

ESTTA Tracking number: **ESTTA475350**

Filing date: **05/30/2012**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Hearts On Fire Company LLC
Granted to Date of previous extension	05/30/2012
Address	99 Summer Street Boston, MA 02110 UNITED STATES

Attorney information	Tish L. Berard Hearts On Fire Company 99 Summer Street Boston, MA 02110 UNITED STATES tberard@heartsonfire.com
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Applicant Information

Application No	85445788	Publication date	01/31/2012
Opposition Filing Date	05/30/2012	Opposition Period Ends	05/30/2012
Applicant	JEWELX NEW YORK, LTD. 529 Fifth Avenue, 18th Floor New York, NY 10017 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. All goods and services in the class are opposed, namely: JEWELRY; JEWELRY WITH PRECIOUS STONES, NAMELY, DIAMONDS, RUBIES, EMERALDS, SAPPHIRES, AND SEMI-PRECIOUS COLORED STONES EMBEDDED THEREIN, AND PEARLS EMBEDDED THEREIN

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2726434	Application Date	04/11/2001
Registration Date	06/17/2003	Foreign Priority Date	NONE
Word Mark	DREAM		

Design Mark	DREAM		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Jewelry		

U.S. Registration No.	2891402	Application Date	10/13/2003
Registration Date	10/05/2004	Foreign Priority Date	NONE
Word Mark	DREAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Gemstones, namely, cut diamonds		

U.S. Registration No.	1732072	Application Date	02/06/1991
Registration Date	11/10/1992	Foreign Priority Date	NONE
Word Mark	DREAM CUT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1991/03/00 First Use In Commerce: 1991/03/00 jewelry; namely, diamonds		

U.S. Registration No.	3736990	Application Date	08/29/2005
Registration Date	01/12/2010	Foreign Priority Date	NONE
Word Mark	DREAMSTONE		

Design Mark	DREAMSTONE
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 2005/01/01 First Use In Commerce: 2005/06/01 Jewelry

U.S. Registration No.	3736986	Application Date	05/10/2005
Registration Date	01/12/2010	Foreign Priority Date	NONE
Word Mark	DREAM STONE		
Design Mark	DREAM STONE		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2005/01/01 First Use In Commerce: 2005/06/01 Jewelry		

Attachments	76239211#TMSN.gif (1 page)(bytes) 78702828#TMSN.jpeg (1 page)(bytes) 78626864#TMSN.jpeg (1 page)(bytes) NOPP VINTAGE DREAMS.pdf (5 pages)(233515 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Tish L. Berard/
Name	Tish L. Berard

Date	05/30/2012
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

HEARTS ON FIRE COMPANY, LLC,)	
)	
OPPOSER,)	
)	
v.)	OPPOSITION No.
)	
JEWELX NEW YORK, LTD.,)	
)	
APPLICANT.)	
)	

NOTICE OF OPPOSITION

Opposer Hearts On Fire Company, LLC (“HOF”), a Massachusetts limited liability company with a business address of 99 Summer Street, 4th Floor, Boston, Massachusetts 02110, believes that it will be damaged by registration of the mark VINTAGE DREAMS that is the subject of application Serial No. 85/445,788, filed October 12, 2011, by Jewelex New York, Ltd. (“Applicant”), and hereby opposes the same and requests that registration to Applicant be refused.

As grounds in support of its opposition, HOF asserts as follows:

OPPOSER, ITS MARKS, AND RELATED GOODWILL

1. Opposer, HOF, is a Massachusetts limited liability company located and doing business at 99 Summer Street, Boston, Massachusetts 02110.
2. Established in 1996, HOF is a recognized industry leader in the marketing and sale of branded diamonds and jewelry, including the DREAM® diamond.
3. The DREAM® diamond is the first square-shaped diamond crafted with the perfect proportions, polish and symmetry necessary to maximize its beauty. The development of the DREAM® diamond took over two years and thirty different models to perfect.

4. The creation of the DREAM® diamond has set the standard of excellence to which all square-shaped diamonds are now compared. Only a limited number of diamond cutters in the world have the skills necessary to cut DREAM® diamonds, as each DREAM® diamond takes over four times as long to cut as other square-cut diamonds.

5. HOF is headquartered in Boston, Massachusetts, USA, and is rapidly expanding internationally.

6. Today, HOF is one of the luxury industry's fastest growing companies and is recognized as the leading branded diamond company in the world.

7. HOF is and has at all times been actively engaged in the design, manufacture, development, marketing, and sale of a range of jewelry products, including, but not limited to, cut diamonds in International Class 14 (collectively, the "Products").

8. HOF has sold, promoted and marketed its Products under the federally registered U.S. trademarks for its DREAM marks (Reg. Nos. 2,726,434 and 2,891,402) in connection with jewelry and gemstones, namely cut diamonds; DREAM CUT (Reg. No. 1,732,072) in connection with jewelry, namely, diamonds; DREAMSTONE (Reg. No. 3,736,990) in connection with jewelry; and DREAM STONE (Reg. 3,736,986) in connection with jewelry (collectively, the "Trademarks"). The Trademarks are valid, existing, unrevoked and uncanceled.

9. HOF first used in commerce the mark DREAM (Reg. Nos. 2,726,434 and 2,891,402) in May 2001.

10. HOF first used in commerce (through its predecessor-in-interest) the mark DREAM CUT, Registration No. 1,732,072, in March 1991.

11. HOF first used in commerce the marks DREAMSTONE and DREAM STONE, Reg. No. 2,786,391 and 3,736,986, in June 2005.

12. HOF's Trademarks have developed an extraordinary reputation with tremendous goodwill. The Trademarks have come to be associated with luxury, prestige and quality within the jewelry industry.

13. Since long prior to October 12, 2011, the filing date of Applicant's application, HOF adopted and commenced use of the Trademarks in connection with the marketing, promoting, offering for sale and selling of the Products.

14. Since long prior to October 12, 2011, HOF has actively, continuously and consistently promoted the Products under the Trademarks on both a national and international basis.

15. As a result of the extensive use and advertising by HOF, the Trademarks have become well known and HOF has built up valuable and substantial goodwill in the Trademarks such that the Trademarks have come to identify HOF's Products and distinguish HOF's Products from the products of others.

16. The Trademarks are closely and uniquely associated with HOF and the Products.

APPLICANT'S CONFUSINGLY SIMILAR MARK

17. HOF repeats and realleges the allegations contained in Paragraphs 1-16 of this Notice of Opposition as though fully alleged herein.

18. Upon information and belief, Applicant is a New York corporation located at 529 Fifth Avenue, 18th Floor, New York, NY 10017.

19. On October 12, 2011, Applicant filed an application for Applicant's mark VINTAGE DREAMS. The application covers the following goods in International Class 14: JEWELRY; JEWELRY WITH PRECIOUS STONES, NAMELY, DIAMONDS, RUBIES, EMERALDS, SAPPHIRES, AND SEMI-PRECIOUS COLORED STONES EMBEDDED THEREIN, AND PEARLS EMBEDDED THEREIN (hereinafter "Applicant's Goods"). Upon information and belief, Applicant's Goods are similar to the Products offered by HOF.

20. Upon information and belief, the relevant public would consider HOF's Trademarks and Applicant's Mark to be either highly similar or identical.

APPLICANT'S INFRINGEMENT OF OPPOSER'S MARKS

21. HOF repeats and realleges the allegations contained in Paragraphs 1 through 20 of this Notice of Opposition as though fully alleged herein.

22. Applicant's Mark is confusingly and deceptively similar to the Trademarks such that the use and registration of VINTAGE DREAMS by Applicant is likely to create confusion, mistake and deception of the trade and purchasing public.

23. In view of the significant goodwill, distinctiveness, reputation, fame and secondary meaning of the Trademarks of HOF, the use and registration of Applicant's Mark is likely to create confusion, mistake and deception among consumers and will cause or tend to cause consumers to believe that Applicant's Goods originate with or are otherwise licensed, sponsored, or authorized by HOF.

24. By reason of the foregoing, HOF will be gravely damaged by the registration of Applicant's Mark.

25. The grant of registration to Applicant should be denied based on the grounds of trademark infringement pursuant to 15 U.S.C. Sections 1063(a) and 1114.

APPLICANT'S DILUTION OF HOF'S MARKS

26. HOF repeats and realleges the allegations contained in Paragraphs 1 through 25 of this Notice of Opposition as though fully alleged herein.

27. Through the expenditure by HOF of substantial time, money and effort over the years for marketing and promotional activity in the United States and elsewhere, and as a result of the worldwide reputation of the Products emanating from HOF, HOF's Trademarks are "famous" marks within the meaning of 15 U.S.C. Section 1125(c) and are therefore entitled to protection against dilution of their distinctive quality.

28. Upon information and belief, Applicant either has not begun use of its Mark, or did not begin to use Applicant's Mark in any form (including the form now sought to be registered) until long after HOF's Trademarks became famous in the United States.

29. Registration and/or commercial use of Applicant's Mark would cause dilution of the distinctive qualities of HOF's Trademarks by significantly lessening the capacity of HOF's Trademarks to identify and distinguish HOF's Products.

30. Registration and/or commercial use of Applicant's Mark would also cause dilution by tarnishing the high quality and prestige by which HOF's Products have come to be known.

31. The grant of a registration to Applicant for Applicant's Mark as sought in this application (Serial No. 85/445,788) should be denied based on the grounds of dilution of HOF's Trademarks pursuant to 15 U.S.C. Sections 1063(a) and 1125(c).

WHEREFORE, HOF respectfully requests that the Notice of Opposition be sustained and that registration of Applicant's Mark be refused.

Dated: May 30, 2012

HEARTS ON FIRE COMPANY, LLC

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