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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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Attachments	Hershey Reply to Opposition to Motion to Strike.pdf (4 pages)(114894 bytes)

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

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HERSHEY CHOCOLATE & CONFECTIONERY :
CORPORATION and THE HERSHEY COMPANY,

Opposers,

Opposition No. 91200575

v.

KENNETH B. WIESEN,

Applicant.

:

x

**REPLY TO APPLICANT'S OPPOSITION TO
MOTION TO STRIKE PORTION OF APPLICANT'S ANSWER**

Applicant Serial No: 85/221,585
Filed: January 19, 2011
Published for Opposition: June 14, 2011
Mark: MILKSHAKE

Applicant Serial No: 85/210,942
Filed: January 5, 2011
Published for Opposition: June 14, 2011
Mark: MILK SHAKE

TO: Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Pursuant to Section 2.127(a) of Title 37 of the Code of Federal Regulations and T.B.M.P. § 502.02(b), Opposers Hershey Chocolate & Confectionery Corporation ("HC&CC") and The Hershey Company ("Hershey Company," and, together with HC&CC, "Hershey") hereby submit this reply in further support of Hershey's Motion to Strike as insufficient and immaterial paragraph 13 of Applicant's Answer to Notice of Opposition.

I. ARGUMENT

The case law cited in the Motion to Strike clearly holds that conduct relating to trademark registrations is irrelevant when the Opposition is premised on the trademark owner's common law rights rather than any registered marks. *See, e.g., Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q.2d 1917, 2006 WL 173463, at *13 (T.T.A.B. 2006), appeal dismissed, 186 Fed. App'x 1005 (Fed. Cir. 2006) (finding applicant's fraud defense to be "clearly irrelevant and frivolous" because opposer was "still entitled to rely on its common law rights in asserting its claim of likelihood of confusion in the opposition"); *Santana Prods., Inc. v. Compression Polymers, Inc.*, 8 F.3d 152, 155 (3d Cir. 1993) (internal citation omitted) ("[T]he cancellation of a trademark registration does not extinguish common law rights the registration did not create."); *California Cooler, Inc. v. Loretto Winery, Ltd.*, 774 F.2d 1451, 1454 (9th Cir. 1985) (holding that "deficiencies in registration, such as a failure to renew, or even cancellation, do not affect common law trademark rights") (internal citation omitted).

Applicant (who, it should be noted, is nominally *pro se*, but is an attorney licensed to practice in New York) has made no effort to dispute this settled law, and, in fact, states in his Opposition that he "does not dispute this well recognized legal canon that a party may rely on their common law rights irrespective of fraud in the acquisition of a prior registration."

Opposition at 1.

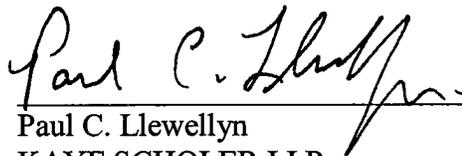
Applicant then misleadingly argues that the defense set forth in paragraph 13 of his Answer purportedly is different because it relates to alleged continuing conduct. However, as noted above, Applicant fails to demonstrate that the alleged conduct relating to Hershey's prior registrations, upon which Hershey does not rely, is relevant under the undisputed case law. Accordingly, any defense relating to those prior registrations is irrelevant as a matter of law and

will needlessly compound discovery. *See, e.g., Specialty Minerals, Inc. v. Pluess-Stauffer AG*, 395 F. Supp. 2d 109, 114 (S.D.N.Y. 2005) (holding that plaintiffs would be prejudiced by the inclusion of defendant's insufficient unclean hands defense because it would require additional discovery and expand the length and scope of trial).

II. CONCLUSION

For the foregoing reasons, Hershey respectfully requests that the Board grant Hershey's Motion to Strike paragraph 13 from Applicant's Answer pursuant to Federal Rule of Civil Procedure 12(f) and T.B.M.P. § 506.

Date: September 9, 2011
New York, New York



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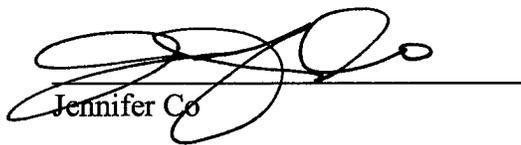
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that she caused the foregoing Reply to Opposition to Motion to Strike Portion of Applicant's Answer to be served this 9th day of September, 2011, by U.S. first class mail, postage prepaid, upon the following correspondent of record for Applicant:

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