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

Proceeding	91169059
Party	Defendant Lappert's Ice Cream, Inc. Lappert's Ice Cream, Inc. 223 Ohio Avenue Richmond, CA 94804
Correspondence Address	SUSAN G. O'NEILL HANSON, BRIDGETT, MARCUS, VLAHOS & RUDY 333 MARKET STREET, 21ST FLOOR SAN FRANCISCO, CA 94105-2173
Submission	Motion to Suspend for Civil Action
Filer's Name	Alexandra V. Atencio, Esq.
Filer's e-mail	aatencio@hansonbridgett.com
Signature	/alexandravatencio/
Date	02/28/2006
Attachments	Lappert's Mot. to Suspend.pdf (7 pages) Exh. A to Lappert's Mot. to Suspend.pdf (13 pages)

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

In the Matter of Trademark Application No. 76/624,588
Trademark: KAUAI PIE
Published in the Official Gazette on 1/4/06

LAPPERT'S, INC. Opposer, v. LAPPERT'S ICE CREAM, INC. Applicant	LAPPERT'S ICE CREAM, INC.'S MOTION TO SUSPEND PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD Opposition No. 91,169,059

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P. O. Box 1451
Alexandria, VA 22313-1415

LAPPERT'S ICE CREAM, INC.'S MOTION TO SUSPEND PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02, Applicant Lappert's Ice Cream, Inc. hereby moves to suspend this proceeding before the Trademark Trial and Appeal Board (hereinafter referred to as the "Board"). This motion is based on the ground that there is a civil action pending in the United States District Court for the Northern District of California regarding ownership of the mark at issue, which directly bears upon this proceeding.

I. PROCEDURAL HISTORY

On January 5, 2005, Lappert's Ice Cream, Inc. filed a United States Trademark Application Serial No. 76/624,588 ("Application") for registration on the Principal Register of

the word mark KAUAI PIE. On December 7, 2005, the Application was approved for publication on the Principal Register. After the mark was published, on February 3, 2006, Lappert's, Inc. initiated an Opposition proceeding to prevent the registration of KAUAI PIE.[1] As a basis for its Opposition, Lappert's, Inc. alleges likelihood of confusion with and dilution of its use of the KAUAI PIE mark.[2]

On February 22, 2006, Lappert's Ice Cream, Inc. filed a civil action in the United States District Court for the Northern District of California for declaratory relief. Specifically, Lappert's Ice Cream, Inc. seeks a determination that it is the sole owner of, among other marks, the KAUAI PIE mark.[3] Because the pending civil action directly bears upon these Board proceedings, Lappert's Ice Cream, Inc. now moves to suspend the Board proceedings until final determination of the civil action.

II. DISCUSSION

THE BOARD SHOULD SUSPEND THESE PROCEEDINGS BECAUSE THE OUTCOME OF THE PENDING CIVIL ACTION BETWEEN THE PARTIES WILL DIRECTLY BEAR UPON THE ISSUES INVOLVED IN THESE PROCEEDINGS.

"Ordinarily, the Board will suspend proceedings in the case before it if the final determination of [a pending civil action] will have a bearing on the issues before the Board."[4] It is better policy to suspend Board proceedings to await final determination of the civil action since a decision by the court is binding on the Patent Office, but the opposite is not true.[5]

In *Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 U.S.P.Q. 125,

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[1] *See* Opposer's Notice of Opposition.
[2] *See* Opposer's Notice of Opposition at 2,3.
[3] *See Lappert's Ice Cream, Inc. v. Lappert's, Inc.*, Case No. C 06 1296, U.S. District Court for the Northern District of California, filed on February 22, 2006; Exhibit A to Declaration of Alexandra V. Atencio ("Atencio Decl.").
[4] *See* 37 CFR § 2.117(a); *Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 U.S.P.Q. 125.
[5] *Tokaido v. Honda Assoc. Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973).

the opposer to an application for a trademark filed a motion to suspend the Board proceedings pending the outcome of a subsequently filed civil suit between the parties.[6] The Board suspended the opposition proceedings until final determination of the civil action based on the similarity of issues involved in the two actions. The Board reasoned that because the civil action was instituted to determine the respective rights of the parties to use in commerce the trademark applied for, "it [was] clear ... that the final determination of the civil suit w[ould] directly affect the resolution of the issue of likelihood of confusion which [was] involved in the proceeding before the Trademark Trial and Appeal Board."[7]

Here, the same reasoning applies because the issues involved in the pending civil suit between the parties and those involved in the Board proceedings are the same. In both proceedings, ownership of the mark KAUAI PIE is at issue. Lappert's, Inc.'s Opposition in this proceeding alleges that it is the owner of the KAUAI PIE mark, and therefore, Lappert's Ice Cream, Inc.'s registration of that mark is likely to cause confusion and would dilute the value of the mark.[8] However, Lappert's Ice Cream, Inc. asserts sole ownership of the KAUAI PIE mark and seeks declaratory relief in the federal action to declare its sole ownership. Because the same issues and evidence would be adjudicated in both proceedings, under *Other Telephone Co.*, the Board proceedings should be suspended until final determination of the civil action.

Further, because the federal court decision is binding on the Board and Board decisions are not binding on the court, it is better policy to suspend the Board proceedings until a final determination of the civil action.[9] Accordingly, pursuant to 37 CFR § 2.117(a), Lappert's Ice

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[6] *See The Other Telephone Co. v. Connecticut National Telephone Co., Inc.*, 181 U.S.P.Q. 125 (T.T.A.B. 1974).
[7] *See id* at 126-27.
[8] *See* Opposer's Notice of Opposition at 2.
[9] *See* TBMP § 510.02(a); *see also Tokaido v. Honda Assoc. Inc.*, 179 U.S.P.Q. 861, 862 (T.T.A.B. 1973).

Cream, Inc. respectfully requests that the Board suspend these proceedings until the final disposition of the pending civil action.

III. CONCLUSION

For these reasons and based on the entire files and records of this proceeding, this proceeding should be suspended.

Dated: February 27, 2006

Respectfully submitted,

By: Alexandra V. Atencio

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Garner K. Weng
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application No. 76/624,588
Trademark: KAUAI PIE
Published in the Official Gazette on 1/4/06

LAPPERT'S, INC. Opposer, v. LAPPERT'S ICE CREAM, INC. Applicant	DECLARATION OF ALEXANDRA V. ATENCIO IN SUPPORT OF LAPPERT'S ICE CREAM, INC.'S MOTION TO SUSPEND PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD Opposition No. 91,169,059

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

DECLARATION OF ALEXANDRA V. ATENCIO IN SUPPORT OF LAPPERT'S ICE CREAM, INC.'S MOTION TO SUSPEND PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

I, Alexandra V. Atencio, do declare and state as follows:

1 I am an attorney with the law firm of Hanson, Bridgett, Marcus, Vlahos & Rudy, LLP ("Hanson Bridgett"), the attorneys for Applicant, Lappert's Ice Cream, Inc., in the captioned matter. I make this declaration in support of Lappert's Ice Cream, Inc.'s Motion to Suspend Proceedings Before the Trademark Trial and Appeal Board. The following statements are within my personal knowledge; all statements made herein of my own knowledge are true; all statements made herein on information and belief are believed to be true. These statements are made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this document.

2. On February 22, 2006, Hanson Bridgett filed a Complaint on behalf of Lappert's

Ice Cream, Inc. seeking declaratory relief against Lappert's, Inc. in the United States District Court for the Northern District of California, Case No. C 06 1296. The second claim for relief seeks a declaration that Applicant is the owner of the KAUAI PIE mark. A true and correct copy of the Complaint is attached hereto as Exhibit A.

Signed at San Francisco, California, this 27th day of February, 2006.

ALEXANDRA V. ATENCIO

Certificate of Service

I hereby certify that a true copy of the foregoing LAPPERT'S ICE CREAM, INC.'S MOTION TO SUSPEND PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD and the Exhibits thereto, were served on opposer LAPPERT'S, INC., by first class mail, postage prepaid, this 28th day of February, 2006 to Opposer's attorney:

C. Dennis Loomis
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	Rosa M. Carrillo Rosa M. Carrillo, Assistant to Alexandra V. Atencio Attorney for Applicant LAPPERT'S ICE CREAM, INC. Hanson Bridgett, Marcus, Vlahos & Rudy, LLP 425 Market Street, 26th Floor San Francisco, CA 94105

Exhibit A

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NORTHERN DISTRICT OF CALIFORNIA

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UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO-OAKLAND DIVISION

SC

C 06 1296

LAPPERT'S ICE CREAM, INC., a California Corporation,

Plaintiff,

v.

LAPPERT'S, INC., a Hawaii Corporation,

Defendant.

COMPLAINT FOR DECLARATORY RELIEF REGARDING TRADEMARK OWNERSHIP

DEMAND FOR JURY TRIAL

Plaintiff Lappert's Ice Cream, Inc. (a California Corporation) ("Lappert's") brings this action against Defendant Lappert's, Inc. (a Hawaii Corporation) ("Lappert's Hawaii") for declaratory relief regarding the ownership of U.S. trademark rights under federal law.

JURISDICTION

1. This action arises under the Declaratory Judgment Act, Title 28 of the United States Code, Sections 2201 and 2202. As set forth in this Complaint, there is an actual, substantial, and continuing justiciable controversy between Plaintiff Lappert's and Defendant Lappert's Hawaii of sufficient immediacy and reality so as to require a declaration of rights by this Court concerning the ownership of the U.S. trademark rights under federal trademark law, particularly with respect to the following trademarks, in connection with ice cream confections,

bakery goods, and coffee: the combination word-design logo made up of the word LAPPERT'S over the image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap) (and variations of this design); the word mark LAPPERT'S (and variations); and the word mark KAUAI PIE. This Court has subject matter jurisdiction over the claims in this action under Title 28 of the United States Code, Sections 1331 (federal question), 1332 (diversity), and 1338(a) (Acts of Congress relating to trademarks) and Title 15 of the United States Code, Sections 1121 *et seq.* (the Lanham Act). Among other things, the claims in this action relate to questions regarding federal trademark law, federal trademark registrations, and applications for federal trademark registration; and the parties to this action are citizens of different States, with the matter in controversy exceeding the sum or value of $75,000.

VENUE

2. Venue is proper in this district pursuant to Title 28 of the United States Code, Section 1391(b). Among other things, a substantial part of the events or omissions giving rise to the claims in this action occurred and continues to occur in this District; and a substantial part of the property that is subject of this action is situated within this District.

INTRADISTRICT ASSIGNMENT

3. Intradistrict assignment to the San Francisco or Oakland Division is appropriate under Civil L.R. 3-2(c) and (d), if applicable. Among other things, a substantial part of the events or omissions giving rise to the claims in this action occurred in the Counties of Contra Costa and Marin, which is encompassed within this Division; and a substantial part of the property that is subject of this action is situated within the County of Contra Costa, which is encompassed within this Division.

PARTIES

4. Plaintiff Lappert's is a corporation organized and existing under the laws of the State of California, having its principal place of business at 223 Ohio Avenue, Richmond, California 94804.

5. Plaintiff is informed and believes and on that basis alleges that Defendant Lappert's Hawaii is a corporation organized and existing under the laws of the State of Hawaii,

having its principal place of business in Hanapepe, Kauai, Hawaii and a mailing address at P.O. Box 692, Hanapepe, Kauai, Hawaii 96716.

GENERAL ALLEGATIONS

6. Plaintiff Lappert's is a provider of premium ice cream and bakery goods and gourmet coffee. Its products are available at stores and restaurants throughout the U.S., including without limitation in California (and multiple locations within the San Francisco Bay Area alone), Nevada, Arizona, Washington, and Illinois; and its products are also available through orders that can be shipped to other locations, including without limitation throughout the mainland U.S. Lappert's (including its predecessors in interest) has long and continuously used a number of trademarks in connection with its ice cream, bakery goods, and coffee products, including without limitation several variations of a combination word-design logos made up of the word LAPPERT'S over the image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap), the word mark LAPPERT'S (and variations), and the word mark KAUAI PIE. Lappert's is the owner of the exclusive U.S. trademark rights in these marks.

7. Underscoring this, Lappert's is the owner of four separate U.S. federal trademark registrations for combination word-design logos made up of the word LAPPERT'S over the image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap). These four registrations are as follows:

Mark Description	*Reg. No.*	*Goods*	*App. Date*	*Reg. Date*
LAPPERT'S design logo	1451116	ice cream confections	7/17/86	8/4/87
LAPPERT'S design logo	1845794	bakery goods and coffee	8/16/93	7/19/94
LAPPERT'S ICE CREAM design logo	2043342	ice cream confections	2/27/96	3/11/97
LAPPERT'S COFFEE design logo	2043345	coffee	2/27/96	3/11/97

8. Not only have these registrations issued, filings have been made and accepted under Lanham Act Section 15 for each of the four registrations, making Lappert's exclusive rights to these marks throughout the U.S. incontestable under federal law. Accordingly, under federal law, these four trademark registrations are conclusive evidence that Lappert's is the owner of the

exclusive rights to these marks throughout the U.S. Incidentally, while Walter Lappert has since passed away, he was alive at the time that these applications were filed and when these registrations issued; and his consent for his likeness to be used in the trademarks is on record with the U.S. Patent & Trademark Office.

9. Lappert's has also applied for U.S. federal trademark registration of the word mark LAPPERT'S in connection with ice cream, coffee, and bakery goods. It filed the application on September 21, 2005; and the application is designated as Serial No. 78717667.

10. Lappert's has additionally applied for U.S. federal trademark registration of the word mark KAUAI PIE in connection with ice cream and coffee. It filed the application on December 16, 2004; and the application is designated as Serial No. 76624588.

11. Lappert's has invested substantial time and resources into promoting and advertising its high-quality ice cream, bakery goods, and coffee under the aforementioned trademarks. Plaintiff is informed and believes and on that basis alleges that the public has come to know these trademarks as designating the high-quality goods provided by Lappert's. By virtue of the described widespread use, promotion, and recognition of these marks, the marks have acquired goodwill, valuable commercial magnetism, and a distinctiveness of secondary meaning signifying Lappert's and the goods that it provides under these marks.

12. Plaintiff is informed and believes and on that basis alleges that Defendant Lappert's Hawaii has long known of the existence of Lappert's, the business of Lappert's, the use of trademarks by Lappert's in connection with ice cream, bakery goods, and coffee (including without limitation the four marks that are covered by the above-referenced U.S. trademark registrations, the word mark LAPPERT's, and the word mark KAUAI PIE), and specifically the four above-referenced U.S. trademark registrations owned by Lappert's. In fact, Lappert's and Lappert's Hawaii have had a long-time business relationship going back many years—in particular including Lappert's licensing the use of certain trademarks to Lappert's Hawaii. It has always been the understanding of Lappert's, however, that Lappert's Hawaii acknowledged and understood that Lappert's owned the trademarks at issue and that all use of the any trademarks at issue by Lappert's Hawaii inured to the benefit of Lappert's.

13. Despite this relationship and past understanding, Lappert's Hawaii suddenly now claims to be the exclusive owner—even relative to Lappert's—of the trademark rights throughout the U.S. in various trademarks identical, similar to, or incorporating in whole or in part trademarks used, owned, and registered by Lappert's. Among the trademarks in which Lappert's Hawaii has now claimed exclusive rights throughout the U.S. are a combination word-design logo featuring the word LAPPERT'S and using the profile of Walter Lappert and the word mark KAUAI PIE. Specifically, on or about February 15, 2006, Lappert's Hawaii informed Lappert's that it believes it has "rights to the tradenames and trademarks" at issue between the companies.

14. On top of this stated claim, Lappert's Hawaii has actually applied for U.S. federal trademark registration of a combination word-design logo made up of the word LAPPERT'S across a circle, the word ICE CREAM across the top of and following the contours of the circle, the word COFFEE across the top of and following the contours of the circle, and within the circle, another smaller circle containing a side profile of a man with a mustache and beard wearing a cap, in connection with bakery deserts, coffee, coffee beans, cookies, dough, frozen confections, frozen yogurt, ground coffee beans, ice cream, ice cream drinks, ice cream cakes, prepared coffee and coffee-based beverages, roasted coffee beans, retail shops featuring ice cream and coffee, and coffee roasting and processing. According to the online records of the U.S. Patent & Trademark Office, this application was filed on August 18, 2005 and is designated as Serial No. 78695972.

15. In the mark that is the subject of this application, the profile of the man with a mustache and beard and wearing a cap that is shown in the trademark is identical to the profile of Walter Lappert that makes up each of the four U.S. trademark registrations owned by Lappert's, described above, except that Walter Lappert is facing to the right (instead of to the left). By the nature of the application, Lappert's Hawaii is claiming the exclusive right to use the described combination word-design logo featuring the word LAPPERT'S and the profile of Walter Lappert. Indeed, in the application, Ms. Mary Pratt (as President of Lappert's Hawaii) swears under penalty of law that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce . . ."

16. On or about December 7, 2005, the U.S. Patent & Trademark Office approved for

publication the application by Lappert's for U.S. trademark registration of KAUAI PIE—indicating that it intended to issue the registration to Lappert's. But on or about February 3, 2006, Lappert's Hawaii filed a Notice of Opposition seeking to prevent the U.S. Patent & Trademark Office from issuing this registration to Lappert's. In the Notice of Opposition, Lappert's Hawaii expressly claimed to own the "exclusive right to use the mark KAUAI PIE for ice cream and coffee . . . ." An opposition proceeding is now pending before the Trademark Trial and Appeal Board. And based on Lappert's Hawaii's statements and actions to date, Lappert's has a reasonable apprehension that Lappert's Hawaii may try to interfere similarly with its pending application for federal registration of the word mark LAPPERT'S or somehow try to take some action against its existing registrations.

17. Also based on Lappert's Hawaii's statements and actions to date—including without limitation its express statements that it owns the exclusive rights to the aforementioned trademarks throughout the U.S.—and based on the fact that Lappert's continues to use its trademarks in which Lappert's Hawaii is now suddenly also claiming exclusive rights, Lappert's has a reasonable apprehension that Lappert's Hawaii will sue it for trademark infringement.

18. Plaintiff is informed and believes and on that basis alleges that Lappert's Hawaii has long known specifically that the corporate headquarters of Lappert's is in California, that Lappert's is a California corporation, that many of the customers of Lappert's are California residents and visitors to California, that many of the sales of Lappert's are made in California, and that many of the locations at which Lappert's products at issue in this action are available are in California. Accordingly, Lappert's Hawaii well knew that its claims of exclusive rights of the trademarks at issue in this action, its application for federal registration of one of these marks (Serial No. 78695972), and its opposition to the application by Lappert's for federal registration of one of these marks would impact Lappert's in California.

19. Moreover, Plaintiff is informed and believes and on that basis alleges that Lappert's Hawaii expressly aims its products—labeled under the trademarks at issue in this action—for sale in California and to California residents.

20. Among other things, Plaintiff is informed and believes and on that basis alleges

that California residents are a particularly strong market for and source of tourism business for Hawaii—and by consequence, they are a strong source of business for the locations in Hawaii at which the products of Lappert's Hawaii are featured. The Hawaii Visitors & Convention Bureau reports on its Web site that, according to its preliminary 2005 numbers, 40.5% of all visitors to Hawaii came from the "U.S. West"—i.e., states on the U.S. mainland that are west of the Rockies. The Hawaii Visitors & Convention Bureau further reports on its Web site that, according to its preliminary 2005 numbers, among all major markets worldwide, travelers to Hawaii haled most often from the Los Angeles, California area (over 740,000 visitors)—with the San Francisco, California area coming in second (over 530,000 visitors), the San Diego, California area coming in sixth (over 160,000 visitors), and the Sacramento, California area coming in eighth (over 110,000 visitors). Accordingly, Plaintiff is informed and believes and on that basis alleges that Hawaii attractions that appeal to tourists—including Lappert's Hawaii—place their marketing and advertisements in Web sites, publications, press, and other media that are targeted toward or have strong visibility or circulation among California residents.

21. Furthermore, Plaintiff is informed and believes and on that basis alleges that Lappert's Hawaii specifically offers and provides its ice cream, bakery goods, and coffee products, under the trademarks at issue in this action, to California residents—including without limitation by phone and mail order and including without limitation as advertised on Web sites accessible by California residents. The Lappert's Hawaii Web site, accessible at www.lappertshawaii.com, states, "If you would like to order coffee or ice cream before then, please call 1-800-356-4045."

22. On a similar note, the Hawaii Magazine Web site, accessible at www.hawaiimagazine.com, contains an article discussing Lappert's Hawaii with an inset text box stating, "If you live west of Colorado, you can mail order Lappert's ice cream, cookies and cinnamon rolls by calling (800) 356-4045. For more information, contact Lappert's Inc., at P.O. Box 692, Hanapepe, Kauai, HI 96716." Additionally, the Hawaii Food Manufacturers Association Web site, accessible at www.foodsofhawaii.com, contains a member listing page for Lappert's Hawaii that states that the company's sales methods include "Wholesale," "Retail," and

"Mail Order" and lists a mailing address, phone number, fax number, and e-mail address for reaching Lappert's Hawaii. The Web site also states explicitly that the association's members "are active in markets around the world."

FIRST CLAIM FOR RELIEF
Declaratory Judgment re:
Ownership of U.S. Trademark Rights in
LAPPERT's word mark, LAPPERT'S combination word-design logos, and design logos featuring likeness of Walter Lappert

23. Plaintiff Lappert's restates and re-avers the allegations of Paragraphs 1 through 22, inclusive, as if set forth here in full as part of this claim for relief.

24. Lappert's owns a family of LAPPERT'S word marks and combination word-design marks featuring the profile of Walter Lappert in connection with ice cream confections, bakery goods, and coffee. Among other things, Lappert's owns the four above-described and now-incontestable U.S. federal trademark registrations for combination word-design logos made up of the word LAPPERT'S over the image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap). Lappert's claims exclusive ownership in the trademark rights in this design (and any similar designs showing a profile of Walter Lappert) throughout the U.S.—and also claims exclusive ownership in the trademark rights in the word mark LAPPERT'S throughout the U.S.

25. Defendant Lappert's Hawaii has filed the above-described application for federal trademark registration for a design incorporating the word LAPPERT's and incorporating an image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap)—the same exact graphic used in the registered trademarks of Lappert's, though with Walter Lappert facing to the right instead of to the left. Lappert's Hawaii also claims exclusive trademark rights in this combination word-design logo, and in other Lappert's marks, throughout the U.S. With the overlap of the term LAPPERT's, the virtually identical side profile of Walter Lappert, and the similar goods, the rights of Lappert's and the claimed rights of Lappert's Hawaii are in direct conflict.

26. Accordingly, there exists an actual, substantial, and continuing justiciable controversy between Lappert's and Lappert's Hawaii concerning who, between them, owns the

U.S. trademark rights to the word mark LAPPERT'S, the combination word-design logos made up of the word LAPPERT'S over the image of a side profile of Walter Lappert (shown as a man with a mustache and beard wearing a cap)—including without limitation variations of this word-design logo and any designs logos featuring the profile or likeness of Walter Lappert—in connection with ice cream confections, bakery goods, and coffee. Lappert's desires and requests a judicial determination and declaration of the respective rights and duties of the parties based on the disputes recited above. This determination and declaration is necessary and appropriate at this time so that the parties may ascertain their respective rights and duties regarding the aforementioned trademark.

SECOND CLAIM FOR RELIEF
Declaratory Judgment re:
Ownership of U.S. Trademark Rights in
KAUAI PIE word mark

27. Plaintiff Lappert's restates and re-avers the allegations of Paragraphs 1 through 26, inclusive, as if set forth here in full as part of this claim for relief.

28. Lappert's claims exclusive ownership in the trademark rights in the word mark KAUAI PIE throughout the U.S. in connection with ice cream confections, bakery goods, and coffee—and has applied for federal registration of this mark. Defendant Lappert's Hawaii has instituted an opposition against this application, seeking to prevent the registration from issuing to Lappert's. Lappert's Hawaii also claims exclusive trademark rights in KAUAI PIE throughout the U.S.

29. Accordingly, there exists an actual, substantial, and continuing justiciable controversy between Lappert's and Lappert's Hawaii concerning who, between them, owns the U.S. trademark rights to the word mark KAUAI PIE in connection with ice cream and coffee. Lappert's desires and requests a judicial determination and declaration of the respective rights and duties of the parties based on the disputes recited above. This determination and declaration is necessary and appropriate at this time so that the parties may ascertain their respective rights and duties regarding the aforementioned trademark.

PRAYER FOR RELIEF

Plaintiff Lappert's prays against Defendant Lappert's Hawaii as follows:

(1) For a judgment declaring that the following U.S. trademark registrations are owned by Lappert's—and are valid and enforceable:

(a) Registration No. 1451116;

(b) Registration No. 1845794;

(c) Registration No. 2043342; and

(d) Registration No. 2043345.

(2) For a judgment declaring that Lappert's is the exclusive owner of the trademark rights throughout the U.S. in the following marks in connection with ice cream, bakery goods, coffee, and similar goods:

(a) the word mark LAPPERT'S (and variations);

(b) any design logo using the word LAPPERT'S;

(c) any design logo featuring the profile or other likeness of Walter Lappert; and

(d) the word mark KAUAI PIE.

(3) For an assessment of costs against Defendant Lappert's Hawaii; and

(4) For such other and further relief as the Court may deem just and proper.

DATED: February 22, 2006

HANSON BRIDGETT MARCUS
VLAHOS & RUDY, LLP

By: G. Weng

SUSAN G. O'NEILL
GARNER K. WENG
ALEXANDRA ATENCIO
Attorneys for Plaintiff
LAPPERT'S ICE CREAM, INC., a
California Corporation

DEMAND FOR JURY TRIAL

Plaintiff Lappert's Ice Cream, Inc. hereby demands a trial by jury in this action as to all issues and claims for relief so triable.

DATED: February 22, 2006

HANSON BRIDGETT MARCUS
VLAHOS & RUDY, LLP

By: G. Weng

SUSAN G. O'NEILL
GARNER K. WENG
ALEXANDRA ATENCIO
Attorneys for Plaintiff
LAPPERT'S ICE CREAM, INC., a
California Corporation

CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil L.R. 3-16, the undersigned certifies that the following listed persons, associations of persons, firms, partnerships, corporations (including parent corporations) or other entities (i) have a financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) have a non-financial interest in the subject matter in controversy or in a party that could be substantially affected by the outcome of this proceeding:

- Michael Lappert—sole shareholder in Plaintiff Lappert's Ice Cream, Inc. (a California Corporation); 50% shareholder in Defendant Lappert's, Inc. (a Hawaii Corporation); and
- Mary Pratt—50% shareholder in Defendant Lappert's, Inc. (a Hawaii Corporation).

DATED: February 22, 2006

HANSON BRIDGETT MARCUS
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By: G. Weng

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California Corporation