

ESTTA Tracking number: **ESTTA268652**Filing date: **02/25/2009**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	WageWorks, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1100 Park Place, 4th Floor San Mateo, CA 94403 UNITED STATES		
Attorney information	Deborah A. Wilcox, Melinda M. Lothes Baker & Hostetler LLP 1900 East 9th Street #3200 Cleveland, OH 44114 UNITED STATES clevelandip@bakerlaw.com,mlothes@bakerlaw.com Phone:216.621.0200		

Applicant Information

Application No	77452423	Publication date	02/24/2009
Opposition Filing Date	02/25/2009	Opposition Period Ends	03/26/2009
Applicant	Take Care Health Systems, LLC Suite 1400 Eight Tower Bridge 161 Washington Street Conshohocken, PA 19428 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. All goods and services in the class are opposed, namely: Managed health care services, namely, providing medical and pharmaceutical consultation, performing diagnosis and treatment of diseases, medical testing, and providing health care information by phone and the internet; medical clinics; home health care services; and mobile health care centers
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2872858	Application Date	05/15/2003
Registration Date	08/10/2004	Foreign Priority Date	NONE
Word Mark	TAKE CARE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 2004/01/15 First Use In Commerce: 2004/01/15 Magnetically encoded debit cards Class 036. First use: First Use: 2004/01/15 First Use In Commerce: 2004/01/15 Debit account services featuring magnetically encoded debit cards; financial services rendered through a transaction card in connection with the purchase of health care goods and services; health care benefit plan administration; medical savings accounts and flexible spending accounts administration
Related Proceedings	Opposition Nos. 91167509 (parent), 91167533, 91167571, 91174378, 91187450, 91187475, 91187476, 91187481, 91187484, 91188835; Cancellation No. 92050197
Attachments	Take Care Tour NoticeOpp.pdf (6 pages)(27400 bytes) TAKE CARE 2872858.pdf (3 pages)(14647 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/mml/
Name	Melinda M. Lothes
Date	02/25/2009

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Application Serial No. 77/452,423
Published In The *Official Gazette*, February 24, 2009

_____)	
WageWorks, Inc.)	Opposition No. _____
)	
)	
Opposer,)	
)	
v.)	NOTICE OF OPPOSITION
)	
Take Care Health Systems, LLC)	
)	
Applicant.)	
_____)	

WageWorks, Inc., a Delaware corporation with its principal place of business at 1100 Park Place, 4th Floor, San Mateo, California 94403 (“WageWorks”), believes that it will be damaged by the registration of the mark covered by Application Serial No. 77/452,423 and hereby opposes the registration of said mark. As grounds for the opposition it is alleged as follows:

1. Applicant seeks to register TAKE CARE TOUR as a service mark for “Managed health care services, namely, providing medical and pharmaceutical consultation, performing diagnosis and treatment of diseases, medical testing, and providing health care information by phone and the internet; medical clinics; home health care services; and mobile health care centers” in International Class 44. The filing date of Applicant’s intent-to-use application is April 18, 2008.

2. WageWorks is a leader in the tax-advantaged benefits industry. Founded in 2000, WageWorks helps employers support consumer directed pre-tax benefit programs, including

health care (Flexible Spending Accounts (FSA), Health Savings Accounts (HAS), Health Reimbursement Arrangements (HRA)), wellness programs, child and elder care, commuting services, education benefits, and employee sponsored programs such as gym reimbursement. WageWorks has more than 1.2 million participants representing over 2,000 clients. More than 100 of America's Fortune 500 employers and millions of their benefits-eligible employees use WageWorks' programs, making WageWorks the nation's leading provider of tax-advantaged health, wellness, commuting, child and elder care benefits and retiree services for Fortune 500 companies. In 2005, 2006 and 2007, WageWorks was named to Inc. magazine's prestigious annual list of America's 500 fastest growing private companies. Also in 2007, WageWorks was named to Deloitte & Touche USA LLP's prestigious Technology Fast 50 Program for Silicon Valley, a ranking of the fastest growing technology, media, telecommunications, and life sciences companies in the region.

3. In 2007, WageWorks acquired MHM Resources, Inc. (now MHM Resources, LLC) ("MHM"). For nearly two decades, MHM has been an end-to-end provider of cutting-edge consumer-driven flexible benefits technology, support systems and advisory services to health insurance carriers, administrators, third-party administrators, payroll providers, financial institutions, employers and consumers. Since 1986, MHM has partnered with more than 1,000 third-party administrators and 35 insurance carriers, who have looked to MHM as their "single-source" provider of marketing support, transactional technology and flexible benefits plan services for various account types.

4. WageWorks, through its subsidiary MHM, has adopted and is using the mark TAKE CARE® in connection with breakthrough consumer-driven flexible benefits plan administration and debit card services in the health care industry.

5. The TAKE CARE® plan is an all-in-one flexible benefits plan administration system that handles all consumer-driven accounts types such as an FSA and HRA, among others. It is a totally integrated flex administration system for administrators, enabling administrators to operate with ease and flexibility. Further, under the TAKE CARE® plan employers can manage their specific plans, plan benefit, limits and eligible expenses, and employees can check account balances, track transactions, obtain payroll contribution reports, view and change elections and make claims.

6. In January 2003, over 1,000 participants enrolled in the initial phase of the TAKE CARE® plan. On or about January 15, 2004, MHM rolled out the TAKE CARE® plan and implemented the fully-integrated TAKE CARE® debit card feature. The TAKE CARE® debit card is a VISA® debit card that enables employees to use their pre-tax flex dollars towards co-pays, deductibles, insurance premiums, medical supplies, prescription drugs and other qualified flexible benefit expenses without having to turn in a receipt and then wait for reimbursement. Qualified expenses are paid by swiping the debit card at qualified locations, which are then automatically deducted from the employee's account balance. The TAKE CARE® debit card can be used at any qualified health care provider, including pharmacies, physician and dental offices and drug stores, among others, as well as certain other qualified flex providers such as transit, parking and dependent care facilities.

7. On August 10, 2004, the United States Patent and Trademark Office granted MHM Federal Registration No. 2,872,858 for the mark TAKE CARE® for “magnetically encoded debit cards” in International Class 9 and “debit account services featuring magnetically encoded debit cards; financial services rendered through a transaction card in connection with the purchase of health care goods and services; health care benefit plan administration; medical

savings accounts and flexible spending accounts administration” in International Class 36. This registration was assigned to WageWorks in 2007. Attached as Exhibit A is a true and accurate copy of the Trademark Applications and Registrations Retrieval (TARR) report for the TAKE CARE® mark.

CLAIM

8. There is no issue as to priority. The date of Applicant’s application is subsequent to the issuance of WageWorks’ registration. Notably, Applicant, a Delaware limited liability company, was formed on October 26, 2004 -- more than two months after WageWorks’ registration date.

9. Applicant’s use of the TAKE CARE TOUR mark for the services specified in the subject application is likely to cause confusion, mistake, or deception with respect to the origin of said services, and to confuse, mislead, or deceive members of the public into believing that Applicant’s services are in some way connected to or affiliated with WageWorks’ various TAKE CARE® financial, health care benefit plan administration and medical savings and flexible spending account administration services, and/or the TAKE CARE® debit card and related services. WageWorks’ goods and services are closely related to and overlap with Applicant’s services, given, among other facts, that TAKE CARE® debit card consumers can and likely will use the TAKE CARE® debit card at Applicant’s TAKE CARE drug store clinics to cover co-pays, deductibles, prescription drugs and/or other qualified expenses. It is likely that TAKE CARE® debit card consumers will be able to use the TAKE CARE® debit card at Applicant’s TAKE CARE mobile health care centers. To further compound the likelihood of confusion, Applicant is part of Walgreen Co.’s (“Walgreens”) newly created Health and Wellness division, which includes Take Care Employer Solutions, managers of worksite-based health and wellness

services. Walgreens' Health and Wellness division was created to marry Applicant's TAKE CARE store clinics with worksite health centers. It is likely that such health centers will be located at the worksites of WageWorks' TAKE CARE® customers. Pursuant to a January 14, 2009 press release issued by Walgreens, one of Walgreens' key initiatives is to enhance the company's leadership as a service provider to managed care organizations and employers. Thus, the likelihood of confusion will increase exponentially as Walgreens carries out this initiative.

10. Any such confusion would result in injury to or have a direct impact on WageWorks and its TAKE CARE® mark. Any defect, objection, or fault found with Applicant's services marketed under the TAKE CARE TOUR mark would negatively impact and seriously injure the reputation WageWorks (and its subsidiary MHM) has established for the goods and services it provides under the TAKE CARE® mark.

11. If Applicant is granted the registration herein opposed, it would be a source of damage and irreparable injury to WageWorks.

WHEREFOR, WageWorks prays that this Opposition be granted and Application Serial No. 77/452,423 be refused registration.

/Melinda M. Lothes/

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Attorneys for WageWorks, Inc.

Exhibit A

Attached.

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2009-02-10 16:33:43 ET

Serial Number: 78250381 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2872858

Mark (words only): TAKE CARE

Standard Character claim: No

Current Status: [Registered](#).

Date of Status: 2004-08-10

Filing Date: 2003-05-15

Transformed into a National Application: No

Registration Date: 2004-08-10

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 112](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-08-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [WAGEWORKS, INC.](#)

Address:

[WAGEWORKS, INC.](#)
[1100 PARK PLACE, 4TH FLOOR](#)
[SAN MATEO, CA 94403](#)
[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Delaware](#)

GOODS AND/OR SERVICES

International Class: [009](#)

Class Status: [Active](#)

[Magnetically encoded debit cards](#)

Basis: [1\(a\)](#)

First Use Date: [2004-01-15](#)

First Use in Commerce Date: [2004-01-15](#)

International Class: [036](#)

Class Status: [Active](#)

Debit account services featuring magnetically encoded debit cards; financial services rendered through a transaction card in connection with the purchase of health care goods and services; health care benefit plan administration; medical savings accounts and flexible spending accounts administration

Basis: 1(a)

First Use Date: 2004-01-15

First Use in Commerce Date: 2004-01-15

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2007-10-17 - Automatic Update Of Assignment Of Ownership

2007-10-16 - Attorney Revoked And/Or Appointed

2007-10-16 - TEAS Revoke/Appoint Attorney Received

2004-08-10 - Registered - Principal Register

2004-05-29 - Allowed for Registration - Principal Register (SOU accepted)

2004-05-21 - TEAS Change Of Correspondence Received

2004-05-18 - Assigned To Examiner

2004-05-17 - Statement of use processing complete

2004-05-06 - Amendment to Use filed

2004-05-06 - PAPER RECEIVED

2004-02-17 - Noa Mailed - SOU Required From Applicant

2003-11-25 - Published for opposition

2003-11-05 - Notice of publication

2003-09-27 - Approved for Pub - Principal Register (Initial exam)

2003-09-27 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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