

ESTTA Tracking number: **ESTTA546616**

Filing date: **07/03/2013**

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	Hallmark Licensing, LLC
Granted to Date of previous extension	07/03/2013
Address	2440 Pershing Road MD 339 Kansas City, MO 64108 UNITED STATES

Attorney information	David N. Johnson Hallmark Cards, Incorporated 2501 McGee Trafficway MD 339 Kansas City, MO 64108 UNITED STATES sara.grabill@hallmark.com, david.johnson@hallmark.com Phone:816-274-8397
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**Applicant Information**

Application No	77457422	Publication date	03/05/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/03/2013
Applicant	HALLMARK INDUSTRIES INC. 800 31ST STREET UNION CITY, NJ 07087 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 014. First Use: 2008/04/23 First Use In Commerce: 2008/04/23 All goods and services in the class are opposed, namely: Beads for use in the manufacture of jewelry; Bracelets; Bronze jewelry; Brooches; Charms; Costume jewelry; Diamond jewelry; Gemstone jewelry; Identification bracelets; Jewelry; Jewelry and imitation jewelry; Jewelry boxes; Jewelry boxes not of metal; Jewelry boxes of metal; Jewelry boxes of precious metal; Jewelry cases; Jewelry cases not of precious metal; Jewelry cases of precious metal; Jewelry caskets; Jewelry caskets of precious metal; Jewelry chains; Jewelry findings; Jewelry for attachment to clothing; Jewelry for the head; Jewelry in the nature of armbands; Jewelry organizers; Jewelry pins for use on hats; Jewelry ring holders; Jewelry to be affixed to bikinis; Jewelry watches; Jewelry, namely, amulets; Jewelry, namely, crosses; Jewelry, namely, precious metal plated real leaves and flowers; Lapel pins; Leather jewelry and accessory boxes; Metal wire for use in the making of jewelry, namely, jewelry cable; Pet jewelry; Pins being jewelry; Plastic bracelets in the nature of jewelry; Rings; Rings being jewelry; Watches and jewelry; Watches, clocks, jewelry and imitation jewelry</p>
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Dilution	Trademark Act section 43(c)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	380596	Application Date	02/14/1940
Registration Date	08/27/1940	Foreign Priority Date	NONE
Word Mark	HALLMARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U038 (International Class 009, 016, 028). First use: First Use: 1925/01/25 First Use In Commerce: 1925/01/25 GREETING CARDS		

U.S. Registration No.	916900	Application Date	08/20/1969
Registration Date	07/20/1971	Foreign Priority Date	NONE
Word Mark	HALLMARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U101 (International Class 035). First use: First Use: 1935/01/01 First Use In Commerce: 1935/01/01 FURNISHING ADVERTISING MATERIAL IN THE FORM OF NEWSPAPER MATS, POSTERS, RADIO AND TELEVISION COMMERCIALS, DISPLAY PIECES AND SIGNS		

U.S. Registration No.	654790	Application Date	01/14/1957
Registration Date	11/19/1957	Foreign Priority Date	NONE
Word Mark	HALLMARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U038 (International Class 009, 016, 028). First use: First Use: 1949/02/03 First Use In Commerce: 1949/02/03 CHRISTMAS SEALS, DECORATIVE SEALS, GIFT TAGS AND ENCLOSURE CARDS, DOOR AND WINDOW DISPLAYS IN THE NATURE OF CARDBOARD SIGNS SOLD AS SUCH FOR USE ON DOORS AND IN STORE WINDOWS AND ON COUNTERS, PARTY INVITATIONS, BIRTH ANNOUNCEMENTS, [ DANCE PROGRAMS, ] CALENDARS, TALLY AND PLACE CARDS, [ SYMPATHY ACKNOWLEDGMENTS, AND MOTTOES ]		

U.S. Registration No.	657441	Application Date	01/14/1957
Registration Date	01/21/1958	Foreign Priority Date	NONE
Word Mark	HALLMARK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U037 (International Class 016, 026, 027). First use: First Use: 1949/02/03 First Use In Commerce: 1949/02/03 DECORATIVE GIFT WRAPPING PAPER, DECORATIVE NOTE PAPER, ALBUMS, [ AND DATE BOOKS ]

U.S. Registration No.	525798	Application Date	03/21/1949
Registration Date	05/30/1950	Foreign Priority Date	NONE
Word Mark	HALLMARK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U038 (International Class 009, 016, 028). First use: First Use: 1949/02/03 First Use In Commerce: 1949/02/18 GREETING CARDS		

Attachments	lms-hallmarkopp_201307031041.pdf(189565 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	/David N. Johnson/
Name	David N. Johnson
Date	07/03/2013



jewelry; Plastic bracelets in the nature of jewelry; Rings; Rings being jewelry; Watches and jewelry; Watches, clocks, jewelry and imitation jewelry,” Application Serial No. 77457422, filed by Hallmark Industries, Inc. (hereinafter called Applicant), published in the Official Gazette of March 5, 2013, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946 (15 U.S.C. § 1063).

As grounds of opposition, it is alleged that:

1. Opposer is the licensor of the mark HALLMARK to licensees which are in the business of manufacturing and selling a wide variety of goods, and rendering and selling certain services, under the mark HALLMARK and various other marks which include the name HALLMARK, including but not limited to HALLMARK KEEPSAKE, HALLMARK BUSINESS CONNECTIONS, and HALLMARK HALL OF FAME. The use of said marks by said licensees inures to the benefit of Opposer.

2. Opposer, or its predecessor in interest, adopted and used the trademark HALLMARK in said business as early as 1925 and Opposer is now using said trademark. Opposer is the owner of all right, title and interest to the trademark HALLMARK for greeting cards, Reg. No. 380596; HALLMARK for furnishing advertising material in the form of newspaper mats, posters, radio and television commercials, display pieces and signs, Reg. No. 916900; and HALLMARK & Crown Device for various goods in International Class 16, Regs. Nos. 654790, 657441 and 525798, all of said registrations and uses predating Applicant’s filing of the subject applications. Opposer owns many other registrations and applications for the mark HALLMARK and other marks which include the word HALLMARK, the filing or use of which predate Applicant’s filing of the subject applications. In addition, Opposer is the owner of marks

which consist of or include the word HALLMARK on account of the use of such marks by Opposer prior to Applicant's filing of the subject applications.

3. The mark HALLMARK which Applicant seeks to register is identical to Opposer's trademark, and the use and registration of HALLMARK by Applicant is likely to cause confusion, mistake or deception as to the source or origin of the goods which are covered by the subject applications, and therefore the granting of the registration would injure Opposer's goodwill in its trademark.

4. Applicant's use and registration of HALLMARK is likely to cause the public to assume erroneously that Applicant's goods are sponsored by Opposer or that they are in some way connected with Opposer, all to Opposer's irreparable damage.

5. Opposer's HALLMARK mark is a "famous mark" under 15 U.S.C. § 1125(c), and registration of the marks HALLMARK would dilute the distinctive quality of Opposer's mark and would, by virtue of 15 U.S.C. § 1125(c)(6), impede Opposer's ability to prevent such dilution from occurring.

6. For the reasons set forth in the foregoing paragraphs 1-5, Opposer believes, and believing, asserts that the goodwill of its trademark HALLMARK will be damaged and that Applicant should be denied registration of the marks which it seeks to register.

WHEREFORE, Opposer prays that this Opposition be sustained and that Application Serial No. 77457422 be refused registration.

The filing fee of Three Hundred Dollars (\$300.00) may be deducted from our Deposit Account, the details of which are included in the electronic Notice of Opposition filed concurrently herewith.

Please recognize David N. Johnson, Legal Department, Hallmark Cards, Incorporated, 2501 McGee Trafficway, P.O. Box 419126, Kansas City, Missouri 64141-6126, member of the bar of the state of Missouri, as the attorney for the Opposer in the above-entitled proceeding.

All communications are to be directed to David N. Johnson at his address identified above.

Hallmark Licensing, LLC

By /s/  
David N. Johnson  
Attorney for Opposer  
P.O. Box 419126  
Kansas City, MO 64141-6126  
Ph: (816) 274-8397  
E-mail: [david.johnson@hallmark.com](mailto:david.johnson@hallmark.com)

CERTIFICATE OF SERVICE

I hereby certify that on this 3<sup>rd</sup> day of July, 2013, the foregoing Notice of Opposition is being served on Applicant by causing a copy to be mailed via first class mail, postage prepaid to :

P.K. JAIN  
PRESIDENT  
HALLMARK INDUSTRIES INC.  
800 31ST ST  
UNION CITY, NJ 07087-2428

By /s/ \_\_\_\_\_  
David N. Johnson