

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: Conical KISSES Design  
Ser. No.: 85773692  
Examining Attorney: Heather Biddulph, Law Office 104

Commissioner for Trademarks P.O.  
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**RESPONSE**

Hershey Chocolate & Confectionery Corporation ("Hershey" or "Applicant") submits this Response to the Office Action dated December 21, 2013.

**Drawing**

The Examining Attorney has requested that the drawing be depicted so that the bottom base of the pouch is presented in dotted lines. Attached please find the amended drawing complying with the Examining Attorney's requirement. The description has also been amended accordingly to "The mark consists of a pouch package configuration design in a stylized conical shape with a wavy plume at the top; the base shape appearing in broken lines is not a feature of the mark."

**Refusal**

In the Office Action, the Examining Attorney has issued a refusal to register the Applicant's iconic Kisses® conical shape with plume design as being a nondistinctive product design or nondistinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127. The Examining Attorney has provided third party uses of a pouch which are dramatically different from the applied-for mark. They do not identify in the least the same famous and iconic Kisses® shape with the plume design. The Examiner cannot dissect the applied-for mark and ignore the individually distinctive elements combining to form the mark. It is also unsupported for the Examining Attorney to assert that the iconic design is a mere refinement of existing candy packaging without any support whatsoever. While the Examining Attorney's evidence may support a non-distinctive pouch base which the Applicant has addressed with the amended drawing submitted with this Response, those third party uses do not show any such uses of the famous Kisses® conical shape and with the plume strategically placed and flowing from the top portion. As a composite mark, then, this design is inherently distinctive, and, in the alternative, is registrable under Section 2(f) of the Act based on long use, prior-owned registrations and evidence submitted separately.

The well-known Hershey's conical shape with plume design has been in use since 1907. Again, the mark is inherently distinctive consistent with the Trademark Trial and Appeal's very pertinent recent and precedential decision in *In re Procter & Gamble Co.*, \_USPQ2d\_ (Serial Nos. 77685045 and 77685052) (T.T.A.B. Nov. 16, 2012). While the Applicant believes that its

mark is inherently distinctive, Applicant has provided unrebuttable evidence demonstrating a *prima facie* case of acquired distinctiveness.

### Section 2(f) Claim

The Applicant claims distinctiveness under Section 2(f) based on long use of this well-known design in interstate commerce as a result of substantially exclusive and continuous use by Applicant in interstate commerce for over 105 years and based on evidence submitted separately which clearly shows the distinctive nature of the mark on multiple items such as candy, clothing, jewelry, tins, cups and mugs, kitchenware and many other items. (See attached evidence of uses on many products.) The Section 2(f) claim is also based on ownership of numerous registrations for the same mark. Cumulatively, all this evidence goes way beyond the required evidence and more than satisfies the burden typically required of Applicants.

### Discussion

While Applicant believes the composite mark is inherently distinctive, for the purpose of securing registration on the Principal Register, however, Applicant offers this claim of acquired distinctiveness as to the composite mark under Trademark Act § 2(f), 15 U.S.C. § 1052(f). As the Examining Attorney knows so well, it is not necessary that the Applicant conclusively establish distinctiveness; evidence which in the opinion of the Examining Attorney establishes a *prima facie* case of acquired distinctiveness is sufficient. *See, eg, In re Packaging Specialists, Inc.*, 221 USPQ 917 (TTAB 1984); *In re Riviana Foods Inc.*, 160 USPQ 757 (TTAB 1969). The clear facts and evidence discussed herein clearly establish such a *prima facie* case.

As the record shows, the Applicant has used the conical shape in relation to candy for well over 105 years and during this period the mark has become so well-known and associated with the Applicant as a very valuable brand and source identifier. The courts and the USPTO recognize that long use of the mark is a relevant consideration in determining whether a mark, or a portion of a mark, has acquired distinctiveness. *See In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986) [§2(f) claim of acquired distinctiveness of SPRAYZON for "cleaning preparations and degreasers for industrial and institutional use" found persuasive where applicant had submitted supporting evidence and attesting to over eighteen years of substantially exclusive and continuous use].

Besides this long and successful use, it is undisputed that this iconic shape has been and continues to be used on many products. The attached evidence shows the uses of this iconic mark on many items, including but not limited to candy, clothing, jewelry, beverage ware, purses, household items and many others. Such advertisements and sales offerings prominently featuring the iconic design configuration are acceptable evidence of secondary meaning. *See, e.g., Black & Decker*, 81 USPQ at 1844; *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1213 (M.D. Fla. 1995); *Gen. Foods Corp. v. MGD Partners*, 224 USPQ 479 (TTAB 1984) (finding that applicant has demonstrated secondary meaning based on various facts including large volume of sales activity). There can be no doubt that an appropriate *prima facie* showing of secondary meaning for the design mark has been shown.

Wikipedia describes Kisses® and the Kisses® conical shape as “Hershey's Kisses is a brand of chocolate manufactured by The Hershey Company. The bite-sized pieces of chocolate have a distinctive shape, commonly described as flat-bottomed teardrops. Hershey's Kisses® chocolates are wrapped in squares of lightweight aluminum foil with a narrow strip of paper protruding from the top.”

The Examiner.com, in an article dated March 1, 2010, by Terri Marshall writes:

Who doesn't love kisses? Those delicious, sweet, melt in your mouth bites of milk chocolate brought to us by Hershey's for the last 103 years are hard to beat! This iconic American candy is recognized for its conical shape, foil wrapper and paper plume which has remained unchanged since it was first produced in 1907.

As the Board discussed in the recent packaging decision in *In re Procter & Gamble Co.*, in determining whether product packaging is inherently distinctive, it analyzed the test in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977), a case cited by the Examining Attorney, yet not followed. According to the test in *Seabrook Foods*, the three relevant factors to consider in packaging trade dress cases are: (1) whether the packaging is a common basic shape or design; (2) whether it is unique or unusual in the particular field; and (3) whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods. The Board found that retail customers of different products are “predisposed” to regard product packaging and containers as source identifiers for a particular product. The Board also noted that the record in *Procter & Gamble* supported the proposition that bottle designs function as source identifiers in the retail market for mouthwash products. Just as the Board found in *Procter & Gamble* that the mouthwash bottle contour and cap were inherently distinctive, so, too is the iconic Kisses® conical shape with plume design for candy under *Seabrook*. Professor McCarthy has stated that “[i]n reality, all three [*Seabrook Foods*] questions are merely different ways to ask whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicia of origin – a trademark.” 1 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Section 8.02 (4<sup>th</sup> ed. 2010). The focus of the inquiry is whether the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers; if so, it is inherently distinctive. *See, e.g., Tone Bros. Inc. v. Sysco Corp.*, 28 F.3d 1192, 31 USPQ2d 1321, 1331 (Fed. Cir. 1994), *citing Paddington Corp. v. Attiki Imps. & Distribs., Inc.*, 996 F.2d 577, 27 USPQ2d 1189, 1192-93 (2d Cir. 1993).

The applied-for mark is (1) not a common shape; (2) unusual for candy packaging in comparison to the other designs offered by the Examining Attorney in the record because it presents the famous conical figure already registered and protected by the Applicant and with a distinctive plume shape in the upper portion; and (3) not a mere refinement of or variation on existing candy packaging.

### Existing U.S. Registrations for Same Conical Shape

Hershey also owns a number of existing U.S. trademark registrations for the iconic Kisses® conical design. Hershey owns the following pertinent registrations supporting a claim of acquired distinctiveness:

U.S. Reg. Nos. 1584608, 3818357, 2815737, 3414496, 3851648, 3851358, 3818370, 3818371, 3724862, 3569982, 3530940, 4027938, 4121092, 4121095, 4161311, 1888004, 1889409, 1885635 and 2843129.

This evidence cannot be disregarded. The Applicant is not now seeking to register a common shape or design, but, rather, one in existence for over 105 years and which has been registered in many instances by the Office. A prior registration can be probative, however, even when it is not the same as or the legal equivalent of the applied-for mark. Thus, in a case with facts similar to this appeal, the Board held that a prior registration for a mark consisting of a design plus a word mark was probative of the secondary meaning of an applied-for mark. *In re Haggard Co.*, 217 USPQ 81, 1982 WL 51971 (TTAB 1982). Similarly, in *In re Thomas Nelson, Inc.*, 97 USPQ2d 1712 (TTAB 2011), the Board reversed where the Examining Attorney had disregarded pre-existing registrations for different but related marks, holding that the earlier registrations were probative and supported a claim of acquired distinctiveness.

### Attempts To Trade On the Famous Hershey Iconic Kisses® Conical Shape

The Applicant seeks to register the instant mark in order to protect its distinctive mark and goodwill. Others have attempted to trade on the famous conical mark. *In re Carl Walther GmbH*, Serial No. 77096523 (TTAB Oct. 26, 2010) ("The fact that the PPK handgun design is sought after and licensed to a maker of replica products has been recognized as one type of evidence that helps establish that a configuration or trade dress mark has become distinctive.") A Law360 article dated May 21, 2010, reported that "The Hershey Co. has filed an infringement suit accusing chocolate mold maker Life of the Party Inc. of selling products that allow buyers to create confections similar to Hershey's Kisses® brand candies and using the chocolate giant's trademarks to advertise the casts.... The plaintiff owns "famous" Kisses- and Hugs-brand trademarks, as well as several marks for the distinctive conical shape of the chocolate candies, which have achieved "universal fame and monumental sales" around the world, the complaint states." The evidence of plagiarism and copying to show distinctiveness of a design was further supported in the recent *In re Procter & Gamble* decision by the Board.

### Summary

The unique conical and plume design is not common for candy products under the *Seabrook Foods* factors. Indeed, it is just the opposite: the record overwhelmingly indicates that this overall packaging design has received widespread notoriety and fame and through the years has attained iconic status. When one compares this design with all the other alternatives available in the field of candy products, the applied-for design is so unique in this field. The applied-for design mark is an uncommon design, is unique and unusual in the field of candy, and

is not a mere refinement of existing designs. Accordingly, Applicant respectfully submits that this application is now in condition for Publication. Favorable action is therefore requested.

Dated: June 21, 2013

Respectfully submitted,

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