

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

\_\_\_\_\_) )  
) )  
HCA-HEALTHONE LLC ) )  
) )  
PETITIONER ) )  
) )  
v. ) )  
) )  
WINIFRED MASTERSON BURKE ) )  
REHABILITATION HOSPITAL, INC. ) )  
) )  
RESPONDENT ) )  
\_\_\_\_\_)

Reg. No. 2102922

Cancellation No. 92042004



11-19-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

CERTIFICATE OF MAILING  
BY EXPRESS MAIL PURSUANT TO 37 C.F.R. § 1.10  
TO THE UNDERSIGNED CERTIFIES THAT HE/SHE IS  
MAILING THIS MATERIAL BY EXPRESS MAIL  
(LABEL NUMBER EL 800659695 45)  
ADDRESSED TO COMMISSIONER OF TRADEMARKS, 2900 CRYSTAL DRIVE,  
ARLINGTON, VIRGINIA 22202-3513, ON THIS 19th DAY  
OF November, 2003.

*Jr. Bracy*

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**MOTION TO REQUIRE RESPONDENT  
TO RESPOND TO DISCOVERY**

Petitioner, HCA-HealthOne LLC (hereinafter "HCA,"), hereby moves this Board, pursuant to 35 C.F.R. §2.116 and Fed. R. Civ. P. 56(f), to enter an Order requiring Respondent to respond to the discovery requests tendered on September 30, 2003 before requiring Petitioner to fully respond to the Motion for Summary Judgment served on October 24, 2003. In support of said Motion, CHA states as follows:

On December 9, 2002, the Respondent, Winifred Masterson Burke Rehabilitation Hospital, Inc., presented Petitioner, through one of its related entities, Spalding

Rehabilitation Hospital, with a cease and desist letter asserting that Petitioner's mark, "REBUILDING LIVES, RESTORING INDEPENDENCE," was substantially similar to Respondent's own mark, "RENEWING HOPE, REBUILDING LIVES, RESOTRING INDEPENDENCE," and likely to cause confusion among customers. While investigating Respondent's claims, Petitioner discovered that it had prior use of the mark as between the two parties. HCA filed the Petition for Cancellation which initiated this proceeding on March 19, 2003. The Petition states that the Challenged Mark, "RENEWING HOPE, REBUILDING LIVES, RESTORING INDEPENDENCE," is likely to cause consumer confusion with the Petitioner's own mark, "REBUILDING LIVES, RENEWING HOPE" and is likely to cause dilution of said mark. At the time of the filing of the Petition, Respondent, Winifred Masterson Burke Rehabilitation Hospital, Inc., had not filed a Section 8 or Section 15 Declaration with respect to the Challenged Mark. Even though registration issued on October 17, 1997, Respondent did not file a Section 8 Declaration with the United States Patent and Trademark Office until July 21, 2003, which was four months *after* Plaintiff filed its Petition to Cancel. Prior to that time, Respondent tendered discovery requests to the Petitioner which sought information relating to the use of Petitioner's own mark and the basis for the Petition to Cancel. Petitioner served its responses to Respondent's requests on August 25, 2003. On September 30, 2003, well before the December 7, 2003 discovery deadline in this case, Petitioner tendered its own set of interrogatories, request for production and request for admission to Respondent requesting information relating to Respondent's use of Respondent's mark *and* information about when Respondent learned of Petitioner's mark.

To date, Respondent has not answered the discovery requests; instead, Respondent filed a Motion for Summary Judgment arguing that the Petition to Cancel should be dismissed since it was filed five years after the date registration issued. The information requested is solely within the province of Respondent's records, and Petitioner submits this information is necessary in order to allow it to fully respond to the Motion for Summary Judgment and determine if any additional bases for cancellation exist.

It is essential that Petitioner has the information requested in the discovery requests before Petitioner can fully respond to the Motion for Summary Judgment. The requests seek information relating to first and subsequent use of Respondent's mark. Without that information, Petitioner cannot fully prosecute the Petition to Cancel or respond to the Motion for Summary Judgment. The information requested is exclusively within Respondent's control, and it would prejudice the Petitioner to require it to fully respond to the Motion for Summary Judgment without the opportunity for discovery on the issues relevant to this case. Petitioner submits that summary judgment is not appropriate as a question of material fact remains as to whether Respondent is estopped from relying on the five-year limitations period under these circumstances.

Petitioner has used its mark since at least as early as June 1990. Respondent did not issue its cease and desist letter until December 9, 2002, some twelve years later. HCA filed the Petition for Cancellation which initiated this proceeding on March 19, 2003. Respondent did not file its Section 8 affidavit until July 21, 2003. In fact, before Respondent filed its Section 8 affidavit, it tendered discovery requests to the Petitioner which sought information relating to the use of Petitioner's own mark and the basis for

the Petition to Cancel. Petitioner served its responses to Respondent's requests on August 25, 2003. Only after Petitioner's own prior use was documented in its answers to the discovery responses did Respondent seek to dismiss this proceeding on a technicality.

Additionally, this information is necessary to determine whether any additional bases for cancellation exist, noting abandonment can be asserted as a basis for cancellation at anytime. 15 U. S. C. §1064(3).

The discovery requests which were tendered to Respondent specifically address the issues set forth in the Petition and whether Respondent should be estopped from asserting the five-year limitations defense in this situation.

Interrogatory Nos. 1, 2, 3, 4, 5, 6 and 11 and Request for Production Nos. 2, 3, 4, 5, 6, 7, 8, 9, 21, 22, 23, 26, 28 and 29 request information regarding Respondent's first and subsequent use of Respondent's mark. The requested information is necessary to establish a record in this case regarding Respondent's use of its mark and to determine whether it was abandoned at any time. It is also important to establish whether any other ground exists which would undermine the validity of the registration of Respondent's mark.

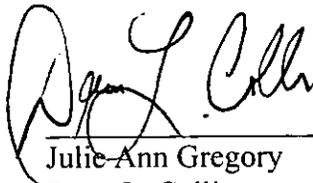
Interrogatory Nos. 9, 10, 12, 13 and 16 and Request for Production Nos. 10, 11, 12, 13, 14, 15, 16, 19, 20, 28 and 29 request information relating to when Respondent first learned of Petitioner's mark and information pertaining to the use of Petitioner's mark in relation to Respondent's mark. This information is totally within the province of the Respondent and is necessary to determine when Respondent became aware of Petitioner's mark and what action it did or did not take to protect its mark over the ensuing years and whether or not Respondent should be estopped from asserting the

arguments set forth in its Motion for Summary Judgment based upon the circumstances in this case.

Petitioner filed timely discovery requests which asked for relevant information which is necessary for a fair and equitable decision to be rendered in this case. A party should not be allowed to defeat the discovery process simply by filing a motion for summary judgment requesting relief on a technicality. There are factual issues in this case which must be determined, and Petitioner must be allowed to discover the proof necessary to its claims. A decision as to whether or not to render summary judgment in a case is inappropriate prior to allowing the parties adequate time for discovery. *Dunkin' Donuts of Am. Inc. v. Metallurgical Exoprodu. Corp.*, 840 F.2d 917 (Fed. Cir. 1988).

For the foregoing reasons, and those set forth in the attached affidavit, this Board should require Respondent to respond to the discovery requests set forth in the attached Order prior to requiring Petitioner to fully respond to the Motion for Summary Judgment. Petitioner also requests that this Board reset the deadline for responding to the Motion for Summary Judgment.

Respectfully submitted,

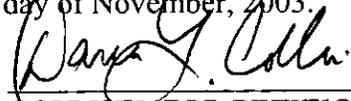


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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was served on Leo Zucker, Esq., Law Office of Leo Zucker, 50 Main Street, Suite 480, White Plains, NY 10606-1964, Counsel for Respondent, on this 19<sup>th</sup> day of November, 2003.



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COUNSEL FOR PETITIONER

TTAB



November 19, 2003

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11-19-2003  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

**Re: Mark: RENEWING HOPE, REBUILDING LIVES,  
RESTORING INDEPENDENCE**  
**Reg. No.: 2,102,922**  
**Cancellation No.: 92042004**

Dear Commissioner:

Enclosed herewith for filing are:

1. Motion to Require Respondent to Respond to Discovery;
2. Affidavit of Julie Ann Gregory;
3. Proposed Order;
4. Certificate of Express Mail under 37 C.F.R. §1.10; and
5. A return postcard.

Please return the postcard to indicate your receipt of the above-referenced materials.  
Thank you for your assistance in this matter.

Very truly yours,

MIDDLETON REUTLINGER

Dana L. Collins

DLC/jb  
Enclosures  
cc: HCA-HealthONE LLC