

ESTTA Tracking number: **ESTTA92877**

Filing date: **08/02/2006**

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

Proceeding	78411727
Applicant	Hallmark Rehabilitation GP, LLC
Applied for Mark	HALLMARK REHABILITATION
Correspondence Address	David A. Plumley Christie, Parker & Hale, LLP P.O. Box 7068 Pasadena, CA 91109-7068 UNITED STATES pto@cph.com
Submission	Appeal Brief
Attachments	Appeal.Brief.pdf (19 pages)(581035 bytes)
Filer's Name	David A. Plumley
Filer's e-mail	pto@cph.com
Signature	/David A. Plumley/
Date	08/02/2006

SERVICE MARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark : HALLMARK REHABILITATION and design
Serial No. : 78/411,727
Filed : April 30, 2004
Applicant : Hallmark Rehabilitation GP, LLC

Law Office : 117
Examiner : Ann Sappenfield
Docket No. : 52529/S688

**SUBMISSION OF APPEAL BRIEF
TO THE TRADEMARK TRIAL AND APPEAL BOARD**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Post Office Box 7068
Pasadena, CA 91109-7068
August 2, 2006

Commissioner:

Following is Applicant's appeal brief in the above-identified matter.

I. TABLE OF AUTHORITIES

1. *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308; 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999)
2. *American Steel Foundries v. Robertson*, 269 U.S. 372 (1926)
3. *Basic Vegetable Products Inc. v. General Foods Corp.*, 165 U.S.P.Q. 781 (T.T.A.B. 1970)
4. *In re Coors Brewing Company*, 343 F.3d 1340; 68 U.S.P.Q.2d 1059 (Fed. Cir. 2003)
5. *National Motor Bearing Co. v. James-Pond-Clark*, 266 F.2d 799; 121 U.S.P.Q. 515, 517 (C.C.P.A. 1959)
6. *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 U.S.P.Q. 295 (C.C.P.A. 1958)

II. INTRODUCTION AND PROCEDURAL BACKGROUND

In the final Office action dated January 5, 2005, the Examining Attorney maintained refusal of the present application on three grounds: (1) for clarification of the recitation of services; (2) for an alleged failure to include a signed declaration; and (3) under Section 2(d) based on a likelihood of confusion with a prior registration. In an amendment and request for reconsideration filed on March 13, 2006, Applicant responded to all three issues. Applicant then filed a Notice of Appeal on April 3, 2006, and the appeal was suspended pending the outcome of Applicant's request for reconsideration. In response to the amendment and request for reconsideration, an Office action issued on June 27, 2006 in which the examining attorney accepted the amendment, but refused the request for reconsideration on the Section 2(d) issue. The appeal was then removed from suspension on July 18, 2006, giving Applicant until September 16, 2006 to file its Appeal Brief. Consequently, this Appeal Brief is timely.

III. ISSUE ON APPEAL

The Examining Attorney alleges that Applicant's HALLMARK REHABILITATION is likely to be confused with the mark HALLMARK HEALTH, found in U.S. Registration No. 2,377,953. Applicant disagrees and requests that the Trademark Trial and Appeal Board reverse the examining attorney's refusal of registration.

IV. ARGUMENT

A. The Term "Hallmark" is a Suggestive and Weak Element, Weighing Against a Finding of Likelihood of Confusion

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The term "hallmark" is defined as "[a] mark indicating quality or excellence." *The American Heritage® Dictionary of the English Language, Fourth Edition*. See Exhibit A.¹ It is therefore a suggestive and somewhat laudatory term because it "attribute[s] quality or excellence to goods or services." *Trademark Manual of Examining Procedure* § 1209.03(k). "Highly suggestive, laudatory, and descriptive designations, however, because of their obvious meaning or suggestion and possible frequent employment in a particular trade as part of trade designations, have been considered to fall within the category of "weak" marks, and the scope of protection afforded these marks has been limited to the substantially identical designation and/or to the subsequent use thereof on substantially similar goods." *Basic Vegetable Products Inc. v. General Foods Corp.*, 165 U.S.P.Q. 781, 784 (T.T.A.B. 1970). "Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case." *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958).

Because "hallmark" is a laudatory term, and the term "health" is a descriptive term, the entire trademark HALLMARK HEALTH should be considered a "weak" mark, and therefore, should be entitled to a limited scope of protection. Furthermore, because Applicant's mark HALLMARK REHABILITATION is not "substantially identical" to the registered mark, the differences are such that consumers will easily distinguish it from the cited mark, relying on

¹ While all of the evidence submitted on Appeal was previously presented to the examining attorney during examination, for the convenience of the Board, Applicant is submitting an entirely new set of exhibits with this Appeal Brief. The new exhibits have been reproduced with higher clarity than the exhibits previously submitted, and while the printouts of certain web pages were printed more recently than the exhibits previously submitted, the exhibits contain essentially the same information such that no new evidence is being presented on Appeal.

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those differences rather than any similarities. *See, Basic Vegetable Products*, 165 U.S.P.Q. at 784. Therefore, confusion between Applicant's mark and the cited mark is unlikely, and Applicant requests reconsideration of refusal to register the proposed mark.

B. The Services Offered Under the Marks, Though Related, are Sufficiently Different to Weigh Against a Finding of Likelihood of Confusion

The goods and services being offered under the marks at issue, though admittedly being somewhat related to registrant's, are nonetheless distinguishable. Applicant's mark is used in conjunction with nursing homes, while the mark HALLMARK HEALTH is used in conjunction with an integrated health care delivery system. As such, the services offered under the marks differ. As likelihood of confusion is a function of relatedness of services, the differing services offered under the marks further decreases the likelihood of confusion between the marks. *See American Steel Foundries v. Robertson*, 269 U.S. 372, 382 (1926) ("The fact, for example, that the articles upon which the mark is used are not of the same description as those put out by the corporation, is entitled to weight, since the probability of such confusion and injury in that situation obviously is more remote than where the articles are of like kind.") For this additional reason, Applicant further requests reconsideration of refusal to register the proposed mark.

C. The Term "Hallmark" is so Commonly Used as to Preclude Any One Person from Having Exclusive Rights, Weighing Against a Likelihood of Confusion

The term "hallmark" is commonly used both in general as well as in the field of medicine and health services. According to the Federal Circuit, where there is evidence of third party use of marks similar to the registered and proposed marks, either wholly or in part, it tends to show a weakness in the mark that is relevant to the likelihood of confusion analysis. *In re Coors*

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Brewing Company, 343 F.3d 1340, 1345; 68 U.S.P.Q.2d 1059 (Fed. Cir. 2003). Furthermore, evidence of present third party usage "indicates a conditioning of the public mind to the common feature, thereby decreasing any likelihood of confusion." *Nat'l Motor Bearing Co. v. James-Pond-Clark*, 266 F.2d 799, 802-803; 121 U.S.P.Q. 515, 517 (C.C.P.A. 1959).

As one example of the evidence showing the weakness of the term "hallmark" when used with healthcare services, Applicant refers to an internet site listing Medicare Certified Nursing Homes that is available at the www.MemberoftheFamily.net website. See Exhibit B. That website lists the following service providers associated with nursing homes:

Name of Nursing Home	Location
HALLMARK CARE CENTER	MOUNT VERNON IA
HALLMARK CARE CENTER	SIOUX CITY IA
HALLMARK HEALTHCARE CENTER	SUMMERVILLE SC
HALLMARK HOUSE NURSING CENTER	PEKIN IL
HALLMARK MANOR	FEDERAL WAY WA
HALLMARK NURSING CENTER	DENVER CO

This website is a national registry of nursing homes, and serves as a resource for people wishing to learn about complaints filed or violations found against particular nursing homes. It is Applicant's understanding that the site is updated on a yearly basis based on publicly available state and federal information. As shown by this website, a number of different nursing homes are operating throughout the country using the term "hallmark" as a portion of their names. Because the term is commonly used, no single owner is entitled to broad and exclusive use, and conversely, Applicant should not be prevented from registering its own distinguishable combination including such a commonly used word.

As further evidence, Applicant conducted a Medicare provider search on a website operated by National Heritage Insurance Company ("NHIC"). NHIC is the contracted Registry

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Carrier responsible for assigning Unique Physician Identification Numbers ("UPIN") to Medicare providers. The UPIN Registry is available at <http://www.upinregistry.com>. The site is updated daily from data supplied by the Medicare carriers. A "Medicare Group" nationwide search was performed using the key word "hallmark," and the results are attached as Exhibit C. This search revealed seventeen providers operating under names that include "hallmark." Of the results, while a number appear to be owned by the registrant of the mark HALLMARK HEALTH trademark, many of the providers appear to be unrelated to registrant. This is still further evidence of the suggestive nature of the term "hallmark" when used in connection with healthcare services.

As still other examples of the common use of the term "hallmark" with health services, further internet searches were conducted. Attached as Exhibit D is a printout of the website for Hallmark HealthCare Center, a nursing home located in Summerville, South Carolina. Furthermore, a search of the "A-to-Z hospital index" available at the U.S. News & World Report website (www.usnews.com) revealed a listing for Hallmark Youthcare in Richmond, Virginia which offers psychiatric services. See Exhibit E. Clearly, the evidence is overwhelming that the term "hallmark" is a commonly used and suggestive term in the field of healthcare as it is used by a number of geographically diverse healthcare providers in connection with the services provided.

The extensive third party usage of "hallmark" makes likelihood of confusion significantly less likely to occur between the marks. According to the Federal Circuit, the common usage of a highly suggestive term in a mark weighs "strongly" against a finding of likelihood of confusion

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between two marks containing the descriptive term. *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1330; 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

V. CONCLUSION

In view of the overwhelming evidence which conclusively establishes that "hallmark" is a weak and somewhat laudatory term that is commonly used in connection with healthcare services, Applicant submits that the examining attorney's refusal of the subject mark should be reversed.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By /DAP/
David A. Plumley
626/795-9900

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EXHIBIT A

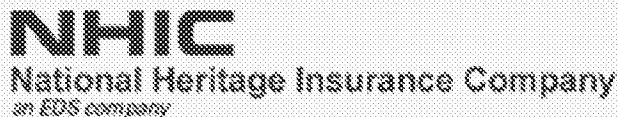
EXHIBIT B

MemberoftheFamily.net

List of Medicare Certified Nursing Homes Beginning With "H"

H & J VONDERLIETH LVG CTR, THE MOUNT PULASKI IL
H C WATKINS MEMORIAL HOSP SNF QUITMAN MS
H R H TRANSITIONAL CARE UNIT MEADOWBROOK PA
HA LE ALOHA CONVALESCENT HOSPITAL CERES CA
HABANA HEALTH CARE CENTER TAMPA FL
HABERSHAM HOME DEMOPEST GA
HACIENDA CARE CENTER LIVERMORE CA
HACIENDA NURSING FACILITY PHOENIX AZ
HACIENDA REHABILITATION & HEA HANFORD CA
HACIENDA REHABILITATION AND CA SIERRA VISTA AZ
HADLEY MEMORIAL HOSPITAL SNU WASHINGTON DC
HAINES CITY HEALTH CARE HAINES CITY FL
HALCYON HOUSE WASHINGTON IA
HALE ANUENUE RESTORATIVE CARE HILO HI
HALE COUNTY NURSING CENTER HALE CENTER TX
HALE HO'OLA HAMAKUA HONOKAA HI
HALE KUPUNA HERITAGE HOME LAWAI HI
HALE MAKUA WAILUKU HI
HALE MAKUA SNF/NF KAHULUI HI
HALE MALAMALAMA HONOLULU HI
HALE NANI REHAB & NURSING CNTR HONOLULU HI
HALE OLA KINO HONOLULU HI
HALES CORNERS CARE CENTER HALES CORNERS WI
HALES REST HOME SPANISH FOPK UT
HALEYVILLE HEALTH CARE CENTER HALEYVILLE AL
HALIFAX REGIONAL HOSPITAL SNF SOUTH BOSTON VA
HALIFAX CONVALESCENT CTR DAYTONA BEACH FL
HALLANDALE REHABILITATION CTR HALLANDALE FL
HALLETTSVILLE REHAB & NUR CTN HALLETTSVILLE TX
HALLMARK CARE CENTER MOUNT VERNON IA
HALLMARK CARE CENTER SIOUX CITY IA
HALLMARK CARE CENTER INC PORTSMOUTH OH
HALLMARK HEALTHCAPE CENTER SUMMERVILLE SC
HALLMARK HOUSE NURSING CENTER PEKIN IL
HALLMARK MANOR FEDERAL WAY WA
HALLMARK N CENTRE CARTHAGE CARTHAGE NY
HALLMARK N CENTRE GRANVILLE GRANVILLE NY
HALLMARK N CENTRE MINOA MINOA NY
HALLMARK N CENTRE ROTTERDAM SCHENECTADY NY
HALLMARK N CENTRE SCHENECTADY SCHENECTADY NY
HALLMARK N CENTRE TROY TROY NY
HALLMARK NURS AND REHAB CENTER NEW BEDFORD MA
HALLMARK NURSING CENTER DENVER CO
HALLMARK NURSING CENTER NEW PALTZ NY
HALLMARK NURSING CENTER GLENS FALLS NY
HALLWORTH HOUSE PROVIDENCE RI
HALSTAD LUTHERAN MEMORIAL HOME HALSTAD MN
HALSTEAD HEALTH AND REHAB CTR HALSTEAD KS
HALSTED TERRACE NURSING CTR CHICAGO IL
HAMDEN HEALTH CARE CENTER HAMDEN CT
HAMILTON ARMS CENTER LANCASTER PA
HAMILTON CENTER BALTIMORE MD
HAMILTON COMMUNITIES, INC NEW CARLISLE IN
HAMILTON CONTINUING CARE TRENTON NJ
HAMILTON COUNTY HOSPITAL LTCU SYRACUSE KS
HAMILTON HEALTHCARE CENTER HAMILTON TX
HAMILTON HOUSE NURSING CENTER COLUMBUS GA
HAMILTON MANOR AURORA NE
HAMILTON MANOR NURSING HOME ROCHESTER NY
HAMILTON MEM NURSING CTR MCLEANSBOPO IL
HAMILTON MEMORIAL HOME TWO RIVERS WI

EXHIBIT C



The UPIN Registry

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Medicare Group Results

The Medicare Groups matching your search criteria are displayed. Fifty records will be displayed per page, use the previous and next page links at the top and bottom of the page to navigate through the list.

⊙ REPEAT MEDICARE GROUP SEARCH

SEARCH CRITERIA USED

NAME	hallmark
CITY	All Cities
STATE	All States
ZIP CODE	All Zip Codes
CREDENTIALS	All Credentials
SPECIALTY	All Specialties

GROUP SEARCH RESULTS

CLICK ON THE ADDRESS TO SEE MORE DETAILS
RECORDS 1 TO 17 OF 17 MATCHING RECORDS

LOC	GROUP NAME	CRED	PAR	ADDRESS	CITY
0001	HALLMARK CHIROPRACTIC	GRP	YES	633 ROANOKE AVE.	RIVERHEAD
0001	HALLMARK FAMILY PHYSIC	GRP	YES	1766 CONNELLY SPRINGS RD.	LENOIR
0001	HALLMARK HEALTH SERVIC	IDF	YES	3 WOODLAND ROAD	STONEHAM
0001	HALLMARK HEALTH SERVIC	GRP	YES	12823 KINGSTON PK.	KNOXVILLE
0001	HALLMARK HEALTH SYSTEM	GRP	YES	170 GOVERNORS AVENUE.	MEDFORD
0002	HALLMARK HEALTH SYSTEM	GRP	YES	170 GOVERNORS AVENUE.	MEDFORD
0003	HALLMARK HEALTH SYSTEM	GRP	YES	585 LEBANON STREET.	MELROSE

http://www.upinregistry.com/group_results.asp?GrpName=hallmark&GrpCity=&GrpState=ALL&GrpZip=&GrpCreds=ALL

0005	HALLMARK HEALTH SYSTEM	GRP	YES	<u>170 GOVERNORS AVENUE</u>	MEDFORD
0008	HALLMARK HEALTH SYSTEM	GRP	YES	<u>100 HOSP RD</u>	MALDEN
0001	HALLMARK HOMECARE LLC	LAB	NO	<u>12915 JONES MALTSBERGER R</u>	SAN ANTONIO
0001	HALLMARK IMAGING ASSOC	GRP	YES	<u>585 LEBANON STREET</u>	MELROSE
0001	HALLMARK MEDICAL GROUP	GRP	YES	<u>300 STONECREST BLVD #250</u>	SMYRNA
0001	HALLMARK MRI LLC	IDF	YES	<u>4130 NORTH HALLMARK PARKW</u>	SAN BERNARDINO
0010	HALLMARK NURSING CENTE	GRP	YES	<u>217 EAST AVE</u>	MINOA
0001	HALLMARK PATHOLOGY PC	GRP	YES	<u>170 GOVERNORS AVENUE</u>	MEDFORD
0001	HALLMARK SURGICAL CENT	ASC	NO	<u>4130 N HALLMARK PARKWAY</u>	SN BERNRDNO
0001	HALLMARK SURGICAL CENT	ASC	YES	<u>8327 RESEDA BLVD</u>	NORTHRIDGE

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EXHIBIT D

Hallmark HealthCare Center - Summerville Nursing Home

Proudly serving the Charleston SC Area

Whether you or a loved one is recovering from surgery,
a serious illness or making decisions regarding long term care,

Hallmark HealthCare Center understands how complex choosing the very best care can be.

Acute
Rehabilitation

Long Term Care

Map & Directions

Medicaid

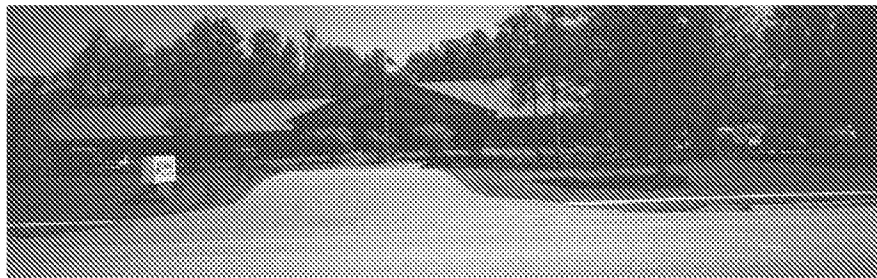
Medicare

Nursing Center

Services

Short Term
Holiday Care

Webmaster



The Hallmark HealthCare Center, licensed for 88 beds, provides a complete skilled nursing center.

The purpose of Hallmark HealthCare Center is to promote and advance the well-being of our community family by providing quality healthcare and health related services, competitively priced, in an environment where our values inspire confidence and our professionals give comfort and encouragement.

Exceptional care is the standard by which we measure and are measured.

Personal, compassionate care showing concern and respect for the dignity of each individual is our hallmark of distinction.

Teamwork professionally and considerately executed is our advantage.

Commitment to our tradition of service is our investment in the future of this community.

We want to hear from you!
Tell us how we can serve you better OR if you have any *comments, questions, complaints, or compliments*, click [HERE](#) to E-mail us.

Programs

HealthCare Center has made an effort to provide the best care at affordable rates. As an independent nursing home, our owners and staff work together to improve the efficiency and reduce the costs to you.

Rates include: room, board, housekeeping and nursing care.

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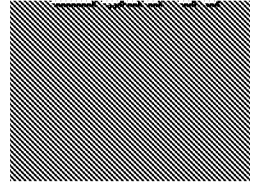


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Hallmark Youthcare - Richmond

At a glance

12800 West Creek Parkway
Richmond, VA 23238-1116
(804) 784-2200

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Hospital type: Psychiatric
Operated by: Corporation
Total beds: 84

Administrator: Ms. Wanda H Sadler, Chief Executive Officer

Parent system: No system affiliation

Key services:
Not reported

Selected accreditations/ memberships:
Not reported

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