

Exhibits

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

MEDSOLUTIONS, INC.,)
)
Opposer,)
)
v.)
)
MEDSOLUTIONS, INC.,)
)
Applicant.)



Opposition No _____

Serial No.: 78/086,674
Filed: October 3, 2001
Mark: MEDSOLUTIONS
Services: Financial services, namely money lending to students to finance education in the health professions, and debt management counseling services related thereto (International Class 36)
Published: March 19, 2002

NOTICE OF OPPOSITION

Opposer MedSolutions, Inc., a Tennessee corporation having its principal business address at 730 Cool Springs Blvd., Suite 800, Franklin, Tennessee 37067 ("MedSolutions"), believes that it will be damaged by the registration of the mark identified in the above-referenced application and hereby opposes the grant of such registration.

As grounds for its opposition, MedSolutions alleges that:

1. MedSolutions and its predecessors have, since at least December 1, 1996, used the service mark MEDSOLUTIONS on or in connection with medical services,

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U.S. EXPRESS MAIL NO. EL027844500US
DATE MAILED: April 17, 2002

Contents: Cover Letter; Notice of Opposition to Registration of MEDSOLUTIONS (76/086,674) (in duplicate); Check for \$300.00

managed health care services and related services (collectively, the "MedSolutions Services"). MedSolutions is submitting herewith, as part hereof and marked as collective Exhibit A, information regarding the services provided by MedSolutions under its MEDSOLUTIONS mark (the "MedSolutions Mark").

2. MedSolutions is the owner by assignment of U.S. Registration No. 2,120,625, issued by the United States Patent and Trademark Office on December 9, 1997, for the mark MEDSOLUTIONS for "medical services and managed health care services" in International Class 42. A copy of this registration and the assignment of this mark and registration from predecessor National Imaging Affiliates, Inc. to MedSolutions are attached hereto as collective Exhibit B.

3. The applicant is a business named MedSolutions, Inc. which, on information and belief, is a Nebraska corporation incorporated on March 12, 2001, with principal offices at P.O. Box 25366, Tempe, Arizona 85285 ("Applicant"). Applicant filed, on October 3, 2001, an application to register the service mark MEDSOLUTIONS (the "Applicant Mark") for "financial services, namely money lending to students to finance education in the health professions, and debt management counseling services related thereto" (the "Applicant Services") in International Class 36, as evidenced by the publication of said mark in the Official Gazette of the United States Patent and Trademark Office on Page TM 607 of the March 19, 2002 issue. A copy of such publication is attached hereto as Exhibit C. MedSolutions is submitting herewith, as part hereof and marked as collective Exhibit D, information regarding the services provided by Applicant under the Applicant Mark.

4. There is no issue of priority. MedSolutions began using the MedSolutions Mark in commerce on or in connection with the MedSolutions Services at least as early as December 1, 1996. Applicant's application indicates that Applicant first used the Applicant Mark on or in connection with the Applicant Services on April 1, 2001. Accordingly, Applicant's date of first use is subsequent to MedSolutions' date of first use.

5. MedSolutions and its predecessors in title have offered the MedSolutions Services under the MedSolutions Mark throughout the United States.

6. MedSolutions made demand upon Applicant by a telephone call in June 2001, approximately three (3) months prior to Applicant's filing of its application to register the Applicant Mark. Accordingly, prior to the filing of its application, Applicant had actual notice of MedSolutions' federal trademark registration.

7. The Applicant Mark is identical to the previously used MedSolutions Mark and is likely, when applied to the Applicant Services to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act of 1946, as amended. Registration of the Applicant Mark will also result in the dilution of the MedSolutions Mark within the meaning of Section 43(c) of the Trademark Act of 1946, as amended. As seen in Exhibit A and Exhibit D, Applicant even displays its mark in the same form as MedSolutions, with a capitalized "M" and a capitalized "S."

8. If Applicant is permitted to use and register the Applicant Mark for the Applicant Services, confusion in trade resulting in damage and injury to MedSolutions would be caused and would result by the fact that the Applicant Mark and the MedSolutions Mark are identical. Persons familiar with the MedSolutions Mark would be likely to buy the Applicant Services as and for services sold by MedSolutions. Any such

confusion in trade inevitably would result in loss of sales to MedSolutions. Further, any defect, objection or fault found with the Applicant Services marketed under the Applicant Mark would necessarily reflect upon and seriously injure the reputation that MedSolutions has established for its services sold under the MedSolutions Mark.

9. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use of the Applicant Mark. Such registration would be a source of damage and injury to MedSolutions.

WHEREFORE, MedSolutions respectfully requests that application Serial No. 78/086,674 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of MedSolutions.

A duplicate copy of this Notice of Opposition and a check in the amount of \$300.00 constituting the filing fee for this Notice of Opposition are enclosed.

Respectfully submitted,

MEDSOLUTIONS, INC.

By: 

Robert P. Felber, Jr. (Tenn. BPR No. 10951)

Robb S. Harvey. (Tenn. BPR No. 11519)

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Dated: April 17, 2002



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04-17-2002

Patent & TMO/TM Mail Rcpt. Dt. #40

Robert P. Felber, Jr.
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April 17, 2002

VIA U.S. EXPRESS MAIL

Box TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Notice of Opposition to Registration of MEDSOLUTIONS (Serial
No. 76/086,674) (Our Ref: 008654-73637)

Dear Sir or Madam:

On behalf of MedSolutions, Inc., I enclose in duplicate a Notice of
Opposition pertaining to the application filed by MedSolutions, Inc. on October 3,
2001 for the service mark MEDSOLUTIONS which was published for opposition
on page TM 607 of the March 19, 2002 Official Gazette of the Patent and
Trademark Office. Also enclosed is a filing fee check in the amount of Three
Hundred and No/100 Dollars (\$300.00).

Should you have any questions concerning the enclosed materials, please
contact the undersigned at (615) 850-8741.

Very truly yours

[Handwritten signature of Robert P. Felber, Jr.]

Robert P. Felber, Jr.

RPF/mlc
Enclosures
cc: Ms. Jessica Riley

U.U.S. EXPRESS MAIL NO. EL027844500US

D/DATE MAILED: April 17, 2002

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