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Filing date: **03/05/2015**

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

Proceeding	91218561
Party	Defendant ehealth Solutions, Inc.
Correspondence Address	James M. Kunick Epstein Becker Green 150 North Michigan Avenue, 35th Floor Chicago, IL 60601 UNITED STATES rbenz@ebglaw.com, bcesaratto@ebglaw.com, rhammer@sigmacare.com
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Date	03/05/2015
Attachments	Answer to Notice of Opposition and Affirmative Defenses (5Mar2015).pdf(515345 bytes )

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

Mark: SIGMAHEALTH  
Serial No.: 86/091,394  
Published: on April 1, 2014

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SIGMA-TAU INDUSTRIE :  
FARMACEUTICHE RIUNITE S.P.A :  
Opposer, :  
v. : Opposition No. 91218561  
EHEALTH SOLUTIONS, INC. d/b/a :  
SIGMACARE® :  
Applicant, :  
----- X

**ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES**

Applicant, eHealth Solutions, Inc., by its attorneys Epstein Becker & Green, P.C., answers the Notice of Opposition (the "Opposition") filed by Sigma-Tau Industrie Farmaceutiche Riunite S.p.A. (hereinafter "Opposer") in Opposition No. 91218561.

**INTRODUCTION**

With respect to the preamble to the Opposition, Applicant denies the assertion by Opposer, a pharmaceutical products manufacturer, that it will be damaged by the registration of the marks shown in the above-identified applications.

**COUNT I**

1. Applicant is a Delaware corporation headquartered in New York State that since February 1, 2006 provides electronic health record ("EHR") software and clinical decision support systems to health care providers of long-term and acute care, including nursing homes and assisted living environments, and admits that in connection with its provision of EHR software and clinical decision support systems to long term and acute care providers, it filed a trademark application for

SIGMAHEALTH and that the application was assigned U.S. Trademark Serial No. 86/091,394 (the “Mark”). Applicant denies the Opposer’s characterization of the information contained in Paragraph 1 of the Opposition, and avers that the trademark application, attached hereto as Exhibit A, speaks for itself and refers the Board to the actual applications as the best evidence of the information set forth therein and legal import thereof.

2. Applicant admits the allegations in Paragraph 2 of the Opposition.

3. Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 3 of the Opposition.

4. Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 4 of the Opposition.

5. Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 5 of the Opposition, except to deny that Opposer has trademarked the word “Sigma” in a logo or otherwise.

6. Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 6 of the Opposition. Applicant further denies the Opposer’s characterization of the information contained Paragraph 6 of the Opposition, and avers that the trademark applications or registrations speak for themselves and refers the Board to the actual applications and/or registrations as the best evidence of the information set forth therein and legal import thereof.

7. Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 7 of the Opposition.

8. The allegations in Paragraph 8 constitute a legal conclusion to which no response is required. To the extent a response is required, Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 8 of the Opposition.

9. The allegations in Paragraph 9 constitute a legal conclusion to which no response is required. To the extent a response is required, Applicant denies knowledge or information to form a belief as to the truth or falsity of the allegations in Paragraph 9 of the Opposition.

10. Applicant denies the allegations in Paragraph 10 of the Opposition. Without limiting the foregoing, Applicant denies that Opposer has acquired or established trademarks or related rights in the Greek word "SIGMA," Applicant further refers the Board to the Opposer's allegations in Paragraphs 5, 6, and 9 which refer only to certain purported marks containing the word "SIGMA-TAU," and another mark that is a graphical symbol, not containing the word "Sigma."

11. Applicant denies the allegations contained in Paragraph 11 of the Opposition.

### **COUNT II**

12. Applicant repeats and realleges the allegations set forth in Paragraphs 1 through 13<sup>1</sup> as set forth herein.

13. Applicant denies the allegations contained in Paragraph 13 of the Opposition.

14. Applicant denies the allegations contained in Paragraph 14 of the Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Opposition, except that Applicant admits that Opposer is not connected with the activities performed by Applicant.

16. Applicant admits that Opposer and Sigma-Tau Healthscience, LLC are not connected with the activities performed by Applicant under the Applicant's Mark.

17. Applicant denies the allegations contained in Paragraph 17 of the Opposition.

18. Applicant denies the allegations contained in Paragraph 18 of the Opposition.

### **AFFIRMATIVE DEFENSES**

In further answer to the Opposition, Applicant asserts as separate and affirmative defenses that:

#### **FIRST AFFIRMATIVE DEFENSE**

1. Opposer lacks standing to oppose the Mark in that Opposer is not likely to be damaged or injured by Applicant's use or registration of the Mark.

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<sup>1</sup> Paragraph 12 of the Opposition repeats and realleges the allegations set forth in "paragraphs 1 through 13." Applicants Answer addresses the allegations restated in Paragraph 12 out of abundance for caution; however, Applicant notes the Opposer's apparent intent to restate allegations only in Paragraphs 1 through 11.

**SECOND AFFIRMATIVE DEFENSE**

2. No likelihood of confusion, mistake or deception exists between the Mark and the Opposer's asserted marks because the Mark is decidedly different in appearance, sound, meaning and commercial impression.

**THIRD AFFIRMATIVE DEFENSE**

3. No likelihood of confusion, mistake or deception exists between the Mark and Opposer's asserted marks because the goods and/or services in connection with which the parties use and propose to use their marks are substantially different. Without limiting the foregoing or any denial of allegations contained herein, Applicant refers the Board to the Opposer's description of the goods and/or services related to Opposer's marks in the allegations contained in Paragraphs 3, 6, and 8, specifically, as all descriptions relate to pharmaceutical products, preparations, or research. Conversely, and of fundamental import, Applicant refers the Board to the description of the goods and/or services related to Applicant's SIGMAHEALTH mark, specifically that all descriptions relate to EHR software and clinical decision support systems, and nowhere in such descriptions of the Mark does Applicant make any reference to pharmaceutical products, preparations, or research.

**FOURTH AFFIRMATIVE DEFENSE**

4. No likelihood of confusion, mistake or deception exists between the Mark and the Opposer's asserted marks because the potential consumers of Opposer's goods and/or services are substantially different from the potential consumers of Applicant's goods and/or services provided under the Mark.

**FIFTH AFFIRMATIVE DEFENSE**

5. Opposer's opposition to the Mark is barred, in whole or in part, in that Applicant already owns substantially similar registered marks for substantially similar goods and/or services such that the Mark causes no added injury to the Opposer.

**SIXTH AFFIRMATIVE DEFENSE**

6. Opposer is not famous nor does it have a reputation such that a connection to Opposer would be presumed when the Mark is used in connection with Applicant's goods or services.

**SEVENTH AFFIRMATIVE DEFENSE**

7. Opposer's Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for opposition.

**EIGHTH AFFIRMATIVE DEFENSE**

8. Opposer is barred by the equitable doctrines of laches, waiver and/or acquiescence to assert an opposition to the Mark and/or prior registration of substantially the same marks for substantially the same goods.

**NINTH AFFIRMATIVE DEFENSE**

9. Opposer's asserted trademarks and Applicant's marks have been coexisting for several years without any instances of actual confusion.

**TENTH AFFIRMATIVE DEFENSE**

10. Opposer's opposition to the Mark is barred, in whole or in part, by prior registration of the Mark.

**ELEVENTH AFFIRMATIVE DEFENSE**

11. The term SIGMA and the depiction of the letter Sigma are used by many third parties in connection with medical related goods and services, software goods and services, and electronic data storage goods and services.

**RELIEF REQUESTED**

WHEREFORE, Applicant respectfully requests that: (i) Opposer's Opposition be denied in all

respects and dismissed with prejudice; and (ii) for such other relief as the Board deems proper.

Dated: March 5, 2015

Respectfully submitted,



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Ryan R. Benz  
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Attorney for Applicant  
eHealth Solutions, Inc.

**CERTIFICATE OF SERVICE AND FILING**

The undersigned hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition and Affirmative Defenses was served on counsel of record for Opposer on the date indicated below via e-mail as agreed by counsel to:

Paolo A. Strino, Esq.  
Gibbons P.C.  
One Pennsylvania Plaza  
37th Floor  
New York, NY 10119  
Telephone: 212-613-2023  
PStrino@gibbonslaw.com

We also served by regular first class mail to the above address.

The undersigned further certifies that this Answer to Notice of Opposition and Affirmative Defenses was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: March 5, 2015



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New York, New York 10177  
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# **EXHIBIT A**

STATUS DOCUMENTS

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Mark: SIGMAHEALTH

**SIGMAHEALTH**

US Serial Number: 86091394

Application Filing Date: Oct. 15, 2013

Register: Principal

Mark Type: Service Mark

**Status:** An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Sep. 26, 2014

Publication Date: Apr. 01, 2014

**Mark Information**

Mark Literal Elements: SIGMAHEALTH

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

**Related Properties Information**

**Claimed Ownership of US** [3255569](#), [3345729](#) and others  
**Registrations:**

**Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [ ] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*, \* identify additional (new) wording in the goods/services.

**For:** Electronic storage of medical records, healthcare information, namely, historical and current clinical, administrative and financial information and documents, and lifestyle information and documents in the nature of personal, recreational and social preferences and activities for remote access by healthcare consumers and for consultation, collaboration, and communication with healthcare vendors in the pharmaceutical, medical and consumer healthcare fields and healthcare professionals in the outpatient, inpatient, long term care, home health care, skilled nursing, rehabilitation, adult day care, and assisted living environments using handheld devices, mobile personal computers, or stationary personal computers

International Class(es): 039 - Primary Class

U.S Class(es): 100, 105

Class Status: ACTIVE

Basis: 1(b)

**For:** Providing online non-downloadable software for use by healthcare consumers for remote access using handheld devices, mobile personal computers, or stationary personal computers to their medical records, healthcare information, namely, historical and current clinical, administrative and financial information and documents, and lifestyle information and documents in the nature of personal, recreational and social preferences and activities, and for consultation, collaboration and communication with healthcare vendors in the pharmaceutical, medical and consumer healthcare fields and healthcare professionals in the outpatient, inpatient, long term care, home health care, skilled nursing, rehabilitation, adult day care, and assisted living environments using handheld devices, mobile personal computers, or stationary personal computers

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(b)

**Basis Information (Case Level)**

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes	Currently ITU: Yes	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

**Current Owner(s) Information**



Owner Name: ehealth Solutions, Inc.  
 Owner Address: 575 Eighth Avenue, 15th Floor  
 New York, NEW YORK 10018  
 UNITED STATES  
 Legal Entity Type: CORPORATION  
 State or Country Where Organized: DELAWARE

**Attorney/Correspondence Information**

**Attorney of Record**

Attorney Name: James M. Kunick  
 Attorney Primary Email [JKunick@ebqlaw.com](mailto:JKunick@ebqlaw.com)  
 Address:  
 Attorney Email Authorized: Yes

**Correspondent**

Correspondent Name/Address: James M. Kunick  
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[rhammer@sigmacare.com](mailto:rhammer@sigmacare.com)  
[BCesaratto@ebqlaw.com](mailto:BCesaratto@ebqlaw.com)  
 Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

**Prosecution History**

Date	Description	Proceeding Number
Oct. 29, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
Oct. 29, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Sep. 26, 2014	OPPOSITION INSTITUTED NO. 999999	218561
Apr. 29, 2014	EXTENSION OF TIME TO OPPOSE RECEIVED	
Apr. 01, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 01, 2014	PUBLISHED FOR OPPOSITION	
Mar. 12, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 22, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Feb. 22, 2014	ASSIGNED TO LIE	77312
Feb. 03, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 03, 2014	EXAMINER'S AMENDMENT ENTERED	88888
Feb. 03, 2014	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Feb. 03, 2014	EXAMINERS AMENDMENT E-MAILED	6328
Feb. 03, 2014	EXAMINERS AMENDMENT -WRITTEN	72517
Jan. 30, 2014	ASSIGNED TO EXAMINER	72517

Oct. 23, 2013 NOTICE OF PSEUDO MARK E-MAILED  
 Oct. 22, 2013 NEW APPLICATION OFFICE SUPPLIED DATA  
 ENTERED IN TRAM  
 Oct. 18, 2013 NEW APPLICATION ENTERED IN TRAM

**TM Staff and Location Information**

**TM Staff Information**

TM Attorney: SAITO, KIM TSUKIYO

Law Office Assigned: LAW OFFICE 102

**File Location**

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Feb. 22, 2014

**Assignment Abstract Of Title Information - Click to Load**

**Proceedings**

**Summary**

Party type

Proceeding type

Number of Proceedings: 2

**Type of Proceeding: Opposition**

Proceeding Number: 91218561

Filing Date: Sep 26, 2014

Status: Pending

Status Date: Sep 26, 2014

Interlocutory Attorney: ELIZABETH A DUNN

**Defendant**

Name: ehealth Solutions, Inc.

Correspondent Address: James M. Kunick  
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 Chicago IL , 60601  
 UNITED STATES

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**Associated marks**

Mark	Application Status	Serial Number	Registration Number
SIGMAHEALTH	Opposition Pending	<u>86091394</u>	

**Plaintiff(s)**

Name: SIGMA-TAU INDUSTRIE FARMACEUTICHE RIUNITE S.p.A.

Correspondent Address: Paolo A. Strino  
 LUCAS & MERCANTI, LLP  
 30 Broad Street, 21st Floor  
 New York NY , 10004  
 UNITED STATES

Correspondent e-mail: [info@lmiplaw.com](mailto:info@lmiplaw.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
SIGMA-TAU PHARMACEUTICALS, INC.	Renewed	<u>73833092</u>	<u>1863145</u>
	Renewed	<u>73833091</u>	<u>1666394</u>
SIGMA-TAU	Registered	<u>85210758</u>	<u>4390273</u>
PROXANA SIGMA-TAU	Published For Opposition	<u>79147460</u>	
SIGMA-TAU CARNITINES	Registered	<u>79099740</u>	<u>4223693</u>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 26, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 26, 2014	Nov 05, 2014

3	PENDING, INSTITUTED	Sep 26, 2014
4	CHANGE OF CORRESP ADDRESS	Oct 29, 2014
5	STIP FOR EXT	Oct 30, 2014
6	EXTENSION OF TIME GRANTED	Oct 30, 2014
7	STIP FOR EXT	Dec 05, 2014
8	EXTENSION OF TIME GRANTED	Dec 05, 2014
9	STIP FOR EXT	Jan 03, 2015
10	EXTENSION OF TIME GRANTED	Jan 03, 2015
11	STIP FOR EXT	Feb 02, 2015
12	EXTENSION OF TIME GRANTED	Feb 02, 2015

**Type of Proceeding: Extension of Time**

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Proceeding Number: 88091394 Filing Date: Apr 29, 2014  
 Status: Terminated Status Date: Sep 28, 2014

Interlocutory Attorney:

**Defendant**

Name: ehealth Solutions, Inc.  
 Correspondent Address: EMILIA F. CANNELLA  
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 800 BOYLSTON ST STE 3600  
 BOSTON MA , 02199-3600

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
SIGMAHEALTH	Opposition Pending	<u>88091394</u>	

**Potential Opposer(s)**

Name: SIGMA-TAU INDUSTRIE FARMACEUTICHE RIUNITE S.p.A.  
 Correspondent Address: Paolo A. Strino  
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**Associated marks**

Mark	Application Status	Serial Number	Registration Number

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Apr 29, 2014	
2	EXTENSION OF TIME GRANTED	Apr 29, 2014	
3	INCOMING - EXT TIME TO OPPOSE FILED	Jul 30, 2014	
4	EXTENSION OF TIME GRANTED	Jul 30, 2014	

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