

**This Opinion is Not a
Precedent of the TTAB**

Mailed: July 9, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
Tasty Greens LLC

v.

Sylvio Campos

—
Opposition No. 91255119

—
Jacqueline L. Patt and Katrina G. Hull of Markery Law LLC
for Tasty Greens LLC.

Todd Wengrovsky of Law Offices of Todd Wengrovsky, PLLC
for Sylvio Campos.

—
Before Shaw, Hudis and Lebow,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Sylvio Campos (“Applicant”) seeks registration on the Principal Register of the mark ONE GREEN (in standard characters, “Green” disclaimed) for “dietary and nutritional supplements; vitamins” in International Class 5.¹

¹ Application Serial No. 88539924 was filed on July 26, 2019, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Tasty Greens LLC (“Opposer”) opposes registration of Applicant’s ONE GREEN mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods identified in the Application, so resembles Opposer’s registered standard character mark 8GREENS for:

Dietary supplement in tablet form containing vitamins and herbs from green leafy vegetables and herbs to make vitamin enhanced beverages in International Class 5,²

and

Nutritional supplements in the form of gummies containing ingredients from green leafy vegetables and herbs; gummy vitamins containing ingredients from green leafy vegetables and herbs in International Class 5,³

as to be likely to cause confusion, mistake, or to deceive.⁴ As a second ground for opposition, Opposer asserts that Applicant did not have a bona fide intent to use the ONE GREEN mark for the goods identified in the application on or before its filing date of July 26, 2019.⁵

² Registration No. 5661353 was issued on the Principal Register pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f), on January 22, 2019.

³ Registration No. 5938596 was issued on the Principal Register pursuant to Trademark Act Section 2(f) on December 17, 2019.

⁴ Amended Notice of Opposition, 13 TTABVUE 7-9, ¶¶ 1-14. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

⁵ *Id.* at 9-10, ¶¶ 15-19.

Applicant denied the salient allegations of the Amended Notice of Opposition in its Answer,⁶ but admitted that (1) Opposer is the owner its claimed registrations for the mark 8GREENS, which are valid and subsisting, (2) Applicant filed its ONE GREEN application for the identified goods on the basis of intent-to-use under Trademark Act Section 1(b), (3) the ONE GREEN application included a verified statement that Applicant had a bona fide intent to use the mark for the goods identified, and (4) in response to a discovery request that Applicant produce “[a]ll documents which support Applicant’s bona fide intent to use Applicant’s Mark on July 26, 2019 [Applicant’s filing date],” Applicant responded with “None.”⁷ Applicant’s Answer did not assert any affirmative defenses or counterclaims.

The case is fully briefed. Having considered the evidentiary record, the parties’ arguments and applicable authorities, we sustain the Opposition on both asserted grounds.

⁶ Answer to Amended Notice of Opposition, 17 TTABVUE.

⁷ *Id.*, at 3-4, ¶¶ 2, 3, 5, 15, 16, 18. Specifically, in response to paragraph 18 of the Amended Notice of Opposition, Applicant stated: “Applicant admits the allegations regarding the discovery response, denies the remaining allegations contained in this Paragraph of the Opposition, and denies that there was a lack of bona fide intent to use the mark.”

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application.

A. ACR Stipulation

In addition, pursuant to the Board's suggested Accelerated Case Resolution ("ACR") procedures,⁸ the parties entered into a stipulation (their "ACR Stipulation") providing that: (1) all witness testimony will be submitted in affidavit or declaration form, with attached exhibits, (2) the right to cross examine an affiant or declarant witness is waived, (3) neither will rely on expert testimony, (4) the parties will utilize the Board's summary judgment format of ACR in lieu of a trial, (5) the parties' ACR briefs and evidence will be treated as the final record and briefs, (6) substantive evidentiary objections may be raised in the parties' ACR briefs, but no objections to evidence can be raised on grounds of non-disclosure outside of the parties' disclosures and discovery, unless the Board had already issued an order compelling discovery and a party did not comply with the discovery order, (7) all evidence (including documents and things produced or received in response to discovery requests) is admissible without the need for authenticating or accompanying witness testimony, subject to the right of the non-offering party to object on substantive grounds, and (8) the parties consent to the Board's resolution of all disputed issues of material fact and to the Board rendering a final decision based on the pleadings, stipulated facts, briefs, and evidence.⁹

In accordance with their ACR Stipulation, the parties introduced the following evidence:

B. Opposer's Evidence

- Records from the USPTO's TSDR database for Opposer's Registration Nos. 5661353 and 5938596 (for the mark 8GREENS), attached to Opposer's Amended Notice of Opposition (13 TTABVUE 11-18).
- Exhibits to Opposer's Trial Brief:
 - Exh. 1 – Opposer's First Set of Interrogatories and Applicant's Answers thereto (20 TTABVUE 63-82).
 - Exh. 2 – Opposer's First Requests for Admissions and Applicant's Responses thereto (20 TTABVUE 83-89).
 - Exh. 3 – Opposer's First Requests for Production and Applicant's Responses thereto (20 TTABVUE 90-100).
 - Exh. 4 – Definition of GREEN from MERRIAM-WEBSTER online dictionary (20 TTABVUE 101-02).
 - Testimony Declaration of Sharon Macwan, Opposer's Director of Operations ("Macwan Decl.") (20 TTABVUE 103-04), serving to make of record: Declaration of Dawn Russell, Opposer's owner and founder ("Russell Decl."), filed pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f) in connection with Application Serial Nos. 87649715 and 87978360 to register Opposer's 8GREENS mark, with exhibits (20 TTABVUE 105-369).¹⁰
 - Public Testimony Declaration of April Siler, Opposer's CEO ("Siler Decl."), with exhibits (20 TTABVUE 370-583) (Confidential version filed at 19 TTABVUE 31-35).
 - Testimony Declaration of Jacqueline Patt, Opposer's counsel ("Patt Decl."), with exhibit (20 TTABVUE 584-87).

C. Applicant's Evidence

- Exhibits to Applicant's Trial Brief:
 - Exh. A and B – Copies of third-party registrations for the marks GREENS 88 (Registration No. 4227791, 21 TTABVUE 16-17) and TRIPLE GREENS (Registration No. 2961844, 21 TTABVUE 18).

¹⁰ The same Trademark Act Section 2(f) declaration was submitted in July 2018 to support both 8GREENS registrations because the 2(f) declaration was filed at the same time as a request to divide Application Serial No. 87978360 (now Registration No. 5938596), resulting in child Application Serial No. 87978360 (now Registration No. 5661353). See Opposer's Brief, 20 TTABVUE 7, n.2.

D. Opposer's Rebuttal Evidence

- Exhibits to Opposer's Rebuttal Brief:
 - Exh. 1 – Record from the USPTO's TSDR database for the mark GREENS 88 (Registration No. 4227791, 22 TTABVUE 20-23), showing that this registration has been cancelled.
 - Exh. 2 – Definition of MULTIPLES from math-on-math.com (22 TTABVUE 24-26).

II. Evidentiary Matters

Before proceeding to the merits of the Opposition, we address a number of evidentiary matters raised in Opposer's Rebuttal Brief.¹¹ Opposer's objections to Applicant's reference to, and reliance on, the cancelled third-party registration for the mark GREENS 88 (Registration No. 4227791, 21 TTABVUE 16-17), and the third-party registration for the mark TRIPLE GREENS (Registration No. 2961844, 21 TTABVUE 18) are **overruled**. We discuss the evidentiary value of these registrations below in the context of evaluating the strength of Opposer's 8GREENS mark.

Opposer's objection to numerous statements made in Applicant's Trial Brief that are unsupported by evidence made of record is **overruled**. We discuss the evidentiary value of these statements below in the context of evaluating Opposer's asserted grounds for opposition.

The parties disagree whether the Board should deem admitted Opposer's Admissions' Requests in their entirety, because Applicant did not timely respond to Opposer's Admissions' Requests. The record on this issue is clear and uncontested.

¹¹ Objections within Opposer's Rebuttal Brief, 22 TTABVUE 5-8.

Opposer served Applicant with Opposer's First Set of Requests for Admissions on August 14, 2020.¹² Applicant's responses were due within 30 days of service, or by September 13, 2020. Fed. R. Civ. P. 36(a)(3). Applicant did not timely respond, nor did it request any extension of time to respond, to the Admissions.¹³ Applicant ultimately served its Admissions' Responses by e-mail on September 24, 2020 – 11 days late. That same day, Opposer e-mailed Applicant in response to inform him that Applicant had not provided timely responses and therefore all of Opposer's Admissions' Requests were deemed admitted.¹⁴ Applicant did not respond to Opposer's e-mail,¹⁵ nor did Applicant move to have its deemed admissions withdrawn or amended at any time. *See* Fed. R. Civ. P. 36(b).

Opposer relies on Applicant's deemed admissions throughout its Trial¹⁶ and Rebuttal¹⁷ Briefs. Applicant, for its part, makes no effort to explain the lateness of his Admissions' Responses, except to state that he specifically served his Answers to Requests for Admission in September, 2020, in which he provided express denials.¹⁸ This statement is misleading. The fact that Applicant's Admissions' Responses were served "sometime in September" tells us nothing. Rather, while appearing to dispute

¹² Patt Decl., 20 TTABVUE 584, ¶ 4; Opposer's Admissions' Requests, 20 TTABVUE 84-87.

¹³ Patt Decl., 20 TTABVUE 584, ¶¶ 5-6.

¹⁴ Patt Decl., 20 TTABVUE 584-85, ¶¶ 7-8; Applicant's Admissions' Responses, 20 TTABVUE 88-89; E-mail exchange of Sept. 24, 2020, 20 TTABVUE 586-87.

¹⁵ Patt Decl., 20 TTABVUE 585, ¶¶ 9-10.

¹⁶ Opposer's Brief, 20 TTABVUE 11, 12, 14, 18, 22.

¹⁷ Opposer's Rebuttal Brief, 22 TTABVUE 7, 8, 12, 16.

¹⁸ Applicant's Trial Brief, 21 TTABVUE 13.

Opposer's contention that Applicant's Admissions' Responses were served late, Applicant omits any mention that they in fact were served late.

Based on the foregoing, we find all of Opposer's requests for admissions to Applicant are deemed admitted. *See Fram Trak Indus. v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (requests for admissions deemed admitted by respondent's failure to respond to petitioner's requests for admissions); *Texas Dept. of Transp. v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010) (stating that an admission conclusively establishes the matter and subsequent argument to the contrary in a response brief are insufficient to raise genuine issue of material fact on summary judgment) (citing *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.8 (TTAB 2007)); *Am. Auto. Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144-45 (5th Cir. 1991) (court may not sua sponte withdraw or ignore admissions without a motion to withdraw or amend).

Applicant therefore has admitted the following for purposes of this proceeding, pursuant to Fed. R. Civ. P. 36(a)(3):

Opposer's Admission Request No.	Applicant's Admission
1.	Applicant did not use the mark ONE GREEN in commerce prior to July 26, 2019.
2.	Applicant has not sold goods under the ONE GREEN in commerce in the United States.
3.	Applicant did not have a bona fide intent to use the ONE GREEN mark for dietary supplements on July 26, 2019.
4.	Applicant did not have a bona fide intent to use the ONE GREEN mark for nutritional supplements on July 26, 2019.

**Opposer's
Admission
Request No.**

**Applicant's
Admission**

5. Applicant did not have a bona fide intent to use the ONE GREEN mark for vitamins on July 26, 2019.
6. Opposer has priority in its Mark 8GREENS over Applicant's Mark ONE GREEN.
7. Opposer has standing to oppose Applicant's application.
8. Applicant's ONE GREEN Mark is similar to Opposer's 8GREENS Mark in sound, meaning and commercial impression.
9. The only substantive difference between Applicant's Mark and Opposer's Mark is the number included as part of the mark.
10. "Dietary supplements in tablet form containing vitamins and herbs from green leafy vegetables and herbs to make vitamin enhanced beverages" are a type of dietary and nutritional supplement.
11. "Nutritional supplements in the form of gummies containing ingredients from green leafy vegetables and herbs" are a type of dietary and nutritional supplement.
12. "Gummy vitamins containing ingredients from green leafy vegetables and herb" are a type of vitamin.
13. The broad category of goods identified in Applicant's Application includes Opposer's more specific goods identified in Opposer's Registrations.
14. The goods listed in Applicant's Application are legally identical to the goods listed in the Opposer's Registrations.
15. Opposer's Mark has acquired distinctiveness in connection with its goods.
16. All documents produced by Applicant in this proceeding are complete, true and correct copies of the original documents and are genuine pursuant to the Federal Rules of Evidence.
17. All documents produced by Applicant in response to Opposer's First Request for Production in this proceeding are part of the business records of Applicant kept in the normal course of Applicant's business.

We hasten to add that, even without Applicant's deemed admissions, we still would find that Opposer proved its claims by a preponderance of the evidence – based upon the record and applicable law.

III. The Parties

Dawn Russell is the owner and founder of Opposer. Nearly two decades ago, Mrs. Russell was diagnosed with an aggressive form of cancer. She underwent surgery, but developed a bone infection that prevented her from undergoing chemotherapy or radiation. After spending several years trying alternative remedies to improve her health, Mrs. Russell found that eating huge amounts of certain vegetables had the largest impact on her well-being. After her recovery, Mrs. Russell searched for a way to bring an affordable dietary supplement to the masses that tasted good but did not have sugar. Ultimately she developed effervescent tablets called 8GREENS.¹⁹

Continuously since December 2015, Opposer has used the 8GREENS mark for dietary supplements in a tablet form that are used to make vitamin enhanced beverages.²⁰ Opposer's "8GREENS [e]ffervescent [t]ablet[s] ... are made from 8 real greens; spinach, kale, aloe vera, wheatgrass, blue green algae, barley grass, chlorella and spirulina...."²¹ Since October 2019, Opposer has sold 8GREENS nutritional supplements in the form of gummies and gummy vitamins.²² Opposer's "8GREENS

¹⁹ Russell Decl., 20 TTABVUE 106, ¶¶ 2-3.

²⁰ Siler Decl., 20 TTABVUE 370, ¶ 5.

²¹ Opposer's website, 8greens.com, 20 TTABVUE 385.

²² Siler Decl., 20 TTABVUE 371, ¶ 7.

[g]ummies ... [also are] made from 8 real greens: spinach, wheatgrass, kale, blue green algae, spirulina, chlorella, barley grass, and aloe vera.”²³

Applicant asserts an intent to sell vitamins, food supplements, and natural products in liquid and solid forms (such as capsules, pills, tablets, etc.) in connection with the ONE GREEN mark.²⁴ Applicant claims that he began sales of such items after the ONE GREEN mark was approved for publication by the USPTO.²⁵ However, Applicant did not provide the Board with proof as to the sale of any of these items.

IV. Entitlement to a Statutory Cause of Action

To establish entitlement to a statutory cause of action under Trademark Act Section 13, 15 U.S.C., § 1063, a plaintiff must demonstrate “an interest falling within the zone of interests protected by the statute and ... proximate causation.” *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, ___ S. Ct. ___ (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)).²⁶ Stated another way, a plaintiff is entitled to a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed.

²³ Opposer’s website, 8greens.com, 20 TTABVUE 410.

²⁴ Applicant’s Interrogatory Answer Nos. 1-2, 20 TTABVUE 76-77.

²⁵ Applicant’s Interrogatory Answer No. 3, 20 TTABVUE 77.

²⁶ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to bring and maintain a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

Cir. 2020); *see also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). According to the Court of Appeals for the Federal Circuit, there is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at *4. Thus, “a party that demonstrates a real interest in [opposing registration of] ... a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3,] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act]. ... Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3]. *Corcamore*, 2020 USPQ2d 11277 at *7.

Opposer claims ownership of the 8GREENS mark and Registration Nos. 5938596 and 5661353 therefor; and introduced into evidence USPTO TSDR database records showing Opposer’s ownership, and the current active status, of these registrations.²⁷ Applicant, as noted above, concedes these facts in his Answer.²⁸ These registrations, which contain the term GREEN(S) shared with Applicant’s mark, give Opposer entitlement to bring its statutory cause of action for priority and likelihood of confusion claim.²⁹ *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d

²⁷ Amended Notice of Opposition, 13 TTABVUE 11-18, Exhs. 1-2.

²⁸ Amended Notice of Opposition, 13 TTABVUE 7-8, ¶¶ 2-3; Answer to Amended Notice of Opposition, 17 TTABVUE 3, ¶¶ 2-3.

²⁹ Because Opposer has established its entitlement to assert a Section 2(d) claim, it may assert any other ground that would bar registration, including Opposer’s claim that Applicant lacked a bona fide intent to use the ONE GREEN mark on the filing date of its

1842, 1844 (Fed. Cir. 2000) (“[Plaintiff’s] registrations and the products sold under the mark they register suffice to establish [Plaintiff]’s direct commercial interest and its [entitlement to a statutory cause of action under Trademark Act Section 2(d)].”).

Opposer has thus established its entitlement to a statutory cause of action.

V. Priority

Because Opposer has established its ownership of, and the subsistence of, its pleaded 8GREENS registrations, and because there is no pending counterclaim to cancel either registration, priority is not an issue with respect to the goods covered by the registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

VI. Likelihood of Confusion

Trademark Act Section 2(d) prohibits the registration of a mark that

Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1052(d).

Opposer bears the burden of proving its Trademark Act Section 2(d) claim by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. Our analysis is based on all of the probative evidence of record. *In re E.I. duPont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont*,” noting the elements, or

application. *See, e.g., Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, *1 (TTAB 2020); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011).

factors, to be considered). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect registrants from damage caused by registration of confusingly similar marks. *DuPont*, 177 USPQ at 566; *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). These factors, and the other *DuPont* factors argued by each party and for which there is evidence, are discussed below.

A. The Similarity or Dissimilarity and Nature of the Goods, Channels of Trade and Potential Customers

We begin with the second *DuPont* factor which concerns the “similarity or dissimilarity and nature of the goods ... as described in an application or registration...” *DuPont*, 177 USPQ at 567. “This factor considers whether ‘the consuming public may perceive [the respective goods of the parties] as related enough to cause confusion about the source or origin of the goods ...’” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1086 (Fed. Cir. 2014) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002)). The third *DuPont* factor concerns the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1159 and 1161 (Fed. Cir. 2014).

To determine the relationship between the goods, we are bound by the identifications in Applicant’s involved Application and Opposer’s Registrations. *See Stone Lion*, 110 USPQ2d at 1162 (quoting *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”)).

Applicant’s identified goods are “dietary and nutritional supplements; vitamins.” Opposer’s identified goods are “dietary supplement[s] in tablet form containing

vitamins and herbs from green leafy vegetables and herbs to make vitamin enhanced beverages” and “nutritional supplements in the form of gummies containing ingredients from green leafy vegetables and herbs; gummy vitamins containing ingredients from green leafy vegetables and herbs.”

It is unnecessary for Opposer to demonstrate that all of the goods in the ONE GREEN application are identical or related to those in Opposer’s 8GREENS registrations; it is sufficient if Applicant’s mark for any of its identified goods in one class is likely to cause confusion with Opposer’s mark for any of its identified goods. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 938-39 (Fed. Cir. 1983) (holding that a single good from among several may sustain a finding of likelihood of confusion); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods or services in the application). Thus, over and above Applicant’s following deemed admissions,³⁰ we find that the parties’ goods are legally identical:

- “Dietary supplements in tablet form containing vitamins and herbs from green leafy vegetables and herbs to make vitamin enhanced beverages” are a type of dietary and nutritional supplement.
- “Nutritional supplements in the form of gummies containing ingredients from green leafy vegetables and herbs” are a type of dietary and nutritional supplement.
- “Gummy vitamins containing ingredients from green leafy vegetables and herb” are a type of vitamin.
- The broad category of goods identified in Applicant’s Application includes Opposer’s more specific goods identified in Opposer’s Registrations.

³⁰ Applicant’s Responses to Opposer’s Admissions’ Requests, 20 TTABVUE 86 and 88.

- The goods listed in Applicant's Application are legally identical to the goods listed in the Opposer's Registrations.

Because Applicant's goods overlap with the goods in each of Opposer's registrations, and are thus legally identical, we must therefore presume that the channels of trade and potential consumers are also identical. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *In re Am. Cruise Lines, Inc.*, 128 USPQ2d 1157, 1158 (TTAB 2018). These are points argued with emphasis in Opposer's Trial Brief,³¹ which Applicant declined to dispute in its Trial Brief.

We find the legally identical nature of the parties' goods, and the presumed overlap of the parties' trade channels and consumers, contribute to an ultimate determination that confusion is likely.

B. Purchasing Conditions

Under the fourth *DuPont* factor, we consider "[t]he conditions under which and buyers to whom sales are made, i.e., 'impulse' vs. careful, sophisticated purchasing." *DuPont*, 177 USPQ at 567. Opposer sells its 8GREENS effervescent tablets in a variety of packaging, which ranges from a 10-tablet container for \$14.00, or \$1.40 per day, to a variety pack with a 30-day supply of tablets for \$39; 8GREENS gummies

³¹ Opposer's Brief, 20 TTABVUE 17-20.

are sold for \$55 per 60-unit container.³² We do not know the actual prices charged for Applicant's goods. However, "Applicant does not intend to limit the marketing or distribution of ... [its] products ... [dietary and nutritional supplements, and vitamins] to prospective customers of any particular demographic(s)." In any event, "[b]ecause the goods are ... [consumable dietary and nutritional products] without any restrictions or limitations as to price point or classes of consumers, the average customer is an ordinary consumer of the respective goods" in the application and registrations at issue. *In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1630 (TTAB 2018).

Thus, "the parties' goods [here] are ordinary consumer items available at a relatively low cost. Generally, purchasers of casual, low cost ordinary consumer items exercise less care in their purchasing decisions and are more likely to be confused as to the source of the goods. *Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009). More particularly, "[b]oth [parties'] products are relatively inexpensive, comestible goods subject to frequent replacement. Purchasers of such products have been held to a lesser standard of purchasing care." *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1282 (Fed. Cir. 1984).

The fourth *DuPont* factor, purchasing conditions, supports an ultimate conclusion that confusion is likely.

³² Siler Decl., 20 TTABVUE 372, 384, 401, 406, 409, 414, 424, 426, 430, 449, 455, 463, ¶¶ 12-13, Exhs. A and B

C. The Similarity or Dissimilarity of the Marks

In our evaluation of the similarity or dissimilarity of the parties' marks, we consider the strength of Opposer's mark and compare the respective marks in their entireties. We do so with the recognition that where the goods of the Application and Opposer's Registrations are legally identical, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012).

1. Strength of Opposer's Mark

Before we turn to the similarity of the marks, we consider the strength of Opposer's mark under the fifth and sixth *DuPont* factors, *DuPont*, 177 USPQ at 567, as that will affect the scope of protection to which it is entitled. In determining the strength of a mark, we consider its conceptual strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning)."). The commercial strength of the mark also is affected by the number and nature of third-party use of similar marks for similar goods. *DuPont*, 177 USPQ at 567.

8GREENS is the quintessential example of a merely descriptive mark. "A mark is merely descriptive if it consists merely of words descriptive of the qualities, ingredients or characteristics of the goods ... related to the mark." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753,

1755 (Fed. Cir. 2012) (cleaned up). As noted on Opposer’s website,³³ 8GREENS immediately refers to the eight green vegetable ingredients in Opposer’s effervescent tablets and gummy vitamins promoted and sold under the mark. Moreover, because Opposer obtained its registrations for the 8GREENS mark under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), Opposer concedes its mark is merely descriptive. *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1044-45 (Fed. Cir. 2018).

Merely descriptive marks are considered inherently weak, such that they are neither registrable nor enforceable without acquiring distinctiveness – otherwise known as secondary meaning. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 764-65 (2d Cir. 1976). However, such marks are still entitled to protection under Trademark Act Section 2(d) against the registration by a subsequent user of a similar mark for goods that are legally identical, as is the case here. *See King Candy*, 182 USPQ at 109; *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1246 (TTAB 2010).

Seeking to further weaken the scope of protection accorded to Opposer’s 8GREENS mark, Applicant argues that “Opposer does not own every mark that includes “GREEN” or “GREENS” and a number or numerical reference.”³⁴ This, says Applicant, is because of “multiple third party Trademark Registrations that are **more**

³³ Opposer’s website, 8greens.com, 20 TTABVUE 385, 410.

³⁴ Applicant’s Brief, 21 TTABVUE 9.

similar to Opposer’s mark than Applicant’s mark is.”³⁵ Applicant’s evidence provided to support this assertion is the following:

Mark	Reg. No.	Goods	Owner
GREENS 88	4227791 Cancelled	Nutritional supplements containing greens, Cl. 5	Nemco, LLC
TRIPLE GREENS	2961844	Dietary food supplements in powdered drink form, Cl. 5	Water Pure, Inc.

The registration for the GREENS 88 mark has been cancelled, and therefore has no probative value. A cancelled registration is not evidence of any existing rights in the mark. *See Action Temp. Servs. v. Labor Force*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (expired registration has no probative value other than for what it shows on its face, i.e., that the registration issued). Since the GREENS 88 registration has been cancelled, we give it no consideration. This leaves one registration – for the mark TRIPLE GREENS – having the term “GREENS” in common with Opposer’s 8GREENS mark. The goods for which the TRIPLE GREENS mark is registered overlap with Opposer’s goods recited in Registration No. 5661353, and are arguably related to Opposer’s goods recited in Registration No. 5938596.

Third-party registration evidence may have some probative value because it “may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017). Third-party registrations are also relevant in the manner of

³⁵ *Id.* at 8. Emphasis supplied by Applicant.

dictionary definitions “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted). *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). However, the number of third-party registrations in this case is substantially smaller than the number found convincing in *Jack Wolfskin* and *Juice Generation* wherein a considerable number of third parties’ registration of similar marks was shown. *Jack Wolfskin*, 116 USPQ2d at 1137; *Juice Generation*, 115 USPQ2d at 1674-75. Applicant, therefore, has failed to present meaningful evidence to further demonstrate the conceptual weakness of Opposer’s 8GREENS mark.

The sixth *DuPont* factor “considers the number and nature of similar marks in use on similar goods.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567), because it potentially impacts our analysis of the similarity of the marks. “The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Id.* (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (internal quotation and quotation marks omitted)). “Third-party use is also ‘relevant to show

that a mark is relatively weak and entitled to only a narrow scope of protection.” *Id.* (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

Applicant provided no evidence regarding the marketplace use of third-party marks similar to 8GREENS for the same or similar goods as those of Opposer. However, Opposer did provide examples of such third-party usage:³⁶

Third-Party Mark	Third-Party Product
GREEN ENERGY	Nutritional supplements
SUPER GREENS	Nutraceuticals
DAILY GREENS	Green lemonade
SKINNY GREENS	Superfood powder
GREEN SUPERFOOD	Antioxidant effervescent tablets

These third-party uses serve as some evidence that the “GREEN(S)” portion of Opposer’s and Applicant’s marks is relatively weak from a commercial standpoint.

On the other hand, Opposer made of record significant evidence that the 8GREENS mark has acquired a modicum of distinctiveness or secondary meaning in the marketplace. “[A] mark has acquired distinctiveness, even if it is not inherently distinctive, if it has developed secondary meaning, which occurs when, in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself.” *Converse, Inc. v. ITC*, 909 F.3d 1110, 28 USPQ2d 1538, 1543 (Fed. Cir. 2018). To determine whether a mark has acquired secondary meaning, we consider: “(1) the degree and manner of use; (2) the exclusivity of use; (3) the length of use; (4) the degree and manner of sales, advertising, and promotional activities; (5)

³⁶ QVC website, 20 TTABVUE 131; USA Love List blog, 20 TTABVUE 319-20; Amazon website, 20 TTABVUE 416, 420; Target website, 20 TTABVUE 446.

the effectiveness of the effort to create secondary meaning; (6) deliberate copying; and (7) association of the ... [mark] with a particular source by actual purchasers (typically measured by customer surveys).” *Converse*, 28 USPQ2d at 1546. Opposer has submitted evidence as to elements 1, 3, 4, and 5 discussed in *Converse*.

As proof of the commercial strength of the 8GREENS mark through use in the marketplace, Opposer points to millions in unit sales and tens of millions in dollar sales of 8GREENS products made through multiple brick-and-mortar and online sales outlets since late 2015,³⁷ millions of dollars spent on social media and other forms of online advertising prominently featuring the 8GREENS mark and resulting in millions of consumer impressions since 2016,³⁸ widely dispersed print and online media attention directed to Opposer’s 8GREENS products since 2015,³⁹ numerous personal broadcast media appearances by Mrs. Russell promoting 8GREENS products since 2016,⁴⁰ and endorsements of 8GREENS products by well-known actors, models and other celebrities.⁴¹ These are all indicia of the commercial strength gained by the 8GREENS mark through its marketplace use by Opposer in the last six years. *Omaha Steaks*, 128 USPQ2d at 1690 (“[T]he ... [strength] of a mark may

³⁷ Russell Decl., 20 TTABVUE 106, ¶¶ 4-10; Siler Decl., 20 TTABVUE 370-72, 375-464, ¶¶ 5, 7, 9, 11, 13 and Exhs. A-B; exact sales numbers confidential.

³⁸ Russell Decl., 20 TTABVUE 107, 141-75, ¶¶ 11-12 and Exhs. 5-6; Siler Decl., 20 TTABVUE 372-73, 465-82, ¶¶ 8, 10, 14-15 and Exh C; exact advertising expenditures confidential.

³⁹ Russell Decl., 20 TTABVUE 107-22, 176-203, 228-369, ¶¶ 13-16, 20-23 and Exhs. 7-10, 14-17; Siler Decl., 20 TTABVUE 373, 483-563, ¶ 16 and Exh. D.

⁴⁰ Russell Decl., 20 TTABVUE 109, 204-27, ¶¶ 17-19, and Exhs. 11-13; Siler Decl., 20 TTABVUE 374, 571-83, ¶ 19 and Exh. F.

⁴¹ Siler Decl., 20 TTABVUE 373, 394-99, 564-69, ¶¶ 17-18, and Exhs. A and E.

be measured indirectly, among other things, by the 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.”). While Opposer was not required to submit a consumer survey to prove its point, *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1308 (Fed. Cir. 2002), what is missing from Opposer’s proofs of marketplace strength is the relative market share of 8GREENS products compared to similar goods in its category. *Id.* at 1309.

Having reviewed Opposer’s evidence of marketplace strength, we cannot say that it has achieved the status of a “famous mark” for likelihood of confusion purposes. We also observed numerous instances in which Opposer’s packaging and advertising content directly informs consumers of 8GREENS ingredients rather than as a designation of the source of the product.⁴² Under controlling case law, the strength of a mark for likelihood of confusion purposes is not “an all-or-nothing factor” and “varies along a spectrum from very strong to very weak[;]” that is, “[a] mark’s renown within a specific product market is the proper standard.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733 (Fed. Cir. 2017). Thus we find that, while inherently weak, Opposer’s 8GREENS mark has attained a degree of marketplace recognition and is therefore entitled to protection against the registration by a subsequent user of a similar mark for legally identical goods. *King Candy*, 182 USPQ at 109.

⁴² Packaging, Siler Decl., 20 TTABVUE 371, ¶¶ 6-7; Opposer’s website, Siler Decl., 20 TTABVUE 375-412, Exh. A.

2. Comparison of the Marks

We now consider the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imps.*, 73 USPQ2d at 1691; *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, 777 Fed. Appx. 516 (Fed. Cir. 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)). We undertake this analysis notwithstanding Applicant’s deemed admissions that (1) “Applicant’s ONE GREEN Mark is similar to Opposer’s 8GREENS Mark in sound, meaning and commercial impression[,]” and (2) “[t]he only substantive difference between Applicant’s Mark and Opposer’s Mark is the number included as part of the mark.”⁴³

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs.*, 101 USPQ2d at 1721) (internal quotation marks omitted). The focus is on the recollection of the average purchaser – here, a member of the general public seeking to consume dietary and nutritional supplements and vitamins – who normally retains a general rather than a specific

⁴³ Applicant’s Admissions to Opposer’s Requests Nos. 8-9, 20 TTABVUE 86 and 88.

impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007).

We find that that the 8GREENS and ONE GREEN marks are similar in sight, sound, meaning, and overall commercial impression, because they both start with a number and end with the identical term “GREEN(S),” differ only by a numerical prefix, share the same format and structure — a single digit number combined with “GREEN(S)” — followed by five shared letters and the same suffix — GREEN/GREENS[,] and have the same number of syllables. Moreover, each mark conveys that the parties’ nutritional supplements and vitamins contain a certain number of “GREEN(S)” and that the products provide the health benefits of a “green.”

We further find any differences between the parties’ marks to be insignificant. For example, marks differing by only a single letter (or, in this case, a single number) are confusingly similar. *See Apple Comput. v. TVNET.net Inc.*, 90 USPQ2d 1393, 1396 (TTAB 2007) (VTUNES.NET vs. ITUNES); *Interlego AG v. Abrams/Gentile Entm’t Inc.*, 63 USPQ2d 1862, 1863 (TTAB 2002) (“Obviously, the marks LEGO and MEGO are extremely similar in that they differ simply by one letter.”). Further, the difference of a space between “ONE” and “GREEN” in Applicant’s mark, which is not present in Opposer’s “8GREENS” mark, is inconsequential. *See, e.g., Seaguard Cor. v. Seaward Int’l, Inc.*, 223 USPQ 48, 51 (TTAB 1984) (“‘SEAGUARD’ and ‘SEA GUARD’ are, in contemplation of law, identical”); *In re Best W. Family Steak House, Inc.*, 222 USPQ 827, 827 (TTAB 1984) (“There can be little doubt that BEEFMASTER and BEEF MASTER are practically identical”). Additionally, although Applicant’s

mark is “ONE GREEN” in the singular while the Opposer’s mark is “8GREENS” in the plural, this difference is minimal. *See Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) (singular and plural of SWISS GRILL deemed “virtually identical”); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (singular and plural forms of SHAPE considered essentially the same mark).

We thus make this comparison of the parties’ marks, without improperly dissecting their elements so as to consider them as a whole. *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Moreover, while the term “GREEN(S)” is entitled to less weight in our analysis, we may not ignore it, even though it is disclaimed in Applicant’s mark and Opposer all but admits that it is a descriptive component in both parties’ marks.⁴⁴ *Shen Mfg. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1355 (Fed. Cir. 2004) (“The disclaimed elements of a mark, however, are relevant to the assessment of similarity ... This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed.”).

⁴⁴ *Id.* A disclaimer of “GREENS” was not required for Opposer’s 8GREENS mark because it is unitary. If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word is required. *See In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (finding that “[a] disclaimer of a descriptive portion of a composite mark is unnecessary ... if the elements are so merged together that they cannot be regarded as separable elements ... for example, ... by combining two words or terms, one of which would be unregistrable by itself ...”).

Overall, we find the marks “ONE GREEN” and “8GREENS” are more similar than they are different, supporting the ultimate conclusion that confusion is likely.

D. Other Factors relating to Likelihood of Confusion

The thirteenth likelihood of confusion factor is “[a]ny other established fact probative of the effect of use.” *DuPont*, 177 USPQ at 567. As Opposer argues,⁴⁵ “doubts about the likelihood of confusion [are resolved] against the newcomer because the newcomer has the opportunity and obligation to avoid confusion with existing marks.” *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *see also, TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 44 USPQ2d 1315, 1318 (Fed. Cir. 1997) (“[A]s witness the fact that applicant has filed an intent to use application, the well[-]established rule that doubts are to be resolved against a newcomer and in favor of an established ... user applies here.”). Given the closeness of the parties’ marks, goods, channels of trade, and prospective customers, we have no doubt that confusion is likely.

On the other hand, Applicant argues that it “has acted in good faith at all times” and that “there was absolutely no bad faith on the part of the Applicant at any time.”⁴⁶ However, “[g]ood faith adoption of a mark will not prevent a finding of likelihood of confusion[.]” *Lebanon Seaboard Corp. v. R & R Turf Supply, Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012), and “proof of intent to trade on another’s goodwill, while persuasive evidence of likelihood of confusion, is not, in any event, a requirement

⁴⁵ Opposer’s Brief, 20 TTABVUE 28.

⁴⁶ Applicant’s Brief, 21 TTABVUE 11.

under [Trademark Act Section] 2(d).” *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988).

We find the thirteenth *DuPont* factor neutral on the question of likelihood of confusion.

E. Conclusion on Likelihood of Confusion

The first, second, third and fourth *DuPont* factors favor finding a likelihood of confusion. The marks at issue are more similar than they are different; the goods are legally identical; we presume identical trade channels and classes of purchasers; and the respective goods are low cost ordinary consumer items purchased with less care by consumers. These factors outweigh any other *DuPont* factors discussed. We thus find that Applicant’s ONE GREEN mark, used in connection with Applicant’s goods, so closely resembles Opposer’s registered 8GREENS mark as to be likely to cause confusion, mistake or deception as to the source of Applicant’s goods.

VII. Applicant’s Bona Fide Intent as of its Application Filing Date

Trademark Act Section 1(b)(3), 15 U.S.C. § 1051(b)(3), requires applicants to verify that they have a bona fide intent to use their marks in commerce as of the application filing date. Therefore, lack of bona fide intent is a proper statutory ground on which to challenge a trademark application filed under Trademark Act Section 1(b).

“Opposer has the initial burden of demonstrating by a preponderance of the evidence that [A]pplicant lacked a bona fide intent to use the mark on the identified goods.” *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). If Opposer satisfies this initial burden, the burden of production shifts to

Applicant to offer additional evidence showing its bona fide intent to use its mark in commerce. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1727 (TTAB 2010).

“The absence of any documentary evidence on the part of an applicant regarding ... [its bona fide] intent constitutes objective proof ... that the applicant lacks [such an] intention to use its mark in commerce.” *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1930 (TTAB 2009) (citing *Commodore Elecs. Ltd. v. CBM K. K.*, 26 USPQ2d 1503, 1507 (TTAB 1993)). The absence of documentary evidence, however, must be considered in context of the evidentiary record as a whole. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015) (the determination of objective intent is made on a case-by-case basis considering totality of circumstances).

If Opposer meets its burden, Applicant may “elect to try to rebut the opposer[’s] prima facie case by offering additional evidence concerning the factual circumstances bearing upon his intent to use his mark in commerce.” *Commodore Elecs.*, 26 USPQ2d at 1507 n.11. “[The] circumstances must indicate the applicant’s intent to use the mark that are ‘firm’ and ‘demonstrable.’” *Société des Produits Nestlé S.A. v. Taboada*, 2020 USPQ2d 10893, at *11 (TTAB 2020) (citing *M.Z. Berger*, 114 USPQ2d at 1898). However, Applicant’s “mere statement of subjective intention, without more, would be insufficient to establish applicant’s bona fide intention to use the mark in commerce.” *Lane Ltd. v. Jackson Int’l Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). Further, as the Board has held in the past, the mere act of filing an

intent-to-use application is insufficient to establish an applicant's bona fide intention to use its mark in commerce for the identified goods:

If the filing and prosecution of a trademark application constituted a bona fide intent to use a mark, then in effect, lack of a bona fide intent to use would never be a ground for opposition or cancellation, since an inter partes proceeding can only be brought if the defendant has filed an application.

Research in Motion, 92 USPQ2d at 1931.

On a related point, the Board found lack of a bona fide intent to use in *L'Oréal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012) based upon the "applicant's complete lack of documentary evidence or any other objective evidence that he can/will use the mark, lack of capacity or experience needed to manufacture or otherwise offer his identified goods, vague allusions to using the mark through licensing or outsourcing, and failure to take any concrete actions or to develop any concrete plans for using the mark" *Id.* at 1443.

A. The Record as to Applicant's Bona Fide Intent

We of course have Applicant's deemed admissions (which confirm what we also glean from other evidence of record):⁴⁷

Opposer's Admission Request No.	Applicant's Admission
1.	Applicant did not use the mark ONE GREEN in commerce prior to July 26, 2019.
2.	Applicant has not sold goods under the ONE GREEN in commerce in the United States.

⁴⁷ Applicant's Admissions' Responses, 20 TTABVUE 85 and 88.

**Opposer's
Admission
Request No.**

**Applicant's
Admission**

- | | |
|----|---|
| 3. | Applicant did not have a bona fide intent to use the ONE GREEN mark for dietary supplements on July 26, 2019. |
| 4. | Applicant did not have a bona fide intent to use the ONE GREEN mark for nutritional supplements on July 26, 2019. |
| 5. | Applicant did not have a bona fide intent to use the ONE GREEN mark for vitamins on July 26, 2019. |

Notwithstanding these admissions, “Applicant [asserts he] fully intended to use the [ONE GREEN] mark as of the time of filing of ... [his] application, and at all times since.”⁴⁸ Applicant further contends:

There is simply nothing in the record to warrant a presumption that Applicant lacked bona fide intent, thus Opposer’s argument must fail. ... To the contrary, the many documents that were produced by Applicant in discovery showed an intense flurry of activity immediately after the application was filed on July 26, 2019.

Unfortunately, Applicant did not make any of these documents of record.

Moreover, Applicant professed to having no documents responsive to Opposer’s requests for production of product specimens or samples, business plans, documented searches, investigations or research, sales projections, planned channels of trade, target customers or consumers, applications for FDA labeling approval, licensing documents, or any other such materials that would support the bona fides of his intent to use the ONE GREEN mark on the filing date of his trademark application, or within a reasonable time thereafter.⁴⁹

⁴⁸ Applicant’s Brief, 21 TTABVUE 10.

⁴⁹ Applicant’s Responses to Opposer’s Production Requests Nos. 3 and 8-18. *See* 20 TTABVUE 92-94. Written responses to requests for production of documents introduced through a notice of reliance (or, as in this case, attached to a party’s trial brief pursuant to the parties’ ACR Stipulation) are admissible solely for the purpose of showing that a party has stated that

Applicant's relevant interrogatory answers are equally unenlightening regarding his bona fide intent. Applicant failed to identify any documented trademark searches or investigations in connection with his adoption of the ONE GREEN mark, nor any product manufacturing, sale or distribution plans.⁵⁰

B. Analysis and Conclusion as to Applicant's Bona Fide Intent

In his Trial Brief, Applicant makes numerous pronouncements regarding the bona fides of his intent to use the ONE GREEN mark on the date he filed his intent-to-use application to register the mark.⁵¹ However, "[a]ttorney argument is no substitute for evidence." *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

We simply have no documentary proof supporting Applicant's bona fide intent to use his mark on or in connection with the identified goods as of his application filing date. The absence of such documentation is fatal to Applicant's assertion that he had such bona fide intent. *Research in Motion*, 92 USPQ2d at 1930; *Commodore Elecs.*, 26 USPQ2d at 1507. Taken together, the absence of supporting documentation, Applicant's unedifying interrogatory answers and Applicant's admissions objectively demonstrate to us that he did not have a bona fide intent to use the ONE GREEN

there are no responsive documents, as Applicant did in certain of its responses. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1038 n.7 (TTAB 2012).

⁵⁰ Applicant's Interrogatory Answers Nos. 8 and 10-14. *See* 20 TTABVUE 78-81.

⁵¹ Applicant's Brief, 21 TTABVUE 11-13.

Opposition No. 91255119

mark in commerce for the identified goods on his application filing date. *M.Z. Berger*, 114 USPQ2d at 1898.

Decision:

The Opposition to Applicant's ONE GREEN trademark application is sustained on the ground of priority and likelihood of confusion, and on the ground that Applicant lacked a bona fide intent to use his mark on his application filing date.