

**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.

NOTICE OF OPPOSITION

Veronica Morales d/b/a Blue Ivy (“Blue Ivy” or “Opposer”) believes it will be damaged by the registration, in all designated classes, International Classes 3, 6, 9, 10, 12, 16, 18, 20, 21, 24, 26, 28, 35, and 41 of the mark BLUE IVY CARTER as shown in Serial No. 86/883,293 (“Applicant’s Application”) filed by BGK Trademark Holdings, LLC (“Applicant” or “BGK”), and opposes the same.

As grounds for opposition, Opposer alleges that:

Opposer Blue Ivy

1. Blue Ivy is an entertainment and event planning firm focused on designing weddings and other elegant events throughout the United States and worldwide. Blue Ivy was founded by Veronica Morales in 2009. Ms. Morales, a Harvard graduate, has been featured in Condé Nast magazine as one of the Top 25 Wedding Planners in the world.

2. Blue Ivy has registered the BLUE IVY mark in the United States Patent and Trademark Office (“USPTO”) as Registration No. 4,224,833 (the “BLUE IVY Mark”), which issued on October 16, 2012.

3. Since at least September 1, 2009, Blue Ivy has continuously used the BLUE IVY Mark in commerce in connection with, *inter alia*, entertainment and event planning services.

4. The BLUE IVY Mark is registered in classes directed to: Event planning and management for marketing, branding, promoting or advertising the goods and services of others; Special event planning for business purposes; Special event planning for commercial, promotional or advertising purposes; Online retail store services and retail store services featuring paintings, wedding portraits, invitations, party favors and party furniture; Personal management services for promotional, corporate and party entertainers; Consultation in the field of special event planning for social entertainment purposes; Special event planning for social entertainment purposes; Party and wedding planning and coordination services; Party and wedding planning consultation services; Providing information in the field of wedding party planning; and Rental of party decorations and wedding decorations.

5. The BLUE IVY Mark is valid, subsisting and owned by Blue Ivy.

6. By virtue of the popularity of Opposer’s products and services offered in connection with the BLUE IVY Mark, and its advertising and promotion of the BLUE IVY Mark, Opposer has built up and now owns valuable goodwill which is symbolized by its BLUE IVY Mark.

7. Any use by Applicant of the applied-for mark is without Opposer’s

consent or permission.

8. Applicant is in no way sponsored by, authorized or licensed by, or in any other way legitimately connected with, Opposer.

Applicant BGK

9. On information and belief, Applicant BGK Trademark Holdings, LLC a limited liability company organized under the laws of Delaware, having an address c/o GSO Business Management, LLC 15260 Ventura Blvd., Suite 2100, Sherman Oaks, California 91403.

10. On information and belief, “BGK” refers to the initials of Beyoncé Giselle Knowles-Carter, a singer, songwriter and actress.

11. On information and belief, Ms. Knowles-Carter wholly owns BGK Trademark Holdings, LLC and is both its Manager and sole Member.

12. Ms. Knowles-Carter is married to American rap artist and businessman Shawn Corey Carter (known professionally as Jay Z). Ms. Knowles-Carter and Mr. Carter are the parents and legal guardians of a minor child named Blue Ivy Carter, born in 2012.

BGK’s First BLUE IVY CARTER Application

13. On January 26, 2012, BGK filed an “intent to use” application for the BLUE IVY CARTER mark covering fourteen international trademark classes. (Application Serial Number 85/526,099, the “’099 Application”).)

14. As provided in the United States Trademark Act, Section 1(b), an Intent to Use application may only be filed by a person “who has a bona fide intention, under circumstances showing the good faith of such person, to use a

trademark in commerce.”

15. In the ‘099 Application, Ms. Knowles signed and submitted to the USPTO a statement affirming that she and BGK had “a bona fide intention to use” the BLUE IVY CARTER mark in commerce on or in connection with all fifteen identified classes of goods and services.

16. Despite affirming with the USPTO a “bona fide intention to use” the BLUE IVY CARTER mark in commerce, from a period of two years, from July 2013 through July 2015, BGK filed five extensions with the USPTO, each requesting additional time to file statements showing use of the BLUE IVY CARTER mark.

17. On February 22, 2016, the USPTO found that BGK had abandoned the ‘099 Application for failure to show any use of the BLUE IVY CARTER mark.

Applicant’s Lack of Intent To Use the Blue Ivy Carter Mark

18. On October 14, 2013, Vanity Fair magazine published an article entitled “Jay Z Has the Room” (the “Vanity Fair Article”).¹ In the article, which was featured as the cover story in the November 2013 issue of Vanity Fair, veteran music industry reporter Lisa Robertson provided excerpts from her interview with Mr. Carter (aka Jay Z). It was billed on the cover as Mr. Carter’s “most revealing interview ever!”

19. In the article, Ms. Robertson writes that she “asked [Mr. Carter] about allegations in the media that he and [Ms. Carter] trademarked their daughter’s name to do a line of baby clothes.” According to Ms. Robinson, Mr. Carter “said they did

¹ See <http://www.vanityfair.com/hollywood/2013/11/jay-z-beyonce-blue-ivy-cover-story>.

it merely so no one else could.”

20. In the Vanity Fair Article, Mr. Carter was quoted as saying:

“People wanted to make products based on our child’s name, and you don’t want anybody trying to benefit off your baby’s name. **It wasn’t for us to do anything; as you see, we haven’t done anything.** First of all, it’s a child, and it bothers me when there’s no [boundaries]. I come from the streets, and even in the most atrocious s**t we were doing, we had lines: no kids, no mothers—there was respect there. But [now] there’s no boundaries. For somebody to say, This person had a kid—I’m gonna make a f***in’ stroller with that kid’s name. It’s, like, where’s the humanity?” (emphasis added and curse words redacted).

21. On information and belief, the reference to “us” in the statement “it wasn’t for us to do anything” refers to Mr. Carter and his wife Ms. Knowles-Carter.

22. On information and belief, Mr. Carter expressed the intention of BGK, which was to file for a trademark only “so that no one else could” and it wasn’t for the Applicant to actually do anything to use the mark.

The Pending BLUE IVY CARTER Application

23. On or around January 26, 2016, BGK filed the pending Intent To Use Application Serial No. 86/883,293, again seeking registration of the BLUE IVY CARTER mark. Applicant designated the mark in the same classes as in the ‘099 Application, which were International Classes 3, 6, 9, 10, 12, 16, 18, 20, 21, 24, 26, 28, 35, and 41.

24. On information and belief, at the time of filing the Applicant’s Application, Applicant’s intention remained the same as what was expressed in the Vanity Fair Article, which was to file for a trademark only “so that no one else could” and it wasn’t for the Applicant to actually do anything to use the mark.

25. BGK’s Executive Vice President, Jonathan Schwartz, signed the

Intent to Use statement in connection with the Applicant's Application. On January 18, 2017, Mr. Schwartz pleaded guilty to Federal charges that he executed a scheme to defraud clients "by means of material false and fraudulent pretenses, representations, and promises, and the concealment of material facts." Mr. Schwartz was sentenced to prison on May 3, 2017.

26. Upon information and belief, to date Applicant still has not made any use of the BLUE IVY CARTER mark in commerce.

First Ground for Opposition
(Lack of Bona Fide Intent to Use)

27. All above paragraphs are incorporated herein by reference.

28. At the time of filing, Applicant did not have the requisite bona fide intent to use the BLUE IVY CARTER mark.

29. For example, Mr. Carter admitted that he and Ms. Knowles-Carter, who wholly owns the Applicant BGK Trademark Holdings, LLC and is both its Manager and sole Member, filed a trademark registration for their daughter's name, BLUE IVY CARTER, "merely so that nobody else could" and that it "wasn't for us to do anything."

30. Additionally, BGK has failed to show any evidence of use in connection with the now-abandoned '099 Application.

31. Additionally, GSK's Executive Vice President, who signed and submitted the oath to the USPTO, has since admitted to schemes to defraud others means of false representations and the concealment of material facts.

32. Based on the above allegations, at the time of filing the Applicant's Application, Applicant lacked any bona fide intent to use the BLUE IVY CARTER

mark in commerce.

Second Ground for Opposition
(Likelihood of Confusion)

33. All above paragraphs are incorporated herein by reference.

34. Opposer's BLUE IVY Mark is inherently distinctive because it does not describe an attribute of Opposer's goods or services.

35. Consumers in the United States associate Opposer's BLUE IVY Mark as identifying goods or services emanating exclusively from Opposer.

36. Opposer also owns common law rights in the United States for BLUE IVY for entertainment-related services.

37. Notwithstanding Opposer's superior rights to the BLUE IVY Mark, Applicant filed intent-to-use Application Serial No. 86/883,293 for BLUE IVY CARTER.

38. Applicant's proposed BLUE IVY CARTER mark is substantially similar to Opposer's BLUE IVY mark in sight, sound, meaning and overall commercial impression.

39. Applicant's designated categories of goods and services and Opposer's goods and services are similar and likely to be sold in the same channels of trade and to the same customers.

40. Additionally, Opposer has used, or intends to use, its BLUE IVY Mark on goods and services that overlap extensively with the categories of goods that Applicant has designated, such as fragrances, cosmetics, audio and video recordings and productions, consumer goods, party favors, baby products, bags,

accessories, and the like.

41. Use by Applicant of the applied-for mark for the services set forth in Applicant's Application is likely to result in confusion with Opposer, or in the belief that Applicant or its services are in some way legitimately connected with, sponsored by, or licensed or approved by, Opposer.

42. Applicant's use and registration of BLUE IVY CARTER is likely to cause confusion, deception, and/or mistake with Opposer's BLUE IVY Mark.

43. If allowed to proceed, Applicant's use and registration of BLUE IVY CARTER will interfere with Opposer's BLUE IVY Mark, and damage Opposer, its business and its goodwill.

Third Ground for Opposition
(Fraud on the USPTO)

44. All above paragraphs are incorporated herein by reference.

45. Applicant has knowingly made false, material misrepresentations of fact to the USPTO.

46. By way of example, it was widely reported in the Vanity Fair Article in 2013 that Applicant filed the BLUE IVY CARTER trademark "merely so that nobody else could" and that it "wasn't for us to do anything." Consistent with that statement, in 2016 Applicant's prior '099 Application was abandoned for failure to show any use of the BLUE IVY CARTER mark for the nearly five years it was pending.

47. Subsequently, on January 26, 2016, Applicant filed Applicant's Application, again seeking registration of the same BLUE IVY CARTER mark, covering the same fourteen classes as the '099 Application, and also based on an

intent to use the mark. Applicant's Application was supported by the declaration of Applicant's Executive Vice President, Mr. Schwartz.

48. On information and belief, Applicant and those affiliated with Applicant, including both Ms. Knowles-Carter (who signed the corresponding declaration in connection with the prior '099 Application) and Mr. Schwartz, knew that Applicant had no plans or intention to use the BLUE IVY CARTER mark, for example from the Vanity Fair Article.

49. Nonetheless, Applicant signed and submitted to the USPTO a sworn declaration that it had "a bona fide intention to use" the BLUE IVY CARTER mark in commerce on or in connection with the identified classes of goods and services.

50. On information and belief, Applicant and those affiliated with Applicant, including Ms. Knowles-Carter and Mr. Schwartz, acted with the intent to deceive the USPTO.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Application, and requests that the opposition be sustained and the registration be denied.

Date: May 10, 2017

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CERTIFICATE OF SERVICE

I hereby certify that a copy of this **NOTICE OF OPPOSITION** has been served upon:

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via email and first class mail, postage prepaid, on May 10, 2017.

/ Ryan E. Hatch /
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