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January 31, 2019

VIA FEDERAL EXPRESS AND EMAIL

Gregory A. Nelson
Fox Rothschild LLP
Phillips Point
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(561) 835-9600

Re: Owl Tutoring

Dear Mr. Nelson:

As discussed, we represent Neil Parsont and his company, Owl Tutoring. We have reviewed your January 11, 2019 correspondence and disagree with your claims in full. Not only is Owl Tutoring not infringing any trademarks of Florida Atlantic University (“FAU” or the “University”), but any legitimate claim of infringement would be barred by the doctrines of estoppel by acquiescence and laches.

No Trademark Infringement

Our client has been using the name “Owl Tutoring,” along with the domain name OWLTUTORING.COM, for tutoring services for over a decade. During this extended period of coexistence with FAU, our client has never used any of FAU’s common law or registered trademarks as source-identifiers.

Your correspondence seems to suggest that the name “Owl Tutoring” and the services offered thereunder violate one or more of the following registered trademarks: (1) FLORIDA ATLANTIC UNIVERSITY & Design, U.S. Reg. No. 3,234,534; (2) FLORIDA ATLANTIC UNIVERSITY, U.S. Reg. No. 3,237,480; and (3) FLORIDA ATLANTIC OWLS, U.S. Reg. Nos. 5,114,651 and 5,327,557. We are confused by this accusation, as none of these marks are in any way similar to “Owl Tutoring.” The only conceivable overlap would be with regard to the term “owl,” which is highly suggestive for tutoring services because owls are a well-known symbol for wisdom and knowledge. To this end, there are over a dozen coexisting registered and

pending trademarks incorporating the term “owl” for educational services. Further, our client has never used the phrase “Florida Atlantic” or a confusingly similar phrase as a trademark, alone or in combination with the term “owls.”

Moreover, while we understand that FAU provides tutoring services, these services are provided under the commercially distinct name “CLASS Tutoring.” *See* http://www.fau.edu/class/tutoring/tutor_listings.php (screenshot attached as Exhibit 2 to your correspondence).

Finally, lest there be any doubt regarding the potential for consumers to mistakenly believe that Owl Tutoring is “owned by, authorized, endorsed or sponsored by FAU,” the “FAQs” page on our client’s website clarifies as follows;

Are you affiliated with FAU?

No - Owl Tutoring is a completely separate and independent entity with no relationship, endorsement or approval from Florida Atlantic University. The company provides services to students from numerous colleges as well as middle school and high school students

See Exhibit 1.

Estoppel by Acquiescence

Not only has Owl Tutoring been providing tutoring services to University students with FAU’s full knowledge for over a decade, FAU has actively supported our client’s services offered under the “Owl Tutoring” name.

Owl Tutoring operated on FAU’s campus from 2008 until early 2013, when it moved off campus to the FAU incubator. The College of Business provided Owl Tutoring a large table to advertise its services from the College of Business’ building lobby, where it displayed a large banner, distributed marketing materials, and gave away t-shirts with the company’s logo. During these activities, Mr. Parsont and his fellow tutors all wore Owl Tutoring-branded attire. *See* Exhibit 2. The company’s flyer was approved by the University before it was posted in the College of Business. *See* Exhibit 3. Owl Tutoring’s services were rendered in FAU classrooms with the University’s full knowledge, as he coordinated with University administrators to reserve space. *See* Exhibit 4.

Later, Owl Tutoring sponsored FAU’s Business Plan Competition, and worked with the University to create joint marketing materials to promote the University’s competition as well as Owl Tutoring’s services. *See* Exhibit 5. Participants in the competition received the “FAU Business Plan Financial Model Builder” designed by our client, which prominently displayed the “Owl Tutoring” name. *See* Exhibit 6. Later, Mr. Parsont was invited to give a lecture to

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competition participants at the Office Depot Center for Executive Education, which he did while wearing Owl Tutoring-branded attire. This lecture was then published by the FAU Center for Entrepreneurship on their official YouTube page. *See* Exhibit 7. Mr. Parsont was also invited by FAU Professor Gary Castrogiovanni to speak to University students about business plans financials on multiple occasions, which he did while wearing Owl Tutoring attire. All correspondence from Mr. Parsont was sent through his “Owl Tutoring” email address. *See* Exhibit 8.

Finally, FAU sent out correspondence on Owl Tutoring’s behalf to every student in the College of Business advertising our client’s services:

Greetings Students,

Owl Tutoring is a private on-campus service established in 2007, dedicated to helping FAU students. Owl Tutoring is one of many on-campus tutoring options and offers individual and group tutoring for your course and many others. We have daily availability from morning until night. All of our tutors have multiple semesters of experience and will provide you with additional notes, calculator instructions and sample problems. For more information or to view availability/book an appointment, please visit our website: www.owltutoring.com and click on your course.

For a complete list of FAU tutors, please visit the CLASS website by clicking here.

See Exhibit 8.

In view of the foregoing, there should be no doubt that FAU has actively consented to our client’s use of “Owl Tutoring.” The University has had full knowledge of our client’s operations since it started over a decade ago, and it has nurtured that growth by providing Owl Tutoring a space to advertise and render services, a platform to promote itself by allowing our client to sponsor a University competition, and by soliciting customers on our client’s behalf via a mailing sent out to over 8,000 students.

Understandably, our client relied on the University’s support to continue and expand its operations. In addition to serving the FAU community, our client now provides tutoring services to other local college students, as well as middle and high school students.

Requiring our client to adopt a new name and website would cause undue prejudice – it has invested a tremendous amount of resources in building the “Owl Tutoring” brand, and has amassed substantial goodwill in both the “Owl Tutoring” name and OWLTUTORING.COM domain name from over 10 years of use.

Laches

Finally, FAU’s failure to take action against “Owl Tutoring,” despite its full knowledge of our client’s operations for more than a decade, is inexcusable. Any claim by the University for trademark infringement – if one were to exist – would be barred by laches. The University

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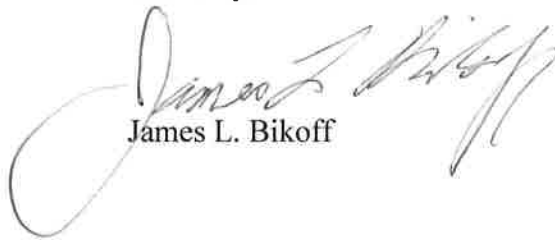
has slept on its rights for over 10 years, all the while actively supporting our client's activities. There is no credible explanation for this egregious delay in taking action, and our client would be unduly prejudiced by having to change its name and transfer its OWLTUTORING.COM domain, which are among our client's most valuable assets.

For the reasons stated herein, Owl Tutoring respectfully declines to take the action requested in your January 11 correspondence.

We trust your letter was sent without knowledge of the longstanding relationship and valued relationship between FAU and our client, and that this letter will resolve your client's concerns.

This letter is written without waiver of any of Owl Tutoring's rights, claims, defenses or remedies, all of which are expressly reserved.

Sincerely,



James L. Bikoff

Enclosures