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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

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PUBLIX ASSET MANAGEMENT COMPANY, :

Opposer, :

v. :

Opposition No. 91186148  
Opposition No. 91186863  
(consolidated as 91186148)

THE GREAT ATLANTIC & PACIFIC TEA :  
COMPANY, INC., :

Applicant. :

-----X

**APPENDIX A TO APPLICANT'S TRIAL BRIEF**

**APPLICANT'S STATEMENT OF OBJECTIONS, MOTIONS TO STRIKE  
AND MOTION FOR PARTIAL CANCELLATION**

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## **INTRODUCTION**

Applicant, The Great Atlantic & Pacific Tea Company, Inc. (“Applicant”), hereby submits this Appendix A to Applicant’s Trial Brief, namely Applicant’s Statement of Objections And Motions to Strike and with regard to certain evidence submitted by Publix Asset Management Company (“Opposer”) through testimonial depositions. Applicant also renews herein its Motion for Partial Cancellation.

### **Objections and Motions to Strike**

#### **1. Testimony of Paul Kalinowski**

Applicant objected both pre-trial and at trial to the proffered testimony by Opposer of Mr. Paul Kalinowski on several grounds, any one of which would be sufficient to strike this testimony. Applicant’s counsel also objected on the record. Kalinowski Test. 16-17.

As a first ground, Applicant was advised by Opposer’s counsel of its intention to call Mr. Kalinowski as a rebuttal witness on the subject of the meanings of the parties’ marks at issue, first by phone, and then by letter dated November 5, 2013. *See* Exh. YYYY. Applicant’s counsel objected, stating that Mr. Kalinowski’s testimony was improper as rebuttal, since Applicant did not raise the subject of the meanings of the marks in its initial Trial Disclosures. In fact, Applicant’s disclosures were amended to add this topic only at the time of rebuttal testimony; therefore, Applicant was left without a chance to rebut this testimony.

For the Board’s convenience, Opposer’s Pretrial Disclosures, dated July 26, 2010, list Mr. Kalinowski as a witness as follows:

“Paul Kalinowski, director of emerging business for Publix Super Markets, Inc., may testify concerning the history and use of the GREENWISE mark.”

The later notice, dated October 28, 2013, states:

“Paul Kalinowski, a business development director for Publix Super Markets, Inc., may testify concerning the history, use and **meaning** of the GREENWISE mark and similar marks.”

Although it is true that in Trial Stipulations entered into between the parties, the parties agreed that witness testimony could be taken out of order for convenience, there was no agreement that a new topic could be raised by such a trial witness for the first time during Opposer’s Rebuttal Trial Period.

Federal Rule of Evidence 611(b) provides that “[c]ross-examination should be limited to the subject matter of the direct examination and matters affecting the credibility of the witness ....” *See also Solar Turbines Inc. v. Gemini Engine Co.*, 218 USPQ 854, 856 n.3 (TTAB 1983). For the same reason, rebuttal testimony may not exceed the scope of direct testimony.

As a second ground, Mr. Kalinowski’s testimony should be stricken because he does not work for Opposer, and therefore was incompetent to testify on Opposer’s behalf as a rebuttal witness or as a witness in the main case. Mr. Kalinowski is employed by Publix Supermarkets, a different company who is not an opposer herein. Kalinowski Test. 4, 16.

Third, Opposer refused to provide discovery regarding the reason for selecting its mark, yet Mr. Kalinowski’s testimony relates specifically to this topic. Specifically, Opposer objected to interrogatory number 3 which stated:

3. State the facts surrounding opposer’s selection of Opposer’s Mark, including but not limited to the reason the mark was selected, and identify each document that refers to or relates to the adoption or selection by or the decision by Opposer to use Opposer’s Mark upon or in connection with each product or service identified in Interrogatory No. 1.

ANSWER: Opposer reiterates the General Objections and, in particular, objects that this interrogatory seeks information that is not relevant and is not reasonably calculated to lead to the discovery of admissible evidence. In particular, the reason for Opposer’s selection of the GREENWISE® mark is immaterial to the issues in this proceeding. In addition, this request seeks information protected by the attorney-client privilege and attorney work-product doctrine and seeks confidential and proprietary business information. Subject to and without waiving these objections and the General

Objections, and without waiving the attorney-client privilege and attorney work-product doctrine, Opposer agrees to produce trademark search reports relating to selection of the GREENWISE® mark.

See Exh. BBBB; Kalinowski Test. 24. NOR Exh. F.

A party may not “during its trial period introduce as evidence on its behalf documents embraced within [requests for production] but which had not been furnished to the requesting party.” *Era Corp. v. Elec. Realty Assocs., Inc.*, 211 USPQ 734, 737 (TTAB 1981); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 204 USPQ 820, 828-29 (C.C.P.A. 1980); *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987) (opposer’s exhibits identified as within the scope of documents requested by an applicant’s requests for production of documents, but not produced by opposer during discovery, excluded from consideration). Accordingly, to the extent, if any, that Opposer’s intended meaning, rather than the meaning perceived by the public, is relevant at all, Opposer’s Exhibit 71 and the testimony of Mr. Kalinowski, as well as that of Mr. Irby, in each case pertaining to the meaning Opposer intended to convey when it selected the GREENWISE mark, should be stricken, in particular, Kalinowski Test. 6, lines 22-25, and 7, line 1, and Irby Test. 60.

Lastly, Applicant through Mr. Kalinowski has attempted to enter into evidence Exhibit 71, which Applicant failed to authenticate or otherwise support with sufficient foundation. Evidence is not relevant and is inadmissible until it is adequately authenticated or identified as what the proponent claims it to be. See F.R.E. 901; *United States v. Diaz*, 918 F.3d 56, 63-64 (1st Cir. 2008); *Otto v. Variable Annuity Life Ins. Co.*, 134 F.3d 841, 853 (7th Cir. 1998). Under Federal Rule of Evidence 901(b)(1), a person may authenticate evidentiary material only if he or she has personal knowledge that the material is what the proffering party claims it to be. See F.R.E. 901(b)(1); F.R.E. 602. As he testified, Mr. Kalinowski’s testimony lacks foundation since



he had no personal knowledge of the Exhibit (Opposer's 71) about which he was called to testify. Kalinowski Test. 20.

While it is not disputed that the exhibit is a copy of pages from a dictionary, Mr. Kawinowski never saw it prior to the preparation for the deposition. *Id.* Therefore, Exhibit 71 and the testimony pertaining thereto should be stricken.

## **2. Testimony Regarding Publix' Supermarket Operations**

There is only one opposer herein, Publix Asset Management Company, which is a trademark holding company, and not an operating entity. Accordingly, Applicant consistently has objected to testimony concerning the operating company unless evidence was submitted by the operating company. Therefore, Applicant moves to strike the following:

- 1) Publix Brief p.22, line 4: "Because both A & P and Publix both operate retail stores."

## **3. Motion for Partial Cancellation**

On January 15, 2013 Applicant moved for an order, pursuant to 37 C.F.R. § 2.133, 37 C.F.R. § 2.107 and Fed. R. Civ. P. 15(a), for leave to amend its Answers in Opposition Nos. 91186148 and 91186863 to assert counterclaims for partial cancellation on the ground of non-use, namely that the subject registrations as set forth further herein were not at that time nor at any time used on goods other than in PUBLIX stores, and thus to seek to have such registrations restricted to such channel of trade. Such motion was denied by Order of the Board on July 16, 2013. Applicant hereby renews its motion, and asks that Applicant's answers be deemed amended, and that Applicant's motion for partial cancellation be granted.

The subject registrations pertaining to the present motion are Registration Nos. 2,732,403; 2,729,423; 3,328,951; 3,546,815; 3,813,937; 4,020,054; 3,813,946; 3,813,868;

3,813,886; 3,813,890; and 3,753,274 (“Publix’ Registered Marks”),<sup>1</sup> which are for goods wherein the use allegedly preceded the filing dates by Applicant of its GREEN WAY marks.<sup>2</sup>

## BACKGROUND

As set forth in Applicant’s Trial Brief, this case is a consolidated opposition filed by Opposer, Publix Asset Management Company (“Opposer”) against Applicant, The Great Atlantic & Pacific Tea Company, Inc., with respect to two applications to register the mark GREEN WAY, namely, Application Serial No. 77/349246 (the “246 Application”) filed December 11, 2007 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 29;
- 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, fruit drinks, and soft drinks, in International Class 32; and

GREEN WAY (in standard characters), Serial No. 77/409725, dated February 29, 2008, for

- shampoos and hair conditioners; skin moisturizers; human body conditioners; skin treatment lotions and creams; anti-aging and stretch mark creams; non-medicated lotions

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<sup>1</sup> Among the marks asserted by Opposer in its Oppositions are the service marks PUBLIX GREENWISE MARKETS for **retail store services**, which clearly identify themselves as services emanating from “Publix” stores, and the service mark GREENWISE for **retail store services** (which are actually always used as “Publix Greenwise Market”). Applicant is not seeking to use or register its mark, GREEN WAY, for retail store services, therefore the retail store service marks do not pertain to this motion.

<sup>2</sup> Registration Nos. 3,813,937; 4,020,054; 3,813,946; 3,813,868; 3,813,886; 3,813,890; and 3,753,274 were each filed subsequently to the filing of Applicant’s GREEN WAY marks.

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;
- 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; tortilla chips, in International Class 30;
- pet food, in International Class 31; and
- soda pop, in International Class 32.

Both the '246 Application and the '725 Application were allowed without objection by the Patent and Trademark Office, were published, and were then opposed by Opposer.

Applicant filed its initial motion before any trial period had opened. Therefore, it asserts that its original motion was timely. Discovery had closed, and an analysis of the documents in total showed that Opposer had only ever sold “Greenwise” products in its own stores, the Publix supermarkets and markets.<sup>3</sup> Further *every* specimen filed with each registration asserted or relied upon, and *every* use of “Greenwise” produced in discovery by Opposer, shows that “Greenwise” is *always* used with the word “Publix” preceding it. In fact, all but one specimen filed with each registration shows “Greenwise” followed by the word “Market,” as in “Publix GREENWISE Market.” *See* Exhs. B, D-I.

Although Applicant believes there is no likelihood of confusion herein (and it so moved for summary judgment, which was denied), it believes that any doubt as to any likelihood at all is completely obviated by the fact that Opposer sells its “Greenwise” goods only at stores which it owns, namely “Publix” stores, operated by Publix Super Markets, Inc. That is, without limitation, since none of Opposer’s goods are sold outside of Publix stores, it is impossible for consumers to encounter both Opposer’s and Applicant’s goods, since Applicant does not sell its goods in Opposer’s stores. Further, since all of Opposer’s goods that bear the word “Greenwise” also always bear the word “Publix” first, it is clear to any consumer coming into contact with such a good that it is a Publix good found in a Publix store.

Since the time of the original motion, Opposer confirmed through its Trial Testimony of Mark Irby that it is **required** that “Publix” be used on each GREENWISE product, and that in fact GREENWISE always appears with “Publix” (and, until recently, also with the word “Market” after GREENWISE). *See* Irby Test. 73-74.

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<sup>3</sup> Opposer herein holds the trademarks, which are licensed to its own commonly owned companies.

## APPLICANT'S MOTION SHOULD BE GRANTED

Applicant by its motion sought to amend its Answer(s) herein to assert counterclaims for partial cancellation on the grounds of non-use under Section 18 of the Trademark Act, 15 U.S.C. § 1068. Now, pursuant to Trademark Rule 2.131, the pleadings should be deemed amended and its motion should be heard simultaneously with Trial.

“Pleadings in a cancellation (opposition) proceedings may be amended in the same manner and to the same extent as in a civil action in a United States district court.” 37 C.F.R. 2.115. Pursuant to Fed. R. Civ. P. 15(a), leave to amend should “freely” be given. *See also* TBMP § 507.01. The Board “has recognized that ‘amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.’” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993), quoting *Am. Optical Corp. v. Am. Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971) (emphasis added). *See also* *Polaris Indus., Inc. v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2000).

Applicant met these standards. Further, as discussed below, the proposed amendment is in keeping with existing and applicable law. Moreover, Applicant’s amended pleadings, which ask the Board to have Opposer restrict its mark(s) to reflect its actual use of such marks under Section 18, eliminates, or at worst narrows any issues as to likelihood of confusion herein. Furthermore, Opposer would not be prejudiced by such an amendment as the amendment seeks only to have Opposer’s registrations match Opposer’s actual use it itself has made.

**A MOTION TO AMEND AND ASSERT PARTIAL  
CANCELLATION ON THE GROUND OF NON-USE IS PROPER**

It is well-settled that pursuant to Trademark Act Section 18, 15 U.S.C. § 1068, a registration may be cancelled in whole *or in part*. In *Eurostar v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994), this Board explained the impetus for the amendment, namely, a study by the *Trademark Review Commission*, a special commission of the USTA (now INTA), and published in 77 Trademark Rep. 375 (1987). In particular, the Board explained that "prior to the amendments to Section 18, the Board was constrained to decide cases presenting the issue of likelihood of confusion based on the recitation of goods or services that appeared in ... the registration, rather than on the evidence adduced at trial as to the actual goods or services or the channels of trade of those goods or services." *Eurostar*, 34 USPQ 2d at 1268.

Since then, a party seeking to avoid a finding of a likelihood of confusion based on an adverse party's pleaded registrations may do so by alleging that (1) the finding of likelihood of confusion will be avoided by the restriction of goods sought in the petition to cancel, and that (2) the opposer is not using the mark on the goods sought to be excluded by the proposed restriction. *Eurostar*, 34 USPQ 2d at 1270. Applicant's proposed amendment meets these requirements.

Here, it cannot be denied by Opposer that it has sold GREENWISE products only in its own stores. In fact, Opposer now admits as much in its testimony. Irby Test. 37 ("Q. Who does Publix Asset allow to sell the GreenWise products? A. Only Publix Super Markets, Incorporated."). Furthermore, on almost every specimen the <sup>TM</sup> and/or ® symbol follows the full phrase "Publix Greenwise Market," not "Greenwise." See Exhs. B, D-I. In fact, on Opposer's own website, on a page entitled "Publix Greenwise Market Products," listing its "wide selection" of products, each and every one of the 71 products listed used the full phrase "Publix Greenwise Market." See Irby Test. 80; Exh. K.

Therefore, Applicant asserts that the Publix Registered Marks are associated in the minds of members of the public with Opposer only; that Applicant's mark GREEN WAY is not confusingly similar thereto; and that due to non-use/abandonment of channels of trade in the Publix Registered Marks outside of Publix, the scope of these registrations should be so limited.

Since this limitation would be consistent with the realities of Opposer's use, it would not prejudice or harm Opposer. In fact, without the proffered limitation, there is instead prejudice to Applicant, as it need not defend these oppositions as to channels of trade not used by Opposer. That is, since the only marks asserted herein that are for goods that allegedly have been sold from dates that precede the filing date and use of Applicant's marks are for goods sold only in Opposer's stores, then the analysis of the confusion factors changes completely. The question becomes whether there is a likelihood of confusion between Opposer's GREENWISE products *sold only in Publix stores*, and goods bearing Applicant's GREEN WAY mark *sold in different stores*. On the other hand, without the proffered amendment, the question is whether there is a likelihood of confusion with regard to GREENWISE products sold anywhere vs. GREEN WAY products sold anywhere. Since this is not the proper analysis, Applicant's motion to assert its counterclaims, which seek to limit the Publix Registered Marks to reflect their true limited channels of trade, should be granted. Where, as here, the marks themselves are different, and the marks share only the overwhelmingly weak term "green" for products that are organic and/or healthful and/or eco-friendly, this distinction based on channels of trade is the final nail in an otherwise already failed claim of likelihood of confusion herein.

### CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board issue an order for partial cancellation of Registration Nos. 2,732,403; 3,545,815; 3,328,951; 3,813,937; 4,020,054;

3,813,946; 3,813,868; 3,813,886; 3,813,890; 3,753,274; and 2,729,423, so as to add the limitation “**sold only in Publix stores,**” on the ground of non-use in channels of trade other than within Opposer’s own stores.

Dated: April 15, 2014

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: s/ Arlana S. Cohen

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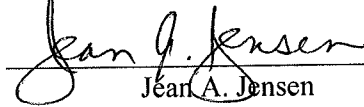
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing Appendix A To Applicant's Trial Brief -- Applicant's Statement Of Objections, Motions To Strike And Motion For Partial Cancellation has been served on opposer by first class mail, postage prepaid on April 15, 2014 addressed to its attorneys as follows:

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