

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: July 11, 2016

Opposition No. 91227868

Health New England, Inc.

v.

Trinity Health Corporation

George C. Pologeorgis,
Administrative Trademark Judge:

Trinity Health Corporation (“Applicant”) seeks to register the mark TRINITY HEALTH NEW ENGLAND and design, as displayed below, for “Home health care services; Hospitals; Medical and pharmaceutical consultation; Medical services; Nursing services; Physician services; Providing long-term care facilities” in International Class 44.¹



On May 13, 2016, Health New England, Inc. (“Opposer”) filed a notice of opposition opposing the registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. In support of its asserted

¹ Application Serial No. 86779873, filed on October 6, 2015, based on a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The terms “HEALTH” and “NEW ENGLAND” are disclaimed.

claim, Opposer alleges prior common law use of the mark HEALTH NEW ENGLAND used in connection with the operation of a health maintenance organization which arranges health and medical care for its members through a network of selected hospitals and physicians. See ¶ 3 of notice of opposition. Opposer additionally pleads ownership of (1) the registered mark HEALTH NEW ENGLAND for various health maintenance organization services,² *id.*, and (2) pending application Serial No. 86771842 for the mark HEALTH NEW ENGLAND, in standard characters, for “home health care services; hospitals; medical and pharmaceutical consultation; medical services; nursing services; physician services; providing long-term care facilities” in International Class 44.³ See ¶ 4 of notice of opposition.

Pursuant to the Board’s May 13, 2016, institution order, the deadline for Applicant to file an answer to the notice of opposition was set for June 22, 2016. In lieu of filing an answer, Applicant, on June 6, 2016, filed a motion to suspend this opposition pending the disposition of a civil action between the parties herein filed in the United States District Court for the District of Massachusetts.⁴

This proceeding now comes before the Board for consideration of Applicant’s motion to suspend for civil action. The motion is fully briefed.

² Registration No. 1426061, registered on January 20, 1987. Section 8 and 15 affidavits accepted on January 20, 2007.

³ Filed on September 29, 2015, based on a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

⁴ Case No. 3:15-cv-30206, styled *Health New England, Inc. v. Trinity Health Corporation*, filed on or about November 23, 2015.

Applicant's Motion to Suspend for Civil Action

In support of its motion, Applicant maintains that suspension of this opposition proceeding is warranted because the civil action involves both Applicant and Opposer, the same trademarks, and common issues of law and fact. In view thereof, Applicant contends that any determination made by the district court would have a bearing on this proceeding.

In response, Opposer argues that the Board should not suspend this opposition proceeding since Applicant is inappropriately representing to the district court that the USPTO has already made a determination during the prosecution of Applicant's involved application that there is no likelihood of confusion between Opposer's pleaded mark and Applicant's involved mark. Additionally, Opposer argues that district court proceeding is in its early stages and that it is more likely that the Board would render a final determination of the opposition well before the final determination of likelihood of confusion by the district court.

Decision

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a).

The Board has carefully reviewed the civil action pleadings, including Applicant's counterclaim in the civil action, and finds that a decision by district court would have a bearing on the issues in this opposition proceeding. Specifically, in both this case and in the district court action, Opposer relies on its prior use of,

and the same registration for, its HEALTH NEW ENGLAND mark, and argues in both cases that Applicant's involved TRINITY HEALTH NEW ENGLAND and design mark is likely to be confused with Opposer's pleaded mark. If Opposer's prayer for relief is granted by the district court, Applicant will be prohibited from using its mark in its involved application. Moreover, the validity of Opposer's pleaded registration and pending application are at issue in the district court action. *See* Applicant's Counterclaim in Civil Action. More specifically, by way of its counterclaim, Applicant seeks to enjoin permanently Opposer from asserting any purported trademarks containing the wording HEALTH NEW ENGLAND against Applicant. If the district court enters judgment in favor of Applicant on its asserted counterclaim in the civil action, such an adjudication may have a bearing on Opposer's standing to pursue this opposition proceeding.

Furthermore, Board decisions are appealable to the district court. *See* Section 21(b) of the Trademark Act, 15 U.S.C. § 1071(b). Moreover, suspending this matter pending the final determination of the civil action will serve the interests of judicial economy.

Finally, Opposer's argument that it is more likely that the Board would render the final determination of the opposition well before the final determination of likelihood of confusion by the district court is merely speculative in nature, particularly since both this opposition proceeding and the district court action are both in their early stages. Furthermore, Opposer's argument that because Applicant is purportedly mispresenting to the district court that the USPTO has already made

a determination that Applicant's involved mark is not likely to cause confusion with Opposer's pleaded mark is not a reason not to suspend this case. That argument is an issue to be resolved by the district court.

Accordingly, Applicant's motion to suspend this proceeding for civil action is **GRANTED** as well taken. In view thereof, this opposition proceeding is *suspended* pending the final disposition of the civil action in the United States District Court for the District of Massachusetts, including all appeals.⁵

Within **twenty (20) days** after the final determination of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.⁶ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

The Board will reset trial dates upon resumption of the proceeding, if necessary and appropriate. During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period. Upon resumption, if appropriate, the Board may consolidate related Board cases.

⁵ In light of the Board's ruling herein, proceedings are deemed suspended as of the filing date of Applicant's motion to suspend for civil action, i.e., June 6, 2016.

⁶ A proceeding is considered to have been finally determined when an order or ruling that ends litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired. TBMP § 510.02(b) (2016).