

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: July 6, 2011

Opposition No. 91194188
Opposition No. 91195669
Opposition No. 91195985
Opposition No. 91195986
Opposition No. 91196035
Opposition No. 91196061
Opposition No. 91196087
Cancellation No. 92053109

Soft Serve, Inc. d/b/a
Sprinkles

v.

Sprinkles Cupcakes, Inc.

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of plaintiff's motion to compel (filed December 13, 2010) in Opposition No. 91194188. The motion has been fully briefed.¹

As an initial matter, the Board finds that plaintiff made a good faith effort to resolve the parties' discovery dispute, as required by Trademark Rule 2.120(e)(1), prior to

¹ The Board deferred consideration of the motion to compel pending defendant's response to the Board's March 4, 2011 order in which, among other things, the Board directed defendant to inform the Board of the status of a civil action styled *Ryan Mealey v. Sprinkles Cupcakes, Inc.*, Case No. 2:09-cv-04048-MAM, filed in the United States District Court for the Eastern District of Pennsylvania. In response thereto, defendant indicated that the civil action was terminated on May 6, 2010, after the plaintiffs in that civil action were, among other things, permanently enjoined on January 28, 2010 from using any trademark that includes the term SPRINKLES.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

seeking Board intervention. Nonetheless, the Board notes that many of the issues in the motion to compel could have been resolved without Board intervention if the parties had more carefully reviewed TBMP Section 414 (3d ed. 2011) regarding discoverability of various types of information in Board proceedings. The parties are reminded that the Board expects parties to cooperate in the discovery proceeding and looks with disfavor upon those who do not. Each party has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. See TBMP Section 408.01.

Through the motion to compel, plaintiff seeks further responses to its interrogatory nos. 4-5, 8 and 13 and document request nos. 1-5, 7-11, 14, 15, 18, 21, 22, and 25 and to require production of all documents withheld under a claim of privilege. As an initial matter, the Board notes that, in response to document request nos. 2, 3, 7-11, 14, 18, 21, and 25, defendant states that, subject to objections, it will produce responsive non-privileged documents that can be located after a "reasonable search." Defendant is reminded that it is under "a duty to *thoroughly* search its records for all information properly sought in

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

the request, and to provide such information to" plaintiff.

TBMP Section 408.02 (emphasis added).

In interrogatory no. 4, plaintiff asks defendant to identify each of the goods and services on which defendant's SPRINKLES and SPRINKLES OF PALM BEACH marks are used and to provide "annual revenues in dollars" for each good and service.² Regarding the SPRINKLES OF PALM BEACH marks, plaintiff has not sought to cancel defendant's Registration Nos. 2938800 and 3004757 for those marks. However, defendant has rendered those marks relevant to these consolidated proceedings by indicating that it intends to rely upon those registrations to establish "superior rights to the SPRINKLES mark and variations thereof." Answer, Opposition No. 91194188, paragraph 16. Defendant's response that it has no plans to use the SPRINKLES OF PALM BEACH marks is acceptable. Moreover, defendant's identification of goods and services on which it uses or intends to use the SPRINKLES mark is acceptable.

Nonetheless, defendant's assertion in its brief in response that it need not provide sales figures on the ground of irrelevance is incorrect. Annual sales figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are discoverable and

² The Board presumes that plaintiff seeks annual sales figures in dollars.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

may be disclosed under protective order.³ See *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147, 149 (TTAB 1985); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975); TBMP Section 414(18). Moreover, defendant will not be heard to object to providing annual sales figures because it requested such figures in its own discovery requests. See TBMP Section 402.01. Defendant is directed to serve a supplemental response to this interrogatory in which it provides annual sales figures in round numbers for the goods and services identified in defendant's involved application and registration for the mark SPRINKLES in standard character form, i.e., application Serial No. 77770541, the involved application in Opposition No. 91194188, for "ice cream; frozen yogurt; candy; sweets; cupcake mixes; ice cream sundaes, sherbets, ices, sorbets, [and] milk shakes"⁴ and Registration No. 3306772, for "bakery goods" and "retail shops featuring baked goods." Further, defendant is directed to provide annual sales figures in round numbers for the goods and services identified in those registrations, i.e., "ice cream" sold under the mark SPRINKLES OF PALM BEACH and "retail store

³ The parties have filed a stipulated protective order herein.

⁴ The Board notes that application Serial No. 77770541 was filed based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

services featuring ice cream" sold under the registered SPRINKLES OF PALM BEACH and design mark.

In document request no. 25, plaintiff seeks documents sufficient to show continuity of usage of the SPRINKLES OF PALM BEACH marks. Because the Board has already required defendant to provide annual sales figures regarding those marks, the Board finds that the documents sought through this request are unreasonably duplicative of information provided in response to interrogatory no. 4.⁵ See Fed. R. Civ. P. 26(b)(2)(C)(i); Trademark Act Section 45, 15 U.S.C. Section 1127; TBMP Section 402.02. Accordingly, defendant need not respond further thereto.

In interrogatory no. 5 and document request no. 18, plaintiff seeks information and documents regarding defendant's dealings with prior owners of the SPRINKLES OF PALM BEACH marks, including information regarding how defendant became aware of those marks. Defendant's response to interrogatory no. 5 that it was assigned the SPRINKLES OF PALM BEACH marks and now licenses those marks to its predecessor-in-interest to those marks and that it first learned of the SPRINKLES OF PALM BEACH marks by searching

1051(b). Accordingly, sales figures, if any, may be limited with regard to the goods identified in that application.

⁵ To the extent that plaintiff seeks to obtain any documents from third parties, such documents must be obtained via *subpoena duces tecum*. See Fed. R. Civ. P. 45(a)(1)(D).

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

USPTO's "trademark register" is incomplete because that response lacks information concerning when the assignment and search at issue took place. Documents reflecting the assignment of those registrations are more conveniently obtained from the records of the USPTO's Assignment Branch.⁶ See Fed. R. Civ. P. 26(b)(2)(C)(i); TBMP Section 402.02. However, any licensing agreements between defendant and the assignor of the SPRINKLES OF PALM BEACH marks are discoverable, as are any reports for searches of USPTO records in which the SPRINKLES OF PALM BEACH marks were discovered. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671 (TTAB 1988); *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 170 (TTAB 1980); TBMP Sections 414(6) and 414(10). On the other hand, comments or opinions of attorneys relating to such search reports are privileged. See *Amerace Corp. v. USM Corp.*, 183 USPQ 506, 507 (TTAB 1974); TBMP Section 414(6). Defendant is directed to supplement its response to interrogatory no. 5 in accordance with the foregoing. To the extent that defendant has not done so already, defendant is directed to produce documents responsive to request no. 18 in accordance with the foregoing.

⁶ The Board notes that plaintiff's attorney is based in the Washington, D.C. metropolitan area.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

In interrogatory no. 8 and document request no. 5, plaintiff seeks information and documents regarding opinions of counsel concerning defendant's right to use or register the SPRINKLES mark, including copies and summaries of any opinions rendered, and any search relating to that mark and SPRINKLES formative marks. Defendant's objections on the basis of attorney-client privilege are sustained. See *id.* Respondent's response to interrogatory no. 8 that is solicited and received such advice on or about July 13, 2005 and on or about February 19, 2009 is acceptable. Defendant need not respond further to document request no. 5.

In document request no. 9, plaintiff seeks all documents relating to searches conducted by respondent in connection with SPRINKLES and SPRINKLES formative marks. Any reports for searches of USPTO records in connection with those marks are discoverable. See *Fisons Ltd. v. Capability Brown Ltd.*, *supra*; TBMP Section 414(6). However, comments or opinions of attorneys relating to such search reports are privileged. See *Amerace Corp. v. USM Corp.*, *supra*; TBMP Section 414(6). To the extent that defendant has not done so already, defendant is directed to produce documents in accordance with the foregoing.

In interrogatory no. 13 and document request nos. 10 and 22, plaintiff seeks information and documents regarding controversies with, and challenges by, any third party

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

involving defendant with regard to the SPRINKLES and/or SPRINKLES OF PALM BEACH marks, including the identification of all documents referring or relating thereto. Information concerning litigation and controversies including settlement and other contractual agreements between a responding party and third parties based on the responding party's involved mark is discoverable. See *J.B. Williams Co. v. Pepsodent GmbH*, 188 USPQ 577, 580-81 (TTAB 1975); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 172 (TTAB 1975); TBMP Section 414(10). However, the only information which must be provided with respect to any legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision, if published. See *Johnson & Johnson v. Rexall Drug Co.*, *supra*; TBMP Section 414(10). Defendant's response, in which it lists names of parties against whom it has alleged trademark infringement and other claims, is incomplete. Defendant is directed to serve a supplemental response to this interrogatory in which it provides the names of the parties, the jurisdiction, the proceeding number, the outcome, and the citation of any published decision based on the SPRINKLES and mark and information concerning any settlement agreements arising from allegations of infringement of the SPRINKLES mark. To the extent that defendant has not done so already, defendant is

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

also directed to produce documents in response to these requests in accordance with the foregoing.

In document request no. 1, plaintiff seeks documents regarding the adoption and selection of the SPRINKLES mark. Basic information concerning the adoption of a mark, such as the identity of persons, dates and documents relating thereto, is discoverable. See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975); TBMP Section 414(4). However, writings relating to the selection of defendant's marks to show what third parties' marks may have been considered and the extent to which opposer believed its mark conflicted therewith are not discoverable. See *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 190 (TTAB 1974). In document request no. 4, plaintiff seeks documents related to market plans, forecasts and sales strategies regarding use of the SPRINKLES and SPRINKLES OF PALM BEACH marks. Such documents are discoverable under protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra* at 1675; TBMP Section 414(8). Defendant indicated in response to these requests that it does not possess, maintain custody or control any responsive documents. Defendant need not create such documents solely to satisfy plaintiff's discovery requests.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

See *Washington v. Garrett*, 10 F.3d 1421, 1437-38 (9th Cir. 1993). Accordingly, these responses are acceptable.⁷

In document request nos. 2 and 3, plaintiff seeks specimens of each use of the SPRINKLES mark and publicity materials used in connection with that mark. Defendant's objections that these document requests are unduly burdensome are sustained. See Fed. R. Civ. P. 26(b)(2)(C); TBMP Section 402.02. Defendant's production of representative samples thereof is acceptable.⁸

In document request no. 7, plaintiff seeks all assignments and agreements including licenses relating to the SPRINKLES OF PALM BEACH marks and all correspondence and documents between defendant and either the assignor of those marks or any third parties. To the extent that this request seeks discoverable information, it is essentially duplicative of interrogatory nos. 5 and 13 and document

⁷ Defendant is reminded, however, that a responding party which fails to provide information and documents that were properly sought in discovery may be precluded from relying as trial evidence on such information and documents, provided that the requesting party raises the matter by objecting to the evidence in question, unless the failure was substantially justified or is harmless. See Fed. R. Civ. P. 37(c)(1); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987). Defendant is also reminded that, when a party, without substantial justification, fails to amend or supplement a prior response, as required, that party may be prohibited from using as evidence the information not disclosed. See Fed. R. Civ. P. 26(e).

⁸ Plaintiff is reminded that these proceedings are concerned solely with the registrability of respondent's marks. See TBMP Section 102.01.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

request nos. 10 and 18. See Fed. R. Civ. P. 26(b)(2)(C).

To the extent that this request seeks documents protected by attorney-client and/or work product doctrine, defendant's objections on that basis are sustained. Nonetheless, to the extent that defendant has not done so already, defendant is directed to supplement its response to this request by producing copies of any licensing agreements with the assignor of the SPRINKLES OF PALM BEACH marks and any cease and desist letters that it has sent or received concerning those marks.

In document request no. 8, plaintiff seeks all documents relating to plaintiff, its goods and services and its marks or trade name. Defendant's objections that this request is overly broad and unduly burdensome are sustained. See Fed. R. Civ. P. 26(b)(2)(C)(i). Defendant need not respond further thereto.

In document request nos. 11 and 21, plaintiff seeks documents regarding defendant's first use of the SPRINKLES and SPRINKLES OF PALM BEACH marks.⁹ Information concerning defendant's first use of its marks at issue (e.g., when it first sold goods under each mark, when it opened its first retail store under each mark, etc.) is discoverable. See

⁹ Contrary to defendant's response to interrogatory no. 11, dates of use set forth in an "[a]llegation of [u]se" do not constitute evidence of use. Rather, use must be established by competent evidence. See Trademark Rule 2.122(b)(2).

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193, 195-96 (TTAB 1976); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 USPQ 495, 496 (TTAB 1975); TBMP Section 414(5). Accordingly, defendant's objections are overruled. To the extent that defendant has not done so already, defendant is directed to produce responsive documents in accordance with the foregoing.

In document request no. 14, plaintiff seeks documents regarding defendant's intent to use the SPRINKLES mark in commerce in connection with the goods identified in application Serial No. 77770541, i.e., "ice cream; frozen yogurt; candy; sweets; cupcake mixes; ice cream sundaes, sherbets, ices, sorbets, [and] milk shakes." Such documents are discoverable under protective order. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, *supra*. Further, such documents may provide a basis for an additional claim that defendant did not have a bona fide intent to use the SPRINKLES mark on those goods when it filed that application. See Fed. R. Civ. P. 26(b)(1); *J. B. Williams Co. v. Pepsodent GmbH.*, 188 USPQ 577, 579 (TTAB 1975); TBMP Section 402.01. Accordingly, defendant's objections are overruled. To the extent defendant has not done so already, defendant is directed to produce documents in accordance with the foregoing.

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

In document request no. 15, plaintiff seeks documents regarding circumstances under which defendant first became aware of plaintiff's use of the SPRINKLES mark. Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. See *American Optical Corp. v. Exomet, Inc.*, 181 USPQ 120, 123 (TTAB 1974); TBMP Section 414(19). Defendant's objection that such documents are protected by attorney-client privilege and/or work product doctrine is overruled. Defendant is directed to produce documents in accordance with the foregoing.

Regarding alleged deficiencies in defendant's privilege log, Federal Rule of Civil Procedure 26(b)(5) states as follows:

When a party withholds information otherwise discoverable by claiming that the information is privileged ..., the party must:

- (i) expressly make the claim; and
- (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed – and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.

The Board agrees with plaintiff that the entry in defendant's privilege log in which it asserts that all

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

opinions of outside counsel regarding defendant's right to use and register the mark SPRINKLES between the years 2005 and 2010 are protected by attorney-client privilege is insufficient because it does not enable other parties to assess the propriety of the claim of privilege with regard to each communication. Nonetheless, the Board agrees with defendant that requiring defendant to produce all documents withheld under claim of privilege is unwarranted. See *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044 (TTAB 2008). Defendant is directed to serve an amended privilege log that provides specific information regarding each document between 2005 and 2010 that is being withheld under claim of privilege. The amended privilege log should also include any documents that were produced with portions redacted under claim of privilege.

Based on the foregoing, the motion to compel is granted in part and denied in part. Defendant is allowed until thirty days from the mailing date set forth in this order to serve supplemental responses to interrogatory nos. 4, 5, and 13 and a revised privilege log. To the extent that defendant has not done so already, defendant is allowed until thirty days from the mailing date set forth in this order to select, designate and identify the items and documents, or categories of items and documents, as supplemental production in response to document requests

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

nos. 7, 9-11, 14, 15, 18, 21, and 22 and to notify plaintiff that the selection, designation and identification of such items and documents has been completed.¹⁰ Plaintiff is allowed until thirty days from receipt of notification from defendant that the items or documents have been selected, designated and identified to inspect and copy the produced materials, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree.¹¹

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any pending discovery requests in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109. The discovery period in Opposition No. 91194188 remains closed. Dates in these consolidated proceedings are reset as follows.

Expert Disclosures Due in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109	9/7/11
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Discovery Closes in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation	10/7/11
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¹⁰ If the materials are voluminous, defendant may produce a representative sampling and so inform plaintiff that a representative sampling has been produced.

¹¹ If defendant fails to comply with this order, plaintiff's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1).

Opposition Nos. 91194188, 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087; Cancellation No. 92053109

No. 92053109

Plaintiff's Pretrial Disclosures Due in All Proceedings	11/21/11
Plaintiff's 30-day Trial Period Ends in All Proceedings	1/5/12
Defendant's Pretrial Disclosures Due in All Proceedings	1/20/12
Defendant's 30-day Trial Period Ends in All Proceedings	3/5/12
Plaintiff's Rebuttal Disclosures Due in All Proceedings	3/20/12
Plaintiff's 15-day Rebuttal Period Ends in All Proceedings	4/19/12

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.