

ESTTA Tracking number: **ESTTA990108**

Filing date: **07/24/2019**

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	Legacy Health
Granted to Date of previous extension	07/24/2019
Address	1919 NW Lovejoy Street Portland, OR 97209 UNITED STATES

Attorney information	Matthew R. Wilmot Stoel Rives LLP 760 SW Ninth Avenue, Suite 3000 Portland, OR 97205 UNITED STATES matt.wilmot@stoel.com, lisa.davis@stoel.com, docketclerk@stoel.com 503-294-9851
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Applicant Information

Application No	88169631	Publication date	03/26/2019
Opposition Filing Date	07/24/2019	Opposition Period Ends	07/24/2019
Applicant	Libby's Legacy Breast Cancer Foundation 112 Annie St Orlando, FL 32806 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 2007/06/22 First Use In Commerce: 2007/06/22 All goods and services in the class are opposed, namely: Health care services, namely, breast health services

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.	1847147	Application Date	09/27/1993
Registration Date	07/26/1994	Foreign Priority Date	NONE
Word Mark	LEGACY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1989/01/18 First Use In Commerce: 1989/01/18 health care services

U.S. Registration No.	1574033	Application Date	04/25/1989
Registration Date	12/26/1989	Foreign Priority Date	NONE
Word Mark	LEGACY HEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/02/18 First Use In Commerce: 1989/02/18 HEALTH CARE SERVICES		

U.S. Registration No.	1574034	Application Date	04/25/1989
Registration Date	12/26/1989	Foreign Priority Date	NONE
Word Mark	LEGACY HEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/02/18 First Use In Commerce: 1989/02/18 HEALTH CARE SERVICES		

U.S. Registration No.	3876668	Application Date	04/05/2010
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Registration Date	11/16/2010	Foreign Priority Date	NONE
Word Mark	OUR LEGACY IS YOURS.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2009/06/00 First Use In Commerce: 2009/06/00 Healthcare		

U.S. Registration No.	3899583	Application Date	04/05/2010
Registration Date	01/04/2011	Foreign Priority Date	NONE
Word Mark	OUR LEGACY IS HEALTHY KIDS.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2009/06/00 First Use In Commerce: 2009/06/00 Healthcare		

Attachments	73795747#TMSN.png(bytes) 73795749#TMSN.png(bytes) 85006112#TMSN.png(bytes) 85006216#TMSN.png(bytes) Notice of Opposition.pdf(476807 bytes)
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Signature	/Matthew R. Wilmot/
Name	Matthew R. Wilmot
Date	07/24/2019

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

Legacy Health,)	Opposition No. _____
)	
)	
)	
)	Serial No. 88/169,631
)	
)	
v.)	For the mark LIBBY’S LEGACY
)	BREAST CANCER FOUNDATION
)	
Libby’s Legacy)	
Breast Cancer Foundation,)	Published on March 26, 2019
)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

I. PARTIES

1. Opposer Legacy Health (“Opposer”) is an Oregon non-profit corporation having its principal place of business at 1919 NW Lovejoy Street, Portland, Oregon 97209. Opposer is a full-service hospital and health care services provider.

2. Applicant Libby’s Legacy Breast Cancer Foundation (“Applicant”) is, on information and belief, a Florida corporation having an address at 112 Annie Street, Orlando, Florida 32806.

II. NOTICE OF OPPOSITION

3. In the matter of application Serial No. 88/169,631 (the “Application”) for federal trademark registration of the mark LIBBY’S LEGACY BREAST CANCER FOUNDATION (the “Opposed Mark”), filed by Applicant on October 25, 2018, and published in the U.S. Patent

and Trademark Office's *Official Gazette* on March 26, 2019, Opposer believes that it would be damaged by the grant of registration of the Opposed Mark and hereby opposes registration of the Opposed Mark by Applicant.

4. Based on use in commerce since at least as early as January 18, 1989, Opposer is the owner of the mark LEGACY. Since at least as early as January 18, 1989, Opposer has continuously used the LEGACY mark in the United States in connection with, among other things, healthcare and health care services.

5. Opposer owns the following federal trademark registrations for marks consisting of or including the term "LEGACY": (i) LEGACY, Registration No. 1,847,147, for use in connection with "health care services" in Class 42; (ii) LEGACY HEALTH SYSTEM, Registration No. 1,574,033, for use in connection with "health care services" in Class 42; (iii) LEGACY HEALTH & Design, Registration No. 1,574,034, for use in connection with "health care services" in Class 42; (iv) OUR LEGACY IS YOURS., Registration No. 3,876,668, for use in connection with "[h]ealthcare" in Class 44; and (v) OUR LEGACY IS HEALTHY KIDS., Registration No. 3,899,583, for use in connection with "[h]ealthcare" in Class 44 (collectively, the "LEGACY Marks").

6. The foregoing registrations for the LEGACY Marks are valid and subsisting, and all of the foregoing registrations have obtained incontestable status. True and correct printouts of the registration certificates are attached hereto as Exhibit A.

7. Applicant seeks registration of the Opposed Mark for use in connection with "[h]ealth care services, namely, breast health services" in Class 44 ("Applicant's Services").

8. Opposer adopted and commenced use of the LEGACY Marks in commerce well prior to any date which may be lawfully claimed by Applicant in connection with the Opposed

Mark, and Opposer's use in commerce is ongoing through the present date. In particular, Opposer's federal registrations for the LEGACY Marks were filed and registered well prior to October 25, 2018, the filing date of the Application.

9. The Opposed Mark is confusingly similar to the LEGACY Marks due to the close similarity between the marks in sight, sound, and commercial impression and the relatedness of the parties' respective services sold under the marks.

10. The Opposed Mark consists, in part, of the term "LEGACY," which term is the dominant portion of the LEGACY Marks owned by Opposer. Although the Opposed Mark includes additional wording, that wording has little impact on the overall appearance of the Opposed Mark and does not alter its overall commercial impression.

11. Applicant's Services are identical, closely related, and/or highly similar to the healthcare and health care services provided by Opposer under the LEGACY Marks in that Applicant's Services consist of health care services and breast health services, which is a type of health care service. Consequently, Applicant's Services fall entirely within and are therefore identical to Opposer's healthcare and health care services provided under the LEGACY Marks.

12. Due to the similar nature of Applicant's Services and because Applicant's Services contain no restrictions as to Applicant's customers, markets, and/or channels of trade, on information and belief, such services are likely to be advertised, promoted, and/or sold in the same channels of trade, to the same class of purchasers, and/or in the same marketing channels as those in which the healthcare and health care services provided by Opposer under the LEGACY Marks are advertised, promoted, and/or sold.

13. In view of the foregoing, the Opposed Mark is likely to cause confusion or to cause mistake, or to deceive when used in connection with Applicant's Services. As a result,

Opposer believes it will be damaged because the public will wrongly assume that Opposer is the source of Applicant's Services, has approved of Applicant, is affiliated with Applicant, or has otherwise sanctioned, sponsored, or licensed Applicant's Services.

14. Opposer has not consented to, licensed, or otherwise authorized Applicant's use of the Opposed Mark.

15. The grant of registration of the Opposed Mark would further create statutory rights in Applicant in violation and derogation of the established prior rights of Opposer, resulting in harm to Opposer.

16. For the foregoing reasons, Opposer would be damaged by the registration of the Opposed Mark by Applicant, including likely consumer confusion, mistake, and/or deception as to source, as well as serious damage to Opposer, who holds priority in the LEGACY Marks.

WHEREFORE, Opposer respectfully requests that this Notice of Opposition be sustained and that the Application be refused registration, and respectfully requests such other and further relief as may be deemed to be just and proper.

Dated: July 24, 2019

Respectfully submitted,

/s/ Matthew R. Wilmot

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Attorney for Opposer Legacy Health

Exhibit A

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office **Reg. No. 1,847,147**
Registered July 26, 1994

**SERVICE MARK
PRINCIPAL REGISTER**

LEGACY

LEGACY HEALTH SYSTEM (OREGON NON-
PROFIT CORPORATION)
1919 NW LOVEJOY STREET
PORTLAND, OR 97209

FOR: HEALTH CARE SERVICES, IN CLASS
42 (U.S. CL. 100).

FIRST USE 1-18-1989; IN COMMERCE
1-18-1989.

OWNER OF U.S. REG. NOS. 1,574,033, 1,574,034
AND OTHERS.

SER. NO. 74-440,810, FILED 9-27-1993.

CATHERINE KAISER KREBS, EXAMINING
ATTORNEY

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office **Reg. No. 1,574,033**
Registered Dec. 26, 1989

**SERVICE MARK
PRINCIPAL REGISTER**

LEGACY HEALTH SYSTEM

LEGACY HEALTH SYSTEM
500 N.E. MULTNOMAH
PORTLAND, OR 97232

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "HEALTH SYSTEM", APART
FROM THE MARK AS SHOWN.

FOR: HEALTH CARE SERVICES, IN CLASS
42 (U.S. CL. 100).

FIRST USE 2-18-1989; IN COMMERCE
2-18-1989.

SER. NO. 73-795,747, FILED 4-25-1989.

LINDA HEBAN, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office



Reg. No. 1,574,034

Registered Dec. 26, 1989

Amended Apr. 25, 2017

Int. Cl.: 42

Service Mark

Principal Register

LEGACY HEALTH (OREGON NONPROFIT CORPORATION)
1919 NW LOVEJOY STREET
PORTLAND, OR 97209

CLASS 42: HEALTH CARE SERVICES

FIRST USE 2-18-1989; IN COMMERCE 2-18-1989

No claim is made to the exclusive right to use the following apart from the mark as shown:
"HEALTH"

SER. NO. 73-795,749, FILED 04-25-1989



Michelle K. Lee

Director of the United States
Patent and Trademark Office

United States of America

United States Patent and Trademark Office

OUR LEGACY IS YOURS.

Reg. No. 3,876,668

Registered Nov. 16, 2010

Int. Cl.: 44

SERVICE MARK

PRINCIPAL REGISTER

LEGACY HEALTH SYSTEM (OREGON NON-PROFIT CORPORATION)
1919 NW LOVEJOY STREET
PORTLAND, OR 97209

FOR: HEALTHCARE, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 6-0-2009; IN COMMERCE 6-0-2009.

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

SER. NO. 85-006,112, FILED 4-5-2010.

SUSAN LESLIE DUBOIS, EXAMINING ATTORNEY



David J. Kyjars

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

OUR LEGACY IS HEALTHY KIDS.

Reg. No. 3,899,583

Registered Jan. 4, 2011

Int. Cl.: 44

SERVICE MARK

PRINCIPAL REGISTER

LEGACY HEALTH SYSTEM (OREGON NON-PROFIT CORPORATION)
1919 NW LOVEJOY STREET
PORTLAND, OR 97209

FOR: HEALTHCARE, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 6-0-2009; IN COMMERCE 6-0-2009.

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

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HEALTHY KIDS", APART FROM THE MARK AS SHOWN.

SER. NO. 85-006,216, FILED 4-5-2010.

SUSAN LESLIE DUBOIS, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office