

ESTTA Tracking number: **ESTTA522330**

Filing date: **02/19/2013**

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

Proceeding	91186148
Party	Defendant The Great Atlantic & Pacific Tea Company, Inc.
Correspondence Address	ARLANA S COHEN COWAN LIEBOWITZ & LATMAN PC 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036-6710 UNITED STATES asc@cll.com, mgg@cll.com, trademark@cll.com, sbi@cll.com, jaj@cll.com
Submission	Reply in Support of Motion
Filer's Name	Arlana S. Cohen
Filer's e-mail	asc@cll.com, mgg@cll.com, trademark@cll.com, sbi@cll.com, jaj@cll.com
Signature	/Arlana S. Cohen/
Date	02/19/2013
Attachments	reply brief for leave to amend.pdf (12 pages)(35601 bytes) reply Gabriel Dec to reply brief for leave to amend.pdf (2 pages)(10161 bytes) Exhibits - Gabriel Decl.pdf (13 pages)(544607 bytes)

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

-----X

PUBLIX ASSET MANAGEMENT COMPANY, :

Opposer, :

Opposition No. 91186148
Opposition No. 91186863

v. :

THE GREAT ATLANTIC & PACIFIC TEA
COMPANY, INC., :

Applicant. :

-----X

**REPLY MEMORANDUM IN FURTHER SUPPORT OF MOTION BY APPLICANT
FOR LEAVE TO AMEND ITS ANSWER(S) AND ASSERT COUNTERCLAIMS**

Opposer has failed to state any valid reason why the Board should not grant Applicant’s motion to amend its answers to assert counterclaims under Section 18 for partial cancellation of Opposer’s registrations to limit the channels of trade for the goods listed in the registrations to the single and narrow channel of trade which has been *actually* used by Opposer: the supermarkets owned by its related company, Publix Supermarkets, Inc.

Failing to even cite the relevant test for motions to amend, which, pursuant to Fed. R. Civ. P. 15(a) should be “freely granted” absent prejudice, Opposer does not argue that it will suffer any prejudice from these amendments, nor could it. Despite Opposer’s prior interrogatory responses that were far from unequivocal, the recent testimony deposition of Mark Irby, Opposer’s President, wholly confirmed that Opposer’s house brand goods are sold *exclusively* in Publix supermarkets. No additional discovery is needed and indeed, no separate testimony period is needed with respect to the counterclaims. Thus, Applicant’s proposed amendments will not delay these proceedings in any manner.

Similarly deficient is Opposer’s argument that Applicant will be unable to *prove* the

merits of its proposed counterclaims, namely, that restriction of the description of goods in Opposer's registrations to the single channel of trade in which they actually are sold will not obviate likely confusion. But Applicant need not *prove* its proposed counterclaims on this motion to amend; Applicant merely is required to *plead* its cause of action, which it has done. (And, Applicant believes that it will ultimately prevail.)

ARGUMENT

Opposer's responsive papers wholly fail to recognize that Trademark Rule 2.106(b)(2)(i) *must* be read in context with other Trademark Rules and the liberal standard governing the amendment of pleadings under Fed. R. Civ. P. 15(a). As held by the Board in *See's Candy Shops, Inc. v. Campbell Soup Co.*, notwithstanding Trademark Rule 2.106(b)(2)(i), "Trademark Rule 2.107 provides that pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in the U.S. District Court. [See Fed. R. Civ. P. 15]." 12 U.S.P.Q.2d 1395, 1397 (T.T.A.B. 1989). "Consistent with Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings *at any stage of the proceeding* when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party." *Zanella Ltd. v. Nordstrom Inc.*, 90 U.S.P.Q.2d 1758, 1759 (T.T.A.B. 2008) (emphasis added) (citing *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B. 1993)). *See also Mitek Corp. v. Woods Indus. Inc.*, 41 U.S.P.Q.2d 1307, 1309 (T.T.A.B. 1996) ("Fed.R.Civ.P. 15(a) requires that leave to grant an amendment to the pleadings be 'freely given when justice so requires'"). Applicant's proposed counterclaims are not futile and Opposer has not established any legally cognizable prejudice that would result should the Board grant the motion to amend. To the contrary, it is Applicant who would be severely prejudiced if the Board denies the instant motion.

Indeed, in *Multi-Local Media Corp. v. Interstate Publisher's Corp.*, the Board expressly

rejected both arguments made by Opposer, namely, that Applicant's delay in seeking leave to assert its partial cancellation claim precluded amendment and that Applicant cannot prove the merits of its proposed claim. Cancellation No. 22,666, 1999 T.T.A.B. LEXIS 280, at *19 (T.T.A.B. July 1, 1999). As held by the Board:

Respondent's argument that the proposed amendment is prejudicial to respondent is not supported by a showing of any specific prejudice other than the normal cost and delay involved in defending a case . . . Respondent's argument that petitioner has not proven the elements required for a restriction to a registration under the case of *Eurostar Inc. v. 'Euro-Star' Reitmoden GmbH & Co. KG*, 34 U.S.P.Q.2d 1266 (T.T.A.B. 1994) is misplaced in that the elements of petitioner's case need not be proven at the pleading stage.

Id. at 19. Similarly here, the Board should reject Opposer's arguments and grant Applicant's motion for leave to amend.

**Opposer Would Not Suffer Any Prejudice
Should the Board Grant Applicant's Motion to Amend the Pleadings**

"Where, as in the present case, the motion for leave to amend is filed *prior to the commencement of trial*, the Board generally finds that the adverse party will not be prejudiced thereby." *Iomega Corp. v. Information Technology Int'l Corp.*, Opposition No. 117,476, 2001 TTAB LEXIS 549, at * 13 (T.T.A.B. July 20, 2001) (emphasis added) (citing T.B.M.P. § 507.02). *See also Hurley Int'l, LLC v. Volta*, 82 U.S.P.Q.2d 1339, 1341 (T.T.A.B. 2007) (granting motion for leave to amend "filed prior to the start of trial"); *Multi-Local Media Corp.*, 1999 T.T.A.B. LEXIS 280, at *18-20 (granting motion to amend made in pretrial stage of proceedings).

In its response, Opposer has not made any argument that it would be prejudiced should the Board grant the instant motion to amend, nor could it. Instead, Opposer merely argues that Applicant "delayed" in seeking leave to amend. However, delay alone is an insufficient ground upon which to deny a motion to amend. *See Hurley*, 82 U.S.P.Q.2d at 1341 (despite argument of

delay, leave to amend granted in absence of prejudice). *See also State Teachers Ret. Bd. v. Fluor Corp.*, 654 F.2d 843, 856 (2d Cir. 1981) (“Mere delay, [without] a showing of bad faith or undue prejudice, does not provide a basis . . . to deny the right amend”); *Multi-Local Media Corp.*, 1999 T.T.A.B. LEXIS 280, at *19-20 (amendment allowed; mere delay is not legally cognizable prejudice); *Iomega Corp.*, 2001 TTAB LEXIS 549, at * 14-15 (same).

As held by the Board in *Iomega Corp.*, where, as here, the opposer argued delay in opposition to a motion to amend:

We have carefully considered opposer’s arguments in support of its claim of prejudice, but are not persuaded that any legally cognizable prejudice would result from the granting of applicant’s motion for leave to amend. It is not dispositive that opposer has expended time and resources in litigating the case to date on the basis of the issues presented in the original pleadings; the same would be true in almost every case in which a party seeks to amend its pleading to add new claims or defenses. As noted above, the Board generally grants such motions to amend if they are filed prior to trial.

Id. at *13. Indeed, the Board in *Iomega Corp.* specifically granted leave to amend, ***even in the face of clear delay*** and although “applicant’s omission of its counterclaim from the original answer is in contravention of Trademark Rule 2.106(b)(2)(i),” which is the same deficient argument made by Opposer here. *Id.*, at *15.

Not only has Opposer failed to show any prejudice that would result should the Board grant Applicant’s motion to amend, but there has been no delay. Setting aside Opposer’s misleading description of the procedural posture of these proceedings, which have been suspended for most of the past three years, due in large part to Applicant’s prior bankruptcy status, Applicant does not contend that it became aware of Opposer’s limited use via Opposer’s interrogatory responses –nor could it, since Opposer failed to respond clearly and fully to an interrogatory directed to the inquiry.¹ Instead, prior to the commencement of trial, the parties

¹ During discovery, Applicant proffered a clear interrogatory seeking to determine the

conferred to reduce the issues remaining for trial such that, in effect, the pleadings would match the reality of the facts. Therefore, the parties sought to come to agreement on certain trial stipulations. Among the matters considered to be stipulated to was the fact that Opposer's products have only been sold in Publix stores, (and that indeed all the specimens bear the name "Publix"). The parties were able to agree on many stipulations, and these were filed with the Board on January 18, 2013, but Opposer would not agree to stipulate to the proposed counterclaims, although it did agree, in Trial Stipulation No. 8, that, "To the extent that A&P is granted leave to lodge its proffered counterclaims, neither party would be required to use and no adverse inference shall arise from the lack of use of a separate testimony period to lodge testimony on the counterclaims." See Plaintiff's Trial Stipulation, Stipulation No. 8 attached as Exh. A at ¶2 to the Reply Declaration of Michael G. Gabriel, Esq. ("Reply Gabriel Decl.").

Most importantly, the fact that all the specimens bear the name "Publix" was confirmed during the testimony deposition of Mark Irby, Opposer's President. See January 22, 2013, testimony deposition transcript of Mark Irby ("Irby Transcript"), Reply Gabriel Decl. Exh. B, ¶3.

exact channels of trade of Opposer's goods, namely: "State whether Opposer sells any product[s] in stores other than those owned by Opposer or by Publix Supermarkets, Inc." Gabriel Decl. Exh. M ¶14. In response, Opposer made the following vague and qualified statement: "Subject to the General Objections, Opposer states that, at this time, GREENWISE® products are sold by Publix Super Markets, Inc., and related companies pursuant to license agreements. However, GREENWISE® products are sold without any restriction on their resale, distribution, or use by consumers. Consequently, the sale of GREENWISE® products is not limited to sales by Opposer alone." *Id.* This response **did not state** that Opposer's goods were from the date of first use and at all times thereafter, sold only in Publix stores, (which is in fact the case).

It would be patently unfair to allow Opposer to enjoy the benefit of an unqualified and indistinct response in its earlier interrogatory answers, and then allow Opposer subsequently to block a proposed amendment based on the argument that it previously provided Applicant with equivocal information. See, e.g., *Mitek Corp.*, 41 U.S.P.Q.2d at 1309 (granting leave to amend where, *inter alia*, "opposer was not forthcoming with information" during discovery); *Turbo Sportswear, Inc v. Marmot Mountain Ltd.*, 77 U.S.P.Q.2d 1152, 1154 (T.T.A.B. 2005) (granting leave to amend where prior interrogatory responses were not definitive and grounds supporting amended claim were confirmed at subsequent deposition).

Q: Okay. Thank you. And I think he has testified that every use of a product that has GreenWise has “Publix” but not every product also has “market.”

A: Right...

Irby Transcript (78:6-10) at *Id.*

Thus, the grant of Applicant’s motion to amend is warranted, since it is fully substantiated by the facts. As stated, the granting of the motion result in any change to the current trial schedule. Not only is Applicant not seeking to reopen the discovery period, but all the discovery relevant to the proposed amendment, which involves the distribution channels of Opposer’s own goods, is already in the possession of Opposer. *See Rose Marie Raccioppi dba Apogee Learning v. Apogee, Inc.*, Opposition No. 96,338, 1997 T.T.A.B. LEXIS 396, at * 5 (T.T.A.B. Dec. 5, 1997) (“since the counterclaim is directed to information within the control of opposer . . . there can be little prejudice to opposer in the inclusion of the counterclaim”).

More importantly, as stated, there is no need for a separate testimony period with regard to the counterclaims, and the parties have *stipulated* that Applicant need not present separate testimony regarding the counterclaims. See Reply Gabriel Decl., at Exhibit A, ¶2.

Finally, while Opposer has failed to demonstrate prejudice, *Applicant will be severely prejudiced* if the amendment is not allowed, “as the effect of dismissing the petition would be to foreclose [Applicant] from asserting any claim it may have against the pleaded registration[s].” *See’s Candy Shops*, 12 U.S.P.Q.2d at 1397. *See also Iomega Corp.*, 2001 T.T.A.B. LEXIS 549, at * 17 (“applicant certainly would be prejudiced if its amendment were to be disallowed, inasmuch as it would be foreclosed from asserting its claim”).

Based on the foregoing, “the liberal policy established by the Federal Rules of Civil Procedure concerning amendments to pleadings dictates allowance of [Applicant’s] cancellation petition.” *See’s Candy Shops*, 12 U.S.P.Q.2d at 1397.

Applicant's Proposed Counterclaims Are Not Futile

Opposer does not dispute that from its date of first use until the present, it has only used its GREENWISE mark on goods sold in Publix stores, nor could it. Opposer instead argues that Applicant will not be able to prove that partial cancellation of Opposer's registrations will result in a finding of no likelihood of confusion, and thus the proposed amendment is futile. Opposer does not cite any legal impediment to the proposed counterclaim, such as lack of statutory grounds. Instead, Opposer misguidedly argues that full analysis of the *DuPont* factors shows that, even with the proposed restriction, confusion still will be likely. *See Opp.* at 7-11. However, Opposer appears to be confused by the standards on a motion to amend. A proposed amendment is futile only if it would not survive a Rule 12(b)(6) motion to dismiss. *See Hunt v. Alliance N. Am. Gov't Income Trust Inc.*, 159 F.3d 723, 728 (2d Cir. 1998). Thus, on a motion to amend, Applicant need only show that it has *pleaded* a cause of action, *not proved it*.

As the Board made clear in *DAK Industries, Inc. v. Daiichi Kosho Co., Ltd.*, “[a] party seeking to avoid a likelihood of confusion finding by restricting the identification of goods listed in an adverse party’s pleaded registration must now allege (*and later prove*) that (i) a finding of likelihood of confusion will be avoided by entry of the restriction sought in the petition to cancel” 35 U.S.P.Q.2d 1434, 1437 (T.T.A.B. 1994). A restriction is properly pleaded if it identifies opposer’s goods “with greater particularity, in terms of type, use, customers, trade channels, etc.” *Id.*

Thus, in *IdeasOne Inc. v. Nationwide Better Health Inc.*, the Board granted the petitioner leave to amend to assert a claim for partial cancellation under Section 18 of the Lanham Act:

Petitioner has satisfied the requirements set forth in *Eurostar* by pleading that the proposed restriction would serve to avoid any likelihood of confusion with respect to petitioner’s applied-for marks for ‘dietary supplements,’ and that respondent has not used its registered mark on the ‘services’ which would be excluded from the registration.

89 U.S.P.Q.2d 1952, 1954 (T.T.A.B. 2009). Similarly, in *Pandemonium, LLC v. Chris Launois*, the Board allowed a petitioner to amend its pleading under Section 18 to restrict a respondent's description of services from "entertainment in the nature of on-going television variety show in the field of news, music, documentaries, and various subjects of controversy" to "non-commercial entertainment in the nature of [an] on-going television variety show containing adult content, in the field of news, music, documentaries, and various subjects of controversy, shown only at non-prime time hours on public access television." Cancellation No. 92032567, 2005 T.T.A.B. LEXIS 142, at * 8 (T.T.A.B. Mar. 31, 2005) ("the amended petition to cancel otherwise provides acceptable notice pleading of grounds for cancellation or restriction of respondent's involved registration").

Applicant's proposed counterclaims here – which seek to limit Opposer's description of goods to their actual single channel of trade – similarly pass muster under this pleading standard. Opposer's "argument that petitioner has not proven the elements required for a restriction to a registration under [*Eurostar*] is misplaced in that the elements of petitioner's case need not be proven at the pleading stage." *Multi-Local Media Corp.*, 1999 T.T.A.B. LEXIS 280, at *19.

Nonetheless, even if the Board did weigh the *DuPont* factors on this mere pleading motion, Opposer has not shown that confusion is likely as a matter of law even with the proposed trade channel limitation. First and foremost, even for identical goods with identical or highly similar marks, a slight distinction in the specific channels of trade, such as would be effectuated by Applicant's proposed counterclaim, can wholly obviate confusion. *See, e.g., Electronic Data Sys. Corp. v. EDSA Micro Corp.*, 23 U.S.P.Q.2d 1460, 1464 (T.T.A.B. 1992) (no likelihood of confusion between marks EDS for computer data processing programming/information management services and EDSA for computer programs for electrical distribution system

analysis and design); *Sunenblick v. Harrell*, 895 F. Supp. 616, 629 (S.D.N.Y. 1995), *aff'd*, 101 F.3d 684 (2d Cir. 1996) (no likelihood of confusion between producers of musical recordings both using UPTOWN label, where plaintiff produced jazz recordings and defendant produced rap and hip-hop recordings, even when sold in same stores); *Yellow Book USA, Inc. v. Interstate Publisher's Corp.*, Cancellation No. 22,666, 2003 T.T.A.B. LEXIS 360, at *11-17 (T.T.A.B. July 30, 2003) (in dispute over YELLOW PAGES mark, Board granted petitioner's request under Section 18 to amend respondent's identification of goods to "manufacturing and industrial buyers guides published annually as classified telephone directories"; no confusion likely where "Respondent does not and never has used its mark on community-oriented classified telephone directories distributed to all telephone subscribers").

Similarly unavailing is Opposer's argument that confusion is likely because the parties' goods are "inexpensive," and thus consumers will exercise a lesser degree of care in their purchasing decisions. *See* Opp. at 9. Not only is there no evidence on this motion concerning the respective price of the parties' goods (which cover a wide range of products), but, as detailed in Applicant's motion for summary judgment, the parties' goods are marketed to consumers who are interested in "organic" and "healthier" foods and household products. Not only do these goods cost more than their conventional counterparts, but such consumers are a highly discerning group. *See Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1448 (S.D. Ohio 1990) ("heightened awareness of health and healthy foods raises the standard of care which the reasonable purchaser of the parties' products would exercise").

Nor is confusion likely merely because, under the limitation, the products would not be sold side by side – to the contrary, such a fact would support a finding that confusion was *not* likely. *See, e.g., Sunenblick*, 895 F. Supp. at 629 (no confusion likely where products were not

sold side by side).

Opposer's argument that confusion would not be obviated by the proposed limitation because "A&P could sell its goods in Publix stores," Opp. at 9, is a complete fiction since Opposer would never allow Applicant's products to be sold in Publix stores. And Opposer's argument that the proposed amendment seeks an geographic restriction of Opposer's goods, which can only be brought in a concurrent use proceeding, is wholly unfounded since there is no mention of any geographic restriction in the proposed limitation. The proposed limitations cover Opposer's goods sold in any Publix store, regardless of its location.

Finally, while T.M.E.P. § 1402.09 states that an applicant *should* not use its own trademark in the description of goods, it is not an express prohibition and would not prevent the Board from issuing appropriate relief to Applicant. Nonetheless, to the extent § 1402.09 is an issue, Applicant simply could amend its limitation to replace "Publix" with "stores owned and/or controlled by" Opposer, which would have the same effect of obviating likely confusion.

Based on the foregoing, the Board cannot state at this juncture that Applicant's proposed counterclaims as pleaded fail as a matter of law. Accordingly, they are not futile.

CONCLUSION

Section 18 of the Lanham Act provides Applicant with an equitable remedy. It would be patently unfair to grant Opposer nationwide exclusive rights in a designation that is used solely on house brand products sold at its Publix stores, and not distributed to the public at large through all normal channels of trades. Because Opposer has shown no prejudice that would result from the allowance of Applicant's proposed counterclaims and Applicant has sufficiently pleaded its counterclaims, the Board should grant Applicant's motion to amend.

Dated: New York, New York
February 19, 2013

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Arlana S. Cohen/
Arlana S. Cohen
Michael G. Gabriel
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9237

Attorneys for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 19, 2013, he served the foregoing
REPLY MEMORANDUM IN FURTHER SUPPORT OF MOTION BY APPLICANT FOR
LEAVE TO AMEND ITS ANSWER(S) AND ASSERT COUNTERCLAIMS on counsel for
Opposer by mailing a true and correct copy to the following address:

James Lake, Esq.
Thomas & LoCicero, PL
601 South Boulevard
Tampa, FL 33606

/Michael G. Gabriel/
Michael G. Gabriel

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

-----x

PUBLIX ASSET MANAGEMENT COMPANY, :

Opposer, : Opposition No. 91186148
Opposition No. 91186863

v. :
THE GREAT ATLANTIC & PACIFIC TEA :
COMPANY, INC., :

Applicant. :

-----x

**REPLY DECLARATION OF MICHAEL G. GABRIEL, ESQ.
IN FURTHER SUPPORT OF MOTION BY APPLICANT FOR LEAVE TO AMEND ITS
ANSWER(S) AND ASSERT COUNTERCLAIMS**

I, Michael G. Gabriel, hereby declare:

1. I am a senior attorney in the law firm of Cowan, Liebowitz & Latman, P.C., attorneys for Applicant, The Great Atlantic & Pacific Tea Company, Inc. ("Applicant"). I respectfully submit this declaration in further support of Applicant's motion for leave to amend its answer(s) and assert counterclaims.

2. A true and correct copy of Plaintiff's Trial Stipulation, filed in the Proceeding on January 18, 2013, is attached hereto as **Exhibit A**.

3. A true and correct copies of selected pages of the January 22, 2013, Testimony Deposition transcript of Mark Irby is attached hereto as **Exhibit B**.

Pursuant to 28 U.S.C. § 1746, I certify under penalty of perjury that the foregoing is true and correct.

Executed this 19th day of February 2013, at New York, New York.

s/ Michael G. Gabriel
Michael G. Gabriel

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 19th day of February, 2013, he served the foregoing REPLY DECLARATION OF MICHAEL G. GABRIEL, ESQ. by mailing a true and correct copy thereof to Opposer's attorneys located at:

James Lake, Esq.
Thomas & LoCicero, PL
601 South Boulevard
Tampa, FL 33606

s/Michael G. Gabriel
Michael G. Gabriel

EXHIBIT A

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

Publix Asset Management Company,

Opposer,

v.

Opposition No. 91186148

Opposition No. 91186863

The Great Atlantic & Pacific Tea
Company, Inc.,

Applicant.

_____!

TRIAL STIPULATION

Opposer, Publix Asset Management Company ("Publix Asset"), and Applicant, The Great Atlantic & Pacific Tea Company, Inc. ("A&P"), stipulate as follows:

1. Publix Asset is not asserting a dilution claim in this proceeding.
2. Publix Super Markets, Inc., is not a party to this proceeding.
3. The GREENWISE mark is used through Publix Asset's related companies, which are Publix Super Markets, Inc., and its subsidiaries.
4. Publix Asset does not assert any use of or rights in the GREENWISE mark prior to the filing date of the earliest of its applications listed in its Amended Notice of Opposition.
5. Based on the foregoing paragraphs, A&P will not assert the defenses in its Answer served July 26, 2012, except its affirmative defense that GREENWISE and GREENWAY are not confusingly similar
6. Publix Asset will be permitted to call Paul Kalinowski and a representative of United as trial witnesses during the rebuttal period, but those witnesses (if called) will not be treated as rebuttal witnesses. So, for example, if and when a deposition of Paul Kalinowski or a United representative is taken, Publix Asset will be permitted to solicit testimony beyond the

scope of A&P's case.

7. The parties stipulate to the authenticity of their own business records that have been produced in discovery without the need for testimony of a records custodian.

8. To the extent that A&P is granted leave to lodge its proffered counterclaims, neither party would be required to use and no adverse inference shall arise from the lack of use of a separate testimony period to lodge testimony on the counterclaims.

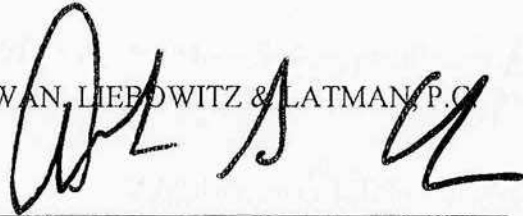
THOMAS & LOCICERO PL



Carol Jean LoCicero
clocicero@tlolawfirm.com
James B. Lake
jlake@tlolawfirm.com
601 South Boulevard
Tampa, FL 33606
Telephone: (813) 984-3060
Facsimile: (813) 984-3070

Attorneys for Opposer
Publix Asset Management Company

COWAN, LIEBOWITZ & LATMAN, P.C.



Arlana S. Cohen
ASC@cll.com
Michael G. Gabriel
mgg@cll.com
1133 Avenue of the Americas
New York, NY 10036
Telephone: (212) 790-9237
Facsimile: (212) 576-0671

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

EXHIBIT B

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

PUBLIX ASSET MANAGEMENT GROUP,

Opposer,

Opposition
No. 91186148

vs.

THE GREAT ATLANTIC & PACIFIC
TEA COMPANY, INC.,

Opposition
No. 91186863

Applicant.

DEPOSITION OF: MARK IRBY

DATE: January 22, 2013

TIME: 9:41 a.m. to 2:43 p.m.

PLACE: Thomas & LoCicero, P.L.
601 South Boulevard
Tampa, Florida

PURSUANT TO: Notice by counsel for Opposer
for purposes of discovery, use at
trial or such other purposes as
are permitted under the Federal
Rules of Civil Procedure

REPORTED BY: Aaron T. Perkins, RPR
Notary Public, State of
Florida at Large

Pages 1 to 116

COPY

1 APPEARANCES:

2 JAMES B. LAKE, ESQUIRE
3 CAROL JEAN LOCICERO, ESQUIRE
4 Thomas & LoCicero
5 601 South Boulevard
6 Tampa, Florida 33606

7 - and -

8 LORI A. DEANGELIS, ESQUIRE
9 Publix Super Markets, Inc.
10 P.O. Box 407
11 Lakeland, Florida 33802

12 Attorneys for Opposer

13

14

15 ARLANA S. COHEN, ESQUIRE
16 Cowan, Liebowitz & Latman, P.C.
17 1133 Avenue of the Americas
18 New York, New York 10036

19 Attorney for Applicant

20

21

22 ALSO PRESENT:

23 Gabrielle Scalise

24

25

1 A. Should be. Yes, ma'am.

2 MS. COHEN: All right. If you'll mark that
3 as H.

4 (Applicant's H was marked for
5 identification.)

6 THE WITNESS: I'm not sure. Excuse me.

7 MS. COHEN: Yes.

8 BY MS. COHEN:

9 Q. Yes. It's also, for some reason, in the same
10 class of goods as cat litter and vegetables and
11 mushrooms.

12 A. They don't always make sense, do they?

13 Q. And do the mushrooms also say Publix
14 GreenWise Market?

15 A. Yes, ma'am, it does.

16 Q. So, here, would you like to look through the
17 rest of them, as you said, and then we can mark it as
18 I?

19 A. Do you want me to look at them?

20 MS. COHEN: There is three of each, so you
21 can just --

22 MR. LAKE: Okay.

23 (A recess was taken at 12:08 p.m.)

24 BY MS. COHEN:

25 Q. So these are a number of your other

1 registrations and a number of your specimens attached.

2 And they each say Publix GreenWise on them?

3 A. Yes, ma'am.

4 (Applicant's I was marked for
5 identification.)

6 MS. COHEN: That's I, but we'll have to take
7 these apart later.

8 BY MS. COHEN:

9 Q. Do you think that GreenWise is associated
10 with Publix in the mind of the public?

11 A. I think it's reasonable to assume that it is.

12 Q. On your store signage, is there also Publix
13 on the store signage of the three stores on the outside
14 sign?

15 A. Yes, ma'am. And "market" is on the store, is
16 also a part of that. It says, Publix GreenWise Market,
17 are the three words on the store fronts.

18 Q. Okay. And I'm just looking back at
19 Opposer's Exhibit 6 on GW1428. There is -- seems to be
20 Publix, a cutoff from the top of the bag of tortilla
21 chips, which would normally read, Publix GreenWise
22 Market, correct?

23 A. I'm certain.

24 MS. COHEN: So after you've looked through
25 that, are you willing to stipulate?

1 MR. LAKE: Yeah. And I think he testified
2 that those specimens on I show "Publix" and
3 "market" with the word "GreenWise."

4 MS. COHEN: Correct.

5 MR. LAKE: Yes.

6 MS. COHEN: Okay. Thank you. And I think he
7 testified that every use of a product that has
8 GreenWise has "Publix" but not every product also
9 has "market."

10 THE WITNESS: Right. There would be an
11 exception, perhaps, on some of the scale labels on
12 what we call random weight products in the stores.
13 So some of the -- some of the labels that are
14 probably on those bulk products, for example,
15 probably just have GreenWise as the item
16 description and probably doesn't have Publix or
17 market there. And I believe we saw some specimens
18 like that this morning. I'm not certain, but I
19 think so.

20 BY MS. COHEN:

21 Q. How about your advertising --

22 A. So salmon, for example, I believe, just said
23 "GreenWise salmon" on the product description. It
24 didn't say "Publix GreenWise salmon" on the item
25 description itself.

1 Q. How about your advertising in fliers, would
2 it say "Publix GreenWise"?

3 A. Yes, ma'am.

4 Q. I'm going to show you a flyer that I picked
5 up yesterday in Publix. And it shows Publix GreenWise
6 New York strip steaks and Publix GreenWise top round
7 London broil.

8 MS. COHEN: And we're going to mark this J.
9 And I have two of those.

10 (Applicant's J was marked for
11 identification.)

12 BY MS. COHEN:

13 Q. And if you see where I marked it with the
14 stickies, would those be examples of how the mark is
15 used in advertising?

16 A. Yes. That's one example, yes, ma'am -- two
17 examples, yes, ma'am.

18 Q. But Publix is used with GreenWise in all
19 examples?

20 A. Yes, ma'am.

21 Q. You talked before about advertising on your
22 website, correct?

23 A. Yes, ma'am, we did.

24 Q. I'm going to show you a list of -- well, I
25 will show you something, and you tell me what it is.

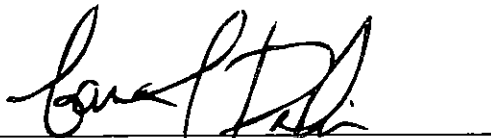
1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

CERTIFICATE OF OATH

STATE OF FLORIDA
COUNTY OF HILLSBOROUGH

I, the undersigned authority, certify that
MARK IRBY, personally appeared before me and was duly
sworn.

WITNESS my hand and official seal this 1st day
of February, 2013.



Aaron T. Perkins, RPR
Notary Public - State of Florida
My Commission Expires: 2/27/2016
Commission No. EE173286



1 REPORTER'S CERTIFICATE

2 STATE OF FLORIDA
3 COUNTY OF HILLSBOROUGH

4
5 I, Aaron T. Perkins, Registered Professional
6 Reporter, certify that I was authorized to and did
7 stenographically report the deposition of
8 MARK IRBY; that a review of the transcript was
9 requested; and that the transcript is a true and
10 complete record of my stenographic notes.

11
12 I further certify that I am not a relative,
13 employee, attorney, or counsel of any of the parties,
14 nor am I a relative or employee of any of the parties'
15 attorney or counsel connected with the action, nor am I
16 financially interested in the action.

17
18 Dated this 1st day of February, 2013.

19
20 
21 Aaron T. Perkins, RPR

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

SIGNATURE PAGE

PLEASE ATTACH TO THE DEPOSITION OF MARK IRBY TAKEN ON
JANUARY 22, 2013, IN THE CASE OF PUBLIX ASSET
MANAGEMENT GROUP AND THE GREAT ATLANTIC & PACIFIC TEA
COMPANY, INC.

PAGE LINE CORRECTION AND REASON THEREFOR

I HAVE READ THE FOREGOING PAGES AND, EXCEPT FOR ANY
CORRECTIONS OR AMENDMENTS INDICATED ABOVE, I HEREBY
SUBSCRIBE TO THE ACCURACY OF THIS TRANSCRIPT.

MARK IRBY

DATE

WITNESS TO SIGNATURE

DATE