

ESTTA Tracking number: **ESTTA449586**

Filing date: **01/05/2012**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Babycakes NYC, Inc.
Granted to Date of previous extension	01/07/2012
Address	248 Broome St. New York, NY 10002 UNITED STATES

Attorney information	John H. Barkley Barkley Law Group 549 Orange Ave Coronado, CA 92118 UNITED STATES jbarkley@barkleylawgroup.com Phone:619-437-0031
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Applicant Information

Application No	85328936	Publication date	11/08/2011
Opposition Filing Date	01/05/2012	Opposition Period Ends	01/07/2012
Applicant	SELECT BRANDS, INC. 10817 Renner Blvd. Lenexa, KS 66219 UNITED STATES		

Goods/Services Affected by Opposition

Class 011. First Use: 2009/12/01 First Use In Commerce: 2009/12/01 All goods and services in the class are opposed, namely: Electric cookware in the nature of electric baking appliances, namely, cupcake makers, donut hole makers, donut makers, waffle makers, small pie makers, pie on a stick makers, whoopie pie makers, slow cookers, brownie makers, cookie makers, cake pop makers and cake makers

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85214746	Application Date	01/11/2011
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BABYCAKES NYC		
Design Mark			
Description of Mark	The mark consists of the stylized letters "babycakes NYC" in the color brown, and a small depiction of a pastry in the colors brown, white, and pink.		
Goods/Services	Class 035. First use: 2005/03/23 First Use In Commerce: 2005/04/13 Retail bakery shops		

Related Proceedings	Ex Parte Appeal of Final Refusal of Application # 85214746
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Attachments	85214746#TMSN.jpeg (1 page)(bytes) Notice of Opp 8936.pdf (6 pages)(114829 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John Barkley/
Name	John H. Barkley
Date	01/05/2012

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

In the matter of the trademark application Serial No. 85328936
For the mark: "Babycakes"
Published in the Official Gazette on: November 8, 2011

BABYCAKES NYC, INC.
Opposer

v.

SELECT BRANDS, INC.
Applicant

Trademark Application
Mark: BABYCAKES
Serial No.: 85328936
Filed: May 24, 2011
Published: November 8, 2011
Opposition No.: _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

Sir:

Babycakes NYC, Inc. a New York Corporation, 248 Broome Street, New York, New York 10002 ("Babycakes NYC" or "Opposer") believes that it will be damaged by registration by Select Brands, Inc. ("Select Brands" or "Applicant") of the mark BABYCAKES shown in Application Serial No. 85328936 and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Applicant filed a trademark application assigned Application Serial No. 85328936 in the United States Patent and Trademark Office ("USPTO") on May 24, 2011. To register the mark BABYCAKES ("Applicant's Mark") for use in connection with "Electric cookware, namely, cupcake makers, donut hole makers, donut makers, waffle makers, small pie makers, pie on a stick makers, whoopie pie makers, slow cookers, brownie makers, cookie makers, cake pop makers and cake makers."

2. The application filed by Applicant was based on Applicant's alleged use of Applicant's Mark in commerce on or before December 1, 2009.
3. The application for Applicant's Mark was published for opposition in the *Official Gazette* on November 8, 2011. On November 29, 2011, Opposer timely filed a 30-day Request for Extension of Time to Oppose Applicant's Mark, which was granted the same day.
4. Babycakes NYC, Inc. has operated retail bakeries under the name "Babycakes NYC" since August 2005. In 2006, the Babycakes NYC, Inc. bakery began shipping its products nationwide. The logo used by Babycakes NYC, Inc. is attached hereto as Exhibit "A" and consists of brown, stylized, all-lower-case lettering, with a cupcake design in pink, brown, and white.
5. Opposer has created a famous brand under the name "Babycakes NYC". Opposer's founder and president has appeared on nationally-televised programs, including twice on "The Martha Stewart Show," NBC's "Nightline," nationally-broadcast radio programs, the cover story for Inc. Magazine July 2008 edition, and makes appearances on nationally televised or radio broadcasted programs approximately (12) times annually. Each of these appearances are in connection with or to promote the Babycakes brand. This was true even before Applicant began using the name "babycakes" in commerce. Babycakes has also been mentioned in pop culture, including by actor Zach Galifinakis, star of the feature films "The Hangover," "The Hangover Part II," "Due Date," "Puss in Boots" and "Disney's The Muppets" declared his affinity for Babycakes NYC in a television interview on the nationally-televised program "Jimmy Kimmel Live." Babycakes NYC has also been featured on the internet newsletter GOOP, authored by Oscar-winning Actress Gwyneth Paltrow. The Babycakes NYC brand is a nationwide phenomenon.

6. Opposer has experienced numerous complaints, questions, and requests from consumers directed to Opposer's locations on a regular basis since Applicant began selling its goods under the "babycakes" name. Consumers who purchase Applicant's products direct complaints to Opposer's telephone lines and e-mail addresses. Consumers have asked Opposer's employees for assistance in using Applicant's electric cupcake and/or cake makers with certain recipes. Consumers have contacted Opposer's locations seeking the "owner's manual" for Applicant's goods. This actual confusion between Applicant's logo, and Opposer's brand is strong evidence of a likelihood of confusion under Section 2(d).
7. Applicant's Mark is essentially identical to that of Opposer. The logo that Applicant supplied as its specimen consists of brown all-lower-case stylized letters of the word "babycakes" and contains several pastel colors, including pink. Therefore a consumer is likely to recognize Applicant's mark on its goods as emanating from Opposer's business.
8. Applicant's claimed goods and services include "Electric cookware in the nature of electric baking appliances, namely, cupcake makers, donut hole makers, donut makers, waffle makers, small pie makers, pie on a stick makers, whoopie pie makers, slow cookers, brownie makers, cookie makers, cake pop makers and cake makers." Opposer operates (3) retail bakeries famous for selling baked sweets including cupcakes, donuts, cakes, cookies, and other baked sweets. Opposer ships its goods nationwide direct to customers. Opposer also has caused (2) cookbooks to be published. A consumer is likely to believe that the cookbook is meant to be used with the electric pop makers. Indeed, in June 2011, Applicant published a cookbook also titled "Babycakes" for use with its cookware.
9. Applicant represents itself in marketing materials as "the One and Only Original Babycakes." Such statement cannot be reconciled with any version of the truth.

10. Applicant and Opposer largely market through use of the World Wide Web. Several internet resellers, including Amazon.com, even sell Applicant's cookware directly alongside Opposer's cookbooks. Therefore Applicant's products travel in many of the same channels of trade as goods distributed by Opposer.
11. Applicant relies on claimed ownership of Trademark Reg. No. 3,788,636. A petition for cancellation for said mark has been filed by Opposer and is also pending.
12. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of 15 U.S.C. §§1052 (likelihood of confusion), 1125(c) (Dilution), and 1125(a) (Passing Off) of the Lanham Act, and Opposer would be damaged thereby.
13. WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 85328936 be REFUSED and that this Opposition be SUSTAINED in favor of Opposer.

DATED: January 5, 2012

/John Barkley/

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Attorney for Opposer
Babycakes NYC, Inc.

Exhibit – A

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NYC 