BULKY DOCUMENTS

(Exceeds 100 pages)

Proceeding/Serial No: **91196061**

Filed: 3/7/2011

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

Part 1 of 1

91196061

TTAB

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March 1, 2011

By First Class Mail

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

#77858599

Re: Opposition No. 91196061
Mark: SPRINKLES CUPCAKES

Dear Sir or Madam:

Applicant Sprinkles Cupcakes, Inc. filed the attached Motion to Suspend the Proceedings and related declaration via ESTTA yesterday evening, but the electronic filing system would not process the voluminous exhibits. We are therefore sending Exhibits A-H in hard copy today, with another copy of the motion as well for reference. As you will see from the proof of service (also submitted electronically yesterday and included here for reference), the motion with the declaration and exhibits were served by U.S. mail yesterday, February 28, 2011.

Respectfully submitted,

Hollis Beth Hire

CERTIFICATE OF MAILING
UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451 Alexandria, VA 22313-1451.

Jo Ann Hylton	March 1, 2011
Printed Name	**Date of Deposit**
JoAnn Hylton	3-1-11
Signature	**Date**

03-07-2011

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

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.	Opposition No: 91196061 Mark: SPRINKLES CUPCAKES

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

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[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.

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[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

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

EXHIBIT A

TTAB

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.

Opposition No. 91194188

TRADEMARK PROCESS
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OPPOSER'S MOTION TO COMPEL

I. INTRODUCTION

Opposer, Soft Serve, Inc. d/b/a Sprinkles, hereby seeks an Order compelling Applicant, Sprinkles Cupcakes, Inc., to answer fully interrogatories set forth in Opposer's First Set of Interrogatories and to fully produce documents responsive to Opposer's First Set of Production Requests. Additionally, as Applicant has failed to provide any supporting basis for, or even identification of, allegedly privileged and/or work product protected documents, Opposer requests an order requiring the production of all such documents.

12-13-2010

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #2

II. FACTUAL BACKGROUND

This Opposition was brought by Soft Serve, Inc. d/b/a Sprinkles in an effort to prevent registration of the mark SPRINKLES to Applicant Sprinkles Cupcakes for the goods recited in the subject application. On May 28, 2010, one day after the opening of discovery, Opposer Sprinkles served its first set of interrogatories and production requests. Applicant's interrogatory answers, production request responses, and document production were deemed by Opposer to be incomplete and inadequate. In addition, Applicant's frequent assertion of attorney client privilege and work product protection were unsupported, as Applicant provided no identification of any documents or communications withheld from discovery pursuant to Applicant's privilege and work product claims.

On September 13, 2010 Opposer's concerns with respect to Applicant's discovery responses were conveyed in a letter from Opposer's counsel to Applicant's counsel. Applicant's response of September 30, 2010 stated that, with very few exceptions it did not agree to supplement either its document production or its responses to interrogatories. Applicant's September 30 letter promised a privilege log, the supplementation of a single interrogatory answer, and an investigation as to whether it would provide information concerning advertising and promotional expenses.

Having received neither (1) a privilege log, (2) any other attempt to identify withheld documents, (3) the withdrawal of numerous objections believed to be of no merit, (4) any supplementation of interrogatory answers, production request responses or additional documentation, another letter expressing Opposer's continued concerns was forwarded to Applicant's counsel on November 9, 2010. Applicant's response of November 19, 2010

promised very limited supplementation, and the delivery of a privilege log, during the week of November 22, 2010.[1] To date, no privilege log or other attempt to identify any documents withheld on the basis of privilege or work product claims has been received. In addition, objections deemed to be without merit have not been withdrawn and the very limited promised supplementation of interrogatory answers have not been forthcoming. Understandably, Opposer's efforts in developing its case have been seriously hampered.

III. MATTERS IN DISPUTE

Opposer requests an Order compelling Applicant to produce responsive documents and to provide responses to production requests and interrogatory answers with respect to the following portions of Opposer's first round of discovery. In addition, Opposer seeks an Order compelling the production of all documents withheld on the basis of unsupported claims of privilege and work product protection.

Privilege And Work Product Documents and Communications – A party claiming attorney client privilege or work product protection as a basis for excluding documents and the substance of communications from discovery bears the burden of establishing such claims. F.R.C.P. 26(b)(5). In those instances in which a party fails to provide information substantiating its claims of privilege or work product protection, it is appropriate to order the production of withheld documents and the substance of perhaps otherwise protectable communications. See *Banks v. Office of the Senate Sergeant-At-Arms*, 222 F.R.D. 7 (D.D.C. 2004); *First American Corp. v. Al-Nahyan*, 2 F.Supp. 2d 58, 63 n. 5 (D.D.C. 1998) and *Bregman v. District of Columbia*, 182 F.R.D. 352, 363 (D.D.C. 1998). It is submitted that in those instances in which

[1] Correspondence referred to herein relating to efforts to resolve these issues is appended as Exhibits 3 - 6 to the Declaration of Thomas J. Vande Sande submitted herewith.

there exists a repeated failure to provide substantiation in favor of claims of privilege and work product protection, the production of such should be ordered.

The entry of an Order requiring production of withheld allegedly privileged and/or work product documents and communications in the possession of Applicant, or its counsel, is fully warranted. Applicant's discovery responses raised claims of privilege and work product protection but offered nothing in support of those claims. Moreover, in spite of Opposer's repeated requests for a privilege log, and Applicant's repeated promise that such would be forthcoming, not a single document or other allegedly privileged communication has been identified by Applicant. Given Applicant's repeated failures to provide any support for its claims of privilege, its unfulfilled promise to provide such during the last week of discovery, the upcoming deadline for Opposer's pretrial disclosures, and the looming opening of Opposer's testimony period, the issuance of an Order compelling the production of withheld documents and details of involved discussions is fully warranted.

Production Request No. 1 – This request seeks the production of documents relevant to the conception, adoption and selection of SPRINKLES as a mark by Applicant. Applicant has responded by objecting to the Request to the extent that it seeks documents protected by attorney client privilege and/or the work product doctrine. For the reasons discussed above, Opposer seeks the production of all responsive documents in the possession of Applicant, or its counsel, relating to the subject of this request.

Production Request No. 2 – In response to this request, which seeks samples and/or specimens of each different use made by Applicant of the subject SPRINKLES as well as "SPRINKLES OF PALM BEACH" marks asserted by Applicant in its Answer to the Notice of

Opposition, Applicant has lodged an objection claiming that the requested documents are (1) publically available and (2) as accessible to Opposer as they are to Applicant. Applicant also objects to the request as being overly broad and unduly burdensome. Finally, Applicant's response indicates that it will produce "A representative sampling" of documents responsive to this request.

Opposer requests an Order compelling Applicant to fully respond to this request. Opposer is entitled to the production of samples and specimens so that Opposer can meaningfully ascertain the types of uses made by Applicant of the SPRINKLES mark, and the marks asserted by Applicant to be relevant to this controversy through its Answer to the Notice of Opposition. Opposer has no ability to determine from unspecified "publically available" documents the full range of uses made by Applicant. Consequently, Applicant's assertion that such are as accessible to Opposer as they are to Applicant is untenable. This request is neither overly broad nor unduly burdensome. Finally, the production of "a representative sampling" does not provide Opposer with the knowledge it requires, and is entitled to, in preparing its case.

Production Request No. 3 – In response to Opposer's request for materials relating to the advertising and promotion of materials used by Applicant or others at its request, or by any licensee, in connection with the marketing, advertising and sale of goods or services under the SPRINKLES and SPRINKLES OF PALM BEACH marks, Applicant again objects claiming that such documents are publically available and as accessible to Opposer as they are to Applicant. Again, an objection is raised claiming that the request is overly broad and unduly burdensome but promising the production of "a representative sampling" of related documents. As noted above in discussing Applicant's response to Request No. 2, Opposer has no way of determining from its own searching of "publically available" documents the full range of advertising and

promotional activities undertaken by Applicant. Consequently, such documents and things are not as accessible to Opposer as they are to Applicant. This Request is neither overly broad nor unduly burdensome and the production of a very limited representative sampling in no way addresses Opposer's legitimate request.

Production Request No. 4 – This request seeks the production of, inter alia, marketing plans for goods and services offered by, or intended to be offered by, Applicant under the SPRINKLES and SPRINKLES OF PALM BEACH marks. Applicant's objection with respect to confidentiality is mooted by the fact that a Protective Order was agreed to and accepted by the Board long ago. Applicant's objection to this request as being overly broad and unduly burdensome appears to be contradicted by Applicant's assertion that "at this time it does not possess, maintain custody or control any documents that are responsive to this request". Moreover, given Applicant's constant pronouncements with respect to its expansion, both nationally and globally, it is extremely hard to imagine that no documents exist that fall within the scope of this request. Such documents are clearly relevant to various DuPont factors and assist not only Opposer but also the Board in determining the ultimate issue of likelihood of confusion. Consequently, Opposer seeks an Order requesting a full response to Production Request No. 4 and the production of all related documents.

Production Request No. 5 – Applicant has asserted claims of privilege and work product protection in response to this request which seeks the production of documents comprising, reflecting, or relating to opinions of counsel regarding Applicant's right to use or register the subject mark. As noted above, an Order is warranted requiring the production of all such documents given Applicant's repeated failures to substantiate its claim of privilege and work product protection with respect to these documents.

Production Request No. 7 – This two part request seeks the production of all agreements relating to the SPRINKLES OF PALM BEACH marks acquired by Applicant through assignment, and in fairness to Applicant it is possible that such have been produced. However, left unaddressed is Opposer's request for the production of all correspondence between Applicant and any third party concerning or referring to the SPRINKLES OF PALM BEACH marks and/or registrations acquired by Applicant. As it is believed that Applicant routinely asserts the SPRINKLES OF PALM BEACH marks and registrations as part of its practice in threatening third party users of SPRINKLES related marks, Applicant's failure to produce such correspondence and other documentation is questioned, especially as Applicant has elsewhere indicated (see Applicant's Answer to Interrogatory 13) that it has challenged some 19 parties in connection with their uses of SPRINKLES related marks. Finally, the production of third party correspondence cannot be avoided by attorney client privilege and work product claims. Moreover, for the reasons discussed above, Applicant should not be allowed to avail itself at this juncture of claims of attorney client privilege or work product protection for any documents responsive to this request.

Production Request No. 8 – Through this request Opposer sought the production of documents which mention, relate or refer to Opposer or its goods or services, the advertising of those goods or services, and Opposer's marks and trade names. Opposer asserts that Applicant's objection to this request as being overly broad and unduly burdensome is ill-founded and that production of all related documents should be ordered given Applicant's failure to substantiate any possible claims of privilege or work product protection.

Production Request No. 9 – This request seeks the production of search related documents and documents reflecting or relating to any such searches. Applicant has produced

the results of two searches. In addition, Applicant has claimed, but not substantiated, claims of privilege in response to this request. While ordinarily it likely would be found that an attorney's search report, or other documentation reflecting an opinion following an analysis of search results, would be properly withheld from discovery on the basis of privilege or work product protection, it is respectfully submitted that, given Applicant's failure to substantiate its privilege claims, an Order is warranted requiring Applicant to product all related documents.

Production Request No. 10 – Documentation referring, relating to, or involving challenges by third parties to Applicant's right to use or register SPRINKLES is sought through Request No. 10. Applicant promised to produce non-privileged responsive documents but it is believed that Applicant's production of documents responsive to this request is incomplete. Applicant has also asserted claims of privilege and work product which, as discussed throughout this Motion, should not be found to excuse production of such documents.

Production Request No. 11 – Documents evidencing Applicant's first use of SPRINKLES are requested. Curiously, Applicant objects to this request to the extent that it seeks documents that are protected by privilege or work product. In addition, Applicant objects to the request to the extent that it seeks documents which are publically available and are as accessible to Opposer as they are to Applicant. Each of these objections is untenable. First, no basis for privilege or work product protection has been offered. Secondly, the objection claiming public availability of such documents is completely nonresponsive to Opposer's legitimate inquiry into first use on behalf of Applicant. Finally, obviously such documents are not as accessible to Opposer as they are to Applicant.

Production Request No. 14 – In response to Opposer's request for documents evidencing Applicant's intention to use SPRINKLES in connection with the goods recited in the subject application, Applicant again objects on the basis of privilege and work product. It is respectfully submitted that, even if Applicant was still entitled to withhold privileged and work product documents, documents evidencing its intention to use the subject mark would not be subject to such claims.

Equally unsustainable is Applicant's objection to this request as being overly broad and unduly burdensome. Opposer requests an order compelling production of all documents relevant to this request.

Production Request No. 15 – This request seeks the production of documents showing the circumstances under which Applicant first became aware of Opposer's use of SPRINKLES. Applicant's only response is the assertion of attorney client privilege and work product protection. As discussed throughout this Motion, Opposer submits that the withholding of documents on the basis of privilege and work product claims is no longer an option available to Applicant.

Production Request No. 18 – This request seeks the production of documents for which identification was requested in Opposer's Interrogatory No. 5, which in turn inquires as to the relationship and dealings between Applicant and any previous owners of the SPRINKLES OF PALM BEACH marks acquired and relied upon by Applicant. For the reasons discussed above, Opposer submits that Applicant's claims of attorney client privilege and work product protection cannot shield responsive documents from production.

Production Request No. 21 – Requested are documents for which identification was sought in Interrogatory No. 11, which in turn relates to details and documents relevant to first use by Applicant of SPRINKLES and SPRINKLES OF PALM BEACH. Opposer submits that such documents could not in the first instance properly be subject to claims of attorney client privilege or work product protection and, in addition, that such claims are no longer available to Applicant. Opposer also takes issue with Applicant's contention that this request is objectionable as calling for a legal conclusion. Opposer is entitled to learn of Applicant's contentions with respect to its use and first use of marks which have been asserted by Applicant as relevant to the issues of this case and the defenses which have been asserted by Applicant through its Answer to the Notice of Opposition.

Production Request No. 22 – Requested are those documents for which identification was sought through Interrogatory No. 13, which is turn deals with conflicts, challenges and controversies with third parties involving Applicant's SPRINKLES and SPRINKLES OF PALM BEACH marks. Applicant's reliance upon claims of privilege and work product cannot shield from discovery correspondence to and from third parties. Equally unavailing is Applicant's contention that it does not understand the meaning of "controversy" or "conflict". Similarly without merit is Applicant's contention that this request is overly broad and unduly burdensome.

Beyond these objections, Applicant identified through its answer to related Interrogatory 13, some 19 individuals and/or businesses as those against whom "Sprinkles has alleged trademark infringement and related claims". Applicant, in its answer to Interrogatory 13, has provided only names of individuals and businesses with no further identifying details. Moreover, Applicant has provided absolutely no documentation to or from the vast majority of the individuals and business entities it has "identified" in related Interrogatory 13.

Opposer seeks an Order compelling full production of all documents relating to these challenges, including correspondence to and from such third parties, documentation sufficient to identify all related litigation, and all documentation which may have arguably qualified as being privileged or work product but for Applicant's failure to identify such.

Production Request No. 25 – In response to Opposer's request for documents sufficient to show continuity of usage of the SPRINKLES OF PALM BEACH marks asserted by Applicant in its Answer to the Notice of Opposition, Applicant asserts an inability to ascertain the meaning of "continuity of Applicant's use". While Applicant indicates that non-privileged responsive documents will be produced subsequent to a reasonable search, to date no supplementation of Applicant's Response to this Request has been forthcoming and no related documents have been produced.

Redaction – Various pages of documentation produced by Applicant indicate that text has been redacted prior to production. Queried as to the basis for such redaction in correspondence exchanged prior to the filing of this Motion, Opposer was informed that various items of text had been redacted based upon claims of privilege and work product protection. To the extent that an Order issues compelling production of documents as to which Applicant has made no effort to substantiate its claims of privilege and work product protection, Opposer similarly requests the production of unredacted copies of all pages previously produced with redactions.

Interrogatory No. 4 – Included within the scope of this interrogatory is a request for the annual revenues generated by the sale of goods and services offered by Applicant, or any

licensee of Applicant, under the SPRINKLES and SPRINKLES OF PALM BEACH marks. No portion of Applicant's answer to this interrogatory addresses this portion of Opposer's inquiry.

Interrogatory No. 5 – Shortcomings with respect to this interrogatory answer are discussed above in the context of Applicant's response to Production No. 18. Opposer seeks an Order compelling the production of related documents without the benefit of exclusion on the basis of attorney client privilege or work product protection.

Interrogatory No. 8 – As discussed above in the context of Applicant's response to Production Request No. 9, Opposer seeks an Order requiring Applicant to provide opinions of counsel.

Interrogatory No. 11 – As discussed above in the context of Production Request No. 11, inquiries concerning first use cannot properly be avoided on the basis that such call for a legal conclusion as asserted by Applicant. Nor is it seen how first use related details and documents can properly be the subject matter of either attorney client privilege or work product protection.

Interrogatory No. 13 – Opposer's comments concerning the short comings of the answer provided in response to this Interrogatory are set forth above in the discussion relating to Production Request No. 22.

IV. CONCLUSION

Opposer requests an Order compelling the full production of requested and relevant documents and complete answers in response to the discovery requests discussed above. Opposer also requests an Order compelling the production of all documents responsive to Opposer's production requests and the answering of all interrogatories notwithstanding

Applicant's unsubstantiated claims that such are protectable from discovery on the basis of either attorney client privilege or the work product doctrine.

Finally, Opposer requests the issuance of new Scheduling Order setting forth revised dates for all scheduled events including and subsequent to the date for Opposer's submission of its pretrial disclosures.

Respectfully submitted,

Date: 12/10/10

Thomas J. Vande Sande
HALL & VANDE SANDE, LLC
Attorneys 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 (1) copy of the foregoing "OPPOSER'S MOTION TO COMPEL AND RELATED DECLARATION OF OPPOSER'S COUNSEL WITH SUPPORTING EXHIBITS." was this day served on Applicant by mailing same, first class mail, to:

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

Date: 12/10/10

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

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.	)	
	)	

DECLARATION OF THOMAS J. VANDE SANDE
IN SUPPORT OF OPPOSER'S MOTION TO COMPEL

I, Thomas J. Vande Sande, declare as follows:

1. I am an attorney at law licensed to practice in the District of Columbia and the state of Maryland. I am principal in the firm of Hall & Vande Sande. I represent Opposer Soft Serve, Inc., d/b/a Sprinkles in connection with various intellectual property matters. I have personal knowledge of the following facts.
2. Attached hereto as Exhibit 1 is a true and correct copy of Opposer's First Set of Requests for Production of Documents and Things and Applicant's Responses thereto.
3. Attached hereto as Exhibit 2 is a true and accurate copy of Opposer's First Set of Interrogatories and Applicant's Answers thereto.
4. I timely received responses to the aforementioned discovery requests from Applicant. In addition, I subsequently received documents from Applicant's counsel in response to various production requests.

5. My review of Applicant's discovery responses convinced me that such were deficient in several respects. Consequently, on September 13, 2010 I forwarded to Applicant's counsel correspondence attached hereto as Exhibit 3 in an effort to resolve discovery issues raised by Applicant's initial interrogatory answers, document production responses, and document production.
6. Attached hereto as Exhibit 4 is a true and accurate copy of a letter I received from counsel for Applicant in response, dated September 30, 2010.
7. Attached hereto as Exhibit 5 is a true and accurate copy of a letter I sent to Applicant's counsel on November 9, 2010 in a further attempt to resolve outstanding discovery disputes.
8. Attached hereto as Exhibit 6 is a true and accurate copy of a letter I received from Applicant's counsel dated November 19, 2010.
9. I believe that good faith efforts have been made to resolve the discovery issues addressed through Opposer's Motion to Compel.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed this 10th day of December, 2010 at Potomac, Maryland.

Date: 12/10/10

Thomas J. Vande Sande
HALL & VANDE SANDE, LLC
Attorneys 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 (1) copy of the foregoing "DECLARATION OF THOMAS J. VANDE SANDE IN SUPPORT OF OPPOSER'S MOTION TO COMPEL" was this day served on Applicant by mailing same, first class mail, to:

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

Date: 12/10/10

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

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.	Opposition No: 91194188

APPLICANT SPRINKLES CUPCAKES' RESPONSES TO OPPOSER'S FIRST REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS

Pursuant to Federal Rule of Civil Procedure 34 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Applicant Sprinkles Cupcakes, Inc. ("Sprinkles"), by and through its undersigned counsel, hereby responds to the First Set of Requests For Production Of Documents And Things ("Requests") by Opposer Soft Serve, Inc. d/b/a/ Sprinkles ("Soft Serve") as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Sprinkles objects to the Requests, to each and every individual request contained therein, and to the "Definitions" contained in the Requests, to the extent they are inconsistent with or seek to impose obligations greater than those imposed by the Federal Rules of Civil Procedure and the TBMP.

GENERAL OBJECTION NO. 2:

Sprinkles objects to the Requests, and to each and every individual request contained therein, to the extent they seek the production of documents or information that: (1) are protected by the attorney-client privilege; (2) constitute work product of Sprinkles' attorneys; and/or (3) are

otherwise privileged. Any inadvertent disclosure of such information shall not be deemed a waiver of the attorney-client privilege, the work product doctrine, or any other applicable privilege or immunity recognized by statute or case law.

GENERAL OBJECTION NO. 3:

Sprinkles objects to the Requests, and to each and every individual request contained therein, as unduly burdensome and oppressive to the extent that they purport to require Sprinkles to search Sprinkles facilities and inquire of Sprinkles employees other than those facilities and employees that would reasonably be expected to have responsive information. Sprinkles' responses are based upon: (1) a reasonable search, given the time allotted to Sprinkles to respond to these requests, of facilities and files that could reasonably be expected to contain responsive information or documents; and (2) inquiries of Sprinkles employees and/or representatives who could reasonably be expected to possess responsive information. The subject matter of these requests is under continuing investigation. Accordingly, these responses are limited to and are applicable only to documents and other information which Sprinkles' counsel has been able to ascertain and locate as of the date hereof. Sprinkles expressly reserves the right to use, rely upon, and offer into evidence any and all documents and other information responsive to these requests, whether or not presently identified or produced, if the documents or other information have not been obtained by counsel and deemed responsive by counsel as of the date of this response, or if the responsiveness of the documents or other information has been overlooked in good faith, or if an objection is interposed to producing a document or other information.

GENERAL OBJECTION NO. 4:

Sprinkles objects to the Requests, and to each and every individual request contained therein, to the extent they require Sprinkles to search for and reveal privileged information from it and its attorneys' files pertaining to this matter.

GENERAL OBJECTION NO. 5:

To the extent that the Requests seek confidential or proprietary information pertaining to Sprinkles' business, trade secrets and/or economic relationships, Sprinkles will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board.

GENERAL OBJECTION NO. 6:

Sprinkles objects to the Requests, and to each and every individual request contained therein, to the extent they call for the production of documents or things which are confidential or proprietary to, or contain the trade secrets of, a third party. Each such request is overly broad, unduly burdensome, oppressive, and seeks to impose obligations beyond those permitted by the TBMP and the Federal Rules of Civil Procedure. Sprinkles will only produce such material subject to the terms of the Protective Order and upon receipt of permission from the third party, if necessary.

GENERAL OBJECTION NO. 7:

Sprinkles objects to the Requests, and to each and every individual request contained therein, to the extent that they call for the production of "all documents" where compliance with such request would be unduly burdensome. In the event a request seeking "all documents" is unduly burdensome, Sprinkles will produce documents sufficient to respond to Soft Serve's request pursuant to TBMP § 419.

GENERAL OBJECTION NO. 8:

Sprinkles objects to the definition of "Sprinkles" on the grounds that it is vague, ambiguous, and unintelligible and that it is so excessively broad that it is unduly burdensome and oppressive. Sprinkles will construe the terms "Sprinkles", "Applicant", "you" and "your" wherever used in the interrogatories to refer to Sprinkles, Inc.

GENERAL OBJECTION NO. 9:

Sprinkles objects to the Requests, and to each and every individual request contained therein, to the extent they seek documents related to experts. Sprinkles will meet and confer with Soft Serve to determine a time when the parties can simultaneously exchange expert-related documents.

GENERAL OBJECTION NO. 10:

Sprinkles objects to the Requests, and to each and every individual request contained therein, as overbroad, unduly burdensome and not reasonably calculated to lead to the production of relevant evidence to the extent they seek documents related to proceedings or the use of marks outside of the United States. Actions taken outside of the United States, and documents relating thereto, are not relevant to this proceeding.

GENERAL OBJECTION NO. 11:

Sprinkles objects to the "Definitions" contained in the Requests insofar as they contain instructions rather than definitions for terms and are thus ambiguous.

Sprinkles expressly incorporates the above General Objections as though set forth fully in response to each of the following individual requests, and, to the extent they are not raised in any particular response, Sprinkles does not waive those objections. An answer to a request shall not be deemed a waiver of any applicable specific or general objection to a request. Likewise, an answer to a request shall not be deemed an admission of any assertions contained in that request.

RESPONSES

REQUEST FOR PRODUCTION NO. 1

All documents of any kind which contain or reflect information bearing upon the conception, adoption and selection of "SPRINKLES" as a mark by Applicant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 1

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

REQUEST FOR PRODUCTION NO. 2

Samples and/or specimens of each different use made by Applicant of "SPRINKLES" and "SPRINKLES OF PALM BEACH" in connection with Applicant's goods and services.

RESPONSE TO REQUEST FOR PRODUCTION NO. 2

Sprinkles objects to this request to the extent it seeks documents that are publicly available and are as accessible to Soft Serve as they are to Sprinkles. Sprinkles objects to this request to the extent it is overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce a representative sampling of documents responsive to this request that can be located after a reasonable search pursuant to TBMP § 414(2).

REQUEST FOR PRODUCTION NO. 3

All advertising, publicity releases, promotional pieces and materials used by Applicant, or by others at Applicant's request or direction or under license from Applicant, in the marketing, advertising, sale, and/or offering for sale, of goods and/or services under "SPRINKLES" or "SPRINKLES OF PALM BEACH" marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 3

Sprinkles objects to this request to the extent it seeks documents that are publicly available and are as accessible to Soft Serve as they are to Sprinkles. Sprinkles objects to this request to the extent it is overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce a representative sampling of documents responsive to this request that can be located after a reasonable search pursuant to TBMP § 414(2).

REQUEST FOR PRODUCTION NO. 4

All documents which comprise, relate to, or refer to any market plans, forecasts, or sales strategies for goods or services offered by or intended to be offered by Applicant, under the "SPRINKLES" and "SPRINKLES OF PALM BEACH" marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 4

Sprinkles objects to this request as overbroad and unduly burdensome. To the extent that this request seeks confidential or proprietary information pertaining to Sprinkles' business, trade secrets and/or economic relationships, Sprinkles will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

REQUEST FOR PRODUCTION NO. 5

All documents comprising, reflecting, relating to, or including, opinions of counsel regarding Applicant's right to use or register "SPRINKLES" as a trademark or service mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 5

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

REQUEST FOR PRODUCTION NO. 6

All documents relating to or reflecting the results of any polls or surveys which Applicant has conducted regarding the "SPRINKLES" or "SPRINKLES OF PALM BEACH" marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 6

Subject to and without waiving its General Objections, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

REQUEST FOR PRODUCTION NO. 7

(a) All assignments and license agreements, and any other agreements relating to the "SPRINKLES OF PALM BEACH" marks referred to in Applicant's Answer, as well as all correspondence between Applicant and any third party concerning or referring to the "SPRINKLES OF PALM BEACH" marks and/or registrations referred to in Applicant's Answer.

(b) All correspondence and all documents comprising or referring to any discussions involving Applicant and any previous owner of the "SPRINKLES OF PALM BEACH" marks and registrations (including all agents, attorneys and representatives of that entity) whether authored prior or subsequent to the assignments of the "SPRINKLES OF PALM BEACH" marks to Applicant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 7

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. To the extent that this request seeks confidential or proprietary information pertaining to Sprinkles' business, trade secrets and/or economic relationships, Sprinkles will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board. Sprinkles objects to this request as vague and ambiguous to the extent the term "authored" is undefined and susceptible to multiple interpretations.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 8

All documents which mention, relate or refer to

(a) Opposer, or;

(b) Opposer's goods or services, or the promotion or sale of same, or;

(c) Opposer's marks or trade name.

RESPONSE TO REQUEST FOR PRODUCTION NO. 8

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request as overbroad and unduly burdensome to the extent it seeks documents not in the possession, custody or control of Sprinkles.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 9

All documents comprising, reflecting or relating to any search made by or on behalf of Applicant relating to the "SPRINKLES" mark, or any "SPRINKLES" formative marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 9

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 10

All documents which refer to, relate to, or involve, any challenge by any third party to Applicant's right to use or register "SPRINKLES" or which contain any suggestion or demand by any third party that Applicant use a different mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 11

All documents evidencing Applicant's first use of "SPRINKLES".

RESPONSE TO REQUEST FOR PRODUCTION NO. 11

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request to the extent it seeks documents that are publicly available and are as accessible to Soft Serve as they are to Sprinkles.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 12

Documents sufficient to show all channels of trade through which Applicant offers, or intends to offer, goods and services under the "SPRINKLES" mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 12

Subject to and without waiving its General Objections above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 13

Documents showing the types of purchasers to whom Applicant has offered goods, or intends to offer, goods or services under the "SPRINKLES" mark.

RESPONSE TO REQUEST FOR PRODUCTION NO. 13

Sprinkles objects to this request as overbroad and unduly burdensome.

Subject to and without waiving its General Objections and its specific objections above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 14

All documents evidencing Applicant's intention to use "SPRINKLES" in commerce in connection with the goods recited in U.S. Application Serial No. 77/770,541.

RESPONSE TO REQUEST FOR PRODUCTION NO. 14

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request to the extent it is overbroad and unduly burdensome. To the extent that this request seeks confidential or proprietary information pertaining to Sprinkles' business, trade secrets and/or economic relationships, Sprinkles will only produce such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 15

Documents showing the circumstances under which Applicant first became aware of Opposer's use of "SPRINKLES".

RESPONSE TO REQUEST FOR PRODUCTION NO. 15

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

REQUEST FOR PRODUCTION NO. 16

All documents for which identification is requested in Opposer's Interrogatory No. 1.

RESPONSE TO REQUEST FOR PRODUCTION NO. 16

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

REQUEST FOR PRODUCTION NO. 17

All documents for which identification is requested in Opposer's Interrogatory No. 2.

RESPONSE TO REQUEST FOR PRODUCTION NO. 17

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

REQUEST FOR PRODUCTION NO. 18

All documents for which identification is requested in Opposer's Interrogatory No. 5.

RESPONSE TO REQUEST FOR PRODUCTION NO. 18

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 19

All documents for which identification is requested in Opposer's Interrogatory No. 8.

RESPONSE TO REQUEST FOR PRODUCTION NO. 19

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

REQUEST FOR PRODUCTION NO. 20

All documents for which identification is requested in Opposer's Interrogatory No. 10.

RESPONSE TO REQUEST FOR PRODUCTION NO. 20

Sprinkles objects to this request as overbroad and unduly burdensome.

REQUEST FOR PRODUCTION NO. 21

All documents for which identification is requested in Opposer's Interrogatory No. 11.

RESPONSE TO REQUEST FOR PRODUCTION NO. 21

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request to the extent that it calls for a legal conclusion.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request in the possession, custody or control of Sprinkles can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 22

All documents for which identification is requested in Opposer's Interrogatory No. 13.

RESPONSE TO REQUEST FOR PRODUCTION NO. 22

Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request as vague and ambiguous to the extent the terms "controversy" and "conflict" are undefined and each are susceptible to multiple interpretations. Sprinkles objects to this request to the extent it is overbroad and unduly burdensome.

REQUEST FOR PRODUCTION NO. 23

All documents identified in any of Applicant's answers to Opposer's First Set of Interrogatories not otherwise produced pursuant to a previous request.

RESPONSE TO REQUEST FOR PRODUCTION NO. 23

Sprinkles objects to this request as overbroad and unduly burdensome.

REQUEST FOR PRODUCTION NO. 24

Any and all documents and things, not produced in response to any other document request, which are within Applicant's possession, custody or control and which are identified or were referred to, reviewed, or consulted in response to, or in preparing answers to, Opposer's First Set of Interrogatories.

RESPONSE TO REQUEST FOR PRODUCTION NO. 24

Sprinkles objects to this request as overbroad and unduly burdensome. Sprinkles objects to this request to the extent that it seeks documents that are protected by the attorney-client privilege and/or work product doctrine.

REQUEST FOR PRODUCTION NO. 25

Documents sufficient to establish the continuity of Applicant's use of the "SPRINKLES OF PALM BEACH" marks in connection with each item of goods and services recited in the related registrations identified in Applicant's Answer, from the date of first use of each such mark to the present.

RESPONSE TO REQUEST FOR PRODUCTION NO. 25

Sprinkles objects to this request as vague and ambiguous to the extent the term "continuity of Applicant's use" is undefined and susceptible to multiple interpretations.

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that it will produce non-privileged documents responsive to this request that can be located after a reasonable search.

REQUEST FOR PRODUCTION NO. 26

Documents recording or reflecting the annual revenues received by Applicant from each item of goods and services offered under the "SPRINKLES OF PALM BEACH" marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 26

Subject to and without waiving its General Objections and its specific objection above, Sprinkles responds that at this time it does not possess, maintain custody or control any documents that are responsive to this request.

Dated: July 2, 2010

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: _____
John L. Slafsky
Matthew J. Kuykendall

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:

APPLICANT SPRINKLES CUPCAKES'S RESPONSES TO OPPOSER'S FIRST REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS

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 July 2, 2010.

Jo Ann Hylton

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.	Opposition No: 91194188

APPLICANT SPRINKLES CUPCAKES' RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES

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

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Sprinkles has not completed its investigation in this matter. All responses to the Interrogatories are based upon the information presently known to Sprinkles and are given without prejudice to Sprinkles' right to adduce evidence discovered or analyzed subsequent to the date of these responses. Sprinkles expressly reserves the right to revise and supplement its responses to the Interrogatories in the event that its continuing investigation of the facts and/or discovery bring to light any additional information responsive to the Interrogatories.

GENERAL OBJECTION NO. 2:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information protected by the attorney-client privilege, work product doctrine, and/or any other applicable privilege or protection. Without prejudice to this objection, Sprinkles will provide responses to the Interrogatories to the extent that such responses do not waive such privileges or protections.

GENERAL OBJECTION NO. 3:

Sprinkles objects to the Interrogatories, including, but not limited to, the "Definitions" therein, and to each and every individual interrogatory, to the extent they purport to impose duties on Sprinkles that are greater than those imposed by the Federal Rules of Civil Procedure and/or the TBMP.

GENERAL OBJECTION NO. 4:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information outside of Sprinkles' possession, custody, or control, on the grounds that any such interrogatory is overbroad and unduly burdensome, seeks to impose discovery obligations in excess of those imposed by the Federal Rules of Civil Procedure and/or the TBMP, and would subject Sprinkles to unreasonable annoyance, burden, and expense.

GENERAL OBJECTION NO. 5:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, as unduly burdensome, oppressive and in violation of the Federal Rules of Civil Procedure and/or the TBMP to the extent they purport to require Sprinkles to respond on behalf of, or conduct any inquiry or investigation with respect to, any party other than Sprinkles. Sprinkles will only answer the Interrogatories on its own behalf.

GENERAL OBJECTION NO. 6:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, to the extent they seek information that is neither admissible nor reasonably calculated to lead to the discovery of admissible evidence.

GENERAL OBJECTION NO. 7:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, as overbroad and unduly burdensome to the extent they do not include a limitation or proposed definition of a relevant time period.

GENERAL OBJECTION NO. 8:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory, to the extent they are not consistent with or do not meet the requirements of Federal Rule of Civil Procedure 33 or the TBMP.

GENERAL OBJECTION NO. 9:

Sprinkles specifically reserves all objections as to the competence, relevancy, materiality, and admissibility of its documents and interrogatory responses or the subject matter thereof, and all rights to object on any ground to the use of any document or interrogatory response, or the subject matter thereof, in any subsequent proceeding, including without limitation the trial of this or any action.

GENERAL OBJECTION NO. 10:

Sprinkles objects to the Interrogatories, and to each and every individual interrogatory contained therein, to the extent they seek confidential or proprietary information pertaining to Sprinkles' business, trade secrets and/or economic relationships ("Trade Secret Information"). To the extent such information is responsive to these Interrogatories and within the proper scope of discovery in this action, Sprinkles will provide such information subject to the terms of a Protective Order signed by the parties in this matter and approved by the Trademark Trial and Appeal Board. Sprinkles objects to producing Trade Secret Information before the execution of

such a protective order and approval of such a Protective Order by the Trademark Trial and Appeal Board.

GENERAL OBJECTION NO. 11:

Sprinkles objects to the "Definitions" contained in the Interrogatories insofar as they contain instructions rather than definitions for terms and are thus ambiguous.

Sprinkles expressly incorporates the above General Objections as though set forth fully in response to each of the following individual interrogatories, and, to the extent they are not raised in any particular response, Sprinkles does not waive those objections. An answer to an interrogatory shall not be deemed a waiver of any applicable specific or general objection to an interrogatory. Likewise, an answer to an interrogatory shall not be deemed an admission of any assertions contained in that interrogatory.

RESPONSES

INTERROGATORY NO. 1:

Describe the facts surrounding the selection of the "SPRINKLES" mark by Applicant, identifying relevant dates and the persons most closely connected with the selection of the mark. Identify all related documents.

RESPONSE TO INTERROGATORY NO. 1:

Subject to and without waiving the General Objections, Sprinkles responds: Sprinkles' founders, Charles and Candace Nelson, conceived the name SPRINKLES CUPCAKES in or about February 2003. Sprinkles is not aware of any related documents.

INTERROGATORY NO. 2:

Identify each meeting or discussion at which the consideration, selection, approval or adoption of the "SPRINKLES" mark for use on any of Applicant's services and/or goods was discussed, and for each such meeting or discussion, identify each participant. Identify all related documents.

RESPONSE TO INTERROGATORY NO. 2:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and the specific objections above, Sprinkles responds: Charles and Candace Nelson discussed the SPRINKLES CUPCAKES name informally in or about February 2003. Sprinkles is not aware of any non-privileged related documents.

INTERROGATORY NO. 3:

Identify the individual(s) employed by or associated with Applicant who are most knowledgeable about Applicant's intended and/or actual use of "SPRINKLES" and the "SPRINKLES OF PALM BEACH" marks and registrations referred to by Applicant in its Answer to the Notice of Opposition.

RESPONSE TO INTERROGATORY NO. 3:

Subject to and without waiving the General Objections, Sprinkles responds: Charles Nelson of Sprinkles is most knowledgeable about Sprinkles' intended or actual use of its trademarks and trademark registrations.

INTERROGATORY NO. 4:

Identify and describe all services and all items of goods in connection with which "SPRINKLES" and "SPRINKLES OF PALM BEACH" marks are used, or are intended to be used, by Applicant, and by any licensee or other entity using those mark(s) with Applicant's permission. As to each item of goods and services state the annual revenues in dollars since use of the mark(s) commenced.

RESPONSE TO INTERROGATORY NO. 4:

Subject to and without waiving the General Objections, Sprinkles responds: Sprinkles uses or intends to use its SPRINKLES-related marks in connection with the following goods and services: bakery goods; retail shops featuring baked goods; clothing, namely, shirts, tank tops, baby bodysuits, and hats; computer software for locating retail stores featuring bakery goods,

desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and merchandise, and for providing information about bakery goods, desserts, and merchandise; computer software for mobile devices for locating retail stores featuring bakery goods, desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and merchandise, and for providing information about bakery goods, desserts, and merchandise; serving trays; serving trays with recessed holes to hold cupcakes; serving towers, namely, towers comprised of stacked serving trays; pet treats; mobile retail store services for the sale of baked goods from a custom vehicle; film and video distribution; entertainment services, namely, distributing audio, video, and multimedia content in the fields of food, drink, and leisure; ice cream; frozen yogurt; candy; sweets; cupcake mixes; and ice cream sundaes, sherbets, ices, sorbets, and milk shakes. Sprinkles has no plans to use the SPRINKLES OF PALM BEACH marks itself.

INTERROGATORY NO. 5:

Describe in detail Applicant's relationship and dealings with any and all prior owners of the "SPRINKLES OF PALM BEACH" marks and registrations referred to by Applicant in its Answer to the Notice of Opposition, including but not limited to the facts surrounding Applicant's first learning of "SPRINKLES OF PALM BEACH". Identify all related documents.

RESPONSE TO INTERROGATORY NO. 5:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and the specific objections above, Sprinkles responds: Sprinkles acquired the SPRINKLES OF PALM BEACH marks from Therapy Too, Inc. and Donna Marks, and Sprinkles now licenses use of the marks to Therapy Too, Inc. and Donna Marks. Sprinkles first learned of the SPRINKLES OF PALM BEACH

marks by reviewing the trademark register maintained by the U.S. Patent and Trademark Office. Sprinkles will produce related non-privileged documents that can be located after a reasonable search.

INTERROGATORY NO. 6:

Identify the types and classes of purchasers of the goods and services offered by Applicant under "SPRINKLES" and "SPRINKLES OF PALM BEACH" marks.

RESPONSE TO INTERROGATORY NO. 6:

Subject to and without waiving the General Objections, Sprinkles responds: Sprinkles offers goods and services under SPRINKLES-related marks, not including SPRINKLES OF PALM BEACH. The types and classes of purchasers of Sprinkles' goods and services include individuals, businesses and organizations who buy the following goods and services: bakery goods; retail shops featuring baked goods; clothing, namely, shirts, tank tops, baby bodysuits, and hats; computer software for locating retail stores featuring bakery goods, desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and merchandise, and for providing information about bakery goods, desserts, and merchandise; computer software for mobile devices for locating retail stores featuring bakery goods, desserts, and merchandise, for sending gift certificates for bakery goods, desserts, and merchandise, for sending virtual bakery goods, desserts, and merchandise, for games featuring bakery goods and desserts, for ordering bakery goods, desserts, and merchandise, and for providing information about bakery goods, desserts, and merchandise; serving trays; serving trays with recessed holes to hold cupcakes; serving towers, namely, towers comprised of stacked serving trays; pet treats; mobile retail store services for the sale of baked goods from a custom vehicle; film and video distribution; entertainment services, namely, distributing audio, video, and multimedia content in the fields of food, drink, and leisure; ice cream; frozen yogurt; candy; sweets; cupcake mixes; and ice cream sundaes, sherbets, ices, sorbets, and milk shakes.

INTERROGATORY NO. 7:

Describe in detail the nature of Applicant's business.

RESPONSE TO INTERROGATORY NO. 7:

Sprinkles objects to this interrogatory on the grounds that it is overly burdensome and harassing.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles is a retail bakery business that specializes in the creation and sale of premium-quality cupcakes. Sprinkles has retail locations in California, Arizona, and Texas. Sprinkles also licenses its marks to other retail merchants.

INTERROGATORY NO. 8:

With respect to each and every opinion of counsel which relates to or refers to Applicant's right to use or register "SPRINKLES", identify each written or oral communication by counsel providing each such opinion and each such communication requesting each such opinion. Provide the date any such opinion(s) was or were requested, as well as the date any such opinion was rendered, and provide a summary of the opinion(s) rendered. Identify all related documents.

RESPONSE TO INTERROGATORY NO. 8:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles has solicited and received advice from counsel in connection with its use of and applications to register SPRINKLES as a trademark. Sprinkles solicited and counsel provided such advice on or about July 13, 2005 and on or about February 19, 2009.

INTERROGATORY NO. 9:

Identify with specificity when and under what circumstances Applicant first learned of Opposer and Opposer's use of "SPRINKLES".

RESPONSE TO INTERROGATORY NO. 9:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles first learned of Opposer on or about December 16, 2009 when Opposer filed papers with the U.S. Patent and Trademark Office in connection with Sprinkles' application to register the mark SPRINKLES. Sprinkles first learned of Opposer's alleged use of SPRINKLES shortly thereafter.

INTERROGATORY NO. 10:

Describe in detail the factual basis, as presently understood, for each Affirmative Defense set forth in paragraphs 13 through 16 of Applicant's Answer to the Notice of Opposition. Identify all related documents.

RESPONSE TO INTERROGATORY NO. 10:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles maintains that Opposer's trademark rights, if any, are extremely narrow, that Opposer does not enjoy trademark priority over Sprinkles (insofar as, among other things, Sprinkles has acquired third-party trademark rights), that there is no likelihood of confusion arising from SPRINKLES' use of SPRINKLES-related marks, that Opposer has not been vigilant about enforcing its trademark rights, if any, and that accordingly it would not be just to allow Opposer to enforce its trademark rights, if any, against Sprinkles. Related documents would primarily be in the custody and possession of Opposer.

INTERROGATORY NO. 11:

Describe in detail Applicant's first use of (a) "SPRINKLES" and (b) "SPRINKLES OF PALM BEACH" with respect to both goods and services. Identify all documents and things

which Applicant contends supports its alleged first use dates and its alleged dates of first use in commerce.

RESPONSE TO INTERROGATORY NO. 11:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this interrogatory to the extent that it calls for a legal conclusion.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles' first use of SPRINKLES with goods and services is set forth in its Allegation of Use submitted to the U.S. Patent and Trademark Office in connection with registration no. 3306772 and is reflected in other documents to be produced in response to Opposer's document demands. *See* Sprinkles documents SC000001 to SC000002. Sprinkles does not use the SPRINKLES OF PALM BEACH marks itself but rather licenses the marks to third parties.

INTERROGATORY NO. 12:

Identify the person(s) most knowledgeable concerning:

a. the goods and services offered by Applicant;

b. trademarks, trade names, and service marks used by Applicant;

c. advertising and advertising plans in connection with which the "SPRINKLES" and "SPRINKLES OF PALM BEACH" marks have been or are currently used or are intended to be used;

d. Applicant's dealings with the prior owner(s) of the "SPRINKLES OF PALM BEACH" marks and registrations.

RESPONSE TO INTERROGATORY NO. 12:

Subject to and without waiving the General Objections, Sprinkles responds: Charles Nelson is the person most knowledgeable about the goods and services offered by Sprinkles, the trademarks, trade names and service marks used by Sprinkles, Sprinkles' advertising and

advertising plans, and Sprinkles' dealings with the prior owner of SPRINKLES OF PALM BEACH marks and registrations.

INTERROGATORY NO. 13:

Identify and describe in detail any conflict, allegation of infringement, or controversy, whether currently pending or resolved, with any third party involving Applicant and the "SPRINKLES" and/or "SPRINKLES OF PALM BEACH" marks. Identify all documents referring or relating thereto.

RESPONSE TO INTERROGATORY NO. 13:

Sprinkles objects to the interrogatory to the extent it seeks information protected by the attorney-client privilege and/or work product doctrine. Sprinkles objects to this request as vague and ambiguous to the extent the terms "conflict" and "controversy" are undefined and each are susceptible to multiple interpretations. Sprinkles further objects to this interrogatory on the grounds that it is overbroad and unduly burdensome.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles has alleged trademark infringement and related claims against the following U.S. users of SPRINKLES-related names and marks: Elizabeth Halpenny, Ali Loewenstein, Ryan Mealey, Matthew Mealey, Dan Mealey, Navigation Catalyst Systems, Inc., Pet Sprinkles, Inc., Perfect Cupcake, LLC, Belize Domain WhoIs Service Ltd., Sprinkles Ice, Sprinkles Fine Desserts, Say It With Sprinkles, Omar Jimenez, Sparkles Cupcakes, Sprinkles Edible Art, Olivia Moran Barre, Sprinkles for Girls, Yolanda Castro, and Sprinkles & Swirls.

INTERROGATORY NO. 14:

State Applicant's annual expenditures for advertising and/or promotion for each of Applicant's goods and services offered in connection with the "SPRINKLES" and "SPRINKLES OF PALM BEACH" marks since the date of first use of those marks.

RESPONSE TO INTERROGATORY NO. 14:

Sprinkles objects to this interrogatory on the grounds that it is overly burdensome and harassing.

Subject to and without waiving the General Objections and specific objections above, Sprinkles responds: Sprinkles does not have such annual expenditure data.

INTERROGATORY NO. 15:

Identify the person or persons most knowledgeable as to each of the answers provided to each of the foregoing Interrogatories.

RESPONSE TO INTERROGATORY NO. 15:

Subject to and without waiving the General Objections, Sprinkles responds: Charles Nelson is most knowledgeable as to each of the answers provided to each of the foregoing Interrogatories.

Dated: July 2, 2010

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: _____
John L. Slafsky
Matthew J. Kuykendall

Attorneys for Applicant
Sprinkles Cupcakes, Inc.

VERIFICATION

I, Charles Nelson, declare as follows:

1. I am Chief Executive Office of Sprinkles Cupcakes, Inc., and am authorized to make this Verification on behalf of Sprinkles Cupcakes, Inc.

2. I have read **APPLICANT SPRINKLES CUPCAKES' RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES.** I am informed and believe that the responses contained therein are true and correct.

I declare under penalty of perjury pursuant to the laws of the United States that the foregoing is true and correct.

Executed this 30 day of June, 2010 at Houston, Texas.

Charles E. Nelson II

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:

APPLICANT SPRINKLES CUPCAKES'S RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES

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 July 2, 2010.

Jo Ann Hylton

HALL & VANDE SANDE, LLC
ATTORNEYS AT LAW
10220 RIVER ROAD, SUITE 200
POTOMAC, MARYLAND 20854
TELEPHONE: (301) 983-2500
FACSIMILE: (301) 983-2100

THOMAS J. VANDE SANDE
DENNIS A. FOSTER
JOHN GIBSON SEMMES

OF COUNSEL
WILLIAM D. HALL
ROBERT R. PRIDDY

Patent, Trademark and Copyright Law and Litigation

September 13, 2010

John L. Slafsky, Esquire
Wilson, Sonsini, Goodrich and Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Re: Soft Serve, Inc. v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188

Dear John:

Our review of Sprinkles Cupcakes' Responses to Opposer's First Set of Interrogatories, Sprinkles Cupcakes' Responses to Opposer's First Request for the Production of Documents and Things and the various documents produced in response to our requests indicates that the discovery responses are incomplete. I write in hopes that we will be able to resolve these issues amicably and without pursuing these issues through a Motion to Compel.

Turning first to your client's responses to our First Set of Requests for Production, we cannot accept the reservation your client claims to use, rely upon, and offer into evidence documents or other information responsive to our requests which have not been produced, or which are not timely produced through supplementation. Please be advised that we will look to have excluded from consideration for any purpose documents and information not provided during discovery.

Through General Objection No. 4, and throughout Sprinkles Cupcakes' document production responses and interrogatory answers, we note frequent assertions of attorney/client privilege. However, in no instances do we find any identification of specific communications alleged to be privileged. Consequently, we request a privilege log or supplementation which will identify allegedly privileged (and work product) communications which have been withheld by Sprinkles Cupcakes in responding to our production requests and our interrogatories.

Turning to Applicant's responses to specific production requests, we note, as mentioned above, that no attempt has been made to identify any privileged documents. Also as noted above, we will seek to exclude any documents relating to your client's conception, adoption and selection of SPRINKLES as a mark to the extent that such are not produced during discovery.

As to Applicant's Response to Request No. 2, obviously the burden imposed on the parties is not substantially the same. Without question, the requested samples and/or specimens are relevant to the issues involved in this proceeding. We request prompt supplementation of this response.

Similarly, Applicant's Response to Request No. 3 is not acceptable in that the documents sought are not as accessible to Opposer as they are to Applicant. We ask that Applicant's Response and its related production of documents be supplemented and again note that we will seek to exclude related documents not produced during discovery.

Given the frequent announcement of planned new store openings, etc., we find it hard to believe that your client does not possess the information requested through Request No. 4. We ask that this response and related production be supplemented.

Applicant's response to Request No. 5 once again ignores the need to provide either a privilege log or some other means of communicating details relating to withheld documents. We ask that such be provided.

We are aware of the fact that SPRINKLES OF PALM BEACH registrations have been and continue to be routinely asserted against third parties. Related correspondence to these third parties is highly relevant and cannot conceivably qualify as the subject of attorney/client privilege or work product. We must insist that all such correspondence be promptly produced.

Similarly, we again ask Applicant to produce all non-privileged correspondence passing between Applicant and any previous owner of the SPRINKLES OF PALM BEACH marks and registrations. To the extent that any such communications are claimed to be privileged, we call upon Applicant to provide related details through a privilege log.

Turing to Applicant's response to Request No. 8, we again request the identification of documents withheld based upon privilege through a privilege log.

We also ask that Applicant provide details relating to its specific claims of privilege in response to Request No. 9. In addition, while we have been provided with search results for two searches conducted in 2005, we have not been provided with search results in connection with Applicant's 2009 search. We request the production of the 2009 search results.

Turning to Applicant's response to Request No. 10, obviously correspondence received by your client or your firm from or on behalf of third parties cannot be excluded from production on the basis of attorney/client privileged or work product. Consequently, we ask that all such correspondence and documents be produced. We again request a privilege log specifically providing details of any relevant documents withheld on the basis of privilege or work product claims.

I am particularly troubled by Applicant's response to Production Request No. 11. I fail to see how, under any circumstances, documents evidencing first use can be withheld on the basis of privilege or work product. Furthermore, the claim that documents evidencing your client's first use are as accessible to Opposer as they are to Applicant is simply untenable. We ask for the prompt supplementation of Applicant's response to this request. To the extent that Applicant contends that it has already produced documents evidencing its first use of SPRINKLES, we ask that Applicant specifically identify which of the documents it has produced to date are claimed to evidence Applicant's first use of the mark.

We do not see that we have been provided with any documents responsive to Request No. 14. Please provide such through supplementation or identify by production number relevant document(s) produced to date or acknowledge that no such documents exist. Parenthetically, while we seriously doubt that any valid claim of privilege or work product can be asserted in response to this request, to the extent that Applicant actually believes such is the case, we require the identification of responsive attorney/client privilege and/or work product documents.

Again, we require and are entitled to the identification of relevant documents, even in the event that the substance of the involved communications might arguably be shielded from discovery by either privilege or work product claims.

Please provide details in a supplemented Response to Request No. 16 that will allow us to evaluate Applicant's claim of privilege and work product in response to this request. We will look to exclude any and all relevant documentation and related information not produced during discovery. These comments are similarly relevant to Applicant's Response to Production Request No. 17.

Please identify with specificity any documents produced to date in response to Interrogatory No. 18. Please provide supporting details in connection with Applicant's claims of privilege and work product protection.

Please provide details identifying the documents requested through Request No. 19.

Please explain Applicant's basis for claiming that Request No. 20 is overly broad and unduly burdensome.

Production Request No. 21, referring to Opposer's Interrogatory No. 11, seeks documents relating to Applicant's first use of SPRINKLES. We fail to see how related documents can be withheld based upon claims of privilege or work product. Please explain Applicant's position in this regard and identify any documents withheld from production on the basis of either privilege or work product protection. In addition, we cannot accept Applicant's position that this request is objectionable "to the extent that it calls for a legal conclusion".

We request that any privileged documents responsive to Request No. 22 be identified with the specificity required. Moreover, we must insist that Applicant provide us with correspondence passing between itself and third parties responsive to Interrogatory No. 13. We very seriously doubt whether either Applicant or its counsel are flummoxed as a result of our references to "controversy" and "conflict".

Finally, Applicant has seen fit to represent on numerous occasions that it has frequently and successfully asserted alleged rights in connection with various SPRINKLES marks. Applicant's Response to Interrogatory No. 13 lists various individuals and businesses as third parties with whom a controversy or conflict has existed. We must insist that Applicant provide a better identification of the parties listed in its answer to Interrogatory No. 13. Moreover, we need Applicant to produce the

correspondence between itself or its counsel and third parties (or their counsel) relating to the subject matter inquired of in Interrogatory No. 13.

Applicant has propounded a production request identical to our Request No. 23. As you are likely aware, the TTAB takes a very dim view of a party objecting to discovery virtually identical to that which it has also propounded. We strongly urge Applicant to produce the documents requested through Production Request No. 23. These comments are equally applicable to Production Request No. 24 and Applicant's Response thereto.

We do not believe that any documents have been produced responsive to Request No. 25. To the extent that we are mistaken in this regard, please identify by production number those documents produced by Applicant in response to this request.

Please explain Applicant's position in avoiding Production Request No. 26.

Turning to Applicant's answers to Opposer's First Set of Interrogatories, we request an adequate identification of any and all communications withheld and not identified in Applicant's answers to Interrogatories 2, 5, 8, 9, 10, 11, and 13.

Please supplement Applicant's Response to Interrogatory No. 4 to include a statement of annual revenues, as requested.

Turning to Interrogatory No. 13, please provide specificity in connection with the various entities listed in Applicant's answer, and also details concerning conflicts, allegations, or controversies sufficient to constitute a meaningful answer.

In the event that Applicant cannot account for annual advertising and promotional expenses in connection with each of its goods and services, please provide us with annual figures companywide and without reference to individual products and/or services. This information is clearly discoverable and consequently we believe it very safe to assume that the TTAB would not find this interrogatory to be either overly burdensome or harassing.

Finally, turning to documents thus far produced by Applicant, we note various instances in which redaction has occurred. By way only of example we direct your attention to SC000003, SC000006, SC000239, SC000278, SC000286, SC000290, SC000295, SC000659, and SC000658. We ask that we be provided with a brief but meaningful explanation as to the basis for redaction in all instances in which we have been provided with incomplete documents.

We ask for the production of "The Sales Agreement" referred to in SC000239. We also request the revised agreement referred to SC000241.

I thank you in advance for your cooperation and prompt supplementation.

Sincerely,

Thomas J. Vande Sande

TVS:dn

WSGR Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
PHONE 650.493.9300
FAX 650.493.6811
www.wsgr.com

September 30, 2010

VIA EMAIL

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

Re: Soft Serve, Inc. v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188 (Application Serial No. 77/770,541 for SPRINKLES)

Dear Tom:

I am responding to your September 13, 2010 letter to John Slafsky concerning the allegedly incomplete responses by Sprinkles Cupcakes ("Sprinkles") to Opposer's First Set of Requests for the Production of Documents and Things ("Production Requests") and to Opposer's First Set of Interrogatories ("Interrogatories"). Before addressing your specific allegations, Sprinkles feels compelled to address the general tone of your letter, which assumes a general inadequacy with the production. Far from it, Sprinkles was diligent and thorough in its responses. The accusations of inadequacy are particularly jarring in light of the meager responses and production of Soft Serve, Inc. ("Soft Serve") in response to Sprinkles' discovery requests – in particular requests to identify and support Soft Serve's date of first use of the SPRINKLES mark – which Sprinkles will address under separate cover.

Production Requests

Unless otherwise noted, Sprinkles does not agree to supplement its production. In most of the instances raised in your letter, a supplemented production is not possible or is unnecessary because of one or more of the following reasons:

- Sprinkles does not have additional documents in its possession or control that are responsive to the Production Request (to ease in addressing the accusations in your letter, we have numbered the paragraphs – here we refer to paragraphs 7, 10, 13, 15, 18[1], 21);

[1] Sprinkles assumes that paragraph 18 concerns Production Request No. 18, rather than Interrogatory No. 18 as stated.

- Sprinkles has produced a sufficient representative sampling of documents responsive to the Production Request pursuant to the TTAB Manual of Procedure;
- The documents responsive to the Production Request are publicly available; and/or
- The documents responsive to the Production Request are in the possession of Soft Serve (*see, e.g.*, ¶ 20).

Paragraph 12 is one of many assertions that mischaracterize Sprinkles' position. You claim that Sprinkles produced two search reports from 2005, and demand production of the 2009 search. In fact, Sprinkles has produced one search from 2005 and one from 2009. (*See* SC000301 indicating that the second search report was completed on February 20, 2009.)

Numerous other paragraphs in your letter merely state and re-state a request for a redaction and privilege log (*see, e.g.*, ¶¶ 3, 4, 8, 10, 11, 13, 16, 17, 27, 31). Sprinkles will certainly provide such logs in the ordinary course, and expects Soft Serve to do the same. As we suspect is the case with Soft Serve as well, to the extent that any documents were redacted or withheld, they concerned attorney-client communications or notes by counsel, which are protected by the work product doctrine. Even if no documents were redacted or withheld on the basis of privilege pursuant to a particular request, Sprinkles is required to make a timely objection to the request on that basis, in the event that such documents emerge or are created in the course of the proceeding.

Several assertions concern a reference to publicly available materials (*see, e.g.*, ¶¶ 5, 6, 14). Sprinkles only means to convey that though documents responsive to the request may not be in Sprinkles' possession, they may be available in public databases or repositories. Such databases are equally available to Soft Serve as they are to Sprinkles. For example, for specimens of Sprinkles' marks, we direct you to the Trademark Document Retrieval service available at the U.S.P.T.O.'s website (www.uspto.gov).

Regarding paragraphs 9 and 22, in the interest of resolution of any discovery dispute, Sprinkles is willing to consider supplementing its production, assuming that the request refers to correspondence to and from third parties addressing the third parties' use of a trademark confusingly similar to Sprinkles' SPRINKLES mark. Although Sprinkles has fully responded to the request identified in paragraph 23, and although you do not further identify what information you still seek, Sprinkles is willing to supplement its response to Interrogatory No. 13 to provide additional information.

Regarding paragraph 24, Sprinkles will supplement its response to indicate that there are no documents in its possession or control that can be located after a reasonable search.

Regarding paragraph 25, you are mistaken, and the documents concerning use of SPRINKLES PALM BEACH are easily identifiable.

Regarding paragraph 26, Sprinkles did not "avoid" any request or interrogatory, but rather responded to each one methodically with applicable objections or information.

Regarding paragraph 28, Sprinkles agrees to look into your request.

In paragraph 32, you ask that Sprinkles produce the agreements referenced by SC000241 and SC000239. Sprinkles agrees to look into this request.

Interrogatories

Unless otherwise noted, Sprinkles does not agree to supplement its responses to the Interrogatories. To the extent that Soft Serve is now requesting information that is outside of the scope of its Interrogatories, it will be necessary for Soft Serve to serve Sprinkles with additional interrogatories.

Regarding paragraph 29, as noted above Sprinkles agrees to supplement its Response to Interrogatory No. 13.

Regarding paragraph 30, Sprinkles will investigate whether it can provide the revised information requested.

We trust that the information contained in this letter and Sprinkles' agreement to amend its discovery responses as noted above resolves the issues that you have raised.

Yours truly,

WILSON SONSINI GOODRICH & ROSATI
A Professional Corporation

Hollis Beth Hire

HALL & VANDE SANDE, LLC
ATTORNEYS AT LAW
10220 RIVER ROAD, SUITE 200
POTOMAC, MARYLAND 20854
TELEPHONE: (301) 983-2500
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THOMAS J. VANDE SANDE
DENNIS A. FOSTER
JOHN GIBSON SEMMES

OF COUNSEL
WILLIAM D. HALL
ROBERT R. PRIDDY

Patent, Trademark and Copyright Law and Litigation

November 9, 2010

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

Re: Soft Serve, Inc. v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188

Dear Hollie:

I write in response to your letter of September 30, 2010 concerning various of the discovery related issues raised in my letter of September 13.

Preliminarily, referring to page 3 of your letter, we ask that you forward to us the supplementations agreed to in connection with my September 13 letter, which you have addressed and identified as paragraphs 24, 28, 32, 29 and 30.

We continue to believe that supplementation is required with respect to Request No. 25 (also paragraph 25) in that we do not see produced to date documents sufficient to establish continuity of use of "SPRINKLES OF PALM BEACH". Please indicate whether Applicant will voluntarily make such documents available.

With respect to the production of search results (paragraph 12), the documents we have received do not contain a page identified as SC000301. Instead, we received two search reports, both of which contain an identical first page bearing "a date received" of July 13, 2005. The first page of each search report, as we received them, bears production number SC000659. The second page of the first search report bears production number SC000302. In the event that you represent that the search results starting at SC000302 are for the search completed on February 20, 2009, please provide us with a copy of SC000301 and we will be able to agree that we have then received both search reports.

Please provide us, at your very earliest convenience, with the privilege log promised at page 2 of your letter.

We again ask Applicant to supplement its Responses to Production Requests 2, 3, and 11 (paragraphs 5, 6, and 14) as well as its related production. As noted in my prior correspondence, the burden imposed on the parties to locate responsive documents and things is obviously not substantially the same. Moreover, your client, and not mine, should have the ability to offer information in connection with Sprinkles Cupcakes' first usage. Please indicate whether your client will voluntarily supplement its responses and related production as requested.

As earlier noted (paragraph 7), we have difficulty in accepting the representation that your client possesses no documents responsive to Request No. 4. Please supplement Applicant's response and production or, in the alternative, please confirm that your client's position is that no such documents exist.

You have indicated that Sprinkles "is willing to consider supplementing its production" as requested through paragraphs 9, 22 and 23. Please provide us with Applicant's supplementation or a statement that such will not voluntarily be forthcoming.

I do not see that the concerns we have raised relating to Applicant's Response to Request No. 3 (paragraph 24) have been addressed. Would you please provide us with Applicant's position in response to our request for a Response to this request.

I thank you in advance for your cooperation in resolving these open matters.

Sincerely,

Thomas J. Vande Sande

TVS:dn

WSGR Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
PHONE 650.493.9300
FAX 650.493.6811
www.wsgr.com

November 19, 2010

VIA EMAIL

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

Re: Soft Serve, Inc. v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188 (Application Serial No. 77/770,541 for SPRINKLES)

Dear Tom:

I am responding to your letter dated November 9, 2010, which we received late in the day on Friday, November 12.

We will be serving supplemental responses and delivering a privilege log next week.

Regarding SC000301, our records indicate that it was sent with the original production. In any event, another copy of the document is attached with this correspondence.

As we noted in prior correspondence, the only documents referred to when stating that Opposer has equal access are those not in Sprinkles' possession, but rather available only in public repositories such as the U.S. Patent and Trademark Office's online databases. Nonetheless, Sprinkles will supplement its production to provide additional documents from these public databases.

For paragraph 9, addressing correspondence asserting the SPRINKLES PALM BEACH marks against third parties: Sprinkles is still conducting its investigation, but is unaware of any such correspondence at this time. Regarding paragraphs 22 and 23, Sprinkles will provide more detailed information regarding third party conflicts in its supplementation next week.

In the penultimate paragraph of your letter – concerning "Request No. 3" – we cannot ascertain what information you are requesting. Sprinkles has responded fully to Request for Production No. 3 and Interrogatory No. 3. Paragraph 24 of your September 13 letter does not refer to "Request No. 3," but rather to Request No. 23. This Request concerned the documents identified in Sprinkles' responses to interrogatories. To the extent there are any such documents, Sprinkles will provide them. If you still have concerns meant to be expressed in this paragraph, please clarify your request.

We trust that this resolves the issues that you have raised.

Sincerely,

Hollis B. Hire /LR

Hollis Beth Hire

Enclosure

EXHIBIT B

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.	Opposition No: 91194188

APPLICANT SPRINKLES CUPCAKES' OPPOSITION TO OPPOSER'S MOTION TO COMPEL

I. INTRODUCTION

Applicant Sprinkles Cupcakes, Inc. ("Sprinkles") has rights in the SPRINKLES trademark for ice cream and retail stores offering ice cream that date back to 1985. Opposer Soft Serve, Inc. ("Opposer" or "Soft Serve") claims to have adopted the name "Sprinkles" in April 2002.[1] Despite its later priority date, Soft Serve has filed this opposition (and seven other proceedings before the Board) seeking an order denying registration of Sprinkles' mark.

In connection with its claims, Soft Serve has served numerous onerous and overreaching discovery requests. Nevertheless, Sprinkles has been forthcoming throughout the discovery process and has responded virtually completely to such requests. Sprinkles has responded to interrogatories and has produced nearly 2,000 pages of documents in three productions. On December 30, 2010, Sprinkles provided privilege and redaction logs to Soft Serve (Soft Serve has yet to provide such logs to Sprinkles).

[1] 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.

The vast majority of issues raised in the present Motion to Compel are moot (and many have always been moot), as Sprinkles has provided the documents or information requested, and has identified any materials withheld on privilege grounds. The only remaining issues are: whether Soft Serve is somehow entitled to production of all documents (including all opinions of counsel) protected by the attorney-client privilege and work product doctrine, whether a representative sampling of Sprinkles uses of the mark and Sprinkles advertising and promotion efforts (comprising hundreds of pages of documents) are sufficient when a full production of these materials would be overly burdensome, and whether Soft Serve is entitled to further responses to two requests that Sprinkles has objected to on the basis of relevance, among other grounds.

As discussed in detail below with respect to each request identified in the Motion, the Board should deny Soft Serve's Motion in its entirety, because (a) Soft Serve's request for waiver of privilege is outlandish and must be rejected, (b) for the vast majority of individual requests called out in the Motion, Sprinkles has produced or provided all documents and information in its possession, and Soft Serve has no reason for questioning the full production, (c) for the two requests where Sprinkles has produced a representative sampling of documents, such a production is commonplace and appropriate, and (d) for the two requests where there is a dispute between the parties, Sprinkles has properly objected that the requests are irrelevant and not likely to lead to the discovery of admissible evidence.

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*, *Travel & Leisure* and *InStyle*. Sprinkles adopted the SPRINKLES and SPRINKLES CUPCAKES marks for bakery goods and

services in 2004. Sprinkles has registered its SPRINKLES and SPRINKLES CUPCAKES marks in the U.S. and around the world.

In 2009, Sprinkles acquired the SPRINKLES PALM BEACH and SPRINKLES PALM BEACH and Design trademarks for ice cream and retail store services featuring ice cream. Use of the SPRINKLES PALM BEACH trademark began in Palm Beach in 1985, and the business received national press attention (including in Washington, DC, where Opposer claims to have rights) in the 1990s. The SPRINKLES OF PALM BEACH registration (Reg. No. 2938800) was filed on November 13, 2002, and registered on April 5, 2005. Sprinkles has licensed use of the marks, and Sprinkles' licensee continues use of the mark in connection with an ice cream shop in Palm Beach, Florida.

Opposer is a soft serve 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 substantiate this date.

B. The TTAB Proceedings and Discovery

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 opposed six other applications of Sprinkles, and has also sought cancellation of Sprinkles' registration for SPRINKLES for bakery goods and related retail services. (Cancellation No. 92053109).

The present opposition proceeding is stayed pending the disposition of the present motion. Sprinkles intends to file a motion requesting a stay of all related proceedings pending the disposition of this Motion as well.[2]

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[2] Several months ago, Opposer requested that all discovery in one action be available for use in the other Sprinkles-related actions pending before the TTAB. After clarifying Opposer's request, Sprinkles agreed to this arrangement. Therefore, because this Motion will affect all eight proceedings, Sprinkles submits that all proceedings should be stayed while the Motion is pending. On December 27, 2010, Sprinkles contacted counsel for Soft Serve to ask whether Soft Serve would consent to the motion, and has followed up on the request. This week counsel reported that Soft Serve is still considering whether it will consent. *See* Declaration of Hollis Beth Hire ("Hire Decl."), ¶ 2.

Soft Serve served discovery requests on May 28, 2010, and Sprinkles served timely responses with detailed interrogatory responses and hundreds of pages of documents. Sprinkles has since supplemented the production of documents twice, bringing the production to nearly 2000 pages of documents. *See* Hire Decl., ¶ 3, Exh. 1. Sprinkles has also provided redaction and privilege logs. *See* Hire Decl., ¶ 4, Exh. 2.

Sprinkles served discovery requests on June 11, 2010. Soft Serve responded on August 10, 2010 with meager responses to interrogatories and with only 173 pages of documents. Soft Serve objected on the basis of privilege in response to multiple requests. Though Sprinkles requested a privilege log in its letter of September 30 ("September 30 Letter," attached to Soft Serve's Motion), Soft Serve has not provided one. *See* Hire Decl., ¶ 5.

III. ARGUMENT

A. Attorney-Client Privilege and Work Product Doctrine Objections Are Reasonable and Valid.

The primary thrust of this Motion is a blasé and inappropriate request for a serious sanction: waiver of privilege for all of Sprinkles' documents and information. Soft Serve bases this request on the bald assertion that Sprinkles "failed to provide any supporting basis for" the assertion of privilege, *see* Motion at 1. However, Sprinkles has provided the supporting basis for its objections multiple times. In its September 30 Letter, Sprinkles explained:: "As we expect is the case with Soft Serve as well, to the extent that any documents were redacted or withheld, they concerned attorney-client communications or notes by counsel, which are protected by the work product doctrine." September 30 letter, at 2. Sprinkles withheld conservatively; the only (arguably) responsive documents not included its production (and information withheld from interrogatory responses) concern communications between the proprietor or other employees of Sprinkles, on the one hand, and attorneys at Wilson Sonsini Goodrich & Rosati, Sprinkles' outside counsel, on the other. The communications concern legal advice to Sprinkles. There is no question that attorney-client privilege applies to these communications.

Though Sprinkles submits that the explanation in its September 30 letter does provide the required substantiation of privilege for the type of documents withheld, the matter is moot because Sprinkles later provided a privilege log, detailing each communication withheld on the basis of privilege. *See* Hire Decl., ¶ 4, Exh. 2. When not unduly burdensome, Sprinkles identified the sender, recipient, date, and substance of each communication (i.e., "advice regarding the instant dispute").[3]

It is black letter law that parties are not entitled to discovery of privileged materials. *See, e.g.*, TBMP § 402.02 ("[I]nformation protected by the attorney-client privilege is not discoverable unless the privilege has been waived."). It is equally well-established that waiver of privilege is a serious sanction, appropriate only in egregious cases. "Waiver of a privilege is a serious sanction most suitable for cases of unjustified delay, inexcusable conduct, and bad faith." *United States v. Philip Morris Inc.*, 347 F.3d 951, 954 (2003). Waiver is not even an automatic result of any technical discovery misstep; even when a party fails to respond to discovery *at all*, such a violation does not trigger the waiver of privilege for documents and information that would have been responsive. *See* TBMP § 403.03. Such a sanction is certainly not applicable here, where Sprinkles complied with its discovery obligations and further provided materials upon meeting and conferring with counsel.

The TTAB has never imposed such a sanction. The TTAB has addressed the issue of privilege log in one case: *M.C.I. Foods, Inc. v. Brady Bunte*, 86 USPQ2d 1044 (February 19,

[3] When detail for each document proved too burdensome, Sprinkles provided a category to documents with sufficient information to substantiate the privilege. Sprinkles used this approach to address documents withheld in response to Soft Serve's request for all documents and information concerning "opinions of counsel" on the use and registration of the SPRINKLES marks. *See* Soft Serve's Production Request No. 5 & Interrogatory No. 8. These requests arguably call for production of every communication between Sprinkles and outside counsel over the course of several years. In addition, the requests (for "opinions of counsel") only implicates privileged materials. Given Soft Serve's dogged pursuit of this paradigmatically privileged information, that it clearly does not have a right to discover, Sprinkles suspects that the requests were propounded merely to create an expensive discovery burden in the creation of a detailed privilege log for a voluminous set of obviously privileged materials. Fortunately, the law does not require parties to participate in such busy-work, and instead deems the identification of the category of documents – often including the senders and recipients, the date range, and the general subject matter – to be sufficient. *See Securities and Exchange Commission v. Thrasher*, 1996 WL 125661 (S.D.N.Y. 1996) (holding that a description of categories of documents is sufficient); *see also Securities and Exchange Commission v. Nacchio*, 2007 WL 219966 (D. Colo. 2007) (same). Sprinkles has provided this description.

2008). In *MCI Foods*, the Board ordered a party to provide privilege log only after the party had failed to respond to discovery, *and* only after the party failed to comply with a prior Board order to produce discovery. *See id.* at 1048. Even in these circumstances, the Board did not impose the exceedingly harsh sanction of waiver of privilege. Soft Serve's request to impose this sanction here – where Sprinkles did provide timely responses to discovery, did provide an immediate explanation for the basis of privilege claims, and did provide an official privilege log – is unprecedented and absurd.

In federal courts as well, waiver of privilege is a sanction only applied in egregious circumstances. In general, if a party has failed to provide a privilege log or other type of explanation of the basis for privilege, the court – like the Board in *M.C.I. Foods* – will simply order the party to provide a log. For example, in *Smith v. Café Asia*, 256 F.R.D. 247, 251 (D.D.C. 2009), a party requested waiver of privilege for another party, who had not provided a privilege log or any basis for claims of privilege nearly a year after a request for a privilege log. The *Smith* court rejected the request to impose the sanction, holding that the party's "discovery violation does not justify such a sanction." *See id.* Instead, the court merely ordered the party to provide a privilege log. *Id. See also TIG Insurance Co. v. Fireman's Insurance Co. of Washington DC*, 718 F. Supp. 2d 90, 97 (D.D.C. 2010) ("[T]he court generally does not deem a party to have waived a privilege because it did not provide an adequate privilege log.") (citing *Smith*); *Trustees of Electrical Workers Local No. 26 Pension Trust Fund v. Trust Fund Advisors*, 266 F. R.D. 1, 9 n.8 (D.D.C. 2010) ("[F]ailure to produce a privilege log does not justify the harsh sanction of privileged documents.") (citing *Smith*).

Soft Serve has not even asserted – let alone proven – any violation or bad faith on the part of Sprinkles that would justify this harsh remedy. The cases Soft Serve cites are older, and in any event do not contradict (or even deviate from) the strong consensus in the federal case law that waiver is only imposed as a sanction in extreme cases of bad faith, unjustified delay and inexcusable conduct. *See First American Corp. v. Al-Nahyan*, 2 F. Supp. 2d 58, 60 (D.D.C. 1998) (merely stating a general rule to provide a basis for privilege claims; the case concerned sealing of

criminal records under a New York statute); *Banks v. Office of the Senate Sergeant-At-*Arms, 222 F. R.D. 7, 20 (D.D.C. 2004) (holding that waiver sanction was not warranted); *Bregman v. D.C.*, 182 F.R.D. 352 (D.D.C. 1998) (finding waiver of privilege only when the party failed to present any indication of why documents withheld would qualify for privilege, and when the party had failed to comply with court orders).

For these reasons, Soft Serve's repeated, extreme, and unjustified requests for waiver of privilege must be denied.

B. Specific Requests

1. Requests in the Motion for which Opposer's Only Argument Concerns Privilege

The bulk of the specific requests in the Motion concern only the outlandish request for waiver of privilege. For the reasons discussed above, this argument must be rejected; as a result, all issues in the motion pertaining to the following requests will be resolved, as privilege is the only issue asserted:

- Production Request No. 1, for documents relating to the adoption of the SPRINKLES mark.
- Production Request No. 5, for opinions of counsel.
- Production Request No. 8, for documents which mention Opposer. Soft Serve also argues that the objection based on overbreadth is ill-founded, but no documents were withheld on this basis.
- Production Request No. 9, for documents related to search reports.
- Production Request No. 14, for documents evidencing Sprinkles' intent to use the SPRINKLES mark in connection with the goods in the application. Soft Serve also argues that the objection based on overbreadth is ill-founded, but no documents were withheld on this basis.

- Production Request No. 15, for documents showing the circumstances under which Sprinkles learned of Soft Serve.
- Production Request No. 18, for documents related to the relationship and dealings between Sprinkles and the previous owners of SPRINKLES PALM BEACH.
- Interrogatory No. 5, for information related to the relationship and dealings between Sprinkles and the previous owners of SPRINKLES PALM BEACH.
- Interrogatory No. 8, for opinions of counsel.

2. Remaining Requests Where There Is No Dispute

There are few issues remaining after the privilege issue is resolved. For most of the remaining issues, there is no dispute between the parties:

Production Request No. 4, for marketing plans. Sprinkles has responded to this request, and has notified Soft Serve that there are no responsive documents in its possession. Sprinkles has explained this response repeatedly, and has reiterated that there are no responsive document. Soft Serve does not present any reason or basis for its request to compel a response, as Sprinkles has already responded fully to the production request.

Production Request No. 7, for documents related to acquisition of the SPRINKLES PALM BEACH marks, and correspondence between Sprinkles and a third party regarding the SPRINKLES PALM BEACH marks. Sprinkles has produced all documents in its possession regarding the acquisition (as Opposer concedes, *see* Motion at 7), and has also produced all correspondence regarding Sprinkles' enforcement of the SPRINKLES PALM BEACH marks. The documents are at SC000104-SC000124. Soft Serve has not articulated a basis for believing that additional documents exist, beyond the vague innuendo that "it is believed that Applicant routinely asserts the SPRINKLES OF PALM BEACH marks and registrations as part of its practice in threatening third party users of SPRINKLES related marks." Motion at 7. Indeed Sprinkles is not aware of any additional documents in its possession that are responsive to this request. Sprinkles has not withheld any correspondence between Sprinkles and third parties regarding enforcement of

the SPRINKLES PALM BEACH marks. For these reasons, Soft Serve's request to compel documents is inadequate and moot.

Opposer also argues that privilege should be waived for this request, but for the reasons stated above such a request must be denied. To the extent there are any attorney-client communications regarding the acquisition or enforcement of the SPRINKLES PALM BEACH marks, such documents are protected from disclosure by the attorney-client privilege and have been identified properly in Sprinkles' correspondence and privilege log.

Production Request No. 10, for documents relating to challenges by third parties to Sprinkles' right to use or register SPRINKLES. Sprinkles has fully complied with this request. The documents are located at SC000104-SC000124.

Opposer also argues that privilege should be waived for this request, but for the reasons stated above such a request must be denied.

Production Request No. 11, for documents evidencing Sprinkles' first use of Sprinkles. Sprinkles has produced all documents related to this request. Sprinkles initially objected on the basis that publically available documents were equally available to Soft Serve, and explained this objection in its September 30 letter ("though documents may not be in Sprinkles' possession, they may be available in public databases or repositories. Such databases are equally available to Soft Serve as they are to Sprinkles." September 30 letter at 2. Sprinkles further directed Soft Serve to the Trademark Document Retrieval service at www.uspto.gov. *See id.* Though this objection was valid and appropriate, in a subsequent production on November 23, 2010, Sprinkles produced all file wrappers for the SPRINKLES-related applications, and all publically available news articles found through online, public archives and LEXIS and Westlaw news searches. Sprinkles also produced a full copy of its website in its first production to Soft Serve, even though that information was available to Soft Serve as well. There are no documents withheld on the basis that they are publically available and therefore equally available to Opposer, and therefore no documents to compel.

To the extent privileged documents could evidence Sprinkles' first use date, these documents were not produced. Soft Serve's request to impose waiver of privilege should be denied for the reasons discussed above.

Interrogatory No. 11, requesting information regarding the first use of Sprinkles' marks. Sprinkles responded fully with respect to its own use of the trademark in the initial responses, identifying the documents in the production which stated Sprinkles' first use in 2004. In addition, Sprinkles has produced additional documents as noted above, which provide and substantiate the information sought in the request. Even so, Sprinkles has also provided a supplemental response to this interrogatory, identifying the 1985 first use date for SPRINKLES OF PALM BEACH. *See* Hire Decl., ¶ 6.

Production Request No. 21, for documents related to the first use of SPRINKLES and SPRINKLES OF PALM BEACH. Sprinkles objected to this request to the extent it called for a legal conclusion; Soft Serve argues that this objection is unfounded. There can be no dispute that the term "first use" in the trademark context is a legal term of art, and that numerous cases, articles, and treatises are dedicated to the meaning of the term. Indeed, there are entire sections of the Trademark Manual of Examining Procedure devoted to the meaning of the term in the context of an application at the Patent and Trademark Office, *see, e.g.*, §§ 901 & 903, and full chapters in major trademark treatises dedicated to the type of use that constitutes "first use" for establishing priority of a trademark, *see, e.g.*, McCarthy on Trademarks and Unfair Competition, Chapter 16: Acquisition and Priority of Trademark Rights.

Regardless, Sprinkles has produced documents to demonstrate that its first use of the SPRINKLES mark for bakery goods in 2004, and that its rights in the SPRINKLES PALM BEACH mark date back to 1985. *See* SC000250-SC000255. Soft Serve, on the other hand, has produced no documents showing use in commerce of the SPRINKLES mark before 2005, and no documents showing contemplation of use before November 2002, even though it claims a first use date of April 2002.

Interrogatory No. 13, requesting parties against whom Sprinkles has asserted its trademark rights in the SPRINKLES and SPRINKLES OF PALM BEACH marks. Under the heading of Request for Production No. 22 (which Sprinkles addresses in Section III.B.3 below), Soft Serve raises an issue concerning Sprinkles' response to this Interrogatory. Sprinkles initially identified all the parties, as requested in the interrogatory. Though not requested in the interrogatory, Sprinkles has further provided a supplemental response identifying the marks at issue in each matter. *See* Hire Decl., ¶ 6. Therefore, Sprinkles has addressed all concerns raised in the Motion pertaining to this Interrogatory.

Production Request No. 25, requesting documents sufficient to show continuity of usage of the SPRINKLES OF PALM BEACH marks. Soft Serve takes issue with Sprinkles' objection to the vague and ambiguous term "continuity of use." This objection is well founded, as the term is unclear: Is Soft Serve requesting documents submitted to the PTO to establish that Applicant's use has been continuous to satisfy filings under Sections 8 & 15? Is Soft Serve requesting news articles from the 1990s through 2010 demonstrating that Sprinkles and its licensee (and predecessor in interest) have used the SPRINKLES OF PALM BEACH marks over time, and still use the marks? In any event, Sprinkles has produced documents sufficient to satisfy either meaning of the request, as it has produced the entire file wrapper for the SPRINKLES OF PALM BEACH marks, including the Section 8 & 15 filings, as well as relevant articles demonstrating use of the marks over time.

For these reasons, Soft Serve's motion concerning these Requests and Interrogatories should be denied.

3. Requests Where There Is a Dispute

After dispensing with the privilege issue and the Requests and Interrogatories where there is no dispute between the parties (as there are no further documents or information to disclose), there are only four remaining requests:

Production Request No. 2 & 3, for samples of each different use of the mark, and for materials relating to advertising or promotion, respectively. Sprinkles responded to these requests,

and produced numerous documents showing use of the SPRINKLES mark on packaging, on signage, and on other products (i.e., water bottles). Sprinkles further provided a full copy of its website, and other marketing materials as well. These documents are representative of Sprinkles' use of the mark, and of its advertising and marketing efforts. To produce all documents *related to* marketing the SPRINKLES mark would be highly burdensome, as Sprinkles has engaged in widespread promotion efforts and has received an enormous amount of media attention. In such cases, production of a representative sampling of documents is commonplace and acceptable. *See* TMBP § 402.02 ("For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought."). Advertising material is the paradigmatic example of the category of documents for which a representative sampling is appropriate. *See Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 288 (TTAB 1974) (allowing a representative sampling of advertising material) (*cited in* TBMP § 402.02, n. 14).

Sprinkles has produced hundreds of pages of documents to comprise a representative sampling of use and advertising material. Soft Serve does not articulate why the representative sampling here is not satisfactory, nor does it explain what advantage additional documents would convey. Indeed, the only effect of a full production would be to unduly burden Sprinkles. Soft Serve's Motion should be denied with respect to Production Requests 2 and 3.

Production Request No. 22, for documents related to conflicts, challenges and controversies with third parties involving Sprinkles' marks. As mentioned above, in its response to Interrogatory No. 13, Sprinkles has provided information concerning the identities of the parties with whom it has addressed inappropriate use of the SPRINKLES mark. Sprinkles has also supplemented its responses to provide information regarding the trademarks involved in each dispute.

The demand letters and other correspondence between Sprinkles and these parties is irrelevant, and not likely to lead to the discovery of admissible evidence. Soft Serve has presented no reason or justification for why this information would be necessary to pursue its claims in this

action. Indeed, there is no reason. For this reason, Soft Serve's Motion to compel further documents pursuant this request should be denied.

Interrogatory No. 4, for revenues of Sprinkles and its licensee. This request is similarly irrelevant and not likely to lead to the discovery of admissible evidence. Like all TTAB proceedings, this action solely concerns the registration of the mark. The Board does not issue damages, or any other kind of monetary relief. *See* TBMP § 502.05 ("The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party."); *see also Babson Bros. Co. v. Surge Power Corp.*, 39 U.S.P.Q.2d 1953, 1954 (TTAB 1996) ("[T]he Board cannot enjoin a party from using a mark, nor can it award monetary damages.") (superceded on other grounds). There is no relationship between Sprinkles' revenues and the registrability of this SPRINKLES trademark. With respect to Sprinkles' licensee's revenues, in addition to being irrelevant to this proceeding, the information is also outside of Sprinkles' possession, custody, or control.

Soft Serve again has presented no reason for its request, and no basis for the relevance of this information. In contrast, the information is highly commercially sensitive, and Sprinkles is understandably uncomfortable with the release of such information even with the Protective Order in place. For these reasons, Soft Serve's Motion to compel this information should also be denied.

IV. CONCLUSION

For the reasons stated above, Sprinkles requests that Soft Serve's Motion to Compel be dismissed in its entirety.

Dated: January 14, 2011

Respectfully Submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

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

Attorneys for Applicant
Sprinkles Cupcakes, Inc.

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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.	Opposition No: 91194188

DECLARATION OF HOLLIS BETH HIRE

1. I am an attorney at Wilson Sonsini Goodrich & Rosati, counsel for applicant Sprinkles Cupcakes Inc. ("Sprinkles") in this matter. I have personal knowledge of the facts set forth in this declaration.

2. Several months ago, Thomas Vande Sande, counsel for Opposer 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, and I have followed up on the request by email. This week, Mr. Vande Sande responded to my email, and reported that he would let me know in the next few days.

3. Attached as Exhibit 1 are true and correct copies of correspondence from my office transmitting nearly 2000 pages of documents to counsel for Soft Serve.

4. Attached as Exhibit 2 are true and correct copies of Sprinkles' redaction and privilege logs provided to counsel for Soft Serve on December 30, 2010.

5. Though Soft Serve objected on privilege grounds to multiple discovery demands, and though Sprinkles requested a privilege log in September, Soft Serve has not provided a privilege log to Sprinkles.

6. On January 13, 2011, Sprinkles served additional supplemental discovery, supplementing the responses to Interrogatories 11 and 13. The supplemental response to Interrogatory No. 11 identified the 1985 first use date for SPRINKLES OF PALM BEACH. The supplemental response to Interrogatory 13 included all the marks at issue in the disputes listed.

I declare under penalty of perjury that the foregoing is true and correct. Executed at Oakland, California, on January 14, 2011.

/s/ Hollis Beth Hire
Hollis Beth Hire

EXHIBIT 1

WSGR Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
PHONE 650.493.9300
FAX 650.493.6811
www.wsgr.com

July 9, 2010

VIA OVERNIGHT COURIER

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

Re: Soft Serve v. Sprinkles – Opposition No. 91194188 (Trademark Trial and Appeal Board)

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC000001 – SC000935. Please note that some of the documents are designated "Confidential" or "Trade Secret/Commercially Sensitive" pursuant to the Stipulated Protective Order approved by the Board on July 2, 2010. The enclosed documents must be treated as specified by the Protective Order.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Matthew J. Kuykendall

Enclosures

WSGR Wilson Sonsini Goodrich & Rosati
PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
PHONE 650.493.9300
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November 23, 2010

VIA U.S. MAIL

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

Re: Soft Serve v. Sprinkles – Opposition No. 91194188 (Trademark Trial and Appeal Board)

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC000936 – SC001690. Please do not hesitate to call if you have any questions.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Hollis Beth Hire

Enclosures

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PROFESSIONAL CORPORATION

650 Page Mill Road
Palo Alto, CA 94304-1050
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December 28, 2010

VIA U.S. MAIL

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

Re: Soft Serve v. Sprinkles – Opposition No. 91194188
(Trademark Trial and Appeal Board)

Dear Mr. Vande Sande:

Enclosed please find Sprinkles' production of documents bearing bates numbers SC001691 - SC001913. Please do not hesitate to call if you have any questions.

Sincerely,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

Hollis Beth Hire

Enclosures

4210536_1.DOC

EXHIBIT 2

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188
Redaction Log for 7/9/10 Production by Sprinkles Cupcakes, Inc.

SC000006	Email from B. Nelson to Charles re: palm beach daily news claims 1983 in fire article	Email communication from C. Nelson to J. Slafsky on 3/29/2010 protected by attorney-client privilege
SC000239	Email from D. Marks to B. Nelson re: fedex label for samples	Email communication from B. Nelson to J. Slafsky on 6/14/2010 protected by attorney-client privilege
SC000278	Email from B. Nelson to C. Nelson re: Palm beach -- privileged/confidential	Email communication from C. Nelson to J. Slafsky on 7/20/2009 protected by attorney-client privilege
SC000286	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Invoice from Dr. Bob's of Upland	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000288	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000290	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000292	Email from DrBobsIceCream to Charles re: Dr.bob's ice cream	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000293	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Invoice from Dr. Bob's of Upland	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000295	Email from Dr. Bob's Handcrafted Ice Creams to Charles re: Report from Dr. Bob's Handcrafted Ice Creams	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege
SC000297	Email from A. Lenardin to Charles re Ice cream packaging	Email communication from C. Nelson to J. Slafsky on 6/23/2010 protected by attorney-client privilege

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188
Redaction Log for 7/9/10 Production by Sprinkles Cupcakes, Inc.

SC000300	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine
SC000658	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine
SC000659	Trademark Research Report	Notations written by WSGR staff protected by work product doctrine

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Applicant Sprinkles Privilege Log

December 29, 2010

Date	To	From	Subject	Privilege Claim
7/15/2005	Charles Nelson	John Slafsky	Attorney advice regarding availability search for SPRINKLES mark	Attorney-client privilege
2/23/2009	Charles Nelson	Hollis Hire	Attorney advice regarding availablility search for SPRINKLES mark	Attorney-client privilege
3/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
3/29/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/1/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/3/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/6/2010	Bobby Nelson & Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/1/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/7/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/10/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/16/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/17/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/24/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/27/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Matthew Kuykendall	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Matthew Kuykendall	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Charles Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.
Opposition No. 91194188
Applicant Sprinkles Privilege Log
December 29, 2010

Date	To	From	Subject	Privilege Claim
7/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
7/7/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
7/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
8/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Matthew Kuykendall & Bobby Nelson	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
8/30/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/4/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/5/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/7/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/12/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/25/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/28/2010	John Slafsky & Hollis Hire	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
10/29/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/1/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/8/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/23/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/30/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
12/1/2010	John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
12/1/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
12/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
2005-2010	Charles Nelson, Nicole Schwartz, & Bobby Nelson	John Slafsky, Hollis Hire, Matthew Kuykendall, and other attorneys at Wilson, Sonsini, Goodrich & Rosati	Opinions of outside counsel regarding Sprinkles' right to use or register SPRINKLES	Attorney-client privilege & work product doctrine

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:

1. **APPLICANT SPRINKLES CUPCAKES' OPPOSITION TO OPPOSER'S MOTION TO COMPEL**

2. **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 January 14, 2011.

Jo Ann Hylton

EXHIBIT C

TTAB

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
	)	77/770,541
Sprinkles Cupcakes, Inc.	)	
	)	
Applicant.	)	
	)	

OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO COMPEL

I. INTRODUCTION

Opposer respectfully requests consideration of this Reply Brief and accompanying exhibits offered in support of its Motion to Compel.[1] This Reply Brief is offered for the purpose of clarifying issues and disputes, addressing matters raised for the first time in Applicant's Brief, and correcting the most glaring of the inaccuracies set forth therein.[2]

02-02-2011

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #0

[1] Applicant has incorporated into its briefing various arguments and assertions advocating its positions with respect to use dates, the nature of Opposer's business, Opposer's discovery responses, etc. To the extent that these allegations are not related to Opposer's Motion to Compel, such are not proper subject matter for argumentation or consideration at this point and Opposer has resisted the urge to respond to these allegations at this juncture. Suffice it to say that Opposer in no way agrees with Applicant's conclusions and characterizations and will methodically dispose of such in a procedurally appropriate manner outside of this Motion to Compel.

Applicant also uses its Brief in response to Opposer's Motion to Compel to assert its position that the filing of Opposer's Motion should result in the stay of all proceedings between the parties. It is submitted that the parties' briefing in connection with Opposer's pending Motion to Compel is not a procedurally appropriate vehicle for requesting, nor for ordering, the suspension of the other proceedings. Moreover, the issues involved may be somewhat more complex than they initially appear. Nevertheless, Opposer's counsel will, promptly upon the filing and service of this Reply Brief, correspond with Applicant's counsel concerning this issue. In the meanwhile, Opposer would greatly appreciate the Board deferring any action in connection with Applicant's suggestion that a suspension of all proceedings would be appropriate.

[2] Without exception, the Exhibits submitted herewith comprise documents generated or produced by Applicant and documentation provided to Applicant during the pendency of this proceeding. Thus, the Board's consideration of these Exhibits in no way unfairly disadvantages Applicant or constitutes "surprise".

II. ARGUMENT

A. Applicant's Arguments With Respect To Specific Interrogatory Answers And Production Request Responses Are Unavailing.

1. Applicant Is Required To Produce Requested Information Divulging Its Revenues.

Noting that "The Board does not issue damages, or any other kind of monetary relief" (Ap. Br. p. 13), Applicant asserts that Opposer's Interrogatory No. 4 requesting information relating to Applicant's revenues in connection with goods offered under its SPRINKLES marks is not discoverable. In fact, this information is clearly discoverable. *Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 U.S.P.Q. 147, 148 (TTAB 1985).

Moreover, Applicant has similarly propounded discovery inquiring of Opposer's sales. See Ap. Int. 5 and Ap. Prod. Reqs. 18 - 20, as well as Opposer's responses thereto, submitted herewith as Ex. 7.[3] Having requested (and received) such financial information from Opposer, Applicant cannot claim that it is not required to provide meaningful responses to discovery probing the same subject matter. See TBMP § 402.01 and cases cited therein.[4]

2. Applicant Is Required To Respond In Full To Discovery Relating To Third Party Challenges.

Applicant, for the first time in its Response brief, claims that documentation and correspondence pertaining to challenges and claims involving third parties under the SPRINKLES mark, and the SPRINKLES OF PALM BEACH registrations asserted by Applicant in its Answer to the Notice of Opposition, are irrelevant. This assertion is erroneous as a matter

[3] Exhibit numbering continues sequentially from Opposer's opening brief.

[4] In the event that the requested financial information is not ordinarily kept by Applicant in the exact manner requested by Opposer, Applicant should be required to produce annual summaries of sales/revenues, as such were generated and produced by Opposer in response to Applicant's sales related discovery.

of law. See, for instance, *Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral and Maxillofacial Surgeons*, 201 USPQ 531, 534 (TTAB 1979).

Consequently, Applicant should be ordered to produce all documents relating to conflicts, challenges and controversies with third parties. (Op. Prod. Reqs. 10 and 22). Applicant also needs to fully and candidly respond to Interrogatory No. 13 which requests information relating to conflicts, etc., with third parties. In addition, the "identification" of the 19 individuals named in response to Interrogatory No. 13 needs to be supplemented to provide, at a minimum, addresses and telephone numbers. The mere listing of names provided by Applicant does not constitute a meaningful identification and such additional information is obviously within Applicant's possession as it has communicated with these parties. Finally, Applicant also needs to identify litigation is has brought relating to its marks. Applicant has instituted relevant litigation and not divulged such in its discovery responses.

3. The "Representative Samplings" Relied Upon By Applicant Are Patently Inadequate.

Applicant argues that it has produced to Opposer a representative sampling of various categories of requested documents and things in response to Op.'s Prod. Reqs. 2 and 3. However, Applicant's production in this regard is patently inadequate. Evidencing this shortcoming is the fact that no samples of specimens (Op. Prod. Req. 2), nor advertising or promotional materials generated by Applicant or others under Applicant's marks (Op. Prod. Req. 3) have been produced with respect to, for instance, the "Sprinkles-branded cupcake mix available at Williams-Sonoma" noted by Applicant at page 2 of its Brief. [5]

[5] Obviously, as Applicant has refused to produce any sales information, Opposer has also been deprived of the ability to consider or further explore the extent of any sales to Williams-Sonoma and the time periods during which any such sales may have occurred.

4. Applicant is Required to Provide A Meaningful Response To Discovery Directed to Registrations Applicant Has Introduced Into This Proceeding.

Applicant, since the filing is its Answer, has repeatedly relied upon two U.S. trademark registrations obtained by assignment in 2009. (See Applicant's Answer to Notice of Opposition ¶ 16). Opposer's Production Request. No. 25 unambiguously requests the production of documents establishing continuity of use of those marks.

Applicant has elected to ignore the clear thrust of this inquiry by claiming that it is confused, and that it is being forced to decide whether Opposer's inquiry is directed to documents which would satisfy a Section 8 filing or, instead, news articles. (Ap. Br. p. 11.) Opposer's request is not confusing and Applicant's choices are not so limited. Opposer is entitled to probe issues concerning Applicant's ability to rely upon registrations it has elected to interject into this proceeding. Clearly, an inquiry requesting documentation in support of continuity of use of the asserted marks is appropriate and cannot be fairly read to be limited to materials submitted in support of a Section 8 Declaration or news articles authored by third parties which possess no evidentiary value.

Applicant should be ordered to provide a full and meaningful response to Request No. 25 and to either produce the documents called for or to acknowledge its inability to establish continuity of use of the marks it has interjected into this proceeding.

5. Applicant Must Produce Documentation Relating To Its Marketing Plans.

Applicant touts its eight U.S. locations (Ap. Br. p. 2). Its website proudly announces the opening of new stores, and the estimated opening dates of yet more stores, such as those currently contemplated in Washington, D.C. and New York. (Ex. 8) Nevertheless, Applicant

steadfastly insists that no documentation exists comprising, relating, or referring to any market plans for goods or services offered, or to be offered, by Applicant under the SPRINKLES mark. (See Ap. Res. to Op. Prod. Req. 4 and Ap. Br. p. 8) Applicant's plans for expansion are clearly relevant under various *DuPont* factors and it is obvious that Applicant's expansion cannot be occurring without its possessing marketing plans responsive to the call of Op. Prod. Req. 4. Consequently, Applicant should be required to produce the documentation requested.

B. Applicant's Claims of Attorney-Client Privilege And Work Product Protection Are Without Support And Its "Privilege Log" Totally Inadequate.

1. The Attorney-Client Privilege

F.R.C.P. 26 (b)(5)(A) unambiguously states:

> When a party withholds information otherwise discoverable by claiming that the information is privileged or subject to protection as trial-preparation material, the party must;
>
> (i.) expressly make the claim; and
> (ii.) describe the nature of the documents, communications, or tangible things not produced or disclosed – and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.

The notes following Rule 26 are also unambiguous in stating the privilege claimant's obligations. "The objection must include sufficient information so that the court and opposing counsel can assess the applicability of the privilege." Actions that might constitute waiver of the privilege are also specifically addressed in the drafter's notes. ("Privileges may be waived broadly for failure to produce a privilege log or to produce a sufficiently detailed log, or specifically for any documents omitted from the privilege log.") The notes following F.R.C.P. 33 are similarly unambiguous ("When privileged information is withheld, the responding party must explicitly state the objection and describe the nature of the information not provided sufficiently to enable other parties to assess the applicability of the privilege".)

Federal courts have had no problem in applying the unambiguous requirements of Rule 26. See, for instance, *Greene, Tweed of Delaware, Inc., v. DuPont Dow Elastomers*, LLC, 202 F.R.D. 418, 423 (E.D. Penn. 2001):

> "A proper claim of privilege requires a specific designation and description of the documents within its scope as well as precise and certain reasons for preserving the confidentiality. (Citations omitted). Thus, '[i]t is incumbent upon one asserting the privilege to make a proper showing that all of the elements of the privilege are present.'"

See also *Willemijn Houdstermaatschaapij BV v. Apollo Computer, Inc.*, 707 F.Supp. 1429, 1439 (D.Del. 1989):

> When responding to an interrogatory, claims of attorney-client privilege and work product protection do not excuse a party from specifically identifying the allegedly privileged item. (Citations omitted). [A] proper claim of attorney-client privilege 'requires a specific designation and description of the documents within its scope as well as precise and certain reasons for preserving their confidentiality.' (Citation omitted). Similarly, a party asserting work product protection must 'identify the withheld documents with sufficient particularity [sic] that the opposing counsel can intelligently argue that the privilege ought not to apply.' (Citations omitted).

"Blanket claims" of privilege do not satisfy the burden of proof imposed on the claimant. *IP Co. LLC v. Cellnet Technology, Inc.*, 2008 WL 3876481 (N.D. Cal.) Moreover, discovery responses claiming privilege that are evasive and incomplete are recognized, both by the federal rules and the tribunals applying those rules, as being the equivalent of a failure to answer. ("An evasive discovery response is no response at all.") Fed. R. Civ. P. 37(a)(3). See also *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 1995 WL 389822 (N.D. Ill.)

Finally, "Because the assertion of the privilege frustrates the search for truth, the privilege must be strictly construed." *Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 143 F.R.D. 611, 615 (E.D. N.C. 1992).

2. Applicant Has Failed To Adequately Support Claims of Attorney-Client Privilege and Work Product Protection.

While Applicant's interrogatory answers and production responses frequently evoke attorney-client privilege and work product claims, Applicant characterizes the efforts required of it to substantiate these claims as "busy work". (Ap. Br. p. 5).[6]

Applicant claims that it substantiated its claims of privilege as required first through the September 30 letter of its counsel and again through a privilege log. (Ap. Br. p. 4-5). Thus, Applicant claims that the following single sentence satisfies its privilege claim obligations: "[T]o the extent that any documents were redacted or withheld, they concerned attorney-client communications or notes of counsel, which are protected by the work product doctrine." Obviously, this conclusory allegation completely fails to meet the standards of description and specificity with respect to particular communications claimed to be privileged or work product protected. Failing to satisfy the standards of Rule 26, and providing neither Opposer nor the Board with any ability to evaluate its claims with respect to a single document, Applicant's reliance upon its September 30 letter is completely unavailing.

Perhaps sensing the inadequacy of its argument with respect to the September 30 letter, Applicant concludes that the privilege document dispute "[I]s moot because Sprinkles later provided a privilege log, detailing each communication withheld on the basis of privilege." (App. Br. p. 5). Let us evaluate this assertion by considering Applicant's "privilege log".[7]

---

[6] While not germane to Opposer's Motion to Compel, Applicant's mischaracterizations of Opposer's position with respect to the attorney/client privilege in responding to Applicant's discovery is revealing. Specifically, Applicant repeatedly notes that Opposer has not produced a privilege log. Applicant states "Soft Serve objected on the basis of privilege in response to multiple requests. Though Sprinkles requested a privilege log in its letter of September 30... Soft Serve has not provided one." (Ap. Br. p. 4.) In fact, in response to exactly four of Applicant's discovery inquiries Opposer succinctly and unambiguously stated that while the inquiry requested privileged information, no such documents exist. Enough said. (Opposer's responses to these four discovery inquiries are attached as Ex. 9).

[7] Applicant's "Privilege Log" was forwarded to Opposer weeks after the filing of the Motion to Compel and well subsequent to Applicant's repeated promises to provide such. The "Privilege Log" is appended hereto as Ex. 10.

Applicant's "official privilege log" (App. Br. p. 6) is comprised of 74 entries. The first two of these entries are identified as opinions of counsel. 71 of the 74 entries are documents authored subsequent to the commencement of this proceeding and thus were not germane to a privilege log. *Grider v. Keystone Health Plan Central, Inc.*, 580 F.3d. 119, 140 n. 22 (3rd Cir. 2009); Notes to Fed. R. Civ. Proc. 26 (b)(5). Significantly, the single remaining entry in the "privilege log", which Applicant repeatedly insists satisfies its obligations reads as follows:

Date	**To**	**From**	**Subject**	**Privilege Claim**
2005 – 2010	Charles Nelson, Nicole Schwartz, & Bobby Nelson	John Slafsky, Hollis Hire Matthew Kuykendall, and other attorneys at Wilson, Sonsini, Goodrich & Rosati	Opinions of outside counsel regarding Sprinkles' right to use and register SPRINKLES	Attorney-client privilege

Through this single entry Applicant looks to shield from discovery, Opposer and the Board, in one broad swipe, all allegedly privileged materials generated between 2005 and 2010. How can Opposer, or the Board, even begin to consider the propriety of privilege and work product claims of documents that are not identified? This approach makes a mockery of the attorney-client privilege, the discovery process, the Federal Rules and the Board. It is questioned how Applicant could reasonably conclude that such a "description" provides the specificity and detail required in order to accommodate the overriding consideration of providing those whose discovery would be limited by claims of privilege with details sufficient in order to comprehend the basis for withholding particular documents and communications.[8]

In the event that Applicant's ploy was ignored by the Board it could reasonably be expected that privilege logs in future Board proceeding would contain but a single reference, spanning years, and reciting a single description, such as "Opinions regarding right to use and register involved mark." Challenging parties, and the Board in every case before it, would be

[8] Note also that while Applicant's discovery objections routinely assert claims of attorney-client privilege and work product protection, its "privilege log" is silent as to work product claims.

completely precluded from any consideration of any specific documents or communications as to which privilege or work product claims were asserted.

In addition, the single entry approach adopted by Applicant deprives Opposer and the Board with non-privileged details that would be reflected in adequate descriptions of otherwise privileged documents. For instance, dates of authorship may be revealing, as may dates upon which various parties received, or were copied with, correspondence or other documents involving numerous *DuPont* subfactors. The single entry approach adopted by Applicant deprives Opposer of its right to nonprivileged information which may itself either constitute evidence or be reasonably calculated to lead to admissible evidence.

3. Applicant Should Be Ordered To Produce Allegedly Privileged Documents As To Which No Identification Has Been Made.

The failure to adequately establish claims of privilege warrants an Order requiring the production of communications that might have been privileged. Significantly, and contrary to the impression Applicant seeks to make, those failing to satisfy their burden in establishing the applicability of privilege are routinely ordered to produce withheld documents. See, for instance, *Willemijn*, 707 F.Supp. at 1440, wherein upon concluding that defendant's privilege claims were evasive and incomplete it was summarily concluded that "Accordingly, defendant will be ordered to fully respond to these interrogatories". See also *Applied Telematics, Inc. v. Sprint Communications Company, L.P.*, 1996 WL 539595 (E.D. Pa.) (p. 6) ("Plaintiff has failed to meet its burden of proving the applicability of the attorney-client privilege to these documents and they must be produced".) The Board is likewise urged to order the production of all privileged documents in the single entry claim asserted by Applicant. The imposition of a lesser sanction, specifically an Order requiring Applicant to submit a privilege log, would be ineffectual given

the "privilege log" which has already been proffered by Applicant and would, moreover, ignore the delay, expense, and waste of judicial resources Applicant has created in connection with this issue.

Finally, while it is submitted that an Order requiring production may be justified in cases in which unjustified delay, inexcusable conduct, or bad faith are not present, it is also respectfully submitted that the cavalier attitude displayed by Applicant in asserting, but refusing to substantiate claims of privilege and work product as constituting nothing more than "busy work", and its disregard for the time honored standards established in connection with making and substantiating claims of privilege, well warrant an Order requiring production of all documents falling within Applicant's single entry claim, regardless of the standard employed in ascertaining the appropriateness of this sanction.

III. CONCLUSION

Opposer's Motion to Compel should be granted. Applicant should be ordered to fully and accurately respond to Interrogatories 4-5, 8 and 13, and Production Requests 2-5, 7, 9, 10, 22 and 25 and to make full production of all documents responsive to Opposer's discovery requests notwithstanding claims of privilege and/or work product protection.

Respectfully submitted,

Date: 2/1/11

Thomas J. Vande Sande
HALL & VANDE SANDE, LLC
Attorneys 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 (1) copy of the foregoing "OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO COMPEL" was this day served on Applicant by mailing same, first class mail, to:

Hollis Beth Hire, Esquire
John L. Slafsky, Esquire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Date: 2/1/11

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

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.	)	Opposition No. 91194188

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. 5

For each product and service requested to be identified in Interrogatory No. 2, state the sales, on an annual basis (in terms of dollar volume and units) of such product or service from the date of first use of the mark SPRINKLES in connection with such product or service, through the present.

ANSWER

This interrogatory is objected to as being overly broad. Moreover, sales information is not available as requested by this interrogatory. Opposer Sprinkles will provide annual sales information, to the extent such is available, and on a year to year basis and under the terms of the Protective Order in response to Production Request No. 18.

INTERROGATORY NO. 6

For each product and service requested to be identified in interrogatory No. 2, explain the extent to which there has been any interruption to continuous use of the mark SPRINKLES to identify the product or service.

ANSWER

All goods and services identified in answer to Interrogatory No. 2 as currently offered by Opposer Sprinkles have been offered continuously and without interruption since their first offering.

INTERROGATORY NO. 7

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

CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer hereby certifies that one (1) copy of the foregoing "OPPOSER'S ANSWERS AND OBJECTIONS TO APPLICANT'S FIRST SET OF INTERROGATORIES" was this day served on Applicant by mailing same, first class mail, to:

John L. Slafsky, Esquire
Matthew J. Kuykendall, Esquire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Date: 8/10/10

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

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.	)	Opposition No. 91194188

OPPOSER'S RESPONSES AND OBJECTIONS TO APPLICANT'S FIRST SET OF PRODUCTION REQUESTS

Pursuant to Federal Rule of Civil Procedure 34 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Opposer Soft Service, Inc. d/b/a Sprinkles ("Opposer Sprinkles"), by and through its undersigned counsel, hereby responds to the First Set of Requests For Production of Documents and Things ("Requests") of Applicant Sprinkles Cupcakes, Inc. as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Opposer Sprinkles objects to the Requests, to each and every individual request contained therein, and to the "Definitions" contained in the Requests, to the extent they are inconsistent

DOCUMENT REQUEST NO. 17

All documents relating to your efforts or plans to promote or expand awareness of the mark SPRINKLES.

RESPONSE

Opposer Sprinkles objects to this production request as being vague. Specifically, all produced documents "relate" to efforts or plans to promote or expand awareness of Opposer Sprinkles' mark and its business. Notwithstanding this objection, see documents produced in response to Request. No. 2.

DOCUMENT REQUEST NO. 18

Documents sufficient to show the annual sales (in dollars and in number of units sold) of each product sold by you under the mark SPRINKLES.

RESPONSE

No such documents exist. Opposer Sprinkles will produce a summary of annual sales.

DOCUMENT REQUEST NO. 19

Documents sufficient to show the annual sales (in dollars) of each service rendered by you under the mark SPRINKLES.

RESPONSE

See Response to Request No. 18.

DOCUMENT REQUEST NO. 20

Documents sufficient to show the annual sales (in dollars and in number of units sold) of cupcakes sold by you under the SPRINKLES mark.

RESPONSE

See Response to Request No. 18. To the extent possible, Opposer Sprinkles will provide in summary fashion, documentation evidencing sales of baked goods.

DOCUMENT REQUEST NO. 21

All documents comprising or relating to classes of dealers, customers, clients, sales representatives, brokers, and/or distributors of Opposer's SPRINKLES products and services.

RESPONSE

See documents produced in response to Request No. 2.

DOCUMENT REQUEST NO. 22

Documents sufficient to identify each catalog, sales outlet, Internet web site or other electronic means, retail outlet, and wholesale outlet in which products offered in connection with the SPRINKLES mark are, or are intended to be, advertised, promoted, distributed, sold, or offered for sale.

RESPONSE

See documents produced in response to Request No. 2.

CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer hereby certifies that one (1) copy of the foregoing "OPPOSER'S RESPONSES AND OBJECTIONS TO APPLICANT'S FIRST SET OF PRODUCTION REQUESTS" was this day served on Applicant by mailing same, first class mail, to:

John L. Slafsky, Esquire
Matthew J. Kuykendall, Esquire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Date: 8/10/10

Thomas J. Vande Sande
HALL & VANDE SANDE, LLC
Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
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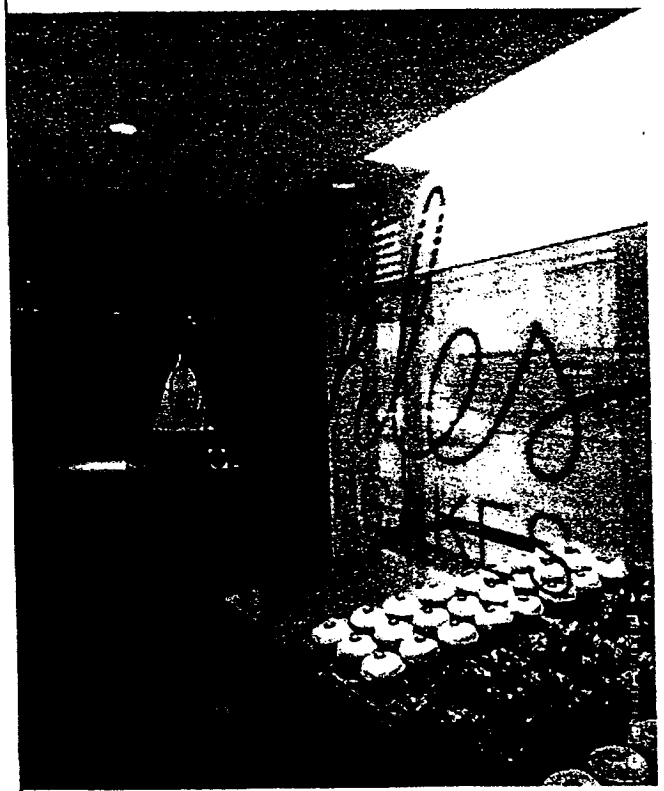

beverly hills **9635 little santa monica boulevard**
pantry **holiday orders only**
chicago **50 east walton street** summer 2010
dallas **plaza at preston center 4020 villanova drive**
houston **highland village 4014 westheimer road** now open
newport beach **corona del mar plaza 944 avocado avenue**
new york **780 lexington avenue** winter 2011
phoenix-scottsdale **4501 north scottsdale road**
san diego-la jolla **8855 la jolla village drive** fall 2010
san francisco-palo alto **393 stanford shopping center**
washington dc-georgetown **3015 m street nw** fall 2010

coming soon vote for the next Sprinkles location!
atlanta boston charlotte denver kansas city london las vegas miami minneapolis nashville paris philadelphia sf seattle tokyo

©2004–10 sprinkles cupcakes THE ORIGINAL CUPCAKE BAKERY

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.	)	Opposition No. 91194188

OPPOSER'S RESPONSES AND OBJECTIONS TO APPLICANT'S FIRST SET OF PRODUCTION REQUESTS

Pursuant to Federal Rule of Civil Procedure 34 and the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Opposer Soft Service, Inc. d/b/a Sprinkles ("Opposer Sprinkles"), by and through its undersigned counsel, hereby responds to the First Set of Requests For Production of Documents and Things ("Requests") of Applicant Sprinkles Cupcakes, Inc. as follows:

GENERAL OBJECTIONS

GENERAL OBJECTION NO. 1:

Opposer Sprinkles objects to the Requests, to each and every individual request contained therein, and to the "Definitions" contained in the Requests, to the extent they are inconsistent

DOCUMENT REQUEST NO. 37

All documents relating to any incident in which a third party has challenged the rights you claim in the mark SPRINKLES, including but not limited to any demand to cease and desist.

RESPONSE

None, as no such challenge or demand has been made.

DOCUMENT REQUEST NO. 38

All documents relating to any incident in which you have challenged the rights of a third party based on the rights you claim in the mark SPRINKLES, including but not limited to any demand to cease and desist.

RESPONSE

None, as no such challenge or demand has been made.

DOCUMENT REQUEST NO. 39

All documents relating to actual confusion arising from Applicant's use of the mark SPRINKLES.

RESPONSE

None, yet.

DOCUMENT REQUEST NO. 40

All documents relating to communications between you and your legal counsel with experts in the Opposition proceeding.

RESPONSE

No such documents currently exist. To the extent that such come into being, this response will be supplemented and related documents will be produced to the extent that such do not constitute or reveal attorney-client privileged communications or protectable work product.

DOCUMENT REQUEST NO. 41

All documents relating to communications between you and your legal counsel with potential experts in this Opposition proceeding.

RESPONSE

No such documents currently exist. To the extent that such come into being, this response will be supplemented and related documents will be produced to the extent that such do not constitute or reveal attorney-client privileged communications or protectable work product.

DOCUMENT REQUEST NO. 42

All documents comprising or relating to opinions of each expert witness that you will or may call in this Opposition proceeding.

RESPONSE

No such documents currently exist. To the extent that such come into being, this response will be supplemented and related documents will be produced to the extent that such do not constitute or reveal attorney-client privileged communications or protectable work product.

CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer hereby certifies that one (1) copy of the foregoing "OPPOSER'S RESPONSES AND OBJECTIONS TO APPLICANT'S FIRST SET OF PRODUCTION REQUESTS" was this day served on Applicant by mailing same, first class mail, to:

John L. Slafsky, Esquire
Matthew J. Kuykendall, Esquire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Date: 8/10/10

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

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.	)	Opposition No. 91194188

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

ANSWER

Opposer Sprinkles' goods and services are offered and sold primarily to individual consumers of baked goods, frozen desserts, and non-alcoholic beverages. Opposer Sprinkles' customers reside in, grew up in, or are visiting the Washington, D.C. metropolitan area and include residents of Potomac, Maryland and surrounding areas; individuals commuting to and from downtown Washington, D.C.; residents of Washington, D.C.; surrounding suburbs of Washington, D.C., and individuals visiting and/or utilizing the various park lands and recreational areas found in Potomac, Maryland. Such include visitors to nearby Great Fall National Park and the thousands of bicyclists per year traveling north and south on Falls Road in Potomac, Maryland who thereby are exposed to Opposer Sprinkles' SPRINKLES retail store and products.

INTERROGATORY NO. 28

Identify every trademark search you conducted relating to the mark SPRINKLES.

ANSWER

Prior to the adoption of SPRINKLES, Mr. Orban conducted a basic computer search.

INTERROGATORY NO. 29

Identify every opinion, legal or otherwise, requested or received by you, regarding the right to use the mark SPRINKLES, including the identity of the persons requesting the opinion, the date and substance of the opinion, and the persons receiving the opinion.

ANSWER

This interrogatory is objected to to the extent that it seeks the substance of attorney-client communications. Without waiving this objection, Opposer Sprinkles answers that no opinions responsive to this request were sought or obtained.

INTERROGATORY NO. 30

Describe (including but not limited to party names, dates of inception and expiration dates) the licenses that you maintain with third parties that allow those third parties to use your mark SPRINKLES.

ANSWER

Opposer Sprinkles has granted no licenses that allow third parties to use the mark SPRINKLES.

INTERROGATORY NO. 31

Identify all documents (license, contract, etc.) by which you have authorized any third party to use the mark SPRINKLES.

ANSWER

No such documents exist as no third parties have been authorized by Opposer Sprinkles to use the mark SPRINKLES.

CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer hereby certifies that one (1) copy of the foregoing "OPPOSER'S ANSWERS AND OBJECTIONS TO APPLICANT'S FIRST SET OF INTERROGATORIES" was this day served on Applicant by mailing same, first class mail, to:

John L. Slafsky, Esquire
Matthew J. Kuykendall, Esquire
Wilson Sonsini Goodrich & Rosati
650 Page Mill Road
Palo Alto, CA 94304-1050

Date: 8/10/10

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

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Applicant Sprinkles Privilege Log

December 29, 2010

Date	To	From	Subject	Privilege Claim
7/15/2005	Charles Nelson	John Slafsky	Attorney advice regarding availability search for SPRINKLES mark	Attorney-client privilege
2/23/2009	Charles Nelson	Hollis Hire	Attorney advice regarding availablility search for SPRINKLES mark	Attorney-client privilege
3/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
3/29/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/1/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
4/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/3/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/6/2010	Bobby Nelson & Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/11/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/17/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson & John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
5/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/1/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/7/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/10/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/13/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/14/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/16/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/17/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/18/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	Nicole Schwartz	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/22/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/23/2010	John Slafsky	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/24/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/27/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
6/29/2010	Matthew Kuykendall	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Matthew Kuykendall	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
6/30/2010	Charles Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege

Soft Serve, Inc. d/b/a Sprinkles v. Sprinkles Cupcakes, Inc.

Opposition No. 91194188

Applicant Sprinkles Privilege Log

December 29, 2010

Date	To	From	Subject	Privilege Claim
7/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
7/7/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
7/8/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
8/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Matthew Kuykendall & Bobby Nelson	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
8/18/2010	Nicole Schwartz	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
8/30/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	John Slafsky	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
9/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/4/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/5/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/6/2010	Bobby Nelson	Matthew Kuykendall	Attorney advice regarding the instant dispute	Attorney-client privilege
10/7/2010	Matthew Kuykendall	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
10/12/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
10/19/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/25/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
10/28/2010	John Slafsky & Hollis Hire	Nicole Schwartz	Attorney advice regarding the instant dispute	Attorney-client privilege
10/29/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/1/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/5/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/8/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/9/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
11/10/2010	Hollis Hire	Charles Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
11/23/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
11/30/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
12/1/2010	John Slafsky	Bobby Nelson	Attorney advice regarding the instant dispute	Attorney-client privilege
12/1/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
12/15/2010	Charles Nelson	Hollis Hire	Attorney advice regarding the instant dispute	Attorney-client privilege
12/16/2010	Charles Nelson	John Slafsky	Attorney advice regarding the instant dispute	Attorney-client privilege
2005-2010	Charles Nelson, Nicole Schwartz, & Bobby Nelson	John Slafsky, Hollis Hire, Matthew Kuykendall, and other attorneys at Wilson, Sonsini, Goodrich & Rosati	Opinions of outside counsel regarding Sprinkles' right to use or register SPRINKLES	Attorney-client privilege & work product doctrine

EXHIBIT D

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

nmt

Mailed: December 21, 2010

Opposition No. 91194188

Soft Serve, Inc. d/b/a Sprinkles

v.

Sprinkles Cupcakes, Inc.

Andrew P. Baxley, Interlocutory Attorney:

Proceedings herein are suspended pending disposition of opposer's motion to compel (filed December 13, 2010), except as discussed below. The parties should not file any paper which is not germane to the motion to compel. See Trademark Rule 2.120(e)(2).

This suspension order does **not** toll the time for either party to make any required disclosure, to respond to discovery requests which had been duly served prior to the filing and service of the motion to compel, or to appear for a discovery deposition which had been duly noticed prior to the filing and service of the motion to compel. See Id. The motion to compel will be decided in due course.

EXHIBIT E

From: Hire, Hollis
Sent: Thursday, September 16, 2010 1:28 AM
To: Thomas J. Vande Sande
Cc: Slafsky, John
Subject: RE: Sprnkles/Soft Serve

Tom,

I do agree that a protective order should be filed in each action. I think it is necessary procedurally to serve discovery in reference to a particular action in order for it to be used in that action; I was only suggesting that the discovery conference would cover the same ground, so we did not think it was necessary to discuss again.

If you would prefer to schedule another one to discuss the remaining actions, please let us know and we are happy to set a time.

Hollie

From: Thomas J. Vande Sande [mailto:tv@hvsllc.com]
Sent: Wednesday, September 15, 2010 12:02 PM
To: Hire, Hollis
Subject: RE: Sprnkles/Soft Serve

Hollie,

Sorry for the delay in getting back to you, but I wanted to be able to mull this over a little bit.

I think I will probably end up agreeing, but ask for your thoughts re the following. Shall we agree that discovery generated in any proceeding can be used in all proceedings that have been or may be lodged? Do you agree that we will still need to submit the Protective Order currently in place for entry in each separate proceeding? Are there other issues of mechanics that come to your mind at this juncture?

Regards,
Tom

From: Hire, Hollis [mailto:hhire@wsgr.com]
Sent: Monday, September 13, 2010 2:36 AM
To: 'tv@hvsllc.com'
Cc: Slafsky, John
Subject: Sprnkles/Soft Serve

Tom,

As you know, the TTAB's deadline for a discovery conference in the SPRINKLESMOBILE opposition is on September 22, and the discovery conference deadlines for the remaining oppositions are approaching soon after.

We believe that the discovery conference held in the spring for the first SPRINKLES opposition covers the remaining oppositions as well. If you disagree, we would be happy to schedule another discovery conference to address the SPRINKLESMOBILE and other pending oppositions. Please let us know as soon as possible if you would like to schedule another conference so we can find a mutually available time in the next week.

Regards,

Hollis Beth Hire
Wilson Sonsini Goodrich & Rosati
Direct dial: 650 849 3040
Email: hhire@wsgr.com

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EXHIBIT F

From: Hire, Hollis
Sent: Tuesday, October 19, 2010 4:52 PM
To: Thomas J. Vande Sande
Subject: RE: SPRINKLES PROCEEDINGS

Tom,

I don't think it's necessary to conduct additional Rule 26 conferences, as I believe the conference in connection with the first proceeding covered all the bases. We are happy to have another conference if you disagree.

We will prepare and send a protective order for all pending proceedings for signature.

Your proposal re discovery sounds fine.

Hollie

From: Thomas J. Vande Sande [mailto:tv@hvsllc.com]
Sent: Thursday, October 14, 2010 9:24 AM
To: Hire, Hollis
Subject: SPRINKLES PROCEEDINGS

Hollie,
I am wondering whether you believe it necessary for us to engage in Rule 26 conferences in connection with the additional cases in which we face deadlines in the next couple of weeks.

I am also wondering whether you want to use the Protective Order John initially drafted for use in the first proceeding. If so, perhaps you could forward such along for execution and use in each of the additional proceedings.

Thank you for your recent letter concerning my earlier correspondence relating to our concerns with your client's responses to our first round of discovery. I will be in touch again soon in connection with what I believe are still some open issues. In addition, we will be supplementing our discovery responses relating to our client's first use in the very near future, as our continuing investigation has shed further light on this subject.

Finally, as to my earlier suggestion relating to our stipulating that discovery used in one case could be used in other cases, I am not suggesting that additional discovery cannot be propounded in each case, I am only seeking your concurrence with the idea that discovery such as documents and interrogatory answers received by either party in one proceeding can be used, for any purpose as to which such are relevant, in any other proceeding. The intention is, of course, to eliminate the need to propound (and respond to) identical discovery requests in multiple proceedings. Are you agreeable to so proceeding?

Best regards,
Tom

EXHIBIT G

From: "Thomas J. Vande Sande" <tv@hvsllc.com>
Date: January 11, 2011 12:17:42 PM PST
To: "Hire, Hollis" <hhire@wsgr.com>
Subject: RE: Sprinkles/Soft Serve -- request re Dec. 30 date

Hollie,

I will be able to give you an answer on that in the next day or so.

Tom

From: Hire, Hollis [mailto:hhire@wsgr.com]
Sent: Monday, January 10, 2011 9:48 PM
To: Thomas J. Vande Sande
Subject: RE: Sprinkles/Soft Serve -- request re Dec. 30 date

Tom,

Any thoughts re the second issue below, namely, a consent motion to stay all proceedings pending the disposition of the pending motion?

Hollie

From: Thomas J. Vande Sande [mailto:tv@hvsllc.com]
Sent: Wednesday, December 29, 2010 8:57 AM
To: Hire, Hollis
Subject: RE: Sprinkles/Soft Serve -- request re Dec. 30 date

Hollie,

We can agree to an extension of your date in connection with the Motion to Compel, but I am wondering whether you really need to extend all the way to Jan. 18. Is there some reason that a slightly shorter time wouldn't work for you, say Jan. 14?

I will be here until 5:00 EST today. Please forward along a draft of the proposed Motion in the event that you are looking to file same with our Consent.

Best,

Tom

From: Hire, Hollis [mailto:hhire@wsgr.com]
Sent: Tuesday, December 28, 2010 6:07 PM
To: Thomas J. Vande Sande
Cc: Slafsky, John
Subject: RE: Sprinkles/Soft Serve -- request re Dec. 30 date

Tom -- Can you please advise re the Dec. 30 date ASAP? Given the time constraints, we need to make a motion by tomorrow morning and would like to indicate consent of both parties if applicable.

Hollie

From: Thomas J. Vande Sande [mailto:tv@hvsllc.com]
Sent: Tuesday, December 28, 2010 11:49 AM
To: Hire, Hollis
Subject: RE: Sprinkles/Soft Serve -- request re Dec. 30 date

Hollie,

I have a call out to my client to discuss your proposals. I will get back to you re same either later today or tomorrow.

I hope your holiday season has been enjoyable as well.

Tom

From: Hire, Hollis [mailto:hhire@wsgr.com]
Sent: Monday, December 27, 2010 9:25 PM
To: Thomas J. Vande Sande
Cc: Slafsky, John
Subject: Sprinkles/Soft Serve -- request re Dec. 30 date

Tom,

Response to the motion to compel you served Dec. 10 is due Dec. 30. Given the holidays, do you consent to a 20-day extension of time to respond, to Jan. 18?

Also, given that the discovery in the different Sprinkles opposition actions is linked as we discussed before, we believe it makes sense to stay proceedings in those actions as well pending a decision on the motion to compel (as you know, the "first" Sprinkles opposition proceeding has already been stayed by the Board). Do you consent to this stay?

Hope you're having a happy holiday season.

Hollie

Hollis Beth Hire
Wilson Sonsini Goodrich & Rosati
Direct dial: 650 849 3040
Email: hhire@wsgr.com

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EXHIBIT H

From: Thomas J. Vande Sande [mailto:tv@hvsllc.com]
Sent: Monday, February 14, 2011 11:10 AM
To: Hire, Hollis
Subject: Pending Proceedings

Hello Hollie,
In response to your inquiry, please be advised that we can agree to stay all proceedings pending the decision on our Motion to Compel, with the exception of the Cancellation proceeding. As we have no idea how long the Motion may be pending, I believe it important to keep discovery open in one case and wish to have the Cancellation proceeding be that case.

Please feel free to draft appropriate documentation for filing with the Board that will reflect our agreement to so proceed, but please give me the opportunity to review your proposed draft prior to filing same.

Best regards,
Tom