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

Proceeding	92051338
Party	Defendant Brien James Cook
Correspondence Address	Brien James Cook 5 Vasconcelos Court Sacramento, CA 95833 UNITED STATES contact@briencook.com
Submission	Motion to Suspend for Civil Action
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Signature	/mark r. leonard/
Date	09/08/2009
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE TRADEMARK TRIAL AND APPEAL BOARD

J&J SNACK FOODS CORP. Petitioner, v. BRIEN JAMES COOK Registrant	Cancellation No.: 92,051,338 Registration No.: 3,658,101 Mark: MIX IT UP!
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MOTION TO SUSPEND CANCELLATION ACTION

I. INTRODUCTION

Brien Cook, by his attorney, hereby moves to suspend the above cancellation action (the “Cancellation Action”) pursuant to TBMP §510.02(a) pending the outcome of a civil action between Cook and Petitioner J&J Snack Foods Corp. (“J&J”). Good cause exists for the suspension of this action because, as explained below, the civil action includes claims that bear on the Cancellation Action as well as claims that cannot be decided by the Board.

II. FACTS

J&J filed the Cancellation Action on or about August 12, 2009. Declaration of Mark R. Leonard In Support of Motion to Suspend (“Leonard Decl.”) ¶2. J&J’s petition seeks to cancel Cook’s registration for the mark MIX IT UP! on the ground that the mark is allegedly merely descriptive. Petition to Cancel ¶8. On or about August 20, 2009 Cook filed suit against J&J in the United States District Court, Eastern District of California (the “District Court Action”). Leonard Decl. ¶4. The District Court Action

alleges federal trademark infringement against J&J and seeks a declaratory judgment that Cook's mark is not descriptive. Leonard Decl. ¶2, Ex. A.

III. ARGUMENT

A. The Cancellation Action Should Be Suspended Because the District Court Action Raises Issues That Have a Bearing on the Cancellation Action.

When the parties in a case pending before the Board are involved in a civil action which may have a bearing on the Board case, the Board may suspend the case pending final determination of the civil action. TMBP §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." *Id.* The "Commissioner of Patents has held that, inasmuch as TTAB determination of the validity of registration are merely advisory to the courts, it is preferable for the TTAB to stay its own proceedings where parallel litigation occurs in the district court." *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F.Supp. 563, 567 (D.Minn 1986) (citations omitted) (district court denied motion to stay proceedings pending outcome of concurrent TTAB proceeding because, *inter alia*, TTAB decision would not be binding on court and district court action included claims outside the TTAB's jurisdiction).

J&J seeks cancellation of Cook's MIX IT UP! registration on the ground of descriptiveness. Petition to Cancel ¶8. In the District Court Action, Cook alleges trademark infringement of a federally registered mark under the Lanham Act and a declaratory judgment that his mark is not descriptive. Leonard Decl. ¶2; Ex.A. Cook's claims are therefore common to both actions. The District Court's determination of those claims will necessarily have a bearing on the Cancellation Action because its decision

will likely be binding on the Board. Accordingly, the Board should suspend the Cancellation Action pending final disposition of the District Court Action.

B. The Cancellation Action Should Be Suspended Because the District Court Action Raises Issues Beyond the Jurisdiction of the Board and Judicial Economy Favors Suspension.

Where facts concerning a disputed federal trademark registration are going to be litigated in connection with other claims before a district court, judicial economy favors the district court's determination of all the claims. *American Bakeries Co.*, 650 F.Supp. at 568.

In the District Court Action, Cook alleges claims of federal trademark infringement and seeks declaratory relief. Leonard Decl. ¶2, Ex. A. As discussed above, irrespective of how the Board rules on the claims before it, that decision is not binding on the District Court. Thus, regardless of which party is ultimately successful in the Cancellation Action, the case will still need to be litigated in the District Court. Additionally, Cook has claims in the District Court Action that are beyond the jurisdiction of the Board. If Cook is successful in the Cancellation Action he will still have to litigate his claims for damages for trademark infringement and declaratory relief. Therefore, judicial economy favors suspension of the Cancellation Action.

IV. CONCLUSION

For the reasons set forth above, Cook respectfully requests the Board to suspend the Cancellation Action pending final resolution of the District Court Action.

Respectfully submitted,

BRIEN JAMES COOK

By his attorneys,

Date: September 8, 2009

By: /mark r. leonard/
Mark R. Leonard
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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Motion to Suspend has been served on J&J Snack Foods Corp. by mailing said copy on Sept. 8, 2009, via U.S. Mail, postage prepaid to: J. Rodman Steele, Novak Druce + Quigg, LLP, 525 Okeechobee Boulevard, 15th Floor, West Palm Beach, FL 33401

/mark r. leonard/
Mark R. Leonard

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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**DECLARATION OF MARK R. LEONARD IN SUPPORT OF MOTION TO
SUSPEND CANCELLATION ACTION**

I, Mark R. Leonard, declare as follows:

1. I am an attorney with Davis & Leonard, LLP. I am licensed to practice law in the State of California, and as such I am a member of the State Bar of California. I am the attorney for the Registrant in the above-referenced opposition action. I have personal knowledge of the facts stated in this declaration, unless stated otherwise, and if called as a witness could and would competently testify to them.

2. J&J Snack Foods Corp. (“J&J”) filed the present cancellation action (the “Cancellation Action”) on or about August 12, 2009. On or about August 20, 2009 Cook filed suit against J&J in the United States District Court, Eastern District of California (the “District Court Action”). The District Court Action alleges federal trademark infringement against J&J and seeks a declaratory judgment that Cook’s mark is not descriptive. A true and correct copy of Cook’s complaint in the District Court Action is attached hereto as Exhibit A.

Being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001 and any equivalent statute or regulation, and that such willful false statements may jeopardize the of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom, I declare that I am properly authorized to execute this declaration as the attorney for Cook in this matter, that the facts set forth in this declaration are true; and that all statements in this declaration re made of my own knowledge and are true.

Date: September 8, 2009

By: /mark r. leonard/
Mark R. Leonard
DAVIS & LEONARD, LLP
8880 Cal Center Dr., Suite 180
Sacramento, CA 95826
Telephone: (916) 362-9000

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Declaration of Mark R. Leonard In Support of Motion to Suspend Cancellation Action has been served on J&J Snack Foods Corp. by mailing said copy on Sept. 8, 2009, via U.S. Mail, postage prepaid to: J. Rodman Steele, Novak Druce + Quigg, LLP, 525 Okeechobee Boulevard, 15th Floor, West Palm Beach, FL 33401

/mark r. leonard/
Mark R. Leonard

EXHIBIT A

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7 Attorneys for Plaintiff
Brien Cook

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9 **UNITED STATES DISTRICT COURT**
10 **EASTERN DISTRICT OF CALIFORNIA**

11
12 BRIEN COOK, an individual,
13 Plaintiff,
14 v.
15 J&J SNACK FOODS CORP., a New Jersey
corporation.
16 Defendant.

CASE NO.

**COMPLAINT FOR LANHAM ACT
VIOLATIONS AND DECLARATORY
RELIEF**

JURY TRIAL DEMANDED

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20 **I. OVERVIEW**

21 Through this action, plaintiff Brien Cook (“Cook”) brings federal claims against
22 defendant J&J Snack Foods Corp. (“J&J”) for federal trademark infringement and
23 declaratory relief.

24 **II. JURISDICTION AND VENUE**

25 1. The jurisdiction of this court is founded on 28 U.S.C. Section 1331 (federal
26 question) and 28 U.S.C. Section 1338 (trademark infringement), because the claims arise
27 under the Federal Lanham Act, 15 U.S.C. Section 1114.

28

1 B. The Defendant

2 9. Upon information and belief, J&J manufactures and distributes snack foods
3 and frozen beverage products, nationally and internationally, to food service customers
4 including snack bar and food stand locations in leading chain, department, discount,
5 warehouse club and convenience stores; malls and shopping centers; fast food outlets;
6 stadiums and sports arenas; leisure and theme parks; movie theatres; independent retailers;
7 and schools, colleges and other institutions.

8 10. Upon information and belief, a J&J subsidiary, The ICEE Company, a
9 Delaware corporation headquartered in Ontario, California and registered to do business
10 with the California Secretary of State, owns ICEE brand frozen drinks. ICEE is one of the
11 most well known brands of frozen drinks in the United States.

12 C. Cook's Initial Contact With The ICEE Company

13 11. In light of The ICEE Company's broad market presence in the frozen
14 beverage industry, in or about December 2004 Cook sought to meet with representatives of
15 The ICEE Company to explore mutual business opportunities, including the marketing of
16 ICEE branded products on Cook's MIX IT UP! website. On or about January 27, 2005
17 Cook met with two employees of The ICEE Company, Dave Springer and Randy Fachner,
18 at Cook's home in Sacramento. Cook's MIX IT UP! marketing materials, including a
19 brightly colored trailer featuring the MIX IT UP! mark on a number of locations on the
20 trailer, were well received by Springer and Fachner who expressed interest in mutual
21 branding opportunities with Cook.

22 12. During a subsequent telephone call between Springer and Cook, Springer
23 stated that there was interest within The ICEE Company in pursuing potential co-branding
24 opportunities with Cook. However, several weeks later Springer told Cook that The ICEE
25 Company's parent company was not interested in pursuing any business opportunities and
26 there were no further discussions between Cook and The ICEE Company.

27 D. J&J's MIX IT UP Mark

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1 13. On or about July 25, 2009 Cook received an e-mail from a friend who had
2 recently visited the Santa Cruz Beach Boardwalk in Santa Cruz, California and discovered
3 a vendor selling frozen beverages from a brightly colored trailer on which the mark MIX
4 IT UP appeared prominently. Cook subsequently contacted the vendor, Whiting Foods, to
5 obtain more information about its use of the MIX IT UP mark. In an e-mail to Cook on or
6 about July 27, 2009, Whiting Foods' owner, Ken Whiting, stated that The ICEE Company
7 created the brand and artwork for the trailer used by Whiting Foods and suggested that
8 Cook contact them for more information. Upon further research, Cook discovered MIX IT
9 UP concessions similar to the Whiting Foods trailer at a number of amusement parks
10 throughout the United States.

11 14. On or about August 4, 2009 Cook received a telephone call from J&J's
12 attorney, J. Rodman Steel, asking to discuss Cook's inquires into J&J's use of the MIX IT
13 UP mark. Cook referred Mr. Steel to his counsel, Mark Leonard. On or about August 5,
14 2009 the parties' counsel discussed J&J's mark during a telephone conversation. J&J's
15 counsel informed Cook's counsel that J&J had applied to register its MIX IT UP mark with
16 the United States Patent and Trademark Office ("PTO") and that the application was
17 suspended based on, *inter alia*, Cook's prior MIX IT UP! application. Cook's counsel
18 stated that Cook was seeking more information on the scope of J&J's use of the mark in
19 order to assess that use and asked J&J's counsel to provide such information.

20 15. After this conversation, Cook's counsel confirmed from PTO records that
21 J&J had filed the above application, Application No. 77/346835, in connection with "non-
22 alcoholic beverages, namely, frozen carbonated beverages" and that the PTO had
23 suspended the application on May 22, 2008 pending disposition of three prior filed
24 applications, including Cook's.

25 E. The Dispute Between The Parties

26 16. On or about August 11, 2009, J&J's counsel telephoned Cook's counsel and
27 informed him that J&J had voluntarily abandoned its application to register MIX IT UP
28

1 and had filed a petition to cancel Cook’s MIX IT UP! registration with the Trademark Trial
2 and Appeal Board on the grounds that the mark is descriptive.

3 FIRST CLAIM FOR RELIEF

4 (Trademark Infringement)

5 (15 U.S.C. §1114(1)(a))

6 17. Cook is the owner of the federally registered mark MIX IT UP!, Reg. No.
7 3,658,101, for “rental of machines and apparatus for making both alcoholic and
8 nonalcoholic iced fruit beverages, for use at special events from house parties to galas and
9 the like.”

10 18. Cook has continuously used his mark in interstate commerce in connection
11 with his website mixitup.biz since 2004.

12 19. As a result of Cook’s use of his MIX IT UP! mark, MIX IT UP! has become
13 a valuable mark indicating the source and origin of Cook’s products and services.

14 20. J&J’s use of its MIX IT UP mark in connection with frozen carbonated
15 beverages products, including offering MIX IT UP branded products and marketing
16 materials to its distributors, constitutes trademark infringement pursuant to 15 U.S.C.
17 §1114 and is likely to cause confusion among the relevant consuming public.

18 21. Upon information and belief, J&J’s wholesale copying of Cook’s MIX IT
19 UP! Mark, namely adopting that mark after its subsidiary’s employees met with Cook to
20 discuss co-branding opportunities, was willful and knowing, making this an exceptional
21 case within the meaning of 15 U.S.C. §1117(a).

22 22. For his claim for trademark infringement, Cook seeks relief as set forth
23 below.

24 SECOND CLAIM FOR RELIEF

25 (Declaratory Relief)

26 (28 U.S.C §2201)

27 23. Cook hereby incorporates the allegations contained in paragraphs 1 through
28 22 above as though fully set forth herein.

1 24. On or about August 11, 2009 J&J filed a petition to cancel Cook’s MIX IT
2 UP! registration with the Trademark Trial and Appeal Board, Cancellation No. 92,051,338
3 on the grounds that the mark is descriptive. Cook denies that his mark is descriptive.

4 25. An actual justiciable controversy within the meaning of 28 U.S.C §2201
5 exists between Cook and J&J concerning their respective rights. A judicial determination
6 is necessary and appropriate to resolve the conflicting claims and positions of the parties.
7 Cook is entitled to a declaratory judgment that his trademark is not descriptive and his
8 registration may continue in full force and effect.

9 26. Wherefore, Cook seeks relief as set forth below.

10 PRAYER FOR RELIEF

11 WHEREFORE, Cook demands judgment against J&J and relief as follows:

12 1. For actual damages, including Cook’s loss of business and profits, J&J’s
13 unjust enrichment, reasonable royalty, and any additional consequential damages or loss of
14 profits resulting from J&J’s wrongful, unlawful, and tortious acts as alleged in this
15 Complaint, in an amount to be proved at trial but believed to significantly exceed \$75,000.

16 2. For an Order preliminarily and permanently enjoining J&J, and any of its
17 officers, agents, employees, subsidiaries, distributors, and all persons acting in concert
18 with it, temporarily and preliminarily during the pendency of this action, and permanently
19 thereafter copying or infringing Cook’s valuable trademarks, trade names, or trade dress, in
20 any way.

21 3. For punitive or exemplary damages as permitted by law in an amount
22 necessary to punish or deter J&J.

23 4. That, with respect to Cook’s claim under the Lanham Act, 15 U.S.C.
24 §1125(a), Cook be awarded J&J’s profits and damages to Cook in an amount to be proved
25 at trial.

26 5. That, with respect to Cook’s claims under the Lanham Act, pursuant to 15
27 U.S.C. §1117(b), Cook recover three times his damages.

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1 6. For attorneys' fees and costs to the extent otherwise allowed by law or by
2 contract, including pursuant to 15 U.S.C. §1117(a).

3 7. For forfeiture and impoundment, as necessary and appropriate, by J&J of
4 any infringing articles or works it has created as a result of its infringement.

5 8. For such other and further relief as the Court may deem proper.

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7 Dated: August 19, 2009

DAVIS & LEONARD, LLP

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/s/Mark R. Leonard _____
Mark R. Leonard
Attorney for Plaintiff
Brien Cook

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