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

Proceeding	91186148
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Publix Asset Management Company,
Opposer,

v.

The Great Atlantic & Pacific Tea Company, Inc.,
Applicant.

Opposition Nos. 91186148 &
91186863 (consolidated under
No. 91186148)

CONFIDENTIAL MATERIAL REDACTED

OPPOSER'S TRIAL BRIEF

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TABLE OF CONTENTS

TABLE OF CONTENTSi

INDEX OF CASES ii

DESCRIPTION OF THE RECORD 1

STATEMENT OF ISSUES3

RECITATION OF FACTS.....3

 I. Publix and Its GreenWise® Mark3

 II. A&P’s Applications for Green Way.....7

ARGUMENT.....9

 I. The Marks Are Used Upon Identical or Related Goods..... 10

 II. The Marks at Issue are Identical in Meaning and Confusingly Similar.12

 III. Goods Upon Which the Marks Are Used Are Inexpensive and May Be
 Purchased on Impulse.....19

 IV. The Channels of Trade Are Similar.....22

 V. GreenWise® is a Famous, Strong Mark Entitled to Broad Protection From
 Similar Marks.23

 VI. Third-Party Registrations for Marks Including the Term “Green” Do Not
 Preclude a Finding That Confusion is Likely.25

 VII. A Lack of Actual Confusion is Not Significant.27

 VIII. The Evidence Belies A&P’s Professed Good Faith.28

 IX. Any Doubt Must Be Resolved in Publix’s Favor.29

SUMMARY.....30

CERTIFICATE OF SERVICE31

INDEX OF CASES

Circuit and District Court Opinions

<u>AMF Inc. v. Sleekcraft Boats,</u> 599 F.2d 341 (9th Cir. 1979)	passim
<u>Beer Nuts, Inc. v. Clover Club Foods Co.,</u> 711 F.2d 934 (10th Cir. 1983)	17, 22
<u>Beer Nuts, Inc. v. Clover Club Foods Co.,</u> 805 F.2d 920 (10th Cir. 1986)	21, 22, 28
<u>Bose Corp. v. QSC Audio Products, Inc.,</u> 293 F.3d 1367 (Fed. Cir. 2002)	12, 23, 24
<u>CBS, Inc. v. Morrow,</u> 708 F.2d 1579 (Fed. Cir. 1983)	10
<u>Century 21 Real Estate Corp. v. Century Life of Am.,</u> 970 F. 2d 874 (Fed. Cir. 1992)	12, 13, 22, 23
<u>G.D. Searle & Co. v. Chas. Pfizer & Co.,</u> 265 F.2d 385 (7th Cir. 1959)	17
<u>Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.,</u> 58 C.C.P.A. 972 (C.C.P.A. 1971).....	14
<u>Giant Food, Inc. v. Nation's Foodservice, Inc.,</u> 710 F.2d 1565 (Fed. Cir. 1983)	12, 27
<u>Han Beauty, Inc. v. Alberto-Culver Co.,</u> 236 F3d 1333 (Fed., Cir. 2001)	10
<u>Hancock v. Am. Steel & Wine Co. of N.J.,</u> 97 U.S.P.Q. 330 (C.C.P.A. 1953).....	13
<u>Hewlett-Packard Co. v. Packard Press, Inc.,</u> 281 F.3d 1261 (Fed. Cir. 2002)	10, 12, 27
<u>Horta v. Sullivan,</u> 4 F.3d 2 (1st Cir. 1993).....	20
<u>In re E.I. DuPont de Nemours & Co.,</u> 476 F.2d 1357 (C.C.P.A. 1973)	9, 23, 25

<u>In re Nat'l Data Corp.,</u> 753 F. 2d 1056 (Fed. Cir. 1985)	12
<u>In re Nett Designs, Inc.,</u> 236 F.3d 1339 (Fed. Cir. 2001)	26
<u>Jellibears, Inc. v. Skating Clubs of Ga., Inc.,</u> 716 F.2d 833 (11th Cir. 1983)	16, 17
<u>Kenner Parker Toys Inc. v. Rose Art Indus., Inc.,</u> 963 F.2d 350, 22 USPQ2d 1453 (Fed.Cir.1992)	23, 24
<u>Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.,</u> 774 F.2d 1144 (Fed. Cir. 1985)	19, 24
<u>Mattel, Inc. v. Walking Mountain,</u> <u>Prods.,</u> 353 F.3d 792 (9th Cir. 2003)	11
<u>Morton-Norwich Products, Inc. v. S.C. Johnson & Son, Inc.,</u> 531 F.2d 561 (C.C.P.A. 1976)	15
<u>Official Airline Guides, Inc. v. Goss,</u> 6 F.3d 1385 (9th Cir. 1992)	28
<u>Recot, Inc. v. M.C. Benton,</u> 214 F.3d 1322 (Fed. Cir. 2000)	12, 19, 23
<u>San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.,</u> 565 F.2d 683 (C.C.P.A. 1977)	29
<u>Sealy, Inc. v. Simmons Co.,</u> 265 F.2d 934 (C.C.P.A. 1959)	18
<u>Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.,</u> 748 F.2d 669 (Fed. Cir. 1984)	10, 16
<u>Standard Brands, Inc. v. Smidler,</u> 151 F.2d 34 (2d Cir. 1945)	11, 12, 23, 24
<u>Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc.,</u> 656 F.2d 186 (5th Cir. 1981)	14
<u>Supercuts, Inc. v. Super Clips,</u> 18 U.S.P.Q.2d 1378 (D. Mass. 1990)	17

<u>Synergistic Int'l, Inc. v. Windshield Doctor, Inc.,</u> No. CV 03-579 FMC (CWx), 2003 WL 21468568 (C.D. Cal. Apr. 28, 2003).....	28
<u>Vitek Sys., Inc. v. Abbott Labs.,</u> 675 F.2d 190 (8th Cir. 1982).....	18
<u>Wella Corp. v. Cal. Concept Corp.,</u> 558 F.2d 1019 (C.C.P.A. 1977).....	27
Federal Statutes 15 U.S.C. §1057(c).....	6
Trademark Trial and Appeal Board Opinions	
<u>Brasserie De Tahiti S.A. v. Tahiti Springs,</u> 2009 WL 1228551 (T.T.A.B. Apr. 24, 2009).....	6
<u>H. Sichel Sohne, GmbH v. John Gross & Co.,</u> 204 U.S.P.Q. 257 (T.T.A.B. 1979).....	16
<u>H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc.,</u> 202 U.S.P.Q. 62 (T.T.A.B. 1979).....	passim
<u>In re Big Pig, Inc.,</u> 81 U.S.P.Q.2d 1436 (T.T.A.B. 2006).....	18
<u>In re Decombe,</u> 9 U.S.P.Q. 2d 1812 (T.T.A.B. 1988).....	20
<u>In Re Healthy's, Inc.,</u> 2001 WL 101525 (T.T.A.B. 2001).....	18
<u>In re Pellerin Milnor Corp.,</u> 221 U.S.P.Q. 558 (T.T.A.B. 1983).....	20
<u>In re Red Bull GMBH,</u> 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006).....	13
<u>In re SL&E Training Stable, Inc.,</u> 88 U.S.P.Q.2d 1216, 2008 WL 4107225 (T.T.A.B. 2008).....	13
<u>ITT Canteen Corp. v. Haven Homes Inc.,</u> 174 U.S.P.Q. 539 (T.T.A.B. 1972).....	18

Steelcase Inc. v. Steelcare Inc.,
219 U.S.P.Q. 433 (T.T.A.B. 1983).....29

Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.,
213 U.S.P.Q. 594 (T.T.A.B. 1982).....13

DESCRIPTION OF THE RECORD

Opposer, Publix Asset Management Company, has introduced the following evidence into the record by notices of reliance or the taking of trial testimony:

- January 22, 2013, Notice of Reliance, Docket Entry No. 60 (“NOR 1”) (Opposer’s Exhibit 1)
- January 22, 2013, Trial Testimony of Mark Irby, President, Publix Asset Management Company, Vice President of Marketing, Publix Super Markets, Inc., and exhibits introduced therein (“Irby Testimony”) (Opposer’s Exhibits 1-23 and Applicant’s Exhibits A-DD)
- January 31, 2013, Trial Testimony of Douglas Palmer, former Vice President of Own Brands, Great Atlantic & Pacific Tea Company, Inc. (“A&P”), and exhibits introduced therein (“Palmer Testimony”) (Opposer’s Exhibits 24-36)
- January 31, 2013, Trial Testimony of Beth Curran, Manager of Own Brands, A&P, and exhibits introduced therein (“Curran Jan. Testimony”) (Opposer’s Exhibits 37-38)
- February 19, 2013, Notice of Reliance, Docket Entry No. 62 (“NOR 2”) (Opposer’s Exhibits 39-69)
- November 21, 2013, Trial Testimony of Paul Kalinowski, Business Development Director, Publix Super Markets, Inc., and exhibits introduced therein (“Kalinowski Testimony”) (Opposer’s Exhibit 71 & Applicant’s Exhibits YYYY-BBBBB)
- November 25, 2013, Notice of Reliance, Docket Entry No. 74 (“NOR 3”) (Opposer’s Exhibits 72-75)

Applicant, Great Atlantic & Pacific Tea Company, Inc., has introduced the following evidence into the record by notices of reliance or the taking of trial testimony:

- September 25, 2013, Trial Testimony of Jay Warren, Global Litigation Counsel, Whole Foods Market Central, and exhibits introduced therein (Applicant’s Exhibits EE-CCC)
- September 26, 2013, Trial Testimony of John Kroeger, Senior Vice President and Deputy General Counsel, Pinnacle Foods, and exhibits introduced therein (Applicant’s Exhibits DDD-III and Opposer’s Exhibit 70)
- October 3, 2013, Trial Testimony of Beth Curran, Manager of Own Brands, A&P, and exhibits introduced therein (“Curran Oct. Testimony”) (Applicant’s Exhibits JJJ-CCCC)

- October 9, 2013, Trial Testimony of Adam Brink, Corporate Counsel, The Clorox Company, and exhibits introduced therein (Applicant's Exhibits DDDD-XXXX)
- October 11, 2013, Notice of Reliance, Docket Entry Nos. 67-73 ("NOR 4")

Evidence automatically of record:

- Opposer's Notices of Opposition and Amended Notice of Opposition
- Applicant's Answers to Notices of Opposition and to Amended Notice of Opposition
- Applicant's Application Serial No. 77/349,246 for the mark GREEN WAY
- Applicant's Application Serial No. 77/409,725 for the mark GREEN WAY

STATEMENT OF ISSUES

This case concerns the confusing similarity of the marks GreenWise® and Green Way, both employed by leading supermarket companies to identify private-label lines of organic, natural, and earth-friendly retail grocery store products. These marks are confusingly similar in sight, sound, and meaning. The GreenWise® mark is senior, well-established, and has been used for many years for many of the same products that are now to be offered under the Green Way mark. And both marks are aimed at the same types of consumers – i.e., health-conscious shoppers. Accordingly, the oppositions filed by the GreenWise® owner, Publix Asset Management Company (“Publix Asset”), ought to be sustained, and the applications by The Great Atlantic & Pacific Tea Company, Inc. (“A&P”) for Green Way must be denied.

RECITATION OF FACTS

I. Publix and Its GreenWise® Mark

The GreenWise® mark identifies organic, natural, and environmentally friendly products offered at approximately 1,060 retail super markets in several states. Irby Testimony p. 12 l. 23-25; p. 16 l. 20 through p. 17 l. 6; p. 24 l. 6-21.¹ The GreenWise® mark is used only in connection with products that meet strict Publix standards. *Id.* p. 16 l. 15 though p. 17 l. 6 & Ex. 2. Thus GreenWise® signs, labels and displays provide a trustworthy means for health-conscious consumers to quickly recognize high-quality, healthy products.

GreenWise® goods are fully integrated into the shopping experience at Publix’s grocery stores. Many stores, for example, include GreenWise® sections, where items such as cereal,

¹ GreenWise® products are sold in stores owned by Publix Super Markets, Inc. See Irby Testimony p. 37 l. 22 through p. 38 l. 2; *id.* p. 65 l. 17-25. Publix Asset is a related company that owns and manages marks licensed to Publix Super Markets. *Id.* p. 10 l. 19-24; p. 34 l. 7-22 & Ex. 14. In this brief, Publix Asset and Publix Super Markets are referred to collectively as “Publix.”

snacks, and juices are available. Id. pp. 24 *l.* 6-21 & Ex. 6 (cereal at GW 1427, juices at GW 1417 & GW1979, snacks at GW 1299). Other products that carry GreenWise® labels include dairy, meat, and seafood items. Id. p. 23 *l.* 10-14 & Ex. 4 (dairy display); p. 26 *l.* 11 through p. 27 *l.* 11, Exs. 10-11 (meat and seafood). The GreenWise® brand also includes such diverse products as vitamins, bathroom tissue, charcoal, chlorine-free bleach, and cat litter. Id. p. 24 *l.* 6-21 & Ex. 6 (vitamins at GW 1326, bathroom tissue at GW 1311, charcoal at GW 2381, chlorine-free bleach at GW 1296, and cat litter at GW 1437). GreenWise® products are marketed alongside other brands. See, e.g., Irby Testimony p. 79 *l.* 4-17 & Ex. J (flier advertising various products, including GreenWise® beef); id. p. 109 *l.* 23 through p. 110 *l.* 16 (noting that other health and beauty products are sold in GreenWise® store sections).

GreenWise® stand-alone stores also exist. Id. pp. 24 *l.* 22 through 25 *l.* 13 & Ex. 7. Products sold in those stores include, of course, products that carry the GreenWise® label. Id. p. 25 *l.* 2-4. Those stores also offer in-store dining and deli services; retail store services featuring candy, bakery items, wine and beer; and café, restaurant and coffee bar services. Id. p. 30 *l.* 9 through p. 32 *l.* 14 & Ex. 13; NOR 1.

As part of its integrated approach catering to the health-conscious consumer, Publix also publishes a GreenWise® magazine and includes educational information on its web site. Id. p. 19 *l.* 23 through p. 20 *l.* 13. The magazine offers information helpful to health-conscious consumers interested in natural and organic products. Id. p. 20 *l.* 1-13 & Ex. 3; id. p. 23 *l.* 18 through p. 24 *l.* 2. The GreenWise® portion of the Publix website contains additional information concerning GreenWise® products and services, such as, for example, a list of GreenWise® private-label products, a list of stores where those products are available, and a natural foods glossary. Id. p. 80 *l.* 4-15 & Ex. K; p. 97 *l.* 21 through p. 98 *l.* 4 & Ex. AA.

Publix currently offers approximately 290 GreenWise® private-label products. *Id.* pp. 27-28 & Ex. 12 (confidential product list). A sample shopping cart might include GreenWise® organic baby lettuce salad, boneless skinless chicken breasts, ground beef, vitamins, organic apple sauce, chocolate soy milk, coffee, organic sweet peas and organic black beans, organic tomato ketchup, organic pure honey, organic eggs, blue corn tortilla chips, chlorine-free bleach, facial tissue, napkins and even cat litter and charcoal. *Id.* Exs. 6 & 12. A shopper purchasing those items at a GreenWise® store could also obtain chocolate candy made in the store, purchase fresh-baked bread, and sample organic wine. NOR 1.

The relevant federal registrations for the GreenWise® mark are:

- Reg. No. 2,520,595, for retail grocery store services, with a first-use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2,732,403, for food products, namely, breakfast cereals, grain-based chips, sauces, honey, and tomato sauce, with a first-use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2,729,423, 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, with a first-use date of March 14, 2001, and arising from an application filed November 19, 1998;
- Reg. No. 2,654,223, for a newsletter in the field of health and nutrition, with a first-use date of February 26, 2001, and arising from an application filed January 09, 2002;
- Reg. No. 3,328,951, for paper products, namely, bathroom tissue, facial tissue, paper napkins and paper towels, with a first-use date of March 31, 2003, and arising from an application filed April 2, 2007;
- Reg. No. 3,546,815, for laundry bleach, with a first-use date of October 31, 2007, and arising from an application filed May 16, 2008;
- Reg. No. 3,753,274, for vitamins and nutritional supplements, with a first use date of July 1, 2009, and arising from an application filed April 1, 2009;
- Reg. No. 3,813,868, for wood chips for smoking and grilling; charcoal briquettes, with a first use date of March 5, 2008, and arising from an application filed November 13, 2009;

- Reg. No. 3,813,886, 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, with a first use date of April 12, 2003, and arising from an application filed November 13, 2009;
- Reg. No. 3,813,890, for fruit juices; tomato juice, with a first use date of October 23, 2003, and arising from an application filed November 13, 2009;
- Reg. No. 3,813,937, for food products, namely, ketchup, mustard, salsa, vinegar, flavored vinegar, wine vinegar, crackers, and candy, namely, chocolate covered raisins, with a first use date of January 2007, and arising from an application filed November 16, 2009;
- Reg. No. 3,813,946, for cat litter; unprocessed vegetables and fruits; unprocessed mushrooms, with a first use date of July 11, 2007, and arising from an application filed November 16, 2009;
- Reg. No. 3,813,950, for retail store services featuring chocolate confectionery, candy and edible gifts, delicatessens, bakery items, wines, organic wines, and beers, with a first use date of September 27, 2007, and arising from an application filed November 16, 2009; and
- Reg. No. 3,813,952, for cafe, restaurant, delicatessen and coffee bar services, in-store and for carry out, with a first use date of September 27, 2007, and arising from an application filed November 16, 2009.

NOR 1.²

As these numerous registrations demonstrate, Publix has used and uses the GreenWise® mark extensively since at least as early as 2001. *Id.*; Irby Testimony p. 15 *l.* 9-25. The GreenWise® mark appears on a host of private-label consumer goods in numerous classes. NOR 1. Through its federal registrations and applications as well as widespread use by Publix, Publix has acquired exclusive rights to use the GreenWise® mark in commerce throughout the United

² Because these pleaded registrations are of record, the application filing dates establish constructive use of Green Wise® for Section 2(d) priority purposes. *See* 15 U.S.C. §1057(c); *Brasserie De Tahiti S.A. v. Tahiti Springs*, 2009 WL 1228551, at *2 (T.T.A.B. Apr. 24, 2009) (finding Section 2(d) priority, because filing date of prior registrant's application that matured into pleaded registration was prior to any date upon which junior user might rely). Publix also presented evidence confirming actual first-use dates. *See e.g.*, Irby Testimony p. 19 *l.* 11-19, p. 21 *l.* 12 through p. 22 *l.* 11, & p. 27 *l.* 17 through p. 28 *l.* 5 & Exs. 3 & 12. There is no question, therefore, that GreenWise® is the senior mark.

States. As explained more fully in the portions of Mr. Irby's testimonial deposition and related exhibits filed under seal, Publix has expended millions of dollars promoting its GreenWise® mark, and the quality of those goods and services combined with Publix's marketing efforts have resulted in significant sales of GreenWise® products and services. Irby Testimony pp. 44-50 & Exs. 21-22.

II. A&P's Applications for Green Way

Despite the strength of the GreenWise® mark and a search report citing the senior GreenWise® registrations, Palmer Testimony pp. 109 *l.* 4-10 *l.* 17, Ex. 35 (pages A&P 636-638) and numerous industry and general circulation news articles discussing the innovative GreenWise® program and products (see NOR 2), A&P selected a highly similar mark for essentially identical products, marketed under a similar strategy to the same type of consumers. A&P operates approximately 450 retail stores, including full-service supermarkets. Notices of Opp'n ¶ 9; Answers ¶ 9. A&P filed the Green Way applications at issue on an intent-to-use basis on December 11, 2007, and February 29, 2008, nearly seven years after Publix began actual use of GreenWise® and a decade after Publix's first constructive first-use date. See Irby Testimony p. 15 *l.* 1-25 (testifying to Publix's March 2001 first-use date); NOR 1 (TSDR printout showing November 1998 filing date for first GreenWise® applications).

A&P seeks to register the Green Way mark in a wide variety of classes, encompassing many products available in grocery stores and overlapping with many GreenWise® goods. For example, A&P's December 11, 2007, application sought registration in the following classes:

- In International Class 29, for 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 30, for 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 31, for fresh vegetables; and
- In International Class 32, for fruit juices, fruit drinks, and soft drinks.

Serial No. 77/349,246.

On February 29, 2008, A&P expanded the planned GreenWay product line to many non-food items. That application sought registration for the following goods:

- In International Class 3, for 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 4, for charcoal; white birch firewood; fire wood chips for use as fuel; fireplace logs.
- In International Class 5, for hand sanitizing preparations; dietary food supplements.
- In International Class 8, for disposable forks, knives, and spoons.
- In International Class 9, for batteries.
- In International Class 11, for compact fluorescent electric light bulbs.
- In International Class 16, for paper towels; paper table cloths; paper napkins; bathroom tissue; notebooks; notebook paper; and facial tissues.
- In International Class 20, for reeds, namely, diffuser reeds.

- In International Class 21, for paper plates and paper cups.
- In International Class 29, for 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 30, for teas; sesame sticks; chocolate coated nuts; yogurt coated nuts; macaroni and cheese; pesto sauce; bread; tortillas; tortillas chips.
- In International Class 31, for pet food.
- In International Class 32, for soda pop.

Serial No. 77/409,725.

Recognizing the similarity of these goods and the Green Way mark to the well-established GreenWise® product line and related services, Publix filed notices of opposition to each application. See Docket Entry No. 1, Opp'n No. 91186863 (Oct. 8, 2008); Docket Entry No. 1, Opp'n No. 91186148 (Sept. 3, 2008). The proceedings were consolidated. See Docket Entry No. 6, Opp'n No. 91186148 (Jan. 7, 2009). In the consolidated proceeding, A&P filed a motion for summary judgment, arguing that GreenWise® and Green Way are not confusingly similar. See Docket Entry No. 23, Opp'n No. 91186148 (Aug. 6, 2010). The Board denied A&P's motion, finding an issue of fact concerning "whether the marks GREEN WAY and GREENWISE are so dissimilar as to preclude a finding of likelihood of confusion." See Docket Entry No. 44, Opp'n No. 91186148 (Apr. 11, 2011). This brief presents Publix's evidence regarding that issue.

ARGUMENT

The key issue in this proceeding is the likelihood of confusion between A&P's new Green Way mark and Publix's incontestable GreenWise® mark. The factors to be considered in a likelihood of confusion inquiry are set forth in In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). Only those factors for which there are probative facts in a case

F.2d 341, 348 n. 10 (9th Cir. 1979) (quoting Standard Brands, Inc. v. Smidler, 151 F.2d 34, 37 (2d Cir. 1945)) abrogated on other grounds by Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 810 n.19 (9th Cir. 2003).

In this case, the parties' goods and services are highly similar. Both the GreenWise® and Green Way marks identify goods sold in retail grocery stores. See Irby Testimony pp. 12 l. 3-25, 24, l. 19-21; Curran Jan. Testimony p. 50 l. 15-22; Notices of Opp'n ¶ 9; Answers ¶ 9. Specifically, the GreenWise® mark identifies a wide range of organic, natural and earth-friendly consumer goods that are sold in grocery stores, and many of those same goods also are listed in the Green Way applications and are similarly labeled as natural, organic and/or earth-friendly. See Irby Testimony pp. 16 l. 15 through p. 17 l. 6; Palmer Testimony p. 19 l. 8-20, p. 31 l. 4-23.

For example, GreenWise® is registered for bread, pretzels, potato chips, processed nuts, edible processed seeds, dried fruits, processed fruits, bathroom tissue, facial tissues, paper napkins, and paper towels, charcoal, wood chips, applesauce, soy milk, milk, vinegar, breakfast cereals, crackers, fresh vegetables and fruit juices. NOR 1. A&P now intends to use Green Way for those same goods. Serial Nos. 77/349,246; 77/409,725. A&P also has plans for Green Way pesto sauce and teas, Serial No. 77/409,725, much like GreenWise® sauces and herbal teas. NOR 1.

Numerous other goods on the A&P applications are closely related to GreenWise® products, such as Green Way paper table cloths and GreenWise® paper napkins; Green Way tortilla chips and GreenWise® grain-based chips; Green Way canned tomatoes and canned beans and GreenWise® canned vegetables; and Green Way pet food and GreenWise® cat litter.

Compare NOR 1 with Serial Nos. 77/349,246 & 77/409,725.³ Such duplication of goods will inevitably foster consumer confusion. See Century 21 Real Estate Corp. v. Century Life of Am., 970 F. 2d 874, 877 (Fed. Cir. 1992) (if marks are used upon identical goods, a lesser degree of similarity is required in order to show a likelihood of confusion).

In this case the parties' marks are used for essentially the same goods – i.e., organic, natural, and eco-friendly or earth-friendly products sold in grocery stores. Irby Testimony pp. 16 *l.* 15-19 *l.* 7; Palmer Testimony pp. 19 *l.* 8-14, 31 *l.* 4-23. Because all such goods are “related,” this factor weighs in favor of finding a likelihood of confusion. See, e.g., Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 1376 (Fed. Cir. 2002) (component parts of a sound system were similar to opposer's stand-alone sound systems); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570 (Fed. Cir. 1983) (good and services of a grocery store chain and a fast food restaurant were sufficiently related as to weigh against an applicant); Standard Brands, Inc. v. Smidler, 151 F.2d 34, 37 (2d Cir. 1945) (vegetable juice and vitamin supplement held to be closely related). Similarly, in this case, those goods that are not identical are still closely related, and this DuPont factor weighs heavily in Publix's favor.

II. The Marks at Issue are Identical in Meaning and Confusingly Similar.

The similarity of the mark factor of the DuPont analysis “examines the relevant features of the marks, including appearance, sound, connotation, and commercial impression.” Hewlett-Packard, 281 F.3d at 1266 (citing Recot, Inc. v. M.C. Benton, 214 F.3d 1322, 1329 (Fed. Cir. 2000)). The marks must be considered as a whole. In re Nat'l Data Corp., 753 F. 2d 1056, 1058

³ [Redacted discussion of material designated Trade Secret/Commercially Sensitive]

(Fed. Cir. 1985). If goods are either identical or closely related, as is the case here, “the degree of similarity [between the marks] necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods.” In re SL&E Training Stable, Inc., 88 U.S.P.Q.2d 1216, 2008 WL 4107225, at *2 (T.T.A.B. 2008) (citations omitted). See also Century 21 Real Estate Corp., 970 F. 2d at 877 (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

Moreover, it is well-settled that “similarity in meaning or significance alone is sufficient to indicate a likelihood of confusion.” H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62, 65 (T.T.A.B. 1979) (citing Hancock v. Am. Steel & Wine Co. of N.J., 97 U.S.P.Q. 330 (C.C.P.A. 1953)). See also AMF Inc., 599 F.2d at 352 (“Closeness in meaning can itself substantiate a claim of similarity of trademarks.”) (citation omitted). In this case, the marks at issue are quite similar in meaning. Both marks have the common element of “green,” which both companies use to refer to organic, natural, environmentally sensitive, healthy products. See, e.g., Irby Testimony p. 54 *l.* 12-19; Curran Oct. Testimony p. 57 *l.* 1-24. The word “wise” can mean a “[m]ethod or manner of doing; way.” See American Heritage College Dictionary at 1573 (4th ed. 2007) (Kalinowski Testimony Ex. 71).⁴ Similarly, as a suffix, -wise “has a long history of use to mean in the manner or direction of, as in clockwise, otherwise, and slantwise.” Kalinowski Testimony p. 13 *l.* 17-19 (quoting Ex. 71). The “wise” suffix also is defined as a “specified manner, direction, or position” or “with reference to, in

⁴ The Board takes judicial notice of dictionary definitions. See, e.g., Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc., 213 U.S.P.Q. 594 (T.T.A.B. 1982), aff’d, 703 F.2d 1372, 217 U.S.P.Q. 505 (Fed. Cir. 1983); In re Red Bull GMBH, 78 U.S.P.Q.2d 1375 (T.T.A.B. 2006).

regard to.” *Id.* p. 13 *l.* 10-14 (quoting Ex. 71). “Way” is similarly defined as a “course of action or conduct,” a “manner or method of doing,” and a “usual or habitual manner or mode of being, living, or acting.” *Id.* p. 14 *l.* 13-19 (quoting Ex. 71). Thus, GreenWise® and Green Way both connote products that fit within a lifestyle – or way of life – that is healthy and environmentally-friendly. They “both imply a method for being green, being more environmentally sensitive, being more healthy.” Irby Testimony p. 54 *l.* 18-19. These marks, therefore, are similar in meaning.

The similarities between GreenWise® and Green Way are particularly likely to foster confusion in the marketplace, which is, of course, the place where likelihood of confusion must be measured. Consequently, “the fallibility of memory over a period of time” must be taken into account when deciding whether two marks are similar in appearance, sound, connotation, or commercial impression. Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 58 C.C.P.A. 972, 974 (C.C.P.A. 1971). Because GreenWise® and Green Way identify private-label brands, the marks are unlikely to appear side-by-side on store shelves. GreenWise® products and services currently are sold in Publix’s stores, and Green Way products are sold in A&P’s stores. Irby Testimony p. 37 *l.* 22 through p. 38 *l.* 2; Palmer Testimony pp. 129 *l.* 21 through p. 130 *l.* 25. The resulting “inability to compare the products side by side and observe the precise differences in appearance may increase the likelihood of confusion,” because in “making a decision to purchase the consumer must rely on memory rather than a visual comparison.” Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186, 192 (5th Cir. 1981) (citing 3 R. Callman, The Law of Unfair Competition Trademarks and Monopolies § 81.1 at 573 (3d ed. 1969)).

For example, if the Green Way mark expands to be used on the full range of goods cited in A&P’s applications, consumers who are winter, “snowbird” residents of Florida and summer

residents of the Northeast are likely to encounter Green Way products and erroneously assume they are versions of the genuine GreenWise® products they have seen in Publix stores for years. Irby Testimony p. 55 *l.* 1-13. The inability of such consumers to make a side-by-side comparison actually enhances the likelihood of confusion.

The fact that GreenWise® and Green Way have the same meaning and create the same commercial impression is supported by the advertising of the parties for these two brands. See Morton-Norwich Products, Inc. v. S.C. Johnson & Son, Inc., 531 F.2d 561, 562-63 (C.C.P.A. 1976) (using advertisements to support finding that the connotation and commercial impressions of Rainfresh for liquid detergents was similar to that of Rain Barrel for fabric softner). The GreenWise® mark describes three kinds of products – organic, natural, and earth-friendly. *See, e.g.*, Irby Testimony p. 16 *l.* 24 through p. 17 *l.* 2; Ex. 2 p. 1 (Trade Secret/Commercially Sensitive Memorandum); Irby Testimony Ex. 6 (GW 2452) (November 2007 GreenWise® magazine cover displaying the description “Organic, All-Natural, and Earth-Friendly”); Irby Testimony p. 72 *l.* 19 through p. 73 *l.* 2 & Ex. E (Summer 2012 GreenWise® magazine cover displaying the description “Organic, All-Natural, and Earth-Friendly”). A&P similarly describes its Green Way products as “natural, organic and earth friendly” and as “[t]he organic, natural and ecologically smart brand.” Palmer Testimony pp. 19 *l.* 8-14, 31 *l.* 4-23; Curran Oct. Testimony p. 10 *l.* 25 through p. 11 *l.* 6. Thus, the commercial impression created by Publix’s GreenWise® mark is the same as that sought to be created by the Green Way mark – the marks identify products that are organic, all-natural, or made in an environmentally-friendly way.

The similarity in this case is even more pronounced than in H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62 (T.T.A.B. 1979). In Sohne, the applicant sought to register the mark “Blue Angel” for wine. Id. at 63. The opposer owned the

registration for “Blue Nun,” also for wine. Id. Thus, like here, the marks were to be used on identical goods. The panel found that the use of the arbitrary term “Blue” with a second word with religious connotation meant that the two marks were “similar in sounds, appearance and meaning.” Id. at 64. The panel rejected the claim that the differences between “Nun” and “Angel” controlled the likelihood of confusion analysis, because despite those differences “the marks convey the same general idea or stimulate the same mental reaction.” Id. at 65. Accordingly, the marks were found confusingly similar. Id. at 66. See also H. Sichel Sohne, GmbH v. John Gross & Co., 204 U.S.P.Q 257, 261 (T.T.A.B. 1979) (cancelling registration for “Blue Chapel” for wine based upon the similar commercial impression for the senior “Blue Nun” mark for wine).

Similarly, the Federal Circuit has held that the marks SPICE ISLANDS and SPICE VALLEY for teas have the same connotation and commercial impression, thus causing a likelihood of confusion and requiring the rejection of SPICE VALLEY. Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669 (Fed. Cir. 1984). Like the GreenWise® and Green Way marks, the Spice Islands and Spice Valley marks consisted of two words with the first being identical. Id. at 672. The second words were the same in that they were both “topographically defined place[s].” Id. Thus, “the similarity of commercial impression” between SPICE VALLEY and SPICE ISLANDS weighed “heavily against the applicant as applied to identical goods.” Id. at 673. See also Jellibeans, Inc. v. Skating Clubs of Ga., Inc., 716 F.2d 833, 842 (11th Cir. 1983) (JELLIBEANS and LOLLIPOPS for skating rinks “evoke the same general impression” and thus were substantially similar). Even more so than SPICE VALLEY and SPICE ISLANDS or JELLIBEANS and LOLLIPOPS, the GreenWise® and Green Way marks create the same commercial impression.

The appearance and sound of the marks also are substantially similar. Both marks begin with “Green” and end with a one-syllable word or suffix that begins with a capital “W.” The inclusion of a space between the two constituent parts in A&P’s mark does not alter the substantial similarity between the two marks’ appearance and sound. See Supercuts, Inc. v. Super Clips, 18 U.S.P.Q.2d 1378, 1380 (D. Mass. 1990) (SUPERCUTS and SUPER CLIPS were “hardly distinguishable”). In fact, the appearance and sound of marks with fewer similarities have been found to be substantially similar.

In Jellibears, the Eleventh Circuit discussed the similarities in appearance and sound for the marks “Jellibears” and “Lollipops” for skating rinks. 716 F.2d at 842. The marks were visually similar, because they were both spelled with an “i” rather than a “y” and both used the plural form. Id. The marks also were similar in sound. “In finding an aural similarity, the [district] court noted that each name has three syllables, with an “l” sound dividing the first and second syllables, and an “e” sound dividing the second and third syllables, and that each name ends in a plural “s.” Id. The Eleventh Circuit affirmed these holdings. Id. The visual and sound similarities of GreenWise® and Green Way are, of course, much greater. See also G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387 (7th Cir. 1959) (rejecting the trial court’s conclusion as clearly erroneous where it was found that the marks Dramamine and Bonamine were not similar in sound, the appellate court explained that “[s]light differences in the sounds of similar trademarks will not protect the infringer”).

The slight verbal differences between GreenWise® and Green Way do not adequately distinguish these marks, because overall they are similar in appearance, sound, connotation, and commercial impression. In a similarity of the marks analysis, “similarities weigh more heavily than differences.” Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934, 940 (10th Cir. 1983)

(“Beer Nuts I”) (quoting AMF, Inc., 599 F.2d at 351); Vitek Sys., Inc. v. Abbott Labs., 675 F.2d 190, 192 (8th Cir. 1982)). Thus, slight verbal differences between the marks carry virtually no weight in the analysis.

Use of the GreenWise® mark with Publix’s house mark does not change this analysis. Over Publix’s relevance objection, A&P elicited trial testimony concerning use of Publix’s other marks, including PUBLIX, in proximity to the GreenWise® mark. See, e.g., Irby Testimony pp. 65 l. 17-66 l. 11; id., p. 77 l. 12-17. Courts and this Board have repeatedly rejected such evidence as irrelevant. For example, in Sealy, Inc. v. Simmons Co., 265 F.2d 934 (C.C.P.A. 1959), the court found that use of the house marks SEALY and SIMMONS on product labels was “not germane to the question of likelihood of confusion between the secondary trademarks” at issue, which “may be used at any time without the respective house-marks.” Id. at 937. Rather, “the issue of likelihood of confusion insofar as the registrability of applicant’s mark is concerned is determined on the basis of such mark and registrant’s mark as they are respectively set forth in the application and the cited registration.” In re Big Pig, Inc., 81 U.S.P.Q.2d 1436 (T.T.A.B. 2006). See also ITT Canteen Corp. v. Haven Homes Inc., 174 U.S.P.Q. 539, 540 (T.T.A.B. 1972) (comparing marks as shown on application and registration; use in other forms “is immaterial”). Therefore, use of another mark with GreenWise® “is legally irrelevant and immaterial in this case inasmuch as the issue of likelihood of confusion must be decided on the basis of the mark sought to be registered by applicant and the mark shown in the cited registration.” In Re Healthy’s, Inc., 2001 WL 101525, at *3 n.3 (T.T.A.B. 2001). A&P sought registration of Green Way without its house marks,⁵ and GreenWise® likewise is registered to

⁵ The Green Way mark is intentionally disconnected from A&P’s house marks, because Green Way “is a consumer brand and with no connection to the store or the marque[e].” See (footnote continued on next page)

Publix as a stand-alone mark. NOR 1. Consequently, whether GreenWise® labels carry other marks is irrelevant.⁶

Publix is rightfully concerned about A&P's proposed registrations. The Green Way mark is not only "very similar to the GreenWise mark in terms of the name, obviously, that is used; but more importantly, it's the entirety in which the brand is applied to a variety of – to a line of products that appear to be following under very similar criteria [to] our own, which is organic, natural, and earth-friendly products." Irby Testimony p. 52 l. 22 through p. 53 l. 3. As A&P concedes, approximately 250 individual products carry the Green Way mark. Curran Oct. Testimony p. 10 l. 25 through p. 11 l. 14.⁷ As a result of the striking similarities in the marks' appearance, sound, meaning and commercial impression, A&P's applications should be denied.

III. Goods Upon Which the Marks Are Used Are Inexpensive and May Be Purchased on Impulse.

Because the goods upon which both the GreenWise® and Green Way marks are used are relatively inexpensive, they are particularly susceptible to consumer confusion. "When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care." Recot, 214 F.3d at 1329 (citing Kimberly-Clark Corp. v. H. Douglas Enter., Ltd., 774 F.2d 1144, 1146 (Fed. Cir. 1985)). The average price of most GreenWise® products "would certainly be under \$20." Irby Testimony pp. 51 l. 10. Consumer price sensitivity was also a significant

Palmer Testimony p. 42 l. 2-7. The lack of a connection between Green Way and a particular store brand enhances the likelihood of confusion.

⁶ Moreover, when GreenWise® is used with Publix's house mark, GreenWise® is clearly dominant, appearing in type seven times larger than Publix's house mark. See Irby Testimony p. 108 l. 11-16. GreenWise® appears in larger type because "Greenwise is what's unique here. Otherwise, it would just be a Publix product." Id. p. 109 l. 1-2.

⁷ [Redacted discussion of material designated Trade Secret/Commercially Sensitive]

concern when A&P launched its Green Way line. Palmer Testimony pp. 99 *l.* 17-100 *l.* 13. As consumers are unlikely to devote careful attention when purchasing the similar, low-cost items contained within the GreenWise® and Green Way product lines, a likelihood of confusion between the marks is further heightened.

This analysis is not altered by unsupported testimony that individuals who purchase organic, natural or environmentally-friendly goods might be better educated than the average shopper. See, e.g., Palmer Testimony p. 122 *l.* 10-14.⁸ Knowledge or sophistication in one field “does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks.” In re Decombe, 9 U.S.P.Q. 2d 1812, 1814-15 (T.T.A.B. 1988). See also In re Pellerin Milnor Corp., 221 U.S.P.Q. 558, 560 (T.T.A.B. 1983) (“The law has long recognized that even technically sophisticated and careful purchasers of industrial equipment and products are not necessarily expert in trademark evaluation or immune from source confusion.”). Moreover, GreenWise® and Green Way purchasers are not shopping for a \$30,000 Prius hybrid vehicle. See AMF Inc., 599 F.2d at 352 (“[W]hen goods are expensive, the buyer can be expected to exercise greater care in his purchases.”). In any event, A&P concedes that Green Way products were never intended to appeal solely to more educated, higher-income customers. Palmer Testimony p. 99 *l.* 17 through p. 100 *l.* 13. It was and is A&P’s admitted goal to make Green Way “accessible to all of [its] customers in every neighborhood that [it] serves.” Curran Jan. Testimony p. 32 *l.* 7-22; see also Curran Oct. Testimony p. 52 *l.* 7-10 (“We really target the brand to all consumers. We really presented the brand to be [accessible] to everybody.”).

⁸ Articles that A&P’s counsel printed from the Internet, see NOR 4, are not admissible to prove the truth of matters they assert. See Horta v. Sullivan, 4 F.3d 2, 8 (1st Cir. 1993) (newspaper article inadmissible for its truth).

The GreenWise® and Green Way marks do not identify expensive, seldomly replaced items such as automobiles, boats, computers, or television sets where consumers typically engage in a substantial amount of research and consideration before making a purchase. Rather, the products at issue – including paper towels, bathroom tissue, potato chips and bread – are lower cost items sold at grocery stores to a wide range of everyday consumers.

In part because of such low prices, the decision to buy such an item is known as a “low involvement purchase.” This means that a “customer typically is making a purchase for an item that they are familiar with, that they buy frequently or often, either by brand or category or type and, basically, because of the familiarity and, generally, a low price point...something that’s no more than a few dollars...[t]hey don’t think a lot about the purchase....” Irby Testimony p. 58 *l.* 12-13. “It’s a matter of routine, and so they buy it out of habit, primarily.” *Id.* *l.* 13-14. Indeed, the “majority of GreenWise® products are “low involvement purchases.” *Id.* *l.* 15-18.

Similarly, Green Way customers, according to the developer of that brand, were expected to purchase Green Way items without closely inspecting them. Palmer Testimony pp. 114 *l.* 23 through p. 115 *l.* 10. In fact, according to the selector of the Green Way mark, consumers often make purchasing decisions concerning natural and organic products in under six to eight seconds. *Id.* p. 123 *l.* 12 through 124 *l.* 10. Consequently, even sophisticated consumers, who are unlikely to see the products side-by-side, are likely to confuse them.

In Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 927 n.6 (10th Cir. 1986) (“Beer Nuts II”), the district court found that consumers used substantial care in purchasing snack items, based upon testimony about a survey reporting that “consumers often exercise great care in purchasing potato chips.” The Tenth Circuit found this holding to be erroneous. *Id.* at 927. Instead, because the items were inexpensive, “these items are more likely to be confused

than expensive items which are chosen carefully.” *Id.* at 926 (quoting Beer Nuts I, 711 F.2d at 941). Similarly, the relatively low cost of GreenWise® and Green Way items weighs decidedly in Publix’s favor and increases the likelihood of confusion between the two marks.

IV. The Channels of Trade Are Similar.

Because A&P and Publix both operate retail grocery stores, the parties also operate in similar channels of trade. Publix’s GreenWise® goods and services are sold in retail grocery stores, just as A&P sells its Green Way goods in its retail grocery stores. Irby Testimony pp. 24-27; Palmer Testimony pp. 38 *l.* 21 through p. 39 *l.* 20. The GreenWise® and Green Way marks, therefore, “will be encountered in the identical way as private label grocery store options.” Docket Entry No. 44, p. 3, Opp’n No. 91186148 (Apr. 11, 2011).

A&P also sells Green Way products in other grocery stores under its banner, including Walbaums, Pathmark, Food Emporium and Super Fresh. Palmer Testimony pp. 129 *l.* 21-30 *l.* 25. Nothing in A&P’s applications limits its sales channels or suggests the goods will not be sold in the same manner as Publix’s GreenWise® goods and services. Nothing prevents A&P from selling Green Way products to other retailers in any geographic market. A&P in fact recognizes that the Green Way brand was developed as a “stand alone brand,” meaning that it is purposefully not identified with A&P grocery stores and could be “sold in places we [A&P] don’t have stores” and “to other retailers so they could also market the brand.” Curran Oct. Testimony p. 8 *l.* 15-23 & p. 9 *l.* 24 through p. 10 *l.* 5. Accordingly, the fact that the parties utilize identical trade channels – i.e., direct sales to consumers in grocery stores – further suggests a likelihood of confusion.

A similar conclusion was reached by the Federal Circuit in Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877 (Fed. Cir. 1992). The Board in Century 21 found

that the two parties “advertise in the same media, offer the same services to the same types of purchasers, and employ the same trade channels,” but discounted the trade channels factor because the insurance products upon which the marks were used were not sold by the same vendors. *Id.* The Federal Circuit rejected this approach and noted that “[a]n opposer need not establish the sale of both parties’ services by the same vendor to show employment of the same trade channels.” *Id.* (citing *DuPont*, 476 F.2d at 1357). Similarly, in this case, the GreenWise® and Green Way goods may not appear on the same grocery shelves, but this does not avoid the conclusion that the goods utilize identical trade channels, a factor that heavily favors Publix.

V. GreenWise® is a Famous, Strong Mark Entitled to Broad Protection From Similar Marks.

“Famous marks ... enjoy a wide latitude of legal protection.” *Recot*, 214 F.3d at 1327 (citing *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1455 (Fed.Cir.1992)). “Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.” *Id.* (citing *Kenner Parker*, 963 F.2d at 352). “[T]he fame of a mark may be measured indirectly, among other things, by volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) (citations omitted). This case law compels the conclusion that GreenWise® is a famous, strong mark.

GreenWise® products are sold in approximately 1,060 grocery stores in several states. Irby Testimony p. 12 *l.* 23-25, p. 13 *l.* 7-10; p. 24 *l.* 19-21. As explained more fully in the portion of Mr. Irby’s testimony under seal and related exhibits, the GreenWise® mark is the subject of extensive marketing expenditures, and GreenWise® sales have been significant. Irby Testimony p. 44 *l.* 18 through p. 46 *l.* 13 & Ex. 21 (advertising information); *id.* p. 47 *l.* 10-23 &

Ex. 22 (sales information). GreenWise® products are promoted through various media including television, newspapers, radio, direct mail, social media, website and outdoor advertisements. Id. p. 44 *l.* 1-8 & p. 59 *l.* 4-11. The mark also is used throughout Publix's stores. See, e.g., Irby Testimony p. 21 *l.* 21 through p. 22 *l.* 24 & Ex. 3; Id. p. 30 *l.* 9 through p. 32 *l.* 14 & Ex. 13. Moreover, the GreenWise® mark has been in use for over a decade, with its first marketplace use in March 2001. Id. p. 15 *l.* 21-25, p. 19 *l.* 11 through p. 20 *l.* 5. Such a long period of use is more than sufficient to support a determination that a mark is famous. Kimberly-Clark Corp. v. H. Douglas Enters., Ltd., 774 F.2d 1144, 1145-47 (Fed. Cir. 1985) (describing use of mark for less than seven years). Similarly, GreenWise® annual sales are well in excess of levels that the Federal Circuit has found sufficient to establish fame. See Bose Corp., 293 F.3d at 1372 (annual sales of greater than \$50 million were sufficient to establish fame of the mark).

As the Federal Circuit has explained:

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys, 963 F.2d at 353.

Further, the GreenWise® products, along with the related GreenWise® Market stand-alone stores, have been the subject of widespread and frequent media coverage in industry publications (including, for example, *Supermarket News* and the Private Label Manufacturers Association's *e-scanner*) as well as in general-circulation news media publications (including, for example, *The Miami Herald*, the *Sun-Sentinel* (Ft. Lauderdale), *The Tampa Tribune* and the *Tampa Bay Times*). Irby Testimony p. 43 *l.* 1-19, Ex. 20; NOR 2.

Because the GreenWise® mark has achieved fame, under the DuPont analysis, it is entitled to the broadest level of protection. A&P has already ridden on the coattails of Publix's development of a broad, storewide line of organic, natural, and earth-friendly products. A&P's efforts to brand a copycat program with a confusingly similar mark should not be rewarded. Thus, the fame of GreenWise® supports a finding that there is a likelihood of confusion between the GreenWise® and Green Way marks.

VI. Third-Party Registrations for Marks Including the Term “Green” Do Not Preclude a Finding That Confusion is Likely.

Another factor that can bear on a likelihood of confusion analysis is the “number and nature of similar marks in use on similar goods.” DuPont, 476 F.2d at 1361. However, and despite A&P's hearsay evidence that the word “green” is common, see A&P NOR 4, such commonality is not dispositive, because the similarity of the Publix and A&P marks rests on much more than merely the shared word “green.” A&P seeks registration of a similarly sounding mark with the same meaning to be used in a similar business to identify another private-label line of organic, natural, and environmentally-friendly products. These facts in combination make confusion likely.

Again in H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62 (T.T.A.B. 1979), the Board was faced with a similar opposition proceeding involving marks for identical goods, wine. Id. at 63. The marks also included the identical color word, “blue,” as the first word in the mark, followed by related religious words, “Nun” and “Angel.” Id. The applicant cited other marks that included the term “blue” and identified alcoholic beverages. These third-party uses, the applicant asserted, weakened the Blue Nun mark, precluding any finding of likelihood of confusion in that case. Id. at 66. The Board rejected that argument:

We must remember that the conflict herein is between “BLUE ANGEL” and “BLUE NUN”, and the fact that others have used and/or registered marks containing a certain feature in common with these marks for similar goods cannot preclude a holding that these marks as a whole are confusingly similar.

Id. (citations omitted).

Likewise, in this case, the conflict is between GreenWise® and Green Way for a variety of identical and related goods. A&P has cited no other store-wide grocery brand that combines the word “green” with a one-syllable suffix starting with a “W.” Third-party usage of “green” does not mean Green Way is sufficiently distinct from GreenWise® – particularly given the similarity of the marks’ meanings and the goods they both identify (i.e., private-label organic, natural, and earth-friendly products). The Board must determine each case on its own record, and prior decisions by examining attorneys concerning other “green” marks are not binding. See In re Nett Designs, Inc., 236 F.3d 1339, 1342 (Fed. Cir. 2001) (PTO’s allowance of prior registrations does not bind the Board). The mere inclusion of the word “green” in a mark is not dispositive of the present issue before the Board.

A&P elicited testimony concerning the marks “Green Giant” and “Green Mission.” See Irby Testimony p. 86 *l.* 5-21 & p. 92 *l.* 11-17. But those marks are much more readily distinguished from GreenWise® than Green Way. As Publix’s Mark Irby testified, “Green Giant is a brand that I think is not trying to make any reference to natural, organic or earth friendly, and it’s limited to a fairly narrow range of products.” Irby Testimony p. 107 *l.* 5-8. And Green Mission is “more about a program of maybe sustainability or environmentally friendly practices rather than products....” Id. *l.* 9-11. Other “green” marks that A&P has cited identify narrow product lines and, therefore, are similarly distinct from the parties’ broad private-label brands. See, e.g., Irby Testimony p. 89 *l.* 16-25 (GREENWOOD for beets, pears, red cabbage, apples);

Irby Testimony p. 69 l. 7-20 (GREEN WORKS cleaning products). The “green” marks that A&P has identified, therefore, do not entitle A&P to registration of Green Way.

VII. A Lack of Actual Confusion is Not Significant.

Because A&P filed intent-to-use applications and only recently introduced its Green Way mark on goods sold in its stores, a lack of actual confusion at this point is not significant. See Wella Corp. v. Cal. Concept Corp., 558 F.2d 1019, 1023 (C.C.P.A. 1977) (lack of actual confusion was not probative, because junior mark had been used for only “a short period of time”). The Patent & Trademark Office is not required to wait for confusion to occur before rejecting a proposed confusing mark. In fact, “actual confusion is not necessary to show a likelihood of confusion.” Hewlett-Packard Co., 281 F.3d at 1267 (citing Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 1571 (Fed. Cir. 1983)). Moreover, the lack of actual confusion is understandable in this case, given the current geographic separation between A&P and Publix.⁹ Of course, that geographic separation does not entitle A&P to a registration, because a registration would convey nationwide rights, including rights in states where GreenWise® products are sold. See Giant Food, 710 F.2d at 1571 (finding restaurant company’s GIANT HAMBURGERS design mark confusingly similar to grocer’s GIANT mark; lack of actual confusion “would appear to be due, not to dissimilarities of the marks, but mainly to the geographic separation of the two parties’ operations”). Indeed, A&P has acknowledged that Green Way products could be “sold in places we [A&P] don’t have stores” and “to other retailers so they could also market the brand.” Curran Oct. Testimony p. 8 l. 15-23 & p. 9 l. 24 through p. 10 l. 5. Thus, this DuPont factor does not weigh in either party’s favor.

⁹ See [Redacted discussion of material designated Trade Secret/Commercially Sensitive]; Irby Testimony p. 13 l. 7-10 (listing states where Publix’s stores are located).

VIII. The Evidence Belies A&P's Professed Good Faith.

A&P knew, or at least should have known, full well that it was treading ever so closely to Publix's GreenWise® mark. Despite this fact, A&P professes to have sought registration in "good faith." The evidence, however, is to the contrary.

Before introducing the Green Way mark, A&P obtained a trademark search report that highlighted Publix's GreenWise® registrations for products similar or identical to those A&P intended to sell under the Green Way label. See Palmer Testimony p. 107 *l.* 16 through p. 110 *l.* 17 & Ex. 35 (A&P 636-638). Notwithstanding these search results, and the variety of industry and general circulation news articles discussing GreenWise® products in the public domain at the time (see NOR 2), A&P pushed forward with its applications and introduced the Green Way mark. A&P's actual knowledge of the GreenWise® marks demonstrates a lack of good faith. Courts have found that "deliberate adoption of a similar mark may lead to an inference of intent to pass off goods as those of another." Beer Nuts II, 805 F.2d at 927. In fact, some courts have gone so far as to presume intent to deceive the public when a party "knowingly adopts a mark similar to another." Synergistic Int'l, Inc. v. Windshield Doctor, Inc., No. CV 03-579 FMC (CWx), 2003 WL 21468568, at * 7 (C.D. Cal. Apr. 28, 2003) (quoting Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1394 (9th Cir. 1992)).

A&P's Green Way products are in the same three categories that Publix adopted for its GreenWise® line of products years earlier. Both sets of products feature goods that are organic, natural, or Earth-friendly. Compare Irby Testimony p. 16 *l.* 15 through p. 17 *l.* 6; Palmer Testimony p. 19 *l.* 8-14, 31 *l.* 4-23. In fact, A&P's entire Green Way product line mimics the GreenWise® brands and services from market position to mark chosen. The facts undercut A&P's argument that it adopted its mark in good faith. Other similarities between the marketing

of the two product lines, discussed supra, also support findings of bad faith and a likelihood of confusion between the two marks.¹⁰

IX. Any Doubt Must Be Resolved in Publix's Favor.

It is well-settled that in opposition proceedings, any doubt as to the likelihood of confusion must be resolved in favor of the senior user. This "Rule of Doubt" or "Newcomer Rule" is "too well settled as an axiom of trademark law to require citation to precedent that on the statutory issue involved here doubts are to be resolved against the newcomer and in favor of the prior user." San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp., 565 F.2d 683, 684 (C.C.P.A. 1977). In fact, a newcomer is "under a duty to select a mark sufficiently far afield from that of [an] opposer to avoid any likelihood of confusion." Steelcase Inc. v. Steelcare Inc., 219 U.S.P.Q. 433, 437 (T.T.A.B. 1983). A&P had a duty to select a mark sufficiently distinct from GreenWise® so as to avoid a likelihood of confusion. Because A&P did not fulfill this duty, judgment should be entered in Publix's favor.

¹⁰ See, e.g., [Redacted discussion of material designated Trade Secret/Commercially Sensitive]

SUMMARY

Publix has invested more than a decade and tens of millions of dollars in its GreenWise® brand of organic, natural, and environmentally-friendly products, stand-alone stores, and a host of related services. Now, A&P seeks to register a mark that is identical in meaning and substantially similar in appearance and sound for both identical and highly related goods. These factors alone dictate that A&P's motion for summary judgment be denied. The other applicable DuPont factors also support a finding that confusion of GreenWise® and Green Way is likely. As a result, judgment should be entered in Publix's favor.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on January 27, 2014, a true and complete copy of the foregoing brief has been sent by E-mail Facsimile Express Mail First Class U.S.

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