

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

RK

Mailed: December 19, 2011

Opposition No. 91200575

Hershey Chocolate & Confectionery
Corporation and The Hershey
Company

v.

Kenneth B. Wiesen

Yong Oh (Richard) Kim, Interlocutory Attorney:

On December 9, 2011, the Board held a telephone conference to hear argument and rule on opposer's motion (filed August 5, 2011) to strike a portion of applicant's answer, specifically paragraph 13. Paul C. Llewellyn, Esq., appeared on behalf of opposer and Kenneth B. Wiesen, Esq., appeared *pro se*.

As part of his answer filed on July 14, 2011, applicant alleged the following:

13. Applicant further affirmatively alleges that Opposers should be estopped from opposing Applicant's marks as such opposition is part of a continuing scheme of fraud in applying for and renewing the MILKSHAKE mark and other similar marks. Such activities include, *inter alia*, Opposers [sic] actions in Registration Nos. 1273766, 1669640 and 1690384 and as further evidenced by Cancellation Proceeding No. 92053727.

Opposer seeks to strike this portion of applicant's answer as "insufficient and immaterial" considering that the opposition "is premised solely on [opposer's] common law rights, and does not assert any trademark registrations." *Motion to Strike*, pp. 1-2. During the conference, the Board afforded applicant an opportunity to further clarify his basis for paragraph 13 as well as his opposition to opposer's motion, to which applicant reiterated his position that the alleged fraud perpetrated in connection with the cited registrations and opposer's surrender of the involved registrations in the cited cancellation proceeding all go to demonstrating a continuing scheme of deceit and fraud which undermine the credibility of opposer's claims of prior use and any evidence in support thereof.

Decision

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP § 506 (3d ed. 2011). While motions to strike are not favored, matter will be stricken if it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

During the conference, the Board noted, and applicant agreed, that a party may rely on its common law rights in a mark to maintain a Board proceeding regardless of any fraud it may have perpetrated in obtaining a federal registration for that mark. *See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006). Indeed, rights in a mark "arise from use and not registration" and therefore "the cancellation of the registration does not necessarily extinguish the rights acquired in the mark through common law usage in commerce." *VIP Foods, Inc. v. V.I.P. Food Products*, 200 USPQ 105, 114 (TTAB 1978). Thus, applicant's claim of opposer's "continuing scheme of fraud in applying for and renewing the MILKSHAKE mark and other similar marks" is irrelevant to this proceeding where opposer relies on its common law rights for its cause of action. Applicant has failed to provide any support for his claim that alleged misconduct in connection with a number of opposer's prior registrations (several of which are for a mark unrelated to opposer's MILKSHAKE mark) taints opposer's common law rights in its MILKSHAKE mark so as to bar opposer from relying on such rights in this proceeding.

In view thereof, opposer's motion to strike paragraph 13 of applicant's answer is **GRANTED**. Proceedings are **RESUMED** and dates are **RESET** as follows:

Deadline for Discovery Conference	1/11/2012
Discovery Opens	1/11/2012
Initial Disclosures Due	2/10/2012
Expert Disclosures Due	6/9/2012
Discovery Closes	7/9/2012
Plaintiff's Pretrial Disclosures Due	8/23/2012
Plaintiff's 30-day Trial Period Ends	10/7/2012
Defendant's Pretrial Disclosures Due	10/22/2012
Defendant's 30-day Trial Period Ends	12/6/2012
Plaintiff's Rebuttal Disclosures Due	12/21/2012
Plaintiff's 15-day Rebuttal Period Ends	1/20/2013

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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