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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
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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 Serial No. 76/529,077
Published in the *Official Gazette* (Trademarks) on August 7, 2007

CAKE DIVAS,)
)
 Opposer,)
)
 vs.) Opposition No. 91177301
)
CHARMAINE V. JONES,)
)
 Applicant.)
_____)

OPPOSER'S REPLY BRIEF ON THE MERITS

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I. INTRODUCTION

The present Opposition turns entirely on Applicant's inability to provide competent evidence of trademark use. Applicant generally concedes that only technical trademark use and not analogous use can be a basis for its application to register. It has been established in the proceeding that Applicant has none of the typical types of evidence to show trademark use on goods, *e.g.* documentation, packaging, tags, labels, and displays. Further, Applicant has failed to personally testify as to the existence of any such evidence. Instead, Applicant improperly attempts to substitute incidental use of the term "cake diva" as trademark use. Because this use falls well short of established trademark use, the Board should deny Application 76/529,077.

II. ARGUMENT

A. Applicant Has Not Demonstrated Any Trademark Use Prior to Opposer's Use of CAKE DIVAS.

It is settled law that trademark use requires, at a minimum, the trademark be displayed on documents associated with the goods or their sale. 15 U.S.C. § 1127. In the present case, no such "documents" have been entered into the record. Further, Applicant has not even personally testified to their existence. Instead of producing documents, Applicant's relies entirely on the Testimony of Ashbell J. McElveen that claims that he had seen "cake diva" in generally two places: 1) on the website foodstop.com and 2) on a business card. However, the website printout offered by Applicant does not display "cake diva" in association with goods for sale. The business card referred to by Mr. McElveen has also not been produced. There is no other supporting evidence of their existence. At best, Mr. McElveen's testimony about the existence of such documents constitutes hearsay and violates the best evidence rule, and Opposer objects to such testimony. Federal Rules of Evidence ("FRE") §§ 802 & 1002. The Board should

therefore not consider any testimony with respect to the unsupported claim that “cake diva” was displayed with the sale of Applicant’s products.

The remainder of Applicant’s claims of use relate to Applicant’s various media appearances, none of which give rise to trademark use. The media appearances generally demonstrate that Applicant colloquially had been referred to as a “cake diva.” The appearances, however, have nothing to do with displaying a trademark in association with the sale of goods as required by 15 U.S.C. § 1127.

Applicant is unable to produce one document displaying the trademark in association with the sale of goods before October 1998. Furthermore, the only evidence remotely relating to such documents fails to rise to the level of competent evidence. Because Applicant cannot show trademark use 15 U.S.C. § 1127, the application should be denied.

B. Applicant’s Claim of Analogous Use is Irrelevant and Inapplicable to the Present Opposition.

Applicant concedes that technical trademark use is a requisite for federal registration in their reliance on the holding *Asplunndh Tree Expert Co. v. Defibrator Fiberboard Aktiebolag*, 208 U.S.P.Q. 954, 958 (TTAB 1980). Applicant, however, improperly relies on *Asplunndh*, as a basis for equating “analogous use” and establishing trademark rights.

Analogous use applies only to situations in which a party that is citing analogous use is attempting to prevent registration by another party. Indeed authorities are in agreement that non-technical trademark use, such as analogous use, is not a basis for determining registration, but for preventing registration only:

Prior use of a term in advertising, as a tradename, as a style or model designation, or in a purely descriptive sense may be sufficient to prevent a later user from obtaining federal registration of that term. ... This kind of priority, however, is purely defensive.

McCarthy on Trademarks and Unfair Competition, Fourth Edition § 16.22 (October 2009).

Thus, analogous use is only relevant if an opposer is attempting to establish that the opposer's analogous use should prevent an applicant's federal registration. Put simply, citing analogous use can only be used as a basis for preventing another party's registration.

Applicant is attempting an "end run" around technical trademark use by substituting "analogous use" to support its application. Such a basis runs completely counter to well-settled law that only technical trademark use will entitle a party to federal registration. Because Applicant's reliance on analogous use cannot and does not establish a basis for registration, the Board should deny Applicant's application.

C. Opposer Has Properly Pleaded and Demonstrated Applicant's Lack of Use in Interstate Commerce.

Opposer's Notice of Opposition cites two independent grounds of Opposition: 1) Priority and likelihood of confusion under Trademark Act section 2(d) and 2) Lack of use by Applicant in interstate commerce prior to Opposer's interstate commerce use. As established above, Applicant cannot establish trademark use until after opposer. It is further established that Applicant only sought registration of the *CAKEDIVA* trademark in 2003 *after* she became aware of Opposer's ongoing use of *CAKE DIVAS*.

While not technically denominated as "fraud" in the Notice of Opposition, Opposer has pleaded a claim of lack of use by Applicant. At a minimum, Applicant's false statement regarding its date of first use amounts to inequitable conduct. Because Applicant lacks evidence to support its alleged date of first use of *CAKEDIVA* on all of the goods as alleged in Application Serial No. 76/529,077, the Board should also deny registration.

III. CONCLUSION

The central issue of the present proceeding is the lack of evidence of Applicant's alleged trademark 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. 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: March 4, 2010

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CERTIFICATE OF SERVICE

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

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Dated: March 4, 2010

s/ Ben T. Lila

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