

ESTTA Tracking number: **ESTTA721687**

Filing date: **01/20/2016**

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	New Line Productions, Inc.
Granted to Date of previous extension	01/20/2016
Address	4000 Warner Boulevard Burbank, CA 91522 UNITED STATES
Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@frosszelnick.com, eweiss@frosszelnick.com Phone:(212) 813-5900

Applicant Information

Application No	86467946	Publication date	09/22/2015
Opposition Filing Date	01/20/2016	Opposition Period Ends	01/20/2016
Applicant	Kelcey Murray 4405 E Verbena Dr. Phoenix, AZ 85044 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 025. First Use: 2014/10/01 First Use In Commerce: 2014/10/01 All goods and services in the class are opposed, namely: Adult novelty gag clothing item, namely, socks; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Athletic tops and bottoms for men, women, babies, toddlers; Babies' pants; Baby bodysuits; Baby bottoms; Babytops; Bandeau tops; Baseball caps and hats; Bibs not of cloth or paper; Body suits for men, women, babies, toddlers; Bottoms; Bottoms for men, women, babies, toddlers; Camouflage shirts; Camp shirts; Children's and infants' cloth bibs; Children's cloth eating bibs; Cloth bibs; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility; Clothing items, namely, adhesive pockets that may be affixed directly to the inside of clothing for storage and safekeeping of personal items; Clothing, namely, crops; Crop tops; Dresses for men, women, babies, toddlers; Fashion hats; Fleece tops; Gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, a coffee mug, and a tote bag; Graphic T-shirts; Halter tops; Hats; Hats for infants, babies, toddlers and children; Headgear, namely, men, women, babies, toddlers; Hooded sweat shirts; Hooded sweatshirts; Hooded sweatshirts for men, women, babies, toddlers; Infant and toddler one piece clothing; Jackets;</p>

Jerseys; Knit tops; Long-sleeved shirts; Muscle tops; Open-necked shirts; Pajamas for men, women, babies, toddlers; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Polo knit tops; Shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Shirts for men, women, babies, toddlers; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleep shirts; Swaddling clothes; Sweat shirts; Sweaters for men, women, babies, toddlers; Sweatpants for men, women, babies, toddlers; Sweatshirts; Sweatshirts for men, women, babies, toddlers; T-shirts; T-shirts for men, women, babies, toddlers; Tank tops; Tank-tops; Tee shirts; Tops; Tops for men, women, babies, toddlers; Tube tops; Wearable garments and clothing, namely, shirts; Women's athletic tops with built-in bras; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's tops, namely, camis; Woven tops; Yoga shirts

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE BEST WAY TO SPREAD CHRISTMAS CHEER IS SINGING LOUD FOR ALL TO HEAR		
Goods/Services	Motion pictures, musicals, audio and video recordings thereof.		

Attachments	Notice of Opposition (THE BEST WAY TO SPREAD CHRISTMAS CHEER IS SINGING LOUD FOR ALL TO HEAR) (F1859691x96B9E).pdf(131016 bytes)
-------------	-----------------------------------------------------------------------------------------------------------------------------------

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	/s/ James D. Weinberger
Name	James D. Weinberger
Date	01/20/2016

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

In the Matter of Serial No. 86/467,946
Published in the *Official Gazette*: September 22, 2015
Mark: THE BEST WAY TO SPREAD CHRISTMAS CHEER IS
SINGING LOUD FOR ALL TO HEAR

NEW LINE PRODUCTIONS, INC.,

Opposer,

-against-

KELCEY MURRAY,

Applicant.

NOTICE OF OPPOSITION

Opposer New Line Productions, Inc., a corporation organized and existing under the laws of California, with a principal place of business at 4000 Warner Boulevard, Burbank, California 91522, believes that it will be damaged by the issuance of registration for the mark THE BEST WAY TO SPREAD CHRISTMAS CHEER IS SINGING LOUD FOR ALL TO HEAR, as applied for in Application Serial No. 86/467,946, and therefore oppose the same. As grounds therefore, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is a production company that for over forty years has produced critically acclaimed hit films, including but not limited to *The Hobbit*, *Hairspray*, and *Wedding Crashers*, as well as the franchises *The Lord of the Rings*, *A Nightmare on Elm Street*, *Austin Powers*, and *Sex and the City*.

2. One of Opposer's well-known films is *Elf*, which was released in 2003 and stars Will Ferrell. *Elf* tells the story of one of Santa's elves named Buddy who discovers that he is in fact a human, not an elf. After learning his true identity, Buddy travels to New York City to

meet his biological father. While there, he tries to spread Christmas cheer to cynical humans, including his own father.

3. One of Buddy's most memorable lines in the film is "the best way to spread Christmas cheer is singing loud for all to hear" ("Opposer's Mark"). Opposer's Mark resonated with viewers, and immediately became a popular saying among those familiar with *Elf*. Indeed, one blog post included it in a list of quotes that "we can't stop repeating."

4. The *Elf* film was immensely successful, grossing over \$150 million in ticket sales in the United States. Moreover, it is now considered a classic holiday movie, with viewers re-watching it every year around Christmas time and continuing to quote the memorable "the best way to spread Christmas cheer is singing loud for all to hear" line. As such, Opposer's Mark has achieved pop cultural significance among consumers.

5. Opposer has significantly promoted the *Elf* film and has derived substantial revenue from the movie, including through home video sales and streaming, as well as associated merchandise. Moreover, Opposer has adapted *Elf* into a Broadway musical, which also recently toured the United States.

6. As a result of the enormous success of *Elf* and the popularity of Opposer's Mark among consumers, Opposer's Mark has achieved secondary meaning and come to be recognized as identifying goods and services of Opposer exclusively and has come to represent enormous goodwill of Opposer.

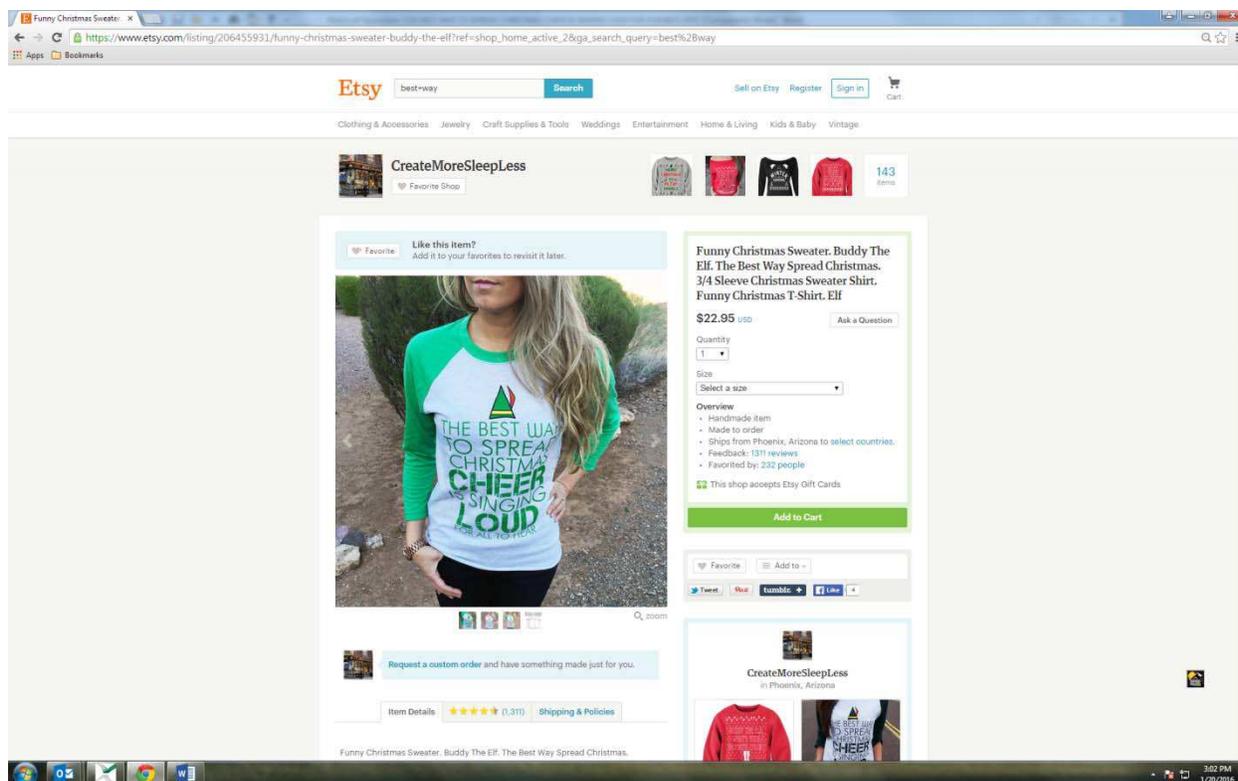
7. Upon information and belief, Kelcey Murray ("Applicant") is an individual with an address of 4405 E. Verbena Drive, Phoenix, Arizona 85044.

8. On December 1, 2014, Applicant filed Application Serial No. 86/467,946 (the "Application") to register the mark THE BEST WAY TO SPREAD CHRISTMAS CHEER IS SINGING LOUD FOR ALL TO HEAR ("Applicant's Mark") for "Adult novelty gag clothing

item, namely, socks; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Athletic tops and bottoms for men, women, babies, toddlers; Babies' pants; Baby bodysuits; Baby bottoms; Baby tops; Bandeau tops; Baseball caps and hats; Bibs not of cloth or paper; Body suits for men, women, babies, toddlers; Bottoms; Bottoms for men, women, babies, toddlers; Camouflage shirts; Camp shirts; Children's and infants' cloth bibs; Children's cloth eating bibs; Cloth bibs; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility; Clothing items, namely, adhesive pockets that may be affixed directly to the inside of clothing for storage and safekeeping of personal items; Clothing, namely, crops; Crop tops; Dresses for men, women, babies, toddlers; Fashion hats; Fleece tops; Gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, a coffee mug, and a tote bag; Graphic T-shirts; Halter tops; Hats; Hats for infants, babies, toddlers and children; Headgear, namely, men, women, babies, toddlers; Hooded sweat shirts; Hooded sweatshirts; Hooded sweatshirts for men, women, babies, toddlers; Infant and toddler one piece clothing; Jackets; Jerseys; Knit tops; Long-sleeved shirts; Muscle tops; Open-necked shirts; Pajamas for men, women, babies, toddlers; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Polo knit tops; Shirts; Shirts and short-sleeved shirts; Shirts for infants, babies, toddlers and children; Shirts for men, women, babies, toddlers; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleep shirts; Swaddling clothes; Sweat shirts; Sweaters for men, women, babies, toddlers; Sweatpants for men, women, babies, toddlers; Sweatshirts; Sweatshirts for men, women, babies, toddlers; T-shirts; T-shirts for men, women, babies, toddlers; Tank tops; Tank-tops; Tee shirts;

Tops; Tops for men, women, babies, toddlers; Tube tops; Wearable garments and clothing, namely, shirts; Women’s athletic tops with built-in bras; Women’s clothing, namely, shirts, dresses, skirts, blouses; Women’s tops, namely, camis; Woven tops; Yoga shirts” in International Class 25, based on use of the mark in commerce since October 1, 2014.

9. Applicant had actual knowledge of Opposer’s prior rights to and interest in Opposer’s Mark before seeking to register Applicant’s Mark. Specifically, Applicant markets her products as being associated with Opposer’s *Elf* film:



See https://www.etsy.com/listing/206455931/funny-christmas-sweater-buddy-the-elf?ref=shop_home_active_2&ga_search_query=best%2Bway. Furthermore, Applicant markets an entire line of *Elf*-themed clothing, none of which was authorized by Opposer. See https://www.etsy.com/shop/CreateMoreSleepLess/search?search_query=elf&order=date_desc&view_type=gallery&ref=shop_search.

COUNT 1: LIKELIHOOD OF CONFUSION UNDER SECTION 2(d)

10. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 9 as if fully set forth herein.

11. Opposer's Mark has been used continuously by Opposer since a date prior to any date on which Applicant can rely. As such, Opposer's rights in Opposer's Mark are prior and superior to any rights Applicant may claim in Applicant's Mark.

12. Applicant's mark is identical to Opposer's Mark in sight, sound, and commercial impression.

13. The goods identified in the Application are closely related to the goods and services that have long been offered by Opposer in connection with Opposer's Mark.

14. As a result of the similarity of the marks and the goods and services, Applicant's use and registration of Applicant's Mark in connection with the goods identified in the Application are likely to cause confusion, cause mistake, or to deceive consumers to falsely believe that Applicant's goods emanate from or otherwise are authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. By reason of the foregoing, Opposer is likely to be harmed by registration of Applicant's Mark.

COUNT 2: FAILURE TO FUNCTION AS A MARK

16. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 15 as if fully set forth herein.

17. To the extent Applicant is using Applicant's Mark in connection with the covered goods, Applicant uses Applicant's Mark as a slogan and not to indicate source.

18. As shown by the specimen submitted by Applicant in connection with the Application, Applicant's Mark appears on the front of the apparel not as a trademark, but rather

as a message that the wearer conveys. To the extent that Applicant's Mark also appears on a hangtag attached to the specimen, Applicant's Mark still does not function as a trademark as Applicant's brand name appears under Applicant's Mark.

19. Therefore, Applicant's Mark does not function as a trademark, and registration of the Application would violate Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, and 1127.

20. By reason of the foregoing, Opposer is likely to be harmed by registration of Applicant's Mark.

COUNT 3: APPLICANT DOES NOT OWN THE MARK

21. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 20 as if fully set forth herein.

22. Applicant does not own and has never owned Applicant's Mark or been authorized by Opposer to register Applicant's Mark.

23. Applicant's filing of the Application was in violation of Section 1 of the Lanham Act, 15 U.S.C. § 1051(a)(1), which provides that only the "owner of a trademark . . . may request Registration." *Id.* (emphasis added).

24. Because Applicant's registration of Applicant's Mark will interfere with Opposer's exclusive right to use and register Opposer's Mark, Opposer would be harmed by the registration of the Application.

COUNT 4: FRAUD

25. Opposer repeats and re-alleges each and every allegation contained in Paragraphs 1 through 24 as if fully set forth herein.

26. In the Application, Applicant knowingly made false, material misrepresentations of fact with regard to her right to use and register Applicant's Mark. Specifically, Applicant declared:

- a. Applicant is "entitled to use [Applicant's Mark] in commerce"; and
- b. "[N]o other person has the right to use [Applicant's Mark] in commerce."

27. Each of the above statements was false because Opposer, not Applicant, has the right to use in commerce and register Opposer's Mark, which is identical to Applicant's Mark. Opposer has not authorized Applicant to use or register Applicant's Mark. As such, Applicant's use of Applicant's Mark is not authorized or exclusive.

28. Applicant knew the above statements were false because Applicant had actual knowledge of Opposer's Mark.

29. Applicant made the above statements willfully, in bad faith, and with an intent to obtain a registration to which Applicant is not entitled, namely, a registration containing Opposer's Mark, to which Applicant had no rights.

30. The above statements are material and have been or will be relied upon by the Examining Attorney because they are required for registration. Accordingly, the Examining Attorney could not issue a registration for the Application without relying on the above false statements and the reasonable belief that the statements are true.

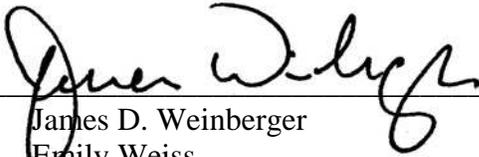
31. Accordingly, Applicant committed fraud on the United States Patent & Trademark Office in connection with the Application, and the Application should be refused under Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a).

32. Because Applicant's registration of Applicant's Mark will interfere with Opposer's exclusive right to use and register Opposer's Mark, Opposer would be harmed by the registration of the Application.

WHEREFORE, it is respectfully requested that this opposition be granted and that Application Serial No. 86/467,946 be refused in its entirety.

Dated: New York, New York
January 20, 2016

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Emily Weiss

866 United Nations Plaza
New York, New York 10017
(212) 813-5900
Email: jweinberger@fzlz.com
eweiss@fzlz.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on January 20, 2016, a copy of the foregoing **NOTICE OF OPPOSITION** was sent by first-class mail, postage pre-paid, to Applicant at the correspondence address of record in the United States Patent and Trademark Office:

Kelcey Murray
4405 E. Verbena Dr.
Phoenix, Arizona 85044


James D. Weinberger