

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Opposition No. **91194188**  
Opposition No. 91195669  
Opposition No. 91195985  
Opposition No. 91195986  
Opposition No. 91196035  
Opposition No. 91196087  
Cancellation No. 92053109

Soft Serve, Inc. d/b/a  
Sprinkles

v.

Sprinkles Cupcakes, Inc.

**Andrew P. Baxley, Interlocutory Attorney:**

In Cancellation No. 92053109, plaintiff seeks to cancel defendant's Registration No. 3306772 for the mark SPRINKLES in standard character form for "bakery goods" in International Class 30 and "retail shops featuring baked goods" in International Class 35<sup>1</sup> on the ground of priority/likelihood of confusion with its previously used trade name and mark SPRINKLES for "baked goods and retail stores selling same."<sup>2</sup> Defendant, in its answer, denied the

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<sup>1</sup> Such registration was issued on October 9, 2007, based on a use-based application that defendant filed on March 3, 2006. In that registration, defendant alleges February 1, 2004 as the date of first use and date of first use in commerce in International Class 30 and April 13, 2005 as the date of first use and date of first use in commerce in International Class 35.

<sup>2</sup> Although not stated in the petition to cancel, the priority/likelihood of confusion claim is pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

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salient allegations of the petition to cancel and asserted affirmative defenses.

On August 11, 2011, plaintiff filed a motion for summary judgment in Cancellation No. 92053109.<sup>3</sup> See Trademark Rule 2.119(c). On September 15, 2011, defendant timely filed a motion for leave to take discovery under Fed. R. Civ. P. 56(d) prior to filing a brief in response to the motion for summary judgment. See Trademark Rules 2.119(c) and 2.127(e)(1). The motion for leave to take Rule 56(d) discovery has been fully briefed.

Through the motion for Rule 56(d) discovery, defendant seeks leave of the Board to: (1) take discovery depositions that it noticed prior to the filing of the motion for summary judgment;<sup>4</sup> (2) receive the documents responsive to

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In the petition to cancel, plaintiff also alleges that that, in view of the similarity of the parties' marks and "the related nature of the uses therefor, [defendant]'s mark may disparage and falsely suggest a connection with" plaintiff. Claims of disparagement and false suggestion of a connection are raised under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a). However, the false suggestion and disparagement grounds that plaintiff is alleging are merely alternative means of alleging the parties' marks are confusingly similar. See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711 (TTAB 1993). Accordingly, the Board will treat the allegations of disparagement and false suggestion as part of plaintiff's Section 2(d) claim and not as separate Section 2(a) claims.

<sup>3</sup> The motion for summary judgment was filed five weeks after the Board issued its July 6, 2011 order granting in part plaintiff's motion to compel discovery and with eight weeks remaining in the discovery period in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109.

<sup>4</sup> Those noticed deponents are identified as plaintiff (under Rule 30(b)(6)), plaintiff's principal Tom Orban, and plaintiff's former employees Aaron Yoches and Sara Haider.

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defendant's second set of document requests in accordance with the responses to document requests that defendant served on August 26, 2011; (3) take discovery depositions of declarants in support of the motion for summary judgment; and (4) take discovery regarding plaintiff's adoption and use of the pleaded SPRINKLES trade name and mark. In particular, defendant seeks to take discovery regarding (1) plaintiff's assertion of priority; (2) plaintiff's alleged likelihood of confusion between the marks at issue; and (3) defendant's pleaded affirmative defenses of laches, waiver, acquiescence, and estoppel.

As an initial matter, defendant's affirmative defenses of laches, waiver, acquiescence, and estoppel are insufficient because they set forth no factual basis therefor. Mere conclusory allegations of equitable defenses, such as defendant's, are insufficient because they do not give fair notice as to the basis for asserting those defenses. See *Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992); *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ2d 1219 (N.D. Ill. 1997); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987); Wright & Miller, *Federal Practice and Procedure: Civil 2d*, Section 1274 (1990 & Supp. 2001). Accordingly, the Board *sua sponte*

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strikes defendant's affirmative defenses of laches, waiver, acquiescence and estoppel. See Fed. R. Civ. P. 12(f); TBMP Section 506.01 (3d ed. 2011).

Turning to the Rule 56(d) motion, a party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. See Fed. R. Civ. P. 56(d); TBMP Section 528.06. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion. In such affidavit, the party must state therein the reasons why it is unable, without discovery, to present by affidavit facts sufficient to show the existence of a genuine issue of material fact for trial. See TBMP Section 528.06.

The Board has stricken defendant's affirmative defenses of laches, waiver, acquiescence and estoppel *supra*. Accordingly, defendant's motion for Rule 56(d) discovery is moot to the extent that defendant seeks discovery in connection with its affirmative defenses.

Defendant's Rule 56(d) motion improperly includes extensive arguments and evidence that responds on the merits to the motion for summary judgment. A party should not respond on the merits to a motion for summary judgment in a

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motion for Rule 56(d) discovery. See *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009 (TTAB 2002); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1253 (TTAB 1995).

In addition, contrary to defendant's assertion, defendant is not entitled to outstanding discovery requests that it requested prior to the filing of the motion for summary judgment and is not entitled to take discovery depositions that it noticed prior to such filing. Rather, the August 26, 2011 order in which the Board suspended proceedings pending the Board's decision on the motion for summary judgment tolled general discovery herein. Compare Trademark Rules 2.120(e)(2) and 2.127(d); TBMP Sections 523.01 and 528.03. See also *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002). Rule 56(d) discovery is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment, even where the nonmoving party had, at the time when the summary judgment motion was filed, outstanding and unanswered requests for broader discovery. See TBMP Section 528.06. Based on the foregoing, the motion for Rule 56(d) discovery is denied with regard to discovery depositions that defendant noticed but did not take prior to the filing of plaintiff's motion for summary judgment and defendant's

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second set of document requests. Nonetheless, the timing of the filing of plaintiff's motion for summary judgment, i.e., with eight weeks remaining in the discovery period and after defendant had noticed several discovery depositions, indicates that plaintiff used the motion for summary judgment as a means of cutting off general discovery well in advance of the October 7, 2011 close of discovery as last reset in the Board's July 6, 2011 order.

After reviewing the parties' arguments and exhibits, the Board finds that defendant has established its need for discovery regarding plaintiff's adoption and alleged prior analogous use and actual use of its pleaded SPRINKLES trade name and mark, the nature of plaintiff's pleaded baked goods sold and retail shop services rendered under the pleaded trade name and mark, and incidents of actual confusion between plaintiff's pleaded trade name and mark and defendant's involved mark prior to responding to the motion for summary judgment.<sup>5</sup>

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<sup>5</sup> Defendant asserts in its answer that it has "superior rights" in the SPRINKLES mark and variations thereof based on its ownership of Registration Nos. 2938800 and 3004757. While a plaintiff may rely upon any confusingly similar mark which it has either registered or any confusingly similar mark or trade name which it has previously used, a defendant can rely upon only its rights in its subject mark, except in very limited situations. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

One such situation involves a defendant's claim that, because the defendant already owns a substantially similar registered mark for substantially similar goods and/or services, a second registration (or second registration sought) will cause no added

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injury to the plaintiff. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969) ("a *Morehouse* defense"). Another such situation involves a defendant's attempt to defeat a plaintiff's priority of use claim by virtue of the defendant's earlier use of a mark which is the legal equivalent of defendant's involved mark for substantially identical goods or services through "tacking." See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991), *aff'g* 18 USPQ2d 1804 (TTAB 1990); *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). Defendant does not clearly indicate in its answer whether it intends to rely upon a *Morehouse* defense or tacking in defense of the petition to cancel.

Plaintiff, in its motion for summary judgment, relies on the filing dates of food service facility/eating and drinking establishment permit application in Montgomery County, Maryland and trade name application in the State of Maryland and the invoice date for store signage in support of its motion. Such dates appears intended to establish use analogous to trademark or service mark use in support of its assertion of priority herein. A party can establish analogous use only where that analogous use is of such a nature and extent as to create public identification of the target term with the party's product or service. See e.g., *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1578, 19 USPQ2d 1424, 1429 (Fed. Cir. 1991). Examples of analogous use are advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications that predate actual use of a mark in commerce. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). See also Trademark Act Section 45, 15 U.S.C. Section 1127.

In determining likelihood of confusion, two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000 (TTAB 2006). The Board notes that, in Cancellation No. 92053109, plaintiff's common law trade name and word mark is SPRINKLES, while defendant's involved mark is SPRINKLES in standard character form. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253 (Fed. Cir. 2011) (a word mark in standard character form encompasses any form of that mark).

Regarding the goods and services at issue, defendant attempts, in support of its Rule 56(d) motion, to limit the scope of the goods and services recited in its involved registration based on the price of goods sold through its retail shops. However, the identification of goods and services in defendant's involved registration, i.e., "bakery goods" and "retail shops featuring baked goods," is not limited as to trade channels or purchasers. Therefore, the Board must presume that defendant's identified goods and services consist of all goods and services of the type and that those goods and services are marketed in all normal

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and likelihood of confusion herein.

In view thereof, defendant's motion for Rule 56(d) discovery is granted, but only to the extent that defendant is allowed until sixty days from the mailing date set forth in this order to take depositions of: (1) Thomas Orban regarding on the issues of plaintiff's adoption and alleged prior analogous use and actual use of its pleaded SPRINKLES trade name and mark, the nature of plaintiff's pleaded baked goods sold and retail shop services rendered under the pleaded trade name and mark, and incidents of actual confusion between plaintiff's pleaded trade name and mark and defendant's involved mark; and (2) Benson Panga, Glyeb Koumasinski, Juliet Hope, and Julianna Kariman regarding instances of actual confusion between plaintiff's pleaded trade name and mark and defendant's involved mark. Defendant may include document requests in its notice of deposition of Mr. Orban. See TBMP Section 406.01.

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trade channels for such goods and services and to all normal classes of purchasers for such goods and services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). In view of the foregoing, likelihood of confusion will be determined based on the identified goods and services in defendant's involved registration and what the evidence of record shows plaintiff's pleaded "baked goods and retail stores selling same" to be. See *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283 (TTAB 2007); *Fram Trak Industries Inc. v. WireTracks LLC*, *supra*. The Board notes that, in support of the motion for summary judgment, plaintiff has submitted evidence of sales of bakery goods under the SPRINKLES mark through its retail store. See, e.g., declaration of Thomas Orban.

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Defendant is allowed until ninety days from the mailing date set forth in this order to file a brief in response to the motion for summary judgment. Plaintiff's reply brief is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1).

Because the Board has reset remaining briefing in connection with the motion for summary judgment, the Board will not consider any arguments or evidence that the parties submitted in the briefing of the Rule 56(d) motion in deciding the motion for summary judgment. See Trademark Rule 2.127(e)(1). The motion for summary judgment will be decided based only on the briefing of that motion and exhibits submitted therewith.

Proceedings herein otherwise remain suspended.