

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA**

BADIA SPICES, INC.,

Plaintiff,

vs.

GEL SPICE COMPANY, INC.

Defendant.

Civil Action: 1:15-cv-24391-MGC

GEL SPICE COMPANY, INC.,

Counterclaim Plaintiff,

vs.

BADIA SPICES, INC.,

Counterclaim Defendant.

**DEFENDANT AND COUNTERCLAIMANT’S MEMORANDUM OF LAW IN
SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

Defendant Gel Spice Company, Inc. (“Gel” or “defendant”) submits this memorandum of law in support of its motion seeking summary judgment dismissing the complaint of Badia Spices, Inc. (“Badia” or “plaintiff”) and on its counterclaims to cancel the registrations for the United States trademarks “SAZON COMPLETA” and “COMPLETE SEASONING” (U.S. Reg. Nos. 2,856,679 and 2,885,777) pursuant to Rule 56 of the Federal Rules of Civil Procedure.

I. PRELIMINARY STATEMENT

Badia is suing Gel for trademark infringement based on Gel’s sale of its own blend of “all-purpose” or “complete” seasoning as . . . “complete seasoning.” Badia makes a lot of money selling its own complete seasoning formulation. In fact, Badia’s complete seasoning is the company’s number-one product, and Badia does not want competition in the lucrative, growing market for this product, a favorite among Latinos.

To preserve its market position, Badia has for years avoided the trouble of convincing consumers that its complete seasoning offering is of higher quality than that of competitors; that its blend is more desirable than other complete seasonings because of its taste; that chefs prefer it; or that Badia's complete seasoning otherwise represents a better value than others. Instead, Badia restricts consumers from choosing from among a range of competing complete seasoning offerings from different manufacturers by threatening competitors with trademark infringement litigation unless they agree to sell their complete seasoning by calling it something else.

Badia has had some, though not complete, success with this strategy, which the record shows it only employs intermittently and on an *ad hoc* basis. Badia's *in terrorem* approach to competition is premised on its registrations for "COMPLETE SEASONING" and "SAZON COMPLETA" (U.S. Reg. Nos. 2,885,777 and 2,856,679) (the "Badia Registrations"). Faced with the cost of litigation against a deep-pocketed, market-dominating adversary, competitors whom Badia deems sufficiently threatening must agree to compete with one hand behind their backs, or to face litigation. As a result, Badia maintains a *de facto* monopoly in the complete seasoning category. Badia's position regarding what competitors may call their own complete seasoning formulations is an inverted version of Henry Ford's famous saying that "You can have a Model T in any color you like, as long as it's black." In this case, you can call your complete seasoning blend whatever you like – as long as you don't call it complete seasoning.

But, generic terms for a product category are available to all to describe their offerings. And complete seasoning is what Gel is selling. Neither the law of trademarks nor the broader rubric of unfair competition support Badia's aggressive stance. Despite the technical designation of the Badia registrations as "incontestable," the term "complete seasoning" and its Spanish equivalent are **not** protectable as a matter of basic trademark law. They are, rather, two forms of a generic description for a category of seasonings. Badia has erected an artificial barrier to competition in the complete seasoning category by threatening meritless, but expensive, litigation. But Badia, like everyone else, should have to compete on quality, value and customer satisfaction.

By granting Gel summary judgment, this Court will even the playing field in the market for complete seasoning. And Gel is entitled to summary judgment because the term "complete seasoning" is indeed generic. It was born that way – it is so descriptive that its generic quality is clear from a simple inspection of the words. And even if, for argument's sake, the United States

Patent and Trademark Office were correct in allowing the Badia Registrations, the extensive third-party generic use of these terms in the record here demonstrates that they are certainly generic now. That is why Badia has, for all its saber-rattling, never received so much as a dollar in tribute or an admission of wrongdoing from any of the alleged “infringers” it has intimidated through the years into threatening its monopoly.

That Badia settles so cheaply leads to an obvious inference: It does not wish to risk the possibility that a competitor would call its bluff and ask a court to pass on the legitimacy of its purported rights. Badia has thus far avoided judicial scrutiny of its trademark claims here as well, conspicuously making no effort to obtain a preliminary injunction on the strength of its claims – the typical approach of a party with bona fide rights seeking relief from alleged infringement by a direct competitor using an almost identical “mark.” Badia’s moment of truth, however, has come.

The record demonstrates that “complete seasoning,” known in Spanish as *sazon completa*, is a term used by consumers, cooks and seasoning suppliers for a category of “all purpose” blends of spices and flavorings. Besides the obvious generic nature of these marks, discussed herein, the record also shows that other manufacturers and distributors seeking to meet the needs of growing demand for *sazon completa* have come to the market with blends they have described as “complete seasoning.” Among these uses are those demonstrated by documents produced by another competitor of Badia, Goya Foods, Inc. (“Goya”), one of the companies that decided it was better to switch than fight with Badia over “*sazon completa*,” given Badia’s irrational “bet the company” posture regarding its “trademarks” and its instable appetite for litigation.

Badia’s domination of this category cannot be explained by a quality difference between the complete seasoning it sells and the offerings of other manufacturers. Its success in keeping competition away is solely a result of its misuse of trademark law to avoid competition. And misuse it is, because contrary to Badia’s claims, trademark and unfair competition law do not restrict Gel’s right to compete in the market for complete seasoning – they **protect** competition. The law does not support Badia’s demand that Gel sell its less expensive complete seasoning by describing it with stilted, artificial or second-best terms.

It is for these reasons too that Badia’s claims for common law trademark infringement and unfair competition must fail along with its claim for infringement of its registered

“trademarks.” Gel is also entitled to summary judgment on Badia’s claims because Badia cannot show a likelihood of confusion between its alleged marks and Gel’s use of the same words to accurately describe its complete seasoning. While actual confusion is not required to show likelihood of confusion, the absence of a **single** instance of confusion between Badia’s product and Gel’s, which came to market more than four years ago – or between Badia’s product and any other product Badia regards as “infringing” its complete seasoning franchise over the span of four decades – substantially undermines Badia’s likelihood of confusion claim. Additionally, Badia’s alleged mark is so weak as to be virtually indistinguishable from the plain language description of the product, including Gel’s. Because Badia cannot demonstrate the existence of facts sufficient to meet the elements for showing a likelihood of confusion in this Circuit, its claim fails as a matter of law.

For these reasons, Gel is entitled to summary judgment on Badia’s claim for trademark infringement and on its counterclaims to cancel the Badia Registrations.

II. STATEMENT OF FACTS¹

Badia filed the Complaint in this action on November 30, 2015, alleging federal trademark infringement under 15 U.S.C. §1114(1); federal unfair competition, false description and false designation of origin as to marks, 15 U.S.C. §1125(a); and common law trademark infringement and unfair competition. [ECF 1]. Badia’s commencement of this action followed more than eight months of its unsuccessful attempts to intimidate Gel from continuing the lawful use of the phrase “Sazon Complete Mix Seasoning” to describe its product, which Gel had actually begun selling years earlier, in 2012. (Harry Blumenfeld Deposition attached as Exhibit 1 (“Blumenfeld Tr.”) at 49:22-25.)

On March 11, 2016, Gel filed its Answer, Affirmative Defenses and Counterclaims, in which Gel asserts that COMPLETE SEASONING and SAZON COMPLETA were at all times generic and not entitled to trademark protection such that the Badia Registrations should be cancelled. [ECF 12]. Gel also alleges that even if Badia’s alleged marks were entitled to

¹ All the contents of the Statement of Facts are found, as are their sources in the record, in the exhibits appended to this brief; the declarations submitted on behalf of Gel, and their accompanying exhibits; or otherwise as specifically cited.

protection at the time of registration, dismissal of their claims and cancellation of the Badia Registrations is appropriate because they have lost any supposed distinctiveness, i.e., secondary meaning, due, in part, to years of third-party usage – a process known as “genericide.”

Gel is a family-owned seasonings company that has been importing and manufacturing spices, seeds, bakery ingredients and other specialty ingredients since 1955. (Declaration of Harry Blumenfeld (“Blumenfeld Decl.”) attached as Exhibit 2 at ¶3.) It started selling complete seasoning in 2012 after one of its largest customers, grocery distributor Forte Distribution, Inc. (“Forte”), asked Gel to add a complete spice product to its Spice Supreme line. (Blumenfeld Decl. at ¶¶5-8; deposition testimony of Samson Baum attached as Exhibit 3 (“Baum Tr.”) at 58:4-8); deposition testimony of Sherman Engel attached as Exhibit 4 (“Engel Tr.”) at 53:6-16; deposition testimony of Romulo Rincon attached as Exhibit 5 (“Rincon Tr.”) at 64:10-65:2; declaration of Romulo Rincon (“Rincon Decl.”) attached as Exhibit 6 at ¶¶5-6.)

Gel had no difficulty complying with this request, given the commercial opportunity it represented. (Blumenfeld Tr. at 32:23-36:4; 40:19-43:22; 50:13-52:15; Rincon Tr. at 58:6-17; deposition testimony of Jeff Strand attached as Exhibit 7 (“Strand Tr.”) at 22:24-23:5.) Gel simply developed artwork for a label, came up with a descriptive name for its complete seasoning product – Sazon Complete Mix Seasoning – and set about manufacturing and bottling the product, the formulation for which was already in the Gel formulary at the time, according to Jeff Strand, Gel’s product development manager, who testified the product was simply added as one in “a general category of spices . . . a lot of companies have their own version of it, just like corn flakes” (Strand Tr. at 22:24-24:14; Blumenfeld Tr. at 40:19-43:22; 50:13-51:25; 67:22-68:3; 77:19-82:8; 113:5-114:16.) Gel’s Sazon Complete Mix Seasoning product is a typical all-purpose or complete seasoning blend, consisting of garlic, onion, oregano, parsley, salt, and MSG, used commonly in Latin recipes. (Baum Tr. at 58:13-22.)

Strand’s testimony is corroborated by Romulo Rincon, a principal of Forte, who testified that at the time Gel met Forte’s request to add Sazon Complete Mix Seasoning, Gel was the only spice company that did not carry a “sazon product,” i.e., a *sazon completa* or complete seasoning. (Rincon Tr. at 58:2-17; 64:10-21.)

Indeed, at least twenty-four other spice manufacturers have sold or currently sell competing complete seasoning spice products under phrases that incorporate the words “complete seasoning” or “*sazon completa*” in whole or in part, or are otherwise substantially

similar. (*Id.* at 64:22-65:2 (Listing manufacturers that sell a complete seasoning product: “Conchita, La Fe, La Flor, Goya, Mojave, El Guapo, Lisy, Badia, supermarkets in general.”); *see* documents produced by Goya in response to subpoena attached as Exhibit 8 at Bates range GOYA-00000001-15; 19-41; 328-336; 851-863; 871-876; 878-892; 895-901; 952-960; 2844-2845; documents produced by Gel attached as Exhibit 9 at Bates range GEL-0000234; 237-239; 241-254.) The widespread generic use of these words was readily demonstrated as recently as August 31, 2016, when a Gel employee purchased complete seasoning products from several different manufacturers, marketed under the names, respectively, of Goya Sazonador Complete Seasoning, La Criolla Complete Seasoning, Baldom Dominican Super Complete Seasoning, and Bohio Sazonador Completo. (Blumenfeld Decl. at ¶¶12-16; GEL 0000241-254.)

III. LEGAL ARGUMENT

A. SUMMARY JUDGMENT STANDARD.

“Summary judgment is appropriate where the pleadings and supporting materials establish that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986); Fed. R. Civ. P. 56(a). Summary judgment “is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed to secure the just, speedy[,] and inexpensive determination of every action.” *Pace v. Capobianco*, 283 F.3d 1275, 1284 (11th Cir. 2002). Summary judgment is appropriate unless there is a genuine issue of fact for trial. *See Agee v. Potter*, 216 Fed. Appx. 837, 840 (11th Cir. 2007). “For factual issues to be considered genuine, they must have a real basis in the record.” *Mize v. Jefferson City Bd. of Educ.*, 93 F.3d 739, 742 (11th Cir. 1996). In opposing a motion for summary judgment, the nonmoving party “must show specific facts to support that there is a genuine dispute.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). The nonmoving party may not rely on the pleadings, but rather must demonstrate a genuine issue for trial through affidavits, depositions, interrogatory answers, and admissions. *Celotex*, 477 U.S. at 323-24. The existence of a “mere scintilla” of evidence in support of the non-moving party’s position is insufficient; there must be evidence on which the finder of fact could reasonably find for the moving party. *See Nat’l Cas. Co. v.*

Pickens, 582 F. App'x 839, 840-41 (11th Cir. 2014) (quoting *Walker v. Darby*, 911 F.2d 1573, 1577 (11th Cir. 1990)).

As further explained below, under this standard and based on the record developed during discovery, the parties' claims are ripe for adjudication by summary judgment.

B. BADIA CANNOT PREVAIL ON ITS FEDERAL TRADEMARK INFRINGEMENT CLAIM (COUNT I).

To prevail on a trademark infringement claim under § 43(a) of the Lanham Act, a claimant must show that (i) its mark is valid and thus protectable; **and** (ii) defendant adopted an identical or similar mark that made consumers likely to confuse the two products. *See Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC*, 702 F.3d 1312, 1317 (11th Cir. 2012). As shown below, Badia cannot, as a matter of law, demonstrate the existence of a question of material fact to overcome the lack of evidence in the record for either of these two propositions.

1. Plaintiff's Alleged Marks are Generic, and Thus not Protectable.

Trademark protection is only available to "distinctive marks," meaning marks that have secondary meaning, i.e., those which identify a source of goods or services. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1991); *Welding Servs. v. Forman*, 509 F.3d 1351, 1357 (11th Cir. 2007). Badia has failed to come forward with any evidence on which a reasonable jury could base a conclusion that Badia's alleged marks are distinctive and entitled to trademark protection. Indeed, every fact in the record and the applicable analysis under the law demonstrate the complete opposite conclusion: That, far from being trademarks, "complete seasoning" and "*sazon completa*" are unprotectable, widely-used generic terms for a category of seasonings.

Trademark law posits four levels of distinctiveness among trademarks, or would-be trademarks: fanciful (or arbitrary), suggestive, descriptive, and generic. Arbitrary or fanciful marks such as ROLEX for watches or COACH for leather goods, communicate no message or semiotic association that bears any logical relationship to the goods or services with which they are used. These marks, therefore, are accorded the greatest level of protection under trademark law. Suggestive marks, such as HUMBLE ABODE for home furnishings, allude to some characteristic of the goods or services, but require a mental leap to connect the mark and the

product or service. Descriptive marks such as DIAL-A-MATTRESS identify “a characteristic or quality of the service or product” and are only entitled to trademark protection after acquiring secondary meaning, i.e., by a demonstration that, by virtue of long use or other evidence, the public associates the mark with a single source despite its descriptive qualities. *See Welding Servs.*, 509 F.3d at 1357; 2 J. Thomas McCarthy, *McCarthy on Trademarks* (“McCarthy”) § 11:16 (4th ed. 2015).

A generic name or term, however, is the word or description “by which the product or service is **commonly** known,” and is no trademark at all. It is entitled to no protection. *Welding Servs.*, 509 F.3d at 1358; *Fla. Int’l Univ. Bd. of Trs. v. Fla. Nat’l Univ., Inc.*, 91 F. Supp. 3d 1265, 1274 (S.D. Fla. 2015) (“Generic marks refer to a particular genus or class of goods or service providers that includes the plaintiff; these marks are not entitled to protection.”) Such a term “may not be registered as a trademark.” *Welding Servs.*, 509 F.3d at 1358, citing *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Nor can a generic name ever achieve trademark protection through acquiring secondary meaning. *See id.* 509 F.3d at 1357 (citing *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 n.20 (5th Cir. 1980)). “A [protectable] mark answers the question ‘Who are you? Where do you come from?’ . . . But the [generic] name of a product answers the question ‘What are you?’ . . .” In response to the question ‘What are you?’ many competitive goods or services will give the same answer, regardless of source of origin – e.g., Hunan-style Chinese restaurant, Pilates exercise instruction services, sun block lotion.” McCarthy at § 12.1.

For these reasons, even if a mark has been registered and has, by virtue of filing the appropriate affidavits of continuous use, been granted “incontestable” registration, **that status will not defeat a meritorious genericness challenge**. Thus many courts have found supposed marks with “incontestable” registrations to be generic *ab initio*. *See PODS Enters. v. U-Haul Int’l, Inc.*, Case No. 12-cv-01479, 2015 U.S. Dist. LEXIS 29849, at *7 (M.D. Fla. Mar. 10, 2015), citing *Retail Servs. Inc. v. Freebies Publ’g*, 364 F.3d 535, 542-43 (4th Cir. 2004). It follows, therefore, merely brandishing an “incontestable” registration will not prevent the entry of summary judgment if a defendant establishes genericness as a matter of law. McCarthy at § 12:12.

a. **Plaintiff's Alleged Marks are Inherently Generic.**

Badia's alleged marks, comprised of the words "COMPLETE SEASONING" in English and "SAZON COMPLETA" in Spanish, are generic for a category of all-purpose goods known as "complete seasoning." These terms, the evidence shows, are used and understood by consumers, manufacturers and others in the grocery business to describe products that fit into a genus of "all purpose"-type seasoning blends. *See* McCarthy at § 12:4 (consumers' perception is most significant in ascertaining genericness); *see Burger King Corp. v. Pilgrim's Pride Corp.*, 705 F. Supp. 1522, 1524-25 (S.D. Fla. 1988) (describing the test for genericness as a "term's meaning to a usual buyer or other relevant member[] of the public").

The generic nature of "complete seasoning" is not only self-evident, but is consistent with the observation by Professor McCarthy that terms consisting of an adjective followed by a noun – such as "CUSTOM BLENDED for a genus of gasoline sold at pumps where grades of gas were blended personally for the motorist"² – are likely to be found generic. McCarthy at § 12:19. Even "arguably descriptive terms" such as complete seasoning are "so descriptive as to be generic" where they "communicate functional characteristics." *See* McCarthy at § 12.10 (citing decision finding LITE BEER generic); *see e.g. Citibank, N.A. v. Citibanc Grp., Inc.*, 724 F.2d 1540, 1550-51 (11th Cir. 1984) ("'City Bank' is a generic term which cannot receive trademark protection. 'City Bank,' like 'town barber shop,' denotes a class of businesses.").

Because Badia dominates the market for complete seasoning – an artifact of its misuse of trademark law – it is likely to argue that its use of the words "complete seasoning" have vested it with so-called "*de facto* secondary meaning." This argument is of no moment, however. The fact that a certain "company is widely known as the leading producer of a product or that company is called to mind by many buyers when prompted by the product name is not sufficient to infuse a generic name with trademark significance." McCarthy at § 12:11.

Nor does it matter that Badia's complete seasoning is a "secret recipe" that others may not be able to replicate exactly,³ or if the term is used by different people to refer to entirely

² Other terms describing categories of this nature listed by McCarthy – where a claimed trademark is used by a manufacturer for its supposed "proprietary blend" or recipe of a product but where the term was found to be generic –include CANDY BOUQUET (floral-type gift arrangement of candies), CUBE STEAK (tenderized steaks), FRESH ORGANICS (fresh fruits and organic vegetables), PRETZEL CRISPS (pretzel crackers), SHREDDED WHEAT (baked wheat biscuit) and, of course, COLA (cola). *Id.* at § 12:19.

³ Badia has refused even to allow witnesses at deposition to reveal what is in its Complete Seasoning, despite the fact that there is a confidentiality order governing discovery in the case.

different kinds of blends from different cultures. It is not necessary for all the offerings within a genus to have identical qualities for the category to be generic; rather “while a name can be used on a wide line of products of more than one genus, it will legally remain a generic name of the particular kind of product that it names.” *Id.* at § 12:23, citing *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F. 3d 137 (2d. Cir. 1991), a case that held HONEY BROWN was generic for a category of lager. This is true despite the availability of other phrases to describe the same category of goods, such as, for example, “total seasoning” or “season all.” *Id.* at § 12.9 (citing *Ale House Mgmt. v. Raleigh Ale House, Inc.*, 205 F.3d 137 (4th Cir. 2000) (“ale house” found generic even though such a facility may also be called a bar, lounge, pub, saloon or tavern); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 U.S.P.Q.2d 1385 (T.T.A.B. 1999) (“e-ticket” found generic despite availability of “electronic ticket”); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 U.S.P.Q.2d 1949 (T.T.A.B. 2014) (“crisps” found generic despite alternative of “crackers”).

The generic quality of “complete seasoning” was as much as acknowledged by Badia’s Joseph Badia, creator of Badia’s highly lucrative complete seasoning blend and the company’s current President. Asked at his deposition why he decided to market Badia’s complete seasoning as “complete seasoning,” he admitted that the name was obvious – a no-brainer that “just happened” – for the simple reason that the product was . . . a complete seasoning:

- Q. Now why did you choose that name for the product?
- A. Because that was the only thing I could think of. It happened. I don’t know why it happened. That’s what we started calling it a long time ago.
- Q. You say that was the only thing you could think of. Why? What was it about that choice of a name that made you think of it?
- A. It was like a season-all, one product – you know, one-stop shop, complete, yeah.
- Q. It was like a complete seasoning?
- A. Yes.

(Deposition testimony of Joseph Badia attached as Exhibit 10 (“Badia Tr.”) at 20:6-11; objections to “form” omitted.)

The record also demonstrates a raft of generic uses of the words “complete seasoning” by dozens of other parties, including a large number of seasoning manufacturers. Among these uses are those demonstrated by documents produced by a common competitor of Badia and Gel,

Goya, in response to a subpoena for documents served by Gel after Gel learned that Goya and Badia had litigated over this very issue (that matter was settled). In fact, the full record includes evidence of no fewer than **two dozen** different third-party spice manufacturers besides plaintiff and Gel that market and sell, or have marketed and sold, a complete seasoning product utilizing the same terms that comprise Badia's alleged marks in their entirety, or are otherwise substantially similar. (See Exhibit 8 at GOYA-00000001-15; 19-41 ;328-336; 851-863; 871-876; 878-892; 895-901; 952-960; 2844-2845; Exhibit 9 at GEL-0000234; 237-239; 241-254.⁴) In addition to the overwhelming evidence of third-party spice manufacturers using the terms "complete seasoning" and "*sazon completa*" to market and sell their products, the record also contains extensive evidence of persons in the trade (non-manufacturers and food industry media) using the terms "complete seasoning" and "*sazon completa*" as generic terms to describe the type of spice blend, rather than the manufacturer. (See Exhibit 12 at GOYA-00000016-18; 42-47; 934-937; 940-941; 943; 947-949; see also the Declaration of Joel MacMull dated September 13, 2016 ("MacMull Decl."), Exs. A through F.)

b. Badia's Alleged Marks Have Lost Any Distinctiveness They May Have Had Due to Years of Third-Party Generic Usage.

"Complete seasoning," as demonstrated above, is clearly an example of *ab initio* genericness. But even if the phrase were not born unprotectable because it is generic, the record demonstrates that it is unquestionably generic now. A term that once qualified for trademark protection can become generic due to "genericide," "which means that a word that began as a coined term became generic through common usage." *PODS Enters.*, 2015 U.S. Dist. LEXIS 29849 at *6, citing *Hunt Masters, Inc. v. Landry's Seafood Rest., Inc.*, 240 F.3d 251, 255 (4th Cir. 2001). A belated attempt to "put the genie back in the bottle" is virtually never successful once an otherwise protectable term has become generic because of widespread use. McCarthy at

⁴ La Criolla- Complete Seasoning; Conchita- Sazon All Purpose Seasoning; Goya- Sazonador Total; Pamplona- Sazon Completa; Pami Lona- Sazon Super Completa; Preciosa Natural- Sazon Completa; Private Label Spices- Sazon Completa (All Purpose Spanish Seasoning); Publix – Condimento Completo; El Gozo- Complete Seasoning Sazon Completa; La Flor- Sazon Completa Complete Seasoning; American Spice- Complete Seasoning Sazon Completa; Lisy- Complete Seasoning; Iberia- Sazon Completa Complete Seasoning; Ralph's- Sazon Completa; Filpo- Sazon Seasoning; R.L Schreiber – Sazon Completa with MSG and Sazon Completa without MSG; Rosa Maria- Complete Seasoning Sazon Completa; Sabora- Complete Seasoning; Saborin- Sazona Todo; Tropical Sun Spices- Spanish Sazon Completa; Maggi – Sazon Completo; McCormick- Sazon and Completa; El Sembrador- Sazon Completa, Mimy's Products- Complete Seasoning Sazon Completa.

§ 12:26. It follows therefore that generic use by competitors that is not contested by the plaintiff is evidence of genericness. *Id.* at 12:1, citing *King-Seeley Thermos Co. v. Aladdin Industries, Inc.*, 321 F.2d 577, 579 (2d Cir. 1963). Here, the record is replete with such use.⁵ (*See* Exhibit 8 at GOYA-00000001-15; 19-41; 328-336; 851-863; 871-876; 878-892; 895-901; 952-960; 2844-2845; Exhibit 9 at GEL-0000234; 237-239; 241-254.) If “complete seasoning” were ever a trademark, it is not one now.

2. Even if the Badia Registrations were Deemed Protectable, Summary Judgment is Appropriate Because Badia Cannot Establish a Likelihood of Confusion Between its Alleged Marks and Gel’s use of “Sazon Complete Mix Seasoning” for its Complete Seasoning Product.

In evaluating whether there is a likelihood of confusion between two marks, the Eleventh Circuit applies the following seven-part, multi-factorial test: “(1) distinctiveness of the mark alleged to have been infringed; (2) similarity of the infringed and infringing marks; (3) similarity between the goods or services offered under the two marks; (4) similarity of the actual sales methods used by the two parties, such as their sales outlets and customer base; (5) similarity of advertising methods; (6) intent of the alleged infringer to misappropriate the proprietor’s good will; and (7) existence and extent of actual confusion in the consuming public.” *Welding Servs.*, 509 F.3d at 1360.

Likelihood of confusion is often deemed a fact intensive inquiry, but courts will decide the issue in order to grant summary judgment in appropriate cases. *See, e.g., Carnival Corp. v. SeaEscape Casino Cruises, Inc.*, 74 F. Supp. 2d 1261, 1263 (S.D. Fla. 1999) (granting summary judgment for defendant on trademark infringement claim in light of absence of actual confusion, dissimilar cruises provided by the parties, and the lack of substantial similarity of trademarks); *Trilink Saw Chain, LLC v. Blount, Inc.*, 583 F. Supp. 2d 1293, 1318-19 (N.D. Ga. 2008) (granting summary judgment on trademark infringement claim where court could not “conclude,

⁵ Anticipating the value of this evidence, Badia “stuffed” the evidentiary record just days before the close of fact discovery with recipes and other online articles that call for Badia-branded complete seasoning product, printed complete with little © symbols. Many of these uses, however, involve Badia as a sponsor or advertiser of the publication. By contrast, Gel had no difficulty turning up innumerable recipes which use the phrase “complete seasoning” in which the references are clearly not references to Badia’s product. (MacMull Decl., Exs. A through F.) Badia’s evidence on this score, therefore, is of little significance, because under the “primary significance rule . . . majority usage controls. . . . Even if the seller educates a few customers to use the generic term as a mark, it is still principally generic.” McCarthy, at § 12:6.

without evidence of actual confusion, that [the marks] are likely to lead to consumer confusion”); *HBP, Inc. v. Am. Marine Holdings, Inc.*, 290 F. Supp. 2d 1320, 1338 (M.D. Fla. 2003) (granting summary judgment on trademark infringement claim where no likelihood of customer confusion as to origin of defendant’s boat); *World Triathlon Corp. v. Dawn Syndicated Prods.*, Case No. 05-cv-983, 2007 U.S. Dist. LEXIS 72544, at *23-25 (M.D. Fla. Sep. 28, 2007) (granting motion for summary judgment on trademark infringement claim where “there simply is no likelihood of customer confusion as to origin or sponsorship”). The Court should do so here as well.

a. Plaintiff’s Alleged Marks are Weak.

The primary factors in assessing trademark strength are “the extent of third party usage and the relationship between the name and the service or good it describes.” *Freedom Sav. & Loan Ass’n v. Way*, 757 F.2d 1176, 1182 (11th Cir. 1985). Another indicator of trademark strength is whether there is a logical correlation between name and product— “if a seller of a product or service would naturally use a particular name, it is weakly protected.” *Id.* at 1182. Marks consisting of or incorporating common English words are weaker than marks comprised of fanciful and fictitious terms. *See Dieter v. B&H Indus. of Southwest Fla., Inc.*, 880 F.2d 322, 327 (11th Cir. 1989).

The fact that the Badia Registrations are “incontestable” does not render Badia’s alleged marks **strong**. *See Dieter*, 880 F.2d at 327; *accord, Michael Caruso & Co. v. Estefan Enters.*, 994 F. Supp. 1454, 1459 (S.D. Fla. 1998) (“incontestability does not render a mark strong”) (citations omitted); *see also Miss World (U.K.) Ltd. v. Mrs. America Pageants, Inc.*, 856 F.2d 1445, 1448-49 (9th Cir. 1988) (“incontestable status does not alone establish a strong mark”); *Oreck Corp. v. U.S. Floor Sys., Inc.*, 803 F.2d 166, 171 (5th Cir. 1986), *cert. denied*, 481 U.S. 1069 (1987) (incontestable status does not preclude defendant from arguing plaintiff’s mark is weak). Even those courts that have drawn a connection between incontestability and strength acknowledge that while “an incontestable mark is generally considered a ‘relatively strong mark,’ this presumption may be rebutted by evidence of extensive third-party use of the mark.” *Fla. Int’l Univ. Bd. of Trs.*, 91 F. Supp. 3d at 1275 (citations omitted). There is no “hard-and-fast rule establishing a single number that suffices to weaken a mark,” however. *Id.* Besides third-party use, courts in this Circuit consider “the entire name a third party uses, as well as the kind of

business in which the user is engaged” when analyzing the impact of third-party use. *See Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1165 (11th Cir. 1982).

Badia’s alleged marks are weak because they consist of common English and Spanish words used extensively by third parties to describe similar goods, i.e., a type of spice blend often utilized in Latin cuisine. *See Michael Caruso & Co.*, 994 F. Supp. at 1458 (finding plaintiff’s mark was weakened by extensive third-party use of the term “bongo”); *Fla. Int’l Univ. Bd. of Trs., v. Fla. Nat’l Univ., Inc.*, Case No. 15-cv-11509, 2016 U.S. App. LEXIS 13612, at *29, (11th Cir. 2016) (finding “extensive third-party use” (twelve third-party uses) diminished the strength of plaintiff’s mark). Furthermore, because Badia’s alleged marks are descriptive, they and variations of them are frequently used by other companies to market and sell all-purpose complete seasoning products in the United States. (*See* Exhibit 8 at GOYA-00000001-15; 19-41; 328-336; 851-863; 871-876; 878-892; 895-901; 952-960; 2844-2845; Exhibit 9 at GEL-0000234; 237-239; 241-254.) These extensive third-party uses weaken any rights that could be claimed in Badia’s alleged marks because they demonstrate that consumers do not identify the terms “complete seasoning” or “*sazon completa*” exclusively with Badia as it insists, but rather with the all-purpose spice blends known as “complete seasoning.” Badia has produced nothing in the way of any credible, admissible evidence to meet its burden of proof as to an alternative conclusion.

b. The Marks are Dissimilar.

There is so little similarity between the words used by Badia and Gel to describe their products that no reasonable fact-finder could find likelihood of confusion here. The mere fact that two marks incorporate a common word or words, even in association with competing goods or services, does not *per se* render the marks likely to be confused. *See, e.g., Freedom Sav. & Loan Ass’n*, 757 F.2d at 1183 (FREEDOM SAVINGS AND LOAN and FREEDOM REALTY marks “lack . . . confusing similarity”); *Bell Laboratories, Inc. v. Colonial Prods., Inc.*, 644 F. Supp. 542, 547, 231 USPQ 569 (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”).

While Badia uses “Complete Seasoning” on its bottles, Gel markets, and always has marketed its product as “Sazon Complete **Mix** Seasoning.” (See Exhibit 9 at Bates GEL0000073; 79.) Gel’s insertion of the word “mix” between the words “complete” and “seasoning” makes the visual and auditory similarities between the phrases sufficiently distinct so as to rule out any purported confusion. *Freedom Sav. & Loan Ass’n*, 757 F.2d at 1183 (when primary word is “weakly protected to begin with, minor alterations [can] effectively negate any confusing similarity between the two [marks]”); McCarthy at § 23:25. This conclusion is further compelled by the anti-dissection rule, which requires conflicting trademarks to be considered in terms of their **entire impression** rather than broken down into their individualized, isolated components. *Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc.*, 106 F.3d 355, 362 (11th Cir. 1997), citing *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-56 (1920). The rationale for the anti-dissection rule is that the commercial impression created by a composite trademark on an ordinary prospective consumer is created by the mark as a whole, “not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc.*, 252 U.S. at 546.

This seemingly small difference looms large because Badia’s alleged marks are so weak. “Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, i.e., are less likely to generate confusion over source identification, than their more fanciful counterparts.” *Juice Generation v. GS Enters. LLC*, 794 F.3d 1334, 1341 (Fed. Cir. 2015). Accordingly, in a situation where, as here, the senior trademark is weak, minor alterations will negate any confusing similarity between it and the altered variation. *Freedom Sav. & Loan Ass’n*, 757 F.2d at 1183. Gel’s inclusion of the word “mix” between the words “complete” and “seasoning” is all by itself sufficient to negate Badia’s likelihood of confusion claim, and for this reason Gel is entitled to summary judgment.

c. Badia Has Produced No Evidence of Actual Confusion.

It is a commonplace that while a trademark infringement claimant is not required to demonstrate actual consumer confusion in support of its claim, actual confusion is nevertheless the **best evidence** of a likelihood of confusion. See *Ocean Bio-Chem, Inc. v. Turner Network TV, Inc.*, 741 F. Supp. 1546, 1558 (S.D. Fla. 1990). Badia, however, has been unable to produce a single instance of actual consumer confusion between its product and Gel’s. And both Forte’s

30(b)(6) witness, Romulo Rincon, and Badia's own 30(b)(6) witness testified that they are **unaware of any actual confusion** between Badia's products and Gel's Sazon Complete Mix Seasoning. (Rincon Tr. at 127:13-16; Rule 30(b)(6) deposition testimony of Alina Lastra attached as Exhibit 11 ("Lastra Tr.") at 31:18-20.)

Additionally, Badia has not yet produced or indicated that it intends to submit survey evidence to support its likelihood of confusion claim here. The proliferation of third party uses of "complete seasoning" that support Gel's argument for genericness is compelling proof of the unlikelihood of confusion as well, as extensive third-party use of an alleged mark demonstrates its weakness and militates against a likelihood of confusion as against a junior user. *Fla. Int'l Univ. Bd. of Trs.*, 91 F. Supp. 3d at 1276-77. So does the complete absence of actual confusion after decades of "unauthorized" uses of "complete seasoning." Summary judgment is thus appropriate.

d. The Advertising Methods Used by Gel and Badia are Dissimilar.

In the Eleventh Circuit, the standard for assessing similarity between advertising methods is "whether there is likely to be significant enough overlap in the [audience of the advertisements] that a possibility of confusion could result." *Fla. Int'l Univ. Bd. of Trs.*, 2016 U.S. App. LEXIS 13612 at *44 (quoting *Frehling Enters., Inc.*, 192 F.3d 1330, 1340 (11th Cir. 1999)). Even where there is "substantial overlap" in the types of advertising methods used by parties, this factor will weigh in favor of a likelihood of confusion finding only if there is overlap in the audience of such advertisements. *See id.* at *44-45.

Here, there is no overlap in the types of advertising or in the audience the parties steer their advertisements towards. While Badia advertises its products through sponsored recipes, videos, social media, manufacturers coupons, and promotions, Gel has spent a mere \$350 on a **single** promotional flyer it developed when it launched its Sazon Complete Mix Seasoning product in 2012. (Lastra Tr. at 60:16-65:11; Blumenfeld Tr. at 87:9-27.) Because Gel is not, for all practical purposes, "advertising" its Sazon Complete Mix Seasoning product, there can be no overlap in the audience of Gel and Badia's advertisements.

e. **Gel did not Adopt its Mark in Bad Faith.**

When assessing the intent factor, a court must determine whether a defendant “had a conscious intent to capitalize on the plaintiff’s business reputation, was intentionally blind, or otherwise manifested improper intent.” *Fla. Int’l Univ. Bd. of Trs.*, 2016 U.S. App. LEXIS 13612 at *45-46. Here there is no evidence of bad faith on Gel’s part. The mere fact that a defendant had prior knowledge of plaintiff’s mark is “insufficient to create an inference of improper intent.” *Id.*

C. **GEL IS ENTITLED TO SUMMARY JUDGMENT ON BADIA’S FEDERAL UNFAIR COMPETITION CLAIMS (COUNT II).**

15 U.S.C. § 1125(a) is designed to protect against a broader range of deceptive or unfair trade practices than 15 U.S.C. § 1114. In addition, both provisions require the same test to determine whether the particular actions complained of are violative of their terms. *See Showtime/The Movie Channel v. Covered Bridge Condo*, 693 F. Supp. 1080, 1090 (S.D. Fla. 1988). Thus, as a general rule, the same set of facts which support an action for trademark infringement also support an action for unfair competition. *Babbit Electronics Inc. v. Dynascan Corp.*, 828 F. Supp. 944, 957 (S.D. Fla. 1993); *Marathon Mfg. Co. v. Enerlite Products Corp.*, 767 F.2d 214, 217 (5th Cir. 1985).

Accordingly, Badia’s false designation of origin and unfair competition claims are governed by the same legal analysis as its federal trademark infringement claim. And, for the same reasons set forth in the infringement section above, Gel is entitled to summary judgment on these claims as well.

D. **BADIA’S STATE LAW CLAIMS FOR COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION (COUNT III) SHOULD BE DISMISSED.**

“The analysis of Florida common law claims of trademark infringement and unfair competition is the same as under the federal trademark infringement claim.” *Pandora Jewelers 1995, Inc. v. Pandora Jewelry, LLC*, Case No. 09-cv-61490, 2011 U.S. Dist. LEXIS 59465, at *48 (S.D. Fla. June 2, 2011), citing *Custom Mfg. & Eng’g, Inc. v. Midway Servs., Inc.*, 508 F.3d

641, 652-53 (11th Cir. 2007). Thus, failure to establish an element of a federal trademark infringement claim will extinguish such claims under Florida law as well. *See id.* at 653.

Because Badia's federal trademark infringement claim fails as a matter of law for the reasons explained above, so too do its analogous state law claims.

E. GEL IS ENTITLED TO SUMMARY JUDGMENT CANCELLING THE BADIA REGISTRATIONS.

As set forth above, courts consistently recognize that a party may defend against alleged trademark infringement by showing the underlying mark is not entitled to protection because it is generic. As a corollary, generic "marks" that have been granted registration do not merit trademark protection and are thus "subject to cancellation at any time," even if the registration is incontestable. *Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 296 (S.D.N.Y. 2000); *cf.* 15 U.S.C. § 1065(4) ("no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which **it** is registered.") (emphasis added).

All the facts of record evidence applied to the applicable legal standards, as set forth in the previous sections, demonstrate that the terms "complete seasoning" and "*sazon completa*" are generic and not inherently distinctive. The widespread use of these terms, again, signifies that the particular product referred to belongs to the genus of ready-made, all-purpose seasonings. The alleged marks are understood by the consuming public, persons within the industry and even Badia itself as generic. Thus, the terms, notwithstanding their registration as trademarks, are legally indistinct and fail to merit protection under the Lanham Act. Accordingly, cancellation of U.S. Trademark Registration Numbers 2,856,679 and 2,885,777 is appropriate as a matter of law.

IV. CONCLUSION

It is the market, not Badia, that should decide which complete seasoning product offers better value. Contrary to Badia's claims, consumers are entitled to this because the purpose of trademark and unfair competition law is not, as Badia would have it, to stifle competition and restrict consumer choice. The law's purpose is to **protect** competition and **maximize** consumer choice –goals premised on a transparent commercial environment in which goods can be found and compared under the names consumers use to describe them. "Complete seasoning" is just

such a description. Moreover, to the extent Badia could be found to have any trademark rights at all in this generic term, it cannot, as set forth above, satisfy its burden to show the existence of a material disputed fact sufficient to justify going to a jury on the issue of a likelihood of confusion.

For all the foregoing reasons, defendant Gel Spice Company, Inc. requests that the Court grant its motion in its entirety seeking (i) summary judgment dismissing each of Badia Spices, Inc.'s affirmative claims; and (ii) further granting summary judgment in favor of defendant's counterclaims pursuant to Rule 56 of the Federal Rules of Civil Procedure.

Dated: September 13, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on September 13, 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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