

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

CASE NO. 1:15-cv-24391-MGC

BADIA SPICES, INC.,

Plaintiff/Counter-Defendant

vs.

GEL SPICE COMPANY, INC.,

Defendant/Counter-Plaintiff,

**DEFENDANT AND COUNTERCLAIMANT GEL SPICE COMPANY'S REPLY
MEMORANDUM OF LAW IN FURTHER SUPPORT OF DEFENDANT'S MOTION
FOR SUMMARY JUDGMENT**

Defendant Gel Spice Company, Inc. ("Gel" or "defendant") submits this reply memorandum of law in further support of Gel's Motion for Summary Judgment [DE 49] pursuant to Rule 56 of the Federal Rules of Civil Procedure.

I. PRELIMINARY STATEMENT

In its moving papers Gel demonstrated that the incontestable registrations for Badia's alleged trademarks for the words "complete seasoning" and their Spanish equivalent, "*sazon completa*" are of essentially no significance as a matter of law. Incontestability is irrelevant here because Gel has shown that Badia's alleged marks are generic descriptions of a genus of seasoning blends. In this respect, complete seasoning can be compared to the word "cola," which is generic for cola-flavored soft drinks. Though many colas are sold by many sources and they are known to differ in quality and taste, they still comprise a genus understood by all consumers as "cola" ("what are you?"). It is the manufacturer's or bottler's task to distinguish its offering by branding ("who are you?"). The time has come for Badia to do the same for its variety of *sazon completa*.

Additionally, Gel's initial submission on its motion for summary judgment set out the well-established legal rule that "incontestability" has little or no relevance to consideration of the strength of a trademark, especially one that is at best descriptive, as the alleged Badia marks are. Gel therefore sets out here, once again and more precisely in terms of Badia's attempt to respond to Gel's comprehensive demolition of that position, the legal principles and facts that

establish that there is only one thing here that, as a matter of law, is incontestable: That Badia's supposed trademark rights are illusory.

Gel also eviscerates the false impression Badia seeks to create by recycling the legally baseless argument that because other competitors have backed down in the face of Badia's repeated promises to "bet the company" on litigation, it must have legitimate rights. In fact, the law is clear that such "settlements" – here made on terms Badia has been at great pains to keep private – prove only that a party such as Badia is prepared to spend a lot of money to get its way. The time has come, however, for Badia to stop using the rubric of "unfair competition" to keep true competition out of the market.

Gel's summary judgment submission revealed that no disputed questions of material fact or legal arguments exist on the question of Gel's entitlement to judgment as a matter of law. As set out below, Badia's opposition fails completely to rebut Gel's arguments and proofs. For this reason, Gel is entitled to summary judgment on all of Badia's claims and on its counterclaim for cancellation of the Badia registrations.

II. LEGAL ARGUMENT

A. **GEL IS ENTITLED TO SUMMARY JUDGMENT BECAUSE IT HAS PRESENTED SUFFICIENT EVIDENCE THAT THE ALLEGED MARKS "COMPLETE SEASONING" AND "SAZON COMPLETA" ARE GENERIC AND NOT ENTITLED TO TRADEMARK PROTECTION.**

Badia's opposition to Gel's motion for summary judgment unsurprisingly places all of Badia's eggs in its flimsy "incontestable" basket. Badia repeats the error of its own summary judgment motion by asserting that an incontestable registration is "conclusively presumed" [sic] valid and immune from a genericness attack. But as Gel demonstrated at length in its opposition to Badia's motion [DE 63], there is nothing "conclusive" about that presumption, if it even exists. Badia's incontestable registrations afforded its alleged marks at best a "bursting-bubble presumption of non-genericness" that shifted the fairly light burden of coming forward with evidence of genericness.

Gel has met and far exceeded that burden. Its moving papers include over two dozen examples of third parties that market and sell or have in the last several years marketed and sold complete seasoning utilizing the terms "complete seasoning," "*sazon completa*," or a combination

thereof.¹ Badia's answer to this? "Incontestable." Gel's extensive evidence of the consuming public using the terms "complete seasoning" and "*sazon completa*" as generic terms to describe a category of spice blend?² Badia replies, "incontestable." In the face of all the evidence, Badia just mutters, "incontestable."

But "incontestable" is the wrong answer no matter how many times Badia evokes it, because Gel's documented proof that Badia's alleged marks are generic far exceeds the quantum other courts have relied on in finding supposed trademarks generic. See, e.g., *In re: Cordua Restaurants, Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016). Given that Gel's burden was merely to produce enough evidence to shift the burden back to Badia to prove that it is entitled to trademark protection, Badia's strategic choice to make virtually no effort to meet that burden is a concession in all but form. On this basis alone Gel is entitled to judgment as a matter of law.

"Make no effort" does not mean that plaintiff does not pretend to engage in the task. Badia does take the trouble to argue that two dozen or more third-party uses is "insufficient" to so much as raise a question as to the supposed validity and strength of its alleged marks. But the cases plaintiff cites do not support that contention – not one of them. See, e.g., *Univ. of Ga. Athletic Ass'n v. Laite*, 756 F.2d 1535, 1545 n. 26 (11th Cir. 1985) (only **two** other local universities used bulldog as mascot and similar color scheme); *Quality Inns Int'l v. McDonald's Corp.*, 695 F. Supp. 198, 213 (D. Md. 1988) (only **four** significant third-party uses)³.

Badia also asserts that the online recipes submitted by Gel that utilize "complete seasoning" and "*sazon completa*" as generic terms are also of no legal importance. Badia's argument is that its alleged marks cannot be generic because some recipes calling for the ingredient use capital letters! (Badia Br. at 13-14.) In fact, however, the record is replete with recipes calling for "Complete seasoning," "complete seasoning," and "*sazon completa*" without reference to source, demonstrating that the terms are, in fact, generic in the minds of consumers.

Badia's genericness problem is so profound even Badia cannot keep tabs of it. Besides the

¹See Exhibit 8 to Gel's Motion for Summary Judgment ("Gel Br.") at Bates Range GOYA-00000001-47; 328-336; 851-863; 871-876; 878-892; 895-901; 934-937; 940-941; 943; 947-949; 952-960; 2844-2845.

² See Exhibit 9 to Gel Br. at GEL-0000234; 237-239; 241-254; see also the Declaration of Joel MacMull dated September 13, 2016 ("MacMull Decl."), Exs. A through F.

³ Badia also cites *Scarves by Vera, Inc. v. Todo Imps., Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976) for the same proposition, but in that case, the Second Circuit held the district court erred in finding the Plaintiff's trademark weakened by third-party trademark **registrations**, not actual use. Unlike here, in *Scarves by Vera* there was no evidence that any of the registration owners actually sold anything using their registered marks.

testimony by Joseph Badia quoted in Gel's moving papers in which Mr. Badia himself uses the term generically,⁴ one of the recipes submitted by Badia under the watchful eye of counsel itself constitutes a textbook example of generic use – listing “**Badia (brand) complete seasoning**” as an ingredient. (See Ex. E at p. 15 to Badia's Memorandum of Law in Opposition to Gel's Motion for Summary Judgment “Badia's Opp. Br.”; emphasis added.) Similarly, GOYA-00000031 calls for “Sazon complete by Goya,” another perfect example where the publisher identifies both “*sazon complete*” as the product – the “what” – and the source, Goya – the “who.” Badia characterizes this use as an example of the very “confusion in the marketplace” that caused it to sue Goya despite the clear indication that the source of the product listed in such recipe is Goya; the absence of any proof of confusion or likelihood of confusion; and the absence of any judgment against Goya for this so-called “infringement.”

Badia's opposition attempts to evade the obvious conclusion that its alleged marks are generic by enunciating a bizarre philosophy of genericness that is really nothing but a string of

⁴ So desperate to find any port in the generic storm is Badia that it actually attempts to impute significance not only to the capitalization choices employed by a court reporter but even which party engaged that court reporter, insisting in footnote 5 at page 7 of its brief that “Notably, Defendant's own [*sic*] court reporter capitalized “Complete Seasoning” in the deposition transcript, signifying that it is a brand.” Gel, in fact, does not consider any court reporters its “own.” Indeed, if any party would be expected to have influence over a court reporter working in the Miami area, it would more likely be plaintiff, not defendant.

More importantly, the transcribed record does not so much as suggest that the witness spelled out the words “Complete Seasoning” and specified that they be capitalized or otherwise suggested it. Courts do not place significance on transcription choices such as capitalization made by court reporters, recognizing that they are likely to be arbitrary or erroneous. See, e.g., *In re Air Crash near Cali, Colom.*, 985 F. Supp. 1106, 1115, n. 5 (S.D. Fla. 1997) (“In those instances where we have quoted the transcript, we have attempted to employ standard rules of capitalization, but have retained the punctuation (or lack thereof) indicated in the exhibit.”); *Bonet v. Now Courier, Inc.*, No. 14-23217, 2016 U.S. Dist. LEXIS 114886 at *7, n. 3 (S.D. Fla. Aug. 24, 2016) (“This Order references trial transcripts, which were obtained from the Court Reporter. . . . non-substantive changes, such as punctuation and capitalization, have been made to the rough transcripts to aid in comprehension.”).

This remark in plaintiff's brief, however, does raise the question of whether, rather than an arbitrary choice by the court reporter, the capitalization of this term may not have come about without some suggestion, albeit not from the witness and not on the record. During a break requested immediately after Mr. Badia's damaging testimony, counsel for plaintiff asked defendant's counsel for a few minutes during which his team could meet alone with the court reporter. Assuming that counsel for plaintiff wanted to review the real-time transcription of the questioning that had just taken place in order to assess plaintiff's situation and, perhaps, decide whether or not direct examination would be called for, defendant's counsel acquiesced, notwithstanding the unusual nature of the request.

In light of footnote 5 in Badia's brief, however, it is certainly not impossible to wonder whether during this review of the transcript, a friendly recommendation might not have been communicated to the locally-based court reporter to the effect that, when transcribed, the term would “properly” be capitalized. Was “Complete Seasoning” not, after all, the “brand name” of the product shown in photographs already marked as exhibits? Such a helpful hint might not strike the non-lawyer court reporter as irregular or a violation of her professional responsibilities or duty to the Court. Plaintiff's counsel never provided an explanation for its “private conference” with the court reporter and, given the sterling reputation of plaintiff's counsel, Gel's attorney did not press for one.

sophistic, self-serving arguments devoid of legal or factual support. For example, Badia posits, by way of *ipsi dixit*, that the word “complete” is an “evolving and subjective concept, especially with regard to the palate” and that therefore, there can be no such genus as a “COMPLETE SEASONING” or “SAZON COMPLETA.” This novel mélange of concepts – a word salad that posits a spice blend’s relationship to the sense of taste evolving over time – is just nonsense.

Similarly, in an effort to demonstrate that the meaning of the term “complete” is subjective – on the dubious premise that if a word’s meaning is “subjective” it cannot be part of a phrase that describes a genus – Badia cites the deposition testimony of Samson Baum. Plaintiff places much stock in a confusing exchange between counsel for Badia and Mr. Baum regarding a hypothetical “complete office.” Given his education and professional expertise, Mr. Baum’s lay opinion concerning what would constitute a “complete office” may be of passing interest, or at least it would be if there were any evidence that the term “complete office” means anything to consumers. Here, however, the evidence demonstrates that there is a commonly-accepted understanding of the phrase “complete seasoning.” And regarding that phrase, which is the subject matter of this action, Mr. Baum, who works for a spices and seasoning company and whose testimony Badia evidently credits, testified that for purposes of consumer perception, the term “complete seasoning,” is “totally generic.” (See Deposition Testimony of Samson Baum attached as Exhibit H to Badia’s Memorandum of Law in Support of Motion for Summary Judgment (“Badia Br.”) at 102:15-19.)

Regardless of Mr. Baum’s testimony, the premise of the legal argument in which Badia invokes his expertise⁵ is, as Gel demonstrated in its moving brief, completely false as a matter of law, because a term is “generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *In re Cordua Rests., Inc.*, 823 F.3d at 605; *Henri’s Food Prods. Co. v.*

⁵ Badia is correct that the majority in *Citibank, N.A. v. Citibanc Grp., Inc.*, 724 F.2d 1540 (11th Cir. 1984) did not hold the mark at issue to be generic, but is incorrect about the significance of the holding to this case. The opinion’s formulation of the basis for the ruling in *Citibank*, in fact, describes everything the trademark CITIBANK is and which the generic term “complete seasoning” is not:

The term “Citi” does not describe a class of banking services or a characteristic of banking services. As the district court stated, “the most that can be said for City Bank is that it **suggests** a modern or urban bank.” Slip op. at 49 (emphasis in original). To paraphrase Professor McCarthy, we find that Citibank indicates not a type of service, but a provider of that service. See J. McCarthy, Trademarks and Unfair Competition, § 12.2 at 407-08.

Citibank, 724 F.2d at 1545. Here, in contrast to the allusive but not descriptive quality of CITIBANK, plaintiff’s “complete seasoning” indicates – to use Prof. McCarthy’s paradigm – not a provider of seasoning (which, in fact is what the word “Badia” on the label does) but a **type** of seasoning.

Tasty Snacks, Inc., 817 F.2d 1303, 1305-06 (7th Cir. 1987) (generic term serves “to denominate a type, a kind, a genus, **or** a subcategory of goods”) (emphasis added)⁶; *Northland Aluminum*, 777 F.2d 1556, 1561 (Fed. Cir. 1985) (BUNDT is generic for a “type of ring cake”).

Indeed, with the exception of an entirely standardized commodity, every single offering from a different source of a competing product within a genus will, axiomatically, have at least **some** different qualities. If this was ever a question in trademark law, it has not been one for generations. Thus, as the court in *Coca-Cola Co. v. Nehi Corp.*, 26 Del. Ch. 140 (Del. Ch. 1942) explained regarding the word “cola” – which, unlike “complete seasoning,” was not necessarily generic *ab initio* – all colas need not be identical, or even particularly “true colas,” for the word to nonetheless constitute a genus recognized by consumers as a general type of soft drink:

Perhaps, some slight confusion is always possible when words of a generic or descriptive nature are used in trade-names. *Bliss, Fabyan & Co. v. Aileen Mills, Inc.*, (4 Cir.) 25 F.2d 370. The fraudulent passing off of one product for another is reprehensible, and, independent of any inferences that may be drawn therefrom, will be frequently enjoined. But, particularly in the absence of any knowledge on the part of the defendant, such acts do not necessarily justify the inference that a known word, originally in some measure descriptive, but which has now become generic, is being used for deceptive and piratical purposes. Standing alone, all other alleged fraudulent acts are relatively unimportant to the main issue. Conceding that an average twelve ounce bottle of Royal Crown Cola contains only about 52/100ths of a drop of the cola nut extract, the use of the word “Cola” is not so deceptive as to affect the main issue, when a known class of drinks is involved. The caffeine properties of the cola nut are supplied by proper substitutes.

Long ago, the complainant company admitted that the public recognized that there was a type or class of beverages known as “cola drinks”; that Coca-Cola was the prototype of that class, and contained but a small amount of the cola nut extract, though it had its properties. The testimony of other witnesses that a beverage could be classed as a “cola drink”, if it had the usual characteristic taste and color, though it contained little or no extract of the cola nut, is, therefore, both understandable and pertinent.

26 Del. Ch. at 167-168 (citations omitted).

Thus the fact that consumers, whose perceptions are paramount, as well as spice manufacturers use the terms “*sazon completa*” and “complete seasoning” to refer to a **category** of “seasoning blend,” rather than **all** seasoning blends, does not resolve the genericness inquiry any more than the fact that Pepsi-Cola, Royal Crown Cola and Coca-Cola are all colas, notwithstanding

⁶ Interestingly, Badia cites this case later in its opposition brief and quotes this exact language. [DE 62 at p. 15.]

strong consumer awareness of the differences among the offerings of different manufacturers and their preference for one brand of cola over another. *Sazon completa* is a species within the genus of “seasonings” as “colas” are a species within the genus “soft drinks.” And as the court in *Nehi Corp.* explained in the passage above regarding the percentage of cola nut extract in RC Cola, it does not matter that Badia’s complete seasoning contains six ingredients, whereas Gel’s complete seasoning contains eight. Colas are not identical in taste, ingredients or quality, yet **they are all colas**. The evidence here shows that in consumers’ eyes, the same applies to complete seasoning blends. They are all *sazones completas*.

Badia also criticizes Gel for arguing that the generic nature of “complete seasoning” is consistent with Prof. McCarthy’s observation that terms consisting of an adjective followed by a noun are likely to be found generic, claiming, strangely enough, that Professor McCarthy “makes no such generalization.” (Badia’s Opp. Br. at 5.) This statement is hard to understand, given how simple it would have been for plaintiff to look it up. In fact, Prof. McCarthy devotes an **entire section** to “generic adjectives” (McCarthy at §12:10) and provides 39 examples⁷ of terms consisting of an adjective followed by a noun that were found to be generic.

Badia also claims that Joseph Badia’s testimony about why he chose the name “Complete Seasoning” for complete seasoning is not evidence of genericness. But Mr. Badia’s testimony is highly probative on the issue, because “the name of a product . . . – what it is – is the very antithesis of a mark.” McCarthy at § 12:1. If a seller cannot most readily identify “what” a product is without using a specific term to describe such product, then such term is generic. The fact that 24 third-party manufacturers have in recent years sold or currently sell competing complete seasonings using what Badia itself maintains is a confusingly similar version of plaintiff’s alleged marks is proof of this principle. Badia’s spin that all these companies are “infringers” – on a record devoid of either a judgment or a settlement acknowledging infringement – is as hard to credit as Badia’s “evolving palette” theory of genericness.

Badia also incorrectly argues that its alleged marks are not generic because Gel refers to

⁷ LIGHT BEER AND LITE BEER; CUSTOM BLENDED; WAREHOUSE SHOES; IMPORTED AUTO PARTS; ANALOG DEVICES; BLINDED VETERANS; CERTIFIED REGISTERED NURSE ANESTHETIST; CLASSIC INSTRUMENTS; CLOSED LOOP MARKETING; DISCOUNT MUFFLERS; DRY ICE; FIRST AID; FIRST NATIONAL BANK; FRESH ORGANICS; GOLD CARD; HARD TO FIND TOOLS; HOLOGRAPHIC DESIGN; HONEY BROWN; IMPORTED AUTO PARTS; MULTIPOINT DATA SERVICE; NET BANK; ON SITE ENERGY; ORGANIC FOOD BAR; OUTDOOR PRODUCTS; PRECISION CUTS; PRIMAL THERAPY; RECORDED BOOKS; RUBBER ROPE; RUSSIANART; SAFE T PLUG; SHREDDED WHEAT; SMART POWER; SOFTCHEWS; SUPER GLUE; UNIMOTORCYCLE; URGENT CARE; WELDING SERVICES; YELLOW PAGES. *Id.* at §12:18

its Sazon Complete Mix Seasoning as a “spice mix” within its Affirmative Defenses and includes the phrase “an all-purpose seasoning” on its product label. Indeed, the companies that have, under threat of litigation by Badia, stopped using the terms it claims as trademarks have also found other ways to describe *sazon completa*. But, again, “the existence of synonyms for a term does not mean the term is not generic.” McCarthy at §12:9 (citing *Loctite Corp. v. National Starch & Chemical Corp.*, 516 F. Supp. 190 (S.D.N.Y. 1981)); *Blinded Veterans Ass’n v. Blinded American Veterans Foundation*, 872 F.2d 1035, 1041 (D.C. Cir. 1989) (J. Ginsburg) (“A term need not be the sole designation of an article in order to be generic.”). Accordingly, the fact that consumers and third-party manufacturers use the terms “complete seasoning,” “*sazon completa*,” and “all-purpose seasoning” interchangeably to describe the same type of product, or the fact that alternative names can be posited, are irrelevant to whether Badia’s alleged marks are generic.

B. GEL IS ENTITLED TO SUMMARY JUDGMENT BECAUSE BADIA HAS FAILED TO DEMONSTRATE A LIKELIHOOD OF CONFUSION

As explained in Gel’s moving brief, plaintiff has not come forward with any evidence that could lead a reasonable jury to conclude that consumers are likely to be confused by defendant’s use of the term “Sazon Complete Mix Seasoning.” Nevertheless, Badia’s misstatements of law and fact require some brief attention.

1. Badia’s Marks are Weak.

Badia’s assertion that its alleged marks are “extremely strong” is nothing but a mantra, unsupported by facts of record or by legal analysis based on precedent. Badia does not even attempt to counter Gel’s argument that Badia’s marks are weak because they consist of common English and Spanish words used extensively by third-parties to describe similar goods. *See Michael Caruso & Co.*, 994 F. Supp. 1454, 1458 (S.D. Fla. 1998) (finding plaintiff’s mark was weakened by extensive third-party use); *Fla. Int’l Univ. Bd. of Trs., v. Fla. Nat’l Univ., Inc.*, No. 15-cv-11509, 2016 U.S. App. LEXIS 13612, at *29, (11th Cir. 2016) (finding “extensive third-party use” (twelve uses) diminished the strength of plaintiff’s mark).

Badia also characterizes the extensive third-party use in the record as “infringing uses.” But no court or jury has ever found a third party use to be infringing, and, as Gel noted in its moving brief with citation to authority, the existence of settlement agreements with third parties is neither evidence that any settling third party “infringed” Badia’s alleged marks nor a fact that should give rise to an inference to that effect.

a. The Parties' Product Names are not Similar.

Gel's Sazon Complete Mix Seasoning and Badia's Complete Seasoning are not likely to be confused with each other. As Gel demonstrated in its moving papers, the fact that two products are sold under names that incorporate a common word or words does not *per se* render the marks likely to be confused, even if used in association with competing goods or services. *See, e.g., Freedom Sav. & Loan Ass'n*, 757 F.2d 1176, 1183 (11th Cir. 1985) (FREEDOM SAVINGS AND LOAN and FREEDOM REALTY marks "lack ... confusing similarity").⁸

The product names not only look sufficiently different to avoid confusion, they are also distinct phonetically. While Gel's Sazon Complete Mix Seasoning has eight syllables, Badia's Complete Seasoning has five syllables – a factor which in and of itself militates against similarity as to sound. As the Sixth Circuit explained in *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 423-24 (6th Cir. 1999), "JET and AEROB-A-JET are visually and verbally distinct. AEROB-A-JET has four syllables to JET's one. . . Considering the impression made by the marks as a whole, JET and AEROB-A-JET are not confusingly similar."

As Gel pointed out in its opposition brief to Plaintiff's motion for summary judgment, plaintiff's meticulous comparison between the parties' product packaging carefully omits the most obvious distinction between the parties' products besides the price – their respective brand names, "Badia" and, for Gel, "Spice Supreme" at the top of each product label, a distinction readily demonstrated by the image reproduced in its own brief. (See Badia's Br. at 13.)

Such display of a brand name eliminates potential consumer confusion, even where parties sell competing products under similar marks. *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46-47 (2d Cir. 2000); *HBP, Inc. v. Am. Marine Holdings, Inc.*, 290 F. Supp. 2d 1320, 1333 (M.D. Fla. 2003) (citing *Nabisco* and finding no similarity between identical marks where defendant also prominently displayed its brand name, "DONZI"). Because Gel's Sazon Complete Mix Seasoning

⁸ See also *Sun Banks of Florida, Inc. v. Sun Federal Sav. and Loan Ass'n*, 651 F.2d 311, 316 (5th Cir. 1981) (SUN FEDERAL AND SAVINGS LOAN ASSOCIATION not confusingly similar to SUN BANKS); *Amstar Corp. v. Domino's Pizza Inc.*, 615 F.2d 252, 259 (5th Cir. 1980) (DOMINO'S PIZZA not similar to DOMINO SUGAR); *Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 547 (S.D. Fla. 1986) (FINAL FLIP and FLIP marks for same product are "ultimately different and different sounding"); *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992) (VARGA GIRL and VARGAS are "sufficiently different in sound, appearance, connotation, and commercial impression, to negate likelihood of confusion"); *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 888 (Fed. Cir. 1986) (ROMANBURGER and ROMAN marks for food products "are not similar in appearance"); *Little Caesar Enterprises, Inc. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987) (PIZZA CAESAR U.S.A. not similar to LITTLE CAESAR'S); *Conde Nast Pubs., Inc. v. Miss. Quality, Inc.*, 507 F.2d 1404, 1407 (CCPA 1975) (COUNTRY VOGUES and VOGUE marks for publications "do not look or sound alike").

also includes its house brand logo, Spice Supreme, the likelihood of potential customer confusion between the parties' products is non-existent as a matter of law.

Finally, Badia cites several cases for the proposition that Gel's addition of the word "mix" does not reduce the likelihood of confusion (Badia's Opp. Br. at 17), but in each of the cases cited by Badia, the marks at issue were, unlike Badia's at best highly descriptive alleged marks, **suggestive or arbitrary** and entitled to broad protection.⁹

b. Gel and Badia do not Use Similar Advertising Methods.

There is no evidence in the record supporting Badia's argument that the parties advertise in similar channels. Badia cites to the testimony of Gel's Harry Blumenfeld to the effect that Gel may have advertised in print, including newspapers, grocery mailers, and grocery circulars "on a couple of occasions," but Mr. Blumenfeld's testimony concerned Gel's promotion of its own private branding offerings on the whole, not the Sazon Complete Mix Seasoning it sells under the Spice Supreme line. (See Blumenfeld Tr. attached as Ex. I to Badia's Br. at 105:1-7.)

The Court should not find this surprising because Badia and Gel are not aligned directly in competition. While the record abounds of advertisements to boost the Badia brand in general and its complete seasoning product in particular, **there is no "Gel brand" of spices**. That is because Gel's business is private label manufacturing. Thus it follows that while Badia has "invested significant sums of money to advertise and promote the Badia Products in the United States," including spending more than \$1.5 million dollars advertising its "*Sazon Completa*" and "Complete Seasoning" products in the United States, (Badia's Br. at 5), Gel's total advertising expenditure on Sazon Complete Mix Seasoning totaled \$350. (Blumenfeld Tr. at 87:9-27)

c. There is No Evidence that Gel Adopted its Product Name in Bad Faith.

It is undisputed that Gel was aware of Badia's alleged marks prior to creating its Sazon Complete Mix Seasoning. But there is no evidence that Gel named its product with the requisite "intention to derive a benefit from Plaintiff's business reputation" needed to establish bad faith. *Frehling v. Int'l Select Grp., Inc.*, 192 F.3d 1330, 1340 (11th Cir. 1999). Badia's argument that Gel "copied" Badia's product label by placing its brand name Spice Supreme at the top of its competing product defies logic. No reasonable consumer could confuse Badia's product (white label, green BADIA logo) next to Gel's Sazon Complete Mix Seasoning (tan label, black SPICE SUPREME logo) with each party's brand name displayed prominently at the top of each label.

⁹ Gel distinguished these cases in its brief in opposition to Plaintiff's Motion for Summary Judgment at p. 13.

d. There is No Evidence of Actual Confusion.

Badia has failed to present the “best evidence” of a likelihood of confusion, i.e., actual confusion. *See, Ocean Bio-Chem, Inc. v. Turner Network TV, Inc.*, 741 F. Supp. 1546, 1558 (S.D. Fla. 1990) (actual confusion is best evidence of infringement); *USA Nutraceuticals Grp., Inc. v. BPI Sports, LLC*, 165 F. Supp. 3d 1256 (S.D. Fla. 2016) (actual confusion factor weighed in favor of defendant where plaintiff admitted that there was no evidence of actual confusion). Badia admits that there is no evidence of actual confusion (which is not surprising given the differences in the parties’ product packaging and label discussed above), so this factor weighs in favor of Gel as a matter of law.

CONCLUSION

For all the foregoing reasons, defendant Gel Spice Company, Inc. requests that the Court grant Defendant Gel’s motion in its entirety seeking summary judgment pursuant to Rule 56 of the Federal Rules of Civil Procedure.

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CERTIFICATE OF SERVICE

I **HEREBY CERTIFY** that on October 11, 2016, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record identified on the Service List below in the manner specified, either via transmission of Notice of Electronic Filing Generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

By: /s/Mark E. Stein

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