

TTAB

Our File No.: 002396.M006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WellPoint Health Networks Inc.,)
(now merged into Anthem Holding Corp.))
Opposer,)
v.) Opposition No.: 91160145
UnumProvident Corporation,)
Applicant.)

**MOTION TO SUSPEND OPPOSITION BASED ON CIVIL ACTION; MOTION TO
EXTEND DISCOVERY AND TRIAL DATES (AND RESPONSIVE DATES TO
DISCOVERY) PENDING ORDER OF SUSPENSION; AND MOTION TO RESET
DISCOVERY AND TRIAL DATES FOLLOWING SUSPENSION IF NOT OTHERWISE
RESOLVED BY CIVIL ACTION**

Opposer, by and through its undersigned attorney, respectfully requests that the Board grant Opposer's Motion to Suspend Opposition based on Opposer's having today filed a civil action in the United States District Court, Central District of California, Western District captioned Anthem Holding Corp. (in which Opposer entity WellPoint Health Networks, Inc. was recently merged) v. Unumprovident Corporation for Injunctive and Declarative Relief for Trademark Infringement, False Designation of Origin, Unfair Competition, Federal and State Trademark Dilution involving the subject matter mark herein.

Pursuant to TBMP Section 510 and 37 CFR Section 2.117, the TTAB may suspend opposition proceedings whenever the parties are engaged in a civil action having a bearing on said opposition proceedings until such time as the civil action is terminated. Pursuant to TBMP Section 510.02(a), the Board ordinarily does suspend when the issues overlap and the parties are



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identical or similar and the court proceeding will have "a bearing on the issues before the Board". See 37 CFR Section 2.117(a).

A copy of the Complaint is attached for the convenience of the Board. As can be seen, the issues of trademark infringement based on likelihood of confusion therein are based on the rights of Opposer as alleged in the Board Proceeding; the Applicant's marks which were published for Opposition, forming the basis of this and two other Oppositions, are the subject of the civil litigation.

Opposer believes that in the interest of judicial economy the Board action should be suspended in view of the injunctive relief sought therein and that issues of trademark infringement have a strict bearing on the issues of the Opposition proceeding. Further, because the Opposition proceeding has not proceeded past discovery such request is timely.

Further, Opposer requests that extensions of time, as to discovery and trial dates, be extended, including responses to discovery requests, pending a decision on the Request for Suspension. Finally, in the event that this proceeding resumes at a later date (in the unlikely event that the matter is not resolved in the civil action), Opposer requests that discovery and trial dates be then reset.

Respectfully submitted,

WellPoint Health Networks, Inc.
(now merged into Anthem Holding Corp.)



Date: October 19, 2005

Lori N. Boatright
Attorney for Opposer

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks Box TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on October 19, 2005.



Al Grossman

October 19, 2005

CERTIFICATE OF SERVICE

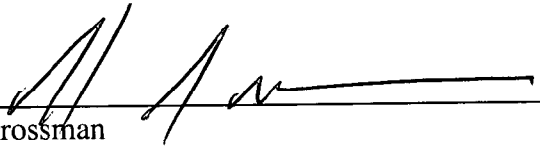
I hereby certify that a true and correct copy of the foregoing:

MOTION TO SUSPEND OPPOSITION BASED ON CIVIL ACTION; MOTION TO EXTEND DISCOVERY AND TRIAL DATES (AND RESPONSIVE DATES TO DISCOVERY) PENDING ORDER OF SUSPENSION; AND MOTION TO RESET DISCOVERY AND TRIAL DATES FOLLOWING SUSPENSION IF NOT OTHERWISE RESOLVED BY CIVIL ACTION

was served by first class mail, postage prepaid, on this day, upon Applicant's attorneys:

Mary Ellen Morris
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Date: October 19, 2005



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9 Attorneys for Plaintiff ANTHEM HOLDING CORP.

10 UNITED STATES DISTRICT COURT
11 CENTRAL DISTRICT OF CALIFORNIA
12 WESTERN DIVISION

13 ANTHEM HOLDING CORP., an Indiana) Case No:
14 corporation,)
15)
16 Plaintiff,) **COMPLAINT FOR INJUNCTIVE**
17 vs.) **AND DECLARATIVE RELIEF FOR**
18) **TRADEMARK INFRINGEMENT, FALSE**
19 UNUMPROVIDENT CORPORATION,) **DESIGNATION OF ORIGIN, UNFAIR**
20 a Delaware corporation) **COMPETITION, FEDERAL AND**
21) **STATE TRADEMARK DILUTION**
22)
23 Defendants)
24)
25)
26)
27)
28)

29 Plaintiff Anthem Holding Corp. complains as follows:

30 **PARTIES, JURISDICTION AND VENUE**

- 31 1. Plaintiff is an Indiana corporation with its
32 headquarters in Indiana and with offices in this District.
33 2. Defendant UnumProvident Corporation is a Delaware
34 corporation with its headquarters in Chattanooga, Tennessee and
35 with offices in this District.
36 3. This complaint alleges claims of trademark
37 infringement, false designation of origin and trademark dilution
38

1 arising under 15 U.S.C. §§1114 and 1125, and related state law
2 claims, of which the Court has federal question jurisdiction
3 under 28 U.S.C. §1338 (a) and (b).

4 4. The Court has personal jurisdiction over the defendant
5 and venue is proper in this district, in that defendant does
6 business in this State and district, out of which the claims
7 arise, and is found within this district.

8 **FIRST CLAIM FOR RELIEF**

9 (Federal Trademark Infringement)

10 5. Plaintiff is in the business of offering health
11 insurance, long term care insurance, life insurance and related
12 goods and services in interstate commerce throughout the United
13 States. Plaintiff is the successor in interest to WellPoint
14 Health Networks Inc. a Delaware corporation with its headquarters
15 in Thousand Oaks, California ("WellPoint Health"), by virtue of a
16 merger with Anthem, Inc., now re-named WellPoint, Inc.
17 consummated in November, 2004.

18 6. By virtue of the merger, plaintiff is the owner of the
19 inherently distinctive design mark depicted below, (hereinafter
20 "the Three-Stripe Mark") its insurance products and related goods
21 and services:



26 7. Plaintiff is the owner of the federal registration on
27 the Principal Register of the Three-Stripe Mark, for the goods
28 and services identified in the certificate of registration for

1 U.S. Reg. No. 2,665,505, copy attached as Exhibit A and
2 incorporated herein by reference. The Three-Stripe Mark has
3 typically been displayed in red.

4 8. Since adopting it in 1993, plaintiff's predecessor
5 WellPoint Health and authorized affiliates have used the Three-
6 Stripe Mark as the logo for their company image and company
7 identity and have used it in nearly all collateral and
8 promotional literature it has published. Plaintiff and
9 authorized affiliates have continued such use since the merger
10 with Anthem.

11 9. Plaintiff, its predecessor WellPoint Health, and their
12 authorized affiliates have extensively advertised, promoted and
13 sold goods and services under the Three-Stripe Mark since 1993,
14 such that the public has come to know and recognize it as
15 identifying goods and services which originate with or are
16 authorized by plaintiff.

17 10. Defendant is in the business of offering insurance
18 products competitive with or complementary to insurance products
19 and related goods and services identified under plaintiff's
20 Three-Stripe Mark, including long term care insurance, disability
21 insurance and life insurance.

22 11. Defendant has adopted the mark depicted below ("the
23 Four-Stripe Mark"), which it has been using as its corporate
24 logo, and in connection with insurance products competitive with

25 ///

26 ///

27 ///

28

1 or complementary to goods and services identified by plaintiff's
2 Three-Stripe Mark.



5
6
7 The design portion of the Four-Stripe Mark appears in red.

8
9 12. The use of the Four-Stripe Mark is likely to create
10 confusion with plaintiff's Three-Stripe Mark, such that the
11 ordinary purchaser is likely to be confused, mistaken or deceived
12 into believing that defendant's goods and services originate with
13 or are associated with, or are sponsored or authorized by
14 plaintiff.

15 13. Defendant's infringement has been willful and
16 deliberate.

17 14. Plaintiff has suffered and, if defendant is not
18 enjoined, it will continue to suffer irreparable harm from
19 defendant's use of the Four-Stripe Mark, as to which it has no
20 adequate legal remedy.

21 **SECOND CLAIM FOR RELIEF**

22 (False Designation of Origin)

23 15. Plaintiff incorporates paragraphs 1 through 14 above,
24 as though set forth at length.

25 16. Defendant's use of the Four-Stripe Mark constitutes
26 false designation of origin, sponsorship and approval of
27 defendant's goods and services sold under such mark, in violation
28 of 15 U.S.C. §1125(a) (1).

1 17. Defendant's false designation has been willful and
2 deliberate.

3 18. Plaintiff has suffered and, if defendant is not
4 enjoined, plaintiff will continue to suffer irreparable harm from
5 defendant's use of the Four-Stripe Mark, for which it has no
6 adequate legal remedy.

7 **THIRD CLAIM FOR RELIEF**

8 (Common Law Unfair Competition)

9 19. Plaintiff incorporates paragraphs 1 through 14 above,
10 as though set forth at length.

11 20. Defendants' use of the Four-Stripe Mark constitutes
12 common law unfair competition.

13 21. Plaintiff has suffered and, if defendant is not
14 enjoined, plaintiff will continue to suffer irreparable harm from
15 defendant's use of the Four-Stripe Mark, for which it has no
16 adequate legal remedy.

17 **FOURTH CLAIM FOR RELIEF**

18 (Federal Trademark Dilution)

19 22. Plaintiff incorporates paragraphs 1 through 11 above,
20 as though set forth at length.

21 23. Plaintiff, WellPoint Health and their affiliates have
22 generated annual revenue in many billions of dollars and have
23 spent proportionate amounts in advertising and promoting goods
24 and services sold under the Three-Stripe Mark, wherefore
25 wherefore it is a famous mark.

26 24. Defendant's use of the Four-Stripe Mark has caused
27 actual dilution of the distinctive quality of the Three-Stripe
28 Mark.

1 25. Defendant adopted the Four-Stripe Mark after the Three-
2 Stripe Mark became famous, with the intent to trade on the
3 reputation of plaintiff and to blur the distinctiveness of
4 plaintiff's mark.

5 26. Plaintiff has suffered and if defendant is not enjoined
6 from using the Four-Stripe mark, it will continue to suffer
7 irreparable harm, for which it has no adequate legal remedy.

8 **FIFTH CLAIM FOR RELIEF**

9 (Dilution Under California Law)

10 27. Plaintiff incorporates paragraphs 1 through 11 above,
11 as though set forth at length.

12 28. Defendant's use of the Four-Stripe Mark constitutes
13 dilution of plaintiff's Three-Stripe Mark.

14 29. Plaintiff has suffered and, if defendant is not
15 enjoined, plaintiff will continue to suffer irreparable harm from
16 defendant's use of the Four-Stripe Mark, for which plaintiff has
17 no adequate legal remedy.

18 **SIXTH CLAIM FOR RELIEF**

19 (Declaratory Judgment)

20 30. Plaintiff incorporates paragraphs 1 through 14 above, as
21 though set forth at length.

22 31. Defendant is presently the applicant for trademark
23 registration of the Four-Stripe Mark under an intent-to-use
24 application on file in the United States Patent and Trademark
25 Office. A copy of the application for the Four-Stripe Mark is
26 attached as Exhibit B. Plaintiff is also the applicant in two
27 separate intent-to-use applications before that office of a
28 design mark consisting of a virtually exact mirror-image copy of

1 plaintiff's Three-Stripe Mark. Copies of these two applications
2 are attached respectively as Exhibits C and D. These three
3 applications are all for goods and services competitive with or
4 complementary to goods and services offered by plaintiff under
5 the Three-Stripe Mark. Plaintiff has filed Oppositions to all
6 three applications.

7 32. There is now a present, active, actual and justifiable
8 controversy between the parties in that plaintiff contends that
9 defendant's intended use in commerce of its copy of the Three-
10 Stripe Mark would be likely to cause customer confusion and would
11 dilute the distinctive quality of that mark and that defendant's
12 use of the Four-Stripe Mark is likely to cause customer confusion
13 and has diluted the quality of plaintiff's mark. Defendant
14 disputes these contentions.

15 33. The parties are in need of a declaratory judgment
16 determining their respective rights and obligations with respect
17 to defendant's proposed or actual use and registration of the
18 marks identified in its applications.

19 34. Plaintiff has suffered and, if defendant is not
20 enjoined, plaintiff will continue to suffer irreparable harm from
21 defendant's proposed or actual use of the Four-Stripe Mark, for
22 which it has no adequate legal remedy.

23
24 **PRAYER FOR RELIEF**

25 WHEREFORE, Plaintiff prays that:

- 26 1. Defendant be preliminarily and permanently enjoined:
27 a) from using in commerce the Four-Stripe Mark, its
28 versions of the Three-Stripe Mark shown in its trademark

1 applications or any other mark or symbol that is confusingly
2 similar to or likely to dilute the distinctive quality of
3 plaintiff's Three-Stripe Mark;

4 b. from pursuing any applications for trademark
5 registration of the Four-Stripe Mark and its versions of the
6 Three-Stripe Mark;

7 2. Plaintiff be awarded its attorneys' fees and expenses
8 pursuant to 15 U.S.C. §1117(a),

9 3. Plaintiff be awarded its costs, and;

10 4. The Court grant such other relief as it deems proper.

11
12 Respectfully submitted,

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14 Dated: October __, 2005

15 _____
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