

ESTTA Tracking number: **ESTTA294219**

Filing date: **07/08/2009**

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	HealthCare Partners Affiliates Medical Group
Granted to Date of previous extension	07/08/2009
Address	19191 S. Vermont Avenue Suite 200 Torrance, CA 90502 UNITED STATES

Attorney information	Patrick C. Stephenson Kutak Rock LLP 1650 Farnam Street Omaha, NE 68102 UNITED STATES patrick.stephenson@kutakrock.com
----------------------	---

Applicant Information

Application No	77064371	Publication date	03/10/2009
Opposition Filing Date	07/08/2009	Opposition Period Ends	07/08/2009
Applicant	Heritage New York, IPA Suite 100 1225 Franklin Avenue Garden City, NY 115301655 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 2002/03/00 First Use In Commerce: 2002/03/00 All goods and services in the class are opposed, namely: Managed health care services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2844139	Application Date	01/02/1997
Registration Date	05/25/2004	Foreign Priority Date	NONE
Word Mark	HEALTH CARE PARTNERS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1993/05/14 First Use In Commerce: 1995/11/01 business management services and medical cost management services for health care providers Class 036. First use: First Use: 1993/05/14 First Use In Commerce: 1995/11/01 administration of patient reimbursement plans and administration of pre-paid health care plans for health care providers

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	HEALTHCARE PARTNERS		
Goods/Services	business management services and medical cost management services for health care providers; administration of patient reimbursement plans and administration of pre-paid health care plans for health care providers; health care services; health care clinics; urgent care clinics; and health and wellness counseling for patients.		

Attachments	75220464#TMSN.gif (1 page)(bytes) Healthcare Partners Notice of Opposition.pdf (8 pages)(25520 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	/Patrick C. Stephenson/
Name	Patrick C. Stephenson
Date	07/08/2009

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

HEALTHCARE PARTNERS AFFILIATES)	
MEDICAL GROUP)	
)	
Opposer,)	
)	
v.)	Serial No. 77,064,371
)	Opposition No. _____
HERITAGE NEW YORK, IPA)	
)	
Applicant)	
)	
_____)	

NOTICE OF OPPOSITION

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

HealthCare Partners Affiliates Medical Group, a California General Partnership located and doing business at 19191 South Vermont Ave., Suite 200, Torrance, California 90502 (“Opposer”) believes that it would be damaged and injured by registration of the purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION for managed health care services in International Class 44, as shown in Application No. 77,064,371, filed December 14, 2006, by Heritage New York, IPA (“Applicant”) and published for Opposition in the *Official Gazette* of the United States Patent and Trademark Office on March 10, 2009.

As grounds for opposition, it is alleged that:

1. Applicant seeks to register the purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION for managed health care services in

International Class 44, as evidenced by publication of said mark for opposition in the *Official Gazette* on March 10, 2009.

2. The United States Patent and Trademark Office initially refused to register Applicant's purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION on the grounds that the purported trademark is merely descriptive of the services set forth in Application Serial No. 77,064,371.

3. Applicant sought to overcome the merely descriptive refusal by claiming that the mark has become distinctive of the services set forth in Application Serial No. 77,064,371 through Applicant's substantially exclusive and continuous use of the term HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION in commerce for at least five years immediately preceding the date of such claim. Such claim was made on or about October 22, 2007.

4. Applicant has disclaimed the word "HEALTHCARE" and the words "MANAGEMENT SERVICES ORGANIZATION" but has not disclaimed the word "PARTNERS".

5. Opposer is the owner of United States Trademark Registration No. 2,844,139, issued on May 25, 2004, for the trademark HEALTHCARE PARTNERS and design, as used in connection with: (i) the provision of business management services and medical cost management services for health care providers, in International Class 035; and (ii) the administration of patient reimbursement plans and the administration of pre-paid health care plans for health care providers, in International Class 036.

6. Opposer made first use of the HEALTHCARE PARTNERS trademark at least as early as May 14, 1993 and made first use in interstate commerce of the HEALTHCARE

PARTNERS trademark at least as early as November 1, 1995. Opposer has made continuous use of the HEALTHCARE PARTNERS trademark since such dates.

7. In addition to the services set forth in United States Trademark Registration No. 2,844,139, Opposer has used, and continues to use, the HEALTHCARE PARTNERS trademark in connection with the promotions and rendering of health care services, health care clinics, urgent care clinics, and health and wellness counseling for patients.

8. By virtue of Opposer's efforts, the expenditure of considerable funds for promotional activities, and the excellence of Opposer's services, Opposer has gained an extremely valuable reputation for its HEALTHCARE PARTNERS trademark.

9. Opposer's HEALTHCARE PARTNERS trademark has become distinctive of the services offered by Opposer, and has attained acquired distinctiveness, by virtue of Opposer's use of the trademark for more than fifteen years as well as Opposer's extensive advertisement and promotion of its services under the HEALTHCARE PARTNERS trademark.

10. Upon information and belief, Opposer's first use of its HEALTHCARE PARTNERS trademark was prior to Applicant's first use of its purported HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION trademark by at least six years.

11. Upon information and belief, Opposer attained acquired distinctiveness for its HEALTHCARE PARTNERS trademark prior to Applicant's October 22, 2007, claim of acquired distinctiveness, or any date on which Applicant could claim acquired distinctiveness, for its purported HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION trademark.

12. Applicant's services are identical or highly related to the services offered by Opposer and would likely be advertised and promoted to identical or overlapping consumers in identical or overlapping channels of trade.

13. Applicant's purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION consists of a mark which, when applied to the services of the Applicant, is merely descriptive of such services and is not entitled to registration.

14. Upon information and belief, Applicant's purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION has not become distinctive of the services set forth in Application Serial No. 77,064,371, so as to overcome its descriptiveness and establish distinctiveness on the basis of secondary meaning under Section 2(f) of the Lanham Act, as required by law in order to confer upon Applicant an exclusive right to use such a descriptive mark.

15. Upon information and belief, Applicant has not made substantially exclusive and continuous use of the purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION in commerce for at least five years immediately preceding its October 22, 2007, claim of acquired distinctiveness.

16. Upon information and belief, Applicant has merely used the term HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION as a trade name and has not used the term as a trademark in interstate commerce.

17. Applicant's purported HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION trademark so resembles Opposer's HEALTHCARE PARTNERS trademark, which is the subject of United States Trademark Registration No. 2,844,139 and

common law trademark rights, so as to be likely, when applied to the services of Applicant, to cause confusion, or to cause mistake, or to deceive.

18. If Applicant is permitted to register its purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION, confusion would likely result by virtue of the substantial similarity between the Applicant's purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION and Opposer's registered and common law trademark HEALTHCARE PARTNERS. Furthermore, any defect, objection or fault found with the Applicant's services rendered under its purported trademark would necessarily reflect on and seriously injure the reputation that Opposer has established through its promotion and use of its valuable HEALTHCARE PARTNERS trademark.

19. If Applicant is permitted to use and register its purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION for the services set forth in Application Serial No. 77,064,371, such use and registration is likely to cause confusion and lead to deception as to the source, origin and/or sponsorship of Applicant's services, causing damage and injury to Opposer.

20. If Applicant is permitted to use and register its purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION for the services set forth in Application Serial No. 77,064,371, such use and registration is likely to damage the value, reputation and/or goodwill associated with Opposer's HEALTHCARE PARTNERS trademark, causing damage and injury to Opposer.

21. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to use its purported trademark HEALTHCARE

PARTNERS MANAGEMENT SERVICES ORGANIZATION for the services set forth in Application Serial No. 77,064,371, causing damage and injury to Opposer.

22. Applicant is not entitled to federal registration of its purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION on the grounds that: (i) Applicant's purported trademark is merely descriptive of the services set forth in Application Serial No. 77,064,371, (ii) Applicant's purported trademark has not attained secondary meaning pursuant to Section 2(f) of the Lanham Act, (iii) Applicant has not made substantially exclusive and continuous use of its purported trademark in commerce for at least five years immediately preceding its October 22, 2007, claim of acquired distinctiveness, and (iv) Applicant's purported trademark is confusingly similar to Opposer's HEALTHCARE PARTNERS trademark, which is the subject of United States Trademark Registration No. 2,844,139 and common law trademark rights.

23. For the reasons set forth in the foregoing paragraphs, Applicant should be precluded from registering its purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION, and Applicant's application for such mark should be denied in accordance with Section 2(d) or Section 2(e) of the Lanham Act, 15 U.S.C. §1052(d) and §1052(e).

WHEREFORE, Opposer prays that Application Serial No. 77/064,371 be rejected and the registration of the purported trademark HEALTHCARE PARTNERS MANAGEMENT SERVICES ORGANIZATION be refused and denied.

Dated: July 8, 2009

/Patrick C. Stephenson/
Patrick C. Stephenson, (NE #19138)
John P. Passarelli, (NE #16018)

Attorneys for Healthcare Partners Affiliates
Medical Group
Kutak Rock LLP
The Omaha Building
1650 Farnam Street
Omaha, NE 68102-2186
Telephone: (402) 346-6000
Fax: (402) 346-1148
Email:
patrick.stephenson@kutakrock.com
john.passarelli@kutakrock.com

CERTIFICATE OF MAILING

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served
this 8th day of July, 2009, by first-class mail, postage prepaid, on:

Thomas M. Rosselli
Carter, Deluca, Farrell & Schmidt, LLP
445 Broadhollow Rd Ste 225
Melville, NY 11747-3615

/Patrick C. Stephenson/
Patrick C. Stephenson