

ESTTA Tracking number: **ESTTA288366**

Filing date: **06/08/2009**

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

Petition for Cancellation

Notice is hereby given that the following parties request to cancel indicated registration.

Petitioner Information

Name	Healthways Health Support, LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	9280 S. Kyrene Road Suite 134 Tempe, AZ 85284 UNITED STATES		

Name	Healthways, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	3841 Green Hills Village Drive Suite 300 Nashville, TN 37215 UNITED STATES		

Attorney information	Robert L. Brewer and Paige W. Mills Bass, Berry & Sims PLC 315 Deaderick Street Suite 2700 Nashville, TN 37238 UNITED STATES trademarks@bassberry.com Phone:615-742-7760		
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Registration Subject to Cancellation

Registration No	3581713	Registration date	02/24/2009
Registrant	American Specialty Health Incorporated Mail Stop #4H 777 Front Street San Diego, CA 92101 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2005/09/23 First Use In Commerce: 2008/07/01 All goods and services in the class are cancelled, namely: Educational services namely, providing classes, seminars, workshops in the fields of health education, fitness and wellness education for Medicare eligible citizens
Class 044. First Use: 2005/09/23 First Use In Commerce: 2008/07/01 All goods and services in the class are cancelled, namely: Health benefit program, namely, providing information and consultation in the field of health care, fitness and wellness for Medicare eligible citizens

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2086072	Application Date	10/02/1996
Registration Date	08/05/1997	Foreign Priority Date	NONE
Word Mark	SILVERSNEAKERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1995/12/00 First Use In Commerce: 1995/12/00 health services, namely, exercise and fitness classes and instruction, and health club services		

Attachments	Petition for Cancellation.pdf (5 pages)(121364 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Paige W. Mills/
Name	Robert L. Brewer and Paige W. Mills
Date	06/08/2009

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

HEALTHWAYS, INC.,)	
)	
and)	
)	
HEALTHWAYS HEALTH SUPPORT, LLC)	
)	
Petitioner,)	
)	
v.)	Cancellation No.
)	
AMERICAN SPECIALTY HEALTH)	
INCORPORATED,)	
)	
Registrant.)	
)	
)	

PETITION FOR CANCELLATION

Healthways, Inc., and its subsidiaries, including but not limited to Healthways Health Support, LLC (“Petitioner”) by and through its undersigned attorneys, believing that it is or will be damaged by the continued registration of SILVERSTEPS, Registration No. 3,581,713, allege as follows:

1. Petitioner, Healthways, Inc., is a Delaware corporation with its principal place of business at 3841 Green Hills Village Drive, Suite 300, Nashville, Tennessee 37215.

2. Petitioner, Healthways Health Support, LLC, is a Delaware limited liability company with its principal place of business at 9280 S. Kyrene Road, Suite 134, Tempe, AZ 85284.

3. Upon information and belief, Registrant American Specialty Health Incorporated is a Delaware corporation having a place of business at 777 Front Street, Mail Stop #4H, San Diego, CA 92101 (“Registrant”).

4. Petitioner is the owner of all right, title, and interest to Registration No. 2,086,072 for the mark SILVERSNEAKERS, for “health services, namely, exercise and fitness classes and instruction, and health club services,” issued August 5, 1997. Petitioner has also made significant common law use of the marks SILVERSNEAKERS and SILVERSNEAKERS STEPS in commerce in connection with a variety of health, exercise and fitness services since at least as early as January 1, 2004.

5. Upon information and belief, Registrant is the owner of record of Registration No. 3,581,713 for “educational services namely, providing classes, seminars, workshops in the fields of health education, fitness and wellness education for Medicare eligible citizens” and “health benefit program, namely, providing information and consultation in the field of health care, fitness and wellness for Medicare eligible citizens,” issued February 24, 2009 (“Registrant’s Mark”).

6. Petitioner, Petitioner’s subsidiary Healthways Health Support, LLC, and such subsidiary’s predecessor-in-interest’s use and registration of Petitioner’s SILVERSNEAKERS mark predates Registrant’s filing date of September 23, 2005 and its date of first use of September 23, 2005 as well as its date of first use in commerce of July 1, 2008 for SILVERSTEPS.

7. Petitioner’s use of Petitioner’s SILVERSNEAKERS STEPS mark predates Registrant’s filing date of September 23, 2005 and its date of first use of September 23, 2005 as well as its date of first use in commerce of July 1, 2008 for SILVERSTEPS.

8. Registrant's SILVERSTEPS mark is similar in terms of appearance, sound, connotation, and commercial impression as to be deceptively similar to Petitioner's SILVERSNEAKERS and SILVERSNEAKERS STEPS marks within the meaning of Section 2(d) of the Trademark Act, and has caused and will cause confusion, mistake and deception as to the origin of Registrant's services bearing the Registrant's SILVERSTEPS mark.

2. The services provided in connection with Petitioner's SILVERSNEAKERS and SILVERSNEAKERS STEPS marks and Registrant's SILVERSTEPS mark are nearly identical, all being health and fitness education services.

3. The conditions surrounding the marketing of the services in connection with Petitioner's SILVERSNEAKERS and SILVERSNEAKERS STEPS marks and the services offered in connection with Registrant's SILVERSTEPS mark are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source.

4. Petitioner will be harmed by the continued registration of Registrant's Mark.

WHEREFORE, Petitioner prays Registration No. 3,581,713 be cancelled.

Please charge any fees due in connection with this document to Deposit Account No. 502483-4995, 011211-235.

DATED: June 8, 2009.

Respectfully submitted,

A handwritten signature in black ink that reads "Paige Mills". The signature is written in a cursive, flowing style.

Paige W. Mills
Robert L. Brewer
Ryann M. Schneider
Bass, Berry & Sims PLC
315 Deaderick Street, Suite 2700
Nashville, Tennessee 37238
Tel: 615-742-7760
Fax: 615-742-0410

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on the 8th day of June, 2009, I caused to be served a true and correct copy of the following document by the method indicated below and addressed as follows:

Petition for Cancellation

Elizabeth Demarest Horton
American Specialty Health Incorporated
Mail Stop #4H
777 Front Street
San Diego CA 92101

U.S. Mail
 Hand Delivery
 Overnight Mail
 Facsimile
 Email

Dated this 8th day of June, 2009.



Marian Moore

CERTIFICATE OF FILING

I hereby certify that on June 8, 2009, I filed this Petition for Cancellation via the ESTTA Filing System.

Dated this 8th day of June, 2009.



Marian Moore
Paralegal
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