

## **PRELIMINARY STATEMENT**

This Memorandum of Law in Opposition to Defendants' Motion to Dismiss demonstrates that Plaintiffs Ed Greene and Jack Greene have stated a plausible claim under the Lanham Act, warranting denial of Defendants' motion. Over nearly a decade, Plaintiffs have built *Emerald Greene Design* into a trusted name in Rye, synonymous with sustainable landscaping and eco-friendly practices. Defendants Rupinder Garcha and *Emerald Greens* threaten this reputation by adopting a strikingly similar name and branding while planning to expand into the same market, creating a substantial likelihood of consumer confusion and risking irreparable harm to Plaintiffs' goodwill. Defendants' Rule 12(b)(6) motion overlooks well-pleaded facts showing Plaintiffs' protectable interest and the likelihood of confusion. For these reasons, Defendants' motion should be denied.

## **STATEMENT OF FACTS**

Jack and Ed Greene ("the Greenes") own and operate *Emerald Greene Design*, a sustainable residential landscaping business that has served Rye, New York, since 2015. Known for their eco-friendly practices and high-quality service, the Greenes have become trusted pillars of the community. Their business serves over 100 families annually, many of whom have relied on their expertise for years. The *Emerald Greene Design* name, prominently featured on their trucks and local advertisements, has become synonymous with quality landscaping in the Rye area. The Greenes' goodwill is further evidenced by their strong community presence and recent feature in *The County*, a respected local newspaper.

In January 2022, Rupinder Garcha launched *Emerald Greens*, a vegan eatery in White Plains, New York, emphasizing eco-friendly practices similar to those of the Greenes. However, her business name and branding closely resemble *Emerald Greene Design*. Ms. Garcha's SUV prominently displays "Emerald Greens" in green lettering, mimicking the visual presentation of

the Greenes' truck signage. Now, Ms. Garcha plans to expand into Rye, directly encroaching on the Greenes' established market. When the Greenes asked Ms. Garcha to change her business name to avoid customer confusion, she refused, citing her investment in branding.

The Greenes, concerned about the dilution of their reputation and the likelihood of consumer confusion, assert that their unregistered mark has acquired protectable status through consistent use and community recognition. At this stage of litigation, their allegations of substantial branding efforts, community goodwill, and the likelihood of consumer confusion establish a plausible claim for relief, sufficient to overcome Defendants' Rule 12(b)(6) motion to dismiss.

## **ARGUMENT**

This brief demonstrates that the mark Emerald Greene Design is protectable under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A), which prohibits the use of any mark that "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association" between two businesses. Following the Second Circuit's two-prong test, this argument first establishes the mark's protectability by showing that Emerald Greene Design is an inherently distinctive, suggestive mark, requiring no secondary meaning for protection. The second prong assesses the likelihood of confusion using the Second Circuit's Polaroid factors, which include considerations such as the proximity of the parties' markets and the bridging of the gap between their businesses. Part I argues that Emerald Greene Design is suggestive because it invites consumer inference to connect it to landscaping services. Part II applies the Polaroid factors to demonstrate that the shared eco-conscious branding, overlapping consumer bases, and Emerald Greens' planned expansion into Rye significantly heighten the risk of consumer confusion. Together, these points show that Emerald Greene Design merits trademark protection and that the likelihood of confusion weighs in the Greenes' favor. Part III brings these elements together and

asserts that Emerald Greene Design's mark is protectable under Section 43(a) of the Lanham Act, and that Emerald Greens' imminent encroachment into Rye will cause consumer confusion.

## **I. THE MARK “EMERALD GREENE DESIGN” IS INHERENTLY DISTINCTIVE AND PROTECTABLE WITHOUT SECONDARY MEANING**

*This section demonstrates that (A) marks are inherently distinctive if they fall into the suggestive category under the Lanham Act, (B) courts have consistently distinguished suggestive marks from descriptive marks in relevant precedent, and (C) the mark “Emerald Greene Design” qualifies as suggestive because it requires consumer inference to connect it to landscaping services.*

### **A. Marks That Are Inherently Distinctive Do Not Require Secondary Meaning**

Under the Lanham Act, a mark is inherently distinctive and protectable without secondary meaning if it is suggestive, requiring consumers to use their imagination to link the mark to the associated product or service. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2d Cir. 1976). In contrast, descriptive marks immediately convey a characteristic of the product or service and require secondary meaning to be protectable. *Cross Commerce Media, Inc. v. Collective, Inc.*, 841 F.3d 155, 162–66 (2d Cir. 2016); *Gruner + Jahr USA Publ’g v. Meredith Corp.*, 991 F.2d 1072, 1075 (2d Cir. 1993)).

### **B. Courts Have Distinguished Suggestive Marks from Descriptive Marks**

In *Cross Commerce*, the court classified "Collective" as suggestive for data-driven analytic software, reasoning that it required a “substantial mental leap” for consumers to link the term to the services provided. *Id.* at 163. By contrast, in *Gruner + Jahr*, the court held that "PARENTS" for a parenting magazine was descriptive because it directly described the magazine’s content without requiring consumer inference. Suggestive marks, unlike descriptive ones, demand mental processing to connect the mark with the product or service. *Id.* at 1076

### **C. The Mark “Emerald Greene Design” Is Suggestive Rather Than Descriptive**

Much like "Collective" in *Cross Commerce*, "Emerald Greene Design" is suggestive

because it requires consumers to infer its connection to landscaping services. The term "Emerald" evokes nature and environmentalism, "Greene" reinforces an eco-conscious theme, and "Design" implies creativity and aesthetics. Together, these elements evoke an abstract, eco-friendly aesthetic without directly describing landscaping services, placing the mark firmly in the suggestive category. Unlike "PARENTS" in *Gruner + Jahr*, which plainly identified the content of a magazine, "Emerald Greene Design" invites consumer interpretation and mental association. Thus, "Emerald Greene Design" qualifies as a suggestive, inherently distinctive mark under Section 43(a) of the Lanham Act, and does not require a showing of secondary meaning to be protectable.

## **II. THE PROXIMITY OF PRODUCTS AND SERVICES AND THE BRIDGING OF THE GAP BETWEEN EMERALD GREENE DESIGN AND EMERALD GREENS INCREASE THE LIKELIHOOD OF CONSUMER CONFUSION.**

*This section demonstrates that (A) the close geographic proximity and shared eco-conscious themes of Emerald Greene Design and Emerald Greens heighten consumer confusion, and (B) the bridging of the gap between their markets further increases the likelihood of confusion.*

### **A. The Close Proximity and Shared Themes of Emerald Greene Design and Emerald Greens Heighten Consumer Confusion**

*This subsection shows that A(i) their shared eco-conscious branding themes, and A(ii) their businesses operating in neighboring towns within the same geographic market reinforce the likelihood of consumer confusion.*

#### **A(i). The Shared Eco-Conscious Branding Themes Reinforce the Likelihood of Consumer**

The shared eco-conscious branding themes of Emerald Greene Design and Emerald Greens reinforce the likelihood of consumer confusion. *Guthrie* denoted that courts recognize when businesses share similar branding concepts, consumers are oftentimes misled into assuming an affiliation between them, thereby increasing the likelihood of confusion. *Guthrie*, 826 F.3d at 45. The *Guthrie* court emphasized that shared thematic elements—such as health-related themes—oftentimes lead consumers to mistakenly believe that two businesses are affiliated. Similarly in *Artisan Mfg. Corp. v. All Granite & Marble Corp.*, 559 F. Supp. 2d 442, 451 (S.D.N.Y. 2008), the

court found that overlapping branding themes and consumer bases—home-improvement related themes—heightened the likelihood of confusion, despite the businesses offering distinct services. *Id.* at 450–51.

Both Emerald Greene Design and Emerald Greens utilize eco-conscious branding themes and cater to the same demographic of sustainability-minded suburban residents. Their mutual focus on environmental sustainability and organic offerings aligns their branding strategies. Following the reasoning in *Guthrie*, the use of similar green logos, fonts, and sustainability branding will most likely lead consumers to presume a relationship or affiliation between the two businesses, despite differences in their services. Like *Artisan*, where similarity in themes (kitchen and bath goods) misled consumers, the shared sustainability focus here could lead consumers to believe these businesses are affiliated.

#### **A(ii). The Businesses Operate in Neighboring Towns Within the Same Geographic Market**

The close geographic proximity of Emerald Greene Design and Emerald Greens operating in neighboring towns within the same market increases the likelihood of consumer confusion. In assessing product proximity, courts look at the nature of the business's offerings and the structure of its relevant market. *Cheddar Bob's Inc. v. Macsnmelts Mgmt. Co.*, No. 16-CV-1331, 2020 U.S. Dist. LEXIS 51092, at \*10, \*25 (E.D.N.Y. Jan. 14, 2020). The proximity of products and services factor assesses whether the geographic and market overlap between two businesses heightens the likelihood of consumer confusion. *Guthrie Healthcare Sys. v. ContextMedia, Inc.*, 826 F.3d 27, 38-39 (2d Cir. 2016). The *Guthrie* court found that when businesses with similar marks operate in the same geographic area and share thematic elements, the potential for consumer confusion is amplified, despite different products and services. *Guthrie Healthcare*, 826 F.3d at 44-45. This close proximity contrasts with *Cheddar Bob's*, where significant distance between businesses

reduced confusion, since both businesses operated in areas too distant.

Emerald Greene Design and Emerald Greens operate in lightly populated, neighboring towns within Westchester County, a tightly interconnected region where residents regularly travel between villages for dining, shopping, and other activities. This mirrors the *Guthrie* court, where the defendant's services (healthcare-related content producers) reached the same communities as the plaintiff's services (healthcare service providers), leading to confusion, given that consumer movement within a localized area increased the likelihood of exposure to both businesses. Unlike *Cheddar Bob's*, where the businesses operated in geographically distinct regions—one in Ohio and the other in New York—the shared market here intensifies the risk of confusion. The close proximity ensures overlapping consumer exposure to both businesses' branding and services, as seen in the Greene's sighting of Ms. Garcha's vehicle. This contrasts with *Cheddar Bob's*, where such incidental encounters between Ohio and New York businesses were unlikely.

## **B. The Bridging of the Gap Between the Parties' Markets and Ms. Garcha's Expansion into Rye Heighten Consumer Confusion**

*This subsection demonstrates that (B) overlapping consumer-demographics and geographic markets eliminate any market distinction; most notably when Ms. Garcha completes her intended expansion into the Rye area, which will directly target Emerald Greene Design's consumer base, effectively bridging the gap and guaranteeing a strong likelihood of confusion.*

The overlapping consumer demographics and geographic markets between Emerald Greene Design and Emerald Greens eliminate any meaningful market gap, increasing the likelihood of consumer confusion. The "bridging the gap" factor assesses whether the senior user is likely to enter the junior user's market or if consumers would perceive such an expansion as plausible, thus heightening the likelihood of confusion. *Nikon, Inc. v. Ikon Corp.*, 803 F. Supp. 910, 914 (S.D.N.Y. 1992). The *Nikon* court emphasized that a senior user already operating within the same market effectively negates the need to discuss bridging the gap, as direct competition and

consumer overlap make confusion likely. *Nikon*, at 918-19. The court in *Lion-Aire Corp. v. Lion Air Installation, Inc.*, No. 19-CV-3554, 2024 U.S. Dist. LEXIS 153890, at \*14, \*31 (E.D.N.Y. Aug. 27, 2024), reasoned that overlapping consumer demographics and geographic markets, particularly in localized or interconnected regions, almost completely eliminate market distinction. *Lion-Aire*, at \*31, \*35. However the court in *24 Hour Fitness USA, Inc. v. Tribeca Fitness, LLC*, 277 F. Supp. 2d 356 (S.D.N.Y. 2003), emphasized that the absence of a concrete plan to enter the junior user's market weakened the likelihood of confusion under the bridging the gap factor. While *24 Hour Fitness* expressed a general intention to expand into New York City, the lack of specific timelines or operational details diminished the perceived overlap between the two markets. *24 Hour Fitness USA*, F. Supp. 2d at 363. Similar to the *24 Hour Fitness* court, the court in *Brennan's, Inc. v. Brennan's Rest., L.L.C.*, 360 F.3d 125, 129 (2d Cir. 2004) asserted that significant distance between the two businesses attested to the distinct nature of their consumer base and thus significantly reduced the likelihood of consumer confusion.

Emerald Greene Design and Emerald Greens already operate within localized neighboring towns, a tightly interconnected region where residents frequently travel between communities for services. This geographic overlap ensures exposure to both businesses, collapsing any meaningful market distinction. Unlike *Brennan's*, 360 F.3d 125, 129, where a 1,000-mile gap significantly reduced confusion, the proximity here creates a shared consumer base of eco-conscious suburban residents, reinforcing confusion. See *Lion-Aire*, No. 19-CV-3554, at \*14, \*31. Moreover, Ms. Garcha has explicitly stated her intention to expand Emerald Greens into Rye, directly targeting Emerald Greene Design's established market and consumer base. Unlike the general expansion plans in *24 Hour Fitness*, Ms. Garcha's concrete plans to enter Rye eliminate any remaining market distinction and bridge the gap entirely. Her planned expansion mirrors the scenario in *Nikon*, where

the junior user's direct targeting of the senior user's market made confusion highly likely. This planned encroachment further ensures that consumers will associate the two businesses, exacerbating the likelihood of confusion.

### **III. CONCLUSION: EMERALD GREENE DESIGN MERITS PROTECTION UNDER THE LANHAM ACT**

Emerald Greene Design's mark is entitled to protection under the Lanham Act as an inherently distinctive, suggestive mark that requires no secondary meaning. The likelihood of consumer confusion is substantial, as evidenced by the close proximity of the businesses, their shared eco-conscious branding, and Emerald Greens' planned expansion into Rye, which directly targets Emerald Greene Design's market. Applying the Second Circuit's two-prong test and the *Polaroid* factors, the overlapping consumer demographics, elimination of market distinctions, and heightened risk of mistaken affiliation all weigh decisively in favor of the Greenes. Protecting Emerald Greene Design's mark is essential to safeguarding its goodwill, reputation, and consumer trust, and the court should deny Defendants' motion to dismiss.