

**THIS OPINION  
IS NOT A PRECEDENT  
OF THE T.T.A.B.**

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

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Mailed: April 11, 2011

Opposition No. 91186148

Opposition No. 91186863

Publix Asset Management  
Company

v.

The Great Atlantic & Pacific  
Tea Company, Inc.

Before Seeherman, Ritchie and Wolfson, Administrative  
Trademark Judges.

By the Board:

The Great Atlantic & Pacific Tea Company, Inc.  
("applicant") filed two applications to register the mark  
GREEN WAY on a wide variety of items, including various food  
products, based on its allegation of an intent to use the  
mark in commerce (Application Serial Nos. 77409725 and  
77349246).

Publix Asset Management Company ("opposer") has opposed  
registration on the grounds that applicant's mark so  
resembles opposer's previously used and registered mark  
GREENWISE for retail grocery store services and a variety of  
products, including food items, that it is likely to cause

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confusion with opposer's mark.<sup>1</sup> In its notices of opposition, opposer pleaded ownership of several federal registrations for the mark GEEENWISE.<sup>2</sup> Applicant, in its answer to the notices of opposition, denied the salient allegations. Proceedings were consolidated, and discovery closed January 11, 2010. This case now comes before the Board for consideration of applicant's motion for summary judgment on opposer's claim of likelihood of confusion. The parties have fully briefed the motion.

In support of its motion, applicant contends that there can be no likelihood of confusion as a matter of law based on the differences between its mark GREEN WAY and opposer's mark GREENWISE, and the weakness of the term GREEN as shown by third-party use. Applicant also argues that the goods are directed to discriminating consumers, that the parties' respective marks have co-existed with no evidence of actual confusion, and that applicant adopted its mark in good faith. We view applicant as conceding, for the purposes of its motion, that the remaining *du Pont* factors may be treated as favoring opposer, such that any genuine disputes

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<sup>1</sup> The notices of opposition also assert the ground of dilution, but because neither the original nor amended consolidated notices of opposition allege that opposer's mark became famous before applicant's filing date, this ground was not properly pleaded. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001). Therefore, we have given it no consideration.

<sup>2</sup> On September 9, 2010, opposer filed a consented motion to amend its notices of opposition to plead recently issued registrations. Opposer's consented motion is granted, and the

with respect to such factors would not preclude entry of summary judgment in applicant's favor. See *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (applicant conceded all *du Pont* factors except for the factor of the similarity of the marks as favoring opposer).

In opposition to entry of summary judgment, opposer asserts that its mark GREENWISE is famous, that notwithstanding the popularity of the term GREEN in general, no other product line in the industry combines the word GREEN with a one-syllable suffix that starts with a W, that the marks GREEN WISE and GREEN WAY have the same connotation of the "green" manner of doing things, and that the marks will be encountered in the identical way as private label grocery store options, and will be marketed in the identical fashion to appeal to the same consumers. Both parties have supported their motions with declarations and a voluminous number of exhibits, all of which have been carefully considered.<sup>3</sup>

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consolidated notice of opposition attached to opposer's motion is the operative pleading.

<sup>3</sup> We note opposer's hearsay objection to applicant's articles obtained from online sources and submitted as evidence that "green" products appeal to well-educated and discriminating consumers. These articles were not considered for the truth of the matters asserted therein, but for what they show on their face, which is that the public may have been exposed to the articles and therefore may be aware of the information contained therein. *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009).

Summary judgment is only appropriate where there are no genuine disputes of material fact, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute as to any material fact, and that it is entitled to a judgment under the applicable law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). All doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Upon consideration of the parties' arguments and competing evidence, the Board finds that applicant has failed to carry its burden of establishing that it is entitled to judgment as a matter of law. At a minimum, applicant has failed to demonstrate the absence of a genuine dispute of material fact as to whether the marks GREEN WAY and GREENWISE are so dissimilar as to preclude a finding of likelihood of confusion. Moreover, we note that applicant's motion is not brought solely on the asserted differences in the marks, but also on the basis of the conditions of purchase, namely, the discriminating nature of the consumers; however, it has not demonstrated the lack of a genuine issue of fact with regard thereto. Compare, *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d

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1142 (Fed. Cir. 1991). Accordingly, applicant's motion for summary judgment is denied.<sup>4</sup>

Proceedings herein are resumed. Opposer as allowed until TWENTY DAYS from the mailing date of this order to file, if it wishes, a second amended notice of opposition with a legally sufficient claim of dilution, failing which this proceeding will go forward only as to the claim of priority and likelihood of confusion.

Applicant is allowed until FORTY DAYS from the mailing date of this order to file its answer to either the amended notice of opposition accepted earlier in this order or any second amended notice of opposition. Proceedings are resumed and dates are reset below:

Plaintiff's Pretrial Disclosures Due	<b>6/13/2011</b>
Plaintiff's 30-day Trial Period Ends	<b>7/28/2011</b>
Defendant's Pretrial Disclosures Due	<b>8/12/2011</b>
Defendant's 30-day Trial Period Ends	<b>9/26/2011</b>
Plaintiff's Rebuttal Disclosures Due	<b>10/11/2011</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>11/10/2011</b>

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<sup>4</sup> Although we have only mentioned two examples of a genuine dispute of material fact in this decision, this is not to say that this is all that would necessarily be at issue for trial. The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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