a direct response to becoming aware of the applicant’s trademark application no. 86501859 filed 01/13/15. The applicant believes the opposer filed application serial nos. 86582893, 86582865, and 86905466 retroactively with intent to do harm on the applicant, as evidenced by the opposer’s application filing dates submitted after the applicant’s filing date’s posting to The Gazette.

19. Applicant further affirmatively alleges that though both appropriately classified as Section 41, the only service remotely similar between applicant and opposer, is the opposer’s interest in providing programs in Meditation. The applicant’s entertainment service of stage hypnosis offered by an individual entertainer, Greenheart Creative partner “Jeffrey ‘Jefe’ Greenheart”, is distinctively different and should not be grounds for confusion.

20. Applicant further affirmatively alleges that the applicant has unique and distinctive grounds for using the word mark, as it is a direct reference to the legal last name “Greenheart” held by the partners of Greenheart Creative (applicant), husband-wife team Kelly Greenheart and Jeffrey Greenheart.

21. Applicant further affirmatively alleges that the applicant has conflicting information of opposer’s exclusive use and recognition in commerce pertaining to the “GREENHEART” word mark, citing overwhelming evidence of other related companies using the word mark without restriction, including “Greenheart Global” (no. 3788815, 3788814, 3555483, 3542117), “Greenheart Farms” (no. 3685101), “Greenheart Games”(no. 4454770), “Growing Green Hearts” (no. 4691097, 4802519), “Greenheart Construction”(no. 85895247), “3 Green Hearts” (no. 86668464), “Treetures Green Heart” (no. 4694778), “Greenheart Project”, “Greenheart Juice Shop”, and “Greenheart Family Farms” in industries directly related to the Opposer’s interests.

22. Applicant further affirmatively alleges that the applicant’s core clients and consumer-base are distinctively different entities than those of the opposer. Any relation to the opposer’s target consumer-base with the inspirational content about the work the applicant does, is purely coincidental. The applicant’s website attracts specific fans of the creative work of Kelly and Jefe Greenheart, as evidenced on the domain Greenheart.tv and social media interactions. The applicant is closely tied with two artistic personalities with celebrity-status in their specific field. The late U.S. Supreme Court Justice Antonin Scalia (passed last month) cited most corporations as “indistinguishable from the individual who owns them.” (NY Times

*The Rights of Corporations*). Thus, the defendant counterclaims that significant damages would result from these opposition proceedings, should they set a precedent that would disconnect the applicant's partner's public fame from the work they are most known for, impeding their ability to make a living. The applicant's last name is synonymous with television, as they have worked with top celebrities on television programs including Jim Carrey, President Barack Obama, Matthew McConaughey, Amy Poehler, Lance Armstrong, and many other household names.

23. Applicant further affirmatively alleges that the GREENHEART word and design marks of the opposer are a public commonality, so common and generic that it is one of the most popular symbols in the language of emoticons or emojis—used independently by millions of people through the most pervasive forms of global communication. Furthermore, this symbol is synonymous with love, nature, people-planet connection, spirituality, and other concepts shared as basic moral value sets by the Opposer, the Applicant, and many other affiliated organizations that retain the GREENHEART name, and therefore cannot have meaning as a trademark. The Applicant mounts a counterclaim that the opposer's U.S. Registration No. 4587123, and Serial no. 86905466 has an unfair claim to a public domain symbol even more common than the shapes and colors of symbols represented on playing cards.

24. Applicant further affirmatively alleges that Applicant has been using its mark and developing consumer recognition and goodwill in its mark for over 5 years, and opposer has done nothing and is consequently barred by laches, acquiescence, and estoppel from opposing Applicant's application.

25. Applicant further affirmatively alleges that there is insufficient information to support the opposer's claim that the applicant's use of the mark GREENHEART TV is likely to cause confusion, mistake, or deception in that consumer's are likely to believe that the Applicant's services are Opposer's services, or the services of a company that is sponsored, authorized, or licensed by the opposer. The applicant cites Trademark Law § 2.41 a (2), claiming the applicant's "substantially exclusive and continuous use in commerce...for five years" in a distinctively separate line of goods and services than the opposer.

26. Applicant further affirmatively alleges that there is insufficient information to support the opposer's claim that the applicant's use of the mark GREENHEART TV is likely to disparage and falsely suggest a connection with opposer to cause loss, damage, or injury. The applicant only seeks to represent themselves as public figures and creators of their original work and related inspirational ideas in good faith. The concept that the defendant would seek to disparage the opposer is wholly inconsistent with the values of the defendant's organization, as Greenheart Creative and their affiliated projects are known for sharing uplifting media content and messages that regularly communicate integrity and positive goodwill. As such, the surname "Greenheart" of the defendant has become synonymous with positivity, and thus they would never seek to intentionally tarnish their own good name and reputation, or do so to any other parties that may be loosely associated in fact or opinion with their public presence.

27. Applicant further affirmatively alleges the opposer to be mistaken in their claim that the applicant's use of the mark GREENHEART TV is likely to interfere with opposer's use of aforementioned marks and opposer's ability to avail itself of present and future commercial benefit resulting from its sustained financial investment in the development of the marks, thereby causing loss, damage and injury to opposer. On the contrary, the opposer's claims

create a grounds to interfere with the acceptance of the applicant's trademark application no. 86501859, and further cause loss, damage, and injury to applicant. The applicant believes it would take significant financial investment to pivot their personal brand, causing irreparable loss to applicant's small business and good name, and therefore makes a motion to counterclaim opposer's allegation.

28. Applicant further affirmatively alleges there is insufficient information to support the opposer's claim that the applicant's use of the mark GREENHEART TV in connection with the services identified in Application Serial No. 86501859 would be damaging to opposer. The application would like to counterclaim that opposition would result in damages that the applicant couldn't recover from professionally or financially. Contacts ranging from major global news outlets like NBC, ABC, and CBS to major corporations rely on finding the applicant through online representation of themselves and their body of work associated with their name.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed. However, if discovery conference proceedings must be held to resolve this matter, the defendant expresses their sincere interest to work together collaboratively with the opposer to identify strategies for differentiation, with reverence for their mutual interests to continue doing good work in this world in their respective arenas.

Respectfully submitted,

GREENHEART CREATIVE

By: 

Kelly V Greenheart, Defendant  
P.O. BOX 91951  
Austin, TX 78709

### **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the attached Answer to Notice of Opposition is being electronically transmitted to the US Patent and Trademark Office Trademark Trial and Appeal Board via the ESTTA filing system in accordance with 37 C.F.R. 1.6(a)(4) and further certifies that a true and correct copy of the forgoing document is being served upon Opposer Greenheart International's counsel of record, Kourtney Mulcahy, via first class mail addressed to Hinshaw & Culbertson LLP, 222 N. LaSalle Street, Suite 300, Chicago, Illinois 60601 on this 31st day of March 2016.

/Kelly V Greenheart/  
Kelly V Greenheart, Defendant