

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: December 27, 2013

Opposition No. 91200575

Hershey Chocolate &
Confectionery Corporation and
The Hershey Company

v.

Kenneth B. Wiesen

**Before Quinn, Wolfson and Masiello,
Administrative Trademark Judges**

By the Board:

This case now comes up for consideration of opposers' motion for partial summary judgment (filed July 22, 2013) on the ground of priority and likelihood of confusion.¹ The motion is fully briefed.²

¹ As last reset, the first testimony period was due to commence on July 25, 2013. As the motion for summary judgment was filed on July 22, 2013, the motion is timely. Trademark Rule 2.127(e)(1).

² As opposers' motion was served on July 22, 2013, via first-class mail, applicant was allowed until August 26, 2013, to serve and file his response. See Trademark Rules 2.119(c) and 2.127(e)(1). However, applicant served and filed his response on August 27, 2013. On September 10, 2013, applicant filed a motion asking the Board to consider his late filing. As opposers have not objected to the filing on timeliness grounds, we have considered applicant's brief on the merits. Cf. *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478 (TTAB 1998) (timeliness requirement waived by plaintiff's failure to object to motion on timeliness grounds).

Background

A notice of opposition was filed on July 7, 2011, against application Serial Nos. 85210942³ and 85221585⁴ on grounds of priority and likelihood of confusion under Section 2(d) and false suggestion of a connection under Section 2(a) of the Trademark Act. Opposers have pled common law use of the mark MILKSHAKE in connection with "various candy products" as well as ownership of application Serial No. 85257980⁵ and "continuous use throughout the United States since 2005." *Notice of Opposition*, ¶¶ 2 and 5.

Applicant filed his answer on July 14, 2011, denying the salient allegations in the notice of opposition.

Summary Judgment Standard

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial,

³ For MILK SHAKE in standard characters for "candy; candy bars" in International Class 30, filed January 5, 2011, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and published for opposition on June 14, 2011. MILK has been disclaimed.

⁴ For MILKSHAKE in standard characters for "candy; candy bars; candy with caramel; candy with cocoa; chocolate candies" in International Class 30, filed January 19, 2011, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), and published for opposition on June 14, 2011.

⁵ For MILKSHAKE in standard characters for "candy" in International Class 30, filed March 4, 2011, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use anywhere and in commerce of December 21, 2005.

that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). If the moving party is able to meet this initial burden, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. The nonmoving party may not rest on mere allegations or assertions but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. Should the nonmoving party fail to raise a genuine dispute of material fact as to an essential element of the moving party's case, judgment as a matter of law may be entered in the moving party's favor.

A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor.

Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board does not resolve disputes of material fact but rather only ascertains whether disputes of material fact exist. See *Lloyd's Food Products*, 987 F.2d at 766, 25 USPQ2d at 2029; *Olde Tyme Foods*, 961 F.2d at 200, 22 USPQ2d at 1542.

Decision

A plaintiff moving for summary judgment on a likelihood of confusion claim must establish that there is no genuine dispute that it has standing to maintain the proceeding, that it has prior proprietary rights in its pleaded mark, and that contemporaneous use of the parties' respective marks on their respective goods and/or services would be likely to cause confusion or mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Turning first to the question of standing, there is no genuine dispute that opposers have established their standing in this matter: opposer Hershey Chocolate & Confectionery Corporation has standing by virtue of its application Serial No. 85257980 being suspended pending disposition of the involved applications, which applicant has admitted in his answer (*Answer*, ¶ 5, and *Declaration of*

Paul C. Llewellyn, Exh. A), and opposer The Hershey Company⁶ has standing by virtue of establishing its common-law use of MILKSHAKE for candy products (*Declaration of Craig Kinderwater* (hereinafter "*Kinderwater Declaration*"), ¶¶ 2-4 and Exh. A). See *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009).

As to priority, since applicant has yet to use the mark in commerce (see *Deposition of Kenneth B. Wiesen*, p. 61 and *Applicant's Response to Opposer's First Set of Interrogatories*, Response No. 5), the earliest date upon which applicant can rely is the filing date of each application, i.e., January 5, 2011 (application Serial No. 85210942), and January 19, 2011 (application Serial No. 85221585). See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). Opposers have pled first use of their mark in connection with candy products since 2005 and have provided evidence in support thereof. See *Kinderwater Declaration*, ¶¶ 2-4 and Exh. A. As applicant has failed to provide any evidence to raise a genuine dispute of material fact about opposers' prior use, we find no genuine dispute as to opposers' priority of use.

Nor do we find a genuine dispute as to the similarity of the parties' marks and goods in question. The marks are

⁶ Opposers, in their notice of opposition, identify The Hershey Company as the licensee of Hershey Chocolate & Confectionery Corporation. *Notice of Opposition*, ¶ 1.

essentially identical in sound, appearance and connotation and the goods are the same. Applicant does not contend otherwise. Rather, and notwithstanding applicant's own applications that are the subject of this proceeding, the basis of applicant's opposition to opposers' motion appears to be either that the mark is not inherently distinctive but is instead merely descriptive of a flavor or characteristic of opposers' candy, or that opposers have abandoned the mark.

In support of applicant's contention that the mark is merely descriptive, applicant argues that "hundreds of nontraditional terms are being used to identify flavors and tastes of products" and attaches to his brief photocopies of various candy packaging, none of which relate or speak to the allegedly descriptive nature of MILKSHAKE. See *Applicant's Opposition*, p. 9 and Exh. 1. The only evidence submitted by applicant relating to the mark in question are copies of opposers' own packaging bearing the term MILKSHAKE. *Id.*, Exh. 3. This evidence is insufficient to raise a genuine dispute as to the inherent distinctiveness of MILKSHAKE as it relates to candy. While it is apparent from opposers' submissions that "milkshake" describes a type of beverage, applicant has failed to submit any evidence to support his contention that "milkshake" describes a flavor or a characteristic of candy. As such, we do not find a

genuine dispute as to the inherent distinctiveness of MILKSHAKE as used in connection with candy.

Finally, to the extent that applicant argues in his brief that opposers "had abandoned the mark as far back as 1996 when they took over the predecessor companies who owned the marks and actually produced the Milkshake candy bar," such abandonment in 1996, even if true, is not a material fact in view of the record before us wherein opposers have submitted evidence of use since 2005, which is not disputed by applicant: "There is no contention that Opposers have not used the term Milkshake periodically between 2005 and present on a number of its Whoppers and Kit Kat branded candy wrappers." *Applicant's Opposition*, pp. 2-3. In other words, even if opposers had abandoned the mark, opposers' subsequent use since 2005 represents a new and separate use of the mark sufficient to establish a new priority date.⁷ See *Cerveceria Centroamericana S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1027, 13 USPQ2d 1307, 1312-13 (Fed. Cir. 1989), *aff'g*, 10 USPQ2d 1064, 1068-69 (TTAB 1989).

In view thereof, as there is no genuine dispute as to any material fact concerning opposers' standing, and claim

⁷ In view of the evidence of use put forward by opposers, applicant's concession of opposers' use of the mark "between 2005 and present" and the lack of any evidence corroborating applicant's claim of abandonment, we find applicant's contention of abandonment based on opposer Hershey Chocolate & Confectionery Corporation's surrender of Registration Nos. 1273766 and 1669640

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of priority and likelihood of confusion, we hereby **GRANT** opposers' motion for summary judgment.⁸ The opposition is sustained and registration to applicant is hereby refused.

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speculative and unsupported by the record and, therefore, insufficient to raise a genuine dispute of material fact.

⁸ In view thereof, we need not reach opposers' Section 2(a) claim.