UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 4, 2011

Opposition No. 91194188
Opposition No. 91195669
Opposition No. 91195985
Opposition No. 91195986
Opposition No. 91196035
Opposition No. 91196061
Opposition No. 91196087[1]
Cancellation No. 92053109

Soft Serve, Inc. d/b/a
Sprinkles

v.

Sprinkles Cupcakes, Inc.

(as consolidated)

Andrew P. Baxley, Interlocutory Attorney:

The above-captioned proceedings involve the same parties and common questions of law or fact. Therefore, the Board, in exercising its inherent authority to control the scheduling of cases on its docket, hereby orders their consolidation.[2] See Fed. R. Civ. P. 42(a); *Regatta Sport*

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[1] The captions of Opposition Nos. 91195669 and 91196087 are amended to identify plaintiff as Soft Serve, Inc. d/b/a Sprinkles. See notices of opposition in those proceedings.

[2] The parties were told in the institution notices of the above-captioned proceedings that, "If [they] are (or during the pendency of this proceeding become) parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately, so that the Board can consider

Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP Section 511 (2d ed. rev. 2004). The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

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

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

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whether consolidation or suspension of proceedings is appropriate." Institution notices at 4. Although consolidation of these proceedings has been appropriate since at least as early as November 2, 2010, when defendant filed its answer in Cancellation No. 92053109, neither party notified the Board that they are involved in eight related proceedings until defendant filed its brief in response to plaintiff's motion to compel in Opposition No. 91194188 on January 14, 2011. Earlier consolidation of these proceedings would have save the parties and the Board considerable time, effort, and expense.

In determining whether to consolidate the above-captioned proceedings, the Board reviewed the pleadings herein. Plaintiff has adequately pleaded claims of priority/likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), in the notices of opposition and petition to cancel in the above-captioned proceedings. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

In paragraph 11 of the notices of opposition and paragraph 2 of the petition to cancel in the above-captioned proceedings, plaintiff appears to intend to plead claims of false suggestion under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a). A Section 2(a) false suggestion claim is rooted in the right of privacy and is not intended as an alternative means of raising a Section 2(d) claim. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Such a claim requires allegations that:

> (1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution;
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> (2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
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> (3) The person or institution identified in the mark is not connected with the goods sold or

> services performed by applicant under the mark; and
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> (4) The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services.

Petróleos Mexicanos v. Intermix SA, 97 USPQ2d 1403, 1405 (TTAB 2010). Plaintiff has not set forth the required elements for a Section 2(a) false suggestion claim in the notices of opposition or petition to cancel in the above-captioned proceedings. Accordingly, the Board *sua sponte* strikes paragraph 11 from the notices of opposition in the above-captioned opposition proceedings and "and falsely suggest a connection with" from paragraph 2 the petition to cancel in the above-captioned cancellation proceeding.[3] See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

Plaintiff also appears to intend to set forth a claim of disparagement under Section 2(a) in paragraph 2 of the petition to cancel in the above-captioned cancellation proceeding. "Disparagement is essentially a violation of one's right of privacy – the right to be 'let alone' from contempt or ridicule." See *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988). A claim of

[3] The Board can strike any insufficient claim or defense whenever it has occasion to review the pleadings. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

disparagement requires allegations that: 1) the communication reasonably would be understood as referring to plaintiff; and 2) the communication is disparaging, i.e., would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. See *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1589 (TTAB 2008). Plaintiff has not set forth the required elements for a Section 2(a) disparagement claim in the petition to cancel in Cancellation No. 92053109. Accordingly, the Board *sua sponte* strikes the remainder of paragraph 2 from the petition to cancel in the above-captioned cancellation proceeding. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

In addition, the USPTO file for Registration No. 3306772, the involved registration in Cancellation No. 92053109, indicates that defendant is a party to a civil action styled *Ryan Mealey v. Sprinkles Cupcakes, Inc.*, Case No. 2:09-cv-04048-MAM, filed September 4, 2009, in the United States District Court for the Eastern District of Pennsylvania.

The Board's general practice is to suspend proceedings before it when the Board is made aware that a party to a pending Board proceeding is involved in a civil action which may have a bearing on the Board case. See Trademark

Rule 2.117(a). Although the USPTO has expertise in determining trademark registrability, such determinations are not within the USPTO's exclusive jurisdiction. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986). To the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court's findings are binding on the Board, whereas the Board's findings are merely advisory to the district court. See *id.*; TBMP Section 510.02(a). Accordingly, defendant is directed to file with the Board within **twenty days** of the mailing date set forth in this order a copy of the pleadings in the civil action and a report on the status thereof so that the Board can determine whether suspension of these consolidated proceedings pending final determination, including any appeals or remands, of the civil action is warranted.

In view of the consolidation of the above-captioned proceedings, these proceedings are suspended pending the disposition of plaintiff's motion to compel in Opposition No. 91194188, except as noted above.[4] See Trademark Rules

[4] Defendant's motions (filed February 28, 2011 in each of the consolidated proceedings except Opposition No. 91195669, in which such motion was filed March 1, 2011) to suspend these proceedings

2.117(c) and 2.120(e)(1). If the Board, after reviewing the pleadings in the civil action, determines that suspension pending the final determination of the civil action is unwarranted, the Board will decide the motion to compel and resume these consolidated proceedings.[5] If suspension pending final determination of the civil action is warranted, consideration of the motion to compel will be deferred until after final determination of the civil action.

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pending the Board's decision on the motion to compel in Opposition No. 91194188 are moot..

[5] In resuming these consolidated proceedings, the schedule will take into account that the different procedural postures of the individual consolidated proceedings.