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

Proceeding	91227868
Party	Defendant Trinity Health Corporation
Correspondence Address	JOHN P GUENTHER DYKEMA GOSSETT PLLC 39577 WOODWARD AVE STE 300 BLOOMFIELD HILLS, MI 48304-5086 UNITED STATES ipmail@dykema.com, jguenther@dykema.com, mcomeau@dykema.com, jfraser@dykema.com
Submission	Reply in Support of Motion
Filer's Name	Jennifer Fraser
Filer's e-mail	ipmail@dykema.com, jfraser@dykema.com, jguenther@dykema.com, mcomeau@dykema.com
Signature	/jf/
Date	07/06/2016
Attachments	Reply to Opposers Response to Motion to Suspend - Opp. No. 91227868.pdf(101304 bytes )

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

In re:

Trademark Application Serial No. 86/779,873

Mark: TRINITY HEALTH NEW ENGLAND  
& Design

Opposition No. 91227868

Published in the  
Official Gazette: March 22, 2016

Health New England, Inc.  
Opposer,

v.

Trinity Health Corporation,  
Applicant.

**REPLY TO OPPOSER'S RESPONSE TO MOTION TO SUSPEND IN VIEW OF  
PENDING CIVIL ACTION**

Health New England, Inc.'s ("Opposer") Response to the Motion to Suspend pending disposition of the pending Federal Civil Action offers no "unusual" circumstances warranting a departure from the Board's standard policy to suspend proceedings when the parties are involved in a civil action which will have a bearing on the Board case. Trademark Rule 2.117(a) and TBMP § 510.02(a). Opposer does not dispute that there are issues in common between the Board proceeding and the Federal Civil Action. Considering the issues raised by the parties in the civil action, it is clear the Court can provide complete relief, and can do so significantly more expeditiously than the Board.

Opposer goes to great lengths to make it seem that Trinity's defenses and other statements in the Answer and Counterclaims are unusual or improper. Despite such disingenuous attempts, however, the legitimate defenses raised in the Federal Civil Action are

not out of the ordinary in a trademark case involving assertion of a descriptive mark, and Opposer's inconsistent statements and attempts to raise irrelevant issues are transparent and do not warrant denial of the requested suspension. Therefore, the opposition proceeding should be suspended pending determination of a pending civil action.

## **ARGUMENT**

### **I. THE OPPOSITION PROCEEDING SHOULD BE SUSPENDED BECAUSE THE COURT CAN PROVIDE COMPLETE RELIEF**

Opposer initiated the litigation in the U.S. District Court for the District of Massachusetts on November 23, 2015 alleging, *inter alia*, federal claims of unfair competition, trademark infringement and false designation of origin, as well as related claims under the common law and the state laws of Massachusetts including unfair competition under Massachusetts General Laws, Title XV, Chapter 93(A), requesting an injunction, damages and costs and fees (the "Federal Civil Action"). The court claims surround assertion of Opposer's alleged trademark HEALTH NEW ENGLAND against Trinity Health Corporation's ("Trinity" or "Applicant") intended use of TRINITY HEALTH NEW ENGLAND & Design. Trinity has raised Counterclaims challenging the validity of Opposer's asserted trademarks and the accuracy of statements made to the PTO, and seeking damages for fraudulent registration under 15 U.S.C. § 1120.

Trademark Rule 2.117(a) provides "[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding." 37 C.F.R. § 2.117(a); TBMP § 510.02(a); *see also Other Telephone Company v. Connecticut*

*National Telephone Company, Inc.*, 181 USPQ 125, 126-127 (TTAB 1974); *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011) *citing* 6 McCarthy on Trademarks and Unfair Competition §32.47 (4<sup>th</sup> ed. Updated June 2011) (stating “[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”). It is beyond dispute that the claims in the Federal Civil Action will have a bearing on the Board proceeding and that the Board’s standard procedure of suspension should be followed.

Not only will the Federal Civil Action have a bearing on the Board proceeding, but the Board cannot provide all of the relief requested by Opposer (Plaintiff in the Federal Civil Action) in the lawsuit it filed, and thus it is inappropriate for the Opposer to oppose a suspension which is clearly warranted under the Board’s rules and practice.<sup>1</sup> As indicated in the Complaint provided with Trinity’s Motion (D.I. 4, Exhibit A, pp. 11-14), Opposer is seeking an injunction, damages and costs and fees in the civil litigation, based on trademark claims as well as state and common law claims, arising out of the same set of facts. Opposer also fails to mention that they represented to the Court they might seek a preliminary injunction. This is also relief the TTAB cannot provide. The transcript page from the June 21, 2016 Scheduling Conference is attached as Exhibit A. Apart from the issues the TTAB might decide, Opposer, could still have claims apart from those that directly relate to the trademark registration.<sup>2</sup>

The Court in Massachusetts is also capable of deciding all the issues raised in the Complaint and Counterclaims. Opposer tries to suggest that the Court will defer to the PTO but

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<sup>1</sup> Notwithstanding the Supreme Court’s decision in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S.Ct. 1293 (2015), the Court can provide complete relief, whereas the Board can only decide certain issues and the preclusive effect for certain issues related to use is unknown and premature where discovery has not commenced.

<sup>2</sup> Since filing the initial Motion, Plaintiff amended its Complaint on June 7, 2016 to add another party, Trinity Health-New England, Inc., a company related to Applicant/Defendant. This is another reason the civil action will provide complete relief, while the TTAB opposition proceeding cannot.

has no provided no basis for this claim for the Court in Massachusetts. In fact, the Magistrate Judge assigned to the pending litigation has rejected a request for a stay in her Court based on a TTAB proceeding, on the basis that the TTAB case was not close to completion and because the TTAB decision is not necessarily final and would not provide complete relief. *Shire City Herbals, Inc. v. Blue*, 2015 U.S. Dist. LEXIS 122678 (D. Mass. 2015) (copy enclosed). In her decision in *Shire City*, Magistrate Judge Robertson even acknowledged *B&B Hardware*, stating the effect is speculative and should not be the basis of a stay. Accordingly, Opposer's speculation about the effect of a TTAB decision is not a sufficient reason to delay adjudication of the parties' rights, particularly where other compelling reasons and the Board's standard procedure mandate suspension.

**II. THE OPPOSITION PROCEEDING SHOULD BE SUSPENDED  
BECAUSE THE FEDERAL CIVIL ACTION SHOULD PROVIDE THE  
REQUESTED RELIEF SOONER**

Opposer tries to suggest the TTAB proceeding will be decided sooner than the Federal Civil Action, but a trial in the Federal Civil Action would be expected in approximately one year. What Opposer fails to mention is that earlier in the day on the 21st of June, counsel was present when Magistrate Judge Robertson approved the Schedule proposed jointly by the parties, including dates for Initial Disclosures (June 30, 2016), end of fact discovery (March 15, 2017) and dispositive motions and motions *in limine* (June 30, 2017), meaning trial is not much further behind. A copy of the Scheduling Order is attached at Exhibit B. As explained by the Chief Judge for the District Court of Massachusetts, the Court's goal is to have trial in approximately one year. See <http://www.mad.uscourts.gov/boston/WGYvideo/Scheduling-Conference.htm>.

As the Board knows, according to the TTAB Dashboard and Performance Measures for Decisions, average pendency for the second quarter of 2016, is currently 170.3 weeks (i.e., over three years).<sup>3</sup> An Answer has not yet been filed in the subject opposition but, without any extensions or delays (including the pending Motion), the soonest the case would be briefed would be early 2018 (to say nothing of the average pendency).

In view of the timing and the importance of this matter to the parties, suspension at the TTAB appears appropriate to allow more expeditious resolution in Court.

### **III. THERE ARE NO UNUSUAL CIRCUMSTANCES IN THE CASE TO DEPART FROM THE BOARD'S STANDARD PRACTICE**

Opposer's attempts to manufacture unusual circumstances to avoid a speedy trial in Massachusetts must fail. It is inappropriate for Opposer to mischaracterize the legitimate defenses and the accurate description of the prosecution history as unusual, or to somehow suggest malfeasance by Applicant. It is not uncommon for applicants to point out that the experienced Examining Attorney, the individual charged with searching and approving applications, did not find a likelihood of confusion. As the Board knows, if the Examining Attorney found a likelihood of confusion, an Office Action would issue. Accordingly, in cases where a party has been accused of willful infringement, it is the norm for a party to raise legitimate defenses and point out the subject application had been approved in view of the allegedly conflicting trademark. In fact, it would be unusual not to, but such pleadings and circumstances in no way justify departure from the Board's standard practice.

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<sup>3</sup> <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/ttab-incoming-filings-and-performance> (accessed on July 1, 2016).

The search strategy and elapsed time of the search also do not create an unusual circumstance to avoid suspension and the irrelevant arguments interposed by Opposer seemed designed to try to obscure the issues before the Board. The Examining Attorney undergoes extensive training by senior attorneys in conducting searches, and 15 minutes, or less, is typically an appropriate amount of time for a search. Similarly, the Examining Attorney presumably decided not to separately search “HEALTH NEW ENGLAND” in view of the descriptiveness of those terms, and the dominant leading term TRINITY (the search would uncover any version of TRINITY, plus one of the descriptive terms, HEALTH, NEW, or ENGLAND). In any event, the actions of the Examining Attorney and the Office’s approval of an application do not create unusual circumstances to depart from the Board’s standard practice of suspension.

Applicant is promptly filing this Reply; however, according to the Certificate of Service accompanying the Response, the Certificate claims the Response was served on Applicant directly, not counsel of record in the TTAB proceeding (and it is not clear how the response was served to a company “electronically”). Opposer’s counsel should not be contacting the Applicant directly where there is counsel of record (although one attorney representing Applicant received a courtesy copy via email). Apart from this issue, the instant Reply is being filed 15 days after the Response, although pursuant to 37 CFR § 2.119 and TBMP 113, Applicant would be entitled to another five days.

#### **IV. CONCLUSION**

The Federal Civil Action involves the same parties, the same mark, and the same issues as those involved in the instant opposition proceeding and the determination of these issues will

not only bear on, but be dispositive of this proceeding and will do so in an expeditious manner. Suspension will avoid the unnecessary expenditure of the Board's and the parties' resources in litigating the same issue in two forums, and there are additional issues present in the Federal Civil Action.

Applicant respectfully requests the Board grant this Motion and suspend the proceeding pending final disposition of the Federal Civil Action.

Respectfully submitted,

Date: July 6, 2016

*/s/ Jennifer Fraser*  
John P. Guenther, Esq.  
Jennifer Fraser, Esq.  
DYKEMA GOSSETT PLLC  
39577 Woodward Ave., Ste. 300  
Bloomfield Hills, MI 48304-5086  
[ipmail@dykema.com](mailto:ipmail@dykema.com); [jfraser@dykema.com](mailto:jfraser@dykema.com);  
[jguenther@dykema.com](mailto:jguenther@dykema.com);  
*Attorneys for Applicant/Respondent*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 6th day of July 2016 a true and correct copy of the  
**MOTION TO SUSPEND** was served on the following parties as indicated below:

**VIA FIRST CLASS MAIL &  
COURTESY COPY VIA E-MAIL**

Nicholas J. Tuccillo, Esq.  
Grogan, Tuccillo & Vanderleeden, LLP  
1350 Main Street, Suite 508  
One Financial Plaza  
Springfield, MA 01103

[docket@gtv-ip.com](mailto:docket@gtv-ip.com)

*/s/ Jeremy Pisigan*

Paralegal

## Exhibit A

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

HEALTH NEW ENGLAND, INC.	. CIVIL NO. 15-30206-MAP
Plaintiff	.
	.
V.	. BOSTON, MASSACHUSETTS
	. JUNE 21, 2016
TRINITY HEALTH CORPORATION	.
Defendant	.
	.
. . . . .	

TRANSCRIPT OF MOTION HEARING  
BEFORE THE HONORABLE KATAHERINE A. ROBERTSON  
UNITED STATES MAGISTRATE JUDGE

APPEARANCES:

GROGAN, TUCCILLO & VANDERLEEDEN, LLP  
James K. Grogan, Esq.  
Kevin Vanderleeden, Esq.  
1350 Main Street, Suite 508  
Springfield, MA 01103  
413-736-5401  
grogan@gtv-ip.com

DYKEMA GOSSETT PLLC  
John Guenther, Esq.  
39577 Woodward Avenue, Suite 300  
Bloomfield Hills, MI 48304  
248-203-0700  
Jguenther2dykema.com

DYKEMA GOSSETT PLLC  
Jennifer Fraser, Esq.  
13001 Street N.W., Suite 300 West  
Washington, DC 20005  
(202) 906-8600  
jfraser@dykema.com

**MARYANN V. YOUNG**  
Certified Court Transcriber  
Wrentham, MA 02093  
(508) 384-2003

HERMES, NETBURN, O'CONNOR & SPEARING  
Matthew E. Bown, Esq.  
265 Franklin Street, 7th Floor  
Boston, MA 02110  
(617) 728-0050  
mbown@hermesnetburn.com

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**MARYANN V. YOUNG**  
**Certified Court Transcriber**  
**Wrentham, MA 02093**  
**(508) 384-2003**

1 probably, I don't know if he's known to you, but Ken  
2 Neiman, who's, who presided here for 20 years and has  
3 really been very successful and I think is well respected  
4 as a mediator, is on recall and is primarily engaged in  
5 mediation in his status as a recall magistrate judge. I'm  
6 not going to press you to do that. Both parties have to  
7 be interested in doing that for that to be fruitful I  
8 think, so if there comes a point in the course of this  
9 litigation, and we will revisit this question at the case  
10 management conference, but if there comes a point at this  
11 litigation where, you know, both parties think it might be  
12 fruitful to try to sit down with a mediator that's, and if  
13 you want to use the Court services, that's as simple as  
14 notifying my courtroom deputy and we can refer the case to  
15 mediation, but again, I'm not going to do that unless I  
16 hear jointly from the parties that that's of interest to  
17 them. We don't mandate ADR.

18 MR. GROGAN: Your Honor, I think under the  
19 circumstances that the, the plaintiff reserves its right  
20 to file for preliminary injunction. We feel at the present  
21 time since the, the mark, the, the infringing mark of the  
22 defendant is just now becoming into, into use. We feel  
23 very strongly that there is a serious risk of, of damage  
24 to the mark, infusion in the marketplace among our  
25 consumers and under the circumstances we, we reserve the

1 right to file for preliminary injunction.

2 THE COURT: All right. All right.

3 MR. GROGAN: And if, Your Honor, one other  
4 matter we have. There's pending now an, an opposition  
5 before the, the patent trademark office--

6 THE COURT: Yeah.

7 MR. GROGAN: --and there is a, we, we need to  
8 this is one last housekeeping issue. We'll be looking to  
9 put a protective order in place to expedite the, the  
10 exchange of information.

11 THE COURT: Yes.

12 MR. GROGAN: That one is a two tiered system.  
13 The plaintiffs feel that something like that, in that,  
14 that format is, is something that we're going to propose  
15 to the defendant to put in place in this particular case.

16 THE COURT: All right, well, so this is, this  
17 case is assigned to Judge Ponsor, and I would be the per,  
18 if there are disputes about the content of a proposed  
19 confidentiality agreement that, that governs the  
20 confidentiality of documents that are exchanged in  
21 discovery, I would be the person who would, in the first  
22 instance anyway, address that dispute, try to address that  
23 dispute to the extent the parties can work out that  
24 dispute all, all the better. If you can work out a  
25 proposed confidentiality or stipulated protective order,

## Exhibit B

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

HEALTH NEW ENGLAND, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Case No. 3:15-cv-30206-MAP
	)	
TRINITY HEALTH CORP., ET AL,	)	
	)	
Defendants.	)	

SCHEDULING ORDER

June 24, 2016

ROBERTSON, U.S.M.J.

The following schedule was established at the scheduling conference held on June 21, 2016:

<b>Date</b>	<b>Deadline/Event</b>
June 30, 2016	Completion of Fed. R. Civ. P. 26(a)(1) initial disclosures
October 3, 2016	Filing of motions for leave to amend the pleadings
March 15, 2017	Completion of fact discovery, including service of and responses to all written discovery (including requests for admissions) and non-expert depositions
March 20, 2017	Case management conference at 2:00 P.M.
March 29, 2017	Plaintiff's designation of trial expert(s) and disclosure of information required by Fed. R. Civ. P. 26(a)(2)
May 1, 2017	Defendant's designation of trial expert(s) and disclosure of information required by Fed. R. Civ. P. 26(a)(2)
May 15, 2017	Completion of Plaintiff's expert depositions
June 15, 2017	Completion of Defendant's expert depositions
June 30, 2017	Filing of dispositive motions
July 28, 2017	Filing of oppositions to dispositive motions
August 11, 2017	Filing of replies to dispositive motions, if any

It is So Ordered.

/s/ Katherine A. Robertson\_\_\_\_\_  
KATHERINE A. ROBERTSON  
United States Magistrate Judge