

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 12, 2013

Opposition No. 91208201

Giorgifred Company

v.

Fresh and Clean Greens Inc.

Andrew P. Baxley, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on February 8, 2013.¹ Participating in the conference were opposer's attorneys Bassam Ibrahim and Lloyd Smith, applicant's principal April Arfa, and Board interlocutory attorney Andrew P. Baxley.

The Board is an administrative tribunal that is empowered solely to determine the right to register and which has no authority to determine the right to use a mark or any infringement or unfair competition issues and no injunctive authority. See TBMP Section 102.01 (3d ed. rev. 2012). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions,

Opposition No. 91208201

interrogatories, document requests, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. As the plaintiff, opposer has the burden of establishing its claims at trial by a preponderance of the evidence. See *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003).

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.²

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/standardgmt.jsp>. If the parties wish to add or modify any

¹ Applicant requested Board participation in the discovery conference through ESTTA on January 21, 2013.

² The parties are advised that, if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence by way of a notice of reliance in the same manner as a printed publication in general circulation in

Opposition No. 91208201

provisions to the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminded the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) can occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

The parties indicated that opposer made a settlement proposal, which applicant rejected without making a counteroffer, and that there is no other pending litigation, in federal court or before the Board, between the parties at this time. The parties were informed that the Board is generous with periods of extension or suspension to facilitate settlement discussions, although the Board does not get involved in the substantive settlement negotiations.

Although applicant is interested in pursuing accelerated case resolution (ACR), opposer is not. In view of the nature of the claim herein, this proceeding appears well-suited for ACR. The parties are directed to review the Board's website regarding ACR at http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp; and

accordance with Trademark Rule 2.122(e). See *Safer Inc. v. OMS*

Opposition No. 91208201

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution on ACR notice from TTAB webpage 12 22 11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated%20Case%20Resolution%20ACR%20notice%20from%20TTAB%20webpage%2012%2022%2011.pdf). If the parties later agree to pursue ACR after some disclosures and discovery, they should notify the Board attorney assigned to this case at 571-272-4253 by not later than two months from the opening of the discovery period.

Pleadings

The Board has reviewed the pleadings in this case. Opposer has adequately pleaded its standing. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); TBMP Section 309.03(b) (3d ed. rev. 2012). That is, the statements paragraphs 1 and 3-6 of the notice of opposition set forth allegations of facts which, if proven, would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. See *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). In addition, opposer sets forth a claim of likelihood of confusion with its alleged prior use and registration of FRESH N' CLEAN in typed form under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), in paragraphs 3-11 of the petition to cancel. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182

Investments Inc., 94 USPQ2d 1031 (TTAB 2010).

Opposition No. 91208201

USPQ 108 (CCPA 1974); TMEP Section 1207.01 *et seq.* (October 2012). Priority will not be an issue in this case if opposer properly makes of record a status and title copy of its pleaded registration. See Trademark Rule 2.122(d)(2); *King Candy Co. v. Eunice King's Kitchen, Inc., supra.*

Applicant, in its answer, denied the salient allegations of the notice of opposition and set forth "affirmative defenses" which amplify those denials. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

As applicant's first affirmative defense, applicant essentially alleges that there is no likelihood of confusion because the parties' goods at issue do not overlap. However, the goods and/or services at issue do not have to be identical or even competitive for the Board to find that there is a likelihood of confusion. See *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009); TMEP Section 1207.01(a)(1). It is sufficient that the goods and/or services of the parties are related in some manner or that the conditions surrounding their marketing are such that such goods and/or services are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source.

Opposition No. 91208201

See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN'S for wheat bran and honey bread, and MARTIN'S for cheese, likely to cause confusion); TMEP Section 1207.01(a)(1).

As applicant's second affirmative defense, applicant essentially alleges that there is no likelihood of confusion between the marks at issue because the marks are different in sound and appearance. However, the Board notes that opposer's pleaded registration is for the mark FRESH N' CLEAN in typed (now standard character) form, which covers any depiction of the registered word mark, including in the font that applicant uses for the words FRESH and CLEAN in its involved mark. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253 (Fed. Cir. 2011). Further, although applicant's involved mark includes a stylized ampersand design, "[i]t has consistently been held that where a mark comprises a word portion and a design portion it is the word feature which is controlling." *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1621 (TTAB 1989). Likelihood of confusion is not necessarily avoided between otherwise confusingly similar marks merely by adding or deleting a house mark, other distinctive matter, or a term that is descriptive or suggestive of the named goods or services; if the dominant portion of both marks is the same, then the marks may be confusingly similar

Opposition No. 91208201

notwithstanding peripheral differences. See TMEP Section 1207.01(b)(iii) and cases cited therein.

As applicant's third affirmative defense, applicant essentially alleges that there is no likelihood of confusion because opposer uses its mark in conjunction with its house mark. Additional matter used on packaging for opposer's pleaded goods sold under its registered mark is irrelevant in distinguishing the parties' marks because such matter might be changed at any time; only the wording FRESH N' CLEAN is registered. See *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1147, 227 USPQ 541, 543 (Fed. Cir. 1985).

In view of the parties' common use of terms which are the phonetic equivalent of FRESH AND CLEAN, this case will essentially turn on whether the parties' goods are related in a manner that will give rise to source confusion, the scope of protection to which opposer's pleaded registered mark is entitled, and the extent of third-party use of similar marks on the same or related goods. The parties are urged to concentrate their discovery on these issues. See TBMP Section 414 regarding the discoverability of various types of information in Board proceedings.

Stipulations/Filings

The parties agreed to service by e-mail, with Trademark Rule 2.119(b)(6) being applicable to such service. The

Opposition No. 91208201

parties were reminded that by making this stipulation the parties may not avail themselves of the additional five days contemplated by Trademark Rule 2.119(c), afforded to parties when service is made by first-class or express mail. The parties exchanged email addresses as follows:

E-mail service upon opposer's counsel shall be made at each of the following email addresses: bassam.ibrahim@bipc.com, holly.lance@bipc.com, michelle.jackson@bipc.com, connie.fuentes@bipc.com, and lloyd.smith@bipc.com. E-mail service upon applicant shall be made at each of the following email addresses: aprilarfa@live.com and farmer@freshandcleangreens.com.

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA) database, available online at: <http://estta.uspto.gov>. Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, online at: <http://www.law.cornell.edu/rules/frcp/>.

Applicant intends to represent itself in this proceeding. While Patent and Trademark Rule 10.14 permits

Opposition No. 91208201

any person to represent himself, persons who are not acquainted with the technicalities of the procedural and substantive law involved in Board *inter partes* proceedings are advised to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, applicant is advised that, under Patent and Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02.

In addition, applicant is reminded that Trademark Rules 2.119(a) and (b) require that every submissions filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the submission will be considered by the Board. Consequently, copies of all submissions which the parties may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and

Opposition No. 91208201

manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

Because opposer is represented by counsel, applicant should not contact opposer directly.

Schedule

All dates remain as set in the Board notice instituting this proceeding. The parties are again reminded that the next significant due date is March 8, 2013, when the parties' initial disclosures are due. In such disclosures, the parties should provide to each other

the name and, if known, the address and telephone number of each individual likely to have discoverable information – along with the subjects of that information – that the disclosing party may use to support its claims or defenses, unless the use would be solely for impeachment [and] a copy – or a description by category and location – of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control and may use to support its claims or defenses, unless the use would be solely for impeachment.

Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii). The parties need not file those disclosures with the Board.

The Board thanks the parties for their participation.