

TTAB

Attorney Docket No: 53109/0047

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

William J. Snell, III
:
Petitioner,
:
v.
:
Priority Healthcare Benefits, Inc.
:
Registrant.
:



06-11-2003

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #22

Cancellation No. 31,365

Reg. No.: 1,947,473

Issued: January 9, 1996

**RESPONDENT'S MEMORANDUM TO THE BOARD REGARDING
RESPONDENT'S PENDING REQUEST FOR RELIEF FROM FINAL JUDGMENT**

COMES NOW Respondent, Priority Healthcare Benefits, Inc. ("PHB"), by and through its attorneys Thompson Coburn LLP, and in response to the Board's Order of December 23, 2002 hereby states as follows:

1. In an Order dated October 18, 2001, the TTAB cancelled PHB's registration No. 1,947,473.
2. On October 18, 2002, PHB filed a Motion on Consent to vacate the entry of judgment against PHB. In response to that motion, Petitioner indicated that upon negotiation and final execution of a coexistence agreement, Petitioner would provide its consent to PHB's request.
3. On December 23, 2002, the Board issued an Order requesting the parties inform the Board when the matter was settled and the coexistence agreement was reached between the parties.
4. Attached herewith is a Coexistence Agreement entered into between Petitioner and Respondent. Under the provisions of the Coexistence Agreement, Petitioner consents to PHB's use and registration of WILLPOWER for *electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills*, and PHB consents to

Petitioner's use and registration of WILL POWER for *professional services, namely providing legal services in the nature of estate planning*. Coexistence Agreement, ¶4.

5. Under the provisions of the agreement, Petitioner consents to PHB's pending request for relief from the final judgment filed with the TTAB on October 18, 2002. Coexistence Agreement, ¶5.

6. In view of the Agreement entered into by the parties, PHB requests that the Board formally vacate the final judgment entered against PHB per PHB's motion filed October 18, 2002 and indicate that U.S. Reg. No. 1,947,473 is in full force and affect.


7. Additionally, PHB requests that the Board terminate cancellation No. 31,365 with prejudice against the Petitioner as set forth in paragraph 5 of the Coexistence Agreement attached hereto, and notification to that effect is solicited at the Board's earliest convenience.

WHEREFORE, Priority Healthcare Benefits, Inc. respectfully requests relief from the final judgment of the TTAB and reinstatement of Reg. No. 1,947,473 and a termination of cancellation of No. 31,365 with prejudice to the Petitioner.

Respectfully submitted,

THOMPSON COBURN LLP

By:



Matthew J. Himich

Reg. No. 47,650

One US Bank Plaza

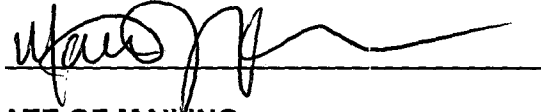
St. Louis, Missouri 63105

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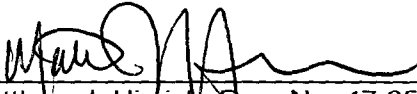
CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of this document has been sent via First Class Mail postage prepaid on JUNE 9, 2003, to Michael Elbein, Hovey Williams LLP, 12405 Grand Boulevard, Suite 400, Kansas City, MO 64108-2519, attorney for Petitioner.



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Box TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the 9th day of JUNE 2003.


Matthew J. Hinich, Reg. No. 47,650

COEXISTENCE AGREEMENT

This Coexistence Agreement ("Agreement") is by and between Priority Healthcare Benefits, Inc., a corporation of the State of Missouri having offices at 1700 Gilsinn Road, Fenton, Missouri 63026 ("PHB") and William J. Snell, III, an individual residing at 35 Albion Street, Wakefield, Massachusetts 01880 ("WJS") (hereinafter WJS and PHB shall be referred to collectively as the "Parties"). This Agreement shall become effective as of the date on which the last signature required for full execution of the Agreement by WJS and PHB is entered upon this Agreement (the "Effective Date").

WHEREAS WJS has filed an application to register the mark WILL POWER (U.S. Trademark Application Serial No. 75/761,026, filed July 26, 1999) for *professional services, namely providing legal services in the nature of estate planning*;

WHEREAS PHB owns U.S. Trademark Registration No. 1,947,473 for the mark WILLPOWER for *electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills*, issued January 9, 1996. PHB's U.S. Trademark Registration No. 1,947,473 was cancelled through order of the TTAB dated October 18, 2001 in Cancellation Proceeding No. 31,365;

WHEREAS The Parties recognize that their respective registration and application with the U.S. Patent & Trademark Office for the mark WILL POWER are for substantially different goods and services and the Parties wish to recognize and avoid any possible conflict;

NOW, THEREFORE, in consideration of the premises set forth above and the mutual promises, covenants, obligations and representations hereinafter set forth, and other good and valuable consideration, the receipt and adequacy of which are hereby acknowledged by both parties hereto, the Parties agree as follows.

1. WJS has adopted and is using the mark WILL POWER for *professional services, namely providing legal services in the nature of estate planning*. WJS agrees that he will not use or register the mark for any goods or services directly related to *electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills*.
2. PHB has adopted and is using the mark WILLPOWER for *electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills*. PHB agrees that it will not use or register the mark for any goods or services directly related to *professional services, namely providing legal services in the nature of estate planning*.
3. The parties believe that there is no likelihood of confusion or conflict between their respective marks used as described in Paragraphs 1 and 2, nor in both being registered as indicated in the Recitals paragraphs above.
4. WJS consents to PHB's use and registration of WILLPOWER for *electronic safekeeping services, namely information storage and retrieval by computer in the field of living wills*. PHB consents to WJS's use and registration of WILL POWER for *professional services, namely providing legal services in the nature of estate planning*.
5. WJS consents to PHB's pending Request For Relief From Final Judgment filed with the TTAB on October 18, 2002 and will file an appropriate paper with the TTAB indicating the same within fifteen (15) days after its execution of this Agreement. WJS will cooperate with PHB and provide other reasonable assistance as necessary to enable PHB to revive and reinstate its cancelled Reg. No. 1,947,473. If the TTAB grants PHB's pending Request for Relief and thereafter resumes the proceedings in Cancellation No. 31,365, WJS will file a withdrawal of the Cancellation No. 31,365 with prejudice. If the Board denies PHB's Request for Relief, PHB shall have the right to file a new trademark application for the mark for the same services specified in Reg. No. 1,947,473, and WJS agrees to not oppose or

otherwise object to PHB's new application for registration and use of the PHB Mark for the services recited therein.

6. Should the need arise, the parties will cooperate to take steps necessary to prevent the possibility of customer confusion arising in the future.

7. Both Parties to this Agreement may license or assign their respective marks hereunder, provided that such license or assignment is consistent with and does not extend beyond the provisions of this Agreement.

8. This Agreement shall be binding upon and inure to the benefit of the parties' successors and assigns.

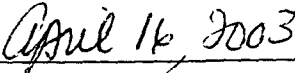
William J. Snell, III

By:



Signature

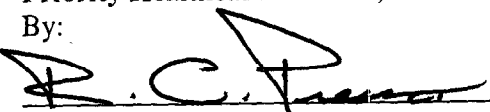
William J. Snell, III



Date

Priority Healthcare Benefits, Inc.

By:



Signature

Ronald C. Presson, President



Date