

ESTTA Tracking number: **ESTTA746330**

Filing date: **05/13/2016**

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	HEALTH NEW ENGLAND, INC.
Granted to Date of previous extension	05/21/2016
Address	ONE MONARCH PLAGE, SUITE 1500 Springfield, MA 01144 UNITED STATES

Attorney information	NICHOLAS J. TUCCILLO Grogan, Tuccillo & Vanderleeden, LLP 1350 Main Street, Suite 508 One Financial Plaza Springfield, MA 01103 UNITED STATES docket@gtv-ip.com Phone:413-736-5401
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Applicant Information

Application No	86779873	Publication date	03/22/2016
Opposition Filing Date	05/13/2016	Opposition Period Ends	05/21/2016
Applicant	Trinity Health Corporation 20555 Victor Parkway Livonia, MI 48152 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Home health care services; Hospitals; Medical and pharmaceutical consultation; Medical services; Nursing services; Physician services; Providing long-term carefacilities
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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.	1426061	Application Date	02/03/1986
Registration Date	01/20/1987	Foreign Priority Date	NONE
Word Mark	HEALTH NEW ENGLAND		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1986/01/01 First Use In Commerce: 1986/01/01 OPERATING A HEALTH MAINTENANCE ORGANIZATION WHICH ARRANGES HEALTH AND MEDICAL CARE FOR ITS MEMBERS THROUGH A NETWORK OF SELECTED HOSPITALS AND PHYSICIANS

Attachments	5022-0050-2_NoticeOfOpposition.pdf(72692 bytes) 5022-0050-2_ExhA.pdf(48339 bytes) 5022-0050-2_ExhB.pdf(228884 bytes)
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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	/NICHOLAS J. TUCCILLO/
Name	NICHOLAS J. TUCCILLO
Date	05/13/2016

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

HEALTH NEW ENGLAND, INC.)	
)	
Plaintiff-Opposer)	Opposition No.
)	Serial No.: 86/779,873
v.)	Mark: TRINITY HEALTH NEW ENGLAND
)	& DESIGN
TRINITY HEALTH CORPORATION)	
)	
Defendant-Applicant.)	
)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Health New England, Inc. ("Opposer") believes that it will be damaged by the registration of the mark in U.S. Trademark Application Serial No. 86/779,873 ("the '873 application"), which was Published for Opposition on March 22, 2016, the time for Opposition being extended until May 22, 2016 by virtue of the previously filed Extension of Time to Oppose, and as such, hereby opposes, in whole, the same.

The grounds for this opposition are as follows:

1. Opposer, Health New England, Inc., is a corporation organized and existing under the laws of the Commonwealth of Massachusetts, having a principal place of business at One Monarch Place, Springfield, Massachusetts 01144.

2. Existing since at least 1986, Opposer is a U.S.-based health maintenance organization. Opposer's activities include functions related both to health insurance and to medical and health care services. Opposer's activities thus include not only services related to financing and coverage of health care, but also to medical and health care services such as coordination and management of medical care, health education, and wellness promotion. Opposer provides such services through,

among other things, providing a network of selected hospitals and physicians and covering some services for its members throughout the United States and Internationally.

3. Since at least January 1, 1986, Opposer has been using the mark "HEALTH NEW ENGLAND" continuously in commerce for, at least, operating a health maintenance organization which arranges health and medical care for its members through a network of selected hospitals and physicians. On February 3, 1986 Opposer filed Trademark application No. 73/580,915 with the US Trademark for the mark "HEALTH NEW ENGLAND". Opposer's application matured into Registration No. 1,426,061 ("the '061 Registration"), registering on January 20, 1987 (copy attached as Exhibit A).

4. Moreover, and in light of Opposer's likely zone of expansion and related, ongoing activities, Opposer filed an intent-to-use application on September 29, 2015 with the US Trademark Office having serial number 86/771,842 ("the '842 application"). The '842 application was filed in connection with home health care services, hospitals, medical and pharmaceutical consultation, medical services, nursing services, physician services and providing long-term care facilities, in international class 44. A copy of the '842 Application is attached hereto as Exhibit B.

5. Trinity Health Corporation ("Trinity") is a corporation organized and existing under the laws of the State of Indiana and has a principal place of business at 20555 Victor Parkway, Livonia, Michigan 48152. On October 6, 2015 Trinity filed the '873 application with the US Trademark Office, also for home health care services, hospitals, medical and pharmaceutical consultation, medical services, nursing services, physician services and providing long-term care facilities, and also in international class 44.

6. The filing of Opposer's '842 application therefore predates the filing of Trinity's '873 application. For its part, Opposer's '061 Registration was itself actually Registered some 30 years prior to Trinity's '873 application being filed, in closely related class 42.

7. Moreover, through Opposer's longstanding and continuous use of its HEALTH NEW ENGLAND mark in connection with Opposer's services, Opposer's mark has become well known as designating Opposer's services throughout the United States, and now enjoys incontestable status.

8. Opposer enjoys substantial and exclusive goodwill throughout the United States in connection with its HEALTH NEW ENGLAND mark.
9. Opposer's HEALTH NEW ENGLAND mark, as reflected in both in the '061 Registration as well as in the '842 application, is highly similar to Trinity's mark ('TRINITY HEALTH NEW ENGLAND') in appearance, sound and commercial impression.
10. Trinity's services and Opposer's services are identical (as in the case of Opposer's previously-filed '842 application) and/or closely related (as in the case of the '061 Registration) and are sold and marketed, or will be sold and marketed, to identical or highly similar types of consumers through identical or highly similar channels of trade.
11. The registration of Trinity's mark in the '873 application, with or without the associated design element, is likely to cause dilution of Opposer's HEALTH NEW ENGLAND mark by blurring the distinctive association Opposer has enjoyed for over 30 years between its HEALTH NEW ENGLAND mark, and the services offered under this mark.
12. Trinity's filing of the '873 application for Trinity's TRINITY HEALTH NEW ENGLAND mark is without license, authorization or permission from Opposer.
13. The granting of a trademark registration to Trinity for their proposed TRINITY HEALTH NEW ENGLAND mark would violate and diminish the prior and superior rights of Opposer in its HEALTH NEW ENGLAND mark and would be in violation of 15 U.S.C. §§ 1052(d) and 1125(c).
14. Opposer would be damaged if the '873 application is allowed to register because Trinity will obtain statutory rights in Trinity's TRINITY HEALTH NEW ENGLAND mark in violation and derogation of the established prior rights of Opposer in its HEALTH NEW ENGLAND mark.
15. The mere inclusion of a design element or an additional term, such as the mere inclusion of Trinity's corporate name in the proposed mark of the '873 application, does not serve to lessen the likelihood of confusion or to further distinguish Trinity's mark from Opposer's '061 Registration or Opposer's '842 application, where Trinity has otherwise totally and completely consumed Opposer's mark within the same. See *Coca-Cola Bottling Co. v. Jos E. Seagram & Sons, Inc.*, 526 F.2d 556, 557,

188 USPQ 105, 106 (C.C.P.A. 1975); In re Toshiba Med. Sys. Corp., 91 USPQ2d 1266, 1269 (TTAB 2009); In re El Torito Rests., Inc., 9 USPQ2d 2002, 2004 (TTAB 1988); TMEP 1207.01(b)(iii).

16. Upon information and belief, neither Opposer's '061 Registration, nor Opposer's earlier-filed '842 application, were discovered, recognized or otherwise considered by the U.S. Trademark Office prior to Trinity's '873 application being published for Opposition.

17. Opposer notes that Opposer has filed civil suit, Civil Action No. 3:15-cv-30206-MAP, against Trinity alleging, *inter alia*, trademark infringement based upon Trinity's use of the mark of the '873 application in commerce.

WHEREFORE, Opposer requests that this opposition be sustained and that registration be refused to Trinity on its '873 application, in whole.

Submitted with this Notice of Opposition is the required fee pursuant to 37 C.P.R. 2.6(a)(17) at \$300 per class. In the advent that any additional fees are required, Opposer's authorizes the Office to charge deposit account No. 506776 for any such fees.

Respectfully submitted,

/Nicholas J. Tuccillo/
Nicholas J. Tuccillo, Esq
Registration No. 44,322
Attorney for Opposer

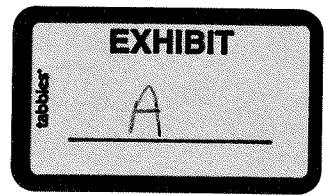
GROGAN, TUCCILLO & VANDERLEEDEN, LLP
One Financial Plaza
1350 Main Street, Suite 508
Springfield, MA 01103
Tel. (413) 736-5401
Fax. (413) 733-4543
docket@gtv-ip.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been sent by first-class mail, postage prepaid to the address of Applicant:

Trinity Health Corporation
20555 Victor Parkway
Livonia, Michigan 48152

/Nicholas J. Tuccillo/
Nicholas J. Tuccillo



Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office Reg. No. 1,426,061
Registered Jan. 20, 1987

**SERVICE MARK
PRINCIPAL REGISTER**

HEALTH NEW ENGLAND

HEALTH NEW ENGLAND, INC. (MASSACHU-
SETTS CORPORATION)
BAYBANK TOWER
SPRINGFIELD, MA 01115

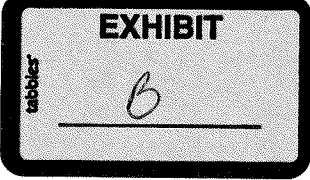
FOR: OPERATING A HEALTH MAINTENANCE ORGANIZATION WHICH ARRANGES HEALTH AND MEDICAL CARE FOR ITS MEMBERS THROUGH A NETWORK OF SELECTED HOSPITALS AND PHYSICIANS, IN CLASS 42 (U.S. CL. 100).

FIRST USE 1-1-1986; IN COMMERCE 1-1-1986.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NEW ENGLAND", APART FROM THE MARK AS SHOWN.

SER. NO. 580,915, FILED 2-3-1986.

AVIS FRAZIER-THOMAS, EXAMINING ATTORNEY



Trademark/Service Mark Application, Principal Register

Serial Number: 86771842
 Filing Date: 09/29/2015

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86771842
MARK INFORMATION	
*MARK	<u>HEALTH NEW ENGLAND</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	HEALTH NEW ENGLAND
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	HEALTH NEW ENGLAND, INC.
*STREET	ONE MONARCH PLACE, SUITE 1500
*CITY	SPRINGFIELD
*STATE (Required for U.S. applicants)	Massachusetts
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants)	01144-1500
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Massachusetts
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	044
*IDENTIFICATION	home health care services; hospitals; medical and pharmaceutical consultation; medical services; nursing services; physician services; providing long-term care facilities.
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	NICHOLAS J. TUCCILLO
ATTORNEY DOCKET NUMBER	5022-0051
FIRM NAME	Grogan, Tuccillo & Vanderleeden, LLP
INTERNAL ADDRESS	One Financial Plaza, Floor 5

STREET	1350 Main Street, Suite 508
CITY	Springfield
STATE	Massachusetts
COUNTRY	United States
ZIP/POSTAL CODE	01103
PHONE	4137365401
FAX	4137334543
EMAIL ADDRESS	docket@gtv-ip.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	J. Kevin Grogan, Nicholas J. Tuccillo, Kevin H. Vanderleeden, Michael D. Cartona, Raymond W. Zenkert, III
CORRESPONDENCE INFORMATION	
NAME	NICHOLAS J. TUCCILLO
FIRM NAME	Grogan, Tuccillo & Vanderleeden, LLP
INTERNAL ADDRESS	One Financial Plaza, Floor 5
STREET	1350 Main Street, Suite 508
CITY	Springfield
STATE	Massachusetts
COUNTRY	United States
ZIP/POSTAL CODE	01103
PHONE	4137365401
FAX	4137334543
*EMAIL ADDRESS	docket@gtv-ip.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
APPLICATION FILING OPTION	TEAS RF
NUMBER OF CLASSES	1
FEE PER CLASS	275
*TOTAL FEE DUE	275
*TOTAL FEE PAID	275
SIGNATURE INFORMATION	
SIGNATURE	/Nicholas J. Tuccillo/
SIGNATORY'S NAME	Nicholas J. Tuccillo
SIGNATORY'S POSITION	Attorney of record, Connecticut bar member.
SIGNATORY'S PHONE NUMBER	413-736-5401
DATE SIGNED	09/29/2015

Trademark/Service Mark Application, Principal Register

Serial Number: 86771842

Filing Date: 09/29/2015

To the Commissioner for Trademarks:

MARK: HEALTH NEW ENGLAND (Standard Characters, see mark)

The literal element of the mark consists of HEALTH NEW ENGLAND.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, HEALTH NEW ENGLAND, INC., a corporation of Massachusetts, having an address of
ONE MONARCH PLACE, SUITE 1500
SPRINGFIELD, Massachusetts 01144-1500
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 044: home health care services; hospitals; medical and pharmaceutical consultation; medical services; nursing services; physician services; providing long-term care facilities.

Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services.

The applicant's current Attorney Information:

NICHOLAS J. TUCCILLO and J. Kevin Grogan, Nicholas J. Tuccillo, Kevin H. Vanderleeden, Michael D. Cartona, Raymond W. Zenkert, III of Grogan, Tuccillo & Vanderleeden, LLP

One Financial Plaza, Floor 5
1350 Main Street, Suite 508
Springfield, Massachusetts 01103
United States

The attorney docket/reference number is 5022-0051.

The applicant's current Correspondence Information:

NICHOLAS J. TUCCILLO
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Springfield, Massachusetts 01103
4137365401(phone)
4137334543(fax)
docket@gtv-ip.com (authorized)

E-mail Authorization: I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or applicant's attorney at the e-mail address provided above. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in an additional processing fee of \$50 per international class of goods/services.

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. § 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant is using the mark in commerce on or in connection with the goods/services in the application; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed

an application under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Nicholas J. Tuccillo/ Date: 09/29/2015

Signatory's Name: Nicholas J. Tuccillo

Signatory's Position: Attorney of record, Connecticut bar member.

RAM Sale Number: 86771842

RAM Accounting Date: 09/29/2015

Serial Number: 86771842

Internet Transmission Date: Tue Sep 29 12:00:24 EDT 2015

TEAS Stamp: USPTO/BAS-X.XX.XXX.XXX-20150929120024223

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HEALTH NEW ENGLAND