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Filing date: **08/22/2018**

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

Proceeding	91238423
Party	Defendant Virtual Health Partners, Inc.
Correspondence Address	MARK FARBER FARBER LLC 4 CORPORATE DR, STE 287 SHELTON, CT 06484 UNITED STATES markfarber@farberllc.com, docketing@farberllc.com 203-286-5254
Submission	Answer and Counterclaim
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Signature	/Mark Farber/
Date	08/22/2018
Attachments	2018-08-22 - HP v. VHP - Answer and Counterclaim.pdf(106160 bytes )

### Registrations Subject to the filing

Registration No.	1882483	Registration date	03/07/1995
Registrant	HealthPartners, Inc. 8100 34th Avenue South P.O. Box 1309 BLOOMINGTON, MN 55425 UNITED STATES		

### Goods/Services Subject to the filing

Class 036. First Use: 1993/03/03 First Use In Commerce: 1993/03/03  
All goods and services in the class are requested, namely: underwriting insurance in the field of health, medical and dental

### Grounds for Cancellation

The mark is or has become generic	Trademark Act Sections 14(3), or Section 23 if on Supplemental Register		
Registration No.	1880942	Registration date	02/28/1995
Registrant	HealthPartners, Inc. 8170 33rd Avenue South Minneapolis, MN 55425 UNITED STATES		

### Goods/Services Subject to the filing

Class 041. First Use: 1993/03/03 First Use In Commerce: 1993/03/03  
All goods and services in the class are requested, namely: educational services, namely conducting-classes and seminars on the topics of health care, personal enrichment and family care issues

## Grounds for Cancellation

The mark is or has become generic		Trademark Act Sections 14(3), or Section 23 if on Supplemental Register	
Registration No.	1885441	Registration date	03/21/1995
Registrant	HealthPartners, Inc. 8100 34th Avenue South Bloomington, MN 55425 UNITED STATES		

## Goods/Services Subject to the filing

Class 044. First Use: 1993/03/03 First Use In Commerce: 1993/03/03  
All goods and services in the class are requested, namely: health care in the nature of a health maintenance organization providing medical and dental care

## Grounds for Cancellation

The mark is or has become generic		Trademark Act Sections 14(3), or Section 23 if on Supplemental Register	
Registration No.	4529705	Registration date	05/13/2014
Registrant	HealthPartners, Inc. 8170-33rd Avenue South Bloomington, MN 55425 UNITED STATES		

## Goods/Services Subject to the filing

Class 016. First Use: 1993/03/03 First Use In Commerce: 1993/03/03  
All goods and services in the class are requested, namely: Printed materials, namely, newsletters, magazines, pamphlets and brochures in the field of health care; printed surveys, questionnaires and reports in the field of health care

Class 035. First Use: 1994/12/31 First Use In Commerce: 1994/12/31  
All goods and services in the class are requested, namely: Retail pharmacy services

Class 041. First Use: 1993/03/03 First Use In Commerce: 1993/03/03  
All goods and services in the class are requested, namely: Educational services, namely, conducting classes, seminars and telephone conferences in the fields of health care and wellness, managing diseases and family health care issues and distributing course materials in connection therewith; medical education and training services, namely, providing lectures, seminars, workshops, classes and conferences in the fields of health care quality improvement, evaluating new and existing medical technologies and health care guidelines for preventing and treating specific health conditions

Class 045. First Use: 2000/08/31 First Use In Commerce: 2000/08/31  
All goods and services in the class are requested, namely: Providing health plan member patient advocate services, namely, coordinating the procurement and administration of medication and coordinating necessary medical services and educational services for medical patient health plan members by telephone and the Internet

Registration No.	4528020	Registration date	05/13/2014
Registrant	HealthPartners, Inc. 8170-33rd Avenue South Bloomington, MN 55425 UNITED STATES		

## Goods/Services Subject to the filing

Class 009. First Use: 2012/09/01 First Use In Commerce: 2012/09/01  
All goods and services in the class are requested, namely: Computer application software for mobile

phones and handheld computers, namely, software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information regarding prescription refills, obtaining healthy eating tips, recipes and healthy restaurant choices all in the field of healthcare services; computer application software for mobile phones and handheld computers, namely, software for enabling health benefit plan members to access information regarding member identification, benefits and account balances in the field of health benefit plans; computer application software for mobile phones and handheld computers, namely, software for enabling consumers to access data regarding availability of visiting health care clinics and for enabling patients to view their own patient information all in the field of healthcare services; downloadable software for calculating healthcare costs

Class 035. First Use: 2007/04/01 First Use In Commerce: 2008/01/01

All goods and services in the class are requested, namely: Employee assistance and wellness program services, namely, referrals in the field of healthcare to assist employees with personal and work-related problems; consulting in the fields of healthcare operations management and hospital operations management; consulting services, namely, to employers, community organizations, brokers and beneficiaries, related to consumer information regarding healthcare plan options, products and programs in the field of managed care and state and federal medical care programs; health insurance claims management in the nature of providing statistical evaluation of health insurance claims performance measures for others

Class 036. First Use: 1993/03/03 First Use In Commerce: 1993/03/03

All goods and services in the class are requested, namely: Insurance underwriting in the fields of health, medical and dental health insurance; health insurance administration; health insurance claims management in the nature of assessing health insurance claims and health insurance claims processing; health insurance claims adjudication in the nature of assessing insurance claims, insurance claims processing and medical insurance case and utilization review and insurance claims adjustment services for healthcare purchasers and payors and providers and Medicare beneficiaries; insurance information regarding health insurance plan eligibility and insurance claims processing status via the global computer information network

Class 041. First Use: 1993/03/03 First Use In Commerce: 1993/03/03

All goods and services in the class are requested, namely: Medical training and teaching; training services in the field of insurance brokerage; educational services, namely, conducting classes and seminars in the fields of healthcare, personal enrichment and family care issues

Class 042. First Use: 1995/10/20 First Use In Commerce: 1995/10/20

All goods and services in the class are requested, namely: Medical laboratory services; medical research; providing an interactive web site featuring technology that enables users to enter, access, track, monitor and generate health and medical information and reports; providing on-line non-downloadable computer software for enabling employers to access information regarding employee health insurance plan information relating to billing, coverage, healthcare utilization and healthcare expenditures

Class 044. First Use: 1993/03/03 First Use In Commerce: 1993/03/03

All goods and services in the class are requested, namely: Healthcare services, namely, medical services, dentist services, wellness programs, health improvement programs in the nature of weight loss programs and programs featuring assistance, fitness evaluation and consultation to individuals to help them make health, wellness and nutritional changes in their daily living to improve health and disease management programs; health plan member services, namely, preventative healthcare interactive medical monitoring and alert service for reminding clients of medicinal dosage, allergic sensitivity, and prescription refills for medical treatment purposes; health care in the nature of health maintenance organizations; health plan member decision support services, namely, providing healthcare information relating to maximizing health care coverage, health care providers and facility selections and health treatment selections; medical services, namely, providing influenza inoculations at the worksite; providing healthcare information; nursing services via telephone and the Internet; consulting services in the field of medical care; providing a web site featuring medical information

Class 045. First Use: 1993/03/03 First Use In Commerce: 1993/03/03

All goods and services in the class are requested, namely: Medical case management services, namely, coordinating the procurement and administration of medication and coordinating necessary medical services and educational services for medical patients

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

<p>HealthPartners, Inc,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>Virtual Health Partners LLC,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91238423</p> <p>U.S. Trademark Application No. 87109224</p> <p>Mark:</p> <div style="text-align: center;"><p>The logo for Virtual Health Partners features a stylized, multi-colored flower-like symbol above the text "Virtual Health" in a bold, sans-serif font, with "PARTNERS" in a smaller, pink font below it.</p></div>
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**ANSWER AND COUNTERCLAIM**

Applicant Virtual Health Partners LLC (“Applicant”) answers the Notice of Opposition filed by Opposer HealthPartners, Inc. (“Opposer”) as follows. Applicant’s statements are made upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters. Applicant reserves the right to amend its answer and to assert additional affirmative defenses upon the discovery of additional facts in these proceedings.

Applicant responds as follows regarding the allegations in the introductory paragraph of the Notice of Opposition. Applicant admits that the Notice of Opposition alleges that Opposer is a Minnesota corporation, and that its address is 8170 33rd Avenue South, Bloomington, Minnesota 55425. Applicant admits that its address is 106 East 19th Street, 2nd Floor, New York, New York 10003. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

1. Applicant admits that the PTO's records indicate that Opposer is the owner of the registrations for the word HEALTHPARTNERS asserted by Opposer in this opposition, namely, Registration Nos. 1882483, 1880942, 1885441, 4529705, and 4528020 (the "HEALTHPARTNERS Registrations"). Applicant admits that the HEALTHPARTNERS Registrations cover the goods and services set forth in this paragraph and were registered on the dates set forth in this paragraph. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

2. Applicant admits that Section 15 declarations have been accepted for the registrations asserted in this paragraph. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

3. Admitted.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

9. Denied.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

13. Applicant admits that, on July 19, 2016, it filed Application No. 87109224 to register the VIRTUAL HEALTH PARTNERS & Design trademark shown below (the “VIRTUAL HEALTH PARTNERS & Design Mark”).



Applicant admits that the application covered the goods and services set forth in this paragraph. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations and inferences contained in this paragraph and therefore denies those allegations and inferences.

14. Denied.

15. Applicant admits that it has not obtained Opposer's consent or permission to use its VIRTUAL HEALTH PARTNERS & Design Mark and denies that it is necessary seek such consent or permission given that the use of the mark does not create any likelihood of confusion.

16. Denied.

Opposer's concluding paragraph is a prayer for relief to which no response is necessary.

#### **AFFIRMATIVE DEFENSES**

1. Opposer fails to state a claim upon which relief can be granted because there is no likelihood of confusion between Applicant's VIRTUAL HEALTH PARTNERS & Design Mark and Opposer's alleged HEALTHPARTNERS mark.

2. Opposer fails to state a claim upon which relief can be granted because there is no likelihood of confusion between Applicant's VIRTUAL HEALTH PARTNERS & Design Mark and Opposer's VIRTUWELL mark.

3. Opposer's alleged HEALTHPARTNERS mark is weak and entitled to a narrow scope of protection in view of the existence of numerous applications and registrations containing the highly descriptive or generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services.

4. Opposer's alleged HEALTHPARTNERS mark is weak and entitled to a narrow scope of protection in view of the use of numerous marks containing the highly descriptive or generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services.

5. Opposer's alleged HEALTHPARTNERS mark is merely descriptive in its entirety in view of the widespread use and/or registration of marks containing the highly descriptive or generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services

6. Opposer's alleged HEALTHPARTNERS mark is generic in view of the widespread use and/or registration of marks containing the generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services.

7. Opposer is estopped from asserting its HEALTHPARTNERS Registrations against Applicant because it has acquiesced in the use and/or registration of numerous marks containing the highly descriptive or generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services for many years.

8. Opposer's HEALTHPARTNERS Registrations are subject to cancellation on grounds of genericness in view of the widespread use and/or registration of marks containing the generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services.

9. Registration Nos. 4529705 and 4528020 are subject to cancellation or partial cancellation on the ground that the word HEALTHPARTNERS is merely descriptive in its entirety and/or should have been registered on the Supplemental Register.

10. Registration Nos. 4529705 and 4528020 are subject to partial cancellation on the ground that the word HEALTHPARTNERS was not used for all of the goods and/or services recited in the registrations at the time the underlying applications were filed.



## **COUNTERCLAIM**

Applicant asserts the following counterclaim to cancel the HEALTHPARTNERS Registrations in whole or in part. Applicant's statements are made upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters. Applicant incorporates the above admissions by reference. Applicant reserves the right to amend its counterclaim upon the discovery of additional facts in these proceedings.

1. Applicant filed an application to register its VIRTUAL HEALTH PARTNERS & Design Mark on July 19, 2016, namely, Application No. 87109224, and Opposer filed an opposition against the application on the basis of its HEALTHPARTNERS Registrations, namely, Registration Nos. 1882483, 1880942, 1885441, 4529705, and 4528020, on December 15, 2017.

2. As Opposer has asserted the HEALTHPARTNERS Registrations against Applicant in this opposition, Applicant is being damaged by these registrations, and therefore has standing to bring this counterclaim.

3. Numerous applications and registrations exist for marks that contain the highly descriptive or generic terms "HEALTH" and "PARTNERS" and cover healthcare-related products and/or services.

4. Numerous marks containing the highly descriptive or generic terms "HEALTH" and "PARTNERS" are used in the marketplace for healthcare-related products and/or services.

5. The widespread use and registration of the highly descriptive or generic terms "HEALTH" and "PARTNERS" for healthcare-related products and/or services establishes that the HEALTHPARTNERS mark is merely descriptive or generic in its entirety for some or all of the healthcare-related products and services set forth in the HEALTHPARTNERS Registrations.

6. Opposer's website does not contain any indication that the word HEALTHPARTNERS is used in connection with some of the goods and/or services set forth in Registration Nos. 4529705 and 4528020 for the word HEALTHPARTNERS.

**Count I**  
**Cancellation on Grounds of Genericness**

7. Applicant repeats and realleges the foregoing allegations set forth in this counterclaim.

8. A registration can be cancelled in whole or in part at any time if the registered mark becomes the generic name for some or all the goods and/or services in question. 15 U.S.C. § 1064(3).

9. The word HEALTHPARTNERS is generic for some or all of the healthcare-related goods and services set forth in the HEALTHPARTNERS Registrations.

10. In view of the above, the HEALTHPARTNERS Registrations should be cancelled in whole if the Board finds that the word HEALTHPARTNERS is generic for all of the goods and services covered by the registrations, and in the alternative, they should be cancelled in part if the Board finds that this word is generic for only some of the goods and services covered by the registrations.

**Count II**  
**Cancellation on Grounds of Mere Descriptiveness**

11. Applicant repeats and realleges the foregoing allegations set forth in this counterclaim.

12. The PTO "may cancel a registration, in whole or in part [and] may otherwise restrict or rectify with respect to the register the registration of a registered mark." 15 U.S.C. § 1068.

13. The word HEALTHPARTNERS is merely descriptive in its entirety and should not have been registered on the Principal Register.

14. Registration Nos. 4529705 and 4528020 for the word HEALTHPARTNERS are not incontestable and may be cancelled on grounds of mere descriptiveness.

15. In view of the above, Registration Nos. 4529705 and 4528020 for the word HEALTHPARTNERS should be cancelled in whole, and in the alternative, they should be cancelled in part by amending the registrations to the Supplemental Register.

**Count III**  
**Cancellation on Grounds of Non-Use of Goods and/or Services**

16. Applicant repeats and realleges the foregoing allegations set forth in this counterclaim.

17. The PTO “may cancel a registration, in whole or in part [and] may modify the . . . registration by limiting the goods or services specified therein.” 15 U.S.C. § 1068.

18. Opposer did not use the word HEALTHPARTNERS for some of the goods and services set forth Registration Nos. 4529705 and 4528020 as of the date the underlying applications were filed.

19. In view of the above, the HEALTHPARTNERS Registrations should be cancelled in part for any goods or services that were not sold or provided as of the date the underlying applications were filed.

WHEREFORE, Applicant requests that the opposition be dismissed on grounds of an absence of any likelihood of confusion and/or the cancellation or partial cancellation of the HEALTHPARTNERS Registrations.

Respectfully submitted,

Dated: August 22, 2018

/Mark Farber/

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Phone: 203-286-5254

Counsel for Applicant  
Virtual Heath Partners LLC

**CERTIFICATE OF SERVICE**

I certify that a copy of the attached ANSWER AND COUNTERCLAIM was served on the following person by email on August 22, 2018.

Ashley M. Bennett Ewald  
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/Mark Farber/  
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