

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

Mailed: May 11, 2010

Opposition No. 91188833

The Cupcakery, LLC

77/550,747

v.

Sift: A Cupcakery LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

The Board notes the filing on April 13, 2010 of opposer's motion for summary judgment. It has also come to the attention of the Board that a civil action is pending in Federal district court, which may have a bearing on this proceeding. Specifically, the Board notes that opposer filed a civil action against applicant in this proceeding in the United States District Court, District of Nevada, on May 5, 2009, which is captioned *The Cupcakery, LLC* (Plaintiff) v. *Andrea Ballus and Sift: A Cupcakery* (Defendants) Case no. 2:09-cv-00807-KJD-LRL.¹

In the Board's institution order in this proceeding (mailed February 12, 2009), the Board required as follows:

If the parties to this proceeding are (or during the pendency of this proceeding become) parties in another

¹ Attached to this order is a copy of the current civil docket for the referenced civil action.


05-21-2010

Opposition No. 91188833

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 whether consolidation or suspension of proceedings is appropriate.

In this case, opposer filed its complaint in the civil action three months after the above-referenced order was issued. However, neither party notified the Board of the above-referenced civil action.

On review of the complaint in said civil action, the Board notes, *inter alia*, that opposer is the plaintiff in the civil action and that one of the defendants therein is the applicant in this proceeding; that plaintiff (opposer herein) alleges in its complaint that there is likelihood of confusion between the parties' marks (complaint, ¶¶ 33-34); and that plaintiff requests injunctive relief in connection with the trademark application involved in this proceeding, such that applicant (defendant in the civil action) may be ordered to abandon the application involved herein (complaint prayer, ¶B). Similarly, one of opposer's grounds for opposition in this proceeding is priority and likelihood of confusion (not. of opp., ¶¶ 7 and 8).

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action that may be dispositive of or have a bearing on the Board case. See Trademark Rules 2.127(a) and 2.117(a), 37 C.F.R. §§ 2.127(a) and 2.117(a). See also TBMP § 510.02 (2d ed. rev. 2004).

Opposition No. 91188833

Suspension of a Board proceeding is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling may have a bearing on the rights of the parties in the Board proceeding. See *Martin Beverage Co. Inc. v. Colita Beverage Company*, 169 USPQ 568, 570 (TTAB 1971). Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, e.g., *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

Inasmuch as the present opposition and the above-referenced civil action are grounded in part in claims that opposer has priority in the mark THE CUPCAKERY and that applicant's use of the mark SIFT: A CUPCAKERY is likely to cause confusion with opposer's asserted THE CUPCAKERY marks, determination of said issue in the civil action may have a direct bearing on this proceeding.

Accordingly, in the interest of judicial economy and consistent with our inherent authority to regulate our own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, this proceeding is **SUSPENDED** pending final disposition of the civil action between the parties. See TBMP § 510.02(a) (2d

Opposition No. 91188833

ed. rev. 2004) (The Board in its discretion may elect to suspend without first deciding the potentially dispositive motion).

In view thereof, consideration of opposer's motion for summary judgment is **deferred**. If this proceeding is resumed, the Board will reset time for briefing of said motion.

Within **TWENTY DAYS** after the final determination of the civil action, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

Opposition No. 91188833



United States District Court
 District of Nevada (Las Vegas)
 CIVIL DOCKET FOR CASE #: 2:09-cv-00807-KJD-LRL

The Copakery, LLC v. Bulfinch &
 Assisted by Jody Neal J. Lawrence
 Referred to Magistrate Judge Lawrence K. Leavelle
 Cause: 111125 Trademark Infringement (Jurisdiction: All)

Date Filed: 05/05/2009
 Case Demand: None
 Nature of Suit: All Trademarks
 Has Orders: Federal Injunction

Date Filed	Docket Text
05/05/2009	1 COMPLAINT for Damages and Injunctive Relief against Andrea Bulfinch, SR. A Copakery (Filing fee: \$ 100 (reg number: 0978306090001271495), Delivered by The Copakery, LLC. Certificate of Service not Filed. See by 05/05/2009 Filed by Plaintiff The Copakery, LLC (Attachments: # 1) Notice of Corrected Image/Docket filed on 5/5/09. (RMZ) (Entered: 05/05/2009)
05/05/2009	2 NOTICE of Corrected Image/Docketing Compliance by Plaintiff The Copakery, LLC. (Service of corrected image is attached) (Attachments: # 1) Exhibit 1 Copakery, LLC (Entered: 05/05/2009)
05/05/2009	Case assigned to Judge J. Neal J. Lawrence and Magistrate Judge Lawrence K. Leavelle (AXM) (Entered: 05/05/2009)
05/05/2009	3 ACD 120 REPORT on the filing or determination of an action regarding a patent or trademark. E-mailed to the US Patent and Trademark Office. (Attachments: # 1) Complaint (AXM) (Entered: 05/05/2009)
05/05/2009	4 NOTICE PURSUANT TO LOCAL RULE 15-2. In accordance with 28 USC 5 (2)(c) and FCIP 73, the parties in this action are provided with a link to the "AO 85 (Notice of Availability, Contents, and Order of Reference - Exercise of Jurisdiction by a U.S. Magistrate Judge)" form on the Court's website: www.uscourts.gov/ao85 . Consent forms should NOT be electronically filed. Upon consent of all parties, consent are entered manually file the form with the Clerk's Office. (no image attached) (AXM) (Entered: 05/05/2009)
05/14/2009	5 CERTIFICATE of interested Parties filed by The Copakery, LLC. There are no known interested parties other than those participating in the case. (Attachments: # 1) (Entered: 05/14/2009)
07/06/2009	6 PROPOSED SUMMONS to be issued. Filed by Plaintiff The Copakery, LLC. (Attachments: # 1) (Entered: 07/06/2009)
07/06/2009	7 PROPOSED SUMMONS to be issued. Filed by Plaintiff The Copakery, LLC. (Attachments: # 1) (Entered: 07/06/2009)
07/06/2009	8 Response filed by Andrea Bulfinch, SR. (Entered: 07/06/2009)
07/06/2009	9 Response filed by Plaintiff The Copakery, LLC. (Entered: 07/06/2009)
07/06/2009	10 SUMMONS (Notice of Availability) issued by The Copakery, LLC. Andrea Bulfinch served on 07/06/2009, answer due 07/13/2009. (Attachments: # 1) (Entered: 07/06/2009)
07/06/2009	11 SUMMONS (Notice of Availability) issued by The Copakery, LLC. Plaintiff The Copakery served on 07/06/2009, answer due 07/13/2009. (Attachments: # 1) (Entered: 07/06/2009)
08/14/2009	12 MOTION to Denial Plaintiff's Complaint by Defendant Andrea Bulfinch, SR. A Copakery. Responses due by 08/14/2009. (Attachments: # 1) (Entered: 08/14/2009)
08/26/2009	13 ANSWER to Plaintiff's Complaint. Filed by Andrea Bulfinch, SR. A Copakery. Certificate of Interested Parties due by 08/26/2009. Considers Plaintiff's Complaint. Delivered by Plaintiff The Copakery, LLC. (Entered: 08/26/2009)
08/26/2009	14 CERTIFICATE of Interested Parties. Filed by Andrea Bulfinch, SR. A Copakery. There are no known interested parties other than those participating in the case. (Attachments: # 1) (Entered: 08/26/2009)
08/31/2009	15 RESPONSE to Plaintiff's MOTION to Denial Plaintiff's Complaint. Filed by Plaintiff The Copakery, LLC. (Response to Defendant Andrea Bulfinch's Motion to Denial Plaintiff's Complaint) Filed due by 08/31/2009. (Attachments: # 1) (Entered: 08/31/2009)
09/02/2009	16 REPLY to Response to Plaintiff's MOTION to Denial Plaintiff's Complaint. Filed by Defendant Andrea Bulfinch, SR. A Copakery. (Stevens, Michael) (Entered: 09/02/2009)
09/17/2009	17 ORDER granting Plaintiff's Motion to Denial Plaintiff's Complaint. IT IS FURTHER ORDERED that Plaintiff shall have thirty (30) days in which to file an answer to Plaintiff's Complaint. Andrea Bulfinch's Complaint deadline: 10/07/2009. Signed by Judge Ronald D. Dawson on 09/17/2009. Responses have been scheduled in accordance to the NLE. (RMZ) (Entered: 09/17/2009)

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