

ESTTA Tracking number: **ESTTA558580**

Filing date: **09/10/2013**

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	Giftcards.com, LLC
Granted to Date of previous extension	09/28/2013
Address	495 Mansfield Avenue Pittsburgh, PA 15205 UNITED STATES
Correspondence information	Chad D. Tomosovich General Counsel Giftcards.com, LLC 495 Mansfield Avenue Pittsburgh, PA 15205 UNITED STATES chad.tomosovich@wolfe.com Phone:187774666649160

**Applicant Information**

Application No	85850491	Publication date	07/30/2013
Opposition Filing Date	09/10/2013	Opposition Period Ends	09/28/2013
Applicant	CardLab, Inc. 5001 Spring Valley Road, Suite 750W Dallas, TX 75244 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 2012/10/03 First Use In Commerce: 2012/10/03 All goods and services in the class are opposed, namely: Financial services, namely, providing prepaid tangible and/or virtual stored value gift, reward, and/or incentive card services for others
---

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	4270035	Application Date	01/27/2012
Registration Date	01/01/2013	Foreign Priority Date	NONE

Word Mark	GIFTCARDS.COM
Design Mark	
Description of Mark	The mark consists of the text "GiftCards.com" with a blue rectangle that represents a "Gift Card" around the "Cards" text, a sans-serif typeface in the color orange for the text "Gift", a white knockout in the color blue for the text "Cards", and the text ".com" being printed outside and to the right of the card in the color blue.
Goods/Services	Class 036. First use: First Use: 2002/08/02 First Use In Commerce: 2002/08/02 Debit card services; Issuing stored value cards; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; Stored value card services

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	the word mark "GIFTCARDS.COM" for which a an application for registration on the Principal Register--serial number 85925989.		
Goods/Services	IC 036. US 100 101 102. G & S: Debit card services; Issuing stored value cards; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; Stored value card services		

Attachments	DOC091013.pdf(85331 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	/Chad D. Tomosovich/
Name	Chad D. Tomosovich
Date	09/10/2013

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

*In the matter of trademark application Serial No: 85850491*

*For the mark: GiftCard.com*

*Published in the Official Gazette on: July 30, 2013*

GiftCards.com, LLC

v.

CardLab, Inc.

**NOTICE OF OPPOSITION**

---

GiftCards.com, LLC, a Delaware limited liability company, with its principal office located at 495 Mansfield Avenue, Pittsburgh, PA 15205, believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

**FACTUAL ALLEGATIONS**

1. GiftCards.com, LLC (the "Company") has been in business using the trade name GiftCards.com since 2003, and operates an online gift card business offering a large selection of personalized Visa gift cards, custom MasterCard gift cards, discount gift cards, e-gift cards, local gift cards, rewards cards, and group gifts and is the highest ranking online gift cards store on the internet.
2. The Company has owned the domain name www.giftcards.com since 2003.
3. The Company also holds a registered trademark, registration # 4270035, on giftcards.com (stylized).
4. The Company has spent tens of millions of dollars in advertising and brand building, and developing its business.
5. The Company has taken on roughly ten million dollars (\$10,000,000) in funding since 2007 and will generate roughly one hundred million (\$100,000,000) in gift card and reward card sales in 2013.

6. In addition, the Company has applied, in the past, to register giftcards.com on the Principal Register, but has been denied on the basis of the mark being merely description as set forth in Section 2 (e) 1 of the Trademark Act.

7. The Company believes, since such time, its mark has acquired secondary meaning and acquired distinctiveness, and the Company currently has an application pending on the Principal Register for the mark giftcards.com.

8. CardLab, Inc. ("Applicant") also operates an online business which sells gift cards and which mirrors the business operated by the Company.

9. Applicant has repeatedly attempted to piggyback the efforts of the Company to establish its business and its brand and has engaged in documented predatory and deceptive business practices which are intentionally designed to confuse consumers by creating apparent association with the Company and its business.

**FIRST REASON FOR OBJECTION**  
**(False suggestion of connection)**

10. The Company incorporates the allegations set forth in paragraphs 1-9 above as if fully set forth herein.

11. Due to the similarity of the Applicant's mark and the Company's mark particularly when one considers the degree to which the Applicant's business is similar to the Company's, granting registration to Applicant's mark would falsely suggest a connection with the Company as prohibited by Section 2 (a) of the Trademark Act.

12. Therefore, Applicant's mark must be denied registration.

**SECOND REASON FOR OBJECTION**  
**(the mark is merely descriptive)**

13. The Company incorporates the allegations set forth in paragraphs 1-12 above as if fully set forth herein.

14. Applicant's mark, when used on or in connection with the services of Applicant, is merely descriptive of its business and has no secondary meaning nor has it acquired distinctiveness.

15. The United States Patent and Trademark Office has taken this position with the Company in connection with its efforts to register a substantially similar mark.

16. Therefore, Applicant's mark must be denied registration pursuant to Section 2(e)1 of the Trademark Act.

**THIRD REASON FOR OBJECTION**  
**(mark is likely to cause confusion with the Company's mark)**

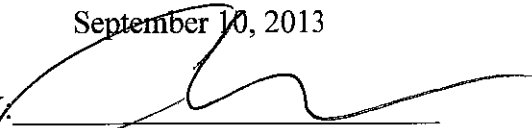
17. The Company incorporates the allegations set forth in paragraphs 1-16 above as if fully set forth herein.

18. The Applicant's mark resembles the Company's registered mark (reg. # 4270035) so closely (i.e. simply taking away the "s" from the Company's name) that it is likely to cause confusions, mistake or to deceive consumers, particularly when one considers the fact that Applicant operates exactly the same business as the Company.

19. Therefore, Applicant's mark must be denied registration pursuant to Section 2 (d) of the Trademark Act.

Respectfully Submitted,  
GIFTCARDS.COM, LLC

September 10, 2013

BY:   
Chad D. Tomosovich, Esquire, General Counsel

**CERTIFICATE OF SERVICE**

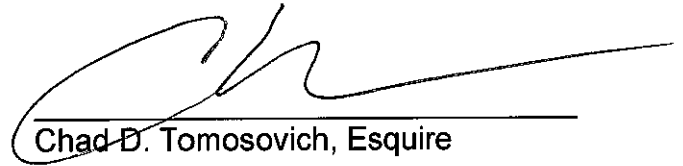
I hereby certify that a true and correct copy of the within Notice of Opposition was mailed on the 10<sup>th</sup> day of September, 2013, by certified mail to the following:

Christopher J. Rourk, Esquire

JACKSON WALKER L.L.P.

901 MAIN ST STE 6000

DALLAS, TX 75202-3797



Chad D. Tomosovich, Esquire