

TTAB

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

Atty. Dkt. 4221.008

Applicant: Sprinkles Cupcakes, Inc.

Mark: Serial No. 77/866,405 for "SAY IT WITH SPRINKLES"

TRANSMITTAL OF NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313

Sir:

Enclosed herewith please find the following items:

- (1) Notice of Opposition - Original and 1 copy
- (2) Transmittal and 1 copy
- (3) Check

Enclosed herewith please find a check for \$300 to cover the cost of filing a Notice of Opposition in Class 35 only for the above-identified subject matter. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-4169. A duplicate of this letter is attached.

Respectfully submitted,

HALL & VANDE SANDE, LLC

By: _____

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

Date: _____

8/4/10

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

Atty. Dkt. 4221.008

Serial No. 77/866,405
Mark: "SAY IT WITH SPRINKLES"
International Class: 35
Filed: November 5, 2009
Published: April 6, 2010

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

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313

Sir:

Soft Serve, Inc. d/b/a Sprinkles (hereinafter "Sprinkles" or "Opposer"), a Maryland corporation, located and doing business at 10148 River Road, Potomac, Maryland 20854, believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes same.

As grounds of Opposition, it is alleged that:

1. Opposer Sprinkles has, for many years, and long prior to the filing date of U.S.

Trademark Application Serial No. 77/866,405, used and has continued to use

“SPRINKLES” in connection with various goods and services, including ice cream, frozen yogurt, baked goods, candy and sweets, and retail sales services and catering services in connection with the sale of such goods, as well as various items of clothing.

2. Opposer Sprinkles has used the mark “SPRINKLES” in the United States in connection with its various goods and services since at least as early as November 2002.
3. Opposer Sprinkles uses “SPRINKLES” as its trade name under which it provides goods and services.
4. Opposer Sprinkles has used, without interruption or abandonment, “SPRINKLES” as a trade name since at least as early as November 2002.
5. Opposer Sprinkles’ use of “SPRINKLES” as a mark and trade name predates Applicant’s filing date and any use by Applicant of “SAY IT WITH SPRINKLES”.
6. Substantial secondary meaning in “SPRINKLES” has been established due to its long and widespread use and promotion by Opposer as a trademark, service mark, and trade name. The mark “SPRINKLES” is a symbol of considerable good will and recognition built up by Opposer through substantial amounts of time and effort.
7. Applicant, Sprinkles Cupcakes, Inc., is the owner of U.S. Trademark Application Serial No.77/866,405 for the mark “SAY IT WITH SPRINKLES” for use in connection with retail shops featuring baked goods in International Class 35.
8. Applicant’s “SAY IT WITH SPRINKLES” mark so resembles Opposer’s mark and trade name as identified above in significance, general appearance, commercial

impression, and verbal identification so as, when used on or in connection with Applicant's recited services, to be likely to cause confusion, to cause mistake, and to deceive.

9. On information and belief, the services recited in Applicant's '405 application are offered and/or are to be offered in the same channels of trade as the goods and services offered by Opposer.
10. On information and belief, Opposer avers that the registration of the mark of U.S. Trademark Application Serial No. 77/866,405 would work to Opposer's disadvantage and would harm and damage Opposer in that the goodwill attached to the "SPRINKLES" mark and trade name of Opposer would likely be extended to Applicant without Opposer's consent, thereby benefiting Applicant rather than Opposer.
11. Opposer would be damaged through the issuance of a registration for "SAY IT WITH SPRINKLES" to Applicant which includes Applicant's recitation of services, as such registration would provide *prima facie* evidence of Applicant's right to use and have registered to it a mark which would falsely suggest a connection between Applicant and Opposer.
12. On information and belief, Opposer avers that in the eyes and minds of a large part of the public, the mark "SAY IT WITH SPRINKLES" as recited in U.S. Trademark Application Serial No. 77/866,405 is closely associated with the goods and services with which Opposer has used and is using "SPRINKLES"; that Applicant's use of the mark "SAY IT WITH SPRINKLES" in connection with the services recited in the

'405 application creates or will create a likelihood of confusion and creates or will create a likelihood of deception of the public by causing the public, upon seeing "SAY IT WITH SPRINKLES" so used, to believe that Applicant's recited services are in reality Opposer's services, or services offered and/or sold by Opposer or offered under the sponsorship, control or direction of Opposer; that such is likely to interfere with or embarrass Opposer; and that registration of the mark of U.S. Trademark Application Serial No. 77/866,405 will result in damage to Opposer and confusion and deception of the public.

WHEREFORE, Opposer prays that said U.S. Trademark Application Serial No. 77/866,405 be rejected and that no registration be issued to Applicant for its mark, and that this Notice of Opposition be sustained in favor of Opposer.

Respectfully submitted,

HALL & VANDE SANDE, LLC

Date: _____

8/4/10



Thomas J. Vande Sande
Attorneys for Opposer
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(301) 983-2500

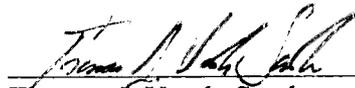
CERTIFICATE OF SERVICE

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

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

Date:

8/4/10



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