

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

-----X  
HCA-HealthONE LLC :  
 :  
Petitioner, :  
 :  
v. :  
 :  
Winifred Masterson Burke :  
Rehabilitation Hospital, Inc. :  
 :  
Respondent. :  
-----X

Reg. No. 2,102,922

Mark: RENEWING HOPE, REBUILDING LIVES,  
RESTORING INDEPENDENCE

Cancellation No. 92/042,004

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RESPONDENT'S MOTION FOR SUMMARY JUDGMENT UNDER 37 C.F.R. § 2.127  
WITH BRIEF, DECLARATION AND EXHIBITS

Law Office of Leo Zucker  
50 Main Street, Suite 480  
White Plains, NY 10606-1964

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Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

October 24, 2003

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## INTRODUCTION

Respondent, Winifred Masterson Burke Rehabilitation Hospital, Inc. ("Burke"), hereby moves for summary judgment under 37 C.F.R. § 2.127 with respect to the above-captioned cancellation proceeding. Burke submits that petitioner HCA-HealthONE LLC ("HealthONE") has failed to state a claim for which relief can be granted, and that the present petition to cancel Burke's Registration 2,102,922 should be dismissed. The motion is based on the within brief, the annexed Declaration of Peter Bassano with Exhibits, the current pleadings, and the file of the '922 registration pursuant to 37 C.F.R. § 2.122(b)(1).

## FACTUAL BACKGROUND

Burke's service mark RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE was registered on October 7, 1997, and a Declaration of Use under Section 8 of the Trademark Act was filed on July 21, 2003. On or about December 2002, Burke became aware that Spalding Rehabilitation Hospital ("Spalding") in Aurora, Colorado was using the phrase "Rebuilding Lives - Renewing Hope" in various media to promote Spalding's rehabilitation services. Believing that such use was likely to cause confusion, mistake or deception among the general public in view of Burke's registered mark, Burke retained Mr. Bassano's firm for the purpose of alerting Spalding to the existence of Burke's registration and Spalding's potentially

infringing uses. Bassano, pars. 3 and 4.

By letter dated December 9, 2002, Mr. Bassano provided Spalding with written notice of Burke's registration and the potential conflict, and invited "a prompt, amicable resolution of [the] matter." Bassano, par. 4; Exhibit 2, last par.

Spalding's counsel responded to Burke's offer of an amicable resolution by filing the present cancellation petition on March 19, 2003, in the name of HealthONE. Bassano, par. 5. By letter of the same date (Exhibit 3), Spalding's counsel (now HealthONE's) forwarded a copy of the petition to Mr. Bassano, pointing out that the petition had *already* been filed. Counsel claimed that their investigation revealed that Spalding had used "Rebuilding Lives - Renewing Hope" prior to the date of first use alleged in Burke's registration. Quoting from Exhibit 3, page 1, last paragraph:

"Since Burke has asserted that the parties' marks are confusingly similar, and since it appears that Spalding has prior use, we have filed a Petition to Cancel Burke's registration with the Trademark Trial and Appeal Board. A copy of this petition is attached for your review." Exhibit 3, page 1, last par.

HealthONE asserts two claims for relief in the present petition. The first states that they are or will be damaged by the continued registration of Burke's mark because the parties' services are marketed to the same class of purchasers, are provided through common channels of trade, and compete with one another. Petition, par. 9. The claim also alleges that HealthONE will be damaged because Burke's mark

so resembles that of HealthONE as to be likely to cause confusion, or to cause mistake, or to deceive. Petition, par. 10.

HealthONE's second claim asserts that their mark "Rebuilding Lives, Renewing Hope" is distinctive and famous, and that the distinctive quality of the mark is being diluted by Burke's continued registration and use of RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE. Petition, pars. 12 & 13.

Along with its answer, Burke served a number of interrogatories on HealthONE. Burke's interrogatories 24-26 and HealthONE's responses are set out below:

"24. Does HealthONE have knowledge of any instance of actual confusion, mistake or deception on the part of the trade or the general public resulting from Burke's use of the mark RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE in connection with Burke's services?

ANSWER: Yes.

25. If the answer to interrogatory 24 is affirmative, describe each instance by date, whether by telephone, mail or other means; the identities of all persons involved, and the subject matter of any associated oral or written communication.

ANSWER: By letter dated December 9, 2002, Peter Bassano, counsel for The Burke Rehabilitation Hospital, contacted Cindy Mansfield claiming that HealthONE's mark, REBUILDING LIVES, RENEWING HOPE was confusingly similar to Burke's mark

RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE.

26. Identify all documents concerning each instance described in response to interrogatory 25.

ANSWER: See Answer to Interrogatory No. 25.”

## ARGUMENT

### I. HealthONE’s First Claim Fails to Allege Grounds For Which Relief Can Be Granted

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HealthONE believes its first claim is substantiated in view of Burke’s assertion that the parties’ marks are confusingly similar. As HealthONE’s counsel stated in the letter of Exhibit 3;

“Since Burke has asserted that the parties’ marks are confusingly similar, and since it appears that Spalding has prior use, we have filed a Petition to Cancel Burke’s registration with the Trademark Trial and Appeal Board.”

Paragraph 10 of the petition states that HealthONE will be damaged because “[r]espondent’s mark so resembles [p]etitioner’s mark so as to be likely to cause confusion, or to cause mistake, or to deceive . . . .” Further, by its answer to Burke’s interrogatories 24 and 25, above, HealthONE acknowledges that apart from Mr. Bassano’s letter of Exhibit 2, HealthONE is not aware of any instance of actual

confusion, mistake or deception resulting from Burke's use of the registered mark. The gravamen of HealthONE's first claim is, therefore, likelihood of confusion.

A petition to cancel a registration of a mark based on likelihood of confusion, *i.e.*, § 2(d) of the Trademark Act, may be filed "[w]ithin five years from the date of the registration of the mark . . . ." 15 U.S.C. § 1064(1). Burke's registration was granted October 7, 1997, and a declaration under section 8 of the Trademark Act was timely filed. Thus, even if HealthONE can prove prior use (through Spalding), the first claim must be dismissed as having been filed beyond the five year term. *Dunleavy Co. v. Koeppel Metal Furniture Corp.*, 122 U.S.P.Q. 395, 396 (T.T.A.B. 1959).

The five year limit serves to balance the public interest with the interest of the registrant in stability of its trademark rights.

[A] petitioner cannot attack a trademark registration more than five years old on the ground of priority of use and likelihood of confusion. It matters not that the petitioner in such a case can prove rampant actual confusion. The likelihood, or even certainty, of confusion or deception of the public is not a factor. *Consorzio del Prosciutto di Parma v. Parma Sausage Products*, 23 U.S.P.Q.2d 1894,1899 (T.T.A.B. 1992).

Moreover, the fact that Burke has not filed a declaration under section 15 of the Trademark Act does not remove the five-year bar.

"Section 14 is, in effect, a five year time limit barring certain attacks on a registration. It should be noted that this section is not dependent on the filing of a declaration under § 15 which provides incontestable rights of use to a limited extent." *Wallpaper Manufacturers, Ltd. v. Crown Walcovering Corp.*, 214 U.S.P.Q. 327 (C.C.P.A. 1982), at 332, n.6.

See also *Imperial Tobacco Ltd. v. Philip Morris*, 14 U.S.P.Q.2d 1390, 1392, n.5 (Fed. Cir. 1990); *Western Worldwide Enterprises Group v. Qinqdao Brewery*, 17 U.S.P.Q.2d 1137, 1139 (T.T.A.B. 1990); and *Norac Company v. Occidental Petroleum Corp.*, 189 U.S.P.Q. 55, 56 (T.T.A.B. 1975).

## II. HealthONE's Second Claim Fails to Allege Grounds For Which Relief Can Be Granted

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HealthONE's second claim alleges that their mark is distinctive and famous, and that the distinctive quality of the mark is being diluted by way of Burke's registration. While section 14 of the Trademark Act does include "dilution" as a form of damage on which a petitioner may rely to cancel a registration, "dilution" is *not* an exception wherein the five year time limit imposed by 15 U.S.C. § 1064(1) becomes inapplicable. See, 3 McCarthy on Trademarks and Unfair Competition, § 20:53.1 (Mar. 2001).

Because the petition was filed beyond the five year limit, HealthONE's second claim also fails to state a ground for which relief may be granted.

## CONCLUSION

In view of the foregoing, there is no genuine issue of material fact and the entire petition should be dismissed as having been untimely filed.

Respectfully submitted,



Leo Zucker, Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

50 Main Street, Suite 480  
White Plains, New York 10606

Telephone: (914) 761-7799

October 24, 2003

CERTIFICATE OF SERVICE

I hereby certify that the within Respondent's Motion for Summary Judgment Under 37 C.F.R. § 2.127 with Brief and Supporting Declaration of Peter Bassano with Exhibits, were served upon Petitioner on October 24, 2003, by mailing a true copy thereof by Express Mail, postage prepaid, and addressed to Julie Ann Gregory, Middleton Reutlinger, Attorneys for Petitioner, 2500 Brown & Williamson Tower, Louisville, KY 40202-3410.

  
\_\_\_\_\_  
Leo Zucker, Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

October 24, 2003

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Petitioner,

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Respondent.

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Reg. No. 2,102,922

Mark: RENEWING HOPE, REBUILDING LIVES,  
RESTORING INDEPENDENCE

Cancellation No. 92/042,004

03 OCT 27 P11 1:32

DECLARATION OF PETER BASSANO UNDER 37 C.F.R. § 2.20  
IN SUPPORT OF RESPONDENT'S MOTION FOR SUMMARY JUDGMENT,  
WITH EXHIBITS

Law Office of Leo Zucker  
50 Main Street, Suite 480  
White Plains, NY 10606-1964

Telephone: (914) 761-7799

Attorney for Respondent  
Winifred Masterson Burke  
Rehabilitation Hospital, Inc.

PETER BASSANO, hereby declares and states that:

1. I am an attorney admitted to practice in the Courts of the State of New York, and in the United States District Court for the Southern District of New York. I am a partner in the law firm of Bleakley, Platt & Schmidt, LLC, located at One North Lexington Avenue, White Plains, NY 10601. I make this declaration in support of respondent's present motion for summary judgment, and I have personal knowledge of all matters set forth below.

2. Respondent ("Burke") was established in 1915 and is known worldwide for, *inter alia*, helping victims of traumatic head and spinal cord injuries to recover through continued advances in the medical and rehabilitative sciences. A leaflet explaining some of Burke's services and programs is attached as Exhibit 1. Burke's present service mark RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE appears on the exhibit. The mark was registered (No. 2,102,922) on October 7, 1997, and a declaration of use under Section 8 of the Trademark Act was filed on July 21, 2003.

3. On or about December 2002, I was retained by Burke to contact Spalding Rehabilitation Hospital ("Spalding") in Aurora, CO, concerning a potential infringement by Spalding of Burke's '922 registration. Specifically, Burke had become aware that Spalding was using the phrase "Rebuilding Lives - Renewing Hope" in various media to promote Spalding's rehabilitation services, and believed that such use was likely to cause confusion, mistake or deception among the public in view of Burke's registered mark. (Trademark Act, § 2(d)).

4. I prepared a letter to Spalding in which I identified the '922 registration, and maintained that because of similarities in the language of Spalding's promotional phrase and Burke's registered mark, the phrase was likely to cause confusion, mistake and deception with respect to the source of Spalding's services. A copy of my letter to Spalding dated December 9, 2002, is attached as Exhibit 2.

5. By letter dated March 19, 2003 (Exhibit 3), counsel for Spalding claimed that their investigation revealed Spalding had used the phrase "Rebuilding Lives - Renewing Hope" as a "tag line" prior to the date of first use alleged by Burke in the '922 registration. Spalding's counsel also included a copy of the present petition which they said had *already* been filed because of my assertion that the parties' marks are confusingly similar, and Spalding's belief that it can show priority of use. See Exhibit 3, page 1, last paragraph.

6. Upon information and belief, the present petition was filed with the TTAB by Express Mail on March 19, 2003, and was later mailed from the TTAB to respondent on May 21, 2003. Because the petition was filed more than five years from the date of issue of the '922 registration, it can not be sustained on the ground that Burke's registered mark is likely to cause confusion, mistake and deception in view of any alleged prior use by Spalding. (Trademark Act, § 14).

7. In view of all the above, I respectfully request the Board to dismiss the petition as not having been timely filed.

8. I further declare that all statements made of my own knowledge are true and that all statements made on information as belief are believed to be true, and that I have been warned that willful false statements and the like are punishable by fine

or imprisonment, or both (18 U.S.C. § 1001), and may jeopardize the validity of respondent's registration, or any related document.



PETER BASSANO

Date: *October 24, 2003*



THE  
BURKE REHABILITATION  
HOSPITAL

RENEWING  
HOPE

REBUILDING  
LIVES

RESTORING  
INDEPENDENCE™

The Burke Rehabilitation Hospital is situated on a magnificent 60-acre campus in White Plains, New York. Established in 1915, our 150-bed, not-for-profit institution is among the most highly regarded rehabilitation centers in the entire world. Every one of Burke's medical and rehabilitative professionals is dedicated to renewing a patient's independence and self-confidence, and to restoring the maximum level of functioning possible. In addition to a beautiful park-like setting, Burke offers numerous amenities for both patient and family.

- Movies
- Library
- Picnics
- In-room TV
- Newspapers
- Art Exhibits
- Internet Access
- Audio & Video Tapes
- Hairdresser
- Lounges
- Washer/Dryer
- Gift Shop
- Chaplain & Religious Services



THE BURKE REHABILITATION HOSPITAL  
785 Mamaroneck Ave. White Plains, NY 10605  
1-888-99-BURKE or [www.burke.org](http://www.burke.org)

For directions, call 914-597-2500 Ext. 3860

RECOVERING FROM  
A HEAD OR  
SPINAL CORD INJURY

WHAT  
HAPPENS  
NEXT?





December 9, 2002

Spalding Rehabilitation Hospital  
900 Potomac Street  
Aurora, Colorado 80011  
Attn: Cindy Mansfield, CEO

Dear Ms. Mansfield:

We represent The Burke Rehabilitation Hospital ("Burke").

Burke has long owned, used and registered the servicemark "RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE" for services in the United States. Burke owns the U.S. servicemark registration No.2,102,922 for the aforementioned servicemark, a copy of which is enclosed for your reference.

Burke has learned that you are using substantially similar language ("Rebuilding Lives, Renewing Hope.") in your promotional materials for rehabilitation services at your hospital. Your use of language in connection with your delivery of rehabilitation services is likely to cause confusion, mistake and deception, to dilute the distinctiveness of Burke's "RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE" servicemark and lead customers to believe that your services emanate from the same source as Burke's services or are otherwise sponsored by or affiliated with Burke.

Accordingly, we request your prompt assurance that you will cease all use of the language "Rebuilding Lives, Renewing Hope," or any similar derivation thereof.

We look forward to your response to this letter and a prompt, amicable resolution of this matter.

Very truly yours,

Peter Bassano

PB/db



Enclosures

cc: HCA-HealthOne LL.  
Spalding Rehabilitation.

an opportunity  
your letter of December  
concerning its use of the tag

Our investigation reveals that Spalding  
as early as June of 1990, which is almost four (4) years  
Rehabilitation Hospital ("Burke") began using the  
Lives, Restoring Independence." Spalding's use of  
client's application to register this mark with the  
1996). Therefore, it appears as if Spalding has  
enclose a few examples of Spalding's use of the

Since Burke has asserted that the parties  
it appears that Spalding has prior use, we have  
registration with the Trademark Trial and  
attached hereto for your review. However,  
Cancel, our client would be willing to negotiate  
allow the parties to continue use of their  
earliest convenience if your client is in