

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
February 5, 2015

Mailed:
August 7, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Publix Asset Management Company
v.
The Great Atlantic & Pacific Tea Company, Inc.

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Opposition Nos. 91186148 and 91186863
—

James B Lake of Thomas & Locicero PL for the Publix Asset Management Company.

Arlana S. Cohen and Lindsay M. Rodman of Cowan Liebowitz & Latman PC for The Great Atlantic & Pacific Tea Company, Inc.

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Before Quinn, Shaw, and Goodman, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

The Great Atlantic & Pacific Tea Company (“Applicant”) filed two intent-to-use applications for the mark GREEN WAY, in standard characters. Serial No. 77349246 was filed on December 11, 2007 and identifies the following goods:

- Olive oil, canned tomatoes, canned beans, broth, soups, applesauce, jams, fruit preserves, peanut butter, soybean milk, milk, butter, cheese, frozen entrees consisting primarily of meat or cheese, frozen vegetables, namely, peas, broccoli, cauliflower, green beans and mixed vegetables, frozen fruits, pre-cut vegetable salad, in International Class 29;

Opposition Nos. 91186148 and 91186863

- Balsamic vinegar, pasta, pasta sauce, salad dressing, salsa, macaroni and cheese, breakfast cereals, coffee, tortilla chips, cheese flavored snacks, namely, cheese puffs and cheese curls, popcorn, pretzels, crackers, cookies, ravioli, frozen entrees consisting primarily of rice or pasta, burritos, enchiladas, ice cream, ice cream sandwiches, sorbets; frozen corn, in International Class 30;
- Fresh vegetables, in International Class 31; and
- Fruit juices and fruit drinks, soft drinks, in International Class 32.

Serial No. 77409725 was filed on February 29, 2008 and identifies the following additional goods:

- Shampoos and hair conditioners; skin moisturizers; human body conditioners; skin treatment lotions and creams; anti-aging and stretch mark creams; non-medicated lotions and creams for hands, nails, skin, face, hair, foot and leg muscles and joints; depilatory lotions and creams; shaving lotions and creams; non-medicated skin care preparation, namely, lotions and creams for treating dry and damaged skin, anti-aging, firming, anti-wrinkle, stretch marks, under eye and eyelid firming; gels, namely, depilatory gels, shaving gels, shower gels; oils, namely, body oils, non-medicated human body serums; soaps; liquid soaps; bar soaps; anti-bacterial liquid soaps; anti-bacterial bar soaps; body washing soaps; bubble bath; body and facial scrubs; masks, namely, beauty masks, facial masks, body masks, gel eye masks, skin masks, and skin moisturizer masks; non-medicated skin care preparations, namely, face peels; cosmetic sun protection creams and lotions, sun creams and lotions; sun block; soaps and detergents for household use for the purposes of cleaning and maintenance without harm to the environment, in International Class 3;
- Charcoal; white birch firewood; fire wood chips for use as fuel; fireplace logs, in International Class 4;
- Hand sanitizing preparations; dietary food supplements, in International Class 5;
- Disposable forks, knives, and spoons, in International Class 8;
- Batteries, in International Class 9;
- Compact fluorescent electric light bulbs, in International Class 11;
- Paper towels; paper table cloths; paper napkins; bathroom tissue; notebooks; notebook paper; and facial tissues, in International Class 16;
- Reeds, namely, diffuser reeds, in International Class 20;
- Paper plates and paper cups, in International Class 21;

Opposition Nos. 91186148 and 91186863

- Frozen hamburger patties; processed edible seeds; processed nuts; dried fruits; raisins; trail mix, namely, snack mixes primarily consisting of processed fruits, processed nuts, pretzels; potato chips, in International Class 29;
- Teas; sesame sticks; chocolate coated nuts; yogurt coated nuts; macaroni and cheese; pesto sauce; bread; tortillas; tortillas chips, in International Class 30;
- Pet food, in International Class 31; and
- Soda pop, in International Class 32.

Publix Asset Management Company (“Opposer”) filed Notices of Opposition against the registration of Applicant’s marks on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).¹ The oppositions have been consolidated. Opposer pleaded ownership of the following registrations for the mark GREENWISE in typed or standard character form for the goods identified:

- Reg. No. 2520595, for retail grocery store services, in International Class 35, with a claimed first-use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2732403, for food products, namely, breakfast cereals, grain-based chips, sauces, honey, and tomato sauce, in International Class 30, with a claimed first-use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2729423, for food products, namely, eggs, milk, flavored milk, chocolate milk, fresh and processed seafood and shellfish, processed nuts, edible processed seeds, dried fruits, dried beans, fresh and processed meat and poultry, and tomato paste, in International Class 29, with a claimed first use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2654223, for a newsletter in the field of health and nutrition, in International Class 16, with a claimed first-use date of February 26, 2001, and arising from an application filed January 9, 2002;

¹ Opposer also pleaded dilution but did not pursue the claim at trial. Accordingly, the dilution claim is considered waived.

- Reg. No. 3328951, for paper products, namely, bathroom tissue, facial tissue, paper napkins and paper towels, in International Class 16, with a claimed first-use date of March 31, 2003, and arising from an application filed April 2, 2007;
- Reg. No. 3546815, for laundry bleach, in International Class 3, with a claimed first-use date of October 31, 2007, and arising from an application filed May 16, 2008;
- Reg. No. 3753274 for vitamins and nutritional supplements, in International Class 5, with a claimed first use date of July 1, 2009, and arising from an application filed April 1, 2009;
- Reg. No. 3813886, for food products, namely, soy milk, applesauce, garden salad mix, processed vegetables and fruits, processed mushrooms, canned vegetables, packaged fresh entrees consisting primarily of meat, fish, poultry or vegetables, in International Class 29, with a claimed first use date of April 12, 2003, and arising from an application filed November 13, 2009;
- Reg. No. 3813890, for fruit juices; tomato juice, in International Class 32, with a claimed first use date of October 23, 2003, and arising from an application filed November 13, 2009;
- Reg. No. 3813937, for food products, namely, ketchup, mustard, salsa, vinegar, flavored vinegar, wine vinegar, crackers, and candy, namely, chocolate covered raisins, in International Class 30, with a claimed first use date of January 2007, and arising from an application filed November 16, 2009;
- Reg. No. 3813946, for cat litter; unprocessed vegetables and fruits; unprocessed mushrooms, in International Class 31, with a claimed first use date of July 11, 2007, and arising from an application filed November 16, 2009;
- Reg. No. 3813950, for retail store services featuring chocolate confectionery, candy and edible gifts, delicatessens, bakery items, wines, organic wines, and beers, in International Class 35, with a claimed first use date of September 27, 2007, and arising from an application filed November 16, 2009; and
- Reg. No. 3813952, for cafe, restaurant, delicatessen and coffee bar services, in-store and for carry out, in International Class 43, with a claimed first use date of September 27, 2007, and arising from an application filed November 16, 2009; and
- Reg. No. 3813868 for wood chips for smoking and grilling; charcoal briquettes, in International Class 4, with a claimed first use date of March 5, 2008 and arising from an application filed on November 13, 2009.

I. Preliminary Issues

A. Objections.

Applicant objects to the testimony of Paul Kalinowski and related exhibits on several grounds: (1) that his testimony on the meaning of the marks was improper rebuttal because Applicant did not raise the subject of the meaning of the marks in its initial trial disclosures; (2) that Mr. Kalinowski does not work for Opposer and is therefore incompetent to testify on Opposer's behalf; (3) that Opposer refused to provide discovery regarding the reasons for selecting its GREENWISE mark, and therefore, Opposer should not be able to rely on any documents or testimony regarding its intended meaning of its mark; and (4) that Mr. Kalinowski failed to properly authenticate exhibit 71, consisting of dictionary definitions.²

Each of these grounds for objecting to the Kalinowski testimony and exhibits is unpersuasive. First, the parties agreed in their trial stipulation that Mr. Kalinowski would "not be treated as a rebuttal witness" and "will be permitted to solicit testimony beyond the scope of A&P's case." 59 TTABVUE 2-3.

Second, Mr. Kalinowski is an employee of Publix Super Markets, the primary licensee of Opposer's marks, and has worked there for more than 34 years. He testified that he was a director of "natural and organic foods" and "helped develop and roll out the name GreenWise." 105 TTABVUE 37. As such, Mr. Kalinowski's testimony is competent and relevant to Opposer's case. His employment by Opposer's licensee does not disqualify him from testifying.

² Applicant's Appendix A to Trial Br., pp. 1-4.

Third, Opposer's objection to discovery regarding the reasons for selecting its GREENWISE mark does not require that all testimony and exhibits regarding the meaning of its mark must also be excluded. A party's intent in selecting a particular mark does not always inform the meaning of the mark to the general public.

Lastly, mainstream dictionary definitions from recognized publishers do not require detailed authentication in order to be entered into the record. It is well settled that the Board may take judicial notice of dictionary definitions and their entry into the record should not be a matter of great dispute. *See* Trademark Rule 2.122(a) and Fed. R. Civ. P. 201 ("Judicial Notice of Adjudicative Facts"); *See also* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 704.12 (2015) ("Judicial Notice") and cases cited therein. Accordingly, the objection to the Kalinowski testimony and exhibits is overruled.

Applicant also objects to argument by Opposer concerning operations by Publix Super Markets, Inc., the licensee of Opposer and operator of Publix grocery stores. The objection is overruled. Use of a mark by a related company or a licensee inures to the benefit of the licensor. *In re Diamond Walnut Growers, Inc. and Sunsweet Growers Inc.*, 204 USPQ 507, 509 (TTAB 1979) ("[L]icensee is a related company . . . and its use of the [a] mark inures to the benefit of the joint applicants.").

B. Motion for Partial Cancellation

Applicant renews its motion, previously denied, to assert counterclaims for partial cancellation of eleven of Opposer's registrations by adding the limitation "sold only in Publix stores" to the identification of goods in each of the registrations.

Opposition Nos. 91186148 and 91186863

The motion is denied. As the Board explained in its order of July 16, 2013, Applicant has not satisfactorily explained why it waited two years from the date of Opposer's amended notice of opposition or four years from the date of the original notice of opposition which identified Opposer's eleven registrations. 66 TTABVUE 4.

More importantly, as the Board also noted in its previous order, the motion is futile and will not avoid a finding of likelihood of confusion. 66 TTABVUE 7. Absent a parallel limitation in Applicant's registration limiting the goods to a different channel of trade, the proposed limitation to Opposer's channels of trade does not obviate a finding of likelihood of confusion. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 (TTAB 1994) ("[T]he Board will not restrict respondent's registration to certain channels of trade in the absence of a pleading and proof that a finding of likelihood of confusion can be avoided by such a restriction.").

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application files. In addition, the parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Opposer's first notice of reliance comprising copies of Opposer's pleaded registrations printed from the electronic database of the USPTO showing the current title to and status of the registrations;
2. Trial Testimony of Mark Irby, President, Publix Asset Management Company, Vice President of Marketing, Publix Super Markets, Inc., with exhibits;
3. Trial Testimony of Douglas Palmer, former Vice President of Own Brands, A&P, with exhibits;

4. Trial Testimony of Beth Curran, Manager of Own Brands, A&P, with exhibits;
5. Opposer's second notice of reliance on documents retrieved from the Internet;
6. Trial Testimony of Paul Kalinowski, Business Development Director, Publix Super Markets, Inc., with exhibits; and
7. Opposer's third notice of reliance on documents retrieved from the Trademark Trial and Appeal Board's web site at ttabvue.uspto.gov.

B. Applicant's testimony and evidence.

1. Trial Testimony of Beth Curran, Manager of Own Brands, A&P, with exhibits;
2. Trial Testimony of Jay Warren, Global Litigation Counsel, Whole Foods Market Central, with exhibits;
3. Trial Testimony of Adam Brink, Corporate Counsel, The Clorox Company, with exhibits;
4. Trial Testimony of John Kroeger, Senior Vice President and Deputy General Counsel, Pinnacle Foods, with exhibits; and
5. Applicant's notice of reliance on the following items:
 - a. Copies of third-party registrations for marks with the term "Green"; and
 - b. Copies of documents, publication and web pages retrieved from the Internet purporting to show use of the term "green" in connection with food and household products, consumer goods, and retail store services.

III. Standing and Priority

Because Opposer has properly made of record its pleaded registrations, Opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Section 2(d) priority is not an issue inasmuch as Opposer has properly made of record its pleaded registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

IV. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of Opposer's mark.

Opposer contends that GREENWISE is a “famous, strong mark.”³ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed

³ Opposer's Br., p. 23.

in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

In its brief, Opposer argues that its GREENWISE mark is famous for the following reasons:

1. “GreenWise® products are sold in approximately 1,060 grocery stores in several states”;

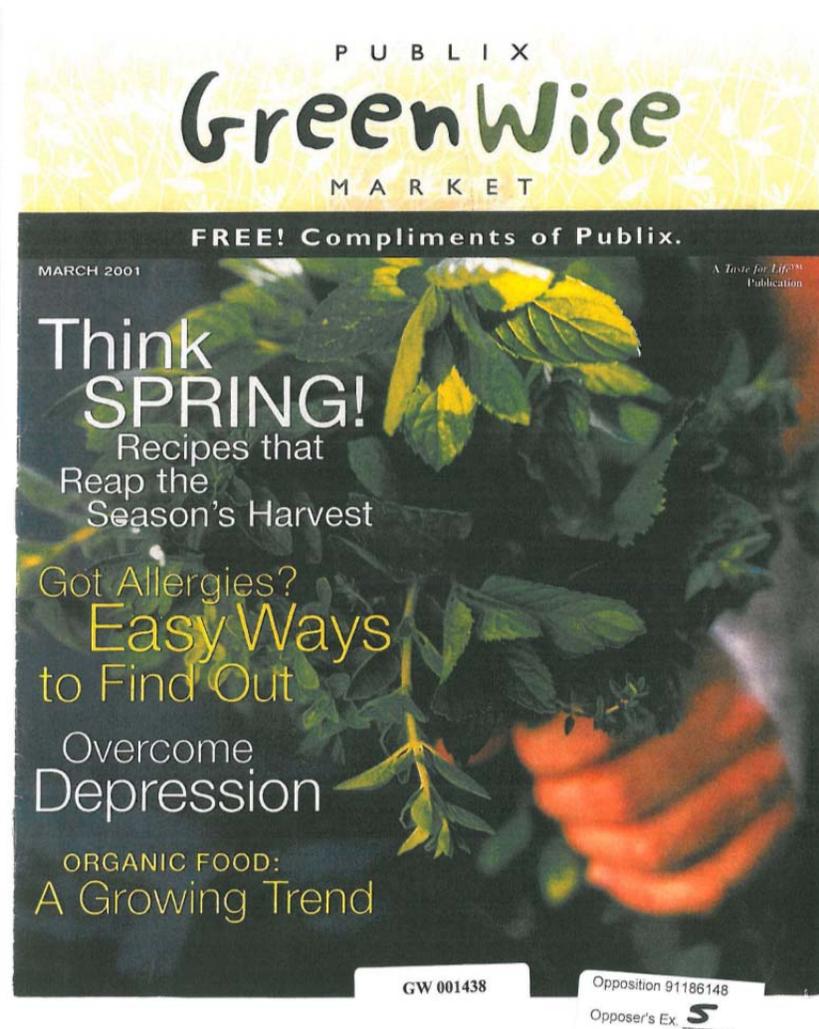
2. “[T]he GreenWise® mark is the subject of extensive marketing expenditures, and GreenWise® sales have been significant”;

3. “GreenWise® products are promoted through various media including television, newspapers, radio, direct mail, social media, website and outdoor advertisements”;

4. “[T]he GreenWise® mark has been in use for over a decade, with its first marketplace use in March 2001”; and

5. “GreenWise® products, along with the related GreenWise® Market standalone stores, have been the subject of widespread and frequent media coverage. . . .”⁴

There are several problems with Opposer’s evidence of fame. In nearly every exhibit the GREENWISE mark appears between the house mark PUBLIX and the term MARKET. For example, one of the earliest uses of the GREENWISE mark was on a cover of a regularly-published magazine, reproduced below.



⁴ *Id.*, pp. 23-24.

Opposition Nos. 91186148 and 91186863

This combination of GREENWISE and PUBLIX MARKET, or PUBLIX GREENWISE MARKET, appears in nearly all of Opposer's advertising and product packaging. Even when the GREENWISE mark is used on point-of-purchase shelf advertising such as shown below, GREENWISE regularly appears between the terms PUBLIX and MARKET.



6

⁵ 111 TTABVUE 56.

⁶ 111 TTABVUE 112.

Opposition Nos. 91186148 and 91186863

When the GREENWISE mark is used on product packaging such as shown below, GREENWISE also appears between the terms PUBLIX and MARKET.



The frequent use of the GREENWISE mark with the house mark PUBLIX and the term MARKET diminishes the significance of Opposer's evidence in proving the fame of the mark. That is, we cannot be sure that the evidence demonstrates public

⁷ 111 TTABVUE 61.

recognition of the GREENWISE mark by itself, as opposed to demonstrating recognition of Opposer's well-known PUBLIX house mark.

It is well-settled that, where, as here, a party's advertising and sales data is based on materials and packaging in which the mark at issue is almost always displayed with another mark, such data does not prove that the mark at issue possesses the requisite degree of consumer recognition. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (sales and advertising figures alone may not suffice where other marks were featured with the mark at issue or the growth could be attributed to the product's popularity).

Thus, while we find that Opposer's confidential marketing expenditures⁸ are significant in size, these expenditures include advertising for PUBLIX GREENWISE MARKET products, not just GREENWISE products. Similarly, Opposer's confidential sales figures,⁹ while impressive, include sales of PUBLIX GREENWISE MARKET products, not just GREENWISE products. Consequently, we are unable to attribute either the marketing expenditures or the resulting sales to the GREENWISE mark alone as opposed to either PUBLIX MARKET or to some combination of the two. For the same reason, use of the mark since 2001 and sales across a large number of stores does not compel a finding that the mark is famous.

Opposer also sells a number of third-party products under its GREENWISE store displays, and Opposer's sales figures "include[] . . . products that may be branded by some other supplier or manufacturer or possibly even non-branded

⁸ Exhibit 21, 110 TTABVUE 22.

⁹ Exhibit 22, 110 TTABVUE 23.

products.”¹⁰ This further diminishes the significance of Opposer’s sales figures in proving fame.

Regarding the news stories and newspaper articles cited by Opposer as evidence of consumer recognition of fame, many of these stories refer to Opposer’s goods and services under the GREENWISE mark as often as they refer to PUBLIX GREENWISE MARKET. For example:

- The Tampa Bay Business Journal (Feb. 26, 2007) – “The first **Publix GreenWise Market** is slated to open this summer in Palm Beach Gardens. . . . **GreenWise** signals Publix’s willingness to test consumer appetite for its healthy shopping concept, said Maria Brous, spokeswoman for the Lakeland-based chain. ‘The **Publix GreenWise’s** whole focus will be health, organic, natural foods and prepared foods’ she said.” (62 TTABVUE 15);
- The Palm Beach Post (May 9, 2007) – “**PUBLIX GREENWISE MARKET PLANNED FOR GARDENS . . .** Palm Beach Gardens and Boca Raton will soon be homes to the first two **Publix GreenWise Markets** in the chain’s history. . . . Work is under way on a new 39,000-square-foot building for a **GreenWise Market** at 11231 Legacy Ave. in Palm Beach Gardens.” (62 TTABVUE 18);
- South Florida Sun Sentinel – Fort Lauderdale, Fla. (May 18, 2007) – “**Publix GreenWise Market** ticketed for Coral Springs . . . Publix Super Markets said Thursday it plans to open a 39,000-square foot **Publix GreenWise Market** store at 3451 University Drive in Coral Springs.” (62 TTABVUE 19);
- The Ledger.com (Nov. 4, 2008) – “**Publix GreenWise Market** Is No Traditional Store . . . **Publix GreenWise Market** is nothing like the 1,000 traditional stores run by the nation’s fourth-largest supermarket chain. . . . It’s the third of the chain’s experimental **GreenWise** chain after Boca Raton and Palm Beach Gardens. . . . **GreenWise Market**, however, is Publix’s competitive answer to Whole Foods and others like Fresh Market that moved into its home state to skim the cream in top-income neighborhoods.” (62 TTABVUE 41);
- The Tampa Tribune (Nov. 6, 2008) – “**Publix GreenWise Market’s** niche is natural and organic groceries, but what will catch your eye is its medley

¹⁰ Irby Test., 107 TTABVUE 50.

of gourmet prepared foods -made with natural, organic and conventional ingredients. . . . Publix debuts its first Tampa Bay-area **GreenWise Market** at 8 a.m. today . . . The company has opened **GreenWise** stores in Boca Raton and Palm Beach Gardens, and is planning two more in the Orlando and Tallahassee areas.” (62 TTABVUE 44); and

- TampaBay.com (Nov. 12, 2008) – “How do **Publix GreenWise Market’s** prices compare? **Publix GreenWise Market** has drawn overflow crowds since its long anticipated grand opening Nov. 6. Last weekend, *City Times* compiled a short grocery list of common health-conscious products and went shopping to see if the **GreenWise** prices were worth the wait when compared to three other organic and natural food stores already in the South Tampa area. . . . (62 TTABVUE 47).

In addition, many of Opposer’s news stories are press releases which appeared in grocery-related trade publications such as *Supermarket News* or *e-scanner*, published by the Private Label Manufacturers Association. We have no evidence that these publications are typically circulated among general grocery consumers and thus these articles carry little weight in determining consumer recognition or fame.

In sum, we find that Opposer is a successful grocery chain selling a wide variety of products, many under the GREENWISE mark. The evidence, however, does not support finding that the GREENWISE is famous. The testimony and evidence establish that GREENWISE is nearly always combined with PUBLIX or PUBLIX MARKET. This significantly diminishes the probative weight of the evidence relating to consumer awareness of fame.

In proving that a mark used in connection with a house mark was famous in its own right, the Federal Circuit made the following observation:

If a product mark used in tandem with a famous house mark . . . has independent trademark significance, it should not be a great burden to substantiate the point. . . . [C]onsumer awareness of the product mark

apart from the fame of the associated house mark, whether demonstrated directly or indirectly, is a reliable test of the independence of the product mark.

Bose Corp. v. QSC Audio Prods. Inc., 63 USPQ2d at 1308. While Opposer has demonstrated that its mark has achieved at least a high degree of recognition, the testimony and evidence is insufficient to support a finding that the mark is famous and thus entitled to the extensive breadth of protection accorded a truly famous mark. Accordingly, the *du Pont* factor relating to fame is neutral.

B. The number and nature of similar marks in use on similar goods and services.

This *du Pont* factor focuses on the usage by third-parties of similar marks in connection with related goods or services in the marketplace. Such evidence demonstrates that customers have become conditioned by a plethora of similar marks to distinguish between different marks on the basis of minute distinctions.

Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

Applicant contends that “it cannot be disputed that the term ‘green’ has been widely used by numerous third parties in the grocery field, both prior to Publix’ first use of GREENWISE and since.”¹¹ Opposer, on the other hand, points out that the “mere inclusion of the word ‘green’ in a mark is not dispositive of the present issue before the board.”¹²

¹¹ Applicant’s Br., p. 15.

¹² Opposer’s Br., p. 26.

We agree with Applicant that it cannot seriously be disputed that the term “green” is widely understood to signify a positive environmental quality. The *Merriam Webster Dictionary* defines the word “green” as, *inter alia*, “tending to preserve environmental quality (as by being recyclable, biodegradable, or nonpolluting).”¹³ The record is replete with admissions and evidence that the parties, as well as other businesses, have sought to bring to market products and services which meet this definition of “green” under marks including the term GREEN.

Opposer’s own witness, Mark Kalinowski, testified regarding the meaning of the GREENWISE mark that “Green refers to nature, natural. Being natural is the reference that we were trying to get with the name [GREENWISE].”¹⁴

Applicant has introduced evidence showing that a number of third parties offer goods and services under marks including the term “green.” Adam Brink, Corporate Counsel for the Clorox Company, testified that Clorox sells a variety of natural household cleaning products under the mark GREEN WORKS.¹⁵ Jay Warren, Global Litigation Counsel for Whole Foods Market Central, testified that Whole Foods is a nationwide natural and organic retailer which uses the mark GREEN

¹³ <http://www.merriam-webster.com/dictionary/green>. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁴ Kalinowski test., 105 TTABVUE 41.

¹⁵ Brink test., 98 TTABVUE 12.

MISSION in association with grocery services and on a variety of grocery products.¹⁶ Mr. Warren testified that

Green Mission itself is a Whole Foods initiative where they're attempting to – where we're attempting to reduce carbon footprints. Reduce, reuse, recycle is the common catch phrase we use. So the Green Mission is building of [sic] new stores using recyclable, reusable materials, as much organic as we can, reducing the usage of electricity for solar power.

It also encompasses the programs we have for reusable grocery bags as opposed to single-use plastic bags, composting programs and also our own line of Green Mission products.¹⁷

Whole Foods also operated two grocery stores named GREENLIFE in Tennessee.¹⁸

Beth Curran, Director of Marketing and Advertising for Applicant, testified that Applicant sells a number of third-party “green” branded products such as GREENER CLEAN sponges, GREEN CUISINE frozen foods, SIMPLE GREEN automobile cleaner, and Clorox’s GREEN WORKS cleaners.¹⁹ Ms. Curran further introduced evidence that Safeway supermarket sells a variety of natural products under the BRIGHT GREEN mark.²⁰

Applicant introduced a number of third-party registrations for marks including the term “green”²¹ but the probative value of many of these registrations is somewhat diminished because they use the term “green” in other contexts that may

¹⁶ Warren test., 88 TTABVUE 14, 22-34.

¹⁷ *Id.*, 88 TTABVUE 38.

¹⁸ *Id.*, 88 TTABVUE 47.

¹⁹ Curran test., 93 TTABVUE 51; 95 TTABVUE 12-41.

²⁰ Curran test., 93 TTABVUE 62.

²¹ Applicant’s Notice of Reliance, Exh. A, 67 TTABVUE 4 to 69 TTABVUE 324.

Opposition Nos. 91186148 and 91186863

not necessarily suggest a connection with natural ingredients or “environmental quality,” e.g., GREEN GIANT, GREEN MOUNTAIN, GREEN VALLEY, GREEN ACRES, etc. Nevertheless, given the growing desire among consumers for more natural food products, we see no reason why consumers might not interpret many of these “green” marks as referring to “natural” rather than merely to the color green, for example.

Not all of the listed marks are accompanied by evidence of use of the marks or evidence that consumers have been exposed to them. *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973). Notwithstanding a lack of evidence of use of the marks, we note that many of the listed registrations which arguably do use the term “green” as referring to natural or “environmental quality” have disclaimed the term “green” or have been registered on the Supplemental Register.²² These registrations, therefore, have some value because they may be used in the manner of a dictionary to show that a mark or a portion of a mark is descriptive or suggestive of goods and services. *In re J. M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1988); *In re Imperial Jade Mining, Inc.*, 193 USPQ 725, 726-27 (TTAB (1977)).

Regardless of the intended meaning of “green” in these third-party marks, there can be no doubt that consumers are exposed to a large number of products and services marketed under marks containing the term “green.” Accordingly, the large

²² See, *inter alia*, Reg. Nos. 3902597 (GREEN WORKS), 4176778 (WAY GREEN), 3264496 (GREEN MISSION), 4275955 (BRIGHT GREEN), 3665239 (GREEN CUISINE), and 3888525 (GREEN EFFECT), 67 TTABVUE.

number and nature of similar marks containing the term “green” in use on similar goods and services weighs against a finding of a likelihood of confusion. *See Juice Generation, Inc. v. GS Enters. LLC*, — F.3d —, 2015 WL 4400033 (Fed. Cir. July 20, 2015) (“The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”).

C. The similarity or dissimilarity and nature of the goods and services, channels of trade and classes of consumers.

Many of Applicant’s goods are identical to Opposer’s goods. Applicant’s paper towels, paper napkins, bathroom tissue, and facial tissues in International Class 16 are identical to Opposer’s goods in Registration No. 3328951. Applicant’s applesauce, soybean milk, milk, pre-processed edible seeds, processed nuts, and dried fruits in International Class 29 are identical to Opposer’s goods in Registration Nos. 2729423 and 3813886. Applicant’s balsamic vinegar, pasta sauce, salsa, breakfast cereals, crackers, and pesto sauce in International Class 30, are identical to or subsumed within Opposer’s goods in Registration Nos. 2732403 and 3813937. Applicant’s fresh vegetables in International Class 31 are identical to Opposer’s goods in Registration No. 3813946. Applicant’s fruit juices in International Class 32 are identical to Opposer’s goods in Registration No. 3813890.

Other goods identified by Applicant, while not identical, are nevertheless closely related to Opposer’s goods. For example, Applicant’s soaps and detergents for household use in International Class 3 are closely related to Opposer’s laundry bleach in Registration No. 3546815. Applicant’s charcoal, white birch firewood, fire

Opposition Nos. 91186148 and 91186863

wood chips for use as fuel, and fireplace logs in International Class 4 are similar to Opposer's wood chips for smoking and grilling and charcoal briquettes, in Registration No. 3813868. Applicant's dietary food supplements in International Class 5 are similar to Opposer's vitamins and nutritional supplements in Registration No. 3753274. Applicant's paper plates and paper cups in International Class 21 are closely related to Opposer's paper products including paper napkins in Registration No. 3328951.

Because Applicant's products described in the applications are in part identical to Opposer's products identified in the registrations, we must presume that the channels of trade and classes of purchasers are the same. *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

With regard to the identical or closely-related goods in International Classes 3, 4, 5, 16, 21, 29, 30, 31, and 32, discussed above, the *du Pont* factor relating to the similarity of the goods, channels of trade, and classes of purchasers favors a finding of likelihood of confusion. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant's remaining goods in International Classes 8, 9, 11, and 20, while not identical or even closely related to Opposer's goods and services, are nevertheless the type that are commonly sold in grocery stores, often under private label store

brands. Opposer argues that all “organic, natural, and eco-friendly or earth-friendly products sold in grocery stores” are “related” for purposes of likelihood of confusion.²³ We disagree. The mere fact that the goods are of a kind that may be sold in the same type of store is insufficient to support a finding of a likelihood of confusion. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). With regard to these remaining goods, this *du Pont* factor does not favor a finding of a likelihood of confusion.

D. Degree of care.

Next we consider the degree of care under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration. Purchaser sophistication or a high degree of care may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive items or a low degree of care may tend to have the opposite effect. *Palm Bay Imports*, 73 USPQ2d at 1695.

Opposer argues that because the goods are “relatively inexpensive, they are particularly susceptible to consumer confusion.”²⁴ The average price of Opposer’s products “would certainly be under \$20.”²⁵ Applicant, on the other hand, argues that purchasers of “green” or organic products are more careful in their purchases and “are inclined by experience . . . to pay attention to the products they purchase.”²⁶

²³ Opposer’s Br., p. 12.

²⁴ *Id.*, p. 19.

²⁵ *Irby Test.*, 107 TTABVUE 55.

²⁶ Applicant’s Br., p. 30.

While the goods of the parties may tend to be relatively inexpensive, we find that prospective consumers of the parties' "green" products are likely to be a bit more careful than impulse shoppers in their purchasing decisions. Opposer's own employees are on the record confirming that sales of "green" products are "not just a trend but a way of life."²⁷ That being said, even assuming that the prospective purchasers are knowledgeable about "green" products, it does not necessarily mean that they are knowledgeable in the field of trademarks or immune from source confusion. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014). This *du Pont* factor is therefore neutral.

E. The nature and extent of any reported instances of actual confusion.

Opposer first used its marks as early as 2001 and Applicant first began using its mark at least as early as 2008. There have been no reported instances of confusion. Applicant asserts that where "the parties' marks have coexisted in the marketplace for six years, the absence of evidence of actual confusion is a strong indicator that confusion is unlikely."²⁸

It is not clear that there has been a meaningful opportunity for confusion to occur inasmuch as the parties operate in different geographic areas of the country. *Cf. Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (Lack of confusion probative where parties operated numerous branch banks nearby each other). We find the lack of evidence of actual confusion to be a neutral factor in our analysis.

²⁷ Irby Test., 107 TTABVUE 119; 111 TTABVUE 205.

²⁸ Applicant's Br., p. 34.

F. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, meaning, and commercial impression.

With the evidence discussed above in regard to the various *du Pont* factors in mind, we turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. Although one portion of a mark may be given more weight than another, the marks must be compared in their entirety and should not be dissected. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*, 177 USPQ at 567); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946-47 (Fed. Cir. 2004).

Applicant's mark is GREEN WAY and Opposer's mark is GREENWISE. Central to the analysis in this case is the impact of the common term "green" to a potential consumer and the degree to which it might create a likelihood of confusion. As discussed *supra*, there can be no dispute that the term "green" is weak, if not descriptive, when used in connection with the parties' "organic, natural, environmentally sensitive, healthy products."²⁹ Dictionary definitions, third-party usage, news stories, and the parties' own testimony all support the conclusion that "green" is an extremely weak term when used on the parties' goods and is entitled to only a narrow scope of protection or exclusivity of use. Therefore, the shared term has less trademark significance and the dominant element of the marks will be the remaining portions of the marks. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ

²⁹ Opposer's Br., p. 13.

749, 751 (Fed. Cir. 1985) (there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark.). The weakness of the term “green” also suggests “that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.” *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996); *see also America’s Best Franchising, Inc. v. Abbott*, 106 USPQ2d 1540, 1549-50 (TTAB 2013).

With regard to appearance, both marks contain two syllables beginning with the shared term “green” followed by a term beginning with the letter “w.” On the other hand, Applicant’s mark is comprised of two words while Opposer’s mark is one word. Moreover, the dominant words “way” and “wise” are separate and distinct words that are readily recognizable. Given the weakness of the term “green” and the other differences between the marks, we cannot say that the marks are similar in appearance for purposes of likelihood of confusion.

Regarding the sound of the marks, aside from the weak term “green”, the marks are different in the pronunciation of the remaining portions. GREEN WAY ends with a soft “ay” pronunciation while GREENWISE ends with a harder sounding “ize” pronunciation.

Regarding connotation and commercial impression, the marks are open to a number of different interpretations. As discussed *supra*, “green” has a variety of meanings, including the one that is most relevant to the parties’ goods and services:

“tending to preserve environmental quality (as by being recyclable, biodegradable, or nonpolluting).”³⁰

The term “way” has a variety of meanings, including the following most common meanings:³¹

- 1 *a* : a thoroughfare for travel or transportation from place to place
- 2 : the course traveled from one place to another : route <asked the *way* to the museum>
- 3 *a* : a course (as a series of actions or sequence of events) leading in a direction or toward an objective
b (1) : a course of action <took the easy *way* out> (2) : opportunity, capability, or fact of doing as one pleases <always manages to get her own *way*>
- 4 *a* : manner or method of doing or happening <admired her *way* of thinking>; *also* : method of accomplishing : means <that's the *way* to do it>
- 5 *a* : characteristic, regular, or habitual manner or mode of being, behaving, or happening <knows nothing of the *ways* of women>

When “green” and “way” are combined we find the most likely connotation of GREEN WAY is the one that suggests an “environmental” course of action, route, or manner of doing something. This is consistent with the consumer trend toward “going green,” the “green lifestyle,” or the “way of life” touted in the parties’ evidence. It is also consistent with the dictionary definition of “greenway” as a “scenic trail or route. . . .”³²

The term “wise” also has a variety of meanings, including the following most common relevant meanings:³³

³⁰ <http://www.merriam-webster.com/dictionary/green>.

³¹ <http://www.merriam-webster.com/dictionary/way>.

³² Random House Unabridged Dictionary (2d ed. 1997), 105 TTABVUE 76.

³³ <http://www.merriam-webster.com/dictionary/wise>.

- 1 *a* : characterized by wisdom : marked by deep understanding, keen discernment, and a capacity for sound judgment
- 2 *a* : evidencing or hinting at the possession of inside information : knowing
b : possessing inside information <the police got *wise* to his whereabouts>
- 3 *archaic* : skilled in magic or divination
- 4 : insolent, smart-alecky, fresh <a tough kid with a *wise* mouth>

Similarly, “wise” can be used as a suffix and “-wise” is defined as:³⁴

- 1 *a* : in the manner of <*crabwise*> <*fanwise*>
b : in the position or direction of <*slantwise*> <*clockwise*>
- 2 : with regard to : in respect of <*dollarwise*>

When “green” and “wise” are combined we find the most likely connotation of GREENWISE is the one that suggests something that is environmentally smart, or “with regard to” something being green. This is consistent with the Kalinowski testimony regarding the creation of the GREENWISE mark wherein the meaning of the term “wise” could refer to the “method of producing” Opposer’s products and as being “smart or intelligent.”³⁵ Opposer argues that the definition of “wise” includes the meaning “[m]ethod or manner of doing: way,”³⁶ but we find this usage of “way” as a synonym for “wise” to be less likely to be perceived as such inasmuch as it requires multiple steps from consumers to get the same connotation from the marks.

In light of the relative weakness of the term “green,” we are persuaded by Applicant’s argument that the marks, while having some similarities, are overall dissimilar in appearance, sound, connotation and commercial impression. *See*

³⁴ <http://www.merriam-webster.com/dictionary/-wise>

³⁵ Kalinowski Test. 105 TTABVUE 43, 51-52.

³⁶ Opposer’s Br., p. 14.

Opposition Nos. 91186148 and 91186863

Kellogg Co. v. Pack'em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (dissimilarity of marks FROOT LOOPS and FROOTIE ICE resulted in finding of no likelihood of confusion despite very close relationship between goods and trade channels); *see also Weight Watchers Int'l v. I. Rokeach & Sons, Inc.*, 211 USPQ 700, 706 (TTAB 1981), *aff'd on other grounds*, 576 F.Supp. 841, 216 USPQ 1090 (SDNY 1982) (concurrent use of “WEIGHT WATCHERS” and “WEIGHT-WISE” would not result in a likelihood of confusion.).

G. Bad faith

Opposer alleges that Applicant did not act in good faith in seeking registration of its marks.³⁷ A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another’s mark or even an intent to copy. *See Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009) (“[T]he only relevant intent is intent to confuse. There is a considerable difference between an intent to copy and an intent to deceive.”). Opposer has not shown that Applicant intended to confuse customers as to the source of its goods. Based on this record, we cannot conclude that respondent acted in bad faith. This *du Pont* factor is neutral.

H. Balancing the factors.

Despite finding the goods are in part identical and the presumption that they move in the same channels of trade and are sold to the same classes of consumers,

³⁷ Opposer’s Br., p. 28.

Opposition Nos. 91186148 and 91186863

because we find, *inter alia*, that Opposer's marks are not famous, there are multiple users of the term "green" in the relevant industry, and the marks are dissimilar, we find that Applicant's marks for the goods set forth therein are not likely to cause confusion with the marks in Opposer's pleaded registrations.

Decision: The oppositions are dismissed on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.