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TTAB

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August 6, 2010

By Express Mail

Commissioner for Trademarks
ATTN: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Publix Asset Management Company v. The Great Atlantic &
Pacific Tea Company, Inc.
Opposition No. 91186148 (consolidated)
Attorney Ref: 25897.190

Dear Commissioner:

We represent Applicant The Great Atlantic & Pacific Tea Company, Inc. in the above-referenced Consolidated Proceedings.


Enclosed please find:

- Applicant's Motion and Memorandum in Support of Applicant's Motion for Summary Judgment;
- Declaration of Douglas Palmer in Support of Motion for Summary Judgment;
- Declaration of Midge M. Hyman in Support of Motion for Summary Judgment.

Respectfully submitted,

Arlana S. Cohen

Enclosures



08-06-2010

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

----- X
PUBLIX ASSET MANAGEMENT COMPANY, :
 :
Opposer, :
 :
v. : **Opposition No. 91186148**
 : **Opposition No. 91186863**
 : **(consolidated under**
THE GREAT ATLANTIC & PACIFIC TEA : **Opposition No. 91186148)**
COMPANY, INC., :
 :
Applicant. :
----- X

**APPLICANT'S MOTION AND MEMORANDUM
IN SUPPORT OF APPLICANT'S
MOTION FOR SUMMARY JUDGMENT**

MOTION

Applicant, The Great Atlantic & Pacific Tea Company, Inc. ("A&P" or "Applicant"), moves the Honorable Trademark Trial and Appeal Board (the "TTAB") to enter summary judgment in its favor on all claims of the Notices of Opposition¹, in accordance with Rule 56(b) of the Federal Rules of Civil Procedure and 37 C.F.R. § 2127. There are no genuine issues of material fact precluding summary judgment in favor of A&P on all of the claims, namely likelihood of confusion and dilution, asserted in the Notices of Opposition.

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¹ Opposer separately lodged Opposition Nos. 91186148 and 91186863. The oppositions were consolidated under Opposition No. 91186148.

Applicant's Motion for Summary Judgment is supported by the following memorandum of law, the Declaration of Douglas Palmer dated August 3, 2010 (with Exhibits A-D) (hereinafter "Palmer Decl."), the Declaration of Midge Hyman dated August 5, 2010 (hereinafter "Hyman Decl.") (with Exhibits A-T) and the pleadings filed in this proceeding.

I. INTRODUCTION

To quote Kermit The Frog, "It Isn't Easy Being Green." Kermit originally lamented and later celebrated that he reflected the color of nature. Businesses are realizing the same thing. Being "green" i.e., eco-friendly, it appears, is good for business too.

In keeping with the trend to offer natural, organic and earth friendly products known as "green" products desired by consumers, in or about August, 2007 Applicant began to develop a unique natural/organic private-label product line having these attributes and conceived of the mark GREEN WAY. (Palmer Decl. ¶ 3-4)² Applicant applied for registration of its GREEN WAY mark in Application Serial No. 77/349,246 dated December 11, 2007 and Application Serial No. 77/409,725 dated February 29, 2008 ("Combined as Applicant's Mark"), which cover a wide range of food, personal care and grocery products (Palmer Decl. ¶ 6; Hyman Decl. ¶ 21-22, Exh. R, S) and both were duly published for opposition. In each case it was expressly noted "the Examining Attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d)." (Hyman Decl. ¶ 10, Exh. G)

Opposer, Publix Asset Management Company ("Publix"), has filed Notices of Opposition against Applicant's Mark citing ownership of its mark GREENWISE for its grocery products and supermarket services (hereinafter referred to as "Opposer's Mark") and claiming that

² Applicant does not, nor does it intend to, offer retail store services under the GREEN WAY mark. (Palmer Decl. ¶7.) Therefore, any attempt on Opposer's part to contend confusion is more likely because both parties operate supermarkets is not a fact truly at issue herein.

Applicant's Mark is confusingly similar to and dilutes and tarnishes Opposer's Mark. The parties have engaged in extensive discovery with Opposer providing 2,284 documents, none of which has yielded any evidence of a likelihood of confusion or actual confusion or dilution or tarnishment. Discovery has closed. Accordingly, Applicant's Motion for Summary Judgment, summarily dismissing the Opposition proceedings, should be granted for the reasons set forth herein.

II. ARGUMENT

A. **Summary Judgment Should Be Granted In A&P's Favor As No Material Issues Of Fact Exist**

Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c)(2); see Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). The aim of summary judgment is "judicial economy," that is, to save the time and expense of trial where no genuine issue of material fact remains, and where no evidence beyond that which is already available in support of the summary judgment motion could reasonably be expected to change the result. United Rum Merchants, Ltd. v. Distillers Corp., Ltd., 9 U.S.P.Q. 2d 1481, 1482 (T.T.A.B. 1988). The TTAB expressly approves of summary judgment as "a salutary method of disposition" and affirmatively states that "the Board does not hesitate to dispose of cases on summary judgment when appropriate." See Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §528.01.

No genuine issue for trial exists "[w]here the record taken as a whole could not lead a rational trier of fact to find for the non-moving party." Matsushita Electric Industrial Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986), cert. denied, 481 U.S. 1029 (1987). "A dispute is genuine only if, on the entirety of the record, a reasonable [trier of fact] could resolve a factual matter in favor of the non-[moving party]." Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.,

833 F.2d 1560, 1562 (Fed. Cir. 1987). Disputes over facts which will not affect the outcome under the governing law are immaterial and do not preclude the entry of summary judgment.

“When the moving party’s motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the non-moving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.” Hurley Int’l, LLC v. Volta, 82 U.S.P.Q.2d 1339, 1343 (T.T.A.B. 2007). “The non-moving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.” Id.

It is clear that summary judgment is appropriate in this case. As further set forth herein, the material facts are not in dispute. Here, the only element in common between Applicant’s Mark GREEN WAY and Opposer’s Mark GREENWISE is the word “green,” itself a descriptive, weak word incorporated into literally hundreds of third party marks used and/or registered to designate food, personal care and grocery products. (Palmer Decl. ¶ 5, 8, Exh. B, C; Hyman Decl. ¶ 4, 5, 8, 12-15, 17-20, Exh. A, B, E, I-L, N-P) This motion is based on the clear, incontrovertible differences between Applicant’s Mark and Opposer’s Mark which are so substantial as to make a determination of no likelihood of confusion appropriate as a matter of law on this factor alone.

B. The Pertinent Du Pont Factors Fall in Applicant’s Favor

The test for likelihood of confusion requires the Board to “take into account, when of record, those of the thirteen evidentiary factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973), that are pertinent to the case.” Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1072-1073 (Fed. Cir. 1989), cert. denied, 506 U.S. 862 (1992). Different factors may play dominant roles in determining the

likelihood confusion. See In re Edward Roth, 2001 TTAB LEXIS 169, at *7 (TTAB 2001) (“It is well established that in determining likelihood of confusion, any one of the DuPont factors may be dispositive. Not every DuPont factor must be considered by the Board. Some factors may be dispositive by themselves, such as dissimilarity of the marks in question. See NBC Fourth Realty Corporation v. T.J. Bailey, Inc., 1997 TTAB LEXIS 211, at *5 (T.T.A.B. 1997)

Sensibly, therefore, the confusion test is designed to be applied in a flexible manner unique to each set of circumstances, and summary judgment can be granted to an Applicant even if some factors weigh in favor of the Opposer. See, e.g., Kellogg Co. v. Park ‘em Enterprises Inc., 14 U.S.P.Q. 2d 1545 (T.T.A.B. 1990), aff’d 951 F.2d 330 (Fed. Cir. 1991) (on summary judgment the dissimilarity of the marks FROOT LOOPS and FROOTIE ICE was the dispositive factor in the likelihood of confusion analysis outweighing all other DuPont factors); Sullivan v. CBS Corp., 385 F.3d 772, 778 (7th Cir. 2004) (affirming summary judgment for defendant on likelihood of confusion despite some similarities in the names and products); See also, Edward Lifesciences Corporation v. Vigilanz Corporation, 94 U.S.P.Q.2d 1399 (TTAB 2010); CareFirst of Maryland, Inc v. First Care, P.C., 434 F.3d 263, 274-275 (4th Cir. 2006) (affirming summary judgment for defendant on likelihood of confusion despite market overlap and survey evidence); See also, Bridgestone Firestone North American Tire, LLC v. Federal Corporation, 2010 TTAB LEXIS 298 *at 32 (T.T.A.B. 2010) (“Despite the identity of the goods, channels of trade and classes of consumers, we find that the differences between the marks warrant a finding that there is no likelihood of confusion. Simply put, we find that the dissimilarity of the marks simply outweighs the other relevant factors”); Duluth News-Tribune v. Mesabi Publishing Co., 84 F.3d 1093, 1099 (8th Cir. 1996) (affirming summary judgment for defendant on likelihood of confusion despite some evidence of actual confusion). Even “factual disputes regarding a single

factor do not preclude [the] entering [of] summary judgment.” Mars Musical Adventures, Inc. v. Mars, Inc., 159 F. Supp. 2d 1146, 1150 (D. Minn. 2001).

The most significant DuPont factors in the present case are established in A&P’s favor by A&P’s motion, the Declarations of Douglas Palmer and Midge M. Hyman and accompanying exhibits submitted by A&P, namely that (1) the parties’ marks are sufficiently different such that confusion is not likely; (2) the only similarity between the parties’ marks is the shared use of the widely used and common term “green” in the food, personal care and grocery product industries to which neither party can claim exclusivity; (3) Publix’s GREENWISE mark is inherently weak and should only be accorded a narrow scope of protection; (4) there is an abundance of third party use of the word “green” in the relevant industries confirming that the word has a common meaning and does not serve to distinguish Publix’s goods from the goods of its competitors; (5) there has been no actual confusion; and (6) A&P, in adopting its GREEN WAY mark, did so in good faith. A review of these applicable DuPont factors shows that there are no genuine issues of material fact and that no likelihood of confusion or dilution exists such that the Board should dismiss this opposition proceeding with prejudice, in its entirety.

C. When the Relevant Factors Are Analyzed in Light of the Facts There Can be No Doubt That There Is No Likelihood of Confusion

(i) The Marks GREEN WAY and GREENWISE Are Different

It is well established that the first factor, namely, the similarity or dissimilarity of the marks in their entireties, can so outweigh the other factors in importance that summary judgment is appropriate in certain circumstances based on this factor alone. See Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43, 46 (2d Cir. 2000) (Importantly, in a case such as this one, “the ‘similarity of the marks’ factor [alone] can be dispositive and will warrant summary judgment

for an infringement defendant ‘if the . . . marks are so dissimilar that no question of fact is presented.’”). This was the circumstance supporting the Federal Circuit’s decision in Kellogg Co. v. Park ‘em Enterprises Inc., 14 U.S.P.Q.2d at 1550 (T.T.A.B. 1990), in which Kellogg’s opposition to the mark FROOTIE ICE based on Kellogg’s own registration for FROOT LOOPS was dismissed on summary judgment. The CAFC affirmed the TTAB’s holding that the marks are so dissimilar that there is no likelihood of confusion. The CAFC held: “[w]e know of no reason why, in a particular case, a single DuPont factor may not be dispositive.” 951 F.2d at 333. See also Imagewear Apparel Corp. v. Wings Manufacturing Corporation, Cancellation No. 92045101 (T.T.A.B. 2010) (In finding no confusion between the marks RED SNAP and RED KAP, both for clothing items, the TTAB held that “despite the overlap in goods, because the marks are so dissimilar, there are no genuine issues of material fact that confusion is unlikely.”)

In numerous other cases the TTAB has dismissed oppositions on the grounds that, even without consideration of each of the DuPont factors, or even if all of the other factors favor the opposer, the degree of dissimilarity between the marks is sufficient to grant summary judgment of no likelihood of confusion. See, e.g., Champagne Louis Roederer, S.A. v. Delicato Vineyards, 148 F.3d 1373, 1375 (Fed. Cir. 1998) (Board did not err in relying on dissimilarity of applicant’s mark “CRYSTAL CREEK” for wine and opposer’s “CRISTAL” mark for champagne in evaluating likelihood of confusion, since single factor may be dispositive in likelihood of confusion analysis, especially when that factor is dissimilarity of marks).

Applicant respectfully submits that the dissimilarity between the GREENWISE and GREEN WAY marks is sufficient to support summary judgment of no likelihood of confusion, although, as discussed below, the other relevant DuPont factors all weigh in Applicant’s favor as well.

In the instant case, as in the Kellogg case, the marks at issue are completely dissimilar. A simple visual comparison of the marks GREEN WAY and GREENWISE in their entireties demonstrates that there can be no likelihood of confusion. Although each include the word “green” the fact that each mark uses a totally different word along with “green” i.e., Applicant uses the word “way” (a three letter word) and Opposer uses the word “wise” (a four letter word), precludes any likelihood of confusion. The mere inclusion of the common weak term “green” in the disputed marks is simply insufficient to support a finding of likelihood of confusion. The marks in question must be considered in their totality taking into consideration the different words incorporated in the marks, not merely the common weak term “green.” See Marx-Haas Clothing Co. v. Men’s Wear, Inc., 180 U.S.P.Q. 603, 604 (T.T.A.B. 1973) (In distinguishing the marks HAMPTON ROAD and HAMPTON HEALTH, the TTAB stated: “[T]his would suggest that the inclusion in each of the marks here involved [of the same diluted term] may not be a sufficient basis upon which to predicate a likelihood of confusion.”)

Further distinguishing the marks GREENWISE and GREEN WAY is the fact that Opposer’s Mark is comprised of one word while Applicant’s Mark is comprised of two separate words, thus providing a very different overall appearance. See In re Cullen/Frost Bankers, Inc., Application No. 75/199524, at p. 3 (T.T.A.B. 2000). “[W]e find that the marks [READYBANK and READY BANKER] are only somewhat similar in terms of visual appearance given the fact that applicant’s mark is depicted as one word, whereas registrant’s mark is depicted as two words and the second word is clearly different.”; In re Raven Lining Systems Inc., Application No. 75/472685, at p. 5 (T.T.A.B. 2002) (“As to appearance, we agree with applicant that AQUATAPOXY, a single word, has a decidedly different appearance from both AQUA POXY

and AQUA EPOXY because of the additional “TA” syllable and the absence of any space within the term.”).

In addition, it has frequently been held that trademarks comprising two words or a compound word are not confusingly similar even though they have in common one word or part which is descriptive or suggestive of the nature of goods to which the marks are applied, or of the use to which such goods are to be put. See Red Bull GmbH v. Cochran, Opp. No. 91152588, at p. 11 (T.T.A.B. 2004) (“notwithstanding the fact that the parties was using their respective marks (RED BULL and RED RAVE) on identical goods which are marketed in the same channels of trade to the same purchasers, we find that the marks are too different.”) Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co., 491 F.2d 1265, 1267 (C.C.P.A. 1974) (affirming “DUTCH APPLE” mark for “smoking tobacco” not confusingly similar to “DUTCH MASTER” mark for “cigars”). The reasoning in those cases clearly supports that the marks “GREENWISE” and “GREEN WAY” are even more dissimilar than the above-noted marks because in this case, one is comprised of one word and the other two.

(ii) Opposer’s GREENWISE Mark is Weak and Entitled to Only a Narrow Scope of Protection

(a) Opposer’s GREENWISE Mark Incorporates a Common Term and Is Inherently Weak

The strength of a mark has been defined as the distinctiveness of the mark, or its tendency to identify the goods sold under the mark as emanating from a particular source. See Kasco Corp. v. Southern Saw Service, Inc. 27 U.S.P.Q.2d 1501, 1505-1506, n.7 (T.T.A.B. 1993). A strong mark “is an arbitrary term having no descriptive or suggestive significance.” In re Emulex Corp., 6 U.S.P.Q.2d 1312, 1314 (T.T.A.B. 1987).

Opposer's GREENWISE mark does not meet this criterion. The word "green" has been commonly used for many years in a variety of industries, including most notably the food industries, to connote natural and organic products and products made from environmentally friendly materials. (Palmer Decl. ¶ 3, 5, Exh. B, C; Hyman Decl. ¶ 5, 6, 8, 23, Exh. B, C, E, T) As noted in the trade publications Shopping Center Business and Supermarket News.com, produced in this opposition by Opposer, Publix introduced its GREENWISE line of products in keeping with this "green" trend. (Hyman Decl. ¶ 23, Exh. T)

The Trademark Office has readily acknowledged the fact that the term "green" describes products made of environmentally friendly materials. See In re Cenveo Corporation, Serial No. 77/289355, 2009 TTAB LEXIS 615 (T.T.A.B. Sept. 30, 2009) (In view of the worldwide emergence of environmentally friendly or "green" products, the TTAB finds that "green key" is generic in relation to environmentally friendly keycards and thus not registrable); In re Bargoose Home Textiles Inc., Serial No. 77255007, 2009 TTAB LEXIS 408, at *9 (T.T.A.B. May 27, 2009) (In affirming the refusal to register the term "Allergy Green" for bedding products the TTAB stated "although 'green' bedding may have various meanings, all of these meanings describe a characteristic of the products as being environmentally friendly, whether the products are organic, or are made from renewable resources, or are recyclable."); In re Hobart Brothers of Canada Limited, Serial No. 74544094, 1996 TTAB LEXIS 114, at *3-5 (T.T.A.B. Nov. 26, 1996) (TTAB takes judicial notice that the term "green" is defined as "environment-friendly" in affirming the refusal to register "green spool" for "spool for feeding welding wire" as descriptive of applicant's product, a recyclable spool.); In re Manhattan Scientifics, Inc., Serial No. 75/478091, 2001 TTAB LEXIS 290, at *2 (T.T.A.B. Apr. 3, 2001) ("[I]t is the combination GREEN CELL, which we found to immediately convey to purchasers that the fuel cell with

which the mark is used is an environmentally friendly cell. As such, the mark GREEN CELL is merely descriptive of the goods.”)

Accordingly, the TTAB has consistently held marks which incorporate the term “green” to be inherently weak and not accorded a wide range of protection. As stated in Sure-Fit Products Co. v. Saltzson Drapery Co., 254 F.2d 158 (C.C.P.A. 1958):

[W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Id. at 160.

Opposer’s GREENWISE mark was weak at inception and due to its very nature, continues to be weak and accordingly should be afforded only a narrow scope of protection. In light of such narrow scope, the addition of differing words to the word “green” in Opposer’s Mark and in Applicant’s Mark clearly distinguishes such marks and precludes a finding of a likelihood of confusion.

This case is virtually identical to The Wooster Brush Co. v. Prager Brush Co., 231 U.S.P.Q. 316 (T.T.A.B. 1986). In Wooster, the Applicant sought to register the mark POLY FLO for paint brushes. Registration was opposed on the basis that the mark POLY FLO was allegedly likely to cause confusion with the marks POLY PRO and EASY FLO for paint brushes and POLY-GLO for paint applicators. The Board dismissed the opposition stating:

It is apparent from the testimony and supporting documentary exhibits that the paint brush industry has developed in such a way that certain terms have come to be frequently used as part of trademarks which suggest certain characteristics of the brush. ‘POLY,’ for example, appears to be widely used in the field to refer to a brush made of synthetic material, either polyester or other polymers. ‘PRO’ is also widely used to refer to a

professional quality brush, indicating one of better quality and greater cost. 'FLO' or its phonetic equivalent 'FLOW' is also in common use in the field presumably to suggest that the paint flows easily and evenly from the brush to the surface being painted. In view of the foregoing, therefore, we believe that the inclusion of any one or more of these terms in a composite trademark is insufficient, in and of itself, to warrant a finding of likelihood of confusion since these terms are commonly used by paint brush manufacturers to suggest qualities of characteristics of the brushes.

Id. at 318.

In the present case, Opposer is seeking to enforce a wide latitude of protection in an inherently weak mark recognized as having a descriptive meaning in the relevant field. Such efforts clearly must fail.

(b) There Is Extensive Third Party Use Of The Word GREEN In The Relevant Industry and The Federal Register Is Replete With Trademark Registrations For Marks Which Include The Word GREEN

"Green" marks are widely used by third parties in the food, grocery products and food services fields. Applicant has submitted copies of web pages from the Internet demonstrating examples of such expansive use. (Hyman Decl. ¶ 5, Exh. B) Photographs of just a small portion of the products readily available in the marketplace with the word "green," including the well-known "Green Giant" brand, which pre-existed the current "green" trend by decades (Palmer Decl. ¶ 8, Exh. C), are attached as Exhibit C to the Palmer Declaration and as Exhibit E to the Hyman Declaration.

It is not surprising that as a result of the "green" marketing explosion in a wide range of industries, including the food industry, a large number of applications have been filed to secure registrations for "green" marks. (Palmer Decl. ¶ 5, Exh. B) In fact, in 2007 over 300,000 marks incorporating the word "green" were registered in the PTO. (Palmer Decl. ¶ 5, Exh. B) A review of the USPTO Trademark Application and Registration Retrieval System (TARR)

discloses many applications and registrations for marks in the food, grocery products and food services classes which include the word “green” which have been permitted to coexist on the Register. (Hyman Decl. ¶ 4, Exh. A) Applicant has submitted copies of certificates of registration of third party “green” marks for food, grocery products and food services (Hyman Decl. ¶ 4, Exh. A), just a sampling of the state of the Register. Opposer is clearly aware of the plethora of “green” mark applications and registrations as many such marks which pre-existed even Opposer’s Mark were disclosed in searches produced by Opposer in this action (Hyman Decl. ¶ 17-19, Exh. N-P).

The existence of third-party use and registration of similar marks is admissible and relevant to show that the mark is weak and entitled to a narrow scope of protection. See PC Club v. Primex Technologies, Inc., 32 Fed. Appx. 576, 579-80 (Fed. Cir. 2002); Bost Bakery, Inc. v. Roland Industries, Inc., 216 U.S.P.Q. 799, 801 (T.T.A.B. 1982) (existence of multiple registrations with the common term HEARTH shows tht PTO had recognized the suggestive significance of term for bread and closely allied products); King Candy Co. v. Eunice King’s Kitchen, Inc., 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974) (when marks are widely used, the public easily distinguishes slight differences among them as well as between the goods).

Indeed, the existence of multiple third-party registrations alone can prove the weakness of a mark. See Airco, Inc. v. Air Products and Chemicals, Inc., 196 U.S.P.Q. 832, 835 (T.T.A.B. 1977) (evidence of third party registrations for marks with “AIR” as a prefix probative of fact that prefix was used to convey meaning that products or services were associated with dispensing gases derived from air). See also Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 U.S.P.Q.2d 1404, 1406 (T.T.A.B. 1988) (“[third-party registrations] are competent to establish that a portion common to the marks involved in a proceeding has a normally understood and

well-known meaning; that this has been recognized by the Patent and Trademark Office by requesting marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each mark may be an insufficient basis upon which to predicate a holding of confusing similarity”) (citations omitted).

As noted, the Federal Register contains numerous registrations that incorporate the term “green” for food and related goods and services. (Hyman Decl. ¶ 4, 12-15, 17-20, Exh. A, I-L, N-P; Palmer Decl. ¶ 5, Exh. B;) Given the large number of registered marks incorporating the term “green” (Hyman Decl. ¶ 4, 12-15, 17-20, Exh. A, I-L, N-P) and the extensive use of that term at common law (Palmer Decl. ¶ 8, Exh. C; Hyman Decl. ¶ 5, 8, Exh. B, E), it is clear that both consumers and the Trademark Office have easily distinguished amongst these marks when viewing them in their entireties. The fact that the Trademark Office has allowed the coexistence of so many federal trademark registrations covering marks which incorporate the word “green” for food, personal care and grocery products underscores the fact that, when viewed in their entireties, there is no likelihood of confusion amongst these marks; See General Mills, Inc. v. Health Valley Foods, 24 U.S.P.Q.2d 1270, 1278 (T.T.A.B. 1992) (“[e]vidence suggests that consumers have become so conditioned by the large number of FIBER marks for food products that customers are accustomed to distinguishing between different fiber marks, even on the basis of small differences.”).

Further supporting the fact that the Trademark Office has allowed the coexistence of marks which include the common term “green” on the Register is that during the prosecution of Publix’s GREENWISE applications and A&P’s GREEN WAY applications, not a single third party registration or application containing the word “green” was cited as a bar to registration by

the Trademark Office. (Hyman Decl. ¶ 9-10 Exh. F, G) This is further indication that an inherently weak mark in a crowded field is only afforded a narrow scope of protection.

The facts of this Opposition are analogous to those in United Foods, Inc. v. J.R. Simplot Co., 4 U.S.P.Q.2d 1172, 1173 (T.T.A.B. 1987). In United Foods, applicant sought to register the mark QUICK 'N CRISPY (CRISPY disclaimed) for frozen potatoes. Opposer attempted to prevent registration on the ground that applicant's mark so resembled opposer's previously registered marks QUICK 'N CHEESY (CHEESY disclaimed) for frozen vegetables, QUICK 'N BUTTERY (BUTTERY disclaimed) for frozen peas, corn, broccoli cuts and mixed vegetables and QUICK 'N SAUCY (SAUCY disclaimed) for frozen mixed vegetables as to be likely to cause confusion. Although the Board found the parties' goods to be closely related, sold through the same channels of trade, to the same classes of consumers and under the same marketing conditions, id. at 1173-1174, the fact that applicant presented many third party registrations for marks which included the word QUICK was found to be convincing. The Board stated:

Nevertheless, third party registrations are entitled to some weight when they are offered to show the sense in which a term, word, prefix or other feature of a mark is used in ordinary parlance. They may show that a particular term has descriptive or suggestive significance as applied to certain goods or services.

Id. at 1174.

In General Mills, the Board permitted the registration of Applicant's FIBER ONE mark over the objection the owner of the registered mark FIBER 7 FLAKES. The Board stated that "[T]he exhibits . . . show numerous third-party uses of 'fiber' in connection with food products. . . In light of the above, we do not believe there is any doubt but that the field of 'fiber' marks for foods (including cereals) is a crowded field." 24 U.S.P.Q.2d at 1277 (citing 1 J.T. McCarthy, Trademarks and Unfair Competition, §11.26 (2d ed. 1984). In so holding, the Board emphasized that:

We reiterate that an important factor in our analysis is the evidence of widespread use of the term ‘fiber’ in connection with cereals and other food products. This evidence suggests that consumers have become so conditioned by the large number of FIBER marks for food products that customers are accustomed to distinguishing between different FIBER marks, even on the basis of small differences.

Id. at 1278.

The Board in United Foods and General Mills properly considered the realities of the marketplace and refused to grant extensive protection to weak marks comprising a common term in the industry. Similarly, Opposer should not be permitted to claim a broad scope of protection for a mark that contains the common word “green.”

**(c) The Incontestable Status Of A Mark
Does Not Make A Weak Mark Strong**

In its Notices of Opposition, Opposer incorrectly states that because its Registration Nos. 2,520,595 and 2,654,223 are incontestable, Publix’ GREENWISE mark is presumptively strong. It is well-settled that “incontestable status does not make a weak mark strong,” as it relates only to registrability and not to commercial strength in the marketplace. Oreck Corp. v. U.S. Floor Systems, Inc., 803 F.2d 166, 171 (5th Cir. 1986), cert. denied, 481 U.S. 1069 (1987).

Indeed, Publix has not demonstrated that its mark has gained any significance in the marketplace, let alone that it had commercial strength when it lodged its oppositions against A&P’s GREEN WAY mark. Therefore, while Publix asserts in its Notices that the GREENWISE mark has been the subject of extensive marketing and advertising by Publix since its introduction, with respect to commercial strength, “it is the effect of such advertising that is important, not its extent.” Co-Rect Prods., Inc. v. Marvy! Advertising Photography, Inc., 780 F.2d 1324, 1332 (8th Cir. 1985) (emphasis added). See also Merit Diamond Corp. v. Suberi Bros., Inc., No. 94 Civ. 4572 (SHS), 1996 U.S. Dist. LEXIS 265, at *11 (S.D.N.Y. Jan. 11,

1996) (markholder “did not present . . . evidence that these expenditures affected consumers in any way”). Opposer offers no direct evidence that consumers recognize the GREENWISE mark or buy products because of it, such as a secondary meaning survey, which is “the most . . . persuasive evidence of” commercial recognition. The Black & Decker Corp. v. Dunsford, 944 F. Supp. 220, 227 n.9 (S.D.N.Y. 1996).

(iii) The Goods Are Directed to Discriminating Consumers

It is widely recognized that “green” organic products appeal to well-educated, discriminating purchasers. (Palmer Decl. ¶ 9-10, Exh. D; Hyman Decl. ¶ 7, Exh. D). As noted in the internal studies conducted by Applicant which explored the demographics of the purchasers of “green” products, it was found such products appeal to well-educated and middle to upper middle income households who carefully make their purchasing decisions for health and/or ecological reasons. (Palmer Decl. ¶ 9-10, Exh. D) Numerous studies and articles in the trade produced by Applicant herein show these well-educated consumers, recognizing the environmental and health benefits of “green” products, are willing to pay more for such products. (Hyman Decl. ¶ 7, Exh. D). For example, the 2009 Green Brands Global Survey conducted by Penn. Schoen & Berland Associates, confirmed that consumers worldwide are ready and willing to spend more of their income to ensure the products and companies they support are operating sustainably. (Hyman Decl. ¶ 7, Exh. D). In addition, as noted by the International Institute for Sustainable Development:

The best ‘green’ customers are people with more money to spend. As a result, the most promising products for ‘greening’ tend to be at the higher end of the market. The most promising outlets for green products are retail stores frequented by better-off shoppers.

In general, green consumers have the education and intellectual orientation to appreciate value; they will understand evidence that is presented in support of environmental claims.

(Hyman Decl. ¶ 7, Exh. D).

This reasoning was echoed in Organic & Wellness News, the international newspaper for the organic trade:

A major market trend is that consumers are becoming more sophisticated. Originally, consumers were buying organic food for health reasons and ecological reasons. However, consumers today are becoming better informed. They still care about the environment and today, climate change has made the environment more important. They are also concerned about the chemicals in products and are buying more natural products that are ‘free from’ additives, synthetic colorings and preservatives.

(Hyman Decl. ¶ 7, Exh. D).

“It is well established that the greater the sophistication of the customer, the less likelihood there is of confusion.” Electronic Design & Sales, Inc. v. Electronic Data Systems Corporation, 954 F.2d 713, 718 (Fed. Cir. 1992) (“Where the purchasers are the same, their sophistication is important and often dispositive because ‘[s]ophisticated consumers may be expected to exercise greater care.’”); Mile High Upholstery Fabric Co. v. General Tire & Rubber, Co., Inc., 221 U.S.P.Q. 217, 223 (N.D. Ill. 1983) (no likelihood of confusion between ESSEX FABRICS used in conjunction with decorating fabrics and ESSEX used in conjunction with sponge rubber carpet padding due in part to knowledgeable and sophisticated purchasers). See also Standard Pressed Steel Co. v. Midwest Chrome Process Co., 418 F. Supp. 485, 491 (N.D. Ill. 1976) (likelihood of confusion decreases as customer sophistication increases).

This factor is in Applicant’s favor as “green” customers carefully make their purchasing decisions for health and/or ecological reasons and therefore carefully scrutinize the labeling and other components of the products purchased. (Palmer Decl. ¶ 10).

(iv) No Evidence of Actual Confusion Exists

Applicant's GREEN WAY products line was launched over fifteen months ago.³

(Palmer Decl. ¶ 7) It is compelling that Opposer cannot point to even a single instance of actual confusion and admits, in its response to Applicant's Interrogatory No. 19, in the consolidated Opposition, that it is not aware of any actual confusion. (Hyman Decl. ¶ 16, Exh. M) Nor is Applicant aware of any confusion or mistake resulting from its use of the GREEN WAY mark. (Palmer Decl. ¶ 11). Clearly, in a case like this, lack of evidence of actual confusion weighs heavily in Applicant's favor. See TRX Corp. v. Almar Communications Inc., No. 90 Civ. 6154 (CSH), 1990 U.S. Dist. LEXIS 15740, at *23 (S.D.N.Y. 1990) (finding five months coexistence between competing products sufficient time period within which to gather evidence of actual confusion).

**(v) Applicant's Adoption Of Its
GREEN WAY Mark Was In Good Faith**

It is telling that Opposer has not provided one shred of evidence that Applicant in any way intended to capitalize on Opposer's reputation or trade upon Opposer's GREENWISE mark. Establishing bad faith requires a showing that Applicant sought to trade on Opposer's good will or reputation. See Kansas City Baseball Corporation v. Anschutz Manchester Hockey, LLC, 2008 TTAB LEXIS 571 *at 46-47 (T.T.A.B. 2008) (Applicant did not adopt its mascot mark in bad faith, with the intent to trade on Opposer's goodwill, even if Applicant was aware of Opposer's mascot mark at the time it adopted its own mascot mark); Alpharma Inc. v. Advanced Animal Nutrition, Inc., 2009 TTAB LEXIS 19 * at 28 (T.T.A.B. 2009). ("There is no evidence in the record that indicates that Applicant was trying to trade on Opposer's goodwill when it

³ Although Applicant's applications are based on an intent-to-use, Applicant has made use of its GREEN WAY mark over fifteen months ago and such should be considered by the Board.

adopted and started using its NITRO mark.”) The record does not support such a showing. In fact, Applicant’s good faith adoption of its GREEN WAY mark is supported by the record.

First, in keeping with the trend to offer natural, organic and earth friendly products known as “green” products, Applicant developed its unique natural/organic private-label product line having these attributes (Palmer Decl. ¶ 3) and named its product line “GREEN WAY” (Palmer Decl. ¶ 4) to embrace the “green” marketing explosion in the food industry. In internal studies conducted by Applicant in the course of bringing Applicant’s GREEN WAY products to fruition, nowhere therein was a mention of Opposer or Opposer’s GREENWISE products or services. (Palmer Decl. ¶ 9, Exh. D).

Applicant duly conducted trademark searches (Palmer Decl. ¶ 4, Exh. A) and conducted market research (Palmer Decl. ¶ 9, Exh. D) prior to applying to register its GREEN WAY mark, further supporting Applicant’s good faith.

The filing and adoption of a “green” mark in light of the co-existence of the numerous third-party registrations which incorporate the common term “green” is evidence that Applicant has not acted in bad faith. See Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas, Inc., Opp. Nos. 91124847 and 91116355, 2005 TTAB LEXIS 600 (T.T.A.B. 2005), aff’d, 479 F.3d 825 (Fed. Cir. 2007). In finding no confusion between CAREFIRST and FIRSTCAROLINACARE, the TTAB stated:

On this record, we conclude that applicant adopted its mark in good faith to convey the key features of applicant’s services, while also relating its new mark to applicant’s established FIRSTHEALTH mark.

Id. at 71.

Similarly, Applicant adopted its GREEN WAY mark, including the common term “green,” to convey the key features of Applicant’s goods, namely that such goods provide shoppers with the highest quality organic and all natural items while maintaining a strong

commitment to environmental stewardship (Palmer Decl. ¶ 7). In fact, the GREEN WAY product line is often promoted with the tag lines “The organic, natural and ecologically smart brand” and “Good for you. Good for the earth,” further reinforcing the “green” aspect of the products designated by the GREEN WAY mark. (Palmer Decl. ¶ 7)

D. GREEN WAY Does Not Dilute the GREENWISE Mark

In its Notices of Opposition, Opposer cryptically states “In addition, registration of GREEN WAY is likely to dilute and to tarnish Publix’s GREENWISE mark. A&P plans to adopt a mark very similar to Publix’s famous GREENWISE mark. A&P’s planned use of that very similar mark threatens to dilute the quality of Publix’s mark by diminishing the mark’s capacity to identify and to distinguish Publix’s goods.” Although it is not clear, it appears that Opposer is attempting to make a claim for dilution by tarnishment, and we will address the claim as such.

Factors which the TTAB will consider in determining whether dilution is likely include: (1) similarity of the marks; (2) renown of the senior party; and (3) whether target customers are likely to associate two different products with the mark even if they are not confused as to the different origins of the products. Toro Co. v. ToroHead Inc., 61 U.S.P.Q.2d 1164 (T.T.A.B. 2001).

Under the similarity of the marks factor, a party must prove more than confusing similarity, it must show that the marks are identical or “very or substantially similar.” Id. (citations omitted). To support a claim for dilution, “the marks must be at least similar enough that a significant segment of the target group of customers sees the two marks as essentially the same.” Luigino’s, Inc. v. Stouffer Corp., 170 F.3d 827 (8th Cir. 1999) (quoting McCarthy on Trademark and Unfair Competition 24:90.1 (4th ed. 1998)).

Here, when the marks are compared in their entireties, Applicant's GREEN WAY mark is clearly not identical or substantially identical to Opposer's GREENWISE mark. There is a higher standard for similarity with respect to a dilution claim as compared to a likelihood of confusion claim, and Opposer cannot satisfy this standard. Accordingly, the differences between the respective marks alone warrant dismissal of the dilution claim, with prejudice.

Fame for dilution purposes is also difficult to prove. See Advantage Rent-A-Car Inc. v. Enterprise Rent-A-Car Co., 238 F.3d 378, 381 (5th Cir. 2001), cert. denied, 540 U.S. 1089 (2003). “[T]he standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection.” Toro Co., 61 U.S.P.Q.2d at 1170 (T.T.A.B. 2001) (citations omitted). “To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services, *i.e.*, devoid of its trademark context.” Id. at 1177 (citations omitted). Opposer has not provided any survey or other evidence regarding consumer recognition of Opposer's marks or expert testimony in support of its dilution claim. Nor has Opposer proffered any evidence that its mark has singular identification when considered separately from Opposer's goods and services and no evidence that potential buyers of Opposer's goods marketed under the GREENWISE mark would make any association between the parties' marks when used on their respective goods or goods and services.

For the foregoing reasons, summary judgment in Applicant's favor is appropriate on Opposer's dilution claim.

CONCLUSION


The undisputed facts support Applicant's entitlement to summary judgment. Opposer's mark is weak and should only be afforded a narrow scope of protection. The marks at issue are clearly different. This finding alone should be dispositive of this proceeding. Further bolstering Applicant's position is the fact there is overwhelming evidence of third-party use of the word "green" in the relevant industry and that these marks have coexisted peacefully without confusion. Accordingly, there are no genuine issues of material fact and Applicant is entitled to judgment as a matter of law.

For the foregoing reasons, Applicant respectfully requests the TTAB grant Applicant's Motion for Summary Judgment and dismiss the Opposition proceedings, with prejudice.

Dated: New York, New York
August 6, 2010

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 6, 2010 she caused a true copy of **Applicant's Motion And Memorandum In Support Of Applicant's Motion For Summary Judgment** to be served by mailing by Express Mail a true and correct copy thereof to Opposer's attorneys to:

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