

ESTTA Tracking number: **ESTTA167622**

Filing date: **10/09/2007**

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	MedAvante, Inc.
Granted to Date of previous extension	10/10/2007
Address	100 American Metro Boulevard Suite 106 Hamilton, NJ 08619 UNITED STATES
Correspondence information	Elliott J. Stein Esq. Stevens & Lee, P.C. 600 College Road East, Suite 4400 Princeton, NJ 08540 UNITED STATES ejs@stevenslee.com Phone:609 987 7050

Applicant Information

Application No	78958913	Publication date	06/12/2007
Opposition Filing Date	10/09/2007	Opposition Period Ends	10/10/2007
Applicant	ProxyMed, Inc. Suite 200 1854 Shackleford Court Norcross, GA 30093 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 2006/01/31 First Use In Commerce: 2006/01/31 All goods and services in the class are opposed, namely: Providing business management services to others in the field of health care; providing administrative services to health care companies, namely, cost management for the health care benefit plans of others; cost management services for preferred provider health plans and patients; cost management services for the health plans of others; Health care cost review and containment services</p>
<p>Class 036. First Use: 2006/01/31 First Use In Commerce: 2006/01/31 All goods and services in the class are opposed, namely: Insurance claims processing; Claims adjustment services in the field of health insurance; Organizing and administering preferred provider plans in the field of health insurance</p>
<p>Class 044. First Use: 2006/01/31 First Use In Commerce: 2006/01/31 All goods and services in the class are opposed, namely: Health care in the nature of a preferred provider organization; maintaining files and records concerning the medical condition of individuals; Managed health care services</p>

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)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2830753	Application Date	02/27/2002
Registration Date	04/06/2004	Foreign Priority Date	NONE
Word Mark	MEDAVANTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2002/04/01 First Use In Commerce: 2002/04/07 Technology consultation, namely, providing technology solutions for conducting clinical trials and/or medical research		

Related Proceedings	MedAvante, Inc. v. ProxyMed, Inc., et als. Civil Action No. 06-cv-03248-MLC-JJH United States District Court, District of New Jersey
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Attachments	SDOC8432.pdf (4 pages)(346039 bytes)
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Signature	/varlawyer/
Name	Elliott J. Stein
Date	10/09/2007

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

MEDAVANTE INC, a Delaware corporation,]	In the Matter of U.S. Application
]	Serial No. 78/958,913 for
]	NPPN NATIONAL PREFERRED
Opposer,]	PROVIDER NETWORK A MEDAVANT
]	NETWORK
v.]	
]	Published in the Official Gazette
PROXYMED, INC., a Florida corporation]	on June 12, 2007
]	
Applicant.]	Opposition No. _____

NOTICE OF OPPOSITION

MedAvante, a Delaware corporation (the “OPPOSER”) with principal offices at 100 American Metro Boulevard, Suite 106, Hamilton, New Jersey, by and through its attorneys. Stevens & Lee, P.C., hereby opposes the application of ProxyMed, Inc., a Florida corporation, (the “APPLICANT”) to register the trademark “NPPN NATIONAL PREFERRED PROVIDER NETWORK A MEDAVANT NETWORK” pursuant to U.S. Trademark Application Serial No. 78/958,913.

As grounds for its opposition OPPOSER states as follows:

1. OPPOSER is a Delaware Corporation, offering technology consultation services in the field of healthcare, namely, providing technology solutions for conducting clinical trials and medical research.
2. OPPOSER was founded in 2002 to provide services to pharmaceutical companies, physicians and other medical professionals engaged in medical research and clinical trials.
3. In or about April 2002, OPPOSER began offering its services to healthcare practitioners using the trademark “MedAvante.”

5. OPPOSER first used the trademark “MedAvante” in interstate commerce at least as early as April 2002 and thereafter.

6. On February 27, 2002, OPPOSER caused U.S. Trademark Application Serial No. 78/111,472 to be filed for the registration of the trademark “MedAvante” (the “’472 Application”).

7. The ‘472 Application was published for opposition in the Official Gazette on September 24, 2002.

8. On April 6, 2004, the trademark “MedAvante” was registered by the United States Patent and Trademark Office as U.S. Trademark No. 2,830,753 (the “MedAvante Registration”).

9. The OPPOSER has broadly marketed its services in interstate commerce using the trademark “MedAvante” and that trademark identifies such services as those of OPPOSER.

10. APPLICANT filed its U.S. Application to register “NPPN NATIONAL PREFERRED PROVIDER NETWORK A MEDAVANT NETWORK” on August 23, 2006, to designate the following services:

In International Class 035:

Providing business management services to others in the field of health care; providing administrative services to healthcare companies, namely, cost management for the healthcare benefit plans of others; cost management services for preferred provider health plans and patients, cost management services for the health plans of others; health care cost review and containment services.

In International Class 036:

Insurance claims processing; claims adjustment services in the field of health insurance; organizing and administering preferred provider plans in the field of health insurance.

In International Class 044:

Health care in the nature of a preferred provider organization; maintaining files and records concerning the medical condition of individuals; managed health care services.

11. APPLICANT's application, which claimed a first use in commerce of January 31, 2006, was assigned U.S. Application Serial no. 78/958,913 and is referred herein as the "'913 Application."

12. The services described in the '913 Application are substantially similar to those offered by OPPOSER using its registered "MedAvante" trademark in commerce since at least April 2002, some four (4) years before APPLICANT's use in commerce.

13. On or about July 18, 2006, OPPOSER instituted a lawsuit in the United States District Court, District of New Jersey, captioned MedAvante, Inc. v. ProxyMed, Inc., et als. bearing Civil Action No. 06-cv-03248-MLC-JJH (the "Action"), asserting, among other things, that ProxyMed's use of certain "MedAvant" trademarks (including that which is the subject of the '913 Application) infringed upon OPPOSER's "MedAvante Registration."

14. On October 12, 2006, U.S. District Judge Mary L. Cooper granted OPPOSER's motion for a preliminary injunction finding that the OPPOSER "...has demonstrated a reasonable likelihood of success on the merits with respect to its claims by showing, inter alia, that ProxyMed's use of the Mark [MedAvant] is likely to create confusion concerning the origin of [OPPOSER's] products and services."

15. On February 13, 2007, the APPLICANT and the OPPOSER entered into a settlement of the Action (the "Settlement"). Under the terms of the Settlement, APPLICANT would obtain a license to use certain "MedAvant" trademarks.

16. OPPOSER subsequently filed a motion to enforce the Settlement. That motion is pending and OPPOSER reserves the right to supplement this Notice in regard thereto.

17. If the registration is granted to APPLICANT, the registration will cause confusion and/or mistake in the marketplace among those who obtain or might obtain services from

OPPOSER, including those who might become confused as to the source or origin's of APPLICANT's services thereby damaging OPPOSER.

18. Furthermore, any defect, objection or fault found with APPLICANT's services marketed under such a registered trademark would necessarily reflect upon and seriously injure the reputation which OPPOSER has established for its services marketed under the registered trademark "MedAvante."

19. Such registration would be a source of damage and injury to the OPPOSER requiring OPPOSER to abandon or modify its use of its registered trademark, all at great expense and detriment to OPPOSER.

WHEREFORE, OPPOSER prays that the '913 Application be rejected and that APPLICANT's request for registration of the trademark "NPPN NATIONAL PREFERRED PROVIDER NETWORK A MEDAVANT NETWORK" be denied and refused.

[This Opposition is to be filed electronically using the ESTTA system.]

Respectfully submitted

Dated: 9 October 2007



Elliott J. Stein
STEVENS & LEE, P.C.
600 College Road East
Suite 4400
Princeton, NJ 08540
(609) 987-7050
ejs@stevenslee.com

Attorneys for OPPOSER, MedAvante, Inc.