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

Proceeding	91186148
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Publix Asset Management Company,
Opposer,

v.

The Great Atlantic & Pacific Tea Company, Inc.,
Applicant.

Opposition Nos. 91186148 &
91186863 (consolidated under
No. 91186148)

**PUBLIX ASSET MANAGEMENT COMPANY'S
OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

Publix Asset Management Company files its opposition to Applicant, The Great Atlantic & Pacific Tea Company, Inc.'s ("A&P") motion for summary judgment. This case concerns whether A&P's recently launched Green Way mark for a line of Earth-friendly retail grocery store products is confusingly similar to the senior and well-established GreenWise® mark that has been used for many years for those same products, as well as a host of related services. The parties' marks are confusingly similar in sight, sound, and meaning. Accordingly, A&P's summary judgment must be denied. Instead, summary judgment should be entered in favor of Publix Asset Management Company.

Background

I. Publix and Its GreenWise® Mark

Publix Super Markets, Inc., is the largest employee-owned supermarket company in the United States. See Mark Irby Declaration ("Irby Decl.") ¶ 5. Founded in 1930, Publix Super Markets has grown into a Fortune 100 company with more than 1,000 stores. Id. Publix Asset Management is related to Publix Super Markets and owns and manages marks and other intellectual property that are licensed to Publix Super Markets. Id. ¶¶ 1, 4. In this memorandum, the two companies are referred to collectively as "Publix."

Among the marks used in all of Publix's 1,000 stores is GreenWise®, which identifies organic, natural, and environmentally friendly products. Id. ¶ 10. In addition, GreenWise® identifies a number of services – all related to the health-conscious consumer seeking healthier food and household good options. Id. ¶ 12.

GreenWise® goods and services are fully integrated into the consumer's shopping experience at Publix. Id. ¶ 10. Many stores include a GreenWise® section, for example, that contains a stock of health-conscious items such as whole grain cereals, soy milk, snack goods, pastas or juices. Id. Those sections contain both GreenWise® private-label items – which must satisfy strict internal criteria – and GreenWise®-worthy products from other manufacturers. Id. GreenWise® products also are available in other areas of the stores. Id. For example, all dairy products may be located within a refrigerated section of a store, and within that section GreenWise® organic skim and whole milks are often offered too. Id. Similarly, GreenWise® paper towels made from recycled paper are available on the same store shelves as Bounty® paper towels. Id.

GreenWise® stand-alone grocery stores also exist. Id. ¶ 11. In those free-standing retail stores, GreenWise® private-label products are available alongside Publix® private label products and products bearing other national or regional brands. Id.

As part of its integrated approach catering to the health-conscious consumer, Publix also publishes a GreenWise® magazine and includes educational information on its web site. Id. Ex. E. The magazine is designed to help consumers make smart, natural choices on everything from food, nutrition, and fitness to remedies and ideas for disease prevention. Id. ¶ 12. The GreenWise® portion of the publix.com site contains additional educational information, such as articles on human nutritional needs. Id. Ex. E.

Publix currently offers some 286 GreenWise® products. Id. ¶ 6 & Ex. A. A sample shopping cart might include GreenWise® organic baby spinach salad, boneless skinless chicken breasts, organic apple sauce, chocolate soy milk, canned organic sweet peas and canned organic black beans, organic tomato ketchup, organic pure honey, blue corn tortilla chips, chlorine-free bleach, facial tissue, and even cat litter. Id.

Publix owns 13 current federal trademark registrations for GreenWise®, including:

- Reg. No. 2,520,595, for retail grocery store services, with a first-use date of March 14, 2001;
- Reg. No. 2,654,223, for newsletters in the field of health and nutrition, with a first-use date of February 26, 2001;
- Reg. No. 2,732,403, for food products, namely, breakfast cereals, cereal derived food bars, grain-based chips, sauces, honey, and tomato sauce, with a first-use date of March 14, 2001;
- Reg. No. 2,729,423, for food products, namely, eggs, milk, flavored milk, chocolate milk, fresh and processed seafood and shellfish, processed nuts, edible processed seeds, dried fruits, dried beans, fresh and processed meat and poultry, and tomato paste, with a first-use date of March 14, 2001;
- Reg. No. 3,328,951, for paper products, namely, bathroom tissue, facial tissue, paper napkins and paper towels, with a first-use date of March 31, 2003;
- Reg. No. 3,546,815, for laundry bleach, with a first-use date of October 31, 2007;
- Reg. No. 3,753,274, for vitamins and nutritional supplements, with a first use date of July 1, 2009;
- Reg. No. 3,813,868, for wood chips for smoking and grilling; charcoal briquettes, with a first use date of March 5, 2008;
- Reg. No. 3,813,886, for food products, namely, soy milk, applesauce, garden salad mix, processed vegetables and fruits, processed mushrooms, canned vegetables, packaged fresh entrees consisting primarily of meat, fish, poultry or vegetables, with a first use date of April 12, 2003;
- Reg. No. 3,813, 890, for fruit juices; tomato juice, with a first use date of October 23, 2003;

- Reg. No. 3,813,937, for food products, namely, ketchup, mustard, salsa, vinegar, flavored vinegar, wine vinegar, crackers, and candy, namely, chocolate covered raisins, with a first use date of January 2007;
- Reg. No. 3,813,946, for cat litter; unprocessed vegetables and fruits; unprocessed mushrooms, with a first use date of July 11, 2007;
- Reg. No. 3,813,950, for retail store services featuring chocolate confectionery, candy and edible gifts, delicatessens, bakery items, wines, organic wines, and beers, with a first use date of September 27, 2007; and
- Reg. No. 3,813,952, for cafe, restaurant, delicatessen and coffee bar services, in-store and for carry out, with a first use date of September 27, 2007.

Id. Ex. C & D. As these numerous registrations demonstrate, Publix has used and uses the GreenWise mark extensively since at least as early as 2001. Id. ¶ 8. The GreenWise® mark appears on a wide variety of private-label consumer goods in numerous classes. Id. ¶ 6. Publix's GreenWise® products are sold in hundreds of retail grocery stores, and the product line is constantly expanding. Id. ¶ 10. Through its federal registrations and applications as well as widespread use by Publix, Publix has acquired exclusive rights to use the GreenWise® mark in commerce throughout the United States. Id. ¶ 16. As explained more fully in Mr. Irby's Declaration (including portions filed under seal), Publix has expended millions of dollars promoting its GreenWise® mark, and the quality of those goods and services combined with Publix's marketing efforts have resulted in significant sales of GreenWise® products and services. Id. ¶¶ 14-15.

II. A&P's Applications for Green Way

Despite the strength of the GreenWise® mark and a search report citing the senior GreenWise® registrations, see Declaration of Douglas Palmer ("Palmer Decl.") ¶ 4 & Ex. A (pages A&P 00636-638), A&P elected to proceed with a highly similar mark for essentially identical products. A&P operates approximately 450 retail stores, including full-service supermarkets. Notices of Opp'n ¶ 9; Answers ¶ 9. A&P's pending applications concern plans for

the private-label brand Green Way to be used in those stores. Palmer Decl. ¶¶ 3, 6. A&P filed those applications on an intent-to-use basis approximately seven years after Publix began using GreenWise®. Irby Decl. ¶ 8; Palmer Decl. ¶ 6. A&P filed these applications despite its receipt of a search report prominently identifying GreenWise® registrations for virtually identical goods and services. Palmer Decl. ¶ 4 Ex. A (pages A&P 00636-638) (citing GreenWise® word-only registrations for numerous food products).

A&P seeks to register the Green Way mark in a wide variety of classes, encompassing many of the products available in grocery stores and overlapping with many of Publix's GreenWise® goods. Irby Decl. ¶19. A&P's initial application sought registration in the following classes:

- In International Class 29, for olive oil, canned tomatoes, canned beans, broth, soups, applesauce, jams, fruit preserves, peanut butter, soybean milk, milk, butter, cheese, frozen entrees consisting primarily of meat or cheese, frozen vegetables, namely, peas, broccoli, cauliflower, green beans and mixed vegetables, frozen fruits, pre-cut vegetable salad;
- In International Class 30, for balsamic vinegar, pasta, pasta sauce, salad dressing, salsa, macaroni and cheese, breakfast cereals, coffee, tortilla chips, cheese flavored snacks, namely, cheese puffs and cheese curls, popcorn, pretzels, crackers, cookies, ravioli, frozen entrees consisting primarily of rice or pasta, burritos, enchiladas, ice cream, ice cream sandwiches, sorbets, frozen corn;
- In International Class 31, for fresh vegetables; and
- In International Class 32, for fruit juices, fruit drinks, and soft drinks.

A&P's second application expanded A&P's planned product line to many non-food items. That application sought registration for the following goods:

- In International Class 3, for shampoos and hair conditioners; skin moisturizers; human body conditioners; skin treatment lotions and creams; anti-aging and stretch mark creams; non-medicated lotions and creams for hands, nails, skin, face, hair, foot and leg muscles and joints; depilatory lotions and creams; shaving lotions and creams; non-medicated skin care preparation, namely, lotions and creams for treating dry and damaged skin, anti-aging, firming, anti-wrinkle, stretch marks, under eye and eyelid firming; gels, namely, depilatory gels, shaving gels, shower gels; oils, namely, body oils,

non-medicated human body serums; soaps; liquid soaps; bar soaps; anti-bacterial liquid soaps; anti-bacterial bar soaps; body washing soaps; bubble bath; body and facial scrubs; masks, namely, beauty masks, facial masks, body masks, gel eye masks, skin masks, and skin moisturizer masks; non-medicated skin care preparations, namely, face peels; cosmetic sun protection creams and lotions, sun creams and lotions; sun block; soaps and detergents for household use for the purposes of cleaning and maintenance without harm to the environment.

- In International Class 4, for charcoal; white birch firewood; fire wood chips for use as fuel; fireplace logs.
- In International Class 5, for hand sanitizing preparations; dietary food supplements.
- In International Class 8, for disposable forks, knives, and spoons.
- In International Class 9, for batteries.
- In International Class 11, for compact fluorescent electric light bulbs.
- In International Class 16, for paper towels; paper table cloths; paper napkins; bathroom tissue; notebooks; notebook paper; and facial tissues.
- In International Class 20, for reeds, namely, diffuser reeds.
- In International Class 21, for paper plates and paper cups.
- In International Class 29, for frozen hamburger patties; processed edible seeds; processed nuts; dried fruits; raisins; trail mix, namely, snack mixes primarily consisting of processed fruits, processed nuts, pretzels; potato chips.
- In International Class 30, for teas; sesame sticks; chocolate coated nuts; yogurt coated nuts; macaroni and cheese; pesto sauce; bread; tortillas; tortillas chips.
- In International Class 31, for pet food.
- In International Class 32, for soda pop.

The goods listed in A&P's pending applications are routinely sold in retail supermarkets, such as A&P's and Publix's. Irby Decl. ¶ 10; Palmer Decl. ¶¶ 6-7. Goods sold under the respective GreenWise® and Green Way marks overlap substantially. Irby Decl. ¶ 19. Consequently, and recognizing that consumers would likely associate the Green Way products with the similarly named and well-established GreenWise® product line, Publix has opposed both applications.

Summary Judgment Standard

Summary judgment is proper in opposition proceedings if “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). A&P, as the moving party, has the burden of showing an absence of genuine issues of fact and that it is entitled to judgment as a matter of law.

Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 528.01 (2d ed. Mar. 2004) (citing Copeland’s Enters., Inc. v. CNV, Inc., 945 F.2d 1563, 1565 (Fed. Cir. 1991)). A&P’s burden is greater than the evidentiary burden it would have at trial. *Id.* In addition, “the evidence must be viewed in a light most favorable to the nonmovant and all reasonable inferences must be drawn in its favor.” Copeland’s Enters., 945 F.2d at 1566. In fact, “[t]he nonmoving party ‘need only present evidence from which a jury might return a verdict in [its] favor.’” *Id.* (quoting Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256 (1986)). If the nonmoving party, Publix in this case, shows the absence of a genuine issue of material fact and that it is entitled to judgment as a matter of law, the Board may sua sponte enter summary judgment in favor of the nonmoving party. TBMP §§ 528.01, 528.08.

Argument

The key issue in this matter is whether there is a likelihood of confusion between A&P’s new Green Way mark and Publix’s incontestable GreenWise® mark. “Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations.” Recot, Inc. v. M.C. Benton, 214 F.3d 1322, 1326 (Fed. Cir. 2000). “The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular channels

of trade or the class of purchases to which sales of the goods are directed.” Octocom Sys., Inc. v. Hous. Computer Servs., Inc., 918 F.2d 937, 942 (Fed. Cir. 1990) (citations omitted).

The factors to be considered in a likelihood of confusion inquiry are set forth in In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). Only those factors for which there are probative facts in a case need be analyzed. Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 671 (Fed. Cir. 1984). The two most important and sometimes dispositive factors are similarities between marks and similarities between the identified goods. Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1265 (Fed. Cir. 2002) (quoting Han Beauty, Inc. v. Alberto-Culver Co., 236 F.3d 1333, 1336 (Fed. Cir. 2001)). Similarly, when a senior user’s mark is “famous” that determination “plays a ‘dominant’ role in the process of balancing the DuPont factors.” Recot, 214 F.3d at 1327 (citing Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 352 (Fed. Cir. 1992)). As the Federal Circuit has said on multiple occasions:

The law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, that there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises “but one inference—that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark,” and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669, 676 (Fed. Cir. 1984) (quoting Planters Nut & Chocolate Co. v. Crown Nut, Co., 305 F.2d 924-25 (C.C.P.A. 1962)).

In this case, the parties’ marks are used on both identical and related goods, and the connotation and commercial impression of the two marks are identical. Based upon these two factors alone, A&P’s motion for summary judgment should be denied. The other applicable

DuPont factors, although unnecessary to address, also weigh heavily in Publix's favor.¹

Accordingly, A&P's motion must be denied, and instead judgment should be entered for Publix.

I. The Marks Are Used Upon Identical or Related Goods.

One key factor in a likelihood of confusion analysis, which is completely ignored by A&P in its Motion, is the similarity of the goods upon which a mark is used. "This 'relatedness of the goods' factor compares the goods and services in the applicant's application with the goods and services in the opposer's registration." Hewlett-Packard, 281 F.2d at 1267 (citing CBS, Inc. v. Morrow, 708 F.2d 1579, 1581 (Fed. Cir. 1983)). "Related goods are those 'products which would be reasonably thought by the buying public to come from the same source if sold under the same mark.'" AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 n. 10 (9th Cir. 1979) (quoting Standard Brands, Inc. v. Smidler, 151 F.2d 34, 37 (2d Cir. 1945)) abrogated on other grounds by Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 810 n.19 (9th Cir. 2003) .

In this case, the parties' goods and services are highly similar and likely to cause confusion. Both A&P and Publix operate retail grocery stores. Irby Decl. ¶ 17. Not surprisingly, therefore, the GreenWise® mark identifies a wide range of consumer goods that are sold in grocery stores, and many of those goods also are listed in the Green Way applications. Id. ¶ Ex. A, C; Palmer ¶ 6. For example, GreenWise® is registered for bread, pretzels, potato chips, processed nuts, processed edible seeds, dried fruits, processed fruits, bathroom tissue, facial tissues, paper napkins, and paper towels, charcoal, wood chips, applesauce, soy milk, milk, vinegar, breakfast cereals, crackers, fresh vegetables and fruit juices. Irby Decl. Ex. C. A&P

¹ The remaining DuPont factors also weigh in Publix's favor, such as the variety of goods on which the mark is used (the GreenWise® product line is extensive), or are not applicable.

now intends to use Green Way for those same goods. Serial Nos. 77/349,246; 77/409,725. A&P also has plans for Green Way pesto sauce and teas, Serial No. 77/409,725, much like Publix's GreenWise® sauces and herbal teas, Irby Decl. Ex. C. And numerous other goods on the A&P applications are closely related to GreenWise® products, such as Green Way paper table cloths and GreenWise® paper napkins; Green Way tortilla chips and GreenWise® grain-based chips; Green Way canned tomatoes and canned beans and GreenWise® canned vegetables; and Green Way pet food and GreenWise® cat litter. Compare Irby Decl. Ex. C with Serial Nos. 77/349,246; 77/409,725. Such duplication of goods will inevitably foster consumer confusion. See Century 21 Real Estate Corp. v. Century Life of Am., 970 F. 2d 874, 877 (Fed. Cir. 1992) (if marks are used upon identical goods, a lesser degree of similarity is required in order to show a likelihood of confusion).

Of course, even non-identical products can be confused if they carry similar marks. And, as A&P concedes, the parties' marks are used for essentially the same goods – i.e., “food, personal care and grocery products.” Palmer Decl. ¶ 6. Because all such goods are “related,” this factor weighs in favor of finding a likelihood of confusion. See, e.g., Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 1376 (Fed. Cir. 2002) (component parts of a sound system were similar to opposer's stand-alone sound systems); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570 (Fed. Cir. 1983) (good and services of a grocery store chain and a fast food restaurant were sufficiently related as to weigh against an applicant); Standard Brands, Inc. v. Smidler, 151 F.2d 34, 37 (2d Cir. 1945) (vegetable juice and vitamin supplement held to be closely related). Similarly, in this case, those goods that are not identical are at least related, and this DuPont factor weighs heavily in Publix's favor.

II. The Marks at Issue are Identical in Meaning and Confusingly Similar.

The similarity of the mark factor of the DuPont analysis “examines the relevant features of the marks, including appearance, sound, connotation, and commercial impression.” Hewlett-Packard, 281 F.3d at 1266 (citing Recot, 214 F.3d at 1329). The marks must be considered as a whole. In re Nat’l Data Corp., 753 F. 2d 1056, 1058 (Fed. Cir. 1985). If goods are either identical or closely related, as is the case here, “the degree of similarity [between the marks] necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods.” In re SL&E Training Stable, Inc., 88 U.S.P.Q.2d 1216, 2008 WL 4107225, at *2 (T.T.A.B. 2008) (citations omitted). See also Century 21 Real Estate Corp., 970 F. 2d at 877 (“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.”).

Moreover, it is well-settled that “similarity in meaning or significance alone is sufficient to indicate a likelihood of confusion.” H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62, 65 (T.T.A.B. 1979) (citing Hancock v. Am. Steel & Wine Co. of N.J., 97 U.S.P.Q. 330 (C.C.P.A. 1953)). See also AMF Inc., 599 F.2d at 352 (“Closeness in meaning can itself substantiate a claim of similarity of trademarks.”) (citation omitted). In this case, the marks at issue are quite similar in meaning. Both marks have the common element of “green,” which denotes products that are relatively healthy and environmentally-friendly. “Wise” means a “[m]ethod or manner of doing; way.” The American Heritage College Dictionary 1573 (4th ed. 2007) (emphasis added) (attached to Karen Lee Grubb Declaration).²

² Similarly, the same dictionary also defines “Wise” as a suffix as “[i]n a specified manner, direction, or position.” The American Heritage College Dictionary 1573 (4th ed. 2007) (attached to Grubb Decl.). An alternative definition of “Way” is “[a] specific direction.” Id. at 1551.

“Way,” like “Wise,” is also defined as a “method or manner of doing.” *Id.* at 1551. Thus, GreenWise® and Green Way both connote products that fit within a lifestyle – or way of life – that is healthy and environmentally-friendly. These marks, therefore, are similar in meaning.

The similarities between GreenWise® and Green Way are particularly likely to foster confusion in the marketplace, which is of course the place where the likelihood of confusion must be measured. “The marks ‘must be compared in the light of what occurs in the marketplace, not in the courtroom.’” Beer Nuts, Inc. v. Clover Club Foods Co., 711 F.2d 934, 941 (10th Cir. 1983) (“Beer Nuts I”) (quoting James Burrough Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 275 (7th Cir. 1976)). Consequently, “the fallibility of memory over a period of time” must be taken into account when deciding whether two marks are similar in appearance, sound, connotation, or commercial impression. Geigy Chem. Corp. v. Atlas Chem. Indus., Inc., 58 C.C.P.A. 972, 974 (C.C.P.A. 1971).

Moreover, because GreenWise® and Green Way marks identify “private-label” brands, the marks are unlikely to appear side-by-side on store shelves. At least as the marks are currently deployed, GreenWise® products and services are sold in Publix® stores, and Green Way products in A&P’s stores. Irby Decl. ¶¶ 6, 10; Palmer Decl. ¶ 7. This “inability to compare the products side by side and observe the precise differences in appearance may increase the likelihood of confusion,” because in “making a decision to purchase the consumer must rely on memory rather than a visual comparison.” Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186, 192 (5th Cir. 1981) (citing 3 R. Callman, The Law of Unfair Competition Trademarks and Monopolies § 81.1 at 573 (3d ed. 1969)). So, for example, if the recently introduced Green Way mark expands to be used on the full range of goods cited in A&P’s applications, consumers who are winter residents of Florida and summer residents of the

Northeast are likely to encounter Green Way products and erroneously assume they are versions of the genuine GreenWise® products they have seen in Publix stores for years. Irby Decl. ¶ 21. The inability of such consumers to make a side-by-side comparison will actually enhance the likelihood of confusion.

The fact that GreenWise® and Green Way have the same meaning and create the same commercial impression is supported by the advertising of the parties for these two brands. See Morton-Norwich Products, Inc. v. S.C. Johnson & Son, Inc., 531 F.2d 561, 562-63 (C.C.P.A. 1976) (using advertisements to support finding that the connotation and commercial impressions of Rainfresh for liquid detergents was similar to that of Rain Barrel for fabric softener). Publix describes its GreenWise® goods and services as “Organic, All-Natural, and Earth-Friendly.” E.g., Irby Decl. Ex. E (including magazine covers that display the phrase “Organic, All-Natural, and Earth-Friendly” in the top-left corner). A&P similarly describes its Green Way products as “natural, organic and earth friendly” and as “[t]he organic, natural and ecologically smart brand.” Palmer Decl. ¶¶ 3, 7. Thus, the commercial impression created by Publix’s GreenWise® mark is the same as that sought to be created by the Green Way mark – the marks identify products that are organic, all-natural, or made in an environmentally-friendly way.

The similarity in this case is even more pronounced than in H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62 (T.T.A.B. 1979). In Sohne, the applicant sought to register the mark “Blue Angel” for wine. Id. at 63. The opposer owned the registration for “Blue Nun,” also for wine. Id. Thus, like here, the marks were to be used on identical goods. The panel found that the use of the arbitrary term “Blue” with a second word with religious connotation meant that the two marks were “similar in sounds, appearance and meaning.” Id. at 64. The panel rejected the claim that the differences between “Nun” and

“Angel” controlled the likelihood of confusion analysis, because despite those differences “the marks convey the same general idea or stimulate the same mental reaction.” Id. at 65.

Accordingly, the marks were found confusingly similar. Id. at 66. See also H. Sichel Sohne, GmbH v. John Gross & Co., 204 U.S.P.Q 257, 261 (T.T.A.B. 1979) (cancelling registration for “Blue Chapel” for wine based upon the similar commercial impression for the senior “Blue Nun” mark for wine).

Similarly, the Federal Circuit has held that the marks “Spice Islands” and “Spice Valley” for teas have the same connotation and commercial impression, thus causing a likelihood of confusion and requiring the rejection of the “Spice Valley” application for registration. Specialty Brands, Inc. v. Coffee Bean Distribs., Inc., 748 F.2d 669 (Fed. Cir. 1984). Like the GreenWise® and Green Way marks, the Spice Islands and Spice Valley marks consisted of two words with the first being identical. Id. at 672. The second words were the same in that they were both “topographically defined place[s].” Id. Thus, “the similarity of commercial impression” between SPICE VALLEY and SPICE ISLANDS weighed “heavily against the applicant as applied to identical goods.” Id. at 673. See also Jellibears, Inc. v. Skating Clubs of Ga., Inc., 716 F.2d 833, 842 (11th Cir. 1983) (“Jellibears” and “Lollipops” for skating rinks “evoke the same general impression” and thus were substantially similar). Similarly, the GreenWise® and Green Way marks create the same commercial impression

The appearance and sound of the marks also are substantially similar. Both marks begin with “Green” and end with a word or suffix which begins with a capital “W.” The “W” word/suffix is also one syllable in both marks. The inclusion of a space between the two constituent parts in A&P’s mark does not alter the substantial similarity between the two marks’ appearance and sound. See Supercuts, Inc. v. Super Clips, 18 U.S.P.Q.2d 1378, 1380 (D. Mass

1990) (SUPERCUTS and SUPER CLIPS were “hardly distinguishable”). In fact, the appearance and sound of marks with fewer similarities have been found to be substantially similar.

In Jellibeans, the Eleventh Circuit discussed the similarities in appearance and sound for the marks “Jellibeans” and “Lollipops” for skating rinks. 716 F.2d at 842. The marks were visually similar, because they were both spelled with an “i” rather than a “y” and both used the plural form. Id. The marks also were similar in sound. “In finding an aural similarity, the [district] court noted that each name has three syllables, with an “l” sound dividing the first and second syllables, and an “e” sound dividing the second and third syllables, and that each names ends in a plural “s.” Id. The Eleventh Circuit affirmed these holdings. Id. The visual and sound similarities of GreenWise® and Green Way are, of course, much greater. See also G.D. Searle & Co. v. Chas. Pfizer & Co., 265 F.2d 385, 387 (7th Cir. 1959) (rejecting the trial court’s conclusion as clearly erroneous where it was found that the marks Dramamine and Bonamine were not similar in sound, the appellate court explained that “[s]light differences in the sounds of similar trademarks will not protect the infringer”).

A&P's efforts to highlight the few differences between the two marks do not alter the conclusion that the marks have identical or similar appearances, sound, connotation, and commercial impression. Rather, in a “similarity of the marks analysis,” “similarities weigh more heavily than differences.” Beer Nuts I, 711 F.2d at 940 (quoting AMF, Inc., 599 F.2d at 351; Vitek Sys., Inc. v. Abbott Labs., 675 F.2d 190, 192 (8th Cir. 1982)). Thus, A&P’s efforts to deny the similarities of the marks by highlighting insignificant dissimilarities carry virtually no weight in the analysis. As a result of the striking similarities in the marks’ appearance, sound, connotation and commercial impression, registrations should be denied A&P.

III. Goods Upon Which the Marks Are Used Are Inexpensive and May Be Purchased on Impulse.

Because the goods upon which both the GreenWise® and Green Way marks are used are relatively inexpensive, they are particularly susceptible to consumer confusion. “When products are relatively low-priced and subject to impulse buying, the risk of likelihood of confusion is increased because purchasers of such products are held to a lesser standard of purchasing care.” Recot, 214 F.3d at 1329 (citing Kimberly-Clark Corp. v. H. Douglas Enter., Ltd., 774 F.2d 1144, 1146 (Fed. Cir. 1985)). Most GreenWise® products are sold for less than \$20. Irby Decl. ¶ 13. Consumers are unlikely to devote careful attention when comparing such low-cost items.

This analysis is not altered by A&P’s speculation that individuals who purchase organic, natural or environmentally-friendly goods might be more discriminating in their purchases than the average shopper. See Applicant’s Mot. for Summ. J. at 17-18.³ Knowledge or sophistication in one field “does not necessarily endow one with knowledge and sophistication in connection with the use of trademarks.” In re Decombe, 9 U.S.P.Q. 2d 1812, 1814-15 (T.T.A.B. 1988). See also In re Pellerin Milnor Corp., 221 U.S.P.Q. 558, 560 (T.T.A.B. 1983) (“The law has long recognized that even technically sophisticated and careful purchasers of industrial equipment and products are not necessarily expert in trademark evaluation or immune from source confusion.”). Moreover, GreenWise® and Green Way purchasers are not shopping for a \$30,000 Prius hybrid vehicle. See AMF Inc., 599 F.2d at 352 (“[W]hen goods are expensive, the buyer can be expected to exercise greater care in his purchases.”). The GreenWise® and Green Way marks do not identify expensive, seldomly replaced items such as automobiles, boats, computers, or

³ Articles that A&P’s counsel printed from the Internet, see Motion for Summ. J. at 17-18, are inadmissible hearsay. See, Horta v. Sullivan, 4 F.3d 2, 8 (1st Cir. 1993) (finding newspaper article inadmissible to prove truth of matters asserted).

television sets. Irby Decl. ¶ 13. The products at issue – including paper towels, bathroom tissue, potato chips and bread – are lower cost items sold at grocery stores to a wide range of consumers everyday. Consequently, even sophisticated consumers, who are unlikely to see the products side-by-side, are likely to confuse them.

The Tenth Circuit has rejected an argument similar to A&P's. In Beer Nuts, Inc. v. Clover Club Foods Co., 805 F.2d 920, 927 n.6 (10th Cir. 1986) ("Beer Nuts II"), the district court found that consumers used substantial care in purchasing snack items, based upon testimony about a survey reporting that "consumers often exercise great care in purchasing potato chips." The Tenth Circuit found this holding to be erroneous. Id. at 927. Instead, because the items were inexpensive "these items are more likely to be confused than expensive items which are chosen carefully." Id. at 926 (quoting Beer Nuts I, 711 F.2d at 941). A&P's proposition that the carefulness of purchasers of organic, natural or environmentally-friendly products weighs against Publix's opposition should similarly be rejected. The low cost of GreenWise® and Green Way items weighs decidedly in Publix's favor and increases the likelihood of confusion between the two marks in this case.

IV. The Channels of Trade Are Similar.

Because A&P and Publix both operate retail grocery stores, the parties also operate in similar channels of trade, another significant DuPont factor that A&P does not address. Publix's GreenWise® goods and services are sold in retail grocery stores, just as A&P sells its Green Way goods in its retail grocery stores. Irby Decl. ¶¶ 6, 10; Palmer Decl. ¶ 7. Nothing in A&P's applications limits its sales channels or suggests the goods will not be sold in the same manner as Publix's GreenWise® goods and services. Nothing prevents A&P from selling Green Way products to other retailers in any geographic market. Accordingly, the fact that the parties utilize

identical trade channels – i.e., direct sales to consumers in grocery stores – further suggests a likelihood of confusion.

A similar conclusion was reached by the Federal Circuit in Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 877 (Fed. Cir. 1992). The Board in Century 21 found that the two parties “advertise in the same media, offer the same services to the same types of purchasers, and employ the same trade channels,” but discounted the trade channels factor because the insurance products upon which the marks were used were not sold by the same vendors. Id. The Federal Circuit rejected this approach and noted that “[a]n opposer need not establish the sale of both parties’ services by the same vendor to show employment of the same trade channels.” Id. (citing DuPont, 476 F.2d at 1357). Similarly, in this case, the GreenWise® and Green Way goods may not appear on the same grocery shelves, but this does not avoid the conclusion that the goods utilize identical trade channels, a factor that heavily favors Publix.

V. GreenWise® is a Famous, Strong Mark Entitled to Broad Protection From Similar Marks.

“Famous marks ... enjoy a wide latitude of legal protection.” Recot, 214 F.3d at 1327 (citing Kenner Parker, 963 F.2d at 352-53). “Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark.” Id. (citing Kenner Parker, 963 F.2d at 352). “[T]he fame of a mark may be measured indirectly, among other things, by volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” Bose Corp. v. QSC Audio Prods., Inc., 293 F.3d 1367, 1371 (Fed. Cir. 2002) (citations omitted). This case law compels the conclusion that GreenWise® is a famous, strong mark.

As explained more fully in the portion of Mr. Irby's affidavit being filed under seal, the GreenWise® mark is the subject of extensive marketing expenditures, and GreenWise® sales have been significant. Irby Decl. ¶¶ 14-15. Moreover, the mark has been in use for nearly a decade. Id. ¶ 8. A period of less than nine years of use of a mark has been found sufficient for a mark to be considered famous. Kimberly-Clark Corp. v. H. Douglas Enters., Ltd., 774 F.2d 1144, 1145-47 (Fed. Cir. 1985) (describing use of mark for less than seven years). Similarly, the GreenWise® annual sales are well in excess of levels that the Federal Circuit has found sufficient to establish fame. See Bose Corp., 293 F.3d at 1372 (annual sales of greater than \$50 million were sufficient to establish fame of the mark).

As the Federal Circuit has explained:

Achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. After earning fame, a mark benefits not only its owner, but the consumers who rely on the symbols to identify the source of a desired product. Both the mark's fame and the consumer's trust in that symbol, however, are subject to exploitation by free riders.

Kenner Parker Toys, 963 F.2d at 353. Because the GreenWise® mark has achieved fame, under the DuPont analysis, it is entitled to the broadest level of protections from A&P's attempt at free riding. Thus, this factor too supports a finding that there is a likelihood of confusion between the GreenWise® and Green Way marks.

VI. Third-Party Registrations for Marks Including the Term "Green" Do Not Preclude a Finding That Confusion is Likely.

Another factor that can bear on a likelihood of confusion analysis is the "number and nature of similar marks in use on similar goods." DuPont, 476 F.2d at 1361. However, and despite A&P's superficial argument that the word "green" is common, Applicant's Mot. for Summ. J. at 12-16, that argument is not dispositive, because the similarity of the Publix and A&P marks rests on much more than merely the shared word "green." A&P seeks registration of a

similarly sounding mark with the same meaning to be used in a similar business to identify another private-label line of organic, natural, and environmentally-friendly products. These facts in combination make confusion likely.

Again in H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc., 202 U.S.P.Q. 62 (T.T.A.B. 1979), the Board was faced with a similar opposition proceeding involving marks for identical goods, wine. Id. at 63. The marks also included the identical color word, “blue,” as the first word in the mark, followed by related religious words, “Nun” and “Angel.” Id. The applicant cited other marks that included the term “blue” and identified alcoholic beverages. These third-party uses, the applicant asserted, weakened the Blue Nun mark, precluding any finding of likelihood of confusion in that case. Id. at 66. The Board rejected that argument:

We must remember that the conflict herein is between “BLUE ANGEL” and “BLUE NUN”, and the fact that others have used and/or registered marks containing a certain feature in common with these marks for similar goods cannot preclude a holding that these marks as a whole are confusingly similar.

Id. (citations omitted).

Likewise, in this case, the conflict is between GreenWise® and Green Way for a variety of identical and related goods. A&P has cited no other use of a mark that combines the word “green” with a one-syllable suffix for a broad “house brand” of groceries items. Although others may use “green” marks, such use does not preclude a finding that Green Way is confusingly similar as a whole to the GreenWise® mark. The Board must determine each case on its own record, and prior decisions by examining attorneys concerning other “green” marks are not binding. See In re Nett Designs, Inc., 236 F.3d 1339, 1342 (Fed. Cir. 2001) (PTO’s allowance of prior registrations does not bind the Board). In light of the similarities discussed earlier, there is at least as much similarity between the GreenWise® and Green Way marks as between BLUE NUN and BLUE ANGEL. These marks, therefore, are confusingly similar.

VII. A Lack of Actual Confusion is Not Significant.

Because A&P filed intent-to-use applications and only recently introduced its Green Way mark on goods sold in its stores, a lack of actual confusion at this point is not significant. See Wella Corp. v. Cal. Concept Corp., 558 F.2d 1019, 1023 (C.C.P.A. 1977) (lack of actual confusion was not probative, because junior mark had been used for only “a short period of time”). The Patent & Trademark Office is not required to wait for confusion to occur before rejecting a proposed confusing mark. In fact, “actual confusion is not necessary to show a likelihood of confusion.” Hewlett-Packard Co., 281 F.3d at 1267 (citing Giant Food, Inc. v. Nation’s Foodservice, Inc., 710 F.2d 1565, 1571 (Fed. Cir. 1983)). Moreover, the lack of actual confusion is understandable, given the geographic separation between A&P and Publix.⁴ See Giant Food, 710 F.2d at 1571 (“Although both parties have used their respective marks over a number of years, there is no evidence of actual confusion. However, this would appear to be due, not to dissimilarities of the marks, but mainly to the geographic separation of the two parties’ operations.”) Thus, this DuPont factor also weighs in Publix’s favor.

VIII. The Evidence Belies A&P’s Professed Good Faith.

A&P knew, or at least should have known, full well that it was trading ever so closely to Publix’s GreenWise® mark. Despite this fact, A&P professes to have sought registration in “good faith.” The evidence, however, is to the contrary.

The search report that A&P reviewed prior to using Green Way highlighted Publix’s GreenWise® registrations. Palmer Decl. Ex. A (pages A&P 00636-638). Notwithstanding these

⁴ The geographic separation of the two companies and their stores also completely undercuts A&P’s internal study that was conducted only in states in which Publix does not operate – New Jersey, New York, Pennsylvania, and Maryland. Palmer Decl. Ex. D (page A&P 00996).

search results, A&P pushed forward with its applications and introduced the Green Way mark. A&P's knowledge of the GreenWise® marks demonstrates a lack of good faith. Courts have found that "deliberate adoption of a similar mark may lead to an inference of intent to pass off goods as those of another which." Beer Nuts II, 805 F.2d at 927. In fact, some courts have gone so far as to presume intent to deceive the public when a party "knowingly adopts a mark similar to another." Synergistic Int'l, Inc. v. Windshield Doctor, Inc., No. CV 03-579 FMC (CWx), 2003 WL 21468568, at * 7 (C.D. Cal. Apr. 28, 2003) (quoting Official Airline Guides, Inc. v. Goss, 6 F.3d 1385, 1394 (9th Cir. 1992)).

A&P uses the same three pillars to support its Green Way products as Publix uses for its GreenWise® line of products. Both sets of products feature goods that are organic, natural, or Earth-friendly. Compare Irby Decl. ¶ 7 with Palmer Decl. ¶ 7. In fact, A&P's entire Green Way product line mimics the GreenWise® brands and services from market position to mark chosen. The facts undercut A&P's argument that it adopted its mark in good faith. Other similarities between the marketing of the two product-lines, discussed supra, also supports a finding of bad faith and a finding of likelihood of confusion between the two marks.

IX. Any Doubt Must Be Resolved in Publix's Favor.

It is well-settled that in opposition proceedings, any doubt as to the likelihood of confusion must be resolved in favor of the senior user. This "Rule of Doubt" or "Newcomer Rule" is "too well settled as an axiom of trademark law to require citation to precedent that on the statutory issue involved here doubts are to be resolved against the newcomer and in favor of the prior user." San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp., 565 F.2d 683, 684 (C.C.P.A. 1977). In fact, a newcomer is "under a duty to select a mark sufficiently far afield from that of [an] opposer to avoid any likelihood of confusion." Steelcase Inc. v. Steelcare Inc.,

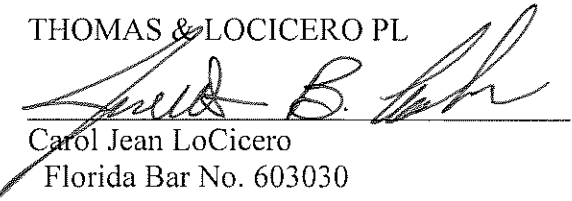
219 U.S.P.Q. 433, 437 (T.T.A.B. 1983). A&P had a duty to select a mark sufficiently distinct from Publix's GreenWise® mark so as to avoid the likelihood of confusion which is present in this case. Because A&P did not fulfill this duty, its motion for summary judgment should be denied, and judgment should be entered in Publix's favor.

Conclusion

Publix has invested more than nine years and millions of dollars in its GreenWise® brand of organic, natural, and environmentally-friendly products and a host of related services. Now, A&P seeks to register a mark that is identical in meaning and substantially similar in appearance and sound for both identical and highly related goods. These factors alone dictate that A&P's motion for summary judgment be denied. The other applicable DuPont factors also support a finding that confusion of GreenWise® and Green Way is likely. As a result, A&P's motion should be denied, and judgment should be entered in Publix's favor.

Respectfully submitted,

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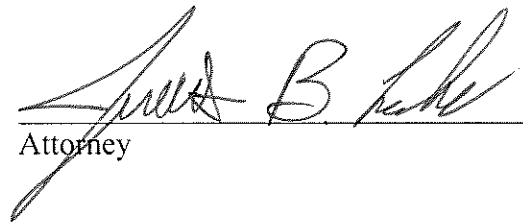
Publix Asset Management Company

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on September 10, 2010, a true and complete copy of the foregoing motion with the declarations of Mark Irby and Karen Lee Grubb have been sent by

E-mail Facsimile Express Mail First Class U.S. Mail, postage pre-paid, to:

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