

ESTTA Tracking number: **ESTTA63322**

Filing date: **01/24/2006**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Focused Health Solutions, Inc.
Granted to Date of previous extension	01/25/2006
Address	1000 Sunset Ridge Road Suite 200 Northbrook, IL 60062 UNITED STATES

Attorney information	Anthony R. Masiello Holland & Knight LLP 2099 Pennsylvania Avenue, N.W. Washington, DC 20006 UNITED STATES anthony.masiello@hkllaw.com Phone:(202) 419-2405
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### Applicant Information

Application No	78156540	Publication date	09/27/2005
Opposition Filing Date	01/24/2006	Opposition Period Ends	01/25/2006
Applicant	Health Solutions of Morton, LLC 11 Currency Drive Suite 201 Bloomington, IL 61704 UNITED STATES		

### Goods/Services Affected by Opposition

Class 044. First Use: 2002/02/01 First Use In Commerce: 2002/02/01 All goods and services in the class are opposed, namely: Chiropractic Services
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Attachments	health__Jan_24_2006_14_49_38_129.pdf ( 5 pages )
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Signature	/anthony masiello/
Name	Anthony R. Masiello
Date	01/24/2006

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

FOCUSED HEALTH SOLUTIONS, INC.	)	
	)	
Opposer	)	
	)	
v.	)	Opp. No. _____
	)	
HEALTH SOLUTIONS OF MORTON, LLC	)	(Serial No. 78/156,540)
	)	
Applicant	)	
_____	)	

**NOTICE OF OPPOSITION**

Focused Health Solutions, Inc. ("Opposer"), a corporation organized and existing under the laws of the State of Illinois, with its principal place of business located at 1000 Sunset Ridge Road, Suite 200, Northbrook, Illinois 60062, believes that it will be damaged by the registration of the mark claimed in Application Serial No. 78/156,540 (the "Application") of Health Solutions of Morton, LLC ("Applicant"), an Illinois limited liability corporation, of 11 Currency Drive, Suite 201, Bloomington, Illinois 61704, filed on August 21, 2002 and published in the Official Gazette of September 27, 2005, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

On October 24, 2005, Opposer timely filed a request for a ninety (90) day extension of time to oppose the subject application, which was granted by the Trademark Trial and Appeal Board on that same day (expiring January 25, 2006).

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the trademark and service mark FOCUSED HEALTH SOLUTIONS, which Opposer has used since at least as early as August 1, 2001 in connection with providing health care information and counseling in the field of chronic health conditions.
  
2. Opposer is the owner of U.S. Registration No. 2,929,979 for the mark FOCUSED HEALTH SOLUTIONS, which registration issued on March 8, 2005 and is valid and subsisting.

3. Opposer is the owner of U.S. Registration No. 2,932,412 for the mark FOCUSED HEALTH SOLUTIONS (AND DESIGN), which registration issued on March 15, 2005 and is valid and subsisting.

4. Opposer provides health care information and counseling services to employers and other organizations having members or employees that require management of chronic conditions. Opposer coordinates its services with those of the patients' other health care providers such as physicians, mental health providers and chiropractors. In connection with the advertising and provision of such services, Opposer displays its mark FOCUSED HEALTH SOLUTIONS.

5. As a result of Opposer's use, advertising, and promotion of the FOCUSED HEALTH SOLUTIONS mark, it has become well-known as a distinctive indicator of the origin of Opposer's services and the mark has acquired a highly favorable reputation among members of the public and has become a valuable symbol of Opposer's goodwill.

6. Notwithstanding Opposer's prior rights in the FOCUSED HEALTH SOLUTIONS mark, on August 21, 2002, Applicant filed the Application in the United States Patent and Trademark Office for registration of the mark HEALTH SOLUTIONS ("Applicant's Mark") for "chiropractic services" ("Applicant's Services").

7. In the Application, the Applicant claimed that it first used the HEALTH SOLUTIONS mark on February 1, 2002, and claimed it first used the mark in regulable commerce on February 1, 2002.

8. On information and belief, Applicant made no use of Applicant's Mark in connection with any services prior to 2002.

9. Opposer has used, advertised and promoted in interstate commerce its FOCUSED HEALTH SOLUTIONS mark from a date long prior to the filing date of the Application and long prior to any use by Applicant of Applicant's Mark.

**COUNT I**  
**Likelihood of Confusion - §2(d)**

10. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 9, above, as if set forth in their entirety herein.

11. The Applicant's Mark so closely resembles the Opposer's mark FOCUSED HEALTH SOLUTIONS in appearance, sound and/or meaning that the use and registration thereof by Applicant are likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Services and will injure and damage

Opposer and the goodwill and reputation symbolized by Opposer's FOCUSED HEALTH SOLUTIONS mark.

12. Applicant's Services offered by reference to Applicant's Mark are so closely related to Opposer's services in providing health care information and counseling under the FOCUSED HEALTH SOLUTIONS mark, that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's Services are those of Opposer or that Applicant is in some way connected with or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage and injury.

13. Likelihood of confusion and deception is enhanced by the fact that Opposer's services offered under the FOCUSED HEALTH SOLUTIONS mark are provided or intended to be provided to the same classes of prospective customers as are Applicant's Services.

14. Under the circumstances, registration and use of Applicant's Mark is likely to cause Opposer to lose control over the good and valuable reputation represented by and derived from the FOCUSED HEALTH SOLUTIONS mark.

15. Registration of Applicant's Mark in light of the prior rights of Opposer in the FOCUSED HEALTH SOLUTIONS mark is therefore likely to cause confusion, mistake and/or deception among members of the relevant purchasing public resulting in damage and injury to Opposer in violation of the provisions of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

## **COUNT II**

### **Mere Descriptiveness - §2(e)(1)**

16. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 15, above, as if set forth in their entirety herein.

17. On information and belief, the word HEALTH is a generic word with respect to chiropractic services and as such is incapable of functioning as a trademark for any business in the field of chiropractic services.

18. The word HEALTH is not registrable under the Lanham Act, 15 U.S.C. §1051 et seq., under any circumstances in connection with health services, including chiropractic services.

19. On information and belief, the phrases "health solutions" and "health solution" are descriptive terminology with respect to health-related goods and services and are widely used in ordinary speech and in commercial speech with respect to health-related issues.

20. The phrase HEALTH SOLUTIONS is merely descriptive of chiropractic services, within the meaning of Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).
21. In accordance with 15 U.S.C. Section 1052(e)(1), the phrase HEALTH SOLUTIONS is not registrable as a service mark for chiropractic services unless it is demonstrated that the phrase has become distinctive of the applicant's services in commerce that may be regulated by the United States Congress, within the meaning of Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f).
22. On information and belief, the U.S. Patent and Trademark Office has determined on numerous occasions that the phrase HEALTH SOLUTIONS is merely descriptive with respect to health-related services and that it is an unregistrable component of a mark within the meaning of 15 U.S.C. Section 1056, and has regularly required applicants to disclaim the exclusive right to use HEALTH SOLUTIONS with respect to health-related services.
23. On information and belief, during the examination of the Application, Applicant offered no demonstration that Applicant's Mark had become distinctive of the Applicant's Services in commerce of any kind.
24. On information and belief, Applicant's Mark has not become distinctive of the Applicant's Services in commerce of any kind.
25. Under the circumstances, registration of Applicant's Mark will damage Opposer and other businesses that use the designations HEALTH SOLUTIONS or HEALTH SOLUTION as a component of their marks, by improperly ascribing to Applicant purportedly exclusive rights over ordinary English terminology that is in widespread commercial use in the field of health-related goods and services.
26. In light of the widespread descriptive use of the terminology "health solutions" and "health solution" in commerce relating to health-related goods and services, registration of Applicant's Mark would violate the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

WHEREFORE, Opposer prays that this opposition be sustained and that registration of Applicant's Mark be denied.

The required fee of \$300.00 has been provided. Any additional charges should be made to the Deposit Account of Holland & Knight LLP, Account No. 50-1542.

Respectfully submitted.

FOCUSED HEALTH SOLUTIONS, INC.

Date: January 24, 2006

By: 

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