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

Proceeding	92052514
Party	Plaintiff Medimpact Healthcare Systems, Inc.
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Attachments	Petitioner's Reply Brief.pdf (5 pages)(296257 bytes)

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

In the Matter of Trademark Registration)	
Registration No.: 3778980)	
Serial No. 77/607899)	
Filed: October 2, 2008)	
By: Medrecon D. Wise Management Corp.)	
For the Trademark: MEDDETECT)	
<hr/>		Cancellation No. 92052514
MEDIMPACT HEALTHCARE SYSTEMS, INC.,)	
a California Corporation,)	
)	
Petitioner,)	
)	
v.)	
)	
Medrecon D. Wise Management Corp.,)	
a Texas Limited Partnership)	
)	
)	
Respondent.)	
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PETITIONER’S REPLY BRIEF

I. INTRODUCTION

In its trial brief, Medrecon has failed to address the basic facts of this case. The marks are identical. MedImpact has priority of use of the mark MEDDETECT dating back to July 2006, over two years before Medrecon’s constructive first use date of October 2, 2008. Medrecon’s registration includes two classes claiming the services of “retrieving information relating to a patient’s previously-filled prescriptions” (Class 042) and “maintaining files and records concerning a patient’s previously-filled prescriptions” (Class 044). U.S. Reg. No. 3778980, automatically of record. These services are identical to those provided by MedImpact under its MEDDETECT mark. As such, this registration should be cancelled under 15 U.S.C.§1052(d).

II. ARGUMENT

In its trial brief, Medrecon did not dispute MedImpact's standing, the distinctive nature of MedImpact's MEDDETECT mark, or MedImpact's priority of use of the mark. Therefore, the only remaining issue is of likelihood of confusion.

Medrecon avoids addressing the strength of MedImpact's argument, namely that the services offered by MedImpact, and that establish common law rights, are the same as those offered by Medrecon. MedImpact's Trial Brief, at 11-15. Instead of addressing the evidence of MedImpact's actual services, Medrecon focuses on the services recited in MedImpact's pending application, particularly on the difference in International Classes. But classification is irrelevant to the likelihood of confusion analysis. 15 U.S.C. §1112 (classification is for convenience "but not to limit or extend the applicant's or registrant's rights"), see *Jean Patou, Inc. v. Theon, Inc.*, 9 F.3d 971, 975; 29 USPQ2d 1771 (Fed. Cir. 1993).

Even focusing on those services recited in MedImpact's application, the "fraud, waste and abuse reporting and auditing services" necessarily require the maintenance and retrieval of information related to a patient's previously-filled prescriptions claimed in Medrecon's registration. Wade Testimony, 11:18-20, 12:25, 13:1-9 (records detail how often a member has received prescriptions, how often they have received prescriptions and what the prescriptions were for); and 14:7-9 (records include a history of what drugs a member has utilized and the frequency of that utilization). The service maintains records down to details about each prescription fill, including the number of units, such as tablets, liquid measurement, or eye drops. Wade Testimony, 16:9-14.

In its attempt to avoid the real issues, Medrecon focuses on a third party, Trace America, whose registration is now “dead.”¹ The former registration is irrelevant to this matter. Likewise, it is irrelevant (and based on inadmissible evidence) that MedImpact has filed many trademark applications for a variety of marks.

Lastly, Medrecon makes a weak argument, with no evidentiary backing, that MedImpact’s common law rights are somehow restricted territorially. But MedImpact provided evidence and testimony regarding nationwide use of the mark in proposals and contracts. MedImpact Trial Exs. 3-10, Wade Testimony, 25-37. Moreover, this is not a concurrent use proceeding.

Therefore, Medrecon has not successfully rebutted any of MedImpact’s likelihood of confusion arguments and MedImpact has carried its burden.

III. CONCLUSION

Because the two marks are likely to be confused and Petitioner has priority of use, MedImpact respectfully requests the Board cancel Reg. No. 3778980 for the mark MEDDETECT.

IV. EVIDENTIARY OBJECTIONS

MedImpact objects to the following evidence referenced by Medrecon in its trial brief:

1. <http://www.traceamerica.com/Servicescategory/Service.aspx?ContentID=35>.
2. Reference to MedImpact’s number of applications on page 6, footnote 8 of

Medrecon’s trial brief.

¹ This registration was included in Medrecon’s notice of reliance, Ex. B, but since that time has been classified as “dead” by the Trademark Office for failure to file the Section 8 & 15. Medrecon references the Trace America website in its brief, but it was not properly introduced during the testimony period. MedImpact provides evidentiary objections to the same at the end of this brief.

This information was not made of record with the Board through a notice of reliance, testimony, or other authorized procedure. Thus, it should not be considered by the Board. 37 CFR §2.123(l).

Respectfully submitted,



By: Susan B. Meyer

Dated: December 5, 2011

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Certificate of Mailing by "First Class U.S. Mail"

I hereby certify that a copy of the **Petitioner's Reply Brief** to Applicant is being served by U.S. First Class Mail service, to Applicant's Correspondent on December 5, 2011, as follows:

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