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

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

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

**APPLICANT’S REPLY MEMORANDUM OF LAW IN FURTHER
SUPPORT OF APPLICANT’S MOTION FOR SUMMARY JUDGMENT**

Applicant, The Great Atlantic & Pacific Tea Company, Inc. (“Applicant”), respectfully submits this Reply Memorandum of Law in further support of its motion for summary judgment.

PRELIMINARY STATEMENT

Publix Asset Management Company (“Opposer”) has failed to raise a genuine issue of fact so as to defeat summary judgment in Applicant’s favor. As Applicant’s moving papers demonstrate, Opposer cannot show that there is a likelihood of confusion between Opposer’s mark GREENWISE (“Opposer’s Mark”) and Applicant’s mark GREEN WAY, which is the subject of Applications Ser. Nos. 77/349,246 and No. 77/409,725 (combined as “Applicant’s Mark”).¹ Nor can Opposer meet the heavy burden of establishing fame for dilution purposes.

¹ Opposer has effectively conceded that there are no disputed issues of fact by requesting summary judgment in its favor instead.

ARGUMENT

I. Opposer Has Failed to Raise A Genuine Issue of Fact

Once the moving party has made an initial showing that there is no evidence to support the nonmoving party's case, the party opposing the motion must come forward with "specific facts showing that there is a genuine issue for trial." *Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). Unsubstantiated allegations and mere denials are not sufficient. *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 1562 (Fed. Cir. 1987). Since Opposer has failed to present competent evidence that creates a genuine issue of fact on its claims for likelihood of confusion and dilution, Applicant's motion for summary judgment should be granted in all respects.

A. Opposer's Mark is Weak

Opposer's papers largely ignore the exhibits of Applicant which show that the term "GREEN" is widely used in connection with organic, healthy and eco-friendly products by hundreds of third parties, and thus is weak. In *Stouffer Corp. v. Health Valley Natural Foods, Inc.*, 1 U.S.P.Q.2d 1900 (T.T.A.B. 1987), the Board held that in considering the issue of confusion, the fact that the portion of the mark common to the corresponding portion of the other party's mark is weak can be determinative. Thus, in *Stouffer*, the Board held the marks LEAN CUISINE and LEAN LIVING, both for diet food products, were not likely to cause confusion. *Id.* at 1904. In *Weight Watchers Int'l, Inc. v. I. Rokeach & Sons, Inc.*, 211 U.S.P.Q. 700, 706 (T.T.A.B. 1981), *aff'd on other grounds*, 546 F. Supp. 841 (S.D.N.Y. 1982), the Board held that WEIGHT WATCHERS and WEIGHT WISE were not confusingly similar in light of the weakness of the term "WEIGHT" and the differences in the terms "WATCHERS" and "WISE." Given the inherent weakness of Opposer's Mark and the plethora of registered marks and

common law uses of the term “GREEN,” for food and eco-friendly products, the fact that the only similarity between the marks is the weak term “green” can be dispositive.

In addition, the fact that the word “way” in Applicant’s GREEN WAY mark starts with the letter “w” and that Opposer’s GREENWISE mark incorporates the letter “w” within does not mean that the parties’ respective marks are similar.² See, *Weight Watchers Int’l*, 211 U.S.P.Q. at 706 (WEIGHT WATCHERS and WEIGHT WISE not confusingly similar). Moreover, there are numerous third party registrations for marks that use the term “GREEN” along with a second word that starts with a “w.” Opposer’s Mark coexists with registrations for the marks GREEN WORKS (Reg. No. 3,413,473); GREEN WONDER (Reg. No. 1,591,633); GREENWOOD’S (Reg. Nos. 713,937) and GREENWICH (Reg. No. 3,106,357). Declaration of Midge M. Hyman (“Hyman Decl.”), ¶ 4, Ex. A. Opposer also coexists with the mark GREEN WORKS, owned by The Clorox Company, which is used on a wide-variety of eco-friendly products. Hyman Decl., ¶ 8, Ex. E. Consumers are able to discern the differences between Opposer’s Mark and the hundreds of other marks that start with the term “GREEN,” and Opposer has not put forth any reason why Opposer’s Mark and Applicant’s Mark cannot also coexist.

B. The Parties’ Marks Are Not Similar In Meaning

Opposer’s Mark and Applicant’s Mark are not similar in meaning. As an initial matter, Opposer’s Mark consists of one word, GREENWISE, which does not have a dictionary meaning. Moreover, the dictionary definition submitted as an exhibit by Opposer contains numerous entries for the word “wise” and the definition on which Opposer relies is actually a subordinate

² Opposer, left without viable arguments, brazenly attempts to use semantic and visual tricks, such as typing its mark so that only the “G” and “W” are capitalized in order to give the impression that its mark consists of two separate words rather than the single block letter mark that appears in all of Opposer’s registrations and applications.

entry. *See* Declaration of Karen Lee Grubb (“Grubb Decl.”) ¶3, Ex. A at 1573. The leading entry contains several definitions for the word, including, among others:

1. Having the ability to discern or judge what is true, right or lasting; sagacious: a wise leader. 2a. Exhibiting common sense; prudent: a wise decision. b. Shrewd; crafty. 3. Having great learning; erudite.
4. Provided with information; informed. ... 5. *Slang* Rude and disrespectful; impudent.

Grubb Decl. ¶3, Ex. A at 1573. There is also a separate entry for “-wise” as a suffix, which contains a “usage note” that states that since the 1930s, the suffix -wise has been widely used to mean ‘with reference to,’ as in *This has not been a good year saleswise.*”

Opposer’s exhibit also contains a lengthy definition for the word “way” (as in Applicant’s GREEN WAY) that itself includes at least 18 different meanings and takes up nearly ½ the page. Grubb Decl. ¶3, Ex. A at 1551. Among the definitions listed is “a road, path, or highway affording passage from one place to another,” “[s]pace to proceed,” “[p]rogress or travel along a certain route or in a specific direction,” and “a course of conduct or action.” *Id.*

Where the words at issue are susceptible to different meanings and there is no link between a specific meaning and the goods at issue, the mark is not subject to any common public understanding. *In re Classic Beverage Inc.*, 6 U.S.P.Q.2d 1383, 1383, 1386-87 (T.T.A.B. 1988) (where the term at issue had many definitions, the Board could not ascribe one particular meaning to applicant’s mark). *See also, Gimix, Inc. v. JS & A Group, Inc.*, 699 F.2d 901, 906 (8th Cir. 1983) (where the term at issue is susceptible to multiple meanings, the mark is not subject to any common public understanding).

Notably, Opposer has not come forth with any evidence that shows how consumers perceive the word “wise” as used as a suffix in Opposer’s Mark. However, Opposer promotes its mark with phrases like “Get wise to Publix GreenWise Market” (GW 002061) and refers to “Smarter Eating” and “smart eating strategies” (GW 002551; GW 002053) when advertising its

GREENWISE products. See Declaration of Mark R. Irby (“Irby Decl.”), ¶¶ 12, 14, Ex. E, F. In addition, Opposer’s GREENWISE magazine is said to be designed to help consumers make “smart, natural choices.” Irby Decl., ¶ 12.

The cases cited by Opposer to support a similarity of meaning are readily distinguishable. In stark contrast to the case here, in *H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc.*, 202 U.S.P.Q. 62, 64-65 (T.T.A.B. 1979), the opposer’s mark, “BLUE NUN,” was completely arbitrary when used in connection with wines. Moreover, the applicant’s mark combined the term “BLUE” with a word that had a religious connotation that was similar to the word “NUN,” *i.e.*, “ANGEL. *Id.* at 65. Similarly, in *Hancock v. Am. Steel & Wire Co. of N.J.*, 97 U.S.P.Q. 330, 332 (C.C.P.A. 1953), the opposer’s mark – TORNADO – was arbitrary when used in connection with fencing and the applicant’s mark – CYCLONE – was identical in meaning. *Id.* In *Jellibeans, Inc. v. Skating Clubs of Ga., Inc.*, 716 F. 2d 833, 841 (11th Cir. 1983), the plaintiff’s mark, JELLIBEANS, was arbitrary when used for roller rinks – in fact, plaintiff’s roller rink was the only one in the U.S. that used a candy name. The defendant’s mark, LOLLIPOPS, was therefore similar because it consisted of a similar candy name. *Id.* at 842. In *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 672-673 (Fed. Cir. 1984), the marks are issue – SPICE ISLAND and SPICE VALLEY – were found similar because they both consisted of two words and they both utilized the term SPICE in conjunction with the name of a place, thus conveying a similar overall meaning. Further distinguishing *Specialty Brands* from the instant case was the fact that the SPICE ISLAND mark’s strength derived from over forty years of use. *Id.* at 674. In fact, therefore, none of these cases involved a weak mark like Opposer’s that consists of a common term like “GREEN” that is used by hundreds of third

parties to identify healthy and eco-friendly products. As such, these cases do not support Opposer's position that the parties' marks are similar in meaning in this case.

C. Opposer Has Not Created A Genuine Issue of Fact Regarding Applicant's Intent

Discovery has closed and Opposer cannot point to any evidence in the record that shows that Applicant in any way intended to capitalize on Opposer's reputation or trade upon Opposer's Mark when Applicant adopted its mark. Bald, unsupported assertions are not sufficient to create a genuine issue of fact. *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 U.S.P.Q.2d 2077, 2081 (T.T.A.B. 1989). Instead, Applicant's good faith is supported by the fact that Applicant's internal research focused on many different brands and Opposer was never mentioned.

Declaration of Douglas Palmer, ¶ 3, 9, Ex. D. Opposer also carefully searched the GREEN WAY mark. *Id.* ¶ 4, Ex. A.

D. Opposer Has Not Created A Genuine Issue Regarding The Discriminating Nature of the Relevant Consumers

As set forth in Applicant's initial brief, purchasers of "green" food products are discriminating. Opposer's claim that consumers are "particularly susceptible to consumer confusion" because the goods at issue are relatively inexpensive is not supported by any evidence in the record. As the Board held in a similar case, "even in the hustle and bustle atmosphere of a supermarket," diet-conscious consumers are apt to be discerning regarding their purchases. *Stouffer Corp.*, 1 U.S.P.Q.2d at 1902.

E. Opposer's "Snowbirds" Argument Is a Red Herring and Should Be Disregarded

Opposer claims that the likelihood of confusion is heightened in this case because the relevant consumers are snowbirds, *i.e.*, Northeasterner residents who spend the summer in Florida. Irby Decl., ¶ 21. Opposer argues that since the parties' products are not likely to appear

side by side, these “snowbirds,” who are used to seeing Opposer’s products in Florida, will see Applicant’s products in the Northeast and are likely to think that Opposer had expanded its product line into that region. This argument is merely a “red herring” and should be discounted. Applicant’s GREEN WAY products are no different than the many other third party GREEN marketed products, *i.e.*, the GREEN GIANT and GREEN WORKS brands, which the relevant consumers, including “snowbirds,” have been able to readily distinguish.³ In addition, Opposer has not produced any demographic data or other statistics regarding Opposer’s customers or Applicant’s customers in discovery. As such, this allegation should be given no weight.

Nature's Way Products Inc. v. Nature's Herbs Inc., 9 U.S.P.Q.2d at 2081.

Nevertheless, even if Opposer’s premise was accepted as true, since Opposer’s Mark is always used in connection with the PUBLIX Mark in Publix supermarkets and in free-standing Publix Greenwise Markets, consumers are aware that that brand is associated with Publix.⁴ *Irby Decl., Ex. F. See, McDonald's Corp. v. Burger King Corp.*, 54 U.S.P.Q.2d 1507, 1507 (E.D. Mich. 1999) (“Because McDonald's and Burger King each have highly identifiable marks, it is difficult to imagine that any consumer visiting a restaurant of either party would believe that he or she is at the other party's restaurant”).⁵ Accordingly, Opposer’s argument regarding “snowbirds” does not weigh in favor of a finding of confusion.

In sum, since all of the *DuPont* factors favor Applicant, summary judgment should be granted in Applicant’s favor.

³ Opposer has also tried to distort the issues by focusing on the fact that Applicant is the operator of supermarkets. However, Applicant’s applications cover goods, not services.

⁴ In fact, Opposer’s Reg. No. 2520594 is for the mark PUBLIX GREENWISE MARKET for retail grocery store services. Opposer also has registrations for PUBLIX GREENWISE MARKET for a variety of food products, *i.e.*, Reg. Nos. 2729422, 2843303, 2688904, and 2683967.

⁵ Moreover, this statement is completely inconsistent with Opposer’s arguments in its brief that the lack of actual confusion is due to the geographic separation between A&P and Publix stores.

II. Opposer Did Not Establish Dilution

A. The Parties' Marks Are Not Essentially Identical

For dilution purposes, a party must use essentially the same mark, not just a similar one. *Thane Int'l v. Trek Bicycle Corp.*, 305 F.3d 894, 905 (9th Cir. 2002); *Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 932 (8th Cir. 1999) quoting *McCarthy on Trademark and Unfair Competition* 24:90.1 (4th ed. 1998). Given the notable differences between the parties' marks, Opposer's claim for dilution fails on this ground alone.

B. Opposer Did Not Establish That Its Mark Is Famous

As set forth in Opposer's moving brief, Opposer did not establish that GREEN WISE is a famous mark for the purposes of dilution. See, *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1170 (T.T.A.B. 2001). To be famous for dilution, the mark must rise to the level of a household name. *Milbank Tweed Hadley & McCloy LLP v. Milbank Holding Corp.*, 2007 U.S. Dist. LEXIS 97934, *13 (C.D. Cal. 2007). Opposer's GREENWISE Mark does not come close to meeting this standard.

Opposer's Mark is not sufficiently distinctive to warrant dilution protection. If the evidence indicates that there are also numerous other uses of the term, the fame of the mark is limited. *Toro*, 61 U.S.P.Q.2d at 1177. Here, Opposer's Mark is inherently weak because it contains the descriptive term "GREEN," which is used to show that its products are organic, natural and eco-friendly. The descriptive nature of this term and the extensive third party use of the term "GREEN" for eco-friendly and health conscious products weighs against a finding of

fame.⁶ *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1539 (9th Cir. 1989) (widespread use defeated dilution claim).

C. Opposer's Sales and Advertising Figures Are Not Sufficient to Show Fame

An opposer must show more than extensive sales and advertising figures to prove fame. *Toro*, 61 U.S.P.Q.2d at 1179-81 (fame for dilution purposes cannot be shown with general advertising and sales figures and unsupported assertions of fame). It must demonstrate that as a result of such sales and advertising, the public associates the mark with opposer in nearly every context. *Id.* at 1181. Thus, the Board has dismissed dilution claims based on sales and advertising figures that were far more extensive than those presented in this case. For instance, in *Toro*, notwithstanding that Opposer had used its mark for over 85 years, had 3,000 dealers worldwide, sales of \$1.3 billion and \$35-40 million in advertising expenditures, the Board held that Opposer failed to show that its mark was famous for dilution purposes. *Id.* at 1179.

The sales and advertising figures set forth in Opposer's opposing papers are not supported by any business or sales records of the company. Irby Decl., ¶ 15. As such, they are not competent evidence to prove such sales. In any event, even accepting those figures as true, Opposer has not shown any link between its advertising expenditures and consumer recognition of its mark. *Toro*, 61 U.S.P.Q.2d at 1180 (“[p]arties claiming their marks are famous must establish conclusively that the advertising has succeeded”). Such a link is typically shown through a consumer survey. *See, Tcip Holding Co. v. Haar Communs., Inc.*, 244 F.3d 88, 99 (2d Cir. 2001) (no consumer surveys were presented to show extent or dimension of public recognition of mark). Nor has Opposer shown the market share of its sales figures *vis à vis* sales

⁶ See discussion in Applicant's moving brief, p.12, referring to over 300,000 registered marks incorporating the word “GREEN” as well as extensive common law usage.

of grocery products generally.⁷ See, *In-N-Out Burgers v. Peak Harvest Foods, LLC*, 2008 T.T.A.B. LEXIS 563, at *34 (T.T.A.B. 2008) (rejecting claim of fame notwithstanding significant sales figures since applicant did not provide the market share represented by its receipts and expenditures).

D. Regional Fame is Not Sufficient

In order to be “famous,” a mark must be “widely recognized by the general consuming public of the United States” as a designation indicating the source of goods or services. 15 U.S.C. § 1125(c)(2)(A). Fame in just one geographic region (niche fame) is not sufficient. *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, 509 F.3d 380, 384 (7th Cir. 2007); *Milbank Tweed Hadley & McCloy LLP*, 2007 U.S. Dist. LEXIS 97934, *15-16; *In-N-Out Burgers*, 2008 T.T.A.B. LEXIS 563, at *34 (restaurants in 3 states not sufficient for fame).

CONCLUSION


For the foregoing reasons and those set forth in Applicant’s moving brief, Applicant’s motion for summary judgment should be granted and the Opposition dismissed with prejudice.

Dated: New York, New York
September 30, 2010

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: _____


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⁷ Opposer’s claims regarding sales under the GREENWISE umbrella are deliberately ambiguous. Irby Decl. ¶ 15. In fact, Opposer appears to be relying on sales from non-GREENWISE products, *i.e.*, third party brands, that are sold in Publix Greenwise Markets supermarkets to support the strength of the GREENWISE mark. Since there is no evidence as to what products are included in those figures, they should be given no weight for purposes of determining the fame of Opposer’s Mark.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 30, 2010, Applicant's Reply Memorandum of Law In Further Support Of Applicant's Motion For Summary Judgment was served by mailing a true and correct copy by first class mail to Opposer's attorneys at:

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