

ESTTA Tracking number: **ESTTA763433**

Filing date: **08/09/2016**

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	HEALTHEOS BY MULTIPLAN, INC.		
Entity	Corporation	Citizenship	Wisconsin
Address	115 Fifth Avenue New York, NY 10003 UNITED STATES		

Attorney information	Robert Meloni Meloni & McCaffrey 3 Columbus Circle 15th Fl New York, NY 10019 UNITED STATES rmeloni@m2lawgroup.com Phone:2125206090		
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Applicant Information

Application No	86845521	Publication date	08/02/2016
Opposition Filing Date	08/09/2016	Opposition Period Ends	09/01/2016
Applicant	Softheon Inc. 1500 Stony Brook Road Stony Brook, NY 11794 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 2015/02/26 First Use In Commerce: 2015/02/26
All goods and services in the class are opposed, namely: Platform as a service (PAAS) featuring computer software for use by consumers, brokers, and agents for enabling consumers to compare and shop for health insurance

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2993586	Application Date	01/09/2002
Registration Date	09/13/2005	Foreign Priority Date	NONE
Word Mark	HEALTHEOS		

Design Mark	HEALTHEOS		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1999/12/11 First Use In Commerce: 1999/12/11 [Data management services, namely, tracking health care records and statistic-relating to members of health care and disease management organizations and tracking records and statistics related to treatment of disease and management of health care by doctors enrolled in healthcare and disease management organizations]</p> <p>Class 044. First use: First Use: 1999/12/11 First Use In Commerce: 1999/12/11 Managed health care services for physicians, health care providers, insurance companies and other participants in the health care industry</p>		

U.S. Registration No.	4894721	Application Date	05/14/2015
Registration Date	02/02/2016	Foreign Priority Date	NONE
Word Mark	HEALTHEOS		
Design Mark	HEALTHEOS		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 Medical cost management services for health care benefit plans of others; medical claims management services, namely, electronic re-pricing of transactions that are originated by physicians, hospitals, and ancillary medical care providers</p> <p>Class 036. First use: First Use: 2006/01/00 First Use In Commerce: 2006/01/00 Organizing and administration of preferred provider networks in the field of health care</p>		

Attachments	<p>76357328#TMSN.png(bytes)</p> <p>86629246#TMSN.png(bytes)</p> <p>Notice of Opposition-WELLTHEOS.pdf(558082 bytes)</p>
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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 Overnight Courier on this date.

Signature	/Robert S. Meloni/
Name	Robert Meloni
Date	08/09/2016

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

HEALTHEOS BY MULTIPLAN, INC.)	
)	Opposition No.
)	
Opposer,)	
)	<i>In the matter of:</i>
v.)	
)	Application Serial No. 86845521
SOFTHEON, INC.,)	
)	Published on March 16, 2016
)	Mark: WELLTHEOS
Applicant.)	
)	

In the matter of the application for registration of the mark WELLTHEOS in International Class 42, filed December 10, 2015 by SOFTHEON, INC. (“Applicant”), assigned Serial No. 86845521, and published for opposition in the *Official Gazette* on August 2, 2016, Opposer HEALTHEOS BY MULTIPLAN, INC. believes that it would be damaged by such registration, and hereby opposes the registration of Applicant’s mark pursuant to 15 U.S.C. §1063 and 37 C.F.R. §2.104.

The grounds for this opposition are as follows:

1. Opposer HEALTHEOS BY MULTIPLAN, INC. (“Opposer”) is a Wisconsin corporation with offices located c/o MultiPlan, Inc., 115 Fifth Avenue, New York, New York 10003.
2. On August 2, 2016, Opposer filed its first request to extend the time to oppose for a period of 60 days, to October 1, 2016.

3. Opposer is the owner of, and will rely herein upon, Federal Trademark No. 2993586 registered on September 13, 2005 in International Class 44 for the mark HEALTHEOS in the following services: “Managed health care services for physicians, health care providers, insurance companies and other participants in the health care industry.”

4. Opposer is the owner of, and will also rely herein upon, Federal Trademark No. 4894721 registered on February 2, 2016 in International Classes 35 and 36 for the mark HEALTHEOS in the following services: (i) Class 35: “Medical cost management services for health care benefit plans of others; medical claims management services, namely, electronic re-pricing of transactions that are originated by physicians, hospitals, and ancillary medical care providers” and (ii) Class 36: “Organizing and administration of preferred provider networks in the field of health care.”

5. Opposer’s mark HEALTHEOS, bearing Federal Trademark No. 2993586 (registered in Class 44), and Federal Trademark No. 4894721 (registered in Classes 35 and 36), is herein referred to as “Opposer’s Mark”.

6. Since at least December 11, 1999, Opposer, and/or the Opposer's related company or licensee and/or the Opposer's predecessor in interest, has been, and is now, using Opposer’s Mark in commerce in Class 44, on or in connection with the identified services in Class 44. 15 U.S.C. §1051(a), as amended.

7. Since at least January 2006, Opposer, or the Opposer's related company and/or licensee, and/or the Opposer's predecessor in interest, has been, and is now, using Opposer’s Mark in commerce in Classes 35 and 36, on or in connection with the identified services in Classes 35 and 36. 15 U.S.C. §1051(a), as amended.

8. Opposer's Mark was first used on December 11, 1999 and first used in commerce on December 11, 1999 in Class 44, and is now in use in such commerce.

9. Opposer's Mark, as amended and reclassified into Classes 35 and 36, was first used in Classes 35 and 36 services on January 1, 2006, and first used in commerce on January 1, 2006, and is now in use in such commerce.

10. On October 21, 2010, a Combined Declaration of Use in Commerce and Incontestability under §§8 and 15 of the Trademark Act, 15 U.S.C. §1058 and §1065 was filed by Opposer for the Opposer's Mark.

11. On November 10, 2010, the Declaration under §8 was accepted and the Declaration of Incontestability under §15 for the Opposer's Mark was acknowledged. The Opposer's Mark is incontestable.

12. On May 14, 2015, Opposer filed a Combined Declaration of Use and/or Excusable Non-use/Application for Renewal of Registration under §§8 and 9 in Class 44 for the Opposer's Mark, and amended the registration by deleting Class 35 services.

13. On June 11, 2015, the Combined Declaration under §§8 and 9 of the Trademark Act, 15 U.S.C. §1058 was accepted for Class 44. The Opposer's Mark was renewed in Class 44 and is now, and will remain in full force and effect, until June 11, 2025.

14. A copy of the TTAB record showing the current active status of Opposer's Mark in Class 44 (Reg. No. 2993586) is attached hereto as Exhibit A.

15. A copy of the TTAB record showing the current active status of Opposer's Mark in Classes 35 and 36 (Reg. No. 4894721) is attached hereto as Exhibit B.

16. Opposer's use of Opposer's Mark has been valid and continuous since at least December 1999 and has not been abandoned.

17. Opposer's Mark is symbolic of extensive goodwill. As a result of the substantial amounts of time and effort in its promotion, Opposer has developed valuable goodwill with respect to Opposer's Mark.

18. Notwithstanding Opposer's rights in and to Opposer's Mark, on December 10, 2015, Applicant filed an application under Section 1(a) for the mark WELLTHEOS in International Class 42 for the following services: "Platform as a service (PAAS) featuring computer software for use by consumers, brokers, and agents for enabling consumers to compare and shop for health insurance."

19. According to its application, Applicant's date of first use of its Mark in commerce was February 26, 2015.

20. The application was assigned Serial No. 86845521, and published for opposition in the *Official Gazette* on August 2, 2016 ("Applicant's Mark").

21. Applicant claims to be one of the nation's largest private health insurance exchanges. It offers consumers and insurance brokers tools and resources for assisting in enrolling individuals and families in Affordable Care Act compliant health insurance plans See <https://www.softheon.com/Site/resources/press-releases/pr47>. The Welltheos.com website describes its business as follows:

Welltheos is an easy-to-use, private exchange platform designed for consumers, brokers, and agents. The platform is designed to enhance the consumer experience, while offering brokers and agents the tools needed to power their enrollment activities and grow their business. Welltheos is committed to increasing health coverage accessibility and enabling consumers to easily compare and shop for brand-name insurance products offered through

healthcare.gov. By establishing relationships with Issuers, Welltheos represents 28,700 qualified health plans offered by 239 issuers participating on and off the Federally Facilitated Marketplace. For more information, visit www.welltheos.com.

<https://www.softheon.com/Site/resources/press-releases/pr47>

Similarity of Marks.

22. Applicant's Mark and Opposer's Mark are very similar in sound, appearance and meaning. The term "EOS" finds its meaning in Greek mythology, and means "the Greek goddess of dawn." See <http://www.merriam-webster.com/dictionary/Eos>. The term "THEO" also finds its meaning in Greek mythology, meaning "god" or "God." See http://www.etymonline.com/index.php?allowed_in_frame=0&search=theos.

23. Both Applicant's Mark and Opposer's Mark combine the term EOS or THEOS, in the case of Applicant, WELLTH with EOS or WELL with THEOS, or in the case of Opposer, HEALTH with EOS or HEAL with THEOS (Opposer).

24. The Opposer's Mark HEALTHEOS is fanciful or arbitrary, as it is a combination of the terms HEALTH and EOS (or HEAL and THEOS), signifying nothing other than the services offered by Opposer in Classes 35, 36 and 44. That is, the Greek words EOS or THEOS do not carry any other significance or have any other relationship to Opposer's services.

25. The terms EOS or THEOS are the dominant features of both marks. The mark WELLTHEOS shares a core portion of Opposer's senior mark HEALTHEOS. That is, overall, the phonetic sound and connotation of both marks are very similar, differentiated only by the first syllable.

26. Further, the syllables WELL and HEALTH signify the same thing (i.e. health and well-being or wellness) in the context of services that are both related to healthcare.

27. Likelihood of confusion is not avoided between otherwise confusingly similar marks merely by substituting the terms WELLTH (with EOS) or WELL (with THEOS), since the test for likelihood of confusion is expressed in terms of the dominance of the common terms. Since the dominant portions of both marks are the same (THEOS or EOS), confusion may be likely notwithstanding peripheral differences.

Similarity of Services and Trade Channels.

28. Both Applicant and Opposer are involved in the business of *healthcare*.

29. The question of likelihood of confusion must be determined based on an analysis of the marks as applied to the goods and/or services recited in the Applicant's application *vis-a-vis* the goods and/or services recited in an Opposer's registration.

30. Applicant's use of the Applicant's Mark does or is likely to falsely suggest a relationship between Applicant's services and Opposer's services. With respect to the similarity of the goods or services identified by the marks, the goods in question need not be identical or in direct competition with each other. Confusion may arise even where products are merely related, and where the public is likely to attribute the products and services to a single source.

31. The description of services for Opposer's Mark HEALTHEOS is quite broad in Class 44 ("Managed health care services for physicians, health care providers, insurance companies and other participants in the health care industry") and Classes 35 ("Medical cost management services for health care benefit plans of others; medical claims management services, namely, electronic re-pricing of transactions that are originated by physicians, hospitals, and ancillary medical care providers") and Class 36 ("Organizing and administration of preferred provider networks in the field of health care.")

32. While WELLTHEOS offers assistance to consumers, brokers and agents in finding appropriate healthcare plans, the scope of services of Applicant's business is more expansive.

33. If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. Opposer's Mark description of services is not proscribed by type of user or customer.

34. The target market for both WELLTHEOS and HEALTHEOS possess some degree of sophistication concerning the business of healthcare (*e.g.*, brokers, agents, health plan administrators, and the like). Even *assuming arguendo* that the services provided by Opposer and Applicant are not presently totally coextensive and *even further assuming arguendo* it is true that the relevant class of purchasers of HEALTHEOS services may be more sophisticated than the average retail consumer of WELLTHEOS services, it is also true that even professional buyers and sophisticated purchasers can be confused.

35. Applicant's use of WELLTHEOS could easily be associated with Opposer's Mark when taking into consideration the possibility of Opposer expanding in the same or similar areas in the future. Thus, although a registrant's current business practices may be quite narrow, they may change at any time from, for example, services offered to a specialized group within one industry to individual consumer sales within the same industry.

36. Upon information and belief, Opposer avers that its customers, and the general public, are likely to be confused, mistaken or deceived as to the origin and sponsorship of

Applicant's proposed services of Applicant's Mark and misled into believing that such services emanate from, or are licensed by, or are in some way directly or indirectly associated with, approved by or sponsored by Opposer, to the damage and detriment of Opposer and its reputation.

37. Further, deficiencies or faults in the quality of Applicant's services are likely to reflect negatively upon, tarnish and seriously injure the reputation which Opposer has established for services provided under Opposer's Registered Mark.

38. The classification of services for Opposer's Mark includes Class 35. Applicant's Mark was originally in Class 35. In the Office Action dated April 13, 2016, the Trademark Examiner deemed the Applicant's description of services to be improperly classified and, as a result, it was reclassified by Examiner's Amendment to Class 42 ("Science and Technology Services").

39. Further, the classification of goods and services has no bearing on the question of likelihood of confusion. Rather, it is the manner in which the applicant and/or registrant have identified their goods or services that is controlling. Applicant's business is in the healthcare industry, and its description states as much ("...computer software for use by consumers, brokers, and agents for enabling consumers to compare and shop for health insurance").

40. The issue is compounded by the fact that Applicant's Mark could easily be associated with Opposer's Mark when taking into consideration the possibility of Opposer expanding in the same or similar areas in the future.

41. Applicant's use of an application to register Applicant's Mark is without the consent or permission of Opposer.

42. Opposer's first use of Opposer's Mark precedes the filing of Applicant's Mark in the United States Patent and Trademark Office.

43. Upon information and belief, Opposer is likely to be damaged by registration of Applicant's Mark in that the *prime facie* effect of registration of Applicant's Mark would tend to impair Opposer's right to use the wording contained in Applicant's Mark.

44. Upon information and belief, Opposer also avers that it will be damaged by the registration of Applicant's Mark in that the alleged Mark will dilute the distinctiveness of Opposer's Mark within the meaning of the provisions of the Federal Trademark Dilution Act of 1995, as amended by the Trademark Revision Act of 2006.

WHEREFORE, Opposer prays that the application for registration of the proposed mark WELLTHEOS assigned Serial No. 86845521 be refused and that this Opposition be sustained in favor of Opposer.

Opposer hereby appoints Robert S. Meloni, a member of the Bar of the State of New York, Meloni & McCaffrey, A Professional Corporation, 3 Columbus Circle, 15th Floor, New York, New York 10019, to act as attorney in the matter of the opposition identified above, to prosecute set opposition, to transact all business in the United States Patent and Trademark Office, and in the United States courts connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to same.

Dated: August 9, 2016

Respectfully submitted for Opposer,

MELONI & McCAFFREY
A Professional Corporation



By: _____

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New York, New York 10019
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Counsel for Opposer

EXHIBIT A



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HEALTHEOS

Word Mark HEALTHEOS

Goods and Services (CANCELLED) IC 035. US 100 101 102. G & S: [Data management services, namely, tracking health care records and statistics relating to members of health care and disease management organizations and tracking records and statistics related to treatment of disease and management of health care by doctors enrolled in health care and disease management organizations]. FIRST USE: 19991211. FIRST USE IN COMMERCE: 19991211

IC 044. US 100 101. G & S: Managed health care services for physicians, health care providers, insurance companies and other participants in the health care industry. FIRST USE: 19991211. FIRST USE IN COMMERCE: 19991211

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76357328

Filing Date January 9, 2002

Current Basis 1A

Original Filing Basis 1A

Published for Opposition June 21, 2005

Change In Registration CHANGE IN REGISTRATION HAS OCCURRED

Registration Number **2993586**

Registration Date September 13, 2005

Owner (REGISTRANT) HEALTHEOS BY MULTIPLAN, INC. CORPORATION WISCONSIN 115 FIFTH AVENUE C/O MULTIPLAN INC. NEW YORK NEW YORK 10003

Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Michael G. Kelber
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). PARTIAL SECTION 8(10-YR) 20150611.
Renewal 1ST RENEWAL 20150611
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EXHIBIT B



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HEALTHEOS

Word Mark	HEALTHEOS
Goods and Services	IC 035. US 100 101 102. G & S: Medical cost management services for health care benefit plans of others; medical claims management services, namely, electronic re-pricing of transactions that are originated by physicians, hospitals, and ancillary medical care providers. FIRST USE: 20060101. FIRST USE IN COMMERCE: 20060101
	IC 036. US 100 101 102. G & S: Organizing and administration of preferred provider networks in the field of health care. FIRST USE: 20060100. FIRST USE IN COMMERCE: 20060100
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86629246
Filing Date	May 14, 2015
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	November 17, 2015
Registration Number	4894721
Registration Date	February 2, 2016
Owner	(REGISTRANT) HEALTHEOS BY MULTIPLAN, INC. CORPORATION WISCONSIN 115 FIFTH AVENUE C/O MULTIPLAN INC. NEW YORK NEW YORK 10003
Assignment Recorded	ASSIGNMENT RECORDED

Attorney of Record Michael G. Kelber
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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HEALTHEOS BY MULTIPLAN, INC.)	
)	Opposition No.
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)	<i>In the matter of:</i>
v.)	
)	Application Serial No. 86845521
SOFTHEON, INC.,)	Published on March 16, 2016
)	Mark: WELLTHEOS
Applicant.)	
)	

The foregoing NOTICE OF OPPOSITION has been served on the following via overnight courier on August 9, 2016:

Lee Grosskreuz Hechtel, Esq.
Eugene Sayan, Esq.
Softheon, Inc.
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Stony Brook, New York 11794
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Applicant's Representative



Robert S. Meloni