

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

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Opposition No. **91194188**
Opposition No. 91195669
Opposition No. 91195985
Opposition No. 91195986
Opposition No. 91196035
Opposition No. 91196061
Opposition No. 91196087
Cancellation No. 92053109
Cancellation No. 92054376
Cancellation No. 92054401

Soft Serve, Inc. d/b/a
Sprinkles

v.

Sprinkles Cupcakes, Inc.

(as consolidated)

Before Kuhlke, Mermelstein, and Kuczma,
Administrative Trademark judges,

By the Board:

In Cancellation No. 92053109, plaintiff seeks to cancel defendant's Registration No. 3306772 for the mark SPRINKLES in standard character form for "bakery goods" in International Class 30 and "retail shops featuring baked goods" in International Class 35¹ on the ground of priority/likelihood of confusion with its previously used trade name and mark SPRINKLES for "baked goods and retail

¹ Such registration was issued on October 9, 2007, based on a use-based application that defendant filed on March 3, 2006.

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stores selling same." Defendant, in its answer, denied the salient allegations of the petition to cancel and asserted affirmative defenses. The above-captioned proceedings other than Cancellation Nos. 92054376 and 92054401 were consolidated in a March 4, 2011, Board order. Cancellation Nos. 92054376 and 92054401 are consolidated *infra*.

On August 11, 2011, plaintiff filed a motion for summary judgment in Cancellation No. 92053109.² See Trademark Rule 2.119(c). After the Board granted defendant leave to take discovery under Fed. R. Civ. P. 56(d), the motion for summary judgment was fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party

² The motion for summary judgment was filed five weeks after the Board issued its July 6, 2011, order granting in part plaintiff's motion to compel discovery and with eight weeks remaining in the discovery period in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109.

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must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F. 2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a party moving for summary judgment in its favor on its Section 2(d) claim, plaintiff must establish that there is no genuine dispute that (1) it has standing to maintain this proceeding; (2) that it is the prior user of its pleaded mark or trade name; and (3) that contemporaneous use of the parties' respective marks in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

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Turning to the likelihood of confusion issue, two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods and services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). With regard to the marks at issue herein, defendant's involved SPRINKLES mark is registered in standard character form, whereas plaintiff's pleaded mark is SPRINKLES in a specific stylized form. Because a mark in standard character form covers any presentation of that mark, the parties' marks are legally identical for purposes of this motion. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011).

With regard to the goods and services at issue, defendant's attempt in its brief in response to limit itself to a "super-premium brand" of its identified goods and services is not well-taken.³ In Board proceedings, the issue of likelihood of confusion is determined based on an analysis of the goods and services recited in defendant's registration vis-à-vis what the evidence of record shows the goods and services pleaded in plaintiff's petition to cancel

³ Likewise, defendant's use of its mark on cupcake mixes that are sold in Williams-Sonoma stores is not at issue in this proceeding and is irrelevant thereto. See TBMP Section 414(11) (3d ed. rev. 2012).

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to be, rather than what defendant's goods and services are asserted or shown to actually be. See, e.g., *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, in deciding this motion, the Board must presume that the scope of defendant's involved registration encompasses all goods and services of the nature and type described, that the identified goods and services move in all channels of trade that would be normal for such goods and services, and that the goods and services would be purchased by all potential customers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Defendant asserts in its answer⁴ in Cancellation No. 92053109 and in its brief in response to plaintiff's motion for summary judgment that it has "superior rights" in the SPRINKLES mark and variations thereof based in part on its acquisition on July 21, 2009 of "further rights to SPRINKLES-related marks, including" Registration Nos.

⁴ Defendant in response to the motion for summary judgment alleges an affirmative defense of unclean hands based on plaintiff's activities in 2009 with regard to marketing cupcakes. However, defendant did not plead an unclean hands defense in its answer and thus cannot rely thereupon in opposition to the motion for summary judgment. See TBMP Sections 314 and 528.07(a).

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2938800 and 3004757, and common law rights that "date back to as early as 1985 ... from an ice cream and baked goods store that had been in operation for" more than twenty years.⁵ To the extent that defendant seeks to rely upon Registration Nos. 2938800 and 3004757 and its common law rights in the marks that are the subject of those registrations, defendant may not rely upon those registrations and common law rights in the marks in those registrations in defense of the motion for summary judgment to defeat plaintiff's claim of priority through tacking. In particular, the marks in those registrations are not the legal equivalent of, or indistinguishable from, defendant's involved SPRINKLES mark, and the goods and services in those registrations are not substantially identical to the goods

⁵ Registration No. 2938800 is for the mark SPRINKLES OF PALM BEACH in typed form for "ice cream" in International Class 30. That registration was issued on April 5, 2005 and alleges October 2002 as the date of first use anywhere and date of first use in commerce. The registration includes a disclaimer of OF PALM BEACH. Section 8 affidavit filed, Section 15 affidavit acknowledged.

Registration No. 3004757 is for the mark SPRINKLES PALM BEACH and design in the following form:



for "retail store services featuring ice cream" in International Class 35. That registration was issued on October 4, 2005 and alleges October 2002 as the date of first use anywhere and date of first use in commerce. The registration includes a disclaimer of PALM BEACH. Section 8 affidavit filed, Section 15 affidavit acknowledged.

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and services in defendant's involved registration.⁶ See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991), *aff'g* 18 USPQ2d 1804 (TTAB 1990); *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991).

Further, the trademark assignment and license agreement, dated July 21, 2009, between defendant, Sprinkles of Palm Beach owner Donna Marks, and Therapy Too, Inc., which was submitted as an exhibit to Ms. Marks's declaration, conveys only the marks SPRINKLES OF PALM BEACH

⁶ Under *Van Dyke-Crotty, Inc.*,

[t]he previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark. ... [E]ven if the two marks are confusingly similar, they still may not be legal equivalents. ... Instead, the marks must create 'the same, continuing commercial impression,' and the later mark should not materially differ from or alter the character of the mark attempted to be 'tacked.'

Van Dyne-Crotty Inc., 17 USPQ2d at 1868 (quoting *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 1224, 188 USPQ 485, 487 (CCPA 1976), and citing 1 J. Gilson, *Trademark Protection and Practice* §3.03[1] at 3-67-68 (1990)).

Even if we assume that the wording PALM BEACH in the registered marks is geographically descriptive, the inclusion of that wording in those marks makes those marks legally different from the SPRINKLES in standard character form mark in defendant's involved registration for tacking purposes. See *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039 (TTAB 1989) (even where both marks "are dominated by the word AMERICAN and the same star and double bar design," AMERICAN MOBILEPHONE and design and AMERICAN MOBILEPHONE PAGING and design found to be "legally different"). Further, the inclusion of a design element in the mark in Registration No. 3004757 renders that registered mark materially different from the SPRINKLES in standard character form mark in defendant's involved registration. See *Van Dyne-Crotty Inc.*, *supra*.

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and SPRINKLES PALM BEACH and design and the two registrations for those marks to defendant. That agreement did not expressly convey common law rights in the word mark SPRINKLES standing alone to defendant. Thus, defendant's assertion that it has rights in the SPRINKLES mark which date back to at least as early as 1985 is unsupported by the current record. Rather, for purposes of this motion, defendant is left to rely upon its own first use of the registered mark, i.e., February 1, 2004, for its identified goods in International Class 30 and April 13, 2005, for its recited services in International Class 35.

Plaintiff's pleaded goods and services are pleaded in the petition to cancel as "baked goods and retail store for selling same." Plaintiff's pleaded services, as identified in the petition to cancel, are essentially bakery services.⁷ Thus, in deciding plaintiff's motion for summary judgment, we decline to treat plaintiff's pleaded services as being any retail store that happens to sell baked goods.⁸ The

⁷ A bakery is "[a]n establishment where baked goods are prepared or sold." *Webster's II New College Dictionary* at 84 (1995 ed.). For purposes of deciding plaintiff's motion for summary judgment, we take judicial notice of this dictionary definition. See *Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁸ For purposes of this motion, plaintiff's pleaded "retail stores for selling" baked goods is vague because such stores could conceivably encompass any retail stores from coffee shops to

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evidence of record herein indicates that, while plaintiff, which may have operated its retail store under the trade name or mark SPRINKLES since possibly as early as April 2002, sold some baked goods, plaintiff's retail store services feature other products, such as ice cream, frozen yogurt, smoothies, coffee, and cappuccino, which suggest that plaintiff's actual services were more in the nature of an ice cream shop during the time period necessary to establish priority.⁹ Indeed, an excerpt from the January 2004 Verizon SuperPages, which defendant submitted as an exhibit to its brief in response, shows plaintiff's telephone number listed in the category "Ice Cream & Frozen Desserts-Dealers." Plaintiff cannot rely upon unpleaded services in support of its motion for summary judgment and its Section 2(d) claim in this proceeding.¹⁰ See TBMP Sections 314 and 528.07(a). Thus, we find that there is a

supermarkets to convenience stores to department stores. Plaintiff appears to have drafted the petition to cancel in Cancellation No. 92053109 so that its pleaded goods and services are essentially identical to the recited goods and services in defendant's involved registration; however, the evidence of record does not indicate that the parties' services are identical.

⁹ The record indicates that plaintiff had been a franchisee of I Can't Believe It's Yogurt.

¹⁰ If plaintiff wants to rely on ice cream shop services or other services in support of its pleaded claim under Trademark Act Section 2(d), it must amend its petition to cancel to so plead. See Fed. R. Civ. P. 15(a); TBMP Section 507.02.

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genuine dispute as to the nature of plaintiff's services at the time necessary to establish its prior use of the SPRINKLES mark.¹¹

In view of the the foregoing, and in view of vague and inconsistent statements in the record regarding plaintiff's alleged prior use of its pleaded mark, and bearing in mind that any reasonable doubt must be resolved in defendant's favor, we find that plaintiff has not met its burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to entry of judgment on its Trademark Act Section 2(d) claim as a matter of law.¹² In view thereof, the motion for summary judgment is

¹¹ Contrary to defendant's's assertion, plaintiff need not establish a specific date of first use; it need only establish that its use of its mark precedes that of defendant or that plaintiff owns a registration for that mark. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Plaintiff does not need a federal registration and can rely solely upon prior use to prevail on its claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). See *id.* Further, even if we assume that plaintiff's use of its pleaded mark is purely intrastate, such use would be sufficient to prevail on a Section 2(d) claim. See *Panda Travel Inc. v. Resort Option Ent. Inc.*, 94 USPQ2d 1789 (TTAB 2009). And even if we assume, as defendant argues, that it adopted the SPRINKLES mark in good faith, such good faith does not preclude a finding of likelihood of confusion. See *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1571 (TTAB 2007).

¹² For example, plaintiff has submitted copies of four cancelled checks dated between March 9, 2003, and August 5, 2003, for an amount totaling \$8779.66 with the word SPRINKLES handwritten above the account holders's name and address, which Mr. Orban avers are "representative checks from the pre-February 1, 2004 era evidencing [plaintiff's] purchase of various bakery goods that were then resold by [plaintiff] under the SPRINKLES mark." Orban declaration at paragraph 2 and exhibit 70 thereto.

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denied.¹³ The Board, in exercising its inherent authority to control the scheduling of its proceedings, will not consider any further motions for summary judgment in these consolidated proceedings.

Cancellation Nos. 92054376 and 92054401 have been suspended pending the Board's decision on the motion for summary judgment in Cancellation No. 92053109. Because Cancellation Nos. 92054376 and 92054401 and the remaining

However, defendant has submitted more than forty cancelled checks from April 2002 to January 2004 which are made out by plaintiff apparently for purchases of bakery goods that do not include the word SPRINKLES anywhere. In addition, although Mr. Orban testifies in his discovery deposition to use of the SPRINKLES mark in connection with baked goods since summer of 2002, plaintiff has failed to provide annual sales figures for baked goods sold under the SPRINKLES mark beyond providing total annual sales figures and Mr. Orban's statement that sales of bakery goods comprise one-third of plaintiff's business. Although plaintiff, in Mr. Orban's declaration, has also submitted copies of stickers showing the SPRINKLES mark, which are for affixation to boxes and bags in which bakery goods are provided to customers, Mr. Orban does not aver specifically in that declaration when the stickers of record were used.

Defendant also submitted declarations of plaintiff's former employees, Aaron Yoches and Saira Haider. Ms. Haider avers to use of SPRINKLES as the store name as early as the "the end of March 2002," but Mr. Yoches avers only to use of SPRINKLES as the store name by the end of the summer of 2002. Moreover, while Ms. Haider avers in her declaration that SPRINKLES was in use on product stickers during the summer of 2002, e-mails between Mr. Yoches and plaintiff's attorney indicate that Mr. Yoches expressly removed that statement from his declaration. Both former employees aver to sales of bakery goods at the SPRINKLES store during the summer of 2002; however, the former employees do not aver to sale of bakery goods *under* the SPRINKLES mark in the SPRINKLES store in that time.

¹³ Evidence submitted in connection with the motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. See TBMP Section 528.05(a).

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above-captioned proceedings involve the same parties and common questions of law or fact, the Board hereby orders their consolidation.¹⁴ See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP Section 511. The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91194188 as the "parent" case. As a general rule, from this point onward, only a single copy of any submission should be filed herein. That copy, however, should include all of the consolidated proceeding numbers in the caption thereof.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

¹⁴ If any more proceedings between the parties are commenced, the parties should notify the Board immediately so that the Board can consider whether to consolidate those proceedings with any or all of the parties' pending proceedings.

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Proceedings herein are resumed. Plaintiff is allowed until thirty days from the mailing date set forth in this order to inspect and copy the materials produced in accordance with the Board's July 6, 2011, order compelling discovery, as provided for in Fed. R. Civ. P. 34(b) and Trademark Rule 2.120(d)(2), unless the parties otherwise agree. The discovery period in Opposition No. 91194188 and Cancellation Nos. 92054376 and 92054401 remains closed. Dates in these consolidated proceedings are reset as follows.

Expert Disclosures Due in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109	1/23/13
Discovery Closes in Opposition Nos. 91195669, 91195985, 91195986, 91196035, 91196061, and 91196087 and Cancellation No. 92053109	2/22/13
Plaintiff's Pretrial Disclosures Due in All Proceedings	4/8/13
Plaintiff's 30-day Trial Period Ends in All Proceedings	5/23/13
Defendant's Pretrial Disclosures Due in All Proceedings	6/7/13
Defendant's 30-day Trial Period Ends in All Proceedings	7/22/13
Plaintiff's Rebuttal Disclosures Due in All Proceedings	8/6/13
Plaintiff's 15-day Rebuttal Period Ends in All Proceedings	9/5/13

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits,

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must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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

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