

ESTTA Tracking number: **ESTTA699883**

Filing date: **10/02/2015**

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

Proceeding	92058000
Party	Plaintiff Nash-Finch Company
Correspondence Address	JOHN A CLIFFORD MERCHANT & GOULD PC PO BOX 2910 MINNEAPOLIS, MN 55402-0910 UNITED STATES hkliebenstein@merchantgould.com, aries@merchantgould.com, aavery@merchantgould.com, dockmpls@merchantgould.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Heather Kliebenstein
Filer's e-mail	hkliebenstein@merchantgould.com, jclifford@merchantgould.com, ak-rueger@merchantgould.com, dockmpls@merchantgould.com, aavery@merchantgould.com
Signature	/Heather Kliebenstein/
Date	10/02/2015
Attachments	2015 10 02 Petitioner Trial Brief_REDACTED.pdf(1713832 bytes)

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

Nash Finch Company)	
)	
)	Cancellation No. 92058000
)	
v.)	Registration No. 4,283,988
)	
Ahold Licensing Sàrl,)	Mark: OUR FAMILY FOUNDATION
)	& DESIGN
)	
Registrant.)	

PETITIONER'S MAIN TRIAL BRIEF

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	DESCRIPTION OF THE RECORD	2
	A. Evidence Automatically of Record	2
	B. Evidence Submitted by Petitioner in its Notice of Reliance (April 2, 2014) And Rebuttal Notice Of Reliance (August 3, 2015)	2
	C. Petitioner’s Testimonial Deposition and Associated Exhibits.....	3
	D. Registrant’s Evidence	3
III.	STATEMENT OF THE ISSUES.....	3
IV.	RECITATION OF THE FACTS	4
	A. Nash Finch Is a Leading Wholesaler, Food Provider And Retailer In The Grocery Industry	4
	B. Nash Finch’s OUR FAMILY Brand Is Widely Used, Heavily Promoted, Advertised And Supported.....	5
	1. The OUR FAMILY Brand Has Been Widely Distributed Since 1904.....	5
	2. Nash Finch Heavily Promotes The OUR FAMILY Products	7
	3. Nash Finch Heavily Advertises The OUR FAMILY Brand.....	12
	4. Nash Finch Invests In The OUR FAMILY Brand Through Corporate Support.....	14
	C. The OUR FAMILY Brand Is Strong And Well-Known	16
	D. OUR FAMILY Products Are Made By Third Party Manufacturers That Make A Variety Of Food Products	16
	E. OUR FAMILY Is Used In Connection With Fundraising And Charity Nationwide.....	17
	1. Nash Finch Fundraises And Donates To Nonprofits Through The OUR FAMILY Labels For Learning Program	18

2.	The OUR FAMILY Brand Is Used For Charitable Donations Nationwide	20
3.	Nash Finch’s NFC Foundation Uses The OUR FAMILY Brand.....	22
F.	Ahold’s OUR FAMILY FOUNDATION Also Provides Fundraising And Charitable Services	23
1.	Ahold Uses Its OUR FAMILY FOUNDATION Mark To Fundraise For Charity And To Donate Money To Charities.....	24
2.	Ahold’s Use Of Its OUR FAMILY FOUNDATION Mark Reaches The Same Customers And Vendors As Nash Finch’s OUR FAMILY Mark.....	25
3.	The Our Family Foundation Promotes Its Mark At Several Public Events Throughout Each Year	27
4.	Ahold Publicly Promotes The OUR FAMILY FOUNDATION Mark.....	29
V.	ARGUMENT.....	32
A.	Nash Finch Has Priority To Use The OUR FAMILY Mark In Connection With Food, Fundraising And Charitable Services	32
B.	Vendors and Customers Are Likely To Be Confused By Ahold’s Use Of Its OUR FAMILY FOUNDATION Mark.....	34
1.	Nash Finch’s OUR FAMILY Mark is Extremely Strong And Famous.....	35
2.	The OUR FAMILY Brand Is Used Across A Wide Range Of Products And Services.....	37
3.	Ahold’s OUR FAMILY FOUNDATION & Design Mark Is Identical To Nash Finch’s Strong OUR FAMILY Mark.....	38
4.	Ahold’s OUR FAMILY FOUNDATION Services Are Identical And Highly Related To Nash Finch’s OUR FAMILY Goods And Services	41
5.	The Parties Market Their Identical Goods And Services Through Identical Trade Channels	44
6.	Ahold And Nash Finch Have Market Interface In The Ever Changing Food Industry	46

7.	The Conditions of Fundraising And Purchase Of Food Products Indicate Confusion Is Likely.....	47
8.	No <i>DuPont</i> Factor Weighs In Ahold’s favor	49
9.	There Is No Evidence The OUR FAMILY Mark Is Diluted By The Actual Use Of Similar Marks On Similar Goods; Thus Nash Finch Has A Broad Right To Exclude Ahold’s Registration Of OUR FAMILY FOUNDATION & Design.....	49
VI.	SUMMARY	49

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>7-Eleven Inc. v. Weshsler</i> , 83 USPQ2d 1715 (TTAB 2007)	41, 47
<i>Bose Corp. v. QSC Audio Prods, Inc.</i> , 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002)	35
<i>CBS Inc. v. Morrow</i> , 708 F. 2d 1579, 218 USPQ 198 (Fed. Cir 1983)	39
<i>Centraz Indus., Inc. v. Spartan Chem. Co.</i> , 77 USPQ2d 1698 (TTAB 2006)	40
<i>Century 21 Real Estate Corp. v. Century Life of Am.</i> , 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)	35, 40
<i>Citigroup Inc. v. Capital City Bank Grp., Inc.</i> , 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011)	37
<i>Cunningham v. Laser Golf Corp.</i> , 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000)	32
<i>Edgecraft Corp. v. Smith’s Consumer Prods., Inc.</i> 2013 TTAB LEXIS 371 (TTAB July 12, 2013)	37, 46
<i>Fossil Inc. v. Fossil Grp.</i> , 49 USPQ2d 1451 (TTAB 1998)	40
<i>Giant Food, Inc. v. Nation’s Foodservice, Inc.</i> , 710 F.2d 1565, 218 USPQ2d 390 (Fed. Cir. 1983)	40
<i>Helene Curtis Indus. Inc. v. Suave Shoe Corp.</i> , 13 USPQ2d 1618 (TTAB 1989)	35
<i>Herbko Int’l Inc. v. Kappa Books, Inc.</i> , 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002)	38, 49
<i>Hewlett-Packard</i> , 62 USPQ2d at 1003	34
<i>In re Davey Prods. Pty Ltd.</i> , 92 USPQ2d 1198 (TTAB 2009)	43
<i>In re Davia</i> , 110 USPQ2d 1810 (TTAB 2014)	38

<i>In re Dixie Rests., Inc.</i> , 105 F.3d 1405 (Fed. Cir. 1997).....	34
<i>In re E.I. du Pont de Nemours & Co.</i> , 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973).....	34, 35
<i>In re Elbaum</i> , 211 USPQ 639 (TTAB 1981).....	41
<i>In re G.B.I. Tile & Stone, Inc.</i> , 92 USPQ2d 1366 (TTAB 2009).....	44
<i>In re Jump Designs, LLC</i> , 80 USPQ2d 1370 (TTAB 2006).....	41
<i>In re Linkvest S.A.</i> , 24 USPQ2d 1716 (TTAB 1992).....	41
<i>In re Paper Doll Promotions, Inc.</i> , 84 USPQ2d 1660 (TTAB 2007).....	44
<i>In re Shell Oil Co.</i> , 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993).....	34, 39
<i>In re Toshiba Med. Sys. Corp.</i> , 91 USPQ2d 1266 (TTAB 2009).....	43
<i>In re Viterra Inc.</i> , 671 F.3d at 1363, 101 USPQ2d at 1909.....	39, 40, 44
<i>Jansem Enters., Inc. v. Rind.</i> , 85 USPQ2d 1104 (TTAB 2007).....	40
<i>Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.</i> , 107 USPQ2d 1424 (TTAB 2013).....	39
<i>Kenner Parker Toys Inc. v. Rose Art Indus., Inc.</i> , 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).....	35
<i>Lipton Indus., Inc. v. Ralston Purina Co.</i> , 670 F.2d 1024, 213 USPQ 185 (C.C.P.A. 1982).....	32
<i>Nike, Inc. v. WNBA Enters., LLC</i> , 85 USPQ2d 1187 (TTAB 2007).....	44
<i>Octocom Sys. Inc. v. Hous. Computers Servs. Inc.</i> , 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1999).....	41, 44

<i>On-line Careline Inc. v. Am. Online Inc.</i> , 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000)	41
<i>Otto Roth & Co. v. Universal Foods Corp.</i> , 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)	32
<i>ProQuest Information & Learning Co. v. Island</i> , 83 USPQ2d 1351 (TTAB 2007)	35
<i>Recot</i> , 214 F.3d at 1327-28, 54 USPQ2d at 1897	35, 41
<i>Research in Motion Limited v. Defining Presence Marking Grp. Inc.</i> , 102 USPQ2d 1187 (TTAB 2012)	32
<i>San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.</i> , 565 F.2d 683, 196 USPQ 1 (C.C.P.A. 1977)	38
<i>Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang</i> , 84 USPQ2d 1323 (TTAB 2007)	40
<i>Sealed Air Corp. v. Scott Paper Co.</i> , 190 USPQ 106 (TTAB 1975)	38
<i>Spoons Rests. Inc. v. Morrison Inc.</i> , 23 USPQ2d 1735 (TTAB 1991), <i>aff'd</i> , No. 9201086 (Fed. Cir. June 5, 1992).....	38
<i>Squirtco v. Tomy Corp.</i> , 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983)	39
<i>Stone Lion Capital Partners, LP v. Lion Capital LLP</i> , 746 F.3d 1317, 110 USPQ2d 1157 (Fed. Cir. 2012)	41
<i>Wet Seal Inc. v. FD Mgmt. Inc.</i> , 82 USPQ2d 1629 (TTAB 2007)	32
STATUTES	
37 C.F.R. § 2.122	2
Trademark Act Section 2(d).....	44
Trademark Rule 2.122	2
OTHER AUTHORITIES	
2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:1 (4th ed. 2013).....	32

I. INTRODUCTION

This cancellation was commenced by Nash Finch Company (“Nash Finch”), one of this country’s leading wholesale suppliers of name brand and private label groceries and related goods to protect its primary private label brand, OUR FAMILY, used since 1904 and now in use on approximately 2,500 separate products. Nash Finch seeks cancellation of a registration for the mark OUR FAMILY FOUNDATION & Design, registered by the brand licensing arm of a competitor, Ahold Licensing Sàrl (“Ahold”). The record shows confusion, and harm to Nash Finch’s OUR FAMILY brand, is inevitable.

Both parties sell groceries at wholesale and supply products to retail stores for sale to the general public. Both parties are also active in philanthropy, each raising substantial sums and spending them in communities where they operate to address social, economic or educational needs. Both parties use the term OUR FAMILY to raise money and provide it to the needy.

Both parties raise money in the same way, from the same people and companies, and both promote their philanthropic activities to the public in similar ways. Nash Finch raises money from the suppliers of its products, including the suppliers of its OUR FAMILY products. Nash Finch also donates five cents for each label of its OUR FAMILY products collected by schools and other civic organizations as part of its OUR FAMILY Labels for Learning program. Ahold raises money using its OUR FAMILY FOUNDATION mark from the suppliers of its products, a great number of whom either make the OUR FAMILY products for Nash Finch, sell their other products to Nash Finch, or are otherwise familiar with the OUR FAMILY brand. Ahold also raises money from, and promotes the OUR FAMILY FOUNDATION mark to, the same general public who clip, collect and donate OUR FAMILY labels as a fund raising activity as part of Nash Finch’s OUR FAMILY - LABELS FOR LEARNING program. Vendors

approached by Nash Finch for donations under the OUR FAMILY banner are likely to believe they already donated—albeit to the Our Family Foundation.

The OUR FAMILY mark is intimately and inseparably associated with Nash’s LABELS FOR LEARNING program and the other charitable services of Nash Finch, while the OUR FAMILY FOUNDATION mark is the banner used by Ahold for its similar services. Charitable fundraising services are so closely related to the grocery business that confusion is highly likely between Nash Finch’s OUR FAMILY marks, and Ahold’s OUR FAMILY FOUNDATION mark. Examination of the record generated in this proceeding leads to that conclusion. Based on that evidence and the applicable law, cancellation of Registration No. 4,283,988 is requested.

II. DESCRIPTION OF THE RECORD

The evidence of record consists of the following:

A. Evidence Automatically of Record.

Pursuant to Trademark Rule 2.122, 37 C.F.R. § 2.122, the record includes the pleadings and orders in the proceeding and the file history of the Application.

B. Evidence Submitted by Petitioner in its Notice of Reliance (April 2, 2014) And Rebuttal Notice Of Reliance (August 3, 2015).

The evidence submitted by Petitioner Nash Finch in its April 2, 2014 Notice of Reliance includes the following:

- Application file for the mark OUR FAMILY FOUNDATION & DESIGN, Reg. No. 4,283,988 (Ex. 1)



- TDSR records, along with assignment information showing the registrations and application are active and are owned by Nash Finch for marks OUR FAMILY, Reg. No. 369,014, for the mark OUR FAMILY Reg. No. 2,690,200 and for the mark OUR FAMILY & Design, Serial No. 85/905,473 (Exs. 2-7)
- Excerpts from Registrant’s interrogatory responses, along with all documents provided as all or part of the interrogatory responses (Exs. 8-10)

- Rule 30(b)(6) deposition of Tracey Pawelski and accompanying Exhibits 4-7 and 10-26 (Ex. 11)
- Rule 30(b)(6) deposition of Deborah Hill and accompanying Exhibits 8-9, 13, 17, 21-23 and 27 (Ex. 12)
- Nash Finch's www.ourfamilyfoods.com website (Ex. 13)
- Printouts of online press mentions of OUR FAMILY and OUR FAMILY FOUNDATION (Ex. 14)
- Certificates of registration, TDSR reports and web printouts relating to marks registered and used in connection with both food products and charitable services (Exs. 15-16)
- Evidence of geographic overlap of the parties' uses of the marks at issue (Ex. 17)
- Nash Finch's annual reports from 2012-2013 (Exs. 18-19)

The evidence submitted by Petitioner in its August 3, 2015 Rebuttal Notice of Reliance includes the following:

- Additional excerpts of the Rule 30(b)(6) deposition of John A. Paul, IV (Ex. 1)
- Printouts of websites showing the businesses of the entities identified in Registrant's Notice of Reliance (Ex. 2)

C. Petitioner's Testimonial Deposition and Associated Exhibits.

Petitioner has provided the testimonial deposition transcripts of the following witnesses:

- Testimonial deposition of John Paul and accompanying Exhibits 5, 10, 30-31, 41-44, 48, 50-58, 60-107, 109-115, 117, 119-151, 157-160, 162-182
- Testimonial deposition of Michele Murphy and accompanying Exhibits 57-58, 160, 183-231
- Testimonial deposition of Paula Docken and accompanying Exhibits 232-243

D. Registrant's Evidence.

Petitioner may rely on documents or deposition transcripts identified by Registrant as its trial evidence or in its Notice of Reliance (filed June 16, 2015) to the extent they are admissible into evidence.

III. STATEMENT OF THE ISSUES

The issue presented in this case is whether the Ahold's registration of the mark OUR FAMILY FOUNDATION & Design, when used on or in connection with "charitable fundraising services" by the licensing arm of Ahold, a competing grocery retailer, is likely to cause

confusion as to the source, or as to affiliation, sponsorship or endorsement with Nash Finch's registered OUR FAMILY marks for food products, and common law OUR FAMILY marks for fundraising services and charitable efforts.

IV. RECITATION OF THE FACTS

A. Nash Finch Is a Leading Wholesaler, Food Provider And Retailer In The Grocery Industry.

Petitioner Nash Finch, wholly owned by SpartanNash since 2014, is one the nation's largest grocery distributors, originally established in 1885 and incorporated in 1921. (28 TTABVUE 877 at Ex. 18.) Its core businesses include distributing grocery products to independent grocery retailers and distributing to and operating its own corporate-owned stores. (*Id.*; 39 TTABVUE 7-8 at Paul 7:23-8:5.) In its 2012 fiscal year, Nash Finch's revenues were approximately \$4.8 billion. (28 TTABVUE 877 at Ex. 18.)

Nash Finch's food distribution segment sells and distributes a wide variety of nationally branded and private label grocery store products from 11 distribution centers to approximately 1,500 independent retail locations and corporate-owned retail stores across the United States. (28 TTABVUE 878 at Ex. 18; 39 TTABVUE 9-10 at Paul¹ 9:3-10:7; *see generally* 38 TTABVUE 3044-3499 at Murphy Ex. 184.) Nash Finch purchases food and grocery products from various manufacturers, processors, and suppliers, as well as manufacturers' representatives and brokers. (28 TTABVUE 879 at Ex. 18.) Nash Finch sells and distributes these products to

¹ Mr. John Paul, a testimonial witness for Nash Finch, is the Vice President of Private Brands for SpartanNash, and is responsible for the OUR FAMILY brand at issue in this proceeding. (39 TTABVUE 7, 16 at Paul 7:6-18; 16:8-24.) Mr. Paul has been in the grocery business for 40 years (*id.* at 11 at Paul 11:14-16), and has been responsible for the OUR FAMILY brand for over 15 years (*id.* at Paul 11:5-13).

independent retail grocery stores or to its corporate-owned stores.² (28 TTABVUE 878 at Ex. 18.) The final purchasers of these products are consumers who purchase the groceries and other goods for themselves and their families. Nash Finch’s reputation reaches in two directions, up the supply chain to producers and their agents, and down the supply chain to retailers and consumers. Nash Finch sells both national brands and has a full range of its own private label brands so its retailer customers can offer consumers a wide range of products across a range of price points. The result is that people at all levels of the supply chain are familiar with Nash Finch and its brands.

B. Nash Finch’s OUR FAMILY Brand Is Widely Used, Heavily Promoted, Advertised And Supported.

1. The OUR FAMILY Brand Has Been Widely Distributed Since 1904.

A major portion of Nash Finch revenues is from private label products, generating hundreds of millions of dollars in revenues a year. (39 TTABVUE 395 at Paul 51.) The oldest and best known of these private labels is Nash Finch’s OUR FAMILY brand. (39 TTABVUE 394 at Paul 51.) The OUR FAMILY mark was used by Nash Finch as early as January 1904, and has been used continuously since that date. (*Id.*; 39 TTABVUE 18 at Paul 18:21-23.) OUR FAMILY products are high quality, equal to or better than national brand equivalents, *i.e.*, OUR FAMILY soup is better than Campbell’s soup, but at a lower price. (39 TTABVUE 23-25 at Paul 23:22-25:10.)

The OUR FAMILY brand is used on “virtually every category in a grocery store.” (39 TTABVUE 18 at Paul 18:24-12.) These products include dry grocery products from “soup to nuts”; perishable items, like dairy; frozen foods; nonedible products, like aluminum foil; paper goods and pet food; and fresh food, like meat and eggs. (*Id.* at 18-19 at Paul 18:24-19:12.)

² Not all retail grocery stores rely on distributors like Nash Finch to supply grocery products to their stores. Larger grocery store chains buy products directly from the same suppliers Nash Finch works with. (39 TTABVUE 10-11 at Paul 10:15-11:4.)

Products also include health and beauty care products. (39 TTABVUE 395-96 at Paul Ex. 51.)

The brand can be found throughout every aisle in a store supplied by Nash Finch. Nash Finch even puts the brand on reusable bags:



(38 TTABVUE 73 at Murphy 73:5-12; 36 TTABVUE 61 at Murphy Ex. 210.) Photographs of some OUR FAMILY products are shown at Paul Ex. 44. (39 TTABVUE at 22-23 at Paul 22:11-23:21.) The brand is always expanding, and today Nash Finch sells over 2,500 different OUR FAMILY products. (39 TTABVUE 19-20 at Paul 19:13-20:2; 39 TTABVUE 396 at Paul Ex. 51; *see generally* 38 TTABVUE 199-3499 (Murphy Exs. 183³ and 184).)

Nash Finch owns two trademark registrations for the OUR FAMILY word mark, and one pending, approved application for OUR FAMILY & Design:

- Reg. No. 369,014 for OUR FAMILY for canned fruits, canned vegetables, canned fruit juice for food purposes, canned corn, canned spaghetti, canned coconut, canned tuna fish, canned salmon, canned soup, canned pork and beans, noodles, spaghetti, macaroni, tea, spices, mustard, vinegar, catsup, cocoa, evaporated milk, olives, pickles, jam, apple butter, peanut butter, fruit preserves, marmalade, cane in Classes 29-32;
- Reg. No. 2,690,200 for OUR FAMILY for dishwashing detergent, laundry detergent, laundry bleach in Class 3; aluminum foil in Class 6; paper towels, paper napkins, bath tissue, facial tissue in class 16; paper plates in Class 21; meals consisting of meat, fish, or poultry in ready to cook portions, peanut butter, pickles, canned fruit, canned vegetables in Class 29; macaroni, noodles, spaghetti, rice, coffee, spaghetti sauce, tea, pretzels, nacho chips, cocoa, catsup, mustard in Class 30; pet food, unpopped popcorn in Class 31; vegetable juice; fruit juice; and fruit drink in Class 32; and

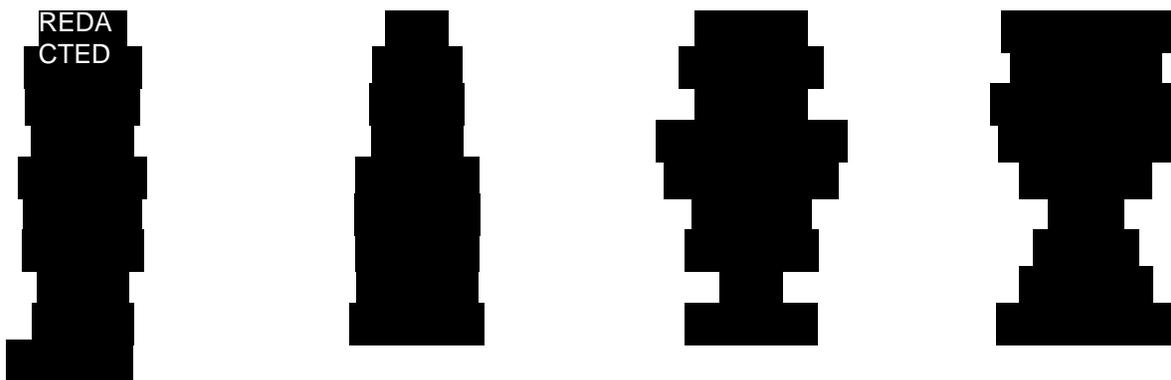
³ Exhibit 183 is a spreadsheet of item sales of OUR FAMILY products from 2008 through 2014 and Exhibit 184 is a spreadsheet of sales of OUR FAMILY product as sold to retail grocery stores. (38 TTABVUE 13-17 at Murphy 13:17-15 and 15:16-17:21)



- Ser. No. 85/905,473 for [redacted] for dishwashing detergent, laundry detergent, laundry bleach, bath and hand soap in Class 3; paper towels, paper napkins, toilet tissue, facial tissue in Class 16; paper plates in Class 21; frozen, prepared, and packaged meals consisting of meat, fish, or poultry in ready to cook portions, peanut butter, pickles, canned fruit, canned vegetables in Class 29; macaroni, noodles, spaghetti, rice, coffee, spaghetti sauce, tea, pretzels, nacho chips, cocoa, leaf tea, catsup, mustard un-popped popcorn in Class 30; pet food in Class 31; vegetable juice, bottled drinking water, fruit juice, and fruit drink in Class 32.

(39 TTABVUE 305-311 at Paul Ex. Murphy Ex. 183.)

The OUR FAMILY brand also has extensive geographic range, reaching grocery stores and consumers [redacted]:



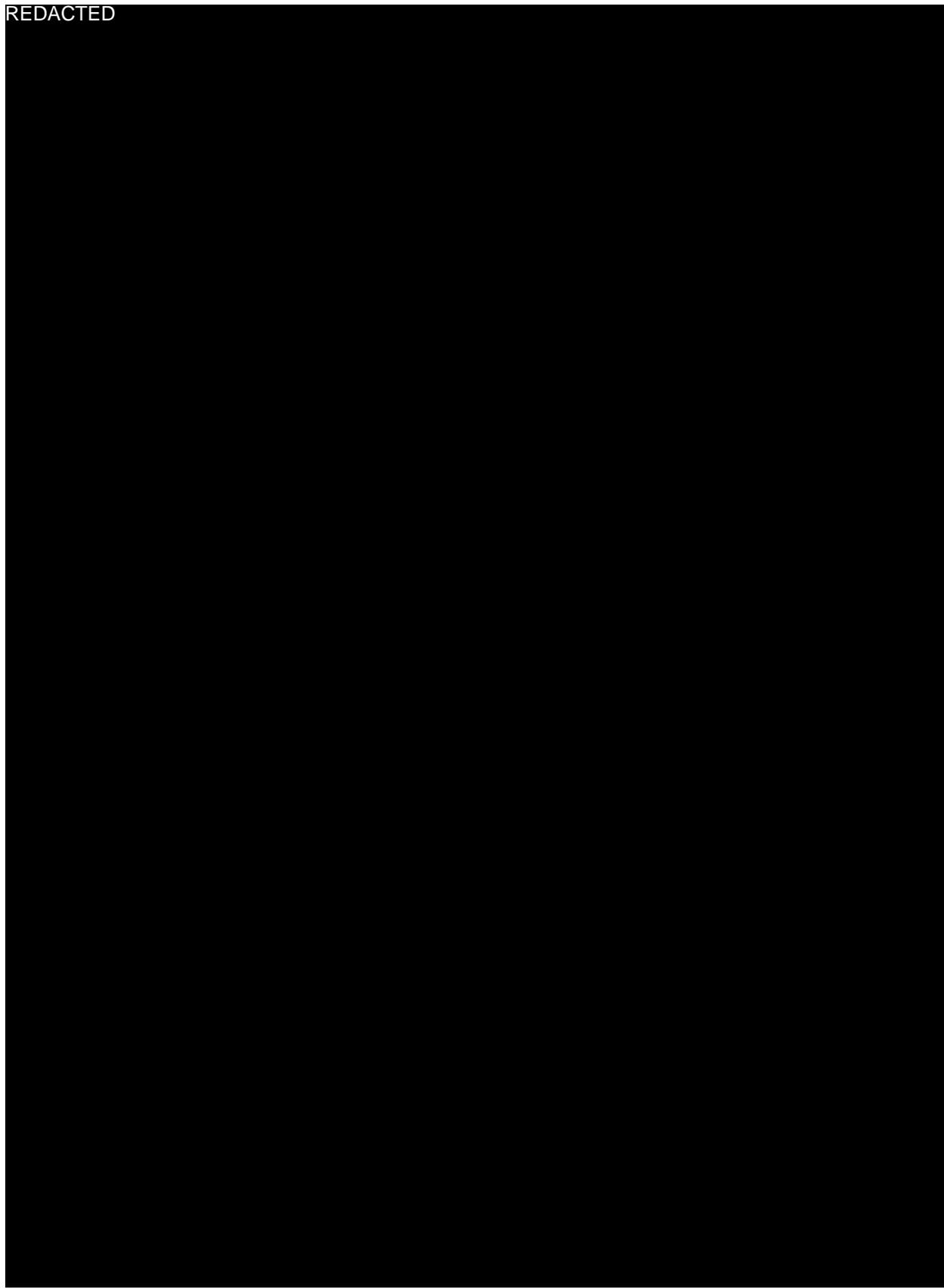
(See generally 38 TTABVUE 199-3043.) Nash Finch has 11 wholesale distribution centers, located in North Dakota, South Dakota, Nebraska, Minnesota, Indiana, Michigan, Ohio, West Virginia, North Carolina, and Georgia. (39 TTABVUE 9-10 at Paul 9:25-10:7.) The OUR FAMILY products do not contain the NASH FINCH name. (38 TTABVUE 23-24 at Murphy 23:25-24:18.)

2. Nash Finch Heavily Promotes The OUR FAMILY Products.

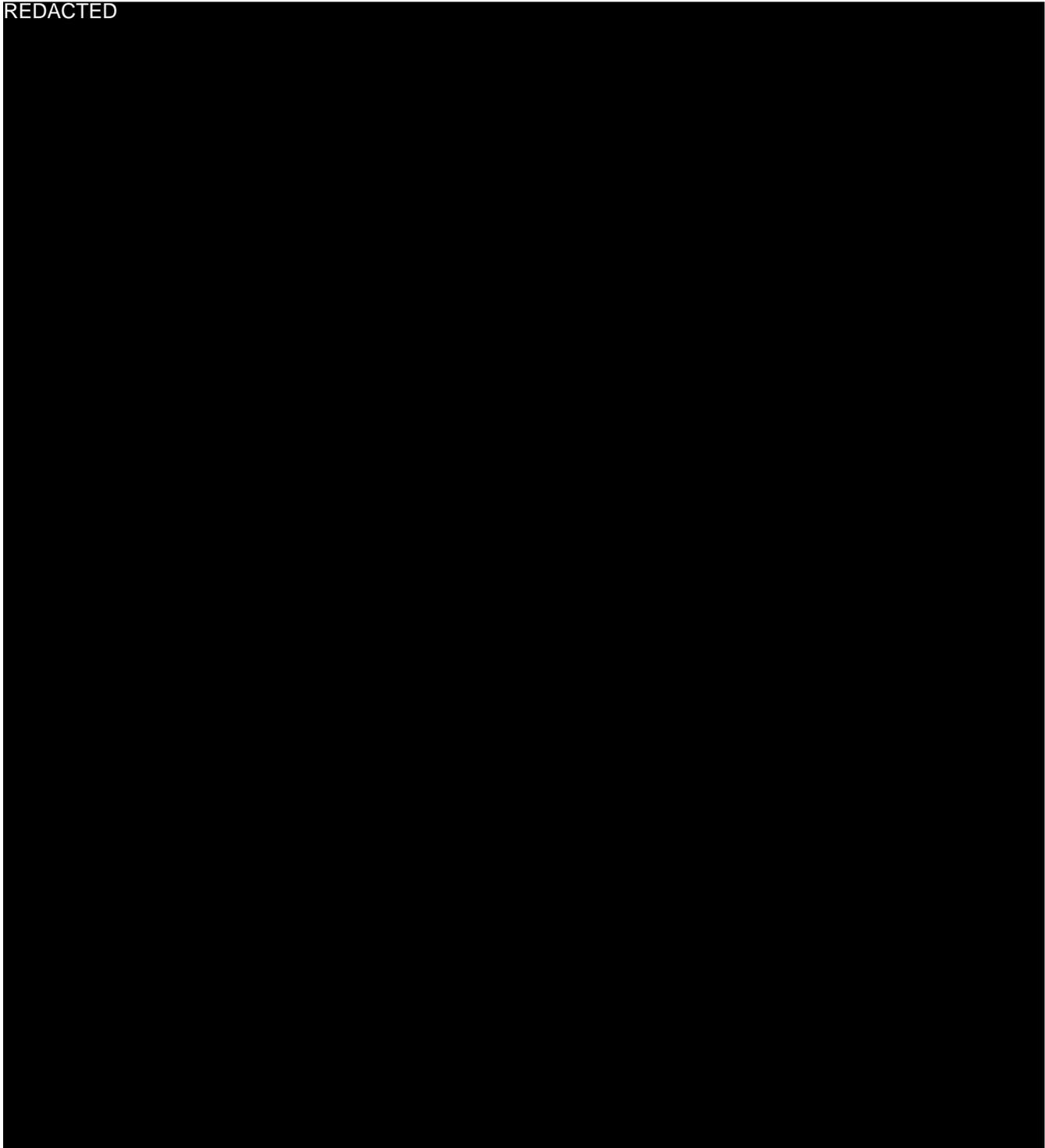
Nash Finch spends [redacted] each year promoting the brand in grocery retail stores and driving sales. Examples of these efforts include:

- [redacted]

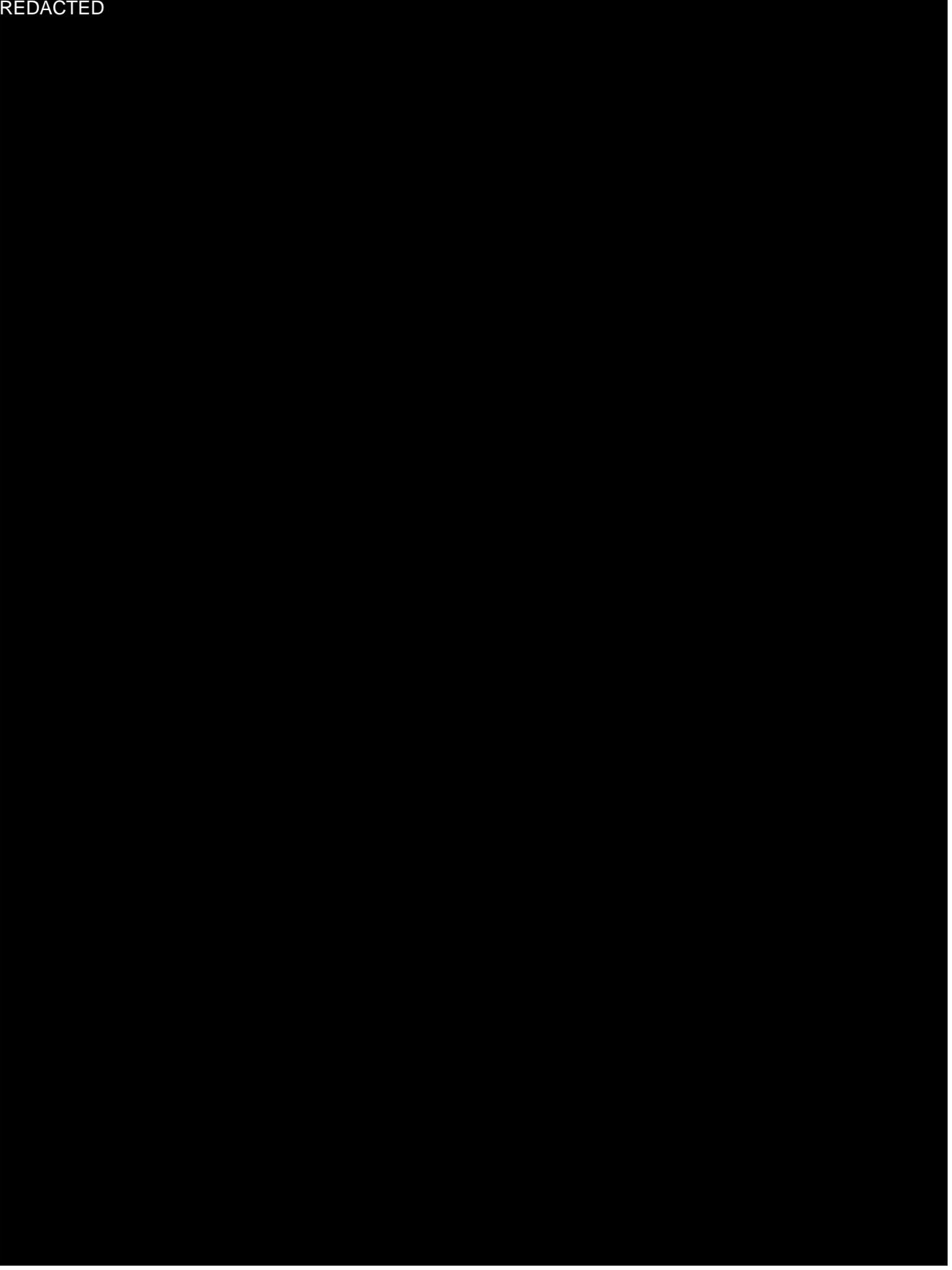
REDACTED



REDACTED



REDACTED



⁴ Exhibit 217 is the marketing budget for the OUR FAMILY brand for 2014, 2009 and 2008. (38 TTABVUE 81-82 at Murphy 81:18-82:17.)

REDACTED

(38 TTABVUE 44-47 at Murphy 44:13-47:17; *see generally* 38 TTABVUE 4177-4221 at Murphy Ex. 187; 35 TTABVUE 1-89 at Murphy Exs. 190-201.) These coordinated themes require a significant amount of effort, investment and expense.

3. Nash Finch Heavily Advertises The OUR FAMILY Brand.

Nash Finch advertises the OUR FAMILY brand to a broad, public audience. Nash Finch's internal documentation shows that Nash Finch spent nearly [REDACTED] from 2008 through 2013 advertising the OUR FAMILY brand. (38 TTABVUE 94-95, 99 at Murphy 94:11-95:12; 99:6-24; *see generally* 37 TTABVUE 15-96 at Murphy Exs. 223-224.) At least [REDACTED] of this expenditure was to advertise the OUR FAMILY brand and products. (38 TTABVUE 95 at Murphy 95:10-16.)

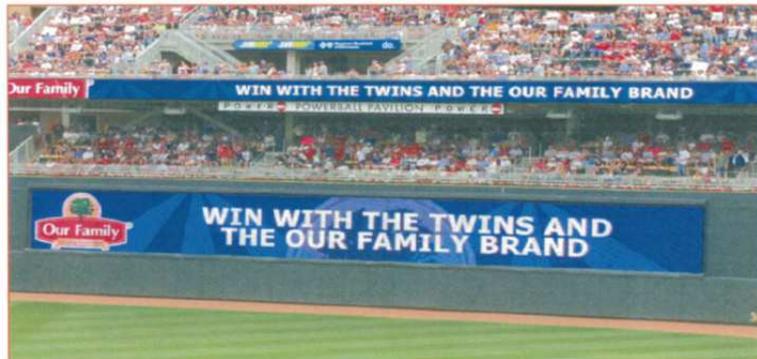
REDACTED

Nash Finch has spent [REDACTED] sponsoring sports teams with the OUR FAMILY brand, such as the Minnesota Twins of Major League Baseball, Minnesota Wild of the National Hockey League (40 TTABVUE 77-94 at Paul Ex. 133), and regional sports teams like the Ohio Valley arena football team and Omaha Royals (38 TTABVUE 85-87 at Murphy at 85:22-87:2; 37 TTABVUE 5-8 at Murphy Ex. 217). These sponsorships have greatly promoted the OUR FAMILY brand. For example, in return for OUR FAMILY sponsorship of

the Minnesota Twins since 2006 (*see* 39 TTABVUE 824-25, 40 TTABVUE 20-35, 50-71), Nash Finch receives the following benefits:

REDACTED

(40 TTABVUE 36-37 at Paul Ex. 120; 39 TTABVUE 118-126 at Paul 118:23-126:19; 38 TTABVUE 87 at Murphy 87:12-21.) The stadium signage is prominent:



(40 TTABVUE 52-71 at Paul Ex. 130.) Both the Twins and Wild markets include Minnesota, North Dakota, South Dakota, Wisconsin, Iowa, and Nebraska. (39 TTABVUE 142 at Paul 142:4-6.) The Twins ticket sweepstakes alone result in month over month increases of sales of OUR FAMILY products of [REDACTED] for Nash Finch owned stores and [REDACTED] for other retailers that carry OUR FAMILY products. (39 TTABVUE 125 at Paul 125:7-20.)

4. Nash Finch Invests In The OUR FAMILY Brand Through Corporate Support.

In addition to its significant expenditures through traditional advertising and promotion, Nash Finch has invested in the OUR FAMILY brand indirectly in ways that make the brand stronger. Historically, Nash Finch has employed a team of approximately [REDACTED] dedicated to developing, quality testing, selling and marketing the OUR FAMILY brand. (38 TTABVUE 9-10 at Murphy 9:23-10:17; 39 TTABVUE 25 at Paul 25:14-9.) The marketing team prepares materials for Nash Finch sales people to use to sell OUR FAMILY products to grocery stores, and also pieces for the general consuming public. These materials show retailers the OUR FAMILY brand is strong, and guaranteed to sell. (*See, e.g.*, 38 TTABVUE 4142-67 at Murphy Ex. 187; *id.* at 25-27 at Murphy 25:1-27:13.) The design team works on packaging, and their commercially effective product design and packaging has received a number of awards. (39 TTABVUE 406-23 at Paul Exs. 53-54; *id.* at 39-40 at Paul 39:1-40:3.)

The sales and marketing team also helps in the success of new retail grocery store customers. [REDACTED]

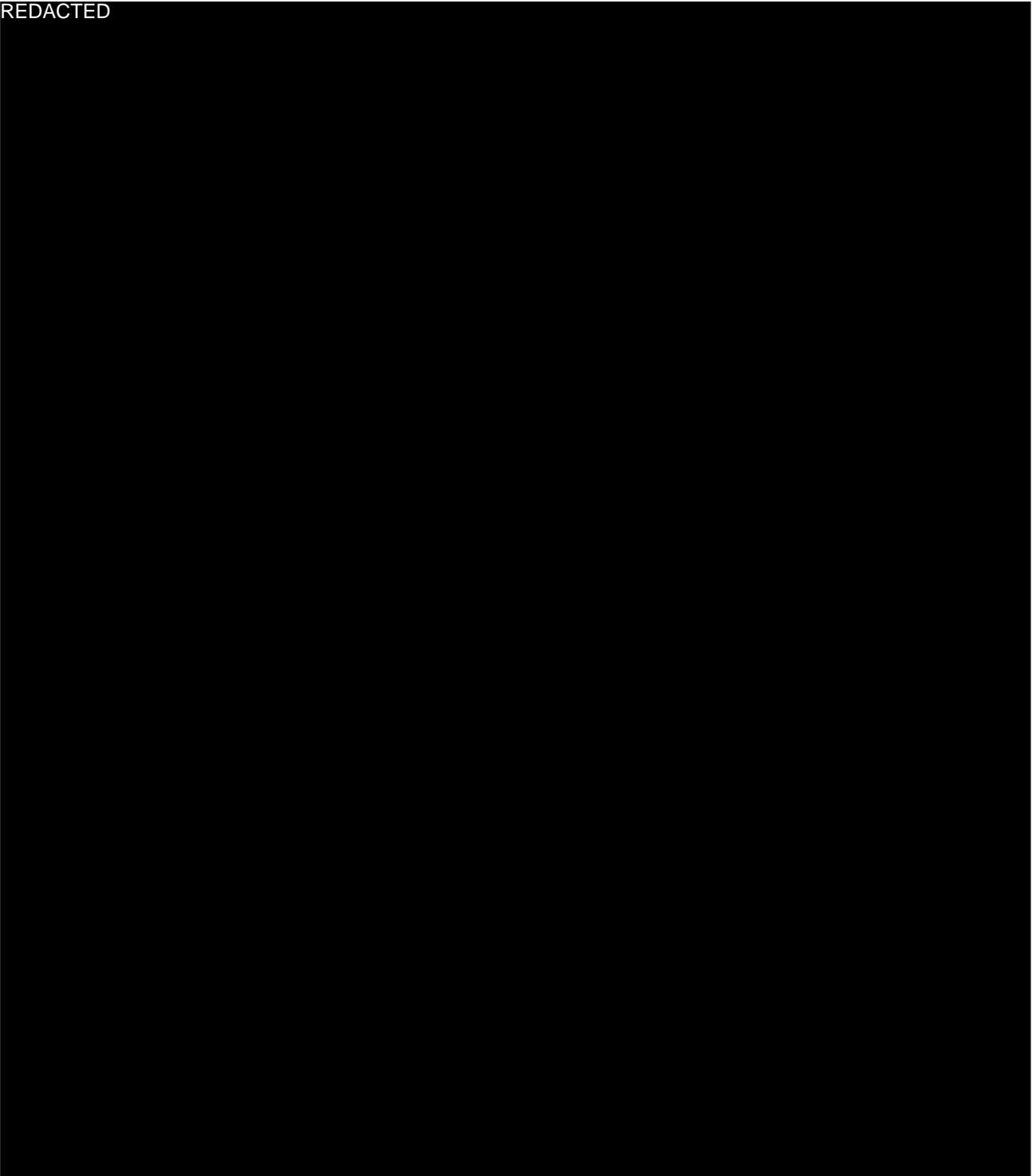
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

REDACTED



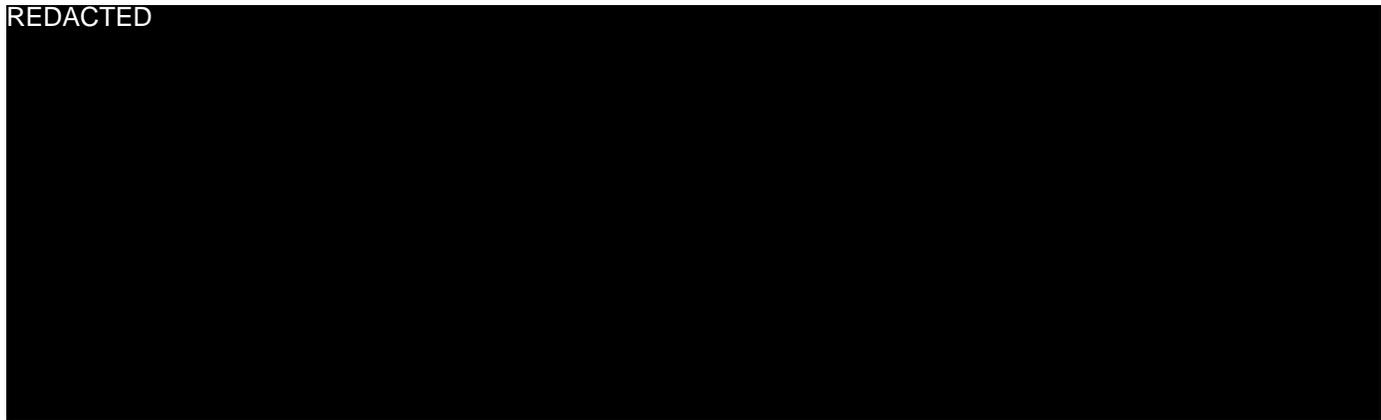
C. The OUR FAMILY Brand Is Strong And Well-Known.

Because of this advertising and promotion, as well as over a century of use, the OUR FAMILY brand has been successful and is well known. Sales exceeded **REDACTED** from 2008 to 2014. (*See generally* 38 TTABVUE 199-3043 at Murphy Ex. 183.) The brand is often featured in industry publications and receives awards, such as:

- June 2004 Private Label Buyer Magazine (39 TTABVUE 392-99 at Paul Ex. 51; *id.* at 36 at Paul 36:18-14)
- January 2005 SuperMarket News Magazine (*id.* at 400-405 at Paul Ex. 52; *id.* at 38 at Paul 38:1-15)
- Private Label Manufacturers' Association (PLMA) Salute to Excellence award (*id.* at 406-408 at Paul Ex. 53; *id.* at 33, 39 at Paul 33:2-25; 39:11-15)
- PL Buyer Packaging Awards (*id.* at 408 at Paul Ex. 53)
- 2013 Wholesaler of the Year Award (*id.* at 412 at Paul Ex. 54; *id.* at 40 at Paul 40:4-20)

Each of these magazines and recognitions targets individuals throughout the grocery industry, including retailers and wholesalers. (39 TTABVUE 36-38 at Paul 36:18-38:15.)

REDACTED



D. OUR FAMILY Products Are Made By Third Party Manufacturers That Make A Variety Of Food Products.

The OUR FAMILY brand is categorized as a “private label” brand. Private label products are those owned by wholesale distributors, such as Nash Finch, or by retail grocery stores, such as Ahold’s Giant, Stop & Shop and Martin’s grocery stores. (39 TTABVUE 13-14 at Paul 13:6-14:10.) “National” brands, on the other hand, are owned and proprietary to a

manufacturer, such as General Mills' CHEERIOS® brand cereal or Hershey's HERSHEY'S® brand chocolate. (*Id.* at 14 at Paul 14:2-10.) Many food manufacturers make both their own national brands and also manufacture the private label products owned by other companies and many retailers offer both so consumers can have a range of options at different price points.

REDACTED

REDACTED (*Id.* at 14-15 at Paul 14:11-15:5.) Exhibit 186 is a spreadsheet identifying more than REDACTED that make OUR FAMILY food for Nash Finch. (38 TTABVUE 20-23 at Murphy 20:24-23:24.) The list of these vendors is extensive, global, and includes such national brand producers REDACTED (38 TTABVUE 3985-4141 at Murphy Ex. 186); 39 TTABVUE 32-33 at Paul 32:22-33:1.)

Many manufacturers throughout the United States know about the OUR FAMILY brand.

REDACTED

E. OUR FAMILY Is Used In Connection With Fundraising And Charity Nationwide.

Like many large corporations, Nash Finch has significant charitable activities. It invests significant effort, money, and goodwill investing in the communities where it operates. Much of

Nash Finch’s charitable efforts are conducted under and using the OUR FAMILY mark. These activities generate additional goodwill for the OUR FAMILY brand, and are discussed below.

1. Nash Finch Fundraises And Donates To Nonprofits Through The OUR FAMILY Labels For Learning Program.

Primary among Nash Finch’s charitable efforts is the OUR FAMILY Labels for Learning program. The program, launched in 2005, is designed to help schools and churches earn funds for items such as athletic equipment, band uniforms, texts books, and teaching aids. (39 TTABVUE 88-89 at Paul 88:22-89:1; 39 TTABVUE 424 at Paul Ex. 20.) Schools collect product labels from OUR FAMILY products, and redeem them 500 or more at a time, for funds in the amount of \$0.05 for each label returned. (39 TTABVUE 88 at Paul 88:10-21; 39 TTABVUE 424 at Paul Ex 55.)

Nash Finch heavily promotes the program at grocery stores that carry OUR FAMILY product. REDACTED

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]



(39 TTABVUE 438-447 at Paul Ex. 58; 38 TTABVUE 39-41, 69-70 at Murphy 39:23-41:16, 69:2-70:24; 36 TTABVUE 59 at Murphy Ex. 208.)

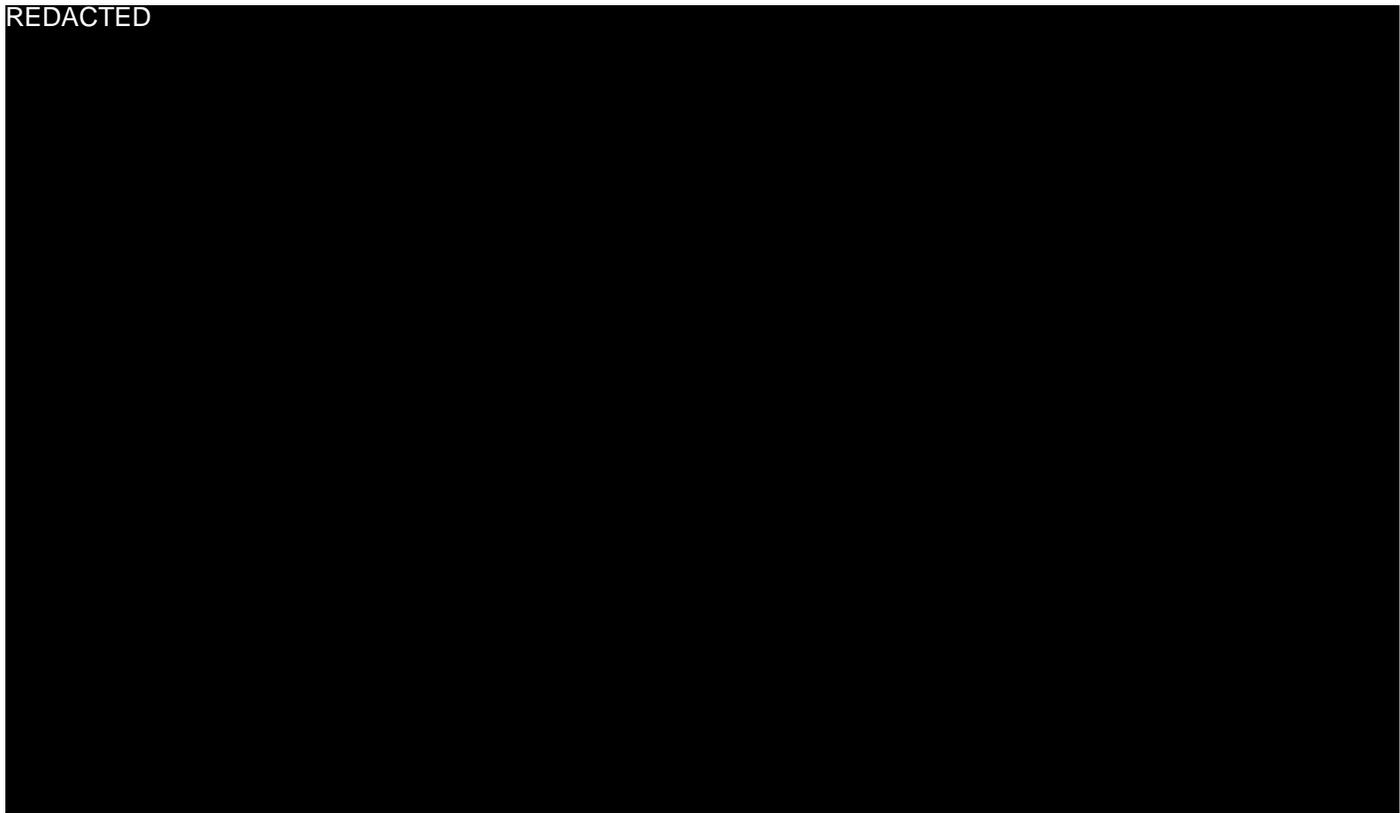
The OUR FAMILY Labels for Learning program is very successful. From 2006 through 2013, for instance, the program paid out more than REDACTED to participating schools, churches, and other organizations from the redemption of REDACTED (39 TTABVUE 90 at Paul 90:5-12; 39 TTABVUE 260 at Paul Ex. 5.) REDACTED

REDACTED

REDACTED

(39 TTABVUE 452-518 at Paul Exs. 63-65 and 179; 40 TTABVUE 323-330; 39 TTABVUE 107-112 at Paul 107:6-112:14.)

REDACTED



2. The OUR FAMILY Brand Is Used For Charitable Donations Nationwide.

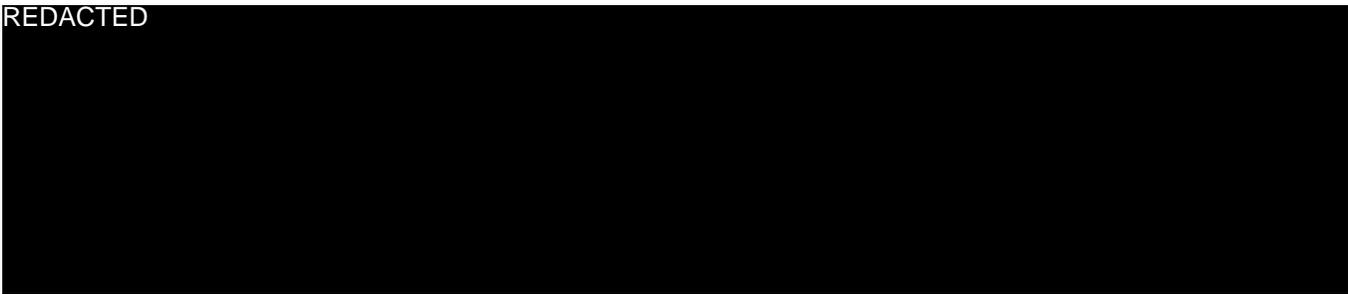
Nash Finch also generously donates OUR FAMILY food product to charitable causes throughout the country. As discussed by Mr. John Paul, the Vice President of Private Brands, OUR FAMILY product is routinely donated to food banks, to local community events where OUR FAMILY food is carried in grocery stores, to nationwide charitable organizations, and for disaster relief throughout the country. (39 TTABVUE 42-45, 62-63 at Paul 42:16-45:12, 62:12-63:2.) Each of Nash Finch's distribution centers in North Dakota, South Dakota, Nebraska, Minnesota, Indiana, Michigan, Ohio, West Virginia, North Carolina and Georgia also provide OUR FAMILY product donations. (39 TTABVUE 67-68, 71-72, 75 at Paul 67:17-68:24, 71:24-

72:15, 75:10-18.) These donations have been made nationwide by Nash Finch for decades. (39 TTABVUE 43-45 at Paul 43:13-45:12.)

Specific, documented examples of charitable donations of OUR FAMILY products include the following:

- Numerous food donations to Hope for the City, a Minnesota-based food bank (39 TTABVUE 561-618 at Paul Ex. 73; *id.* at 57-61 at Paul 57:8-61:17; 37 TTABVUE 203-04 at Docken 68:5-69:2), including 2 truckloads of OUR FAMILY food donated in 2009 (37 TTABVUE 374-75 at Docken Ex. 245; *id.* at 209-210 Docken 74:3-75:23)
- Monthly food and meal donations to Loaves and Fishes, a Minnesota-based food bank (39 TTABVUE 626-27 at Paul Ex. 75; *id.* at 63 at Paul 63:4-10; 37 TTABVUE 197-200 at Docken 62:21-65:15; 37 TTABVUE 365-70 at Docken Ex. 243)
- Donations to Boy Scouts of America (39 TTABVUE 618-25 at Paul Ex. 62)
- Donations to the United Way (39 TTABVUE 558-560, 771-782 at Paul Exs. 72 and 103; *id.* at 54-57 at Paul 54:19-57:7)
- Donations to Special Olympics events (39 TTABVUE 537-57 at Paul Ex. 71; *id.* at 49-51 Paul 49:9-51:17)
- Donations to local community and charity events (39 TTABVUE 628-97, 753-58, 792-97 at Paul Exs. 76-88; *id.* at 63-70, 83-85 at Paul 63:13-67:16, 68:25-70:21, 83:20-85:19)
- Donations to local food pantries at each distribution location (39 TTABVUE 702-03, 739-52, 798-806 at Paul Exs. 90, 97- 99, 106; *id.* at 72-75, 85-88 at Paul 72:16-74:24, 75:19-75:3, 85:20-88:2.)
- Relief for natural disasters throughout the nation, such as flooding in Minnesota, Kentucky and in New Orleans (39 TTABVUE 698-701, 759, 771-82 at Paul Exs. 89, 101, 103; *id.* at 71, 79-81 at Paul 71:15-22, 79:11-81:11; 37 TTABVUE 217 at Docken 82:11-24.)
- Nash Finch's Hunger Awareness Day in 2009 where 400 days of OUR FAMILY meals were delivered to local food pantries in Minnesota (37 TTABVUE 207-08 at Docken 72:11-73:25; 37 TTABVUE at 371-73 at Docken Ex. 244)
- Annual snack sponsor of the Walk to End Hunger at the Mall of America, attended by 5,000-10,000 people (37 TTABVUE 216-17 at Docken 81:1-82:10)

REDACTED



Nash Finch routinely requests public recognition of the OUR FAMILY brand for the donations, such as through signage and press mentions. (39 TTABVUE 46-47, 61-62 at Paul 46:24-47:13, 61:18-62:8; 39 TTABVUE 807.) By way of specific example, Minneapolis-based ABC and NBC television stations publicized the donation of 2 truckloads of OUR FAMILY food to Hope for the City. (37 TTABVUE 209-210 at Docken 74:19-75:23.)

3. Nash Finch's NFC Foundation Uses The OUR FAMILY Brand.

Like many other companies in the food industry, Nash Finch also operates a charitable foundation. This foundation is called the NFC Foundation, and the mission is to aid people with hunger and shelter needs throughout the communities where Nash Finch associates live and work. (37 TTABVUE 143 at Docken 8:10-20; 37 TTABVUE 261-289 at Docken Ex. 232.) Those communities include the upper Midwest and every location where there is a Nash Finch distribution center, including Virginia and Georgia. (37 TTABVUE 194-195 Docken 59:17-60:16.) The NFC Foundation organizes volunteer events, fundraises, and also provides grants to nonprofit organizations. (37 TTABVUE 146-49 at Docken 11:22-14:21.) OUR FAMILY food is also served at many of the volunteer or fundraising events. (37 TTABVUE 151 at Docken 16:6-23.)

As part of its charitable efforts, the NFC Foundation hosted a golf event for many years up to 2013, to which the Foundation invited vendor partners to play in exchange for a donation. (37 TTABVUE 328-29 at Docken Ex. 237.) The OUR FAMILY mark and brand was front and center at this event every year, including as hole signage (37 TABVUE at 261-289 at Docken Ex. 232), in raffle items (*id.* at 183 at Docken 48:16-25), and as refreshments.

Nash Finch solicits donations from its vendors and suppliers, including those who make OUR FAMILY products for Nash Finch. **REDACTED**

REDACTED

(37 TTABVUE 290-326 at Docken Exs. 233-236; *id.* at 156, 161-62, 164, 166 at Docken 21:17-23, 26:16-27:5, 29:2-29:12, 31:19-21.) Paula Docken, a member of the NFC Board of Directors and a member of the company's IT group (37 TTABVUE 140, 144 at Docken 5:14-23, 9:13-24), REDACTED

REDACTED These individuals are likely less familiar with Nash Finch than Nash Finch's contact.

F. Ahold's OUR FAMILY FOUNDATION Also Provides Fundraising And Charitable Services.

Registrant Ahold is also in the food industry. Ahold owns and operates retail grocery stores in the United States and abroad. (43 TTABVUE at Pawelski Dep. 7:17-21.) Ahold owns four grocery store chains: Stop & Shop New England, Stop & Shop New York Metro, Giant Landover and Giant Carlisle. (*Id.* at 7:25-8:5.) Stop & Shop operates in Massachusetts, Connecticut, Rhode Island, New Hampshire, New York, and New Jersey; Giant Landover operates in Maryland, Washington, D.C., Delaware and Virginia; Giant Carlisle operates in Pennsylvania, West Virginia, Maryland and Virginia. (*Id.* at 8:6-13.) Giant Carlisle also operates Martin's Food Markets in Pennsylvania, Maryland and West Virginia. (*Id.* at 8:14-21.)

Ahold also owns Peapod, which is an online grocery shopping and delivery service in Chicago and the Midwest. (30 TTABVUE 6-7 Ex. 11 at Pawelski 30(b)(6) 13:15-14:4.) REDACTED

1. Ahold Uses Its OUR FAMILY FOUNDATION Mark To Fundraise For Charity And To Donate Money To Charities.

Ahold began using the OUR FAMILY FOUNDATION mark in connection with charitable fundraising services in 2012 REDACTED

REDACTED (43 TTABVUE at Pawelski Dep. 10:12-18; 29 TTABVUE 447 at 4/28/2014 Resp. to Interrog. 1.) Registrant Ahold filed for registration of the OUR FAMILY FOUNDATION & Design and word mark in connection with “[c]haritable fundraising services” on February 21, 2012. (43 TTABVUE at Ahold Ex. 1.) The registered mark is as follows:



The description of the mark makes it clear the words OUR FAMILY FOUNDATION are a cornerstone of the registered mark:

The mark consists of the phrase “OUR FAMILY FOUNDATION” appears in black below a design of three houses. The house on the left is green with a white window, the house in the center is white with a red heart, and the house on the right is gold with a white window.

(*Id.*)

The Our Family Foundation fundraises money from three REDACTED

REDACTED (30 TTABVUE 51 Ex. 11 at Pawelski 30(b)(6) 72:13-25; 29
TTABVUE at Ex. 8 at 4/28/2014 Resp. to Interrog. 4.) REDACTED

REDACTED
REDACTED
REDACTED
REDACTED

**2. Ahold's Use Of Its OUR FAMILY FOUNDATION Mark Reaches
The Same Customers And Vendors As Nash Finch's OUR FAMILY
Mark.**

The Our Family Foundation, similar to the OUR FAMILY Labels for Learning program
and the NFC Foundation, raises funds in several different ways: REDACTED

REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED
REDACTED

REDACTED

REDACTED

(*Compare* 38 TTABVUE 3985-4141 Murphy Ex. 186 *with* 43 TTABVUE at Ahold Ex. 21.)

The Our Family Foundation organizes events that raise funds from the general public. One example is a sweepstakes game called the “Triple Winner” game. This Triple Winner game is played in the Stop & Shop and Giant Landover divisions. (43 TTABVUE at Pawelski Dep. 23:16-24:11.) Scratch-off tickets containing coupons and prizes are sold at the checkout counters in grocery stores, and the OUR FAMILY FOUNDATION name appears on the back of each ticket and in the game rules. (43 TTABVUE at Ahold Exs. 4-5, 12-13; 30 TTABVUE 25-27 at Pawelski 30(b)(6) 42:15-44:1.) Another event is a balloon/candle fundraiser, held in the Giant Carlisle division stores, where customer donations are made at the checkout for local hospitals. (30 TTABVUE 74-76 at Pawelski 30(b)(6) 109:19-111:7.)

3. The Our Family Foundation Promotes Its Mark At Several Public Events Throughout Each Year.

The Our Family Foundation has sponsored several events, with participants coming from all over the United States. (30 TTABVUE 394 at Ex. 12 at Hill 24:20-22.) As Nash Finch had done for many years prior, since 2012, the Our Family Foundation has sponsored the “Our Family Foundation Golf Outing” as a benefit for donors. (30 TTABVUE 46-47 at Ex. 11 at Pawelski 30(b)(6) 66:21-67:21.) Attendees receive promotional items bearing the OUR FAMILY FOUNDATION name, such as bags, hats, and mugs. (*Id.* at 49-50 at Pawelski 30(b)(6) 69:21-70:11.) An example is shown below:



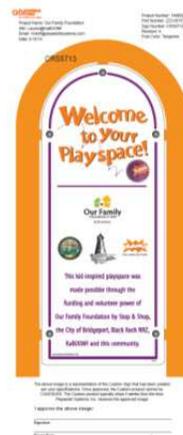
(43 TTABVUE at Ahold Ex. 8; *id.* at Pawelski Dep. 40:4-41:23.) The golf event is also publicized alongside the OUR FAMILY FOUNDATION mark on local television channels:



(30 TTABVUE 356-57 at Ex. 11 and 18; *id.* at 89-90 at Pawelski 30(b)(6) 129:17-130:25.)

In 2014, Our Family Foundation was a co-sponsor of a series of public concerts by the musician Hunter Hayes to raise awareness about child hunger. (30 TTABVUE 367-70 at Ex. 11 at Pawelski Ex. 24; *id.* at 102-04 at Pawelski 30(b)(6) 143:17-145:8.) The concerts were held on the East Coast with thousands of members of the general public in attendance. (*Id.*) Each concert venue displayed OUR FAMILY FOUNDATION signage. (*Id.*)

In 2015, the Our Family Foundation hosted a playground build with 500 volunteers in Bridgeport, Connecticut. (43 TTABVUE at Pawelski Dep. 37:11-22.) OUR FAMILY FOUNDATION signage was used at the event, and is on permanent signage at the playground:



(*Id.* at Ahold Ex. 11; *id.* at Pawelski Dep. 41:24-25, 44:17-45:25; *id.* at Ahold Ex. 9.)

4. Ahold Publicly Promotes The OUR FAMILY FOUNDATION Mark.

The Our Family Foundation is publicly promoted in a number of different ways. The OUR FAMILY FOUNDATION mark is present on signage and ads throughout all Ahold-owned grocery stores. For example, Our Family Foundation places a “thank you” stanchion sign outside of all grocery stores for two week periods during each year since 2012, similar to this sign:



(43 TTABVUE at Ahold Ex. 10; *id.* at Pawelski Dep. 43:1-44:16.)

The foundation also places “thank you” ads in weekly circulars distributed in Ahold grocery stores. The purpose of these circulars is to communicate with customers—the general public. (30 TTABVUE 40-41 at Pawelski 30(b)(6) 58:22-59:4.) For example, once a year, Our Family Foundation publishes an insert to be placed in a Giant Carlisle weekly circular featuring the Our Family Foundation and its support of the Gittlen Cancer Research Foundation:



(43 TTABVUE at Ahold Ex. 16.) **REDACTED**

REDACTED

REDACTED (43 TTABVUE at Ahold Ex. 15; *id.* at Pawelski Dep. 58:11-60:1, 71:6-74:2.)

Our Family Foundation also publishes other “thank you” advertisements in the Ahold grocery store weekly circulars several times a year:



AHOLD-00344

(43 TTABVUE at Ahold Ex. 19.) **REDACTED**

REDACTED

REDACTED

(*id.* at Ahold Ex. 18; *id.* at Pawelski Dep. 52:10-58:10, 62:8-70:18.) REDACTED

REDACTED

REDACTED (*id.* at Ahold Ex. 18.) The name “Ahold” was not on these ads.

REDACTED

REDACTED (30 TTABVUE Pawelski 30(b)(6) 86:15-88:12.) REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

The Our Family Foundation is promoted on local television stations, such as Fox 43 in Pennsylvania, which runs programs about the Our Family Foundation and their charitable activities. (30 TTABVUE 85 at Pawelski 30(b)(6) 121:4-17; 30 TTABVUE 356-57 at Pawelski Ex. 18.) Further, the divisions and charities receiving money routinely issue public press releases promoting the Our Family Foundation. (30 TTABVUE 358-75 at Pawelski Exs. 19-25.) News articles about Our Family Foundation have been run by a CBS outlet in Texas, Progressive Grocer; Retailing Today, Long Island News, Business Wire, Boston.com, and The Shelby Report. (*Id.*; *see also* 30 TTABVUE 906-80 at Ex. 14.) As shown in these examples, the use of the OUR FAMILY FOUNDATION mark is often without the Ahold, Giant, Stop & Shop or Martin’s names.

V. ARGUMENT

A. **Nash Finch Has Priority To Use The OUR FAMILY Mark In Connection With Food, Fundraising And Charitable Services.**

Nash Finch's priority is undisputed, and not at issue because Nash Finch owns federal, incontestable registrations for the OUR FAMILY mark. Ahold filed its application for the OUR FAMILY FOUNDATION mark for charitable fundraising services on February 21, 2012, and claims that it first used the OUR FAMILY FOUNDATION mark in commerce in 2012. Nash Finch first used the OUR FAMILY mark on food and grocery products in 1904, and has continuously used the mark since that time. (39 TTABVue 305-311 at Paul Exs. 41-43; *id.* at 18 at Paul 18:21-23.) Nash Finch's rights pre-date Ahold by 108 years. Nash Finch's incontestable registrations were issued in 1939 and 2002, respectively. (29 TTABVue 65-358 at Exs. 2-4.) Nash Finch's registrations foreclose any challenge based on priority. Nash Finch's use and registration of its marks establish its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (C.C.P.A. 1982).

Nash Finch also has priority of use of OUR FAMILY in connection with charitable fundraising services based on common law use. A party may prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark where the mark is distinctive, inherently or otherwise, and the party can show priority of use based on prior trademark use. *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); *see also* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:1 (4th ed. 2013) (priority is shown by actual use in commerce). Priority based on common law rights must be proved by competent evidence. *Research in Motion Limited v. Defining Presence Marking Grp. Inc.*, 102 USPQ2d 1187, 1195 (TTAB 2012).

Here, Nash Finch used OUR FAMILY for fundraising services since at least as early as 2005, when it launched the OUR FAMILY Labels of Learning Program. (39 TTABVUE 88-89 at Paul 88:22-89:1.) Through this program, Nash Finch solicits donations from its nationwide vendors and distributes money to schools, churches and other nonprofit organizations **REDACTED** (39 TTABVUE 88, 91-92 at Paul 88:10-21, 91:12-92:3.) Nash Finch advertises the OUR FAMILY Labels for Learning program to consumers using the OUR FAMILY mark through all grocery retailers that stock OUR FAMILY. (39 TTABVUE 339, 424-28, 431-47, 534-36 at Paul Exs. 48, 55, 57, 58, and 70.) Recipients are across the United States. (39 TTABVUE 452-518; 40 TTABVUE 323-330.) **REDACTED**

REDACTED (39 TTABVUE 522-24, 534-36 at Paul Exs. 67 and 70; 40 TTABVUE 323-330 at Paul Ex. 179; 38 TTABVUE 3985-4141 at Murphy Ex. 186; 39 TTABVUE 113-117 at Paul 113:12-117:15.)

Nash Finch uses the OUR FAMILY brand for charitable donations of OUR FAMILY food to food banks, charities, non-profits, local community events and disaster relief for years, and well before Ahold's 2012 filing date. *Supra* at Section IV(E)(2). These donations are made nationwide, and the OUR FAMILY brand is often featured alongside the product donations. *Id.*

Nash Finch used the OUR FAMILY brand for decades in connection with Nash Finch's own NFC Foundation that raises money from product vendors and donates money to charitable causes. **REDACTED**

REDACTED (37 TTABVUE 290-326 at Docken Exs. 233-236; *id.* at 156, 161-62, 164, 166 at Docken 21:17-23, 26:16-27:5, 29:2-12; 31:19-21.) NFC Foundation uses the

OUR FAMILY mark at events, both as signage and for food served. (37 TTABVUE 151 at Docken 16:6-23; 37 TABVUE at 261-289 at Docken Exs. 232.) The OUR FAMILY registration for closely related food products and services, and the actual use of the OUR FAMILY mark in connection with charitable fundraising are sufficient to provide Nash Finch with priority over the OUR FAMILY mark overall and specifically for charitable fundraising services.

B. Vendors And Customers Are Likely To Be Confused By Ahold’s Use Of Its OUR FAMILY FOUNDATION Mark.

Likelihood of confusion is decided on the facts of each case. *In re Dixie Rests., Inc.*, 105 F.3d 1405 (Fed. Cir. 1997); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Likelihood of confusion is based on an analysis of the probative facts in evidence relevant to the familiar factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 537 (C.C.P.A. 1973). “The likelihood of confusion analysis considers all *DuPont* factors for which there is evidence of record but ‘may focus . . . on dispositive factors, such as similarity of the marks and the relatedness of the goods.’” *Hewlett-Packard*, 62 USPQ2d at 1003 (citations omitted). The *DuPont* factors most relevant to this case include:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
- (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs careful, sophisticated purchasing;
- (5) the fame of the prior mark (sales, advertising, length of use);
- (6) the number and nature of similar marks in use on similar goods;
- (7) the nature and extent of any actual confusion;
- (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion;

- (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark);
- (10) the market interface between registrant and the owner of a prior mark; and
- (11) the extent of which registrant has a right to exclude others from use of its mark on its goods.

E.I. du Pont, 476 F.2d 1357. Nash Finch addresses each of these factors below.

1. Nash Finch’s OUR FAMILY Mark is Extremely Strong And Famous.

The strength of a mark plays a dominant role in likelihood of confusion cases featuring a famous or strong mark. *Bose Corp. v. QSC Audio Prods, Inc.*, 293 F.3d 1367, 1371, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot*, 214 F.3d at 1327-28, 54 USPQ2d at 1897 (“[W]e hold that the fame of the mark must always be accorded full weight when determining the likelihood of confusion.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992); *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (“[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark.”); *ProQuest Information & Learning Co. v. Island*, 83 USPQ2d 1351, 1358 (TTAB 2007) (INQUEST likely to cause confusion with PROQUEST; fame of Opposer’s mark plays “dominant role”); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1622 (TTAB 1989) (“[T]he propensity of consumers to associate a relatively unknown mark with one which is well known to them increases the likelihood of confusion, mistake or deception.”). A mark’s strength may be measured by direct evidence such as consumer polls, or indirect evidence, including sales, advertising volume, and length of time in use. *Bose Corp.*, 63 USPQ2d at 1305-06.

As explained above in Section IV(B), the evidence shows the OUR FAMILY mark is strong and well-known. The mark has been in use for over 110 years, since 1904, REDACTED

REDACTED (39 TTABVUE 18 at Paul 18:21-23; 38 TTABVUE 199-3043 at Murphy Ex. 183.) Sales from 2008-2014 exceed REDACTED (38 TTABVUE 199-3043 at Murphy Ex. 183.) REDACTED

REDACTED (39 TTABVUE 343-91, 395, 412 at Paul Exs. 50, 51 and 54.) The brand has won awards and been featured in numerous industry publications. *Supra* at p. 16.

Nash Finch extensively promotes the sale of OUR FAMILY products in grocery stores, through use of coupons, weekly advertising circulars, in store signage, themed promotions, displays, and support of retailer-specific promotional activities. *Supra* at pp. 7-12. REDACTED

REDACTED

REDACTED

REDACTED (38 TTABVUE 43, 53, 120-121 at Murphy 43:2-8, 53:12-19, 120:21-121:7; 36 TTABVUE 51-53, 59, 62-63 at Murphy Exs. 205, 208, 211, 217.)

Nash Finch spent nearly REDACTED on advertising OUR FAMILY to the general public from 2008-2013. (37 TTABVUE 52-96 at Murphy Ex. 224.) These efforts include in store demonstrations, billboards, radio advertisements, television commercials, advertisements in magazine, and sports sponsorships. *Supra* at pp. 12-13. Nash Finch's sponsorship of the Minnesota Twins major league baseball team since 2006, for example, has resulted in significant brand exposure both at the stadium, on radio, television and throughout the Twins territory. *Supra* at pp. 12-14. The impact of this promotion is proven by the uptick in sales of OUR FAMILY wherever a ticket giveaway sweepstakes is held—REDACTED

REDACTED at the time the sweepstakes are run. (39 TTABVUE 125 at Paul 125:7-20.)

Nash Finch has also strengthened the brand through non-advertising development activities. REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED *See also, supra* at Section IV(B)(4). This effort shows retail grocery stores that the brand is supported by Nash Finch and profitable. Based on this evidence, the OUR FAMILY mark is strong, entitled to a wide zone of enforcement. This *DuPont* factor weighs heavily in favor of Nash Finch.

2. The OUR FAMILY Brand Is Used Across A Wide Range Of Products And Services.

Not only is the OUR FAMILY brand strong, but it is used across a wide range of goods and services. Nash Finch presently uses the OUR FAMILY brand across a product line of 2,500 items, and the brand is always expanding. (39 TTABVUE 19-20 at Paul 19:13-20:2; 39 TTABVUE 396; 38 TTABVUE 199-3500 at (Murphy Exs. 183⁵ and 184).) Consumers see OUR FAMILY products in every aisle of the grocery store, from dry grocery products to dairy, frozen foods, paper goods, and fresh foods. (39 TTABVUE 18-19 at Paul 18:24-19:12.) Nash Finch consistently uses the brand for fundraising, donations and other charitable services. Consumers and vendors, accustomed to seeing Nash Finch use OUR FAMILY to identify a broad range of goods and services, would not be surprised to see Nash Finch name a foundation OUR FAMILY FOUNDATION. *Edgecraft Corp. v. Smith's Consumer Prods., Inc.*, Cancellation Nos. 92052940, 92054092, 92054104, 2013 TTAB LEXIS 371, at *41, 44-45

⁵ Exhibit 183 is a spreadsheet of item sales of OUR FAMILY products from 2008 through 2014 and Exhibit 184 is a spreadsheet of sales of OUR FAMILY product as sold by retail grocery stores. (38 TTABVUE 13, 15-17 at Murphy 13:17-15 and 15:16-17:21)

(TTAB July 12, 2013) (finding confusion more likely where a customer would expect to find a category of goods or services under a certain mark).

3. Ahold's OUR FAMILY FOUNDATION & Design Mark Is Identical To Nash Finch's Strong OUR FAMILY Mark.

Ahold's OUR FAMILY FOUNDATION & Design mark and Nash Finch's OUR FAMILY mark are nearly identical in appearance, sound, connotation, and commercial impression. *See Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014). In analyzing the similarity or dissimilarity of the marks, the test is not whether the marks can be distinguished when subject to side-by-side comparison, but rather whether the marks are sufficiently similar in terms of overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (C.C.P.A. 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd*, No. 9201086 (Fed. Cir. June 5, 1992). In making this determination, the factfinder must consider the recollection of the average purchaser who normally retains only a general, rather than a specific, impression of the marks. *Spoon Rests.*, 23 USPQ2d at 1741; *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Here, the parties' marks are substantially identical. The only difference between Nash Finch's registered OUR FAMILY word mark and Ahold's OUR FAMILY FOUNDATION word mark is the word "foundation," which is disclaimed. (43 TTABVUE at Pawelski Ex. 1.) Portions of marks that are disclaimed during registration receive less consideration in likelihood of confusion analysis, particularly where the disclaimed portion is not a dominant part of the

registered mark. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1329, 98 USPQ2d 1253 (Fed. Cir. 2011). The dominant portions of the marks are the same.

Although Ahold's registered mark appears in stylized text and includes design elements, these elements do not dispel the likelihood of confusion. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). A mark presented in stylized characters and with a design element generally will not avoid a likelihood of confusion with a word mark because the marks could be presented in the same manner of display. *See, e.g., In re Viterra Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not viable where one party asserts rights in no particular display").

Here, Nash Finch owns registrations for OUR FAMILY as word marks, without stylization. (29 TTABVUE 65-358 at Exs. 2-3.) Its rights extend to all types of stylizations of the OUR FAMILY mark, and Nash Finch routinely updates its design of the OUR FAMILY mark to keep it fresh and current. (39 TTABVUE 308-311 at Paul Ex. 43; *id.* at 20-22 at Paul 20:3-22:10.) Ahold's registration describes its own mark as "consisting of the phrase OUR FAMILY FOUNDATION," and the words OUR FAMILY **are not** disclaimed. (43 TTABVUE at Ahold Ex. 1.) In this case, the marks should legally be considered visually nearly identical.

Further, for a composite mark containing both words and a design, the word portion is often what is impressed in consumers' memory. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often the dominant feature and is accorded greater weight in the confusion analysis, particularly where the words, such as OUR FAMILY, have not been

disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Consistent with this law, Ahold's stylization enhances the likelihood of confusion because it incorporates images of houses and a heart, elements regularly associated with family. This design emphasizes the mark is OUR FAMILY:



The marks also sound alike, only differing in the disclaimed word “foundation.” The marks also have similar connotation. “Our Family” has the same connotation regardless of the use of the term “foundation” following it, and, regardless, the “foundation” portion of OUR FAMILY FOUNDATION has been disclaimed. Again, the design elements of houses and a heart in Ahold's design mark only emphasize the commercial impression is OUR FAMILY. The marks thus have an identical meaning.

Even though the marks here are highly similar, the degree of similarity needed to cause a likelihood of confusion is relatively low in this case because the parties are in the same industry, using the same marks on the same or highly related goods and services. In such a situation, the degree of similarity of the marks necessary to support a conclusion of likely confusion declines. *Fossil Inc. v. Fossil Grp.*, 49 USPQ2d 1451, 1456 (TTAB 1998) (quoting *Century 21*, 970 F.2d at 877, 23 USPQ2d at 1700); accord *Schering-Plough HealthCare Prods. Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007); *Jansem Enters., Inc. v. Rind.*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Centraz Indus., Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1700 (TTAB 2006). The similarities between the marks OUR FAMILY and OUR FAMILY FOUNDATION

weigh heavily in favor of a likelihood of confusion. This *DuPont* factor strongly favors Nash Finch.

4. Ahold's OUR FAMILY FOUNDATION Services Are Identical And Highly Related To Nash Finch's OUR FAMILY Goods And Services.

Similarity of goods and services is analyzed based on the description of the services stated in the registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2012) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1999)). Unrestricted and broad identifications are presumed to encompass all services of the type described, and to target all consumers. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992). Services need not be identical to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot*, 214 F.3d at 1329; TMEP § 1207.01(a)(i). The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [is] such that they could give rise to the mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Weshsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP § 1207.01(a)(i).

Here, Ahold's registration is for charitable fundraising services. (43 TTABVUE at Ahold Ex. 1.) Nash Finch was the first to use its OUR FAMILY mark in connection with a variety of charitable fundraising services, particularly for the OUR FAMILY Labels for Learning program, and has done so since at least as early as 2005. *Supra* at p. 18. Nash Finch's www.ourfamilyfoods.com website describes the program:



(30 TTABVUE 585 at Ex. 13.)

In this program, OUR FAMILY food labels are collected to raise money for schools. Participants turn the labels in to Nash Finch, who then pays the participating school or nonprofit \$0.05 per label, or \$25.00 for 500 labels. (*Id.*) REDACTED

REDACTED
REDACTED to
Ahold's first use and registration of its OUR FAMILY mark. *Supra* at p. 19.

For decades, Nash Finch has routinely used the OUR FAMILY brand for donations across the United States of OUR FAMILY food products to those in need. *Supra* at pp. 19-21. Nash Finch also uses the OUR FAMILY mark in connection with fundraising services for its own foundation, the NFC Foundation, including as signage, prizes and refreshments. *Supra* at pp. 21-22. The services under the parties' marks are the same.

In this case, Ahold's charitable fundraising services are also highly similar, and related, to Nash Finch's use of OUR FAMILY on grocery products. The relatedness is demonstrated by both parties' distribution of reusable bags bearing the OUR FAMILY marks:



(38 TTABVUE 73 at Murphy 73:5-12; 36 TTABVUE 61 at Murphy Ex. 210; 43 TTABVUE at Ahold Ex. 8; *id.* at Pawelski Dep. 40:4-41.23.)

Further, evidence of the same entities commonly providing the same goods or services demonstrates the relatedness of goods. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009). Both parties are in the grocery business. (43 TTABVUE at Pawelski Dep. 7:17-21; 39 TTABVUE 7-8 at Paul 7:23-8:5.) It is common for companies in the grocery business to not only sell food, but provide charitable services as well. Several news articles in evidence discuss grocery companies offering both. (30 TTABVUE 358-75, 906-80;; 39 TTABVUE 392-405, 409-23.) In the grocery business, many companies use the same trademarks on food and fundraising or charitable services. Examples include:

- HERSHEY'S KISSES and HERSHEY'S KISSMOBILE
- KELLOGG'S and KELLOGG FOUNDATION
- NEWMAN'S OWN, NO! NEWMAN'S OWN FOUNDATION and NEWMAN'S OWN ALL PROFITS TO CHARITY
- BREAKFAST OF CHAMPIONS
- CHILD HUNGER ENDS HERE

(30 TTABVUE 981-1162 at (Exs. 15 and 16⁶.) People often purchase food and are asked for donations at the checkout. REDACTED

REDACTED (30 TTABVUE 25-27 at Pawelski Ex. 11, 74-76 at Pawelski 30(b)(6) 42:15-44:1, 109:19-111:7.) For these reasons, charitable fundraising services offered by a food company are related to food products.

5. The Parties Market Their Identical Goods And Services Through Identical Trade Channels.

Because there are no trade channel restrictions in Ahold’s registration, it is presumed that the OUR FAMILY FOUNDATION services will be offered through normal channels of trade.

Octocom Sys., Inc. v. Houston Computer Servs., Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Nike, Inc. v. WNBA Enters., LLC*, 85 USPQ2d 1187, 1195 (TTAB 2007).

Where the parties are offering similar goods or services, they are presumed to travel in the same channels of trade to the same class of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). Here, Ahold’s channels of trade for OUR FAMILY FOUNDATION are presumed to be the same as Nash Finch’s OUR FAMILY food products. *Id.* This factor automatically weighs in favor of Nash Finch.

Further, Nash Finch has proven the parties’ channels of trade for charitable services, and food products, do in fact overlap. REDACTED

REDACTED

REDACTED

REDACTED

⁶ Evidence obtained from the Internet may be used to support a determination under Trademark Act Section 2(d) that goods and/or services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

REDACTED

REDACTED

REDACTED

REDACTED (38

TTABVUE 3985-4141 at Murphy Ex. 186; 43 TTABVUE at Ahold Ex. 21.)

Both parties market their OUR FAMILY goods and services to the general public. The Our Family Foundation receives donations from members of the general public through the Triple Winner game and Candle and Balloon Fundraiser. *Supra* at p. 24. Ahold places freestanding signs that promote OUR FAMILY FOUNDATION in its stores. REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

Ahold promotes the OUR FAMILY FOUNDATION direct to consumers by placing signage at public events, such as concerts with Hunter Hayes, a popular recording artist, and a playground build in Connecticut in 2015. (30 TTABVUE 367-70 at Exs. 11 and 24; 43 TTABVUE at Pawelski Dep. 37:11-22.) The Our Family Foundation has been promoted in a number of news articles and television spots. (30 TTABVUE 85 at Pawelski 30(b)(6) 121:4-17; 30 TTABVUE 158-162, 358-75, 906-80 at Exs. 11, 19-25.)

Nash Finch also advertises its fundraising, charitable services and grocery products to the general public. Nash Finch publicly promotes the OUR FAMILY Labels for Learning program in public advertising, like billboards, promotions in grocery stores, and weekly ads distributed to

⁷ REDACTED

REDACTED

customers. *Supra* Section IV(E)(1). As a result, Nash Finch has received REDACTED

REDACTED (39

TTABVUE 90 at Paul 90:5-12; 39 TTABVUE 260 at Paul Ex. 5.) When donating OUR FAMILY goods to charitable causes or non-profit events, Nash Finch consistently requests mention of the OUR FAMILY brand either by signage or press mentions. (39 TTABVUE 46-47, 61-62 at Paul 46:24-47:13, 61:18-62:8; 39 TTABVUE 807 at Paul Ex. 107.) Nash Finch has spent over REDACTED in publicly advertising it's OUR FAMILY brand from 2008-2014 on such things as REDACTED

REDACTED

REDACTED *Supra* Section IV(B)(1)-(2). As a result, Nash Finch has sold over REDACTED in OUR FAMILY products from 2008-2014 in 38 states. (38 TTABVUE 199-3043.)

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED Even without the presumption, the evidence demonstrates that the parties fundraise through the same trade channels.

6. Ahold And Nash Finch Have Market Interface In The Ever Changing Food Industry.

The overlap between the core corporate businesses of the parties also weighs in favor of finding a likelihood of confusion. *Edgecraft Corp.*, 2013 TTAB LEXIS 371, at *41, 44-45. Both parties sell grocery products to general customers, and are large players in the grocery

industry. As discussed directly above, the parties' public use of OUR FAMILY overlaps in several states, and even in the same towns. REDACTED

REDACTED (Compare 38 TTABVUE 3985-4141 with 43 TTABVUE at Ahold Ex. 21.) Both the OUR FAMILY brand and the OUR FAMILY FOUNDATION mark appear in industry magazines. (39 TTABVUE 392-405, 409-23 at Paul Exs. 51-52, 54; 27 TTABVUE at Ex. 14.) There is market interface today.

In the future, there will be more overlap. REDACTED

REDACTED

REDACTED

REDACTED

The food industry in general is in a period of consolidation. Mergers and acquisitions happen often. Both players in the food industry and general consumers are accustomed to seeing changes in the food industry. (39 TTABVUE 12-13 at Paul 12:19-13:4.) It would not be surprising in these circumstances for consumers to expect to see a private label brand like OUR FAMILY show up in a new store and believe that this is confirmed by seeing reference to OUR FAMILY FOUNDATION. The frequent instances in which both the Ahold and Nash Finch appear in close proximity, and the ever-changing grocery industry dictates that this factor weighs in favor of finding confusion is likely and in favor of cancellation.

7. The Conditions Of Fundraising And Purchase Of Food Products Indicate Confusion Is Likely.

The next relevant *DuPont* factor considers the conditions under which and buyers to whom sales are made. The discernment exercised by a reasonably prudent purchaser varies with the circumstances. *7-Eleven, Inc. v. Lawrence I. Weschler*, 83 USPQ2d 1715 (TTAB 2007).

REDACTED

REDACTED

Moreover, Nash Finch's OUR FAMILY food products are sold at relatively low price points. The OUR FAMILY products do not contain the NASH FINCH name. (38 TTABVUE 23-24 at Murphy 23:25-24:18.) These products are sold in thousands of different grocery stores, all with different names. (38 TTABVUE 3044-3499 at Murphy Ex. 184.) A customer could readily visit a store that carries Nash Finch's OUR FAMILY products, and then receive an Ahold weekly advertisement circular in the mail or visit an Ahold Giant, Stop & Shop or Martin's store and see a stanchion sign out front for OUR FAMILY FOUNDATION. Having familiarity with OUR FAMILY, and knowing that different grocery stores carry the brand, these customers are likely to visit Ahold grocery stores looking for OUR FAMILY food products. Given the unsophisticated purchasing situation that grocery shopping is, it is likely that consumers in these geographic areas would believe that OUR FAMILY FOUNDATION and Nash Finch's OUR FAMILY products are related. Further, there is also likely confusion when beneficiaries of the donations receive them, as the geographic scope of sales of OUR FAMILY food overlaps with

the donations of the Our Family Foundation on the East Coast. This factor thus favors a finding that confusion is likely.

8. While No Confusion Has Been Uncovered To Date, The Likelihood Of Confusion Is High.

To date, there has been no documented confusion. However, actual confusion is extremely difficult to uncover and thus is not necessary to establish a finding of a likelihood of confusion. *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002). In this case, Ahold has only started use of the OUR FAMILY FOUNDATION & Design mark in 2012. REDACTED

REDACTED This factor is neutral or weighs in favor of Nash Finch.

9. There Is No Evidence The OUR FAMILY Mark Is Diluted By The Actual Use Of Similar Marks On Similar Goods; Thus Nash Finch Has A Broad Right To Exclude Ahold's Registration Of OUR FAMILY FOUNDATION & Design.

The evidence fails to establish Nash Finch's OUR FAMILY mark is anything but strong, undiluted, and entitled to a broad scope of protection. There is no evidence of third party use of OUR FAMILY in connection with food products that is known by consumers. There is also no evidence of the use of OUR FAMILY by a third party for charitable services—other than Ahold and its OUR FAMILY FOUNDATION mark. This factor weighs in favor of Nash Finch.

VI. SUMMARY

In summary, given the proof of the likelihood of confusion, Petitioner Nash Finch Company asks the Trademark Trial and Appeal Board to cancel Registrant Ahold's registration for OUR FAMILY FOUNDATION & Design. As explained in detail above, many of *Dupont* factors weigh in favor of cancellation of the mark. None weigh in favor of Ahold. Cancellation of Registration No. 4,283,988 is appropriate.

Respectfully submitted,

NASH FINCH COMPANY

By its attorneys



John A. Clifford

Heather J. Kliebenstein

Merchant & Gould P.C. Suite 3200

80 South Eighth Street

Minneapolis, MN 55402

Tel: 612.332.5300

Fax: 612.332.9081

Attorneys for Petitioner

Date: October 2, 2015

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PETITIONER'S TRIAL BRIEF was served via first class mail, postage prepaid, this 2nd day of October, 2015, on:

Harvey Freedenberg
Brian P. Gregg
100 Pine Street
P.O. Box 1166
Harrisburg, PA 17108-1166
HFreedenberg@mwn.com
BGregg@mwn.com


Abigail Krueger

CERTIFICATE OF FILING

I hereby certify that PETITIONER'S NOTICE OF RELIANCE was filed electronically with the United States Patent and Trademark Office's Electronic System for Trademark Trial & Appeals (ESTTA) on this 2nd day of October, 2015.


Abigail Krueger