ESTTA Tracking number: **ESTTA831379**
Filing date: **07/05/2017**

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	ScrippsHealth
Granted to Date of previous extension	07/05/2017
Address	4275 Campus Point Court San Diego, CA 92121 UNITED STATES
Party who filed Extension of time to oppose	Scripps Health
Relationship to party who filed Extension of time to oppose	There was a typographical error and there is not a space between opposer's name as entered in the extension request Scripps Health. Opposer is ScrippsHealth.

Attorney information	Barry F. Soalt Procopio Cory Hargreaves & Savitch LLP 525 B Street, Suite 2200 San Diego, CA 92101 UNITED STATES Email: calendaring@procopio.com, barry.soalt@procopio.com, geena.jackson@procopio.com Phone: 619 525 3865

Applicant Information

Application No	87201304	Publication date	03/07/2017
Opposition Filing Date	07/05/2017	Opposition Period Ends	07/05/2017
Applicant	Scrip, Inc. 360 Veterans Parkway, Suite 115 Bollingbrook, IL 60440 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Catalog ordering service and electronic-catalog ordering service featuring durable medical equipment and supplies; wholesale distributorships featuring durablemedical equipment and supplies

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2066118	Application Date	07/06/1994
Registration Date	06/03/1997	Foreign Priority Date	NONE
Word Mark	SCRIPPS HEALTH		
Design Mark	SCRIPPS HEALTH		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/01/01 First Use In Commerce: 1993/01/01 educational services, namely, conducting classes and seminars on general healthissues Class 042. First use: First Use: 1993/01/01 First Use In Commerce: 1993/01/01 medical and health care services, general acute care hospital services, skilled-nursing services, medical laboratory services, home health care, outpatient medical services, leasing of durable medical equipment and medical and bio-technicalresearch		

Attachments	74546328#TMSN.png(bytes) NOTICE OF OPPOSITION Scripmedical.pdf(1576850 bytes)

Signature	/Barry F. Soalt/
Name	Barry F. Soalt
Date	07/05/2017

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

In the Matter of Trademark Application Serial No. 87/201,304 For the Mark: SCRIPMEDICAL (stylized) International Class 35 Published: March 7, 2017 SCRIPPSHEALTH Opposer, v. SCRIP, INC. Applicant.	Opposition No.: _____

NOTICE OF OPPOSITION

SCRIPPSHEALTH ("Opposer"), a California corporation, having a principal place of business at 4275 Campus Point Ct., San Diego, California 92121, by and through its undersigned attorneys, hereby opposes registration of the mark SCRIPMEDICAL, Serial No. 87/201,304, in International Class 35, published March 7, 2017 (the Opposed Mark), filed by Scrip, Inc. ("Applicant"), with an address of 360 Veterans Parkway, Suite 115, Bollingbrook, Illinois 60440. Opposer will be damaged by registration of the SCRIPMEDICAL mark, and therefore opposes registration of the application Serial No. 87/201,304, in International Class 35 pursuant to 15 U.S.C. §§ 1052 and 1063, and hereby requests that the application for registration in class 35 be denied and refused.

As grounds in support of its opposition, Opposer alleges as follows:

1. Opposer is the owner of the service mark registration for SCRIPPS HEALTH, Registration No. 2,066,118, which issued on June 3, 1997, and has achieved incontestable status.

2. On October 12, 2016, Applicant filed service mark application Serial No. 87/201,304 to register the mark SCRIPMEDICAL based on intent-to-use in International Class 35 for "Catalog ordering service and electronic catalog ordering service featuring durable medical equipment and supplies; wholesale distributorships featuring durable medical equipment and supplies." Said application was published for opposition on March 7, 2017, and Opposer filed a 90 day Request for Extension of Time to Oppose the application, to and including July 5, 2017.

3. Opposer owns the incontestable service mark registration for SCRIPPS HEALTH, Reg. No. 2,066,118 in International Classes 41 and 42. International Class 42 services cover "medical and health care services, general acute care hospital services, skilled nursing services, medical laboratory services, home health care, outpatient medical services, leasing of durable medical equipment and medical and biotechnical research" (a copy of the Registration Certificate and the U.S. Patent and Trademark Office's TSDR status record for this registration are attached hereto as Exhibit "A").

4. Opposer has also continuously used SCRIPPS as a common law mark having used said mark in connection with its medical and healthcare services long prior to its 1993 first use of SCRIPPS HEALTH in Reg. No. 2, 066,118. Opposer is well-known and referred to under the SCRIPPS mark, name and identity throughout the pertinent public for the outstanding quality of its medical and healthcare services.

5. Opposer's use of SCRIPPS in connection with the above medical and healthcare

services, and its use and registration of SCRIPPS HEALTH in Reg. No. 2,066.118 for the services recited therein occurred long prior to Applicant's filing date in the intent-to-use application for SCRIPMEDICAL (Serial No. 87/201,304), and on information and belief, long prior to any use by Applicant of the SCRIPMEDICAL mark in interstate commerce. Therefore, Opposer's use of its SCRIPPS mark and the use, filing and registration of its SCRIPPS HEALTH service mark registration predates any constructive use/filing date and/or actual use date of the Applicant in Application Serial No. 87/201,304.

6. The SCRIPPS HEALTH registration of Opposer (Reg. No. 2,066,118) is evidence of Opposer's exclusive right to use the mark in commerce for the services specified in the registration.

7. Applicant's mark, SCRIPMEDICAL, is confusingly similar to and conveys the same or similar commercial impression as Opposer's SCRIPPS mark and SCRIPPS HEALTH mark and registration for overlapping services and field of use, namely medical and healthcare services, therefore denying to Opposer the benefits of exclusive rights under its registration marks. The respective marks are highly similar in appearance, sound, meaning and commercial impression. Applicant's use of SCRIPMEDICAL for the sale and distribution of durable medical equipment creates a likelihood of confusion with Opposer's SCRIPPS HEALTH and SCRIPPS mark and name for overlapping medical and healthcare services, insofar as "health" and "medical" convey highly similar commercial impressions, and have similar meaning in the context of healthcare and medical services. The services provided by the respective parties under the SCRIPMEDICAL and SCRIPPS HEALTH marks (and SCRIPPS mark and name) are highly similar and overlapping and are directed to the same or similar marketing channels of trade in the medical and healthcare field, such that the marks are both likely to be encountered by

the same consuming public. Therefore, Applicant's mark so resembles Opposer's registered mark SCRIPPS HEALTH and common law SCRIPPS mark, name and identity as to be likely to cause confusion, or to cause mistake or to deceive.

8. Upon information and belief, Opposer's services, and Applicant's services both travel in the same or similar overlapping channels of trade, and are directed to the medical and healthcare services field.

9. Opposer has spent substantial time, effort and money to promote its medical and healthcare services under its SCRIPPS HEALTH registration and its SCRIPPS mark and tradename, and said marks have attained substantial goodwill in the marketplace.

10. Purchasers familiar with Opposer's services are likely to believe that Applicant's services are sponsored by, authorized by, endorsed by, affiliated with or otherwise approved by Opposer, because Applicant's SCRIPMEDICAL mark is so highly similar to Opposer's SCRIPPS HEALTH registration and SCRIPPS mark and tradename.

11. The services purported to be provided by the Applicant include services which third parties may assume emanated from Opposer, specifically the provision of durable medical equipment and supplies; and wholesale distributorships featuring durable medical equipment and supplies," as alleged in the application. There exists a substantial likelihood of confusion of the relevant public who are exposed to both marks in connection with the Applicant's services and those of Opposer. The Applicant's catalog and distribution services of durable medical equipment under the SCRIPMEDICAL mark will be perceived as being sponsored by, associated with or somehow affiliated with Opposer's medical and healthcare services under the SCRIPPS HEALTH registration and the SCRIPPS mark, name and identity, and thus is likely to cause

confusion, mistake or deception as to source of its goods and services.

12. WHEREFORE, Opposer respectfully requests that Application Serial No. 87/201,304 be refused and denied registration. Opposer believes and avers that it will be damaged by the registration of application Serial No. 87/201,304, as aforesaid and requests that Applicant be required to answer the allegations of this Notice of Opposition, and that the opposition to said application be sustained.

Respectfully submitted,
PROCOPIO, CORY, HARGREAVES &
SAVITCH LLP

DATED: July 5, 2017

By: /Barry F. Soalt/
Barry F. Soalt
Attorneys for Opposer

530 B Street, Suite 2100
San Diego, CA 92101
Tel: (619) 525-3865
Fax: (619) 235-0398
Email: docketing@procopio.com
Reference No. 106921-OPP001

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION is being mailed on July 5, 2017 by U.S. First Class Mail to Applicant's attorney of record as follows:

Kristin J. Achterhof
Katten Muchin Rosenman, LLP
525 West Monroe Street
Chicago, Il 60661

Scrip, Inc.
360 Veterans Parkway, Suite 115
Bollingbrook, IL 60440

Dated: July 5, 2017

By: /Geena L. Jackson/
Geena L. Jackson

EXHIBIT A

Int. Cls.: 41 and 42
Prior U.S. Cls.: 100, 101 and 107
United States Patent and Trademark Office
Amended

Reg. No. 2,066,118
Registered June 3, 1997
OG Date Oct. 2, 2007

SERVICE MARK
PRINCIPAL REGISTER

SCRIPPS HEALTH

SCRIPPSHEALTH (CALIFORNIA CORPORATION)
4275 CAMPUS POINT CT.
SAN DIEGO, CA 92121

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,545,760, 1,546,839 AND OTHERS.

FOR: EDUCATIONAL SERVICES, NAMELY, CONDUCTING CLASSES AND SEMINARS ON GENERAL HEALTH ISSUES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 1-1-1993; IN COMMERCE 1-1-1993.

FOR: MEDICAL AND HEALTH CARE SERVICES, GENERAL ACUTE CARE HOSPITAL SERVICES, SKILLED NURSING SERVICES, MEDICAL LABORATORY SERVICES, HOME HEALTH CARE, OUTPATIENT MEDICAL SERVICES, LEASING OF DURABLE MEDICAL EQUIPMENT AND MEDICAL AND BIOTECHNICAL RESEARCH, IN CLASS 42 (U.S. CL. 100).

FIRST USE 1-1-1993; IN COMMERCE 1-1-1993.

SER. NO. 74-546,328, FILED 7-6-1994.

In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Oct. 2, 2007.

DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE

EXHIBIT A

Int. Cls.: 41 and 42

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,066,118

United States Patent and Trademark Office

Registered June 3, 1997

SERVICE MARK
PRINCIPAL REGISTER

SCRIPPSHEALTH

SCRIPPSHEALTH (CALIFORNIA CORPORATION)
4275 CAMPUS POINT CT.
SAN DIEGO, CA 92121

FOR: EDUCATIONAL SERVICES, NAMELY, CONDUCTING CLASSES AND SEMINARS ON GENERAL HEALTH ISSUES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 1-1-1993; IN COMMERCE 1-1-1993.

FOR: MEDICAL AND HEALTH CARE SERVICES, GENERAL ACUTE CARE HOSPITAL SERVICES, SKILLED NURSING SERVICES, MEDICAL LABORATORY SERVICES, HOME HEALTH CARE, OUTPATIENT MEDICAL SERVICES, LEASING OF DURABLE MEDICAL EQUIPMENT AND MEDICAL AND BIOTECHNICAL RESEARCH, IN CLASS 42 (U.S. CL. 100).

FIRST USE 1-1-1993; IN COMMERCE 1-1-1993.

OWNER OF U.S. REG. NOS. 1,545,760, 1,546,839 AND OTHERS.

SER. NO. 74-546,328, FILED 7-6-1994.

ANGELA LYKOS, EXAMINING ATTORNEY

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Mark: SCRIPPS HEALTH

SCRIPPS HEALTH

US Serial Number: 74546328

Application Filing Date: Jul. 06, 1994

US Registration Number: 2066118

Registration Date: Jun. 03, 1997

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Sep. 07, 2016

Publication Date: Mar. 11, 1997

Mark Information

Mark Literal Elements: SCRIPPS HEALTH

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 Registrations: 1545760, 1545761, 1545762, 1546839 and others

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: educational services, namely, conducting classes and seminars on general health issues

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1993

Use in Commerce: Jan. 01, 1993

For: medical and health care services, general acute care hospital services, skilled nursing services, medical laboratory services, home health care, outpatient medical services, leasing of durable medical equipment and medical and biotechnical research

International Class(es): 042 - Primary Class

U.S Class(es): 100

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1993

Use in Commerce: Jan. 01, 1993

Basis Information (Case Level)

Filed Use:	Yes	**Currently Use:**	Yes	**Amended Use:**	No
Filed ITU:	No	**Currently ITU:**	No	**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: ScrippsHealth

Owner Address: 4275 Campus Point Ct.
San Diego, CALIFORNIA 92121
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: CALIFORNIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Barry F. Soalt

Docket Number: 106921-37

Attorney Primary Email Address: docketing@procopio.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Barry F. Soalt
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525 B Street, Suite 2200
SAN DIEGO, CALIFORNIA 92101
UNITED STATES

Phone: 619 525 3865

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Correspondent e-mail: docketing@procopio.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 07, 2016	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Sep. 07, 2016	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	77315
Sep. 07, 2016	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	77315
Aug. 25, 2016	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Jun. 03, 2016	TEAS SECTION 8 & 9 RECEIVED	
Aug. 29, 2007	AMENDMENT UNDER SECTION 7 - ISSUED	
Aug. 29, 2007	ASSIGNED TO PARALEGAL	61619
Jul. 17, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jul. 17, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 25, 2007	ASSIGNED TO PARALEGAL	67723
Jun. 04, 2007	SEC 7 REQUEST FILED	
Jun. 04, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 04, 2007	PAPER RECEIVED	
Dec. 13, 2006	CASE FILE IN TICRS	
Aug. 07, 2003	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jun. 02, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
May 30, 2003	TEAS SECTION 8 & 15 RECEIVED	
Jun. 03, 1997	REGISTERED-PRINCIPAL REGISTER	
Mar. 11, 1997	PUBLISHED FOR OPPOSITION	
Feb. 07, 1997	NOTICE OF PUBLICATION	
Nov. 26, 1996	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 15, 1996	EXAMINER'S AMENDMENT MAILED	
Jun. 13, 1996	LETTER OF SUSPENSION MAILED	
Mar. 28, 1996	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Sep. 25, 1995	NON-FINAL ACTION MAILED	
Sep. 06, 1995	LETTER OF SUSPENSION MAILED	

Aug. 04, 1995	ASSIGNED TO EXAMINER	72513
May 01, 1995	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 02, 1995	NON-FINAL ACTION MAILED	
Jan. 23, 1995	ASSIGNED TO EXAMINER	69193
Jan. 23, 1995	ASSIGNED TO EXAMINER	72156
Jan. 06, 1995	ASSIGNED TO EXAMINER	72506

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jun. 03, 2017

Change in Registration: Yes

Amendment to a Registration/Renewal Certificate: The drawing is amended to appear as follows: SCRIPPS HEALTH

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Sep. 07, 2016