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

### Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

#### Petitioner Information

Name	Tandem Management Co., LLC		
Entity	Limited Liability Company	Citizenship	New Jersey
Address	433 Hackensack Avenue Suite 1200 Hackensack, NJ 07601 UNITED STATES		

Attorney information	Susan Okin Goldsmith Duane Morris LLP 744 Broad St Suite 1200 Newark, NJ 07102 UNITED STATES sogoldsmith@duanemorris.com Phone:973-424-2064		
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#### Registrations Subject to Cancellation

Registration No	2250226	Registration date	06/01/1999
Registrant	TANDEM HEALTH CARE, INC. 800 CONCOURSE PKWY S. STE. 200 MAITLAND, FL 32751 UNITED STATES		
Goods/Services Subject to Cancellation	Class 042. First Use: 1998/09/01 , First Use In Commerce: 1998/09/01 Goods/Services: nursing homes; providing assisted living facilities; providing at home healthcare		

Grounds for Cancellation	The registration was obtained fraudulently.		
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Registration No	2526933	Registration date	01/08/2002
Registrant	TANDEM HEALTH CARE, INC. Cherrington Corporate Center 200 Corporate Center Drive, Suite 360 Moon Township, PA 15108 UNITED STATES		
Goods/Services Subject to Cancellation	Class 042. First Use: 1998/07/31 , First Use In Commerce: 1998/07/31 Goods/Services: NURSING HOMES; PROVIDING ASSISTED LIVING FACILITIES; PROVIDING AT HOME HEALTHCARE		

Related Proceedings	TANDEM HEALTH CARE, INC. v. TANDEM MANAGEMENT CO., LLC, Civil Action No. 05-3960 (DRD), United States District Court for the District of New Jersey		
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Attachments	Tandem cancellation petition.pdf ( 5 pages )		
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Signature	/Susan Goldsmith/		
Name	Susan Okin Goldsmith		

Date	03/06/2006
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 2,250,226  
Registered: June 1, 1999  
Mark: TANDEM HEALTH CARE

In re Registration No. 2,526,933  
Registered: January 8, 2002  
Mark: TANDEM and DESIGN

TANDEM MANAGEMENT CO., LLC	X	
	:	
	:	
v.	:	Petitioner,
	:	
TANDEM HEALTH CARE, INC.	:	
	:	
	:	Registrant.
	X	

**PETITION FOR CANCELLATION**

Tandem Management Co., LLC ("Petitioner"), believes that it is and will be damaged by the continued registration on the Principal Register of the mark TANDEM HEALTH CARE, as shown in Registration No. 2,250,226 issued on June 1, 1999 (the "Word Mark"), and of the mark TANDEM and DESIGN, as shown in Registration No. 2,526,933 issued on January 8, 2002 (the "Design Mark"), to Tandem Health Care, Inc. ("Registrant"), and hereby petitions for cancellation of the same, pursuant to Section 24 of the Trademark Act, 15 U.S.C. § 1064.

As grounds therefor, Petitioner alleges as follows:

## **THE WORD MARK**

1. On June 1, 1999, Registrant obtained a registration on the Principal Register for the Word Mark for "nursing homes; providing assisted living facilities; providing at home healthcare," in International Class 42.

2. The application to register the Word Mark had initially been filed under 15 U.S.C. § 1051(b), on the basis of intent-to-use. A Notice of Allowance was issued for the Word Mark on May 26, 1998, covering those same services as specified in the application for registration, namely, "nursing homes; providing assisted living facilities; providing at home healthcare."

3. Registrant's Statement of Use of the Word Mark, filed on or about January 14, 1999 under 37 C.F.R. § 2.88, which was duly accompanied by a Declaration and was signed by Lawrence R. Deering, Chairman and CEO of the Registrant, asserted the Word Mark was first used in commerce on September 1, 1998, and did not request deletion of any of the services identified in the Notice of Allowance.

4. On information and belief, the Word Mark was not in use in commerce in connection with all services identified in the Notice of Allowance at the time the Statement of Use and accompanying Declaration was signed and filed; specifically, at the time of filing the Statement of Use and Declaration, Registrant was not "providing at home healthcare" services.

5. The Registrant filed the Statement of Use and Declaration and thereby obtained registration without making use of the Word Mark in commerce on or in connection with all services specified in the Notice of Allowance, as required by 37 C.F.R. § 2.88(c).

6. The Registrant's representative, its Chairman and C.E.O., knew or should have known at the time the Statement of Use and Declaration was signed and filed that Registrant was

not actually using the Word Mark in commerce in connection with all services claimed, and that the Statement of Use and Declaration were therefore false.

7. On December 17, 2004, Registrant submitted a Combined Declaration of Use and Incontestability under Trademark Act Sections 8 and 15 (15 U.S.C. §§ 1058 and 1065) (the "Combined Declaration") with respect to the Word Mark. Again, the Combined Declaration was signed by the Registrant's representative, Mr. Deering. It said, "the owner is using or is using through a related company or licensee the mark in commerce on or in connection with all goods and/or services listed in the existing registration."

8. On information and belief, the Word Mark was not used in connection with "providing at home healthcare" services at the time the Combined Declaration was signed and filed.

9. On information and belief, the Word Mark has never been used to provide "at home healthcare" services.

10. The Registrant's Representative knew or should have known at the time the Combined Declaration was signed and filed that Registrant was not actually making use of the Word Mark in commerce in connection with all services claimed, and that the Combined Declaration was therefore false.

### **THE DESIGN MARK**

11. On January 8, 2002, Registrant obtained a registration on the Principal Register for the Design Mark for "nursing homes; providing assisted living facilities; providing at home healthcare" in International Class 42.

12. The application to register the Design Mark was filed on May 12, 2000 and included a Statement of Use and Declaration signed by a representative of the Registrant, Carla

Naegele, its Vice President for Marketing. The application claimed a date of first use, and first use in commerce, at least as early as July 31, 1998.

13. On information and belief, Registrant was not using the Design Mark in connection with all services claimed as early as July 31, 1998, and was not using the Design Mark in connection with all services claimed at the time of filing; specifically, on information and belief, Registrant was not “providing at home healthcare” services.

14. Registrant’s representative, its Vice President for Marketing, knew or should have known at the time the application for registration of the Design Mark was signed and filed that the Registrant was not actually using the Design Mark in commerce in connection with all services claimed, and that the application was therefore false.

15. Furthermore, in a response to an Office Action issued in connection with the application to register the Design Mark, the Registrant distinguished its own services by stating that it “provides nursing home and in home healthcare” while the other party did not provide those services.

16. On information and belief, the Design Mark has never been used to provide “at home healthcare” services.

17. False statements with regard to use of the Design Mark constitute fraud in the securing of the registration of a federal trademark and are grounds for the cancellation thereof pursuant to 15 U.S.C. § 1064.

#### **AS TO BOTH THE WORD MARK AND THE DESIGN MARK**

18. The Word Mark was registered and has been maintained by the use of false statements, and should therefore be subject to cancellation on the basis of fraud pursuant to 15 U.S.C. § 1064(3).

19. The Design Mark was registered through the use of false statements, and should therefore be subject to cancellation on the basis of fraud pursuant to 15 U.S.C. § 1064(3).

20. The Petitioner believes that it has been and will continue to be damaged by the subject registrations because the Registrant has asserted its registrations of the Word Mark and the Design Mark in civil litigation against the Petitioner, which action is captioned TANDEM HEALTH CARE, INC. v. TANDEM MANAGEMENT CO., LLC, Civil Action No. 05-3960 (DRD), brought in the United States District Court for the District of New Jersey (the “Civil Action”).

21. The Petitioner has asserted, by way of counterclaim in the Civil Action, that the registration of the Word Mark and the Design Mark should each be cancelled pursuant to 15 U.S.C. §1119 and 15 U.S.C. §1064.

WHEREFORE, Petitioner respectfully requests that Registration No. 2,250,226 and Registration No. 2,526,933 be canceled.

Respectfully submitted,

DUANE MORRIS LLP

Dated: March 6, 2006

By:           /Susan Goldsmith/            
Susan Okin Goldsmith  
Gregory R. Haworth

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Tandem Management Co.

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