

ESTTA Tracking number: **ESTTA610559**

Filing date: **06/18/2014**

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	Hallite Seals International Limited
Granted to Date of previous extension	06/18/2014
Address	130 Oldfield Road Hampton, Middlesex, TW12 2HT UNITED KINGDOM
Attorney information	Jonathan M. Gelchinsky Pierce Atwood LLP Merrill's Wharf 254 Commercial Street Portland, ME 04101 UNITED STATES trademark@pierceatwood.com Phone:207-791-1100

Applicant Information

Application No	79129925	Publication date	02/18/2014
Opposition Filing Date	06/18/2014	Opposition Period Ends	06/18/2014
International Registration No.	1159660	International Registration Date	02/26/2013
Applicant	Carl Freudenberg KG HÄßlerweg 2-4 GERMANY		

Goods/Services Affected by Opposition

Class 006. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Rails of metal
Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Engine and machine part bearings, in particular hydraulic bearings, spherical bearings, conical bearings, machine bearings, flat bearings, wedge-shaped bearings, round bearings, buffers being parts of machines, instrument bearings, support bearings, spherical roller bearings, framework support bearings, axle guide bearings, hydraulic axle guide bearings, double U-shaped bearings, V-shaped bearings, motor bearings, M-shaped bearings, O-shaped bearings; machine part bushings, in particular hydraulic bushings; machine part springs, in particular multilayered springs, conical springs, chevron springs, roller springs, auxiliary springs; parts of machines, namely, spring inserts; parts of machines, namely, spring bases; rolling support systems being parts of machines; power operated tools, namely, transverse and longitudinal buffers; wedge bundles being parts of machines
Class 012. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Handle bars, in particular wheel-set guides

and longitudinal swinging arms for use with motorcycles and bicycles; air springs being vehicle suspension components for cushioning driver's seats and cabs; pneumatic spring systems being suspension springs for motor vehicles

Class 017. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Industrial rubber components, namely, molded rubber parts for oscillation and vibration isolating and damping; insulating and sealing materials having rubber-metal compounds; articles of rubber for vibration isolation, namely, shock absorbing rubber buffers, vibration isolation mounts, vibration isolation dampers, and vibration isolation bearings and bushes; vibration control components of rubber, namely, shock absorbing rubber buffers, vibration isolation mounts, vibration isolation dampers, and vibration isolation bearings and bushes

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	913472	Application Date	12/24/1969
Registration Date	06/08/1971	Foreign Priority Date	NONE
Word Mark	HALLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 017. First use: First Use: 1917/00/00 First Use In Commerce: 1917/00/00 HYDRAULIC AND PNEUMATIC SEALS OF SYNTHETIC RUBBER OR PLASTIC		

Attachments	Notice of Opposition - HALL Mark 6-18-2014 (W4314783x7AC2E).pdf(44211 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	/Jonathan Gelchinsky/
Name	Jonathan M. Gelchinsky
Date	06/18/2014

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

<p>HALLITE SEALS INTERNATIONAL LIMITED,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>CARL FREUDENBERG KG,</p> <p style="text-align:center">Applicant.</p>	<p>Application No.: 79/129,925 Mark: HALL Filing Date: February 26, 2013</p>
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NOTICE OF OPPOSITION

Hallite Seals International Limited (“Opposer”), a U.K. limited liability company having its principal place of business at 130 Oldfield Road, Hampton, Middlesex TW12 2HT, England, believes that it is being and will be damaged by the registration of the mark HALL by Carl Freudenberg KG (“Applicant”), as shown in U.S. Trademark Application No. 79/129,925, and hereby opposes the same.

As grounds for opposition, Opposer alleges that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to Applicant and Applicant’s mark:

Opposer’s HALLITE Mark

1. For nearly a century, Opposer and its predecessors in interest have used the mark and name HALLITE in commerce for a variety of hydraulic and pneumatic seals and related products. Opposer’s products are used in a wide range of industries, including mining, off-highway, construction, agriculture, mechanical handling, aerospace, and automation. Opposer’s HALLITE seals are especially suited to hydraulic and pneumatic applications and are water-resistant, low-friction, and long-

lasting, with wide temperature capability. Opposer also provides a range of services involving the design, development, and manufacturing for others of seals for OEM and other applications.

2. Opposer's HALLITE products have received and continue to receive numerous industry awards and accolades, and have been the subject of unsolicited media attention. For example, Opposer's HALLITE products were recently featured in the November 2013 issue of *Rubber & Plastics News*, a publication with thousands of subscribers that provides rubber industry news to executives, managers, engineers, chemists, suppliers, consultants, laboratories and manufacturers.

3. Opposer owns U.S. Registration No. 913,472 for the mark HALLITE covering "hydraulic and pneumatic seals of synthetic rubber or plastic" in International Class 17, issued on June 8, 1971. A printout of this registration from the PTO's TSDR database is attached as Exhibit A.

4. The foregoing registration is valid and subsisting, and is incontestable. It constitutes conclusive evidence of Opposer's exclusive right to use the HALLITE trademark in connection with the goods recited in the registration.

5. Opposer's predecessor in interest was known for many years as Hall & Hall Limited, and was founded by two individuals with the last name Hall.

6. Opposer has continuously and extensively used the HALLITE mark and name in commerce in connection with the sale and advertising of its goods and services for nearly a century prior to Applicant's filing date, foreign priority date, and any date of first use that may be alleged by Applicant.

7. Opposer has enjoyed substantial sales and has invested considerable money in advertising and promoting its HALLITE products throughout the United States over the nearly 100 years that its mark has been used. Opposer currently sells approximately \$20 million worth of its HALLITE seals in the U.S. annually.

8. By virtue of Opposer's extensive use and promotion of the HALLITE mark and name, the mark and the goods and services it identifies have enjoyed substantial commercial success, and consumers have come to recognize Opposer exclusively as the source of those goods and services.

Applicant and Its Mark

9. Applicant Carl Freudenberg KG is a German entity with an address at Höhnerweg 2-4, 69469 Weinheim, Germany.

10. On February 26, 2013, Applicant filed U.S. Trademark Application No. 79/129,925 to register the mark HALL for the following goods under Section 66(a), 15 U.S.C. § 1141(f):

- Rails of metal in International Class 6;
- Engine and machine part bearings, in particular hydraulic bearings, spherical bearings, conical bearings, machine bearings, flat bearings, wedge-shaped bearings, round bearings, buffers being parts of machines, instrument bearings, support bearings, spherical roller bearings, framework support bearings, axle guide bearings, hydraulic axle guide bearings, double U-shaped bearings, V-shaped bearings, motor bearings, M-shaped bearings, O-shaped bearings; machine part bushings, in particular hydraulic bushings; machine part springs, in particular multilayered springs, conical springs, chevron springs, roller springs, auxiliary springs; parts of machines, namely, spring inserts; parts of machines, namely, spring bases; rolling support systems being parts of machines; power operated tools, namely, transverse and longitudinal buffers; wedge bundles being parts of machines in International Class 7;
- Handle bars, in particular wheel-set guides and longitudinal swinging arms for use with motorcycles and bicycles; air springs being vehicle

suspension components for cushioning driver's seats and cabs; pneumatic spring systems being suspension springs for motor vehicles in International Class 12; and

- Industrial rubber components, namely, molded rubber parts for oscillation and vibration isolating and damping; insulating and sealing materials having rubber-metal compounds; articles of rubber for vibration isolation, namely, shock absorbing rubber buffers, vibration isolation mounts, vibration isolation dampers, and vibration isolation bearings and bushes; vibration control components of rubber, namely, shock absorbing rubber buffers, vibration isolation mounts, vibration isolation dampers, and vibration isolation bearings and bushes in International Class 17.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

11. Opposer repeats and re-alleges each and every allegation set forth in Paragraphs 1 through 10.

12. Opposer has used its HALLITE mark in commerce well prior to the filing and foreign priority dates of the opposed application and any date of first use that Applicant may allege. Opposer's pleaded registration for the HALLITE mark issued prior to the filing and priority dates of the opposed application and any date of first use that Applicant may allege.

13. Applicant's mark is strikingly similar in appearance, sound, meaning, and overall commercial impression to Opposer's previously used and registered HALLITE mark.

14. Application No. 79/129,925 for the mark HALL covers products that are identical or closely related to Opposer's HALLITE products and services.

15. Opposer and Applicant are direct competitors in the global seal market, in which there are less than a half dozen major manufacturers in total. Opposer's and Applicant's products are advertised in the same industry/trade publications, on some of

the same websites, and at the same trade shows, and their respective goods travel through many of the same trade and distribution channels.

16. Applicant's HALL mark so resembles Opposer's previously used and registered HALLITE mark as to be likely, when applied to the identified goods, to cause confusion, or to cause mistake, or to deceive under Section 2(d), 15 U.S.C. § 1052(d).

WHEREFORE, for the foregoing reasons, Opposer is being and will be damaged by the registration of the mark HALL shown in Application No. 79/129,925, and respectfully requests that registration to Applicant be refused, and that this Opposition be sustained in favor of Opposer.

A filing fee of \$1,200 has been submitted electronically. If the filing fee is found to be insufficient for any reason, please charge the deficiency to Deposit Account No. 50-0282.

Respectfully Submitted,

HALLITE SEALS INTERNATIONAL LIMITED

Dated: June 18, 2014

By: /Jonathan Gelchinsky/
Jonathan M. Gelchinsky
Sara M. Benjamin
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Telephone: (207) 791-1100
Facsimile: (207) 791-1350

Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on this 18th day of June 2014, on Applicant at the following address of record:

Jessica S. Sachs
Harness, Dickey & Pierce, P.L.C.
5445 Corporate Drive
Suite 200
Troy, Michigan 48098

/Jonathan Gelchinsky/

Exhibit A

Attorney of Record

Attorney Name: Joseph J. Santaniello, Esq. **Docket Number:** F65724-14816
Attorney Primary Email Address: jsantaniello@slk-law.com **Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: Joseph J. Santaniello, Esq.
 Shumaker, Loop & Kendrick, LLP
 128 South Tryon Street, Suite 1800
 Charlotte, NORTH CAROLINA 28202
 UNITED STATES
Phone: (704) 375-0057 **Fax:** (704) 332-1197
Correspondent e-mail: jsantaniello@slk-law.com rpetitgout@slk-law.com **Correspondent e-mail Authorized:** Yes

Domestic Representative

Domestic Representative Name: ABELMAN FRAYNE & SCHWAB

Prosecution History

Date	Description	Proceeding Number
Oct. 16, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 16, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jul. 30, 2011	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	75461
Jul. 30, 2011	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jul. 30, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Jun. 22, 2011	TEAS SECTION 8 & 9 RECEIVED	
Sep. 24, 2008	CASE FILE IN TICRS	
Aug. 30, 2006	REVIEW OF CORRESPONDENCE COMPLETE	74215
Aug. 21, 2006	PAPER RECEIVED	
Jun. 22, 2001	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Jun. 22, 2001	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Mar. 21, 2001	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 13, 1992	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Mar. 20, 1992	RESPONSE RECEIVED TO POST REG. ACTION	
Mar. 16, 1992	POST REGISTRATION ACTION MAILED - SEC. 9	
Jan. 23, 1992	RESPONSE RECEIVED TO POST REG. ACTION	
Aug. 23, 1991	POST REGISTRATION ACTION MAILED - SEC. 9	
Jun. 10, 1991	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jun. 08, 2011

TM Staff and Location Information**TM Staff Information - None****File Location**

Current Location: GENERIC WEB UPDATE

Date in Location: Jul. 30, 2011

Assignment Abstract Of Title Information**Summary**

Total Assignments: 2

Registrant: HALLITE HOLDINGS LIMITED

Assignment 1 of 2

Conveyance: CERTIFICATE FROM THE ASSISTANT REGISTRAR OF COMPANIES LONDON, SHOWING CHANGE OF NAME ON NOV. 7, 1973.

Reel/Frame: [0298/0402](#)

Pages: 2

Date Recorded: Nov. 11, 1976

Supporting Documents: No Supporting Documents Available

Assignor

Name: [HALLITE HOLDINGS LIMITED](#) Execution Date: Sep. 09, 1976
Legal Entity Type: UNKNOWN State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [HALL & HALL LIMITED](#)
Legal Entity Type: UNKNOWN State or Country Where Organized: No Place Where Organized Found
Address: No Assignee Address Found

Correspondent

Correspondent Name: MASON, FENWICK & LAWRENCE
Correspondent Address: 310 OFC BLDG.
1730 RHODE ISLAND AVENUE, N.W.
WASHINGTON, DC 20036

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: CHANGE OF NAME. ADDITIONAL PROPERTIES MAY SUBSEQUENTLY BE INDEXED AGAINST THE ORIGINAL DOCUMENT. THE PAPER REQUESTING SUCH INDEXING MUST ADEQUATELY IDENTIFY ALL SUCH PROPERTIES AND MUST INDICATED THE REEL AND FRAME NUMBER ON WHICH THE ORI

Reel/Frame: [0792/0062](#)

Pages: 2

Date Recorded: Jun. 10, 1991

Supporting Documents: No Supporting Documents Available

Assignor

Name: [HALL & HALL LIMITED \(CHANGED TO\)](#) Execution Date: Nov. 14, 1990
Legal Entity Type: SEE DOCUMENT FOR DETAILS. State or Country Where Organized: No Place Where Organized Found

Name: [HALLITE SEALS LIMITED \(CHANGED TO\)](#) Execution Date: Nov. 14, 1990
Legal Entity Type: SEE DOCUMENT FOR DETAILS State or Country Where Organized: No Place Where Organized Found

Name: [HALLITE HOLDINGS LIMITED \(CHANGED TO\)](#) Execution Date: Nov. 14, 1990
Legal Entity Type: SEE DOCUMENT FOR DETAILS State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [HALLITE SEALS INTERNATIONAL LIMITED](#)
Legal Entity Type: SEE DOCUMENT FOR DETAILS. State or Country Where Organized: No Place Where Organized Found
Address: No Assignee Address Found

Correspondent

Correspondent Name: MASON, FENWICK & LAWRENCE
Correspondent Address: SUITE 1000
1225 EYE STREET, NW
WASHINGTON, DC 20005

Domestic Representative - Not Found