

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

Hearing:
September 14, 2010

Mailed:
February 23, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

Cake Divas
v.
Charmaine Jones

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Opposition No. 91177301
to Application Serial No. 76529077
filed July 11, 2007

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Joseph A. Mandour and Ben T. Lila of Mandour & Associates,
APC for Cake Divas.

Karin Segall and Dana C. Rundlof of Foley & Lardner LLP for
Charmaine Jones.

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Before Seeherman, Taylor and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Cake Divas, a California partnership ("opposer"), has filed an opposition to Charmaine Jones' ("applicant") application to register the mark CAKEDIVA, in standard character form, for, *inter alia*, for the following goods:¹

Cakes, namely, wedding cakes, bridal shower cakes, party cakes, novelty cakes and cakes for all occasions; edible cake sculptures of all shapes and sizes made primarily of sugar; cookies of all shapes and sizes; edible sugar

¹ The application also includes "greeting cards," in Class 16, but the application for registration of the mark for those goods was not opposed.

sculptures in the form of flowers,
inanimate objects, human images; and
edible decorations made of sugar for
cakes and cookies, in Class 30.

As the ground for opposition, opposer has alleged use of the mark CAKE DIVAS in connection with unidentified goods and services and that applicant's mark CAKEDIVA in connection with cakes so resembles opposer's mark as to be likely to cause confusion. In the ESTTA generated form,² opposer identified its application Serial No. 76538360 for the mark CAKE DIVAS for "custom cake making, baking, designing and decorating services for edible and faux cakes" as the basis for the opposition. The ESTTA generated form is considered part of the pleading. *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) ("the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper filed with the Board").

Although opposer did not plead that it had priority of use, as discussed below, priority was the only factual issue litigated in this case. In view thereof, we find that priority has been tried by the implied consent of the parties pursuant to Fed.R.Civ.P. 15(b)(2) and the notice of opposition is deemed amended accordingly.

² ESTTA is the Board's electronic filing system.

In its brief, opposer argued that "[r]egistration should be refused, [sic] because applicant falsely represented it has used the trademark CAKEDIVA on all of the goods listed in Application Serial No. 76529077," and, therefore, "the Board should also deny registration on the basis of fraud."³ As noted above, opposer alleged only likelihood of confusion as the ground for opposition. Opposer did not allege fraud as a ground for opposition nor did it seek to amend the pleading to assert fraud. Applicant, in her brief, objected to opposer's untimely assertion of fraud.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of the evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720-1721 (TTAB 2008).

The question of whether an issue was tried by consent is basically one of fairness. The non-moving party must be aware that the issue is being tried, and therefore there should be no doubt on this matter.

³ Opposer's Brief, pp. 5

Morgan Creek Productions Inc. v. Foria International Inc.,
91 USPQ2d at 1139.

Suffice it say that there was nothing in the evidence submitted by opposer to show that the issue of fraud was being tried. Certainly applicant was not aware that opposer was cross-examining applicant's witness for purposes of proving that applicant had committed fraud during the prosecution of her application for registration. We find that applicant was not aware that opposer intended to assert fraud until opposer filed its brief, and that the issue of fraud was not tried. Accordingly, opposer's arguments concerning applicant's purported fraud have been given no consideration.

Preliminary Issues

Ashbell J. McElveen, an executive chef, testifying on behalf of applicant, introduced into evidence a copy of the homepage from his website at "foodstop.com."⁴ The homepage features a link to a CAKE DIVA webpage identifying applicant's products. Mr. McElveen did not introduce the CAKE DIVA webpage, but described its contents. During the deposition, Mr. McElveen explained that although he has the entire website in storage, he obtained the copy of the homepage from a photographer that he had worked with

⁴ McElveen Dep., Exhibit 1.

previously.⁵ Opposer lodged an objection to Mr. McElveen's testimony regarding the contents of the CAKE DIVA webpage on the ground that it violates the best evidence rule.⁶

Opposer renewed the objection in its reply brief.⁷

The "best evidence rule" is a common law proposition that has been codified in Rule 1002 of the Federal Rules of Evidence, which states: "To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by Act of Congress." The "best evidence rule" requires the production of the original document when the contents of that document are at issue, as they are in this case. Federal Rule of Evidence 1004 excuses this requirement where it can be shown that the original has been lost or destroyed, as long as unavailability is not the result of the proponent's bad faith, the original is not obtainable, or the document is not closely related to a controlling issue.

Opposer's objection is well taken because (1) the webpage has not been lost or destroyed, (2) applicant failed to adequately explain the absence of the document, even

⁵ McElveen Dep., p. 11.

⁶ McElveen Dep., pp. 18-20.

⁷ Opposer's Reply Brief, p. 1. The better practice would have been for opposer to have renewed the objection in its main brief so that applicant would have had the opportunity to respond.

though testimony indicated that it existed, (3) applicant failed to show that a diligent effort to obtain the document was made, and (4) the content of the webpage is closely related to a controlling issue in this proceeding. In view thereof, opposer's objection to Mr. McElveen's testimony describing the CAKE DIVA webpage is sustained.

Opposer also objected to Mr. McElveen's testimony describing applicant's business cards displaying the CAKE DIVA mark on the basis of the "best evidence rule" because the business cards were not introduced into evidence. The objection is not well taken with respect to the testimony regarding the business cards because opposer elicited the testimony from the witness on cross-examination: that is, opposer specifically asked the witness to describe the business cards.⁸

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the application file for applicant's mark. The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. A notice of reliance on applicant's responses to opposer's interrogatory Nos. 1 and 2, including documents

⁸ McElveen Dep., p. 41.

identified by Bates Nos. CD000007-16 and CD000026-111 submitted in response to those interrogatories.

2. Testimony deposition of Leigh Groh, a Cake Divas partner, with attached exhibits;

3. Testimony deposition of Joan Spitler, a Cake Divas partner, with attached exhibits;

4. Testimony deposition of Lisa Feldman, a psychotherapist, testifying as to her personal knowledge regarding opposer's use of its mark;

5. Testimony deposition of Majbritt Almskou, an employee of opposer, testifying as to her personal knowledge regarding opposer's use of its mark.

B. Applicant's Evidence.

1. Testimony deposition of Ashbell J. McElveen, an executive chef, with attached exhibits, testifying as to his personal knowledge regarding applicant's use of her mark.

2. A notice of reliance on an article in the *Gary Info* filed pursuant to Trademark Rule 2.122(e).

Standing

Opposer uses the mark CAKE DIVAS to identify the manufacturing, baking and designing of edible and faux cakes.⁹ This is sufficient to demonstrate that opposer has a real interest in this proceeding and, therefore, has

⁹ Grode Dep., pp. 11, 14.

standing. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

In order for opposer to prevail on its likelihood of confusion claim, it must prove that it has a proprietary interest in the mark CAKE DIVAS and that its interest was obtained prior to either the filing date of applicant's application for registration or applicant's date of first use. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).

Opposer began using the mark CAKE DIVAS to identify the manufacturing, baking and designing of cakes on October 15, 1998.¹⁰

Establishing applicant's first use date for the mark CAKEDIVA for cakes is far more complex because applicant did not introduce any evidence of technical trademark use prior to opposer's established date of first use. Thus, applicant must rely on use analogous to trademark use. In other words, applicant must establish use analogous to trademark use prior to any use provable by opposer in order to tack

¹⁰ Grode Dep., pp. 15-16, 19 and Exhibit 2; Spitler Dep., p. 44.

such use onto the constructive use date attributable to the filing date of her application.

It is the commercial usage of a trademark which creates trademark rights. *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1130 (TTAB 1990). "Such usage can consist of use analogous to trademark use and need not be technical trademark use." *Id.*

Use analogous to trademark use must be of "such a nature and extent as to create an association of said [term] with a single source ... sufficient to create a proprietary right in the user deserving of protection." *Era Corp. v. Electronic Realty Associates, Inc.*, 211 USPQ 734, 745 (TTAB 1981). The manner of use must be "calculated to attract the attention of potential customers or customers in the applicable field of trade" so as to create an association of the term with a single source, even if anonymous. *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 308 (TTAB 1979).

Dyneer Corp. v. Automotive Products plc, 37 USPQ2d 1251, 1254 (TTAB 1995). "[T]he fact finder may infer the fact of identification on the basis of indirect evidence regarding the opposer's use of the word or phrase in advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications." *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996).

Opposer argues that "analogous use is only relevant if an opposer is attempting to establish that the opposer's

analogous use should prevent an applicant's federal registration. Simply put, citing analogous use can only be used as a basis for preventing another party's registration."¹¹ However, opposer's position is contrary to the cases where the applicant proved its priority through "analogous use." *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995) ("we find that there is no genuine issue of material fact that TSL, applicant's predecessor-in-interest, used the SURETRAC mark in a manner analogous to trademark use" to prove priority); *Asplundh Tree Expert Co. v. Defibrator Fiberboard Aktiebolag*, 208 USPQ 954, 957-959 (TTAB 1980) (applicant tried, but failed, to prove priority by use analogous to trademark use); see also *Era Corp. v. Electronic Realty Associates, Inc.*, 211 USPQ at 745 ("prior use of a term analogous to trademark or service mark use, although not of a nature sufficient for purposes of registration, may be sufficient to preclude a cause of action by a subsequent user notwithstanding that said party may have been the first to have made a technical trademark or service mark usages of its designation"); *In re Cedar Point, Inc.*, 220 USPQ 533, 537 (TTAB 1983) ("Of course, an applicant or registrant involved in an inter partes proceeding before the Board may himself reply on use analogous to trademark or service mark use to the extent

¹¹ Opposer's Reply Brief, p. 3.

that he may tack such use on to his technical trademark or service mark use for purposes of determining priority").

Opposer has not cited, and we have not found, any cases supporting opposer's proposition that analogous use can only be used as a basis for preventing another party's registration. Opposer relies on an excerpt from Professor McCarthy's treatise to support its position. However, opposer did not include the highlighted portion.

Prior use of a term in advertising, as a tradename, as a style or model designation, or in a purely descriptive sense may be sufficient to prevent a later user from obtaining federal registration of that term. ... This kind of priority, however, is purely defensive. **That is, the first to use a term, even in a non-affixed usage, may prevent federal registration by another, even though he himself may not be able to obtain federal registration.**

McCarthy On Trademarks and Unfair Competition § 16:22 (4th ed. 2010). In other words, a party may prove priority through use analogous to trademark use, but to obtain a registration, it must make technical use of the mark. Thus, "[a]nalogous service mark or trademark use may be tacked on to technical use of the term in question for the purpose of establishing prior rights in a proceeding of this type." *Era Corp. v. Electronic Realty Associates, Inc.*, 211 USPQ at 745.

As noted, the only issue litigated and argued in this case has been priority of use.

The following testimony and evidence has been made of record regarding applicant's use of CAKE DIVA:

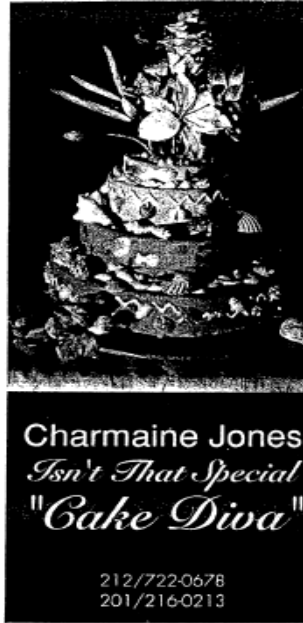
1. The advertisement shown below was published in the March 1993 *Brides Today* magazine.¹²



2. The advertisement shown below was published in the June 15, 1993 issue of *Brides Today* magazine.¹³

¹² Opposer's notice of reliance.

¹³ *Id.*



3. An article in the May/June 1994 issue of *Sugarcraft Magazine* entitled "New York Show Cakes: Charmaine Jones." The article noted that applicant is "[a]ffectionately known as the 'cake diva.'"¹⁴

4. An article in the September 1, 1994 issue of the *Gary Info* entitled "Gary native 'cake diva' in New York."¹⁵ The author writes that "Horace Mann High School's 1975 graduate Charmaine Williams-Jones, is known as the cake diva of New York City with astounding array of Afro-centric cakes." The article features a photograph of applicant with the heading "Charmaine Jones, the cake diva of New York and a former Garyite."

5. An article in the Spring/Summer 1996 issue of *Wedding Dresses Magazine* entitled "Isn't That Special:

¹⁴ *Id.*

¹⁵ Applicant's notice of reliance.

Outrageous Cakes.”¹⁶ In the article, the author wrote that “[s]tacked cakes and theme cakes are all the rage and Charmaine Jones, affectionately known as the ‘cake diva’ is leading the nation into very unique cake styles.”

6. An interview with applicant appearing in the May 1997 issue of *Black Diaprosa Magazine* entitled “Charmaine Jones The Cake Diva of Outrageous Cakes.”¹⁷ In the interview, the author revealed that “Charmaine Jones wants to take her business onto the next plateau hope-fully [sic] becoming a household name, Cake Diva.”

7. Ashbell McElveen, an executive chef, testified that “probably around ‘93’” he remembers applicant marketing “Christmas cards with gift box cakes on them” and that CAKE DIVA appeared on the cards.¹⁸ Mr. McElveen also testified that in 1995 he delivered a cake for applicant and left the cards next to the cake. The cards said “‘Outrageous cakes, the Cake Diva,’ with some contact details and a photograph of the Cake Diva.”¹⁹

Mr. McElveen also introduced into evidence a screen shot from the home page of his website *foodstop.com*.²⁰ There is a link to The Cake Diva webpage on the left-hand

¹⁶ Opposer’s notice of reliance.

¹⁷ *Id.*

¹⁸ McElveen Dep., p. 40.

¹⁹ McElveen Dep., pp. 31 and 41 (Opposer’s cross-examination).

²⁰ McElveen Dep., Exhibit 1.

side of the home page. The *foodstop.com* home page is displayed below.



The *foodstop.com* website home page was publicly available in October 1996.²¹ Mr. McElveen testified that the Cake Diva link generated "about thirty or so e-mails in the period of '96 that I recall that specifically wanted, 'How do you get in touch with Cake Diva, and how do I get a cake?'"²² On cross-examination, Mr. McElveen confirmed that the people who sent e-mails "referred to her as the Cake Diva, because that was what was on the site."²³ The Cake

²¹ McElveen Dep., p. 14.

²² McElveen Dep., p. 22.

²³ McElveen Dep., pp. 42-43.

Diva link appeared on the *foodstop.com* website through 2002.²⁴

Finally, Mr. McElveen testified that he had a segment on the Sunday Morning Weekend Today Show on NBC from 1990 through 1993²⁵ and that he featured applicant's cake for the 1993 Thanksgiving show.

Charmaine made a cornucopia cake. It is a huge cornucopia with all of the autumn vegetables and stuff, leaves. It was absolutely stunning, and that was the lead-into that Sunday show from my segment, and the show teased with the cornucopia.²⁶

Based on the evidence presented, we find that applicant used CAKE DIVA in a manner analogous to trademark and service mark use as of 1993. Applicant made *bona fide* commercial use of the mark through her advertising. Her use of the mark CAKE DIVA created a public identification for her mark and her goods as demonstrated by Ashbell McElveen displaying the cornucopia cake on the 1993 Thanksgiving show for the Sunday Morning Weekend Today Show and this public identification continued with the news articles referencing the Cake Diva in the *Gary Info*, *Wedding Dresses Magazine*, *Sugarcraft Magazine*, and *Black Diaprosa Magazine*.

²⁴ McElveen Dep., p. 26.

²⁵ McElveen Dep., p. 5.

²⁶ McElveen Dep., pp. 27-28. Because McElveen met applicant in 1993, the Thanksgiving show had to be in 1993. (McElveen Dep., p. 28.)

We note that applicant's early use is for the mark CAKE DIVA as two words and the mark sought to be registered is CAKEDIVA as one word. To tack the prior use of one mark [CAKE DIVA] onto another [CAKEDIVA] requires that the marks be legal equivalents or indistinguishable from each other, and that the consumer considers both as the same mark. The marks must create the same continuing commercial impression and the later mark must not materially differ from or alter the character of the mark attempted to be tacked. *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991). The marks CAKE DIVA and CAKEDIVA are legal equivalents because the space between the words "Cake" and "Diva" is inconsequential.²⁷ See *Humble Oil & Refining Co. v. Sekisui Chemical Co.*, 165 USPQ 596, 603 (TTAB 1970) (the marks S-LON and ESLON convey the same significance and would be recognized as the same marks); see also *In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (THEATL is the compressed version of THE ATL they are equivalent in sound, meaning and impression); *In re Planalytics Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004) ("gasbuyer" is the equivalent of "gas buyer"); (*Ex parte Pocket Books, Inc.*, 91 USPQ 182, 183 (Pat. Off. Ex.-in Chief 1951) (in an application where original drawing displayed

²⁷ Opposer contends that "[o]pposer's CAKE DIVAS and Applicant's CAKEDIVA trademarks are nearly identical in sight, sound, and connotation. (Opposer's Brief, p. 4).

the mark as two words and the substitute drawing displayed the mark as one word, the presence or absence of the space was immaterial).

In conclusion, we find that the mark CAKE DIVA is the legal equivalent of CAKEDIVA, that applicant may tack her use of CAKE DIVA onto CAKEDIVA, that applicant first used CAKE DIVA in 1993 and, therefore, that applicant has prior use. Because opposer has failed to prove that it had a proprietary interest in CAKE DIVA prior to that of applicant, opposer's likelihood of confusion claim fails.

Decision: The opposition is dismissed with prejudice.