

ESTTA Tracking number: **ESTTA845224**

Filing date: **09/12/2017**

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	Multiplan, Inc.
Granted to Date of previous extension	09/13/2017
Address	115 Fifth Avenue New York, NY 10003 UNITED STATES

Attorney information	Michael G. Kelber Neal, Gerber & Eisenberg LLP Two North LaSalle Street Suite 1700 Chicago, IL 60602 UNITED STATES Email: trademarks@nge.com, mkelber@nge.com, jcohen@nge.com, mparnaby@nge.com
----------------------	--

Applicant Information

Application No	87298752	Publication date	05/16/2017
Opposition Filing Date	09/12/2017	Opposition Period Ends	09/13/2017
Applicant	Multiplan USA Corporation Suite 1560 1450 Brickell Avenue Miami, FL 33131 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2016/12/01 First Use In Commerce: 2016/12/01 All goods and services in the class are opposed, namely: Real estate funds investment services; Real estate investment services; Real estate management consultation; Real estate management services
Class 037. First Use: 2016/12/01 First Use In Commerce: 2016/12/01 All goods and services in the class are opposed, namely: Real estate development

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1839584	Application Date	07/09/1993
-----------------------	---------	------------------	------------

Registration Date	06/14/1994	Foreign Priority Date	NONE
Word Mark	MULTIPLAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1991/05/00 First Use In Commerce: 1991/05/00 medical cost management services for preferred provider health plans and patients; cost management services for the health plans of others		

U.S. Registration No.	3456460	Application Date	04/16/2007
Registration Date	07/01/2008	Foreign Priority Date	NONE
Word Mark	MULTIPLAN NETWORK		
Design Mark	MULTIPLAN NETWORK		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2004/03/01 First Use In Commerce: 2004/03/01 Administration of a network of independent healthcare providers in preferred provider plans in the healthcare field wherein independent healthcare providers agree to accept rates of reimbursement as full payment for services rendered or administered to individuals enrolled in health care benefit programs issued or administered by clients of applicant		

U.S. Registration No.	3384174	Application Date	02/07/2007
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	VALUEPOINT BY MULTIPLAN		
Design Mark	ValuePoint By Multiplan		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/11/01 First Use In Commerce: 2005/11/01 Managed health care services, namely, operation and administration of a network of independently contracted health care providers who have agreed to accept discounted reimbursement for health care services rendered to members of non-insured or high member contribution medical card programs		

Attachments	77157808#TMSN.png(bytes) 77101141#TMSN.png(bytes) Notice of Opposition re MULTIPLAN USA.pdf(124276 bytes) MULTIPLAN Opposition Exhibit A final.pdf(254894 bytes)
-------------	---

Signature	/Michael G. Kelber/
Name	Michael G. Kelber
Date	09/12/2017

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

In the Matter of Application Serial No.:
87/298,752 for MULTIPLAN

Published in the Official Gazette
on May 16, 2017

MULTIPLAN, INC.,

Opposer,

v.

MULTIPLAN USA CORPORATION,

Applicant.

NOTICE OF OPPOSITION

This Notice of Opposition is submitted in the matter of Application Serial No. 87/298,752 for registration by MultiPlan USA Corporation (“Applicant”) of the mark MULTIPLAN based upon its claimed use of the mark in connection with “real estate funds investment services; real estate investment services; real estate management consultation; real estate management services” in Class 36 and “real estate development.” in Class 37 (collectively, the “Claimed Services”), which was published for opposition in the Official Gazette on May 16, 2017. Multiplan, Inc. (“MultiPlan”), a New York corporation having a place of business at 115 Fifth Avenue, New York, NY 10003, believes that it would be damaged by the registration of this mark for the services described above, and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. For more than 30 years, MultiPlan has offered healthcare cost management solutions and a preferred provider network under the service mark MULTIPLAN®, which is now among the largest networks of proprietary preferred provider organizations (PPOs) in the country, and includes more than 900,000 providers and services more than 68 million consumers.

In connection with its PPO services, MultiPlan also offers administrative, cost-analytics and financial services.

2. As a result of the enormous time, effort and resources devoted to promoting its MULTIPLAN® brand, MultiPlan has built substantial goodwill symbolized by the MULTIPLAN® mark, which is now among its most valuable assets.

3. To protect its substantial rights in the MULTIPLAN® name and mark, MultiPlan has obtained registrations from the United States Trademark Office for MULTIPLAN® in connection with cost management services for health plans (Reg. No. 1,839,584), MULTIPLAN NETWORK® in connection with administration of a network of health care providers (Reg. No. 3,456,460) and VALUEPOINT BY MULTIPLAN® in connection with managed health care services (Reg. No. 3,384,174), which are now incontestable pursuant to 15 U.S.C. § 1065. As a result, MultiPlan owns substantial goodwill in its MULTIPLAN® marks, which is a significant and invaluable asset of its business. Printouts from the U.S. Patent & Trademark Office website showing the current status and title of the registrations listed above are attached hereto as Exhibit A.

4. On January 12, 2017, long after MultiPlan's MULTIPLAN marks had become established and well-known in the relevant market, Applicant applied to register the mark MULTIPLAN USA (App. Serial No. 87/298,752) based upon its alleged use of the mark in connection with the Claimed Services. On May 16, 2017, the application was published for opposition. MultiPlan timely filed and was granted an Extension of Time, which has since been extended by consent with counsel for Applicant. The window for opposition closes September 13, 2017. Accordingly, this Notice is being timely filed.

5. Registration of the MULTIPLAN mark by Applicant is likely to cause confusion with MultiPlan's registered MULTIPLAN marks.

6. Should registration be allowed, consumers, upon seeing Applicant's MULTIPLAN mark used in connection with Applicant's services, are likely to mistakenly believe that it, and the services provided in connection with it, originated with or are connected with, sponsored by, associated with, or licensed or approved by MultiPlan. Thus, the registration and alleged use by Applicant of the MULTIPLAN mark in connection with the recited services are likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1052(d).

7. If a registration is issued to Applicant for the MULTIPLAN mark, the confusion with MultiPlan's MULTIPLAN marks would result in damage and injury to MultiPlan and the public. Registration of this term would give Applicant an unqualified right to wrongfully appropriate MultiPlan's valuable goodwill and reputation associated with MultiPlan's marks; to benefit from the likely confusion among purchasers led to believe that Applicant's services are related in some fashion to MultiPlan; to dilute the distinctiveness of MultiPlan's marks and harm its goodwill and reputation associated with its marks; to tarnish MultiPlan's good name by offering confusingly similar services not subject to MultiPlan's quality controls; and to restrict the natural growth of MultiPlan's MULTIPLAN marks.

WHEREFORE, MultiPlan, Inc. requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained. MultiPlan requests that the requisite filing fee be charged to the deposit account of Neal, Gerber & Eisenberg, LLP, Account No. 502261.

Respectfully submitted,

Date: September 12, 2017

By: /Michael G. Kelber/
One of the Attorneys for
MultiPlan, Inc.

Michael G. Kelber
Jessica Rissman Cohen
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street
Chicago, Illinois 60602-3801
(312) 269-8000

26700843.2

EXHIBIT A



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Sep 12 05:21:44 EDT 2017

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSER DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	MULTIPLAN
Goods and Services	IC 035. US 100 101. G & S: medical cost management services for preferred provider health plans and patients; cost management services for the health plans of others. FIRST USE: 19910500. FIRST USE IN COMMERCE: 19910500
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	74410481
Filing Date	July 9, 1993
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	March 22, 1994
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	1839584
Registration Date	June 14, 1994
Owner	(REGISTRANT) MULTIPLAN, INC. CORPORATION NEW YORK 115 FIFTH AVENUE 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). SECTION 8(10-YR) 20140419.
Renewal	2ND RENEWAL 20140419

Live/Dead
Indicator

LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Sep 12 05:21:44 EDT 2017

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSER DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

MULTIPLAN NETWORK

Word Mark	MULTIPLAN NETWORK
Goods and Services	IC 035. US 100 101 102. G & S: Administration of a network of independent healthcare providers in preferred provider plans in the healthcare field wherein independent healthcare providers agree to accept rates of reimbursement as full payment for services rendered or administered to individuals enrolled in health care benefit programs issued or administered by clients of applicant. FIRST USE: 20040301. FIRST USE IN COMMERCE: 20040301
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77157808
Filing Date	April 16, 2007
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 15, 2008
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	3456460
Registration Date	July 1, 2008
Owner	(REGISTRANT) Multiplan, Inc. CORPORATION NEW YORK 115 Fifth Avenue New York NEW YORK 10003
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Michael G. Kelber

Prior Registrations 1839584

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NETWORK" APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Sep 12 05:21:44 EDT 2017

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSER DICT](#) [SEARCH OG](#) [BOTTOM](#) [HELP](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)

ValuePoint By Multiplan

Word Mark	VALUEPOINT BY MULTIPLAN
Goods and Services	IC 035. US 100 101 102. G & S: Managed health care services, namely, operation and administration of a network of independently contracted health care providers who have agreed to accept discounted reimbursement for health care services rendered to members of non-insured or high member contribution medical card programs. FIRST USE: 20051101. FIRST USE IN COMMERCE: 20051101
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77101141
Filing Date	February 7, 2007
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	December 4, 2007
Registration Number	3384174
Registration Date	February 19, 2008
Owner	(REGISTRANT) Multiplan, Inc. CORPORATION NEW YORK 115 Fifth Avenue New York NEW YORK 10003
Assignment Recorded	ASSIGNMENT RECORDED

Attorney of Record Robert S. Meloni
Prior Registrations 1839584
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSER DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)