

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

Soft Serve, Inc. d/b/a Sprinkles,)	Opposition No. 91194188
)	Opposition No. 91195669
)	Opposition No. 91195985
vs.)	Opposition No. 91195986
)	Opposition No. 91196035
)	Opposition No. 91196061
Sprinkles Cupcakes, Inc.)	Opposition No. 91196087
)	Cancellation No. 92053109
)	
Registrant.)	

PLAINTIFF'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGEMENT

I. INTRODUCTION

Plaintiff has established its use of SPRINKLES in connection with baked goods and related retail services prior to the 2004 and 2005 dates recited in the '772 registration. As the legally inadequate SPRINKLES OF PALM BEACH "superior rights" defense urged by Defendant in its Response is unavailing, no genuine issue of material fact exists with respect to Plaintiff's priority. Summary judgment should be entered in Plaintiff's favor.¹

II. NO GENUINE ISSUE OF MATERIAL FACT EXISTS WITH RESPECT TO PRIORITY

A. DEFENDANT HAS FAILED TO ESTABLISH DATES WHICH EVIDENCE A GENUINE ISSUE OF MATERIAL FACT AS TO PRIORITY

Defendant now suggests that the 2009 acquisition of two "SPRINKLES-related marks" (Defendant's characterization; Def. Br. p. 7; Nelson Dec. ¶ 40), specifically SPRINKLES OF PALM BEACH registrations, provide it with rights to SPRINKLES.² However, neither tacking of the asserted

¹ Plaintiff admits to having been stung by the Board's adoption of the accusation that the filing of this Motion was timed so as cut off Defendant's discovery. Plaintiff reasonably elected to defer the filing of its Motion until it received documents ordered to be produced in response to Plaintiff's Motion to Compel. Those documents were mailed to Plaintiff on August 5, 2011 and this Motion was filed on August 11. Defendant's subpoena to take Mr. Yoches' deposition was mailed by Defendant the same day. Ms. Haider's Notice was couriered by Defendant to England on August 10, 2011. Soft Serve's landlord was not subpoenaed until August 24, 2011. Defendant never took any steps to depose Plaintiff's sign manufacturer or any of Plaintiff's vendors. Plaintiff's filing was not timed so as to thwart Defendant's discovery.

² Defendant was warned by the Board that it had not adequately pled or articulated any available defense by merely broadly claiming "superior rights". Generously provided a second chance to correct its failing

SPRINKLES OF PALM BEACH registrations nor a *Morehouse* defense can save the '772 registration. As noted in the Board's March 13, 2012 decision, tacking is available only in the very limited situation where a party can satisfy the three following elements: (1) an earlier use of a mark which is the (2) "legal equivalent" of the challenged mark for (3) "substantially identical" goods or services. Defendant cannot satisfy any of these elements.

The ice cream goods and related services of the '800 registration for SPRINKLES OF PALM BEACH and the '757 registration for SPRINKLES PALM BEACH and Design do not meet the strict "legally equivalent" standard employed in tacking cases. Whether the goods and services of these registrations are related to the baked goods and related services of the '772 registration is not the issue in the context of tacking. The tacking standard is stricter than the likelihood of confusion standard. *Van Dyne – Crotty v. Wear-Guard*, 17 USPQ 2d 1866, 1868 (Fed. Cir. 1992); *American Paging v. American Mobilphone*, 13 USPQ 2d 2036, 2038 (TTAB 1989). The goods are simply not "legally equivalent". This fact alone renders tacking unavailable to Defendant.

Neither can Defendant prevail in claiming that SPRINKLES OF PALM BEACH, let alone SPRINKLES PALM BEACH with its distinctive design, are marks "substantially identical" to SPRINKLES. When the relied upon marks were refused registration on the basis of earlier registered SPRINKLES marks, it was insisted in connection with the design mark of the '757 registration that:

"While it is true that the Applicant's mark "SPRINKLES OF PALM BEACH" contains the term SPRINKLES, the term is stylized and the mark also contains a significant design feature of ice cream cones that emulate palm trees together with the term PALM BEACH. Thus, the Applicant's mark is not identical to the cited mark nor is the Applicant's entire mark incorporated within the referenced mark."

"Applicant submits that the design features of Applicant's mark are significant and will not create the same commercial impression as the registrant's simple word mark SPRINKLES. The Applicant's mark contains the term SPRINKLES in a unique, stylized font with two ice cream cones emulating palm trees prominently displayed underneath the term and forming the center of the mark with the words PALM BEACH below the design. Consequently, the portion of the mark likely to be impressed upon a

to articulate either tacking or *Morehouse* defenses Defendant has done neither. In fact, Defendant repeats its inadequate "superior rights" assertion. ("Sprinkles has asserted a defense that it enjoys superior trademark rights".) (Def. Br. p. 1-2). Having twice failed to provide the specificity of it required in order to maintain either a tacking defense or a *Morehouse* defense, Defendant's "superior rights" pleading and "defense" should now be stricken.

purchaser's memory is the distinctive ice cream cone design. This design when combined with the words PALM BEACH creates a completely distinct and unique commercial impression. Thus, when the design element and the word PALM BEACH are given fair and proper weight, confusion with the simple word mark "SPRINKLES" is eliminated."

"Moreover, although the additional term "Palm Beach" must be disclaimed, it cannot be completely ignored and does in fact play a significant role in eliminating potential confusion."

"Accordingly, Applicant believes that the marks create substantially different commercial impressions and that confusion is not likely." (Vande Sande Dec. Ex. 1, hereinafter referred to as VS Dec.).

In order to obtain registration of the word mark of the '800 registration it was insisted (VS Dec.

Ex. 2):

"While it is true that the Applicant's mark "SPRINKLES OF PALM BEACH" contains the term SPRINKLES, the mark also contains the additional term "PALM BEACH". Thus, the Applicant's mark is not identical to the cited mark nor is the Applicant's entire mark incorporated within the referenced mark."

"Consequently, Applicant's composite mark "SPRINKLES OF PALM BEACH" when viewed in its entirety is not confusingly similar to the simple word mark "SPRINKLES".³

Finally, Defendant's tacking defense must fail because even where the involved goods or services are "legally equivalent", and the marks are "substantially identical", the use relied upon must be earlier.

The use dates recited in the '800 and '757 registrations are October 2002, to be read as October 31, 2002.

That date is later than Plaintiff's.

As Defendant cannot prevail as to any, let alone all three tacking factors, it should be determined, in the context of this Motion and as a matter of law, that the goods recited in the "SPRINKLES-related" (as described by Defendant) registrations are not "substantially identical" to those recited in the '772 registration and that the marks of those registrations are not "legally equivalent" to the mark of the '772. Separately, the dates recited in the SPRINKLES OF PALM BEACH registrations (the last day of October 2002), evidence no genuine issue of material fact as to the "earlier use" element of a tacking defense.

³ Plaintiff does not assert that these statements create an estoppel. They should, however, be seen as admissions against interest. *Textron, Inc. v. Gillette Co.*, 180 USPQ 153 (TTAB 1973). Moreover, they well articulate why the SPRINKLES OF PALM BEACH marks are distinct from SPRINKLES to the extent that they create no likelihood of confusion. As they create no likelihood of confusion, they also fall far short of being "substantially identical" to SPRINKLES for purposes of any alleged tacking.

Because neither tacking nor *Morehouse* defenses are available, the assignment of the SPRINKLES of PALM BEACH registrations cannot, contrary to Defendant's argument, provide earlier rights in the SPRINKLES mark. Consequently, Defendant's attempt to prove rights as of 2002, and 1985, as a result of its acquisition of the '800 and '757 registrations fails. Defendant is left with the 2004 and 2005 dates recited in the '772 registration.⁴

B. SUBSTANTIAL EVIDENCE ESTABLISHES PLAINTIFF'S PRIORITY

Plaintiff has met its burden of establishing use prior to the 2004 and 2005 dates recited in the '772 registration. However, as Defendant through its Response now attempts to go behind the dates recited in the '772 by urging the '800 and '757 registrations, it is proper for Plaintiff to include in its Reply arguments and exhibits rebutting Defendant's attempt. *Shalom Children's Wear v. In-Wear A/S*, 26 USPQ 2d 1516, 1517 (TTAB 1993). It is also appropriate for Plaintiff to include in its Reply argument and exhibits rebutting Defendant's attack on Mr. Orban's credibility, and its assertions that his Declaration averments and deposition testimony are uncorroborated. (Def. Br. p. 15).

1. MR. ORBAN'S AVERMENTS AND TESTIMONY ARE CREDIBLE AND CORROBORATED

Substantial evidence refutes the unwarranted attack on Mr. Orban's credibility.⁵ The conclusion is inescapable that from the outset of these proceedings Mr. Orban has committed himself to an ongoing and good faith search for evidence documenting Plaintiff's first use of SPRINKLES and corroborating the

⁴Defendant's characterization of "the first-use dates in the challenged registration" as being October 2002 (Def. Br. p. 7, fn 7) is incorrect. The first use dates of the '772 registration are February 1, 2004 as to goods and April 13, 2005 as to services.

⁵Defendant has on many occasions substantially mischaracterized Mr. Orban's testimony. Representative examples include the allegation that Mr. Orban stated that he was beta-testing the SPRINKLES mark during the summer of 2002. (Def. Br. p. 13); that Plaintiff did not commission the creation of a SPRINKLES sign until late 2002 (Def. Br. p. 5) and that usage of SPRINKLES commenced in November 2002. (Def. Br. p. 13). Even a cursory viewing of Slafsky Dec. Exs. 12, 22 and 23 reveals that none of these statements remotely reflect Mr. Orban's testimony. Misstatements and mischaracterizations neither create genuine issues of material fact nor undermine credibility.

summer of 2002 first use he recalls. Other dates earlier introduced by Plaintiff do not cast doubt on his credibility. His ongoing research and good faith supplementation of discovery responses should not be criticized.⁶

Subsequent to the initiation of these proceedings, and in an effort to corroborate the fact that usage of the SPRINKLES mark, and name, commenced in the summer of 2002, Mr. Orban sought out the two (not eight as alleged by Defendant) employees (Ms. Haider and Mr. Yoches) who were hired to work that summer.⁷ His approach was reasonable and honest. He sought out those employees who had been hired to work for just the summer of 2002 because “their window of memory was limited to that summer.” (VS Dec. Ex. 5).

The Haider and Yoches Declarations (VS Dec. Exs. 6, 7) have also been introduced and relied upon by Defendant. (Slafsky Dec. Exs. 21 and 29).⁸ The fact that Mr. Orban has not embraced Ms. Haider’s April 2002 remembrance as to use dates as his own and has instead repeatedly, throughout his seven hour deposition and consistent with his Declaration, attested to a later time, specifically the summer of 2002, further evidences his candor and good faith.

Defendant’s attempt to discredit Mr. Orban by highlighting efforts involved in attempts to avoid and resolve problems with his landlord (and with his former franchisor, ICBY, prior to Soft Serve’s

⁶ Typical of these efforts was Plaintiff’s August 2010 Answer to Int. No. 4 stating: “[s]ubject to supplementation as Opposer Sprinkles’ related research continues, Opposer Sprinkles responds as follows: As to all goods and services, with the exception of clothing goods, Opposer Sprinkles’ date of first use is a date in 2002 prior to November 21. Further specificity will be provided by supplementation upon the conclusion of Opposer Sprinkles’ investigation.” (VS Dec. Ex. 3).

⁷ These individuals were identified to Defendant as long ago as November 4, 2010. (VS Dec. Ex. 4). While Defendant complains that Plaintiff and the Board have precluded it from conducting important discovery, in fact, Defendant neglected to timely commence discovery. Moreover, time allegedly lost as a result of the first stay of these proceedings was the result of Defendant’s failures in responding to discovery. Most importantly, every bit of the discovery Defendant complains of not having, and all discovery it might have desired, could have been pursued at any time between November 2, 2011 and April 30, 2012 in connection with pending consolidated proceeding No. 92054376. In fact, Defendant chose to refrain from conducting any discovery in those cases. (VS Dec. ¶ 6).

⁸ These Declarations were not concealed as alleged by Defendant. The 2002 dates they establish were not in issue until Defendant’s Response brief attempted to move its dates to 2002 based upon the SPRINKLES OF PALM BEACH registrations.

having adopted SPRINKLES) should not serve as a distraction. The conclusion is unavoidable that Plaintiff's use of the SPRINKLES mark in a recurring, substantial and technical sense, in connection with its bakery and its ice cream goods and services, preceded any date available to Defendant.

2. SUBSTANTIAL EVIDENCE INDEPENDENTLY ESTABLISHES PLAINTIFF'S PRIORITY AND ALSO FURTHER CORROBORATES MR. ORBAN'S DECLARATION AVERMENTS AND DEPOSITION TESTIMONY

In evaluating priority "[o]ne should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use". *West Florida Seafood v. Jet Industries*, 31 USPQ 2d 1660, 1663 (Fed. Cir. 1994). Even regulatory documentation offered to corroborate first use allegations is to be considered. *West Florida @ 1664*.⁹

The evidence establishing Plaintiff's use of SPRINKLES as a mark and name prior to the dates recited in the '772 registration is substantial. When viewed in the aggregate it indisputably establishes prior, regular and recurring use of the SPRINKLES mark and name, including such use in connection with the offering and sale of baked goods.

Mr. Orban testified to the fact that Plaintiff's business phone was answered as "SPRINKLES" in 2002. (VS Dec. Ex. 8). SPRINKLES coupons were created and used by Mr. Orban in 2002 and were passed out to potential customers in the summer of 2002. (VS Dec. Ex. 9; VS Dec. Ex. 7 ¶ 3; VS Dec. Ex. 6 ¶ 4). Signage was created by Plaintiff in 2002 (VS Dec. Ex. 10), well prior to its obtaining and hanging a large exterior sign in October 2002 (VS Dec. Exs. 10, 11) which was later invoiced by its manufacturer on October 30, 2002 (VS Dec. Exs. 12, 13) and paid for by credit card in November 2002. (VS Dec. Ex. 14).¹⁰

⁹ References to various items such as cancelled checks (Ex. 20), the Sprinkles Trade Name application (Ex. 69), the Sprinkles Health Department submission (Ex. 74), a Sprinkles signage invoice (Ex. 71), and credit card company correspondence (Exs. 72, 73), corroborate Mr. Orban's recollection and knowledge with respect to first use of SPRINKLES prior to the dates recited in the '772 registration. (See pp. 3-4 of Plaintiff's opening brief referring to various exhibits as lending "further support" to, and "further corroboration" of, Mr. Orban's averments.

¹⁰ Mr. Orban fully and candidly explained that the October 18, 2002 letter written to his landlord in the context of seeking an early renewal of his lease was actually authored well subsequent to his adoption of SPRINKLES. It was intended to protect the investment already made in the mark and to aid Mr. Orban in

In addition, SPRINKLES stickers and labels were used in 2002 (VS Dec. Ex. 17; VS Dec. Ex. 6 ¶ 4). The SPRINKLES name was also used in the summer of 2002 in connection with community activities. (VS Dec. Ex. 7 ¶ 3; VS Dec. Ex. 6 ¶ 4) and receipts evidence the rendering of SPRINKLES catering services in 2004. (VS Dec. Ex. 18). In 2003, Plaintiff elected for the first the time to accept credit cards. (VS Dec. Ex. 19). In response, American Express sent a welcome letter to “SPRINKLES” in July 2003 (Ex. 72) and Discover sent a bill in October 2003. (Ex. 73). An August 2003 invoice from a vendor is addressed to “SPRINKLES” (VS Dec. Ex. 20) and an invoice generated in connection with the manufacture of a second professionally created sign referring to “SPRINKLES” is dated October 22, 2003. (Ex. 71). As noted below, even the January 2004 phone book listing offered by Defendant supports Plaintiff’s showing of priority over any dates available to Defendant.¹¹

The evidence establishes not only substantial and ongoing usage of SPRINKLES prior to Defendant’s available dates, but also prior substantial use of SPRINKLES in connection with baked goods and related services. Baked goods have been offered by SPRINKLES since the summer of 2002. (Orban Dec. ¶ 5; VS Dec. Ex. 7 ¶ 4; VS Dec. Ex. 6 ¶ 5, VS Dec. Ex.21). Money Mailer coupons evidence usage of SPRINKLES in connection with goods in 2003 and 2004, should the Board consider the landlord’s 2003 coupon referenced repeatedly by Defendant and offered herewith (as VS Dec. Ex. 22).¹² This evidence independently establishes baked goods use and also speaks to the credibility to be afforded the averments of Mr. Orban, Ms. Haider, and Mr. Yoches.

circumventing the landlord’s strict architectural approval requirements in advance of the imminent hanging of an exterior SPRINKLES sign. (VS Dec. Ex. 15). The hanging of that sign in fact occurred within just a few days of the October 18, 2002 letter to the landlord. (VS Dec. Ex. 16).

¹¹ The “timeline” (Def. Br. p. 8) offered by Defendant is flawed and must be disregarded. It excludes virtually all uses of SPRINKLES by Plaintiff and misstates others. For instance, it identifies February 1, 2004 as the date not only of Defendant’s first usage of SPRINKLES but also as the “first phone directory listing for Plaintiff”. (Slafsky Dec. Ex. No. 18). In reality, Defendant’s exhibit reveals the 2004 SPRINKLES phone book reference as January 2004, a month earlier than the first use claimed in the ‘772 registration.

¹² Outdated lease language, specifically historical references to I Can’t Believe It’s Yogurt, do not (1) constitute trade name usage of I Can’t Believe It’s Yogurt nor (2) create any issue of fact as to whether

“SPRINKLES” checks to Chantilly Donuts, in amounts of thousands of dollars (Ex.70) evidence the fact that the sales of baked goods even in 2003 were substantial. Mr. Orban’s uncontradicted averments that baked goods constitute a third of his business (Orban Dec. ¶ 6) and virtually all of his business throughout the morning hours, (VS Dec. Ex. 23) further evidence substantial and long usage of SPRINKLES in connection with baked goods.¹³ The same may be said with respect to the fact that baking ovens have been a part of SPRINKLES’ fixtures since it opened (VS Dec. Ex. 25) and that bakery goods have been baked on-site for at least a decade. (VS Dec. Ex. 26; Orban Dec. ¶ 2). The procurement, in 2002, of exterior signage promoting bagels (VS Dec. Ex. 27) is but one more factor establishing Plaintiff’s priority.

Viewed in its totality, as required, the evidence overwhelmingly and indisputably establishes Plaintiff’s substantial and ongoing use of SPRINKLES in connection with baked goods and related services as a mark, and as a name, prior to the dates available to Defendant.

III. NO GENUINE ISSUE OF MATERIAL FACT EXISTS AS TO LIKELIHOOD OF CONFUSION

A. THE PARTIES’ MARKS, GOODS, CHANNELS OF TRADE AND CONSUMER BASE ARE IDENTICAL

The ‘772 recites usage in connection with “bakery goods” and “retail shops featuring baked goods.” The Board’s March 13, 2012 Decision acknowledged the significance of the absence of any restrictions as to types of purchasers, prices of baked goods or channels of trade recited in the ‘772 recitation of goods and services. Nevertheless, Defendant continues to assert that factors nowhere referred to in that recitation allow it to escape the conclusion that the *DuPont* analysis strongly favors

during the relevant time frame (from 2002 up to and including the present) Plaintiff has been regularly, broadly and exclusively operating under the SPRINKLES mark and name in connection with a broad array of baked goods.

¹³ It is also beyond dispute that a wide variety of baked goods have been offered by Plaintiff since the opening of SPRINKLES. (Orban Dec. ¶ 5; VS Dec. Ex. 6 ¶ 5, VS Dec. Ex. 7 ¶ 4). The offering of baked goods has included muffins, pastries, brownies, cakes, cookies, croissants, bagels, donuts, pies, and, for the last several years, cupcakes. (Orban Dec. ¶ 2; VS Dec. Ex 24; Panga Dec. ¶ 3; Hope Dec. ¶ 2, Kariman Dec. ¶ 2).

Plaintiff. The parties' marks, goods, channels of trade, and customers are identical for the purposes of this proceeding.¹⁴

B. EVIDENCE OF ACTUAL CONFUSION AUGMENTS PLAINTIFF'S SHOWING OF A LIKELIHOOD OF CONFUSION

Evidence demonstrating instances of actual confusion remains uncontroverted. Defendant initially insisted that depositions of Plaintiff's employees who experienced instances of actual confusion would be essential to its successfully defending against summary judgment. Despite the Board's providing the opportunity to depose all four such employees, Defendant chose to depose none. It cannot controvert the actual confusion evidence established through the Declarations of Panga, Hope, Kariman and Koumasinski. While Defendant attempts to discredit customer inquiries, a variety of instances of actual confusion remain undisputed. Such include a local school newspaper writer's story relating to the supposed pending relocation of Plaintiff's shop to Georgetown (Orban Dec. ¶ 18), and advertisements mailed to Plaintiff offering business image pens featuring Defendant's mark and reciting Plaintiff's address and telephone number. (VS Dec. Ex. 28). Further examples include the statement of a customer relieved at not having to drive downtown for SPRINKLES cupcakes (Kariman Dec. ¶ 4), and a customer attempting to redeem a Sprinkles gift card issued by Defendant. (Koumasinski Dec. ¶ 6).¹⁵

Defendant's insistence that "most importantly" instances of actual confusion are unavailing if they do not result in lost sales (Def. Br. p. 24) reveals a lack of appreciation as to the essence of the harm

¹⁴ The Goodstein Declaration must be ignored. It constitutes but a second Response brief and while professing to be based in part upon relevant legal and marketing treatises, the advice it provides the Board in terms of how it should decide this case simply ignores the "bakery goods" and "retail shops featuring baked goods" recitations in the '772 registration in favor of a discussion of "equity positioning", "retail atmospherics" and store design aesthetics.

¹⁵ Defendant's hearsay objection is ill-founded to the extent that the various statements, such as the statement that a visitor is glad he needn't go to Georgetown for SPRINKLES cupcakes, are not offered to prove the truth of the matter asserted. Obviously, other instances, such as the attempt to redeem Defendant's gift card at SPRINKLES, the SPRINKLES pen offering to Plaintiff, and the contemplated newspaper article are similarly in no way hearsay.

inflicted through confusion, namely, the loss of the ability to control one's reputation. *Professional Golfer's Assn. v. Banker's Life & Cas.*, 514 F.2d 665, 670-671 (5th Cir. 1975). This damage was well captured by Mr. Orban: "I can't think of you know the economic damage, but I don't – I don't like, personally, if I understand the word "hurt," having customers come in confused about my identity that I have worked to build up over a dozen years, yes, that hurts me". (VS Dec. Ex. 29).

IV. CONCLUSION

Defendant has failed to establish any date of first use, either in the context of the challenged registration, or through tacking or *Morehouse* defenses as a result of the acquisition of what it terms the "SPRINKLES-related marks" of the SPRINKLES of PALM BEACH registrations. Priority clearly resides with Plaintiff as a result of its broad and regular use of the SPRINKLES mark and name in connection with baked goods and the retail sale of those goods. There exists no genuine issue of material fact as to the similarities of the marks, goods, services, channels of trade or consumers. Finally, while not necessary, the existence of actual confusion bolsters the conclusion that summary judgment in favor of Plaintiff is warranted.

Hall & Vande Sande, LLC

Date: 6/28/12



Thomas J. Vande Sande
Attorney for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
Phone: (301) 983-2500

CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer hereby certifies that one copy of the foregoing "PLAINTIFF'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGEMENT" and related Declaration and exhibits was this day served on Applicant by mailing same, first class mail, to:

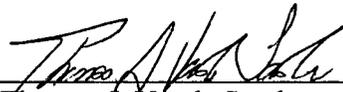
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&

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Date:

6/26/12



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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)	
Registrant.)	

DECLARATION OF THOMAS J. VANDE SANDE

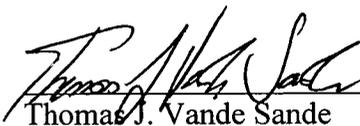
1. I am counsel for Petitioner Soft Serve, Inc. d/b/a Sprinkles in this matter. I have personal knowledge of the facts in this declaration, and, if called as a witness, I could competently testify to them.
2. Attached hereto as Exhibit 1 is a true and accurate copy of the Response Under 37 C.F.R. § 2.62 filed August 9, 2004 in connection with U.S. Trademark Reg. No. 3,004,757 for the mark SPRINKLES PALM BEACH and Design.
3. Attached hereto as Exhibit 2 is a true and accurate copy of the Response Under 37 C.F.R. § 2.62 filed November 5, 2003 in connection with U.S. Trademark Reg. No. 2,938,800 for the mark SPRINKLES OF PALM BEACH.
4. Attached hereto as Exhibit 3 is a true and accurate copy of Plaintiff's August 4, 2010 Answer to Interrogatory No. 4 of Applicant's First Set of Interrogatories.
5. Attached hereto as Exhibit 4 is a true and accurate copy of Opposer's Supplemental Disclosures dated November 4, 2010 which identifies Saira Haider and Aaron Yoches.
6. Defendant served no discovery in Consolidated Cancellation Proceeding No. 92054376.
7. Attached hereto as Exhibit 5 is a true and accurate copy of page 203 from the transcript of the May 10, 2012 deposition of Thomas John Orban in this proceeding ("Orban Deposition").
8. Attached hereto as Exhibit 6 is a true and accurate copy of the Declaration of Saira Haider executed on May 11, 2011.

Declaration

9. Attached hereto as Exhibit 7 is a true and accurate copy of the Declaration of Aaron Yoches executed on June 3, 2011.
10. Attached hereto as Exhibit 8 is a true and accurate copy of pages 183-184 from the transcript of the Orban Deposition.
11. Attached hereto as Exhibit 9 is a true and accurate copy of pages 182-183 from the transcript of the Orban Deposition.
12. Attached hereto as Exhibit 10 is a true and accurate copy of pages 54-55 from the transcript of the Orban Deposition.
13. Attached hereto as Exhibit 11 is a true and accurate copy of page 208 from the transcript of the Orban Deposition.
14. Attached hereto as Exhibit 12 is a true and accurate copy of page 145 from the transcript of the Orban Deposition.
15. Attached hereto as Exhibit 13 is a true and accurate copy of an October 30, 2002 invoice from the sign manufacturer Sterico.
16. Attached hereto as Exhibit 14 is a true and accurate copy of pages 196-198 and 180 from the transcript of the Orban Deposition.
17. Attached hereto as Exhibit 15 is a true and accurate copy of page 145 from the transcript of the Orban Deposition.
18. Attached hereto as Exhibit 16 is a true and accurate copy of page 196 from the transcript of the Orban Deposition.
19. Attached hereto as Exhibit 17 is a true and accurate copy of page 173 from the transcript of the Orban Deposition.
20. Attached hereto as Exhibit 18 are true and accurate copies of catering receipts from Riggs Bank dated March 19, 2004 and May 14, 2004.
21. Attached hereto as Exhibit 19 is a true and accurate copy of page 229 from the transcript of the Orban Deposition.

22. Attached hereto as Exhibit 20 is a true and accurate copy of the August 2003 Invoice from Kemp Foods, Inc., bearing Orban deposition exhibit No. 40.
23. Attached hereto as Exhibit 21 is a true and accurate copy of pages 315-316 from the transcript of the Orban Deposition.
24. Attached hereto as Exhibit 22 is a true and accurate copy of a 2003 Money Mailer coupon produced to Defendant on September 12, 2011 and bearing production number 5217.
25. Attached hereto as Exhibit 23 is a true and accurate copy of page 253 from the transcript of the Orban Deposition.
26. Attached hereto as Exhibit 24 is a true and accurate copy of pages 263, 297, 299 and 315-316 from the transcript of the Orban Deposition.
27. Attached hereto as Exhibit 25 is a true and accurate copy of page 264 from the transcript of the Orban Deposition.
28. Attached hereto as Exhibit 26 is a true and accurate copy of page 263 from the transcript of the Orban Deposition.
29. Attached hereto as Exhibit 27 is a true and accurate copy of pages 194-195 from the transcript of the Orban Deposition.
30. Attached hereto as Exhibit 28 is a true and accurate copy of a promotional pen sample and related correspondence sent to Plaintiff in 2011 depicting Defendant's mark and a photo of their cupcakes, bearing production numbers 5193-5195 and produced to Defendant on September 12, 2011.
31. Attached hereto as Exhibit 29 is a true and accurate copy of page 281 from the transcript of the Orban Deposition.

I declare under penalty of perjury that the foregoing is true and accurate. Executed at Potomac, Maryland on June 26, 2012.

By: 
Thomas J. Vande Sande

VS DEC. EX 1

Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Therapy Too, Inc.

Filing Date: July 16, 2003

Examiner: Odessa Bibbins

Serial No.: 76/529862

Law Office: 113

Mark: SPRINKLES PALM BEACH and Design

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

August 9, 2004

Diane Churchill

Diane Churchill

TRANSMITTAL LETTER

Attention: Box Responses – No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

110011 0000 0000 1000 1000 0000 0000 0000

08-12-2004

U.S. Patent & TMO/TM Mail Rept Dt. #77

Sir:

Please find enclosed the following for filing:

- Response to Office Action with Exhibit A
- One (1) Postcard

Please charge any fee deficiencies and credit any overpayments to Deposit Account No. 50-0951.

Respectfully submitted,

Date: August 9, 2004

Diane Churchill

Diane Churchill

Florida Bar No. 487510

AKERMAN SENTERFITT

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West Palm Beach, Florida 33402-3188

Telephone No: (561) 653-5000

Our Reference No: 7538-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Therapy Too, Inc.

Filing Date: July 16, 2003

Examiner: Odessa Bibbins

Serial No.: 76/529862

Law Office: 113

Mark: **SPRINKLES OF PALM BEACH and Design**

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on

August 9, 2004



Diane Churchill

RESPONSE UNDER 37 C.F.R. § 2.62

Box Responses - No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

RESPONSE/AMENDMENT TO OFFICE ACTION

Therapy Too, Inc., the ("Applicant"), hereby responds to the Examining Attorney's Office Action dated February 9, 2004 with respect to the above-referenced application. The Examining Attorney has refused registration under Trademark Act §2(d), 15 U.S.C. §1052(d), alleging that the Applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 1,894,726 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 et seq. Additionally, the Examining Attorney also states that the recitation of services is unacceptable as indefinite and must be placed in the proper class. Further the Examining Attorney requires that the Applicant disclaim the word PALM BEACH.

Based on the following response to the §2(d), amendment to the recitation of services and proper classification, and disclaimer of the wording "Palm Beach" apart from the mark as shown, the Applicant respectfully requests that the Examining Attorney withdraw her refusal and grant registration on the Principal Register.

I. Likelihood of Confusion

The determination of likelihood of confusion involves a two step analysis that includes an evaluation of: (i) the similarity of the marks in terms of their appearance, sound, connotation and commercial impression; and (ii) the similarity of the goods and services offered in connection with the marks. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973); *In re August Storck KG*, 218 U.S.P.Q. 823 (TTAB 1983).

Applicant believes that the Examining Attorney's determination of likelihood of confusion between the cited registered mark and the pending application fails because the Examining Attorney has not properly examined the differences between the appearance and commercial impression of the cited mark and has neglected to analyze the significant distinction between the Applicant's services and the services of the cited mark. Accordingly, the Applicant requests that the Examining Attorney withdraw the Section 2(d) refusal as to the registered mark as a likelihood of confusion does not exist.

U.S. Registration No. 1,894,726 is for the mark SPRINKLES for use in connection with a restaurant services in International Class 42. As set forth below, the Applicant respectfully submits that the Examining Attorney has failed to properly evaluate the likelihood of confusion with respect to this registration and the refusal must be withdrawn.

A. Dissimilarity of the Marks

U.S. Registration No. 1,894,726 is for the mark SPRINKLES for use in connection with restaurant services. While it is true that the Applicant's mark "SPRINKLES OF PALM BEACH" contains the term SPRINKLES, the term is stylized and the mark also contains a significant design feature of ice cream cones that emulate palm trees together with the term PALM BEACH. Thus, the Applicant's mark is not identical to the cited mark nor is the Applicant's entire mark incorporated within the referenced mark.

Conflicting marks must be compared in their *entireties* to determine likelihood of confusion. *Id.* citing *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (C.C.P.A. 1960). The question is whether or not the similarity of the names is such as to make likely the deception of any appreciable number of ordinary prudent customers. *I.T.S. Industria Tessuti Speciali v. The Aerfab Corp., et al.*, 280 F. Supp. 581, 586 (S.D.N.Y. 1967) citing *La Touraine Coffee Co., Inc. v. Lorraine Coffee Co.*, 157 F.2d 115, 117 (2d Cir. 1946); *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 612 (2d Cir. 1960). In this regard, it is the general overall impression given by the marks which count. *Id.* citing *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 762 (2d Cir. 1960). Thus, when analyzing the similarities of sight, sound and meaning between two marks one must look to the overall impression created by the marks and not merely compare individual features. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987); TMEP §1207.01 citing *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

The Examining Attorney states that the registrant's simple word mark SPRINKLES is confusingly similar to the Applicant's composite stylized mark and design SPRINKLES PALM BEACH. In support of this conclusion the Examining Attorney states that when a mark consists

of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. This "'literacy' presumption, in that it assumes that words have more impact than designs, [is] a dubious generalization." J. McCarthy, *Trademarks and Unfair Competition*, §23:47, p. 23-126.

The Federal Circuit has cautioned that "There is no general rule as to whether letters or design will dominate in composite marks.... No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." *citing In Re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 U.S.P.Q.2d 1239 (Fed. Cir. 1990).

Id.

Conflicting marks consisting of both words and pictorial symbols must be compared in their entireties to determine likelihood of confusion. *Id.* citing *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (C.C.P.A. 1960). The question is whether or not the similarity of the names is such as to make likely the deception of any appreciable number of ordinary prudent customers. *I.T.S. Industria Tessuti Speciali v. The Aerfab Corp., et al.*, 280 F. Supp. 581, 586 (S.D.N.Y. 1967) citing *La Touraine Coffee Co., Inc. v. Lorraine Coffee Co.*, 157 F.2d 115, 117 (2d Cir. 1946); *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 612 (2d Cir. 1960). Thus, it is the general overall impression given by the marks which counts. *Id.* citing *Harold F. Ritchie, Inc. v. Chesebrough-Pond's Inc.*, 281 F.2d 755, 762 (2d Cir. 1960). Consideration must be given to appearance, sound and meaning of the marks, as well as the manner in which they are displayed. *E. Remy Martin & Co. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1531 (11th Cir. 1985). Where one mark consists of a design and a word, and the other mark of merely a word, similarity is usually controlled by determining whether the word or the design dominates the first mark. J. McCarthy, *Trademarks and Unfair Competition*, §23:47, p. 23-138.

Applicant submits that the design features of Applicant's mark are significant and will not create the same commercial impression as the registrant's simple word mark SPRINKLES. The Applicant's mark contains the term SPRINKLES in a unique, stylized font with two ice cream cones emulating palm trees prominently displayed underneath the term and forming the center of the mark with the words PALM BEACH below the design. Consequently, the portion of the mark likely to be impressed upon a purchaser's memory is the distinctive ice cream cone design. This design when combined with the words PALM BEACH creates a completely distinct and unique commercial impression. Thus, when the design element and the word PALM BEACH are given fair and proper weight, confusion with the simple word mark "SPRINKLES" is eliminated.

Moreover, although the additional term "Palm Beach" must be disclaimed, it cannot be completely ignored and does in fact play a significant role in eliminating potential confusion. There are numerous analogous cases to support this contention. In *Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 161 (CCPA 1960) the court found that the use of the marks "EASY" and "EASYTINT" both for paint products was not likely to lead to confusion. In *Plus Products v. Stark-Kist Foods, Inc.*, the TTAB held that the marks "MEAT PLUS" and "PLUS" created substantially different commercial impressions even though the former was used in connection with pet food and the latter was used for dietary food supplements for dogs and cats. 220 USPQ 541 (TTAB 1979). Accordingly, Applicant believes that the marks create substantially different commercial impressions and that confusion is not likely. See *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 644 F.Supp. 542 (S.D. Fla. 1986)(finding no likelihood of confusion between "FLIP" and "FINAL FLIP" where both were used for rodenticide); *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440 (9th Cir.

1980)(finding that District Court's determination that "ALPHA" and "ALPHA STEEL TUBE" or "ALPHA STEEL" taken as a whole were not confusing similar is not clearly erroneous); *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973)(holding that the obvious substantial differences between "SILK" for face cream and "SILK 'N SATIN" for beauty lotion and bath oil for hands and skin were sufficient to prevent any reasonable likelihood of confusion); *Monarch Licensing Ltd. v Ritam Int'l. Ltd., Inc.*, 24 USPQ 2d 1456 (SDNY 1992)(holding that "OOZ" and "OOZE BALL" for similar toys was not likely to cause confusion); *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983)(finding that contemporaneous use of "WONDER BOND PLUS" and "BOND-PLUS" both for adhesives was not likely to cause confusion or mistake).

Bolstering Applicant's argument is the fact that registrant's mark is not so distinct or famous that it warrants a scope of protection substantially beyond the actual registration granted to registrant. *In Re Dayco Products-Eagle Motive, Inc.*, 9 U.S.P.Q.2d 1910 (TTAB 1988); *In Re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559 (TTAB 1996). There are a number of current listings on the Principal Register for the mark "SPRINKLES" or "SPRINKLE":

SPRINKLES	Registration No. 2,011,142 for toy bunny
SPRINKLES and design	Registration No. 2,115,408 for children's clothing, namely cloth bibs, smocks, shirts, pants, hats, socks and underwear.
SPRINKLES stylized	Registration No. 1,541,489 for party decorations, namely, confetti and paper cutouts.
SPRINKLE and design	Registration No. 1,314,244 for pharmaceutical preparations, namely a bronchodilator used in a capsule intended to be opened.
SPRINKLE and design	Registration No. 0863212 for dry mixture of seasonings, dehydrated vegetables and spices for food flavoring purposes.

MYSTIK SPRINKLES Registration No. 2,297,687 for paper invitations, paper party decorations, instructions sheets, paper cards, paper bags, playing cards and pads of paper.

Additionally, the word "sprinkles" is subject to common usage as a reference to a sugar or candy topping used on various desert items. Consequently, consumers are not likely to have significant associations of the term with the registrant. In fact, a review of the registrant's website and a search on the Internet using the term "sprinkles" in connection with the name of the registrant did not reveal any references. See, Exhibit A attached hereto. The registrant is the owner and operator of several well known restaurant chains which are primarily known for their steak and hamburgers, namely, Bennigan's®, Steak and Ale®, Ponderosa Steakhouse® and Bonanza™. There is no mention of "Sprinkles" in connection with the registrant or any of these restaurants.

B. Dissimilarity of Services

The second step requires the Examining Attorney to compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely.

The Applicant submits that the second step is immaterial because "[t]he question to be determined is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods because of the marks used thereon." TMEP 1207.01 [emphasis supplied]. As noted above, the marks are not identical and, therefore, there is no likelihood of confusion because consumers would not be under the mistaken belief that the services or goods originate from, or are in some way associated with, the same source. Consequently, the Examining Attorney can remove the Section 2(d) refusal on the basis of the foregoing discussion alone.

Even if the Examining Attorney should find the above argument unpersuasive, and believes that the marks are similar, this fact alone does not satisfy the prerequisites for a finding of likelihood of confusion. Even where the marks are identical, the use of the same word is not dispositive of the issue of likelihood of confusion. *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 609, 610 (D. Mass. 1983). The similarity of the goods and/or services must also be evaluated. If the products are not related or marketed in such a way that they would be encountered by the same person in situations that would create an inference that they originate from the same source, *then, even if the marks are identical, confusion is not likely.* TMEP 1207.01(a)(i). *See, Quartz Radiation Corp. v. Comm/Scope Company*, 1 U.S.P.Q.2d 1668 (TTAB 1986)(holding there was not confusion between "QR" for coaxial cable and "QR" for electrical products); *Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 U.S.P.Q.2d (TTAB 1990)(holding "LITTLE PLUMBER" for advertising services for plumbing companies not confusing with "LITTLE PLUMBER" for liquid drain cleaner).

The Examining Attorney states that since there are a number of registrations in which a registrant provides restaurant services as well as retail store services, there is a relationship between the Applicant's services and the restaurant services of Registration No. 1,894,726 sufficient to support a Section 2(d) refusal. Applicant submits that this simply is too broad a generalization.

As noted above, the owner of the cited registration, Metromedia is the owner and operator of the Bennigan's®, Steak and Ale®, Ponderosa Steakhouse® and Bonanza™ restaurants all of which are known for their steaks and burgers. *See, Exhibit A.* While the Examiner's point that certain restaurant operations cross-over into the retail market offering food products for sale is accurate, there is no *per se* rule that confusion is always likely when a similar

mark is used on restaurant services and the sale of a particular food product. J. McCarthy, *Trademarks and Unfair Competition*, §24:48, p. 24-78.1 citing *Lloyd's Food Products, Inv. v. Eli's, Inc.*, 987 F.2d 766, 768 (Fed. Cir. 1993)(no likelihood of confusion between LLOYD'S for restaurant and LLOYD'S for barbecued meats). Nor can an inference be drawn from the fact that restaurants frequently package their food for sale at retail establishments. *Lloyd's, supra*, at 769. To the contrary, *a party must show something more than that similar or even identical marks are used for food products and for restaurant services. Jacobs v. International Multifoods Corporation*, 668 F.2d 1234, 1236 (C.C.P.A. 1982)[emphasis supplied].

Moreover, the Applicant's retail sale of ice cream is not complimentary to the registrant's sale of steaks and hamburgers by its restaurants and thus are not likely to be confused. Food products are somewhat unique under trademark law because many producers tend to use marks that are highly similar in general and because likelihood of confusion as to similar marks used on different items of food must be analyzed by the degree of relatedness and complementarity of the products. *Basic Vegetable Products, Inc. v. General Foods Corp.*, 165 USPQ 781 (TTAB 1970)(finding no likelihood of confusion between "MAGIC" for dehydrated onions and garlic and "SOUR MAGIC" for sour cream mix where "magic" was frequently used by producers of food products); J. McCarthy, *Trademarks and Unfair Competition*, §24:48, p.24-78. Only similar marks used on complementary items may be likely to cause confusion. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926 (C.C.P.A. 1978)(no likelihood of confusion between opposer's ZINGERS for cakes and applicant's RED ZINGER for herbal tea); *In Re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984)(CANYON fresh citrus fruits versus CANYON candy bars, the rule of resolving doubts in favor of the senior user does not apply because there is no "substantial doubt" in the court's mind that confusion is *unlikely*.)

Applicant's ice cream is not a complement to the steak and hamburgers served by registrant's restaurants. If there is no general similarity or likelihood of confusion between the two unrelated foods products, then there cannot be a likelihood of confusion between the restaurant services and the retail sale of a particular unrelated food product. *Lloyd's, supra.* at 769. In other words, if the Applicant were seeking to register its mark for the retail sale of steak sauce, baby back ribs or barbequed chicken, then an argument could be advanced that such marketing might be confusing with a steakhouse restaurant, all offered under the same trademark given the complementarity of the products. Such is not the case here. As explained above, Applicant is selling ice cream under the mark. Ultimately, Applicant submits that the Examining Attorney has not demonstrated anything more than that similar marks are used for the retail sale of food products and for restaurant services. This is not sufficient evidence to support the Section 2(d) refusal and, therefore the refusal should be withdrawn.

II. Informalities

A. Incorrect Classification and Amend to Recitation of Services.

The Examining Attorney states that the Applicant has classified the services incorrectly in International Class 43 and that the recitation of services is indefinite. The Applicant adopts the following recitation and classification and requests that the application be amended to substitute the following description for the current recitation:

Retail store services featuring ice cream in International Class 35.

B. Disclaimer of Wording

The Examining Attorney requires that the words PALM BEACH be disclaimed apart from the mark as shown. No claim is made to the exclusive right to use PALM BEACH apart from the mark as shown.

Based on the Applicant's amendment to the recitation of services, disclaimer and response to the refusal to register based upon Trademark Action Section 2(d), Applicant respectfully requests that the Examining Attorney allow registration of its mark.

Respectfully submitted,

Date: August 7, 2004

Diane Churchill

Diane Churchill

Florida Bar No. 487510

AKERMAN SENTERFITT

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West Palm Beach, Florida 33402-3188

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Our Reference No: 7538-2

VS DEC. EX 2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Therapy Too, Inc.

Filing Date: November 13, 2002 Examiner: John E. Michos

Serial No.: 78/184899 Law Office: 105

Mark: SPRINKLES OF PALM BEACH

TRANSMITTAL LETTER

CERTIFICATE UNDER 37 CFR 1.8

I hereby certify that this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office on the date shown below:

11/5/03
Diane Churchill
Diane Churchill

Attention: Box Responses - No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Sir:

Please find enclosed the following for filing:

- Response to Office Action Exhibits A and B
- Revocation of Power of Attorney and Appointment of New Attorney of Record
- One (1) Postcard

Please charge any fee deficiencies and credit any overpayments to Deposit Account No. 50-0951. This transmittal letter is submitted in duplicate.

Respectfully submitted,

Date: 11/5/03

Diane Churchill
Diane Churchill
Florida Bar No. 487510
AKERMAN SENTERFITT
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West Palm Beach, Florida 33402-3188
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Our Reference No: 7538-1

(WP157030;1)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Therapy Too, Inc.

Filing Date: November 13, 2002

Examiner: John E. Michos

Serial No.: 78/184899

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11/5/03
Diane Churchill
Diane Churchill

RESPONSE UNDER 37 C.F.R. § 2.62

Box Responses - No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

RESPONSE/AMENDMENT TO OFFICE ACTION

Therapy Too, Inc., the ("Applicant"), hereby responds to the Examining Attorney's Office Action dated May 5, 2003 with respect to the above-referenced application. The Examining Attorney has refused registration under Trademark Act §2(d), 15 U.S.C. §1052(d), alleging that the Applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration Nos. 2,011,142 and 2,086,440 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 et seq. The Examining Attorney also cites pending Application Serial No. 76/348733 as a potential for refusal under Trademark Act §2(d) should the application mature into a registration. Further, the Examining attorney also refuses registration under Trademark Act §2(e)(2), alleging that the Applicant's mark is geographically descriptive.

Additionally, the Examining Attorney also states that the identification of goods is unacceptable as indefinite.

Based on the following response to the §2(d) and §2(e)(2) refusals and amendment to the identification of goods, the Applicant respectfully requests that the Examining Attorney withdraw his refusals and grant registration on the Principal Register.

I. Identification of Goods

The Examining Attorney states that the identification of goods is unacceptable as indefinite. The Applicant adopts the following identification and requests that the application be amended:

Ice cream in International Class 30.

II. Likelihood of Confusion

The determination of likelihood of confusion involves a two step analysis that includes an evaluation of: (i) the similarity of the marks in terms of their appearance, sound, connotation and commercial impression; and (ii) the similarity of the goods and services offered in connection with the marks. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973); *In re August Storck KG*, 218 U.S.P.Q. 323 (TTAB 1983).

Applicant believes that the Examining Attorney's determination of likelihood of confusion between the two cited registered marks and the pending application fails because the Examining Attorney has not properly examined the differences between the appearance and commercial impression of the cited marks and has neglected to analyze the significant distinction between the Applicant's goods and the goods of the cited mark. Accordingly, the Applicant requests that the Examining Attorney withdraw the potential 2(d) refusal as to the registered marks and the pending application as a likelihood of confusion does not exist.

A. U.S. Registration No. 2,011,142

U.S. Registration No. 2,011,142 is for the mark SPRINKLES for use in connection with a toy bunny in International Class 28. The Examining Attorney states in the Office Action that the refusal under Section 2(d) is applicable to all food items and toys. Since the Applicant has amended and limited its description of goods to ice cream, the Applicant respectfully submits that the Section 2(d) refusal based upon U.S. Registration No. 2,011,142 is no longer applicable and should be withdrawn.

B. U.S. Registration No. 2,086,440

The Examining Attorney also cites U.S. Registration 2,086,440 for the mark SPRINKLES used in connection with fresh produce, namely, leafy greens. As set forth below, the Applicant respectfully submits that the Examining Attorney has failed to properly evaluate the likelihood of confusion with respect to this registration and the refusal must be withdrawn.

1. Dissimilarity of the Marks

U.S. Registration No. 2,086,440 is for the mark SPRINKLES for use in connection with fresh produce, namely leafy greens. While it is true that the Applicant's mark "SPRINKLES OF PALM BEACH" contains the term SPRINKLES, the mark also contains the additional term "PALM BEACH". Thus, the Applicant's mark is not identical to the cited mark nor is the Applicant's entire mark incorporated within the referenced mark.

Conflicting marks must be compared in their *entireties* to determine likelihood of confusion. *Id.* citing *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192, 125 U.S.P.Q. 406 (C.C.P.A. 1960). The question is whether or not the similarity of the names is such as to make likely the deception of any appreciable number of ordinary prudent customers. *I.T.S. Industria Tessuti Speciali v. The Aerfab Corp., et al*, 280 F. Supp. 581, 586 (S.D.N.Y. 1967) citing *La*

Touraine Coffee Co., Inc. v. Lorraine Coffee Co., 157 F.2d 115, 117 (2d Cir. 1946); *Avon Shoe Co. v. David Crystal, Inc.*, 279 F.2d 607, 612 (2d Cir. 1960). In this regard, it is the general overall impression given by the marks which count. *Id.* citing *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 762 (2d Cir. 1960). Thus, when analyzing the similarities of sight, sound and meaning between two marks one must look to the overall impression created by the marks and not merely compare individual features. *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622 (8th Cir. 1987); TMEP §1207.01 citing *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985).

While the Examining Attorney may argue that the mere addition of a term to a mark is not sufficient to overcome a likelihood of confusion under Section 2(d), there are numerous cases which hold to the contrary. *United Drug Company v. The Mercirex Company*, 182 F.2d 222 (CCPA 1950)(holding that "REX" and "MERCIREX," both for medicinal and pharmaceutical products, were not likely to lead to confusion); *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440 (9th Cir. 1980)(finding that there was no error in the District Court's determination that "ALPHA" and "ALPHA STEEL TUBE" or "ALPHA STEELE" taken as a whole were not confusingly similar); *Pacquin-Lester Co. v. Charnaceuticals, Inc.*, 484 F.2d 1384 (CCPA 1973) (holding that the obvious substantial differences between "SILK" for face cream and "SILK 'N SATIN" for beauty lotion and bath oil for hands and skin were sufficient to prevent any reasonable likelihood of confusion); *Monarch Licensing Ltd. v. Ritam Int'l. Ltd., Inc.*, 24 U.S.P.Q.2d 1456 (S.D.N.Y. 1992)(holding that "OOZ" and "OOZ BALL" for similar toys was not likely to cause confusion); *Industrial Adhesive Co. v. Borden, Inc.*, 218 U.S.P.Q. 945 (TTAB 1983)(finding that contemporaneous use of "WONDER BOND PLUS" and "BOND-PLUS" both for adhesives was not likely to cause confusion or mistake.) Consequently, Applicant's composite mark

"SPRINKLES OF PALM BEACH" when viewed in its entirety is not confusingly similar to the simple work mark "SPRINKLES".

2. Dissimilarity of Goods

The second step requires the Examining Attorney to compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely.

The Applicant submits that the second step is immaterial because "[t]he question to be determined is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the source of the goods because of the marks used thereon." TMEP 1207.01 [emphasis supplied]. As noted above, the marks are not identical and, therefore, there is no likelihood of confusion because consumers would not be under the mistaken belief that the services or goods originate from, or are in some way associated with, the same source. Consequently, the Examining Attorney can remove the Section 2(d) refusal on the basis of the foregoing discussion alone.

Even if the Examining Attorney should find the above argument unpersuasive, and believes that the marks are similar, this fact alone does not satisfy the prerequisites for a finding of likelihood of confusion. Even where the marks are identical, the use of the same word is not dispositive of the issue of likelihood of confusion. *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 220 U.S.P.Q. 609, 610 (D. Mass. 1983). The similarity of the goods and/or services must also be evaluated. If the products are not related or marketed in such a way that they would be encountered by the same person in situations that would create an inference that they originate from the same source, then, even if the marks are identical, confusion is not likely. TMEP 1207.01(a)(i). See, *Quartz Radiation Corp. v. CommScope Company*, 1 U.S.P.Q.2d 1668 (TTAB

1986)(holding there was not confusion between "QR" for coaxial cable and "QR" for electrical products); *Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 U.S.P.Q.2d (TTAB 1990)(holding "LITTLE PLUMBER" for advertising services for plumbing companies not confusing with "LITTLE PLUMBER" for liquid drain cleaner).

Food products are somewhat unique under trademark law. This is in part due to the fact that many producers may use marks that are highly similar in general and, therefore, likelihood of confusion as to similar marks used on different items of food must be analyzed by the degree of relatedness and complementarity of the products. See, *Basic Vegetable Products, Inc. v. General Foods Corp.*, 165 U.S.P.Q. 781 (TTAB 1970)(finding no likelihood of confusion between "MAGIC" for dehydrated onions and garlic and "SOUR MAGIC" for sour cream mix where "magic" was frequently used by producers of food products.); J. McCarthy, *Trademarks and Unfair Competition*, §24:48, p. 24-78. Only similar marks used on complementary items may be likely to cause confusion. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926 (C.C.P.A. 1978)(no likelihood of confusion between opposer's ZINGERS for cakes and applicant's RED ZINGER for herbal tea); *In Re Mars, Inc.*, 741 F.2d 395 (Fed. Cir. 1984) (CANYON for fresh citrus fruits v. CANYON for candy bars – the rule resolving doubts in favor of the senior user *does not apply* because there is no "substantial doubt" in the court's mind that confusion is *unlikely*.) [emphasis added].

Based on the Applicant's amendment to its identification of goods, the Applicant's and registrant's goods are not complementary. In fact, the court's analysis and ruling *In Re Mars, Inc.*, *supra*, is absolutely applicable and should be adopted by the Examining Attorney. The registrant distributes the leafy vegetables such as salad savoy which is related to kale and cabbage See, printout of a portion of the registrant's website, www.saladsavoy.com, attached hereto as Exhibit A.

The registrant's vegetable is used as a side dish, in salads, soups, casseroles and as a garnish on vegetable or relish trays. Vegetables certainly do not complement or bring to mind ice-cream. The Applicant's product is certainly not designed to be used in conjunction with ice cream nor does ice cream fall within the category of vegetables. Consequently, confusion is not likely and the Section 2(d) refusal should be withdrawn.

C. U.S. Application Serial No. 76/348733

The Examining Attorney has also cited pending Application Serial No. 76/348733 for the mark SPRINKLES used in connection with electric night lights, clocks, bookends; photograph holders; memo holders, picture frames; decorative wall shelves with hooks; compartmentalized organizers made of wood and/or resin; trinket boxes made of resin; drawer pulls of plastic or wood, cork, wicker, shell, mother-of-pearl and/or substitutes for the foregoing materials, non-meal bank; plush toys; musical toys; children's bath toys and infant rattles and as a potential for refusal under §2(d).

As set forth in Section II. A. above, the Examining Attorney states in the Office Action that the refusal under Section 2(d) is applicable to all food items and toys. Since the Applicant has amended and limited its description of goods to ice cream. The Applicant respectfully submits that the Section 2(d) refusal based upon U.S. Application Serial No. 76/348733 is no longer applicable and should be withdrawn.

III. Refusal to Register - Geographically Descriptive

The Examining Attorney has refused registration of the Applicant's mark on the Principal Register because the Examiner alleges that the mark is primarily geographically descriptive of the Applicant's goods. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); TMEP §§1210.01(a) and 1210.04(b). The Examining Attorney states that the Applicant's addition of the descriptive term

SPRINKLES to the term PALM BEACH does not obviate a determination of geographic descriptiveness.

The Applicant submits that the term SPRINKLES is not in any way descriptive of ice cream. A mark is merely descriptive under the Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 2 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

In reaching a determination that a term is descriptive, the Examining Attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985) [emphasis supplied]. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the good to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). The Examining Attorney is respectfully requested to reconsider the determination that SPRINKLES is descriptive for ice cream.

If a matter is inherently distinctive as a trademark, it is registrable on the Principle Register without evidence that it is recognized as a mark. If the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services in commerce, then the matter in question is registrable on the Principal Register pursuant to 2(f) of the trademark Act, 15 U.S.C. 1052(f).

It appears that the Examining Attorney's refusal is based upon the common use of sprinkles to refer to small round balls of brightly colored sugar used as decorations on cakes, cookies, trifles and other desserts and, thus describes a primary feature of the Applicant's product. See printout from www.foodreference.com attached hereto as Exhibit B. The existence of the alternative use of "sprinkles" on various desert and pastry products, however, demonstrates that mental, pause, reflection and forethought (recognized hallmarks of the suggestive mark) are required when potential customers are confronted with the term "SPRINKLES" in order to determine the nature of the product.

Applicant believes that the term SPRINKLES is not descriptive, but is inherently distinctive. "A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Equine Technologies, Inc. v. Equitechnology, Inc.*, 68 F.3d 542, 544 (1st Cir. 1995) (citations omitted). Trademark law limits the protection accorded merely descriptive terms because they are poor means of distinguishing between competing services or goods and because descriptive terms are often necessary for a company to describe its services or goods to consumers. *See id.* Given the wealth of synonyms in the English Language, such concerns are reduced when the term is merely suggestive. *See Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp.*, 259 F.2d 314, 317 (2nd Cir. 1958).

In the present case, the term SPRINKLES is not descriptive as applied to Applicant's product. The term "sprinkles" does not describe any ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. Consequently, when one thinks of "SPRINKLES" this does not immediately bring to mind ice cream. Sprinkles are not an ingredient, feature or characteristic of the Applicant's ice cream as the ice cream is not packaged with sprinkles on or in

the ice cream like for example ice cream that contains swirls of fudge, chocolate, caramel or peanut butter or pieces of chocolate chips or nuts. Nor does Sprinkles describe the quality of the Applicant's ice cream or the use or purpose of the ice cream. No information about the product is conveyed by the term "SPRINKLES. There is only a hint or suggestion that it probably has something to do with a desert or pastry product. Consequently, the term "SPRINKLES" requires that one exercise his or her imagination in order to draw a conclusion as to the nature of the goods. Accordingly, the mark "SPRINKLES" must be viewed as only suggestive of the Applicant's product.

Moreover, the Applicant's mark is a composite mark and the geographic component of the mark "PALM BEACH" is a separable feature of the mark. Thus, since the term SPRINKLES is not descriptive, the Applicant's mark cannot be primarily geographically descriptive and is not subject to a refusal under §2(e)(2). TMEP §1207.08.

IV. Other Formalities

The Applicant will file an Amendment to Allege Use with the proper specimen pursuant to the Examining Attorney's instructions.

Based on the Applicant's amendment to the identification of goods and response to the refusal to register based upon Trademark Action Sections 2(d) and 2(e)(2), Applicant respectfully requests that the Examining Attorney allow registration of its mark.

Respectfully submitted,

Date: 11/5/03

Diane Churchill

Diane Churchill

Florida Bar No. 487510

AKERMAN SENTERFITT

222 Lakeview Avenue, 4th Floor, Post Office Box 3188

West Palm Beach, Florida 33402-3188

Telephone No: (561) 653-5000

Our Reference No: 7538-1

VS DEC. EX 3

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

Soft Serve, Inc. d/b/a Sprinkles)	
)	
Opposer,)	
)	
v.)	Opposition No. 91194188
)	
Sprinkles Cupcakes, Inc.)	
)	
Applicant.)	

**OPPOSER'S ANSWERS AND OBJECTIONS TO APPLICANT'S
FIRST SET OF INTERROGATORIES**

Pursuant to Federal Rule of Civil Procedure 33 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Opposer Soft Serve, Inc. d/b/a Sprinkles ("Opposer Sprinkles"), by and through its undersigned counsel, hereby responds to the First Set of Interrogatories ("Interrogatories") of Applicant Sprinkles Cupcakes, Inc. as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Opposer Sprinkles has not completed its investigation in this matter. All responses to Interrogatories are based upon the information presently known to Opposer Sprinkles and are given without prejudice to its right to adduce evidence discovered or analyzed subsequent to the date of these responses. Opposer Sprinkles expressly reserves the right to revise and supplement

INTERROGATORY NO. 3

For each product and service requested to be identified in Interrogatory No. 2, identify the persons most knowledgeable about each product or service.

ANSWER

Opposer Sprinkles repeats and incorporates by reference herein its objection to Interrogatory No. 2. Without waiving its objection, the person most knowledgeable about the products and services offered by Opposer Sprinkles is Thomas Orban, President and owner of Opposer Sprinkles.

INTERROGATORY NO. 4

For each product and service requested to be identified by Interrogatory No. 2, identify the time period (including day, month, and year) during which you offered each of those products and services.

ANSWER

Opposer Sprinkles repeats and hereby incorporates by reference its objection to Interrogatory No. 2. Without waiving this objection, and subject to supplementation as Opposer Sprinkles' related research continues, Opposer Sprinkles responds as follows: As to all goods and services, with the exception of clothing goods, Opposer Sprinkles' date of first use is a date in 2002 prior to November 21. Further specificity will be provided by supplementation upon the conclusion of Opposer Sprinkles' investigation. Opposer Sprinkles' date of first use in connection with clothing goods is at least as early as November 18, 2004. Opposer Sprinkles' offering of these products and services has been and remains ongoing.

ANSWER

Opposer Sprinkles has used the mark SPRINKLES, as defined by Applicant, for a number of years in connection with various goods specifically recited, and closely related to, the goods recited in the '541 application. Consequently, as a result of Opposer Sprinkles' long and successful usage of the mark and trade name SPRINKLES, the purchasing public has come to recognize the mark SPRINKLES as referring to Opposer Sprinkles.

INTERROGATORY NO. 39

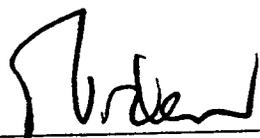
Identify each person who provided information on which your responses to these Interrogatories and based, specifying the interrogatory or interrogatories for which each person provided information.

ANSWER

Thomas Orban, President and owner of Opposer Sprinkles, as to all Interrogatory answers.

Soft Serve, Inc. d/b/a Sprinkles

Date: Aug 26, 2010



Thomas Orban

VS DEC. EX 4

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

Soft Serve, Inc. d/b/a Sprinkles)	
)	
Opposer,)	
)	
v.)	Opposition No. 91194188
)	
Sprinkles Cupcakes, Inc.)	
)	
Applicant.)	

OPPOSER'S SUPPLEMENTAL DISCLOSURES

Pursuant to Rule 26 (a) and (d) Opposer identifies the following additional individuals having information that may be used to support Opposer's claims.

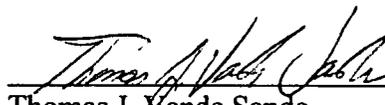
1. Saira Haider, 89a Leathwaite Road, London, SW11 6RN, England. Former employee. Knowledge includes Opposer's first use of SPRINKLES at least as early as April 24, 2002.
2. Aaron Yoches, 5200 S. Ulster Street, Apt. 1612, Greenwood Villgae, CO 80111. Former employee. Knowledge includes Opposer's first use of SPRINKLES at least as early as May – August 2002.

Opposer reserves the right to further amend and supplement its initial disclosures.

HALL & VANDE SANDE, LLC

Date: _____

11/4/10



Thomas J. Vande Sande
Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

CERTIFICATE OF SERVICE

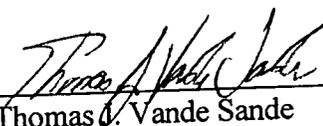
The undersigned, Thomas J. Vande Sande, attorney for Opposer, hereby certifies that one (1) copy of the foregoing "OPPOSER'S SUPPLMENTAL DISCLOSURES" was this day served on Applicant by mailing same, first class mail, to:

Hollis Beth Hire, Esquire
Wilson, Sonsini, Goodrich and Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

HALL & VANDE SANDE, LLC

Date:

10/4/10



Thomas J. Vande Sande
Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

VS DEC. EX 5

1 A My recollection all along was that
2 we had been using Sprinkles in the summer of
3 2002. I could not find any documents to
4 corroborate what I remembered as being what
5 happened.

6 So what I did was I identified the
7 people who worked there that summer whose
8 window of memory was limited to that summer
9 and I went after them to get their
10 recollection and that's what we produced to
11 you and corroborates my memory.

12 Q What happened between October 2010
13 and November 2010, specifically, that caused
14 you to now make the claim that Sprinkles was
15 in use at least as early as April 24?

16 A First of all, that is my
17 recollection. Second, I know --

18 Q You had that recollection all
19 along?

20 A I had that recollection.

21 Q April 24 was your recollection?

22 A April 24, was not my recollection.

VS DEC. EX 6

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

Soft Serve, Inc. d/b/a Sprinkles)	
)	
Petitioner,)	Consolidated Proceeding No. 91194188
)	
v.)	Cancellation No. 92053109
)	
Sprinkles Cupcakes, Inc.)	
)	
Registrant.)	
<hr/>		

DECLARATION OF SAIRA HAIDER

I, Saira Haider, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, declare as follows:

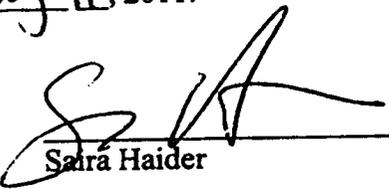
1. I have personal knowledge of the matters set forth herein and am competent to testify thereto.
2. I am a former employee of Soft Serve, Inc. More specifically, I applied for employment with Soft Serve at the end of March 2002 and began working shortly thereafter, specifically in April 2002. I was employed by Soft Serve, Inc. through the summer of 2002. I left SPRINKLES at the end of the summer to return to school.
3. At all involved times, specifically at the time of my applying for employment at the end of March 2002, at the time I began working in April 2002, throughout the

ensuing summer, and at the time of my departure to return to school, the business was known as SPRINKLES.

4. In addition, during the entire time I worked at SPRINKLES and at the time I applied to work at SPRINKLES, SPRINKLES was in use not only as the name of the store, but also in connection with various related materials such as product stickers, coupons, signage, advertisements, catering menus and various community activities.
5. Bakery goods were already being offered for sale at SPRINKLES at the time I applied for employment, and were still being offered for sale when I left my job at the end of the summer of 2002. Included in the array of bakery goods offered by SPRINKLES during that time were at least donuts, bagels, pastries and muffins. While bakery goods and various ice cream products were offered for sale throughout the day and evening, sales of bakery goods at SPRINKLES during the morning hours substantially outnumbered the sales of ice cream products during the course of my employment.
6. My duties at SPRINKLES included the filling of customers' orders for bakery goods and various ice cream products.

I declare under penalty of perjury that the foregoing is true and correct. Executed in London United Kingdom on May 11, 2011.

By:


Sara Haider

VS DEC. EX 7

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

Soft Serve, Inc. d/b/a Sprinkles)	
)	
Petitioner,)	Consolidated Proceeding No. 91194188
)	
v.)	Cancellation No. 92053109
)	
Sprinkles Cupcakes, Inc.)	
)	
Registrant.)	
<hr/>		

DECLARATION OF AARON YOCHES

I, Aaron Yoches, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, declare as follows:

1. I have personal knowledge of the matters set forth herein and would so testify if called upon to do so.
2. I was previously an employee of Soft Serve, Inc. I applied for employment with Soft Serve in May 2002 and was employed shortly thereafter. I worked for Soft Serve, Inc: throughout the summer of 2002 leaving at the end of the summer to return to school.
3. By the time I left my employment at the end of the summer of 2002, SPRINKLES was used not only as the name of the store, but also increasingly in connection with

various related materials and activities such as coupons, signage, advertisements and community activities.

4. Bakery goods were already being offered for sale at SPRINKLES at the time I applied for employment and were still being offered for sale when I left my job at the end of the summer of 2002. Included in the array of bakery goods offered by SPRINKLES during that time were at least donuts, bagels, pastries and muffins. While bakery goods and various ice cream products were offered for sale throughout the day and evening, sales of bakery goods at SPRINKLES during the morning hours substantially outnumbered the sales of ice cream products during the course of my employment.
5. My duties at SPRINKLES included the filling of customers' orders for bakery goods and various ice cream products.

I declare under penalty of perjury that the foregoing is true and correct. Executed in Denver Colorado on June 3, 2011.

By: 
Aaron Yoches

VS DEC. EX 8

1 happened contemporaneously.

2 So I have asked you twice now at
3 least whether you took out any advertising
4 and what you have responded was that there
5 were coupons.

6 What were the coupons?

7 A Well, for example, we stood on the
8 corner of River Road and Falls Road in the
9 morning and passed out coupons offering a
10 free donut to people who would come into our
11 store and buy a cup of coffee. I did that
12 myself.

13 Q You have a recollection of having
14 done so in October 2002?

15 A We were using Sprinkles way before
16 October 2002. We have to distinguish between
17 the use of this logo and the word mark
18 Sprinkles. You have to understand I was
19 operating my store without a name for a long
20 time. This is a huge void that I was very --

21 Q I think we understand that.

22 A -- very anxious to fill, and so

1 once I decided on the name Sprinkles, and we
2 started by answering the phone Sprinkles and
3 telling the staff to answer the phone
4 Sprinkles, it behooved me to implement the
5 name as rapidly as I could, but it took me
6 time.

7 I am not a speed demon. I wasn't
8 going to pay a lot of money to have somebody
9 come up with a logo for me. It took me time
10 to formulate this logo a long time after I
11 had made the decision and Beta tested the
12 name in the store and gotten customer to tell
13 me, yes, they thought it was cool, et cetera.

14 Q So you were using the name without
15 a logo?

16 A That is right.

17 Q But you were afraid to tell your
18 landlord that you were now doing business as
19 Sprinkles?

20 A No, I wasn't.

21 Q But you didn't?

22 A There is no point in hiding that

VS DEC. EX 9

1 BY MR. BEN-VENISTE:

2 Q You say there was a coupon that was
3 produced. Is there anything else? Is there
4 an ad in any of the newspapers that cover
5 Potomac that you took out saying Sprinkles
6 now operating at your address?

7 A I don't know.

8 Q You haven't produced one obviously.
9 Do you recall having taken out an ad?

10 A Well, the shopping center, for
11 example, sent out direct mail. That was part
12 of our rent and I believe that went out twice
13 a year and I tried to get the 2002 direct
14 mail piece from Money Mailer without success.
15 He didn't give me what went out that year.

16 So I don't know the answer to your
17 question because that very well could have
18 gone out saying Sprinkles.

19 Q So what we're trying to focus on is
20 your best recollection and to the extent that
21 it might be corroborated with documentary
22 evidence a more robust recollection of what

1 happened contemporaneously.

2 So I have asked you twice now at
3 least whether you took out any advertising
4 and what you have responded was that there
5 were coupons.

6 What were the coupons?

7 A Well, for example, we stood on the
8 corner of River Road and Falls Road in the
9 morning and passed out coupons offering a
10 free donut to people who would come into our
11 store and buy a cup of coffee. I did that
12 myself.

13 Q You have a recollection of having
14 done so in October 2002?

15 A We were using Sprinkles way before
16 October 2002. We have to distinguish between
17 the use of this logo and the word mark
18 Sprinkles. You have to understand I was
19 operating my store without a name for a long
20 time. This is a huge void that I was very --

21 Q I think we understand that.

22 A -- very anxious to fill, and so

VS DEC. EX 10

1 specific that I was looking for, just
2 anything that pertained to our case.

3 Q So there was nothing specific that
4 you remembered you had but could not find, is
5 that fair?

6 A No, I wouldn't say that either.
7 For example, things that I generated on my
8 computer in 2002, with the Sprinkles name
9 that we used in my store, in 2002, I would
10 have had loved to have been able to present
11 you with some hard copy.

12 Q Did you have an electronic copy?

13 A I looked for that too and I was
14 unable to locate it and generate it.

15 Q So you think there were things that
16 were generated by your computer in hard copy
17 in 2002 that would have been responsive to
18 the demand for documents?

19 A Yes.

20 Q What specifically?

21 A Well, I would refer you to the
22 declarations of Cyra Hyder and Aaron Yoakes.

- 1 Q Just from your memory, what things?
- 2 A Product labels, signage.
- 3 Q Signage?
- 4 A Signage.
- 5 Q Computer generated signage?
- 6 A Correct.
- 7 Q What kind of signage?
- 8 A Signage that would have had the
- 9 word mark on it in the time that we still had
- 10 not generated the logo that we currently use.
- 11 Q So the name Sprinkle?
- 12 A Yes, Sprinkles.
- 13 Q So that signage you remember was
- 14 generated on your computer, do you still have
- 15 that computer?
- 16 A No.
- 17 Q So where did you look for it?
- 18 A I had the floppies in Florida in my
- 19 home.
- 20 Q In Florida?
- 21 A Yes.
- 22 Q Well, we haven't heard about the

VS DEC. EX 11

1 remembers we were using the name when she
2 started, I think, in April and I do not
3 dispute that.

4 We may very well have been using it
5 in April. I just don't remember. I do
6 remember the summer. I can't be more clearer
7 than that.

8 Q And the first sign that you claim
9 was exhibited relating to the name Sprinkles
10 on your shop was according to your
11 recollection soon after you wrote the October
12 letter to your landlord, October 2002?

13 A The main sign outside of the
14 building, yes.

15 Q Was there some other sign now that
16 you claim said Sprinkles that identified it?

17 A Well, I have tried my best to
18 explain to you that we developed the logo
19 which was used for a number of purposes
20 including the outside sign, but we had been
21 using Sprinkles to identify the store well
22 before the development of the logo which

VS DEC. EX 12

1 Q You were not nervous?

2 A No. What I was nervous about was
3 the fact that I was about to hang a Sprinkles
4 sign that I hadn't requested approval for
5 from the architectural department of his
6 company and I wanted to cover my ass by
7 sending this letter, and saying, in the third
8 paragraph, "and by the way, we are going to
9 be saying it is called Sprinkles," so that at
10 a later date after I had hung the sign he
11 could not reproach me for not having informed
12 him.

13 That was the whole purpose of this
14 letter. The logo had already been designed,
15 and the Sprinkles sign, if it hadn't, or if
16 it wasn't ready, it was ready within days and
17 I have the invoice dated October 30, I think,
18 towards the latter part of October, that is
19 the invoice for the refurbishing of that
20 yogurt sign into the Sprinkles sign.

21 I can tell you that Sterico took
22 their good old time in invoicing me and that

VS DEC. EX 13

Invoice

16159 Shady Grove Rd.
 Gaithersburg, MD 20877
 301.948.8088 (P); 301.948.8244 (F)
 sterico@STERICOSIGNS.com

Date: 10/30/2002

No.: 2382



Sold To:

SOFT SERVE, INC.
 10148 RIVER ROAD
 POTOMAC, MD 20854

Ship To:

4000 WISCONSIN AVE.

P.O. #: TOM	TERMS: Net 30	PAYMENT DUE: 11/29/2002	ACC'T MGR: NLU	ORDERED BY:	VIA: PICK UP
----------------	------------------	----------------------------	-------------------	-------------	-----------------

QTY.	CODE	DESCRIPTION	UNIT COST	EXTENSION
1	NEON	NEON SIGN	156.50	156.50T
1	GRAPHICS	GRAPHICS	25.00	25.00T
1	VENT12...	12030 VENTEX TRANSFORMER	179.99	179.99T
1	SHOPR	IN SHOP REPAIR TO CUSTOMER'S ITEM	495.00	495.00

Thank you for your business.

Subtotal \$856.49

Refunds are not permitted on custom work. All product remains the property of Sterico, Inc. until paid in full. If not paid according to terms, Sterico, Inc. has the right to remove product from client's premises and to assess interest fees of 1.5% per month plus collection costs. STERICO SIGNS is locally and independently owned and operated. FEIN #: 521638173

Sales Tax (5.0%) \$18.07

Total \$874.56

YOUR FULL SERVICE SIGN CENTER

www.STERICOSIGNS.com

VS DEC. EX 14

1 produced here is December 31, 2002?

2 A No, sir. This is an archive. All
3 of the work we had done by Sterico in 2002,
4 was archived on the 31st of December 2002,
5 and that is the best information they could
6 provide.

7 MR. BEN-VENISTE: Move to strike
8 hearsay.

9 BY MR. BEN-VENISTE:

10 Q What document do you have that
11 shows that you ordered a Sprinkles sign prior
12 to late October 2002?

13 A Oh, I have an invoice. We don't
14 have that exhibit in front of us, but there
15 is an invoice for that sign for \$495.

16 Q We will get to that in a moment.
17 Did you announce in some way through
18 advertising in the local newspapers or
19 elsewhere that you were changing the name of
20 your store inspectors?

21 A Since 2002?

22 Q In 2002.

1 But you're right. I usually sign off on the
2 graphics before they produce, but I don't
3 have that.

4 Q The \$495 was to reconfigure an
5 existing sign?

6 A Recondition it.

7 Q Well --

8 A The same word. The same intent or
9 meaning.

10 Q Can you tell us why these items
11 were shipped to 4000 Wisconsin Avenue?

12 A They weren't. I picked it up, that
13 sign, myself, brought in my car and hung it
14 myself or it would have cost a lot more.

15 Q So that is incorrect?

16 A That is incorrect.

17 Q When do you claim you received it?

18 A Very shortly after I wrote my
19 landlord the letter.

20 Q So before the invoice was printed?

21 A Absolutely.

22 Q You're sure?

1 A I am positive.

2 Q You paid for this with a credit
3 card?

4 A That was my habit.

5 Q You have produced --

6 MR. BEN-VENISTE: Let's see 23.

7 (Whereupon, Respondent's

8 Exhibit Number 23 is marked for

9 Identification.)

10 THE REPORTER: Presenting Exhibit

11 23 to the witness.

12 BY MR. BEN-VENISTE:

13 Q If you look on the back of this
14 credit card, "U.S. Airways Dividend Miles,"
15 right?

16 A Yes.

17 Q Is that the payment of that invoice
18 to Sign-O-Rama?

19 A It is.

20 Q Who is Sign-O-Rama?

21 A The company that produced the sign.

22 Q Is that different than Sterico?

1 A No.

2 Q When you first decided to oppose
3 the Sprinkles trademark designation at the
4 TTAB, you made a claim that Soft Serve had
5 been using the trade Sprinkles since at least
6 as early as November 2002. Do you recall
7 that or do we need to show you?

8 A I do recall that clearly.

9 Q And that notice of opposition was
10 dated March 12, 2010. Do you accept that?

11 MR. VANDE SANDE : Sorry.

12 MR. BEN-VENISTE: That notice of
13 opposition was dated March 12, 2010.

14 MR. VANDE SANDE : I think that is
15 likely.

16 BY MR. BEN-VENISTE:

17 Q In making that statement, what did
18 you use to refresh your recollection as to
19 the date? How did you come up with at least
20 as early as November 2002?

21 A That is because I had filed or
22 registered the name Sprinkles with the State

VS DEC. EX 15

1 Q You were not nervous?

2 A No. What I was nervous about was
3 the fact that I was about to hang a Sprinkles
4 sign that I hadn't requested approval for
5 from the architectural department of his
6 company and I wanted to cover my ass by
7 sending this letter, and saying, in the third
8 paragraph, "and by the way, we are going to
9 be saying it is called Sprinkles," so that at
10 a later date after I had hung the sign he
11 could not reproach me for not having informed
12 him.

13 That was the whole purpose of this
14 letter. The logo had already been designed,
15 and the Sprinkles sign, if it hadn't, or if
16 it wasn't ready, it was ready within days and
17 I have the invoice dated October 30, I think,
18 towards the latter part of October, that is
19 the invoice for the refurbishing of that
20 yogurt sign into the Sprinkles sign.

21 I can tell you that Sterico took
22 their good old time in invoicing me and that

VS DEC. EX 16

1 But you're right. I usually sign off on the
2 graphics before they produce, but I don't
3 have that.

4 Q The \$495 was to reconfigure an
5 existing sign?

6 A Recondition it.

7 Q Well --

8 A The same word. The same intent or
9 meaning.

10 Q Can you tell us why these items
11 were shipped to 4000 Wisconsin Avenue?

12 A They weren't. I picked it up, that
13 sign, myself, brought in my car and hung it
14 myself or it would have cost a lot more.

15 Q So that is incorrect?

16 A That is incorrect.

17 Q When do you claim you received it?

18 A Very shortly after I wrote my
19 landlord the letter.

20 Q So before the invoice was printed?

21 A Absolutely.

22 Q You're sure?

VS DEC. EX 17

1 5172?

2 A No.

3 Q You refer in your responsive papers
4 to "freezer labels." Were freezer labels
5 with a Sprinkles logo produced?

6 A Yes.

7 Q How were they printed?

8 A You're referring to this logo?

9 Q I am referring to Sprinkles. Any
10 Sprinkles logo?

11 A During the summer of 2002, the word
12 mark Sprinkles was produced on my computer
13 for various applications in my business.
14 After the logo had been produced those labels
15 that we still use were produced by a company
16 called Daydots.

17 Q Spell that, please.

18 A D A Y D O T S.

19 Q When were they first used, these
20 Daydots labels?

21 A In 2003.

22 Q What month?

VS DEC. EX 18

INVOICE

SPRINKLES
10148 RIVER RD
POTOMAC MD
20854

Handwritten: Paid
H.C. J.L.

No.

INVOICE DATE **MARCH 19, 2004**
CUSTOMER'S ORDER NO.

SOLD TO: **RIGGS BANK
10150 RIVER RD
POTOMAC MD
20854**

SHIP TO:

SALESMAN SHIPPED VIA TERMS F.O.B.

QTY. ORDERED	QTY. SHIPPED	DESCRIPTION	UNIT	AMOUNT
		2 pots coffee & dozen donuts	20.50	
		2/06		
		2/13		
		2/20		
		2/27		
		3/05		
		3/12		
		3/19		
				\$143.5

Invoice

FORM 1072

INVOICE

"SPRINKLES"
 10148 RIVER RD
 POTOMAC, MD. 20854

No.

INVOICE DATE MAY 14, 2004
 CUSTOMER'S ORDER NO.

SOLD TO: RIGGS BANK
 10150 RIVER RD.
 POTOMAC, MD. 20854

SHIP TO:

SALESMAN Tom SHIPPED VIA TERMS F.O.B.

QTY. ORDERED	QTY. SHIPPED	DESCRIPTION	UNIT	AMOUNT
		MAR 26	2 AIRPOTS + DOR DONUTS	2050
		APRIL 2	"	
		9	"	
		16	"	
		23	"	
		30	"	
		MAY 7		
		14		
		21		
		28		
			TOTAL	161.00 205.00

Invoice

1-877

VS DEC. EX 19

1 Q Is this the first use of the credit
2 facility in the name of Sprinkles?

3 A In any name.

4 Q As far as you know?

5 A In any name. This was when we
6 started taking credit cards in the store.

7 Q So prior to 2003, you didn't take
8 credit cards?

9 A That is right or at least not
10 AmericanExpress.

11 Q Which ones did you take?

12 A Well, I don't think we took -- we
13 introduced the credit cards for Visa and
14 MasterCard and AmericanExpress, and Discover
15 all at the same time.

16 I am just saying that I don't know
17 how long it takes them to send out a thank
18 you letter so we may have put credit cards in
19 three months or five months or six months
20 earlier.

21 This letter doesn't reflect the
22 date of the inception of credit cards in the

VS DEC. EX 20



Company Food, LLC

Phone: (800) 859-2007
FAX: (717) 399-8509
email: www.kempsfood.com

KEMPS FOODS, LLC
CREDIT APPLICATION

(complete both sides)

Date ^{AUG} ~~JUL~~ 3, 2003

Legal Business Name SOFT SERVE INC Trade Name SPRINKLES
Address 10148 RIVER ROAD, POTOMAC, MD. 20854

Billing Address (if different) _____

Phone Number w/Area Code 301-299-8415 DUNS# _____

Type of Business RETAIL FOOD Corporation Partnership () Proprietorship ()

Name and Title of Principals:

1. Name T.J. ORBAN Title PRESIDENT SSN 081660631

2. Name G.A. ORBAN Title SECT/TRES SSN _____

3. Name EVA ORBAN Title VP SSN _____

Person to contact concerning payments T.J. ORBAN Phone No. 703 748 0978

Former Business Name(s) N/A

Year Started 1986 Length of Time at Present Location 14 YEARS

Property Owned () Leased ZUCKERMAN GRAVEL, 2 WISCONSIN CIRCLE #560
CHRYSLER CREDIT CORP, INC. Number of Lessors: _____

Payment Requirements: either/or Priced Delivery Ticket Invoice

Seasonal Business: Yes No ()

Estimated Annual Purchases From Kemps: \$ 10,000

Financial Statements Attached Not Attached () Reason (if not attached):

N/A FOR 2002 YET

Trade References (list at least three (3) current food or grocery suppliers:

Name of Supplier and Address	Phone No. w/Area Code	Account Number
1. <u>MCLAIN FOODS</u>	<u>888-792-9300</u>	<u>239 663</u>
2. <u>KAHN PAPER</u>	<u>301 499 1700</u>	<u>101 245 001</u>
3. <u>US FOODS</u>	<u>800 547-8628</u>	<u>160801-7</u>

(if faxing return to attn: Dave Wise, Credit Manager 717-399-8584)

Page 2

Keeps Foods, LLC Credit Application

Bank Reference(s):

Name: 301-887-6000 VICKY TANGE
 Address: 10150 RIVER RD POTOMAC MD 20854
 Phone No. w/Area Code: 301-887-6000 Contact: 1404304282
 Account #: 50081902
RIGGS BANK (HARLAND)

Additional Information: CHEVY CHASE BANK 4000 WISCONSIN AV DC 20016
202-237-1911 DIERDRE CURRISTIN

I/We hereby authorize Keeps Foods, LLC to investigate the references listed pertaining to my/our credit & financial responsibility, both on the business, as well as its principals, and also authorize references to release applicable information to Keeps Foods, Inc.

Conditions in consideration of any open account terms granted to applicant by Keeps Foods, LLC, applicant agrees to pay in accordance with the terms extended by Keeps Foods, LLC, which appear on its invoice, and also agrees to pay a finance charge on any balances not paid when due. The finance charge shall be imposed upon the past due principal balance at the rate of 1 1/4 percent per month. The applicant also agrees to pay expenses incidental to the collection of any past due amounts, including reasonable attorney's fees.

This application must be signed by the sole proprietor, a general partner, or by an authorized officer. In any event, the person signing this application certifies he/she has the authority to enter into a binding contract on behalf of the applicant.

Applicant's Name: (please print) SOFT SERVE INC

Authorized Signature: [Signature]

Title: PRESIDENT

Date: AUG 3, 2003

Phone Number w/Area Code: 703 748 0978

Fax Number w/Area Code: 301 299 8415

E-mail Address: TOM ORBAN @ EROLS.COM

FOR INTERNAL USE ONLY

Class of Trade _____

Sales Volume _____

Credit Approved () Denied ()

High Credit Extended _____

Terms _____

Initial _____

Date _____

VS DEC. EX 21

1 ask some questions, I suggest since you were
2 a stickler for the rules that you do it on
3 your time.

4 MR. VANDE SANDE: I will do it
5 right now on my time right now.

6 MR. BEN-VENISTE: The depo is over.

7 MR. VANDE SANDE : No, I am sorry.
8 Richard, this is --

9 MR. BEN-VENISTE: This is 6:30. I
10 have accommodated you by finishing in the day
11 because you didn't want to go over and now
12 you want to ask questions beyond the seven
13 hours.

14 MR. VANDE SANDE : I am asking two
15 questions that will take less than the time
16 we have had right now.

17 EXAMINATION BY MR. VANDE SANDE:

18 Q Mr. Orban, was Soft Serve using the
19 Sprinkles name and mark as of the summer
20 2002?

21 A Yes.

22 Q Was that usage in connection with

1 not only ice cream and yogurt goods, but also
2 baked goods?

3 A Yes.

4 Q Has that usage been continuous
5 under the Sprinkles mark in connection with
6 baked goods since that time?

7 A Yes.

8 MR. VANDE SANDE: Thank you.

9 MR. BEN-VENISTE: Well, you were
10 true to the brevity of these redundant
11 questions.

12 THE VIDEOGRAPHER: This ends disk
13 number 5 and concludes the testimony of
14 Thomas Orban in the matter of Soft Serve
15 Incorporated versus Sprinkles. The date is
16 May 10, 2012, the time is 6:23:48. Off the
17 record.

18
19 (Whereupon, the deposition
20 concluded at 6:23 p.m.)

21
22

VS DEC. EX 22

SPRINKLES

Ice cream, donuts, muffins, bagels

- Frozen Yogurt
- Wow Cow™
- Carbo Lite™
- Java Coast Fine Coffees (hot or iced)
- Bethesda Bagels
- Holiday Cakes & Pies

**Fresh Donuts, Bagels, Muffins
and Coffee Daily**



Potomac Place
Falls & River Rds.

301-299-8415

\$1 OFF
Any
Ice Cream
Soda

with coupon
expires 5/31/03

FREE
Bagel Or
Donut

with purchase of medium coffee

with coupon
expires 5/31/03

HALF PRICE
ANY CONE
THOMAS SWEET™
ICE CREAM

with coupon
expires 5/31/03

ADVERTISE WITH MONEY MAILER, CALL (301) 294-0364
368-21-703

Find us at: www.moneymailer.com
368-21-0137/368-21-703/549410 02003 Money Mailer, LLC



VS DEC. EX 23

1 original email from you, any response.

2 MR. BEN-VENISTE: I would ask that
3 those be produced. Let's move on since you
4 are eager to finish today.

5 BY MR. BEN-VENISTE:

6 Q Is it fair to say that your store
7 is generally known, and "by your store," I
8 mean the Potomac Shopping Center store, is
9 known as an ice cream store?

10 A Absolutely -- well, it is also
11 known as an ice cream store, however it is
12 open from 5:00 in the morning we are there
13 every day of the week 365 days of the year
14 and nobody is eating ice cream at 5:00 in the
15 morning, or at 6:00 or at 7:00, or at 8:00,
16 or at 9:00, or at 10:00, or 11:00 or at
17 12:00.

18 And all of those hours that were
19 open every day of the year we are selling
20 baked goods.

21 MR. VANDE SANDE : I am sorry,
22 could you read back the beginning of the

VS DEC. EX 24

1 with.

2 Q You were baking cupcakes?

3 A Yes. Actually, we had been baking
4 all kinds of things for at least a decade.

5 Q Are you capable of listening to my
6 question and answer --

7 A Was I baking cupcakes? Yes.

8 Q So in the article where it says the
9 first big change in Sprinkles has already
10 taken place last week they started selling
11 home made cupcakes?

12 A That is just inaccurate.

13 Q Did you complain?

14 A No, it is just a newspaper article.

15 Q You have been baking cupcakes in
16 your store for quite some time. That is your
17 testimony?

18 A Before Angela came on board, yes.
19 Have you ever read anything accurate in a
20 newspaper? About yourself even?

21 Q You have yet to take my deposition,
22 but not today. So when did you install an

1 the sales tax department should I ever be
2 audited.

3 Q Have you ever been audited?

4 A Yes.

5 Q When?

6 A Very early in my business. I
7 wasn't more than a year or two old when I was
8 audited.

9 Q Have you ever been audited for the
10 Potomac store?

11 A Maybe because it was the Maryland
12 Tax Department that audited me and I just
13 don't know whether Potomac was opened by then
14 or not. They came to the house in Olney. I
15 think it was. I think it was by then open.

16 Q Why don't you just show cupcakes?
17 Why it wasn't this baked? You have bagels,
18 donuts, coffee, soft drinks.

19 A Yes, because I have sold other
20 things. I have sold pies. I have sold any
21 number of baked goods that don't fall within
22 the narrow category of bagel or donut or

1 A That is probably all lately.

2 Things that we have sold over the years like
3 croissants and pies, apple pies.

4 Q Help me out here. You're on Friday
5 the 17th. You haven't sold any cupcakes but
6 you baked cupcakes in the morning?

7 A Yes, we do. Just every day we bake
8 them.

9 Q Then what happened to the cupcakes
10 you baked on Friday?

11 A Well, they probably got eaten by
12 somebody. I give it away.

13 Q You had a reduced section for sale,
14 right, a reduced price in your showcase?

15 A We do lately sell bagels and donuts
16 at a reduced price. Some in the showcase and
17 some in front of the register.

18 Q But not cupcakes?

19 A Only very rarely have we sold
20 reduced cupcakes. What I have been doing
21 because I am there a lot in the evening, is I
22 take all the day old cupcakes and I wait for

1 ask some questions, I suggest since you were
2 a stickler for the rules that you do it on
3 your time.

4 MR. VANDE SANDE: I will do it
5 right now on my time right now.

6 MR. BEN-VENISTE: The depo is over.

7 MR. VANDE SANDE : No, I am sorry.
8 Richard, this is --

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19 Sprinkles name and mark as of the summer
20 2002?

21 A Yes.

22 Q Was that usage in connection with

1 not only ice cream and yogurt goods, but also
2 baked goods?

3 A Yes.

4 Q Has that usage been continuous
5 under the Sprinkles mark in connection with
6 baked goods since that time?

7 A Yes.

8 MR. VANDE SANDE: Thank you.

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15 Incorporated versus Sprinkles. The date is
16 May 10, 2012, the time is 6:23:48. Off the
17 record.

18

19 (Whereupon, the deposition
20 concluded at 6:23 p.m.)

21

22

VS DEC. EX 25

1 oven for the purpose of baking?

2 A We had an oven in there for -- we
3 have always had an oven in the store even
4 during the period of "I Can't Believe It's
5 Yogurt" period.

6 Q Who was in charge of baking the
7 cupcakes before Ms. Zyre came along?

8 A Some of the staff including me. We
9 did it in-house.

10 Q So who on the staff?

11 A I don't remember.

12 Q Did the sign that announced
13 cupcakes for sale, the first sign that
14 announced cupcakes for sale on your exterior
15 signage was the cupcakes sign for which we
16 have no invoice which you estimate was
17 installed in 2009?

18 A After Angela came on board, yes,
19 some time after that.

20 Q So Angela Zyre came on board unless
21 the article is erroneous you know more about
22 March 2000, sorry, in April 2009?

VS DEC. EX 26

1 with.

2 Q You were baking cupcakes?

3 A Yes. Actually, we had been baking
4 all kinds of things for at least a decade.

5 Q Are you capable of listening to my
6 question and answer --

7 A Was I baking cupcakes? Yes.

8 Q So in the article where it says the
9 first big change in Sprinkles has already
10 taken place last week they started selling
11 home made cupcakes?

12 A That is just inaccurate.

13 Q Did you complain?

14 A No, it is just a newspaper article.

15 Q You have been baking cupcakes in
16 your store for quite some time. That is your
17 testimony?

18 A Before Angela came on board, yes.
19 Have you ever read anything accurate in a
20 newspaper? About yourself even?

21 Q You have yet to take my deposition,
22 but not today. So when did you install an

VS DEC. EX 27

1 invoice to you, Soft Serve on River Road that
2 is dated October 30, 2002, correct?

3 A Correct?

4 Q That is OP-5214, correct?

5 A Well, what is correct, sir?

6 Q 5214?

7 A Yes.

8 Q It says "one neon sign"?

9 A (Non-verbalized response.)

10 Q What is that neon sign?

11 A I would be guessing at what that
12 one was.

13 Q What could it be?

14 A It could have been the bagel sign.

15 Q The bagel?

16 A Yes, 156 bucks.

17 Q One graphics?

18 A Actually, that is too cheap. I
19 don't know what that one was.

20 Q You have one graphics, \$25?

21 A Yes.

22 Q What was that?

1 A I don't know. Ah, the transformer
2 is built separately. Yes, the neon and the
3 transformer together that was likely the sign
4 that said bagels.

5 Q That wasn't the sign that said
6 Thomas Sweet?

7 A No, no. That was a neon.

8 Q Then it says, "In shop repair to
9 customers item." What was that?

10 A Well, I took the sign down from the
11 front of my store that said yogurt and took
12 that sign, you have photographs of it, to
13 Sterico and they refurbished that sign and
14 turned it into the sign that we have up there
15 now that says Sprinkles.

16 So all they did was what they
17 characterized in the invoice as a repair.

18 Q A repair and there was no prior art
19 that was produced to show what it was they
20 were going to do?

21 A Oh, they may have had some
22 internally, but I don't have it in my file.

VS DEC. EX 28

Sprinkles

has been pre-approved to order up to \$250 on Open Account.
 Your credit is good with us. Send no money now; we'll bill you later.

For Fastest Service – Order Online at www.orderpens.com. Your Promo Code is 2F5XAC1A

SUSAN KIPLAGT
 SPRINKLES
 10148 RIVER RD
 POTOMAC MD 20854-4903

Dear Susan Kiplagt,

I designed and produced the enclosed full-color sample especially for you.

It was a labor of love, and I hope you agree it looks terrific. Actually my whole company is buzzing with excitement for you. Everyone who saw your pen loved it!

I took the liberty of producing this custom-designed sample to make a dramatic statement and to demonstrate to you how important your account is and will be to my company and me. I'm sure you'll agree you've never seen anything like this before. My patented graphic process is creating a real buzz in the promotional pen industry!

With your first order you'll understand why others say this is **THE most effective promotional tool you will ever use**. It's colorful. It's compelling. And it demands attention for you.

As a special promotion for your company, I've dropped our standard requirement of the 1500-pen minimum for fully customized designs like your sample pen. This provides you with the flexibility to place a large order or a small one – I really want your business.

Also, to make this offer irresistible, I'll also give you...

100 Business Image Pens for ONLY 39¢ EACH!
Save more than \$1.00 off regular prices!

Just give us a call at 800/854-1000 if you have any questions or send me your order today. I really want to be your promotional product supplier. Rest assured, your purchase must be free of defects and produced exactly to your specifications. NO STRINGS ATTACHED. National Pen has been a direct-selling manufacturer for over 45 years, so you can be sure of our quality and guarantee.

Best Regards,

Dave Thompson

Dave Thompson, CEO

P.S. Demand for this product is very strong and my patented printing process is running at full production. For the next 10 days, I will reserve capacity for you and rush your order out as soon as I get it. I'll bill you later but please order quickly and stock up. I may never repeat this offer again, and no one else has a process like mine, so do act now.

VISIT OUR ONLINE CATALOG
WWW.PENS.COM

It's Simple to Place your Order! Here's How:

- **No changes?** --If you have no changes to your imprint or image, just give us a call, send in or fax your order form. OR go to www.orderpens.com (your Promo Code is 2F5XAC1A).
- **Changes to the Imprint only?** --Make text changes in "Your Business Image Pen Imprint" section below and give us a call or send in the Order Form indicating the quantity and ink color you desire.
- **Changes To or Redoing your image?** --It's easy! Just give us a call and we'll help you create custom art just for you. (Add \$25 for image changes or additions.)

Detach here and return this Order Form in the enclosed envelope.



Please rush out my new FULL-COLOR BUSINESS IMAGE Pens and bill me later. My satisfaction is 100% guaranteed!

- 1. Quantity** (Check One Only.)
- 100 @ \$1.49 ea. 39¢ each
 - 150 @ \$1.45 ea. 38¢ each
 - 250 @ \$1.43 ea. 37¢ each
 - 500 @ \$1.39 ea. 36¢ each
 - 1000 @ \$1.35 ea. 35¢ each

- 3. Ink Color** (Check One Only.)
- Blue
 - Black

2. Track Your Shipment

Please provide your Email Address to receive Online tracking information regarding your order:

★ P76553481AC1A06 ★

SUSAN KIPLAGT
 SPRINKLES
 10148 RIVER RD
 POTOMAC MD 20854-4903

Hurry, this Offer Expires in 30 Days!

CTW-XXX-XCSWK-BB 07/08/11 US-CTWPRO5

Please allow a \$14.95 set up charge plus delivery/handling charge.

4. Your Business Image Pen Imprint

No charge for imprint changes (name, address, city, state, zip or phone). For image changes or additions, add \$25. Please print clearly.

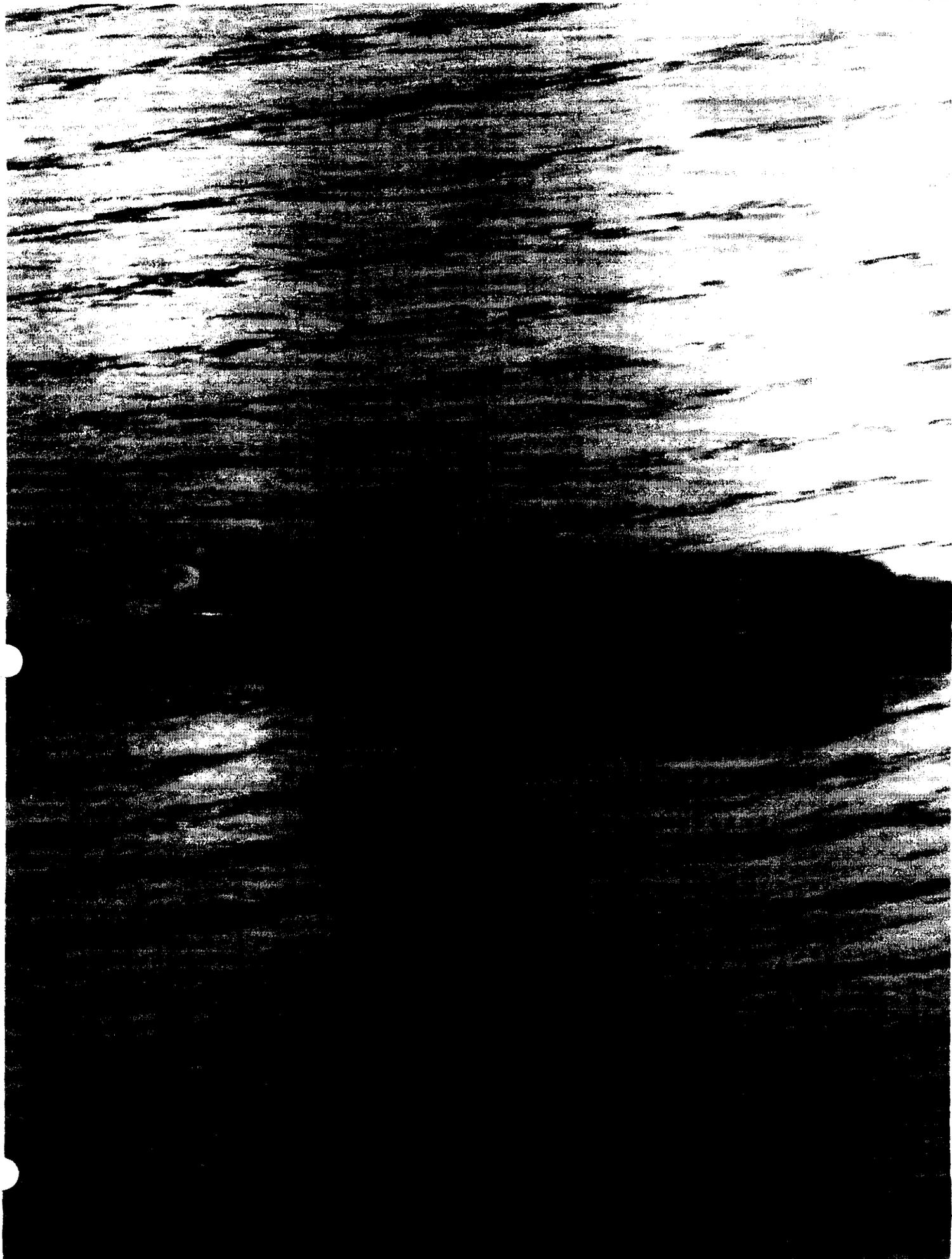


5. Ordered By Name and valid Phone Number required to process order.

()

PRINT Your Name Area Code Day Phone Number

Sprinkler



VS DEC. EX 29

1 associated with Sprinkles Cupcakes?

2 A You're asking me whether that would
3 hurt my store? Is that your question?

4 Q Yes.

5 A I think it could. The answer is
6 yes.

7 Q How?

8 A By competing with me.

9 Q How? Someone has come to your
10 store and they you might be associated with
11 Sprinkles Cupcakes and how did that hurt you?

12 A (No response.)

13 Q Mr. Orban, if you're tired and you
14 want to take a break we can do that?

15 A No, I am fine. I can't think of
16 you know the economic damage, but I don't --
17 I don't like, personally, if I understand the
18 word "hurt," having customers come in
19 confused about my identity that I have worked
20 to build up over a dozen years, yes, that
21 hurts me.

22 Q You get the opportunity to have