ESTTA Tracking number: **ESTTA395570**
Filing date: **02/28/2011**

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

| | |
|---|---|
| Proceeding | 91196035 |
| Party | Defendant<br>Sprinkles Cupcakes, Inc. |
| Correspondence Address | HOLLIS BETH HIRE<br>WILSON SONSINI GOODRICH & ROSATI<br>650 PAGE MILL ROAD<br>PALO ALTO, CA 94304-1050<br>UNITED STATES<br>trademarks@wsgr.com |
| Submission | Other Motions/Papers |
| Filer's Name | Hollis Beth Hire |
| Filer's e-mail | hhire@wsgr.com |
| Signature | /Hollis Beth Hire/ |
| Date | 02/28/2011 |
| Attachments | SAY IT WITH SPRINKLES 035.pdf ( 6 pages )(22568 bytes )<br>COS.pdf ( 1 page )(24889 bytes )<br>Decl -- Opp.pdf ( 2 pages )(7698 bytes )<br>Too voluminous.pdf ( 1 page )(3012 bytes ) |

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

| | | |
|---|---|---|
| Soft Serve, Inc. d/b/a Sprinkles, | ) | |
| Opposer, | ) | Opposition No: 91196035 |
| v. | ) | Mark: SAY IT WITH SPRINKLES |
| Sprinkles Cupcakes, Inc., | ) | |
| Applicant. | ) | |

**SPRINKLES CUPCAKES' MOTION TO SUSPEND THE PROCEEDINGS**

## I. INTRODUCTION

Sprinkles Cupcakes, Inc. ("Sprinkles") hereby moves this Board, pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §510, to suspend the above-captioned proceeding, either pending the disposition of Soft Serve, Inc.'s ("Soft Serve") motion to compel, filed in a related proceeding (Opposition No. 91194188 (the "Primary Opposition")), or pending resolution of the Primary Opposition itself.[1]

Soft Serve has filed seven oppositions against Sprinkles' applications, all incorporating the SPRINKLES mark. In addition, Soft Serve has petitioned to cancel Sprinkles' registration for the SPRINKLES mark. Because the issues in each SPRINKLES-related proceeding are so similar, Soft Serve's counsel requested that discovery in one proceeding be used in all other proceedings. Sprinkles agreed to proceed in this manner. Relying on this arrangement, the parties have so far conducted discovery in the Primary Opposition only. *See* Declaration of Hollis Beth Hire submitted herewith ("Hire Decl.") ¶¶ 2, 7-8 and Exs. E-F. For this reason, discovery issues raised in the Primary Opposition impact all other related proceedings, including the above-captioned

[1] Soft Serve's motion to compel certain discovery responses was filed on December 10, 2010. The motion has been fully briefed by the parties.

proceeding. Sprinkles therefore respectfully requests that this proceeding be suspended at least until Soft Serve's motion to compel in the Primary Opposition is resolved.[2]

## II. BACKGROUND

### A. The Parties

Sprinkles is a well-known cupcake bakery with retail stores selling cupcakes in eight locations across the U.S. and a Sprinkles-branded cupcake mix available at Williams-Sonoma stores across North America. Sprinkles has been featured in *The Oprah Winfrey Show*, *Good Morning America*, The Food Network, *Access Hollywood* and *Entertainment Tonight*, as well as in *The New York Times*, *Los Angeles Times*, *Bon Appetit*, *Food & Wine, Gourmet*, *Travel & Leisure* and *InStyle*. Sprinkles adopted the SPRINKLES and SPRINKLES CUPCAKES marks for bakery goods and services in 2004 and has registered its marks in the U.S. and around the world.

In 2009, Sprinkles acquired the SPRINKLES OF PALM BEACH and SPRINKLES PALM BEACH and Design trademarks for ice cream and retail store services featuring ice cream. Sprinkles has licensed use of these marks, and Sprinkles' licensee and the licensee's predecessors-in-interest have used the SPRINKLES trademark since 1985. The SPRINKLES OF PALM BEACH word mark (Reg. No. 2938800) was filed on November 13, 2002, and registered on April 5, 2005. The SPRINKLES PALM BEACH and Design mark (Reg. No. 3004757) was filed on July 16, 2003 and registered on October 4, 2005.

Soft Serve is an ice cream and yogurt shop in Potomac, Maryland. Soft Serve claims it first used the SPRINKLES trademark in April 2002, though it has not produced any documents to

---

[2] In December, Sprinkles requested consent from Soft Serve for this motion to suspend. After considering the issue for nearly seven weeks, Soft Serve responded that it would not consent to suspend all proceedings, but instead would only consent to suspend all but one proceeding. *See* Hire Decl. ¶¶ 2, 9-10 and Exs. G-H. As explained above, the parties have agreed that the discovery in one proceeding is applicable to all; Soft Serve's suggestion, then, is nonsensical, and is tantamount to proceeding with discovery in all actions, despite the unresolved discovery dispute between the parties. As Sprinkles could not agree to this arrangement, Sprinkles was compelled to file this motion to suspend without consent.

substantiate this date.[3]

**B. Soft Serve – Sprinkles Proceedings**

Sprinkles filed Application Serial No. 77/770541 for SPRINKLES for "Ice cream; frozen yogurt; candy; sweets; cupcake mixes; ice cream sundaes, sherbets, ices, sorbets, milk shakes" in Class 30. The application was approved and published, and Soft Serve opposed it on March 12, 2010. Soft Serve later filed seven additional proceedings against Sprinkles, including the above-captioned proceeding, each of which involves a SPRINKLES mark:

| Proceeding Number | Mark | Next Deadline (Close of Discovery) |
|---|---|---|
| *Opposition No. 91194188* | *SPRINKLES* | *Suspended* |
| Opposition No. 91195669 | SPRINKLESMOBILE | March 21, 2011 |
| Opposition No. 91195985 | I (heart) SPRINKLES | April 16, 2011 |
| Opposition No. 91195986 | SAY IT WITH SPRINKLES | April 16, 2011 |
| Opposition No. 91196035 | SAY IT WITH SPRINKLES | April 18, 2011 |
| Opposition No. 91196061 | SPRINKLES CUPCAKES | April 20, 2011 |
| Opposition No. 91196087 | I LOVE SPRINKLES | April 23, 2011 |
| Cancellation No. 92053109 | SPRINKLES | June 14, 2011 |

The reference above to the so-called "Primary Opposition" is italicized.

**C. Motion to Compel**

On December 10, 2010, Soft Serve moved to compel discovery of information and production of documents in the Primary Opposition. Soft Serve also requested a finding that Sprinkles has waived any claim of privilege over documents responsive to Soft Serve's requests. Sprinkles strongly disagrees with Soft Serve's contentions in the motion to compel, and has

[3] Sprinkles disputes this first use date, as it is supported only by a bald assertion in Opposer's interrogatory responses, and Opposer has not submitted any documents that would support this first use date; indeed, the documents indicate that Opposer's soft serve restaurant changed its name from I CAN'T BELIEVE IT'S YOGURT to SPRINKLES in December 2002 at the earliest, after Sprinkles' licensee had filed a federal application for the SPRINKLES OF PALM BEACH mark.

opposed the motion. In particular, among other issues the parties disagree regarding: (1) whether Soft Serve is entitled to all of Sprinkles' privileged communications with its attorneys (Sprinkles claims that this argument is extraordinary and baseless), (2) whether Soft Serve is entitled to detailed and highly confidential revenue information in this proceeding (Sprinkles claims that this information is irrelevant to the TTAB proceeding), and (3) whether Soft Serve is entitled to detailed and highly confidential information about prior disputes between Sprinkles and third-parties (Sprinkles claims that this information is irrelevant to Soft Serve's claims in the TTAB proceedings, and in any event Sprinkles has provided sufficient information about these prior disputes to satisfy any perceivable discovery obligation about them). *See* Hire Decl. Exs. A-C. The Board has suspended the Primary Opposition pending disposition of the motion. *See* Hire Decl., Ex. D.

## III. ARGUMENT

### A. This Proceeding Should Be Suspended Pending Resolution of Soft Serve's Motion to Compel

Good cause exists to suspend proceedings pending resolution of the motion to compel in a highly related proceeding. *See* TBMP §510.03(a); Trademark Rule 2.117(c) ("Proceedings may [] be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board."). Not only do the matters in the Primary Opposition and the above-captioned proceeding overlap, pursuant to the agreement of the parties, the very discovery at issue in the Primary Opposition is to be applied to the above-captioned proceeding. The Board routinely suspends proceedings pending disposition of a motion to compel, and the Board has suspended the proceedings in the Primary Opposition. *See* Hire Decl., Ex. D; TBMP § 510.03(a) ("when a party files a motion to compel discovery, the Board will issue an order suspending the proceeding with respect to all matters not germane to the motion."); Trademark Rule 2.120(e)(2) ("When a party files a motion for an order to compel initial disclosures, expert testimony disclosure, or discovery, the case will be suspended

by the Board with respect to all matters not germane to the motion.").[4] If the Board does not suspend the present proceeding, then the parties will be forced to repeat the discovery dispute in this action, resulting in unnecessary duplicative motions to compel discovery in this matter. This action should be suspended so discovery can proceed with the benefit of the Board's guidance.

### B. Alternatively, This Proceeding Should Be Suspended Pending Final Resolution of the Primary Opposition

Alternatively, Sprinkles requests suspension of this proceeding pending final resolution of the Primary Opposition on the merits. All proceedings concern the SPRINKLES mark, and are primarily focused on priority. As such, the issues in all proceedings are inextricably intertwined. The TBMP encourages suspension of Board proceedings when a more advanced proceeding may have an impact on a later-filed Board action. *See* Trademark Rule 2.117(a) ("Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in . . . another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of . . . the other Board proceeding."); TBMP § 510.02(a) ("Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.")

## IV. CONCLUSION

For the reasons stated above, Sprinkles requests that the Board suspend this proceeding pending the disposition of Soft Serve's motion to compel, filed in the Primary Opposition. Alternatively, Sprinkles requests that the Board suspend this proceeding pending the final disposition of the Primary Opposition.

---

[4] *See also, e.g., Jain v. Ramparts, Inc.,* 49 U.S.P.Q. 2d 1429, 1430 (TTAB 1998) (granting motion to suspend proceedings pending disposition of a motion to compel); *National Football League v. DHN Mgmt.,* 85 U.S.P.Q. 2d 1852, 1855 (TTAB 2008) (noting that "[p]roceedings remain suspended pending disposition of opposers' motion to compel.").

Dated: February 28, 2011

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: /Hollis Beth Hire/.
John L. Slafsky
Hollis Beth Hire

Attorneys for Applicant
Sprinkles Cupcakes, Inc.

## CERTIFICATE OF SERVICE BY MAIL

I, Jo Ann Hylton, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served:

**SPRINKLES CUPCAKES' MOTION TO SUSPEND THE PROCEEDINGS**

**DECLARATION OF HOLLIS BETH HIRE**

on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
Potomac, Maryland 20854

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed at Palo Alto, California on February 28, 2011.

Jo Ann Hylton

4201559_1

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

| | |
|---|---|
| Soft Serve, Inc. d/b/a Sprinkles, | ) |
| Opposer, | ) |
| v. | ) |
| Sprinkles Cupcakes, Inc., | ) |
| Applicant. | ) |

**DECLARATION OF HOLLIS BETH HIRE IN SUPPORT OF SPRINKLES CUPCAKES' MOTION TO SUSPEND THE PROCEEDINGS**

1. I am an attorney at Wilson Sonsini Goodrich & Rosati, counsel for Sprinkles Cupcakes, Inc. ("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. Several months ago, Thomas Vande Sande, counsel for Soft Serve, Inc. ("Soft Serve"), requested that all discovery in one action be available for use in the other Sprinkles-related actions pending before the Trademark Trial and Appeal Board. After clarifying the request, Sprinkles agreed to this arrangement. On December 27, 2010, I contacted Mr. Vande Sande to ask whether Soft Serve would consent to a motion to suspend all proceedings pending the disposition of the motion to compel filed by Soft Serve in Opposition No. 91194188 and I followed up on the request on January 11, 2011. Mr. Vande Sande responded on February 14, 2011 and reported that Soft Serve would not consent to suspend all proceedings.

3. Attached hereto as Exhibit A is a true and correct copy of the motion to compel filed by Soft Serve in Opposition No. 91194188.

4. Attached hereto as Exhibit B is a true and correct copy of Sprinkles' opposition to Soft Serve's motion to compel, filed in Opposition No. 91194188.

5. Attached hereto as Exhibit C is a true and correct copy of Soft Serve's reply in support of its motion to compel, filed in Opposition No. 91194188.

6. Attached hereto as Exhibit D is a true and correct copy of an order from the Trademark Trial and Appeal Board, dated December 21, 2010, suspending Opposition No. 91194188 pending disposition of Soft Serve's motion to compel.

7. Attached hereto as Exhibit E is a true and correct copy of an email communication with Thomas Vande Sande containing messages bearing dates between September 13, 2010 and September 16, 2010.

8. Attached hereto as Exhibit F is a true and correct copy of an email communication with Thomas Vande Sande containing messages bearing the dates October 14, 2010 and October 19, 2010.

9. Attached hereto as Exhibit G is a true and correct copy of an email communication with Thomas Vande Sande containing messages bearing dates between December 27, 2010 and January 11, 2011.

10. Attached hereto as Exhibit H is a true and correct copy of an email communication with Thomas Vande Sande dated February 14, 2011.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed at Palo Alto, California on February 28, 2011.

By: /s/ Hollis Beth Hire.
Hollis Beth Hire

4266711_2

**EXHIBITS ARE TOO VOLUMINOUS FOR ELECTRONIC FILING.**

**EXHIBITS WERE SERVED ON FEBRUARY 28, 2011, BUT WILL BE MAILED TO THE TTAB TO SUPPLEMENT THIS ELECTRONIC FILING.**