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

In the Matter of Application Serial No. 86/883,293: BLUE IVY CARTER
Published in the Official Gazette of January 10, 2017 in all designated classes (International Classes 3, 6, 9, 10, 12, 16, 18, 20, 21, 24, 26, 28, 35, and 41).

BLUE IVY, Opposer, v. BGK TRADEMARK HOLDINGS, LLC, Applicant.	Opposition No. 91234467 Serial No. 86/883,293 Mark: **BLUE IVY CARTER**

BGK TRADEMARK HOLDINGS, LLC'S RESPONSE TO

MOTION FOR LEAVE TO TAKE LIMITED EARLY DISCOVERY

I. INTRODUCTION.

More than five years ago, it became publicly known that Beyoncé Knowles Carter ("Mrs. Carter"), a world-renowned artist, intended to trademark her daughter's name, Blue Ivy Carter.[1] On January 26, 2012—three weeks after her daughter's highly-publicized birth—Mrs. Carter filed an application for the mark BLUE IVY CARTER (the "Mark") in connection with products such as apparel, body wash, cosmetics, DVDs, books, and other merchandise. This application went unopposed.

In early 2017, Mrs. Carter filed a renewed application for the Mark. When this application was published for opposition, a wedding planning company named Blue Ivy ("opposer") sought to oppose. Opposer, however, did not oppose this application within the 30-day proscribed period. Instead, it requested two extensions, totaling three months, and waited until the last day of the deadline to file an opposition. One week later, without ever discussing the matter with BGK, opposer filed the instant motion, demanding the immediate commencement of discovery due to Jonathan Schwartz's July incarceration.

Opposer's motion for discovery is unnecessary and a waste of Board's resources and time. First, opposer did not in good faith attempt to consult BGK before filing this motion, which could have resolved the dispute and obviated the need for this motion. If opposer had done so, it would have discovered that BGK has neither the ability nor the obligation to produce Mr. Schwartz for a deposition, as he is no longer affiliated in any way with BGK.

Second, there is no reason that opposer cannot depose Mr. Schwartz in the normal course of discovery. Opposer's preference to depose Mr. Schwartz in California rather than Oregon—even though the TTAB rules provide a procedure

[1] BGK Trademark Holdings, LLC's ("BGK") is the holding company for Mrs. Carter's trademark portfolio.

for Mr. Schwartz's deposition to take place in Oregon—is plainly not good cause for allowing early discovery. Moreover, any purported urgency is of opposer's own making. Opposer delayed the initiation of this opposition proceeding for four months. Without such delay, Mr. Schwartz's deposition could have likely proceeded in the normal course of discovery and before his incarceration.

While BGK does not object to Mr. Schwartz's deposition proceeding under the discovery schedule set forth by the Board, opposer has not shown there is good cause to compel BGK to engage in early discovery prior to filing its response and initial disclosures. Opposer's motion should be denied.

II. BACKGROUND.

On January 7, 2012, Mrs. Carter gave birth to a daughter, named Blue Ivy Carter. Given Mrs. Carter's fame, news of her newborn daughter and her unique name spread quickly. It soon became apparent that those who were searching for news about Mrs. Carter's daughter, Blue Ivy, would also find opposer's wedding planning business. On January 9, 2012, opposer commented publicly to TMZ that she embraced the attention that the birth of Blue Ivy Carter was providing to her business: "Clearly great minds think alike, and who better than our Blue Ivy to plan events for B&J's Blue Ivy!?" Declaration of Marvin S. Putnam ("Putnam Decl.") Ex. 1 at 2 (TMZ). Opposer also published a blog on her website—titled "TOP 20 REASONS BLUE IVY IS CONSIDERED ONE OF THE BEST WEDDING PLANNERS IN THE COUNTRY!"—which sought to capitalize on the fame of Mrs. Carter and her daughter, listing as reason No. 20:

> Did we mention that Blue Ivy has Beyonce [*sic*] and Jay-Z loving the name so much, that they named their daughter the same name as our company!? :) It failry [*sic*] safe to think this spirit of synchronicity speaks volumes about our level of trend setting creativity.

Id., Ex. 2 at 3 (Blue Ivy Blog).

On January 26, 2012, Mrs. Carter, through BGK, applied for the trademark BLUE IVY CARTER—the Mark. *Id.*, Ex. 3 (application). About three weeks later, opposer applied for its BLUE IVY mark. *Id.*, Ex. 4 (application). Interestingly, the specimen that opposer attached to its trademark application was a printout of its website, which contained on multiple web pages Mrs. Carter's picture and the statement "Congrats to our SOUL MATE Couple with Baby Blue Ivy!!!" *See id.*, Ex. 4 at 29-30, 35-37, 42, 44-45, 50-52, 57. Relying on this specimen, opposer obtained its registration for the BLUE IVY mark on October 16, 2012. *Id.* On November 27, 2012, six weeks later, Mrs. Carter's Mark was published for opposition. *Id.*, Ex. 5. Opposer never opposed BGK's initial application for the Mark with the United States Patent and Trademark Office.

In early 2016, the initial BGK application for the Mark was deemed abandoned, and Mrs. Carter's then-business manager, Jonathan Schwartz, refiled the application. *Id.*, Ex. 6 (renewed application). At that time, Mr. Schwartz filed a declaration in support of the application, attesting that to the best of his knowledge all statements therein were true. *Id.*, Ex. 7 (Schwartz Declaration).[2] On January 10, 2017, following BGK's renewed application, the BLUE IVY CARTER mark was once again published for opposition. *Id.*, Ex. 8 (publication).

On February 7, 2017, two days before the end of the 30-day opposition period, opposer requested and obtained an extension of time to oppose the Mark. *Id.*, Ex. 9 (extension). On March 4, 2017, opposer obtained yet another extension of time to oppose the application. *Id.*, Ex. 10 (extension). On May 10, 2017—the latest possible date for filing, opposer initiated this opposition. That same day, acting with newfound urgency, counsel for opposer called BGK's former counsel

[2] Opposer's allegation that this application was somehow fraudulent or lacking in good faith is unfounded, baseless, and without any evidentiary support at all.

to request immediate discovery. *See* Hatch Decl. ¶ 5. Learning that BGK had obtained new counsel, he then contacted undersigned counsel. *Id.* As opposer's counsel concedes, BGK's counsel responded two days later, leaving him a voicemail. *Id.* ¶ 6. Opposer's counsel then waited three days to call back, and less than 48 hours later—before BGK's counsel had any opportunity to respond—filed the instant motion. *Id.* ¶¶ 6-7.

III. ARGUMENT.

A. Opposer Failed To Meet And Confer In Good Faith

As the Board has made clear:

> where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement.

Sentrol, Inc. v. Sentex Sys., Inc., 231 U.S.P.Q. 666, at *2 (T.T.A.B. 1986). "[I]t is generally the policy of the Board to intervene in disputes concerning discovery . . . *only where it is clear that the parties have in fact followed the aforesaid process*." *Id.* (emphasis added).

Despite BGK counsel's willingness to discuss the matter, opposer prematurely filed the instant motion without ever conferring with BGK. BGK's counsel reached out to opposer's counsel to discuss its early discovery request. Hatch Decl. ¶ 5. Opposer's counsel waited three days before returning BGK counsel's call, and then filed the instant motion less than 48 hours after leaving a voicemail for BGK counsel. *Id.* ¶¶ 6-7. Opposer made minimal effort to engage in a good faith discussion regarding discovery related to Mr. Schwartz. As a result, opposer did not learn that BGK has no legal control over Mr. Schwartz. He is no longer an officer, director, or managing agent of BGK. Indeed, he is not affiliated with BGK in any manner whatsoever.

As such, BGK does not have the ability or obligation to make him available for deposition—whether early or in the normal course of discovery. 37 C.F.R. § 2.120(b) ("The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party."); *Kellogg Co. v. New Gen. Foods Inc.*, 6 U.S.P.Q.2d 2045, 2048-49 (T.T.A.B. 1988) (deposition of former employee can only be taken by voluntary appearance or by subpoena). Nor does BGK have any knowledge of Mr. Schwartz's whereabouts.[3] Again, had opposer conferred with BGK before filing this motion, the Board may have been spared this unnecessary motion practice.

B. There Is Not Good Cause For Early Discovery.

As a threshold matter, opposer fails to demonstrate that early discovery is even permitted. None of the authorities opposer cites indicates that early discovery is available in Board proceedings. *See* Mot. at 2-3 n.2. Nor has BGK found a single precedential Board opinion stating that early discovery is available in opposition proceedings.

But even assuming early discovery is permitted and applying opposer's proposed "good cause" standard, this discovery is still not warranted. *See* Mot. at 2-3. There is no reason to expedite discovery related to Mr. Schwartz, as he can be deposed during the discovery period, despite his incarceration. Opposer's purported urgent need to depose Mr. Schwartz is not only manufactured, but any purported urgency is due to its own actions. Had opposer not waited four months to initiate this opposition proceeding, it likely would have had the opportunity to depose Mr. Schwartz before his incarceration.

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[3] If opposer wishes to depose Mr. Schwartz, it must locate him and serve him with a subpoena before it can take any deposition. *See* T.T.A.B. Man. P. § 404.02; 37 C.F.R. § 2.120(b).

But irrespective of this delay, the fact that Mr. Schwartz is apparently going to be incarcerated on July 11, 2017, *see* Hatch Decl., Ex. A at 3, has no adverse effect on opposer's ability to depose him. The Board's Manual of Procedure expressly provides that a person who is confined in prison may be deposed, provided it obtains permission from the Board. T.T.A.B. Man. P. § 404.02; Fed. R. Civ. P. 30(a). If anything, his incarceration may aid opposer in obtaining a deposition, given that opposer will know precisely where to serve his subpoena.

Moreover, opposer's claim that Mr. Schwartz's incarceration somehow will lead to the unavailability of documents necessary for its opposition is pure speculation. *See* Mot. at 4. Opposer presumes—without any factual basis—that agents for Mr. Schwartz will not have access to his files during his incarceration. Further, opposer ignores that evidence of BGK's intent to use the Mark—the only stated reason for needing to depose Mr. Schwartz—can certainly be obtained from other, less burdensome sources. Simply put, there is not good cause to expedite discovery.

IV. CONCLUSION.

For the foregoing reasons, BGK respectfully requests that the Board deny opposer's motion for leave to take early discovery.

Dated: June 6, 2017

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CERTIFICATE OF SERVICE

I, John Eastly, hereby certify that on June 6, 2017, I served a true and correct copy of the foregoing **BGK TRADEMARK HOLDINGS, LLC'S RESPONSE TO MOTION FOR LEAVE TO TAKE LIMITED EARLY DISCOVERY** by electronic mail upon:

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