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

Proceeding	91200575
Party	Plaintiff Hershey Chocolate & Confectionery Corporation, The Hershey Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HERSHEY CHOCOLATE & CONFECTIONERY  
CORPORATION and THE HERSHEY COMPANY,

Opposers,

v.

KENNETH B. WIESEN,

Applicant.

Opposition No. 91200575

**REPLY BRIEF IN FURTHER SUPPORT OF  
OPPOSERS' MOTION FOR SUMMARY JUDGMENT**

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Opposers Hershey Chocolate & Confectionery Corporation and The Hershey Company (together, “Hershey”) submit this reply brief in further support of their motion for summary judgment.

### **PRELIMINARY STATEMENT**

In its moving papers, Hershey provided undisputed evidence confirming that it has used MILKSHAKE as a mark for many years, that the mark is suggestive rather than merely descriptive, that even if the mark were merely descriptive, it has acquired distinctiveness, and that Applicant’s marks MILKSHAKE and MILK SHAKE pose an obvious likelihood of confusion.

Applicant, a practicing attorney, responded with no admissible evidence showing any disputed issue of fact, no expert evidence rebutting the opinion of Hershey’s expert, and largely irrelevant legal argument that does not address the settled authority cited by Hershey. Put simply, Applicant raises no issue of material fact that would preclude summary judgment.

Applicant’s main argument appears to be that the term MILKSHAKE on Hershey’s goods does not function as a trademark because, according to Applicant, it is a flavor identifier. But, as shown in Hershey’s moving papers and below, the evidence shows unmistakably that Hershey uses the mark in a trademark sense on its packages, in a prominent, stylized typeface, separate from and in addition to actual flavor designations. What is more, Applicant has conceded that the term MILKSHAKE can function as a mark for the confectionery goods, and cites no authority that, even if MILKSHAKE were a flavor identifier, that such an identifier itself could not serve as a mark.

Applicant also argues that MILKSHAKE is merely descriptive of Hershey’s goods, but fails to cite any admissible evidence to support this argument, and fails to refute (and largely ignores) the evidence cited by Hershey that the mark is at least suggestive, including dictionary definitions, third-party use, an expert linguistic opinion and the approval of prior registrations for

the mark in connection with candy products—all of which are precisely the types of evidence that the Board repeatedly has held are pertinent to the issue of whether a mark is suggestive or merely descriptive. Applicant even ignores his own legal position: his own applications claim that MILKSHAKE is registrable as an inherently distinctive mark for confectionery goods, and he has conceded that the previously MILKSHAKE registration (which was registered without a Section 2(f) claim) was used for a product that he hopes to resurrect and that, Applicant concedes, had the same flavor characteristics as Hershey’s MILKSHAKE-branded products.

Moreover, even if there were a triable issue as to whether Hershey’s mark is suggestive, Applicant also wholly fails to refute Hershey’s showing of acquired distinctiveness. Applicant points to no triable issue of fact in response to Hershey’s proof of tens of millions of dollars in sales and millions of dollars in advertising for MILKSHAKE-branded products over the past seven years, and provides no basis to disregard this classic evidence of acquired distinctiveness.

Finally, Applicant makes no attempt to address Hershey’s showing of likelihood of confusion. Applicant references no facts in the record, cites no cases, and discusses none of the applicable *du Pont* factors—effectively conceding that, if Hershey prevails in showing that it has a protectable mark, Applicant’s registrations would create a likelihood of confusion.

## **ARGUMENT**

### **A. The Undisputed Evidence Shows That Hershey Has Used MILKSHAKE as a Trademark Since 2005**

In his opposition, Applicant asserts that Hershey’s use of MILKSHAKE in its Whoppers and Kit Kat packaging is as a flavor identifier rather than as a mark. The record evidence, however, unequivocally shows that Hershey has used MILKSHAKE as a mark. Moreover, Applicant cites no authority that a suggestive “flavor identifier” cannot also serve as a mark.

A “trademark” is “any word, name, symbol, or device . . . used by a person . . . to identify

and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127. “[I]t is settled that a product label can bear more than one trademark without diminishing the identifying function of each portion. The salient question is whether the designation in question, as used, will be recognized in and of itself as an indication of origin for this particular product.” *Proctor & Gamble Co. v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468, 474 (TTAB 1976) (holding that opposer’s use of the term BUMPER TO BUMPER on labels, along with its house mark and product marks, was use as a trademark).

Here, as shown in the samples attached to the Kinderwater Declaration (one of which is reproduced below), the term MILKSHAKE is used as and functions as a mark on Hershey’s product packaging. It appears in the center of the label, in a distinctive font different from that used elsewhere on the label. The mark appears in all capital letters, except for the letter “i,” which appears in lowercase—a distinctive appearance that is indicative of trademark use. Further, as shown in the examples in Exhibit A to the Kinderwater Declaration, Hershey held MILKSHAKE out as a mark by using the ® symbol on its packaging during the periods in which Hershey owned a live registration for the mark. *See, e.g., STK LLC v. Backrack, Inc.*, 2012 TTAB LEXIS 186, \*28–29 (TTAB 2012) (non-precedential) (use of TM symbol “reinforce[d] the trademark significance of the term”).

Applicant’s position that MILKSHAKE is used as a flavor designation finds no support in the record. Indeed, the MILKSHAKE mark on Hershey’s goods is used *in addition to* terms describing the flavors of each product, such as “orange crème,” “vanilla” and “strawberry.” *See* Kinderwater Decl. Ex. A. The MILKSHAKE mark also is also visually separated from the descriptive words “malted milk balls,” which appear in much smaller font. *See id.* Finally, the

unrebutted expert testimony of Geoffrey Nunberg establishes that there is no “milkshake” flavor, meaning that consumers are more likely to view MILKSHAKE with source-indicating significance. Nunberg Report ¶¶ 21–42.



Kinderwater Decl. Ex. A.

None of the evidence cited in Applicant’s memorandum raises an issue of triable fact as to use as a trademark. To begin with, the photographs of other products attached by Applicant are irrelevant: None of those products uses the term “milkshake” at all, much less on a candy product similar to Hershey’s goods. See Applicant’s Exhibits I & II. Moreover, for many of the products, it is not even clear that the “nontraditional” flavor terms used in Applicant’s examples do not function as trademarks. As for the few anecdotal purported statements from the internet pasted into the body Applicant’s memorandum, they have no probative value. See *King of the Mt. Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1092 (10th Cir. 1999) (holding that “seven examples of actual confusion” was “de minimis and d[id] not support a finding of a genuine issue of material fact as to the likelihood of confusion”); *Ugg Holdings, Inc. v. Severn*, 2005 U.S.

Dist. LEXIS 45783, \*13–15, 21 (C.D. Cal. Feb. 24, 2005) (holding that anecdotal evidence of alleged generic usage did not create a genuine issue of material fact as to mark’s validity).

Nor does the page from Hershey’s website in 2007 raise a genuine issue of fact, as it relates to a use upon which Hershey does not rely, and does not alter the undisputed fact that Hershey has used MILKSHAKE as a trademark on tens of millions of dollars’ worth of candy products in the last eight years. In any event, as explained below (pp. 9–10), all of Applicant’s evidence, in addition to being irrelevant or non-probative, is inadmissible.

In sum, Applicant has failed to raise a genuine issue of material fact as to whether MILKSHAKE is used as a trademark on Hershey’s goods.

**B. The Undisputed Evidence Shows That Hershey’s MILKSHAKE Mark is Suggestive**

As set forth in Hershey’s opening brief, a mark is suggestive where, when encountered by a consumer, a multi-stage reasoning process or a mental leap is required to reach a conclusion about the nature of the goods. Opening Br. at 6–7 (citing, *inter alia*, *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 214, 218 (CCPA 1978); *Fortune Dynamic, Inc. v. Victoria’s Secret Stores Brand Mgmt., Inc.*, 618 F.3d 1025, 1033 (9th Cir. 2010)). By contrast, a merely descriptive mark will immediately convey the ingredients, qualities or characteristics of the goods with some degree of particularity. Opening Br. at 7 (citing, *inter alia*, *In re Abcor Dev. Corp.*, 588 F.2d at 814, 200 USPQ at 218); *Plus Prods. v. Med. Modalities Assocs., Inc.*, 211 USPQ 1199, 1204–05 (TTAB 1981)). Applicant does not contest, nor could he, these well-established legal standards.

Hershey’s opening brief set forth extensive evidence in the record—much of which is ignored by Applicant—showing that the mark MILKSHAKE on Hershey’s products is suggestive. *First*, Hershey cited a number of dictionary definitions (and Applicant’s own definition) of the term “milkshake” as a cold beverage made from milk, ice cream and flavorings. Opening Br.

at 9–10; Nunberg Report ¶ 21; Llewellyn Decl. Ex. E. Applicant offers no explanation as to how the MILKSHAKE mark merely describes the properties of Hershey’s goods, which are not cold beverages made from blending milk, ice cream and flavorings. *Second*, Hershey showed that the MILKSHAKE mark is not used by Hershey’s competitors as a descriptive term on candy products, which weighs in favor of Hershey’s argument that the mark is suggestive. *See* Opening Br. at 12 (citing, *inter alia*, *Minn. Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 1180 (CCPA 1972); *Sperry Rand Corp. v. Sunbeam Corp.*, 442 F.2d 979, 980 (CCPA 1971)). Applicant ignored this evidence and has introduced no evidence of third-party descriptive use of MILKSHAKE on candy products. *Third*, Hershey submitted evidence that the USPTO has approved registrations on three separate occasions for MILKSHAKE in connection with candy products—in 1929, 1984 and 1991—without requiring proof of secondary meaning, showing again that MILKSHAKE is not descriptive of candy products. *See* Opening Br. at 12; Llewellyn Decl. Ex. F. Again, Applicant fails to address this evidence.

Nor does Applicant raise any triable issue of fact in response to the unrebutted expert opinion of Hershey’s linguistics and lexicography expert, Dr. Nunberg, who explained that MILKSHAKE as used by Hershey is suggestive rather than descriptive because, among other reasons, “milkshake” does not connote a flavor or a “mouth feel,” and the term “milkshake” conveys socio-historical connotations unrelated to “gustatory associations.” Llewellyn Decl. Ex. D, Nunberg Report ¶¶ 22–42. Notably, Applicant does not take issue with Dr. Nunberg’s qualifications, which include (i) a Ph.D. in linguistics; (ii) experience teaching graduate and undergraduate linguistics courses at Stanford and elsewhere; (iii) work as a lexicographer, including a position as chairman emeritus of the Usage Panel of the *American Heritage Dictionary*; (iv) numerous publications in the field of linguistics and semantics; and (v) serving as an expert

witness in various proceedings, including cases before the TTAB. Nunberg Report ¶¶ 5–14 & Ex. A. Indeed, Applicant admits that Dr. Nunberg’s qualifications are “excellent.” Opp. at 5.

In arguing that Dr. Nunberg’s declaration is mere “opinion” (*id.*)—and purporting to offer his own non-expert testimony on linguistic and lexicological issues—Applicant seems to misunderstand the nature and function of expert testimony. Expert witnesses, unlike fact witnesses, are permitted to opine on issues within their expertise, as long as the expert’s opinion is based on reasoning or methodology that is sufficiently sound. *See Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993); Fed. R. Evid. 702. The Board has considered the opinions of expert witnesses, including linguists and lexicographers, in determining where marks fall on the distinctiveness spectrum. *See, e.g., In re Country Music Assoc., Inc.*, 100 USPQ2d 1824, 1830–31 (TTAB 2011) (crediting portions of report by the applicant’s expert, a professional linguist and lexicographer, regarding the genericness of the applied-for mark); *Labor Ready, Inc. v. Randstad General Partner (US) LLC*, 2008 TTAB LEXIS 555, \*14–19 (TTAB Jan. 23, 2008) (non-precedential) (crediting the opinion of the opposer’s expert witness, a linguist, on the issue of descriptiveness). Applicant, who has no qualifications to opine on these issues himself, proffers no expert opinion to rebut Dr. Nunberg’s well-reasoned opinion.

Finally, Applicant ignores the dispositive effect of his own legal position and admissions. Applicant is seeking to register MILKSHAKE as an inherently distinctive mark for goods similar to those sold by Hershey under the same mark, and has *conceded* that the older MILKSHAKE-branded candy products, which Applicant himself hopes to “reviv[e]” (Opp. at 1) in the same formulation using his applied-for MILKSHAKE mark, have the same flavor characteristics that, according to Applicant, render MILKSHAKE merely descriptive of Hershey’s products. *See* Opening Br. at 13 & n.7; Llewellyn Decl. Ex. B, Wiesen Depo. at 74:7–75:6, 93:21–94:17.

Applicant simply ignores this fundamental inconsistency in his own position.

**C. In the Alternative, There Is No Genuine Issue of Disputed Fact Refuting Hershey’s Showing that MILKSHAKE Has Acquired Distinctiveness**

Even if the Board were to conclude that the MILKSHAKE mark is merely descriptive of the goods sold by Hershey under that mark, Applicant has failed to raise a triable issue of fact regarding acquired distinctiveness. In particular, Hershey has put forward evidence of more than seven years of continuous and exclusive use, which itself is *prima facie* evidence of acquired distinctiveness. Kinderwater Decl. ¶ 2. Hershey also showed that it has sold more than \$31.5 million worth of MILKSHAKE-branded products over the past seven years, and that it has spent approximately \$4 million in advertising and promoting such products. *Id.* ¶¶ 5–6.

Applicant utterly fails to rebut Hershey’s showing or raise any issue of material fact with respect to the acquired distinctiveness of Hershey’s MILKSHAKE mark. In his cursory discussion of acquired distinctiveness, Applicant cites *no* evidence in the record to rebut Applicant’s showing. Applicant’s attorney argument, unhinged from the evidence in the record, is insufficient as a matter of law to rebut Hershey’s *prima facie* showing. *See In re Simulations Publications, Inc.*, 521 F.2d 797, 798, 187 USPQ 147, 148 (CCPA 1975) (“Statements in a brief cannot take the place of evidence.”).

Instead of citing evidence to refute Hershey’s showing of acquired distinctiveness, Applicant merely asserts, *ipse dixit*, that Hershey’s evidence is not probative.<sup>1</sup> Opp. at 4.

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<sup>1</sup> It is unclear what Applicant’s point is when he argues that the sales and advertising figures set forth in the Kinderwater Declaration are not “connect[ed]” to the MILKSHAKE mark. Opp. at 4. To the contrary, the sales and advertising figures cited by Hershey are specifically related to products sold under the MILKSHAKE mark, not to other Whoppers or Kit Kat products sold by Hershey without the MILKSHAKE mark. *See* Kinderwater Decl. ¶ 5 (\$31.5 million in sales on products “bearing the MILKSHAKE mark”); *id.* ¶ 6 (\$4 million in advertising for products sold under the MILKSHAKE mark).

Applicant makes no attempt to square his flippant disregard of Hershey's evidence with the settled authority cited by Hershey and unrefuted by Applicant, which holds that evidence of continuous and exclusive use of a mark in commerce for more than five years, substantial advertising expenditures, and significant sales of products sold under the mark are all highly probative of acquired distinctiveness. *See* Opening Br. at 13–14 (citing cases).

**D. Applicant Does Not Address Opposer's Showing of a Likelihood of Confusion**

Applicant devotes a mere two sentences to rebutting Opposer's showing of likelihood of confusion. Citing no evidence, and addressing none of the relevant *du Pont* factors, Applicant asserts that there will be no confusion between the parties' marks because Hershey uses the MILKSHAKE mark is merely a flavor designation. By not addressing Hershey's arguments regarding likelihood of confusion, Applicant effectively concedes that if Hershey prevails in showing that it has protectable rights in the MILKSHAKE mark, then Applicant's applications must be denied on likelihood-of-confusion grounds.

**HERSHEY'S EVIDENTIARY OBJECTIONS**

As explained above, Applicant's evidence, even if fully considered by the Board, is insufficient to raise a triable issue of fact. In addition, much of the evidence attached or incorporated into Applicant's brief, with the exception of three pages of Hershey business records,<sup>2</sup> is inadmissible and should be stricken or disregarded by the Board.

First, Applicant has failed to authenticate (a) the photographs of products attached as Exhibits I and II, and (b) the first page of Exhibit III, which purports to be a page from Hershey's website in 2007 from the Internet Archive's "Wayback Machine." Without a supporting declara-

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<sup>2</sup> Hershey does not object to Applicant's reference, as part of Exhibit III, to three business records produced by Hershey during discovery bearing Bates stamps HRSY00000624, 632 and 633, which are examples of Hershey's use of the MILKSHAKE mark.

tion to authenticate these documents, they cannot be considered as part of the summary judgment record. *See Paris Glove of Canada, Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1858–59 (TTAB 2007) (striking unauthenticated pages from Internet Archive’s “Wayback Machine” that were introduced without a supporting declaration) (citing, *inter alia*, *Novak v. Tucows, Inc.*, 2007 U.S. Dist. LEXIS 21269, \*17 (E.D.N.Y. Mar. 26, 2007)); *see also* TBMP § 528.05(e).

Second, with respect to the quotations in Applicant’s memorandum of various Google search results, Applicant has failed to make these webpages or search results part of the record by attaching copies to his brief. *Cf. Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); TMBP § 528.05(e) (allowing self-authenticating evidence to be “submitted *as an attachment* or exhibit to a party’s supporting brief”) (emphasis added); 37 C.F.R. § 2.122(e).

### CONCLUSION

For the reasons set forth above and in Hershey’s opening brief, Hershey respectfully requests that the Board grant Hershey’s motion for summary judgment and refuse registration of applicant’s infringing MILKSHAKE and MILK SHAKE trademarks.

Dated: September 16, 2013  
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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that, on September 16, 2013, I caused the foregoing REPLY BRIEF IN FURTHER SUPPORT OF OPPOSERS' MOTION FOR SUMMARY JUDGMENT to be served by email and by U.S. first-class mail, postage prepaid, upon the following correspondent of record for applicant:

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