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

Proceeding	91177301
Party	Plaintiff Cake Divas
Correspondence Address	Ben T. Lila, Esq. Mandour & Associates, APC 16870 W. Bernardo Drive, Suite 400 San Diego, CA 92127 UNITED STATES blila@mandourlaw.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Ben T. Lila
Filer's e-mail	blila@mandourlaw.com,jmandour@mandourlaw.com,kbruce@mandourlaw.com
Signature	/Ben T. Lila/
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I. SUMMARY OF THE ARGUMENT

Opposer Cake Divas, a California general partnership, is the prior user of the trademark CAKE DIVAS, which has been used continuously in commerce in conjunction with services relating to custom cake making since October 15, 1998.

Applicant Charmaine Jones (“Jones”) seeks to register the nearly identical trademark CAKEDIVA for goods also relating to cake making in Trademark Application Serial No. 76/529,077. However, Jones has not produced any evidence showing use of her trademark on all of the goods listed in the Application at issue. Moreover, despite alleging a date of first use in commerce of June 15, 1993, Applicant has not produced any evidence of use prior to Opposer’s date of first use in 1998. Opposer, in contrast, has produced extensive documentary evidence that establishes its prior use. Accordingly, Applicant’s Trademark Application Serial No. 76/529,077 should be refused registration based on: 1) a likelihood of confusion; and 2) fraud.

II. DESCRIPTION OF THE RECORD

A. Evidence Submitted By Opposer

Opposer has submitted a Notice of Reliance dated April 30, 2009 (“Opposer’s NOR”), which was made of record pursuant to Trademark Rule 2.122(e), containing Applicant’s Responses and Objections to Opposer’s Interrogatories (Exhibit 1) and Documents identified by Bates Numbers CD000121-122 (Exhibit 2).

Opposer has made the following testimony depositions of record pursuant to Trademark Rule 2.123, with exhibits thereto:

1. Leigh Grode, Principal of Cake Divas, taken on April 16, 2009, including Exhibits 1-9 (“Grode Testimony”).
2. Majbritt Almskou, witness, taken on May 1, 2009 (“Almskou Testimony”).

3. Lisa Feldman, witness, taken on May 1, 2009 (“Feldman Testimony”).
4. Joan Spitler, Manager of Cake Divas, taken on May 15, 2009, including Exhibit 1 (“Spitler Testimony”).

B. Evidence Submitted By Applicant

Applicant has submitted a Notice of Reliance dated October 2, 2009 (“Applicant’s NOR”), which was made of record pursuant to Trademark Rule 2.122(e), containing an article purportedly dated September 1, 1994.

Applicant has made the following testimony depositions of record pursuant to Trademark Rule 2.123, with exhibits thereto:

1. Ashbell McElveen, witness, taken on October 1, 2009, including Exhibit 1.

III. STATEMENT OF THE ISSUES

1. Whether Applicant made use of CAKEDIVA as a trademark prior to Opposer’s documented use of the CAKE DIVAS trademark in 1998.
2. Whether Applicant’s false allegation regarding use in commerce bars registration based on fraud.

IV. STATEMENT OF FACTS

In September 1998, Leigh Grode and Joan Spitler created a cake making business named Cake Divas. Cake Divas is the Opposer of record in the present proceeding. After searching for variations of the CAKE DIVAS trademark online and applying for a fictitious business name, Opposer published the name of their business “Cake Divas” in a Los Angeles County newspaper (Spitler Testimony, 13:5 – 14:25; Doc. No. CD 00059-00061). On October 15, 1998, Opposer used its CAKE DIVAS trademark in conjunction with its cake making service (Grode Testimony, 16:15-17:20, Exhibit 2). Also on that date, Opposer began distributing advertising

material bearing its CAKE DIVAS trademark (Grode Testimony, 29:8-31:3 Exhibit 6). In 2003, Opposer filed Trademark Application Serial No. 76/538,360 for its CAKE DIVAS trademark alleging a date of first use of October 15, 1998. Since its date of first use, Cake Divas' business has gained wide success and has appeared nationwide and internationally in print, film, and television.

Applicant Charmaine Jones is also in the business of making cakes. Applicant originally operated its business under the trademark ISN'T THAT SPECIAL OUTRAGEOUS CAKES (Opposer's NOR Exhibit 1, Doc. No. CD000010). In articles, Applicant is referred to only colloquially as a "cake diva." However, CAKEDIVA was not used in association with the actual sale of goods, nor was it used to designate the source of goods (Opposer's NOR, Exhibit 1). Subsequent to observing Opposer's use of its CAKE DIVAS trademark, on July 11, 2003 Applicant filed Trademark Application Serial No. 76/529,077 alleging a date of first use in commerce of June 15, 1993, over 11 years earlier than the filing date. Applicant's Trademark Application Serial No. 76/529,077 seeks registration in Class 016 for: "*Greeting cards featuring photographs of cakes and cookies*" and Class 030 for: "*Cakes, namely, wedding cakes, bridal shower cakes, party cakes, novelty cakes and cakes for all occasions; edible cake sculptures of all shapes and sizes made primarily of sugar; cookies of all shapes and sizes; edible sugar sculptures in the form of flowers, inanimate objects, human images; and edible decorations made of sugar for cakes and cookies.*" Applicant did not adopt the business name CAKEDIVA until June 2004 (Opposer's NOR, Exhibit 2, Doc. No. CD000121).

V. ARGUMENT

A. Applicant's CAKEDIVA Application Can Not Register, Because Applicant Did Not Acquire Any Trademark Rights to CAKEDIVA Prior to Opposer's Use Of CAKE DIVAS.

1. Opposer Has Priority in the CAKE DIVAS Trademark Based on Its Date of Use in Commerce on October 15, 1998.

The record is devoid of any evidence demonstrating that Applicant used the trademark CAKEDIVA prior to Opposer. Applicant has provided no evidence of a single document demonstrating the sale of goods under the CAKEDIVA trademark prior to 1998.

In stark contrast to Applicant, Opposer has well-established documentary evidence of its use of CAKE DIVAS since 1998 culminating in its current use of CAKE DIVAS on the television show “Ultimate Cake Off” on The Learning Channel. Applicant’s invoice dated October 15, 1998 (Grote Deposition, Exhibit 2) clearly evidences Opposer’s “use in commerce” of its CAKE DIVAS trademark. Additionally, Opposer has testified that the CAKE DIVAS trademark appeared in various advertising materials since October 15, 1998 (Grote Testimony, 29:13).

Opposer has been able to prove its use of the CAKE DIVAS trademark since 1998. Applicant, on the other hand, has provided no evidence in the record of use of the CAKEDIVA trademark prior to 1998. Opposer has therefore established priority in its trademark, and the Board should therefore refuse Applicant’s application.

2. Applicant’s Applied-For Trademark CAKEDIVA Is Likely to be Confused with Opposer’s CAKE DIVAS Trademark.

To prevail in an opposition proceeding, an opposer must establish priority of use of its trademark and a likelihood of confusion. *LifeZone Inc. v. Middleman Group, Inc.*, 87 U.S.P.Q.2d 1953 (T.T.A.B. 2008). The determination of whether a likelihood of confusion exists is made by evaluation and balancing of the pertinent factors outlined in the case: *In re E.I. du Pont de Nemours*, 476 F.2d 1357, 177 (C.C.P.A. 1973). Opposer’s CAKE DIVAS and Applicant’s CAKEDIVA trademarks are nearly identical in sight, sound, and connotation.

Additionally, both trademarks are used for goods and services related to cake making, and Opposer and Applicant advertize and market within identical channels of trade.

The fact that Applicant is seeking registration for goods and Opposer's application is for services, does not avoid a likelihood of confusion. It is well recognized that confusion is likely to occur from the use of the same or similar trademarks for goods on one hand, and for related services on the other. *See, e.g., Steelcase Inc. v. Steelcare Inc.*, 219 U.S.P.Q. 433 (T.T.A.B. 1983) (STEELCARE INC. for refinishing of furniture services held likely to be confused with STEELCASE for office furniture and accessories).

Based on all the *du Pont* factors, there is no genuine dispute that there is a likelihood of confusion between the trademarks at issue. Because Applicant's and Opposer's respective goods and services relate to cake making, consumers are likely to be confused as to the source of the goods or services.

B. Registration Should Be Refused, Because Applicant Falsely Represented It Has Used The Trademark CAKEDIVA On All of the Goods listed in Application Serial No. 76/529,077.

To establish trademark rights for goods, Applicant is required to demonstrate "use in commerce." 15 U.S.C. § 1051. Under 15 U.S.C. § 1157, a trademark must be affixed on goods or if impractical use must be on documents associated with the sale of goods. A fraudulent statement regarding use of a trademark constitutes grounds for cancelation. *See generally, Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003).

In the present case, Applicant has provided no evidence showing that it used the CAKEDIVA trademark on "...*edible cake sculptures of all shapes and sizes made primarily of sugar; cookies of all shapes and sizes; edible sugar sculptures in the form of flowers, inanimate objects, human images; and edible decorations made of sugar for cakes and cookies*" in Class

030. Because of Applicant's complete lack of evidence to support that it used the CAKEDIVA trademark affixed on all of the goods as alleged in Application Serial No. 76/529,077, the Board should also deny registration on the basis of fraud.

VI. CONCLUSION

The central issue of the present proceeding is the lack of evidence of Applicant's alleged use. Applicant has offered no documentary evidence supporting her claim that she used the CAKEDIVA trademark prior to Opposer's use in 1998. Similarly, the record is devoid of any evidence demonstrating that Applicant used the CAKEDIVA trademark for all of the goods listed in Trademark Application Serial No. 76/529,077. In fact, Applicant only sought registration of the CAKEDIVA trademark in 2003 *after* she became aware of Opposer's ongoing use of CAKE DIVAS.

Accordingly and for the foregoing reasons, Opposer Cake Divas respectfully requests that the Board deny registration of Application Serial No. 76/529,077.

Respectfully Submitted,

Date: January 15, 2010

By: _____ s/ Ben T. Lila
Ben T. Lila
blila@mandourlaw.com
Mandour & Associates, APC
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing “OPPOSER’S BRIEF ON THE MERITS” has been served via first-class mail, postage pre-paid, upon the attorneys for Applicant at the following address:

Karin Segall
Foley & Lardner LLP
90 Park Avenue
New York, NY 10016

Dated: January 15, 2010

s/ Ben T. Lila
Ben Lila