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

Proceeding	91200575
Party	Defendant Kenneth B. Wiesen
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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,

v

Opposition No.
91200575

KENNETH B. WIESEN,

Applicant.

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Opposers counsel argues that the Trial and Appeal Board is limited to considering only evidence of the “consumers understanding of the term MILKSHAKE”. Page 10 of Opposer’s counsels opposition states that such consideration is ***“the only issue relevant to Applicant’s theory that Hershey purportedly did not use MILKSHAKE in a trademark manner”***. Such position not only defies logic, US Patent and Trademark rules and regulations and case law interpretation, but the argument itself lays bare Opposer’s desperation to secret the most basic evidence. Opposer wishes their alleged common law use to be reviewed on standards that are not only different, but based on a much narrower and less stringent standard, than the US Patent & Trademark Office would evaluate an application for the MILSHAKE mark in the first instance.

More specifically, it is axiomatic that a USPTO examiner would issue an office action based upon apparent descriptive or mis-descriptive use of the term, MILKSHAKE when reviewing an application for the MILKSHAKE Mark, as used on the Kit Kat & Whoppers specimens offered by Opposer Hershey. These two specimens are submitted as Exhibit 1, for ready reference. It should be noted that the term MILKSHAKE is next to an image of a milkshake drink and the term

strawberry is also next to an image of a strawberry, (clearly and naturally relaying flavor and ingredient of the product). In such instance the applicant would, at the very least, be required to offer evidence that the term MILKSHAKE on the specimen offered was neither a flavor nor ingredient as well as explain how such term as used on the wrappers were not mis-descriptive. Opposer, who is not a registrant of the mark wishes to prevent Registrant's use on evidence which, Opposer argues should be evaluated in the abstract and with less scrutiny than a routine application for the mark. As registrant of the mark, I only seek evidence from Opposer as to whether or not MILKSHAKE flavor was an ingredient in the products they offered. I do not, as Opposer claims in their opposition, seek discovery of Hershey's employees *consideration* of the meaning of the term, MILKSHAKE.

15 U.S.C. A. Section 1052 (a) holds that registration will be refused on the principal registry if it *"consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively mis-descriptive of them"*. In the case *Vision Center v. Opticks, Inc.*, 596F.2d 111 (5th Cir. 1979), the Fifth Circuit concluded that the disputed mark was descriptive. The court observed that *"[w]henever a word or phrase naturally directs attention to the qualities, characteristics, effect, or purpose of the product or service, it is descriptive and cannot be claimed as an exclusive trade name."* Opposer not only asks this reviewing body to ignore the *natural* reaction to the term Milkshake, as used by Opposer, but it wishes to place barriers in Registrant's ability to seek disclosure of potential evidence that the specimen offered by Opposer, as proof of trademark use, is by its very nature a descriptive term unregistrable according to the rules which guide the USPTO. In effect Opposer wishes to prevent a registration based upon a claimed common law use that would not pass muster as an Application for the Registration of a Mark in the first instance.

In the Application of Helena Rubinstein Inc., 410 F.2d 438, the Court considered whether

the refusal by the Trial and Appeals Board to allow registration of the Marks *Pasturized & Pasteurized Face Cream* should be upheld as the terms were in fact descriptive. In considering the central issue of descriptiveness the Court examined evidence as to whether or not the product offered was in fact *pasturized*. Similarly, in *Eagle Snacks, Inc. v. Nabisco Brands, Inc.* 625 F.Supp.571, the U.S. District Court considered the ingredients of the product offered to determine whether or not the term "*honey roasted*" was descriptive and thus could not be registered. Additionally, the US District Court considered evidence in *Natures Bounty, Inc. v. Basic Organics*, 432 F. Supp 546 as to what the ingredients of the product were in order to determine whether or not the mark "**B-100**" was merely descriptive.

Registrant does not take the position that competent evidence of public perception may not be probative for consideration. Opposer may in fact argue that despite the inherent descriptive nature of the term, MILKSHAKE or that the term is in fact is a flavor ingredient in their products offered, the term, MILKSHAKE nevertheless has taken on a secondary meaning and identifies the source of the goods to consumers. Of note, as of yet, in this matter, Opposer has offered no such competent survey of public perception evidence. Rather it wishes to rely upon the offering of a hired linguist. Of course it will be Registrant's position that since the matter of descriptiveness by its very nature must be viewed from a natural and common sense basis, a Linguist would not nothing more than an improper attempt to substitute the role of the reviewing body with that of an "expert".

Opposer wishes to forgo basic review and common sense. Alleged common law use should be viewed from the offering of the product specimen and surely not in the abstract. Opposer wishes to forgo the facts. Opposer's alleged common law use should be evaluated in the first instance on what Opposer actually offers as proof of the common law use. Both specimens **naturally direct** attention to the flavor, ingredients and characteristics of the product. Both offers of proof bear other Marks that clearly identify the source or origin of the products. Courts have routinely held that non-

trademark use must be evaluated in the context it is used. In *Dessert Beauty, Inc v. Fox*, 568 F.Supp 2d 416, *Tommy Hilfiger Licensing, Inc. V. Nature Labs, LLC*, 221 F.Supp2d 410 & *Cosmetically Sealed*, 125 F.3d at 30-31, the Courts all held that the **non**-trademark use of a mark is evidenced by the fact that the source of the product is clearly identified by the prominent display of the manufacturers *other* well known Marks. In this instance the *other* well known marks are KIT KAT and WHOPPERS.

Along the same vein, Opposer would ask that their alleged use of the mark should be evaluated only in the abstract and not in connection with other product offerings. For example, as depicted in Exhibit 1, the KIT KAT product is offered in numerous flavors. Those flavors are exactly in the same location as the term MILKSHAKE. Moreover Opposer's own website (available to all consumer's) clearly lists "MILKSHAKE" as a flavor of the KIT KAT product, see Exhibit 2.

All registrant asks is to be given a fair opportunity to seek disclosure so that opposer's claimed common law use can be examined in a complete and actual sense rather than in a limiting and abstract fashion.

Lastly, Opposer's claim that your Affirmant has not acted in good faith to resolve the issues of discovery, is absurd. The specific line of disclosure sought has been the same from the very beginning of the discovery process. Each conversation with Opposer's counsel, including conference calls with the assigned attorney, each reply to my written inquiries have been exactly the same, *we have fully complied*. The reason I stated in my last letter to Opposer's counsel that this is my "**last**" good faith effort was because I had made the very same requests and efforts time and time again previously. Remarkably, Opposer's Counsel complains that my last letter was similar to one of my previous letters. Well that was so because it was the very same disclosure sought time and time again, only to be met by the very same position by Opposer's Counsel. Opposer's Counsel attempts to take the Board's March 8, 2012 Order out of context. Simply because I did not renew a telephone

call with opposer's counsel **subsequent** to the date of the order does not in any way demonstrate that I did not make repeat and replete attempts to get Opposer to budge of of their continued refusal to budge from their decision not to disclose.

For all of the foregoing reasons it is respectfully requested that Opposer be compelled to comply with the disclosure demands as specified in the moving papers.

Dated February 14, 2013
Carle Place, New York

A handwritten signature in black ink, appearing to read "Kenneth B. Wiesen". The signature is written in a cursive style with a horizontal line underneath it.

Kenneth B. Wiesen, Pro se Registrant
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that he caused the foregoing REPLY to be served on the 15th day of February, 2013 by email and by first class mail, postage prepaid, upon the following correspondents of record for Opposer;

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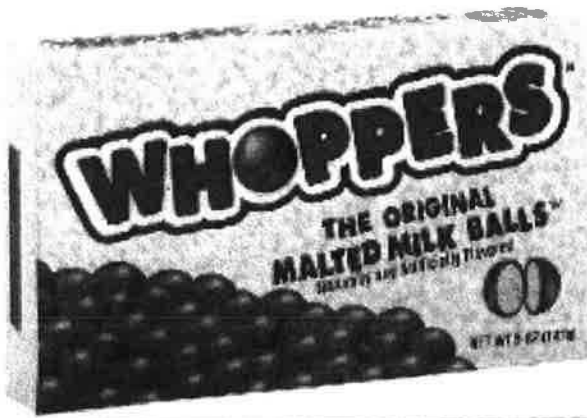


Exhibit B



Exhibit C

products by category

- ◆ chocolate candy
- ◆ sugar confectionery
- ◆ gum & mint
- ◆ snacks
- ◆ pantry items
- ◆ HERSHEY'S SOLUTION CENTER
- ◆ kosher products
- ◆ products a-z

general nutrition information

- ◆ chocolate
- ◆ antioxidants
- ◆ low fat products
- ◆ nuts
- ◆ fat
- ◆ black licorice
- ◆ insulin resistance
- ◆ physical activity & young people
- ◆ health & nutrition info for professionals



HERSHEY'S Kitchens
MINI KISSES Butter Pecan Bars

◆ find the recipe ◆



KIT KAT wafer bar

KIT KAT's light, crispy wafers in chocolate are a simple treat that complements your lighthearted, positive approach to life.

www.hersheys.com/kitkat

Flavors



Milk Chocolate



White Chocolate



Limited Edition Coffee



Limited Edition Milkshake



Limited Edition Orange Creme



Limited Edition Extra Crispy

Nutrition Information

Flavor

Nutrition information for this flavor is not available online at this time. Please consult the package label or call us at (800) 468-1714 for further information.

History

KIT KAT is the number one selling candy bar in the U.K. KIT KAT is a licensed brand from Societe Des Produits Nestle S.A. Hershey Foods Corporation's original licensing agreement was executed with Rowntree Products in 1969. In 1988, Nestle purchased Rowntree.

Timeline

- 1931** The KIT KAT wafer bar is introduced.
- 2000** The KIT KAT BIG KAT wafer bar is introduced.
- 2002** KIT KAT Limited Edition White Chocolate and Dark Chocolate wafer bars are introduced.
- 2003** KIT KAT expands its limited edition line to include mint and orange flavors.
- 2004** KIT KAT BIG KAT Limited Edition White Chocolate and KIT KAT Triple Chocolate wafer bars are introduced.

EXHIBIT E

Handwritten signature