

ESTTA Tracking number: **ESTTA560387**

Filing date: **09/19/2013**

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 party requests to cancel indicated registration.

**Petitioner Information**

Name	New Liberty Hospital District		
Entity	Political Subdivision	Citizenship	Missouri
Address	2525 Glen Hendren Drive Liberty, MO 64068 UNITED STATES		

Attorney information	Michael Elbein HOVEY WILLIAMS LLP 10801 Mastin Blvd., Suite 1000 Overland Park, KS 66210 UNITED STATES mme@hoveywilliams.com, litigation@hoveywilliams.com Phone:913-647-9050
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**Registration Subject to Cancellation**

Registration No	3504159	Registration date	09/23/2008
Registrant	Liberty Medical Center 1504 NE 96th Street Liberty, MO 64068 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 044. First Use: 2005/02/04 First Use In Commerce: 2005/07/05 All goods and services in the class are cancelled, namely: Physician services
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**Grounds for Cancellation**

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

U.S. Registration No.	1970126	Application Date	06/12/1995
Registration Date	04/23/1996	Foreign Priority Date	NONE
Word Mark	LIBERTY HOSPITAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1984/11/00 First Use In Commerce: 1984/11/00 health care services		

U.S. Registration No.	3853189	Application Date	02/17/2010
Registration Date	09/28/2010	Foreign Priority Date	NONE
Word Mark	THE LIBERTY CLINIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 1994/01/11 First Use In Commerce: 1994/01/11 Physician services, medical services and obstetric and gynecology services		

Attachments	Petition for Cancellation.pdf(336648 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	/michael elbein/
Name	Michael Elbein
Date	09/19/2013

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

In the matter of Trademark Registration No. 3504159  
For the Mark: LIBERTY MEDICAL CENTER  
Registration Issued September 23, 2008

New Liberty Hospital District	)	
	)	
Plaintiff - Petitioner	)	
	)	
vs.	)	Cancellation Proceeding
	)	No. _____
Liberty Medical Center,	)	
	)	
Defendant - Registrant.	)	

**PETITION FOR CANCELLATION**

In the matter of Trademark Registration No. 3504159, for the mark LIBERTY MEDICAL CENTER, registered on September 23, 2008.

New Liberty Hospital District, a political subdivision of the State of Missouri, organized pursuant to Chapter 206 of the Revised Statutes of Missouri, with its principal place of business at 2525 Glen Hendren Drive, Liberty, Missouri 64068 (“NLHD” or “Petitioner”) believes that it will be damaged by the continued registration of the mark shown in the above-identified registration for the services identified in the above-referenced registration and therefore petitions to cancel the same.

The grounds for the cancellation are as follows:

1. Liberty Medical Center, Registrant (“Registrant”), is listed in the United States Patent and Trademark Office (“USPTO”) records as a Missouri limited liability company and the owner of Registration No. 3504159 for the mark LIBERTY MEDICAL CENTER, for “physician

services” as evidenced by the registration. The Registrant’s address, per the Trademark Office records, is 1504 NE 96<sup>th</sup> Street, Liberty, MO 64068.

2. The application that resulted in the registration that is the subject of this Cancellation Petition was filed on November 19, 2007, on the basis of Section 1(a) of the Trademark Act. In that application Registrant claimed a date of first use of the mark, on or in connection with the services listed in the registration, of February 4, 2005; and a date of first use in commerce of July 5, 2005. The registration was issued on September 23, 2008; the same dates of first use and first use in commerce as in the application are listed on the registration.

3. Petitioner, on its own and/or through its predecessors in interest and/or related entities, is and has been engaged in the provision of medical, health, and physician services. Petitioner has provided these services in connection with the service marks LIBERTY HOSPITAL and THE LIBERTY CLINIC, both with and without design.

4. Petitioner, on its own and/or through its predecessors in interest and/or related entities, has used its LIBERTY HOSPITAL and THE LIBERTY CLINIC service marks in commerce in connection with its services for many years prior to February 4, 2005.

5. Since at least as early as November 1984, Petitioner’s use of the LIBERTY HOSPITAL mark in connection with its health care and related services has been continuous, commercially significant and substantially exclusive.

6. Since at least as early as January 1994, Petitioners use of the THE LIBERTY CLINIC mark in connection with its physician services, medical services and obstetric and gynecology services has been continuous, commercially significant and substantially exclusive.

7. Petitioner is the owner of the following United States trademark

registrations, all of which are valid and subsisting:

a. Registration No. 1970126, for the mark LIBERTY HOSPITAL and Design, for health care services, which registration is incontestable (copies of the registration and status information from the USPTO database are attached as Exhibit 1); and

b. Registration No. 3853189, for the mark THE LIBERTY CLINIC, for physician services, medical services and obstetric and gynecological services (copies of the registration and status information from the USPTO database are attached as Exhibit 2).

8. By virtue of Petitioner's continuous use in commerce of its LIBERTY HOSPITAL and THE LIBERTY CLINIC marks and promotion of the same, the NLHD's marks have become well and favorably known to the relevant trade and public in connection with such services.

9. Petitioner has priority due to its use in commerce of its LIBERTY HOSPITAL and THE LIBERTY CLINIC marks before the filing date of the application that resulted in the Registrant's registration and / or the date of first use by the Registrant of the LIBERTY MEDICAL CENTER mark.

10. Petitioner's marks were distinctive, either inherently or through acquired distinctiveness, prior to the filing date of the application that resulted in the Registrant's registration and/or the date of first use by the Registrant of the LIBERTY MEDICAL CENTER mark.

11. Because Registrant's LIBERTY MEDICAL CENTER mark causes a likelihood of confusion with Petitioner's marks, Petitioner is being injured by the continued registration of the mark shown in Registration No. 3504159.

12. As Petitioner has priority due to prior use of its marks, and the Registrant's

registration was issued less than five years ago, Registration No. 3504159 is subject to cancellation under Section 2(d) of the Trademark Act due to a likelihood of confusion with Petitioner's LIBERTY HOSPITAL and THE LIBERTY CLINIC marks.

13. Per the certificate of service below, a true and correct copy of this Petition for Cancellation is being served upon the owner of record for the registration that is the subject of this petition.

WHEREFORE, New Liberty Hospital District prays that Registration No. 3504159 for the mark LIBERTY MEDICAL CENTER be cancelled and that this Petition for Cancellation be sustained.

The \$300 filing fee for this Cancellation has been charged to Deposit Account No. 19-0522 through the Trademark Trial and Appeal Board's ESTTA filing system. Any additional fees in connection with the institution of this Cancellation may also be charged to this account, and any overpayment may be credited to this account.

Respectfully submitted,

/michael elbein/

Michael Elbein  
Cheryl L. Burbach  
Matthew B. Walters  
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Suite 1000  
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(913) 647-9050 - Phone  
(913) 647-9057 - Fax  
Attorneys for Opposer

**Certificate of Service**

I hereby certify that a true and correct copy of the foregoing Petition for Cancellation, which was filed electronically with the Trademark Trial and Appeal Board, was served upon the Registrant owner of record, this 19th day of September, 2013, by First Class Mail sent to the following address:

Liberty Medical Center  
1504 NE 96<sup>th</sup> Street  
Liberty, MO 64068

/Michael Elbein/

# **Exhibit 1**



# United States of America

United States Patent and Trademark Office



**Reg. No. 1,970,126**

**Registered Apr. 23, 1996**

**Corrected Sep. 11, 2012**

**Int. Cl.: 42**

**SERVICE MARK**

**PRINCIPAL REGISTER**

NEW LIBERTY HOSPITAL DISTRICT (MISSOURI DISTRICT HOSPITAL UNDER CHAPTER 206),  
2525 GLENN HENDREN DRIVE  
LIBERTY, MO 64068

FOR: HEALTH CARE SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 11-0-1984; IN COMMERCE 11-0-1984.

OWNER OF U.S. REG. NO. 1,743,705.

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

SER. NO. 74-687,219, FILED 6-12-1995.



*David J. Kappas*

Director of the United States Patent and Trademark Office

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Mark: LIBERTY HOSPITAL



US Serial Number: 74687219      Application Filing Date: Jun. 12, 1995  
US Registration Number: 1970126      Registration Date: Apr. 23, 1996  
Register: Principal  
Mark Type: Service Mark  
Status: The registration has been renewed.  
Status Date: Sep. 06, 2005  
Publication Date: Jan. 30, 1996

## Mark Information

Mark Literal Elements: LIBERTY HOSPITAL  
Standard Character Claim: No  
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)  
Color(s) Claimed: Color is not claimed as a feature of the mark.  
Disclaimer: "HOSPITAL"  
Design Search Code(s): 05.01.02 - Trees or bushes with a generally rounded shape, including deciduous trees; Maple tree  
26.17.13 - Overlined words or letters; Underlined words or letters; Letters or words underlined and/or overlined by one or more strokes or lines

## Related Properties Information

Claimed Ownership of US Registrations: 1743705

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [ . ] indicate deleted goods/services;
- Double parenthesis ((. )) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: health care services  
International Class(es): 042 - Primary Class      U.S Class(es): 100, 101  
Class Status: ACTIVE  
Basis: 1(a)  
First Use: Nov. 1984      Use in Commerce: Nov. 1984

## Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

## Current Owner(s) Information

Owner Name: NEW LIBERTY HOSPITAL DISTRICT  
Owner Address: 2525 Glenn Hendren Drive  
Liberty, MISSOURI 64068  
UNITED STATES  
Legal Entity Type: DISTRICT HOSPITAL UNDER CHAPTER 206      State or Country Where Organized: MISSOURI

## Attorney/Correspondence Information

**Attorney of Record**

**Attorney Name:** Michael Elbein

**Docket Number:** 2930.000; Dk

**Correspondent**

**Correspondent Name/Address:** Michael Elbein  
HOVEY WILLIAMS LLP  
10801 MASTIN BLVD., SUITE 1000  
84 CORPORATE WOODS  
OVERLAND PARK, KANSAS 66210  
UNITED STATES

**Phone:** 913-647-9050

**Fax:** 913-647-9057

**Domestic Representative - Not Found**

**Prosecution History**

Date	Description	Proceeding Number
Aug. 08, 2012	CERTIFICATE OF CORRECTION ISSUED	73376
Aug. 01, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	73376
Jul. 31, 2012	TEAS SECTION 7 REQUEST RECEIVED	
May 19, 2008	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 17, 2006	CASE FILE IN TICRS	
Sep. 06, 2005	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Sep. 06, 2005	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 28, 2005	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Sep. 02, 2005	ASSIGNED TO PARALEGAL	66607
Jun. 28, 2005	TEAS SECTION 8 & 9 RECEIVED	
Aug. 10, 2001	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jun. 08, 2001	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Apr. 23, 1996	REGISTERED-PRINCIPAL REGISTER	
Jan. 30, 1996	PUBLISHED FOR OPPOSITION	
Dec. 29, 1995	NOTICE OF PUBLICATION	
Nov. 06, 1995	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 25, 1995	ASSIGNED TO EXAMINER	62920

**Maintenance Filings or Post Registration Information**

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Apr. 23, 2006

**Change in Registration:** Yes

**Correction made to Registration:** In the Statement, Column 1, lines 1 and 2, "NEW LIBERTY HOSPITAL DISTRICT OF CLAY COUNTY" should be deleted, and, "NEW LIBERTY HOSPITAL DISTRICT" should be inserted.

**TM Staff and Location Information**

**TM Staff Information - None**

**File Location**

**Current Location:** POST REGISTRATION

**Date in Location:** Aug. 08. 2012

# **Exhibit 2**

# United States of America

United States Patent and Trademark Office

## THE LIBERTY CLINIC

**Reg. No. 3,853,189**

**Registered Sep. 28, 2010**

**Int. Cl.: 44**

**SERVICE MARK**

**PRINCIPAL REGISTER**

NEW LIBERTY HOSPITAL DISTRICT OF CLAY COUNTY (MISSOURI MISSOURI HOSPITAL DISTRICT UNDER CHAPTER 206 OF THE REVISED STATUTES OF MISSOURI)  
2525 GLENN HENDREN DRIVE  
LIBERTY, MO 64068

FOR: PHYSICIAN SERVICES, MEDICAL SERVICES AND OBSTETRIC AND GYNECOLOGY SERVICES, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 1-11-1994; IN COMMERCE 1-11-1994.

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

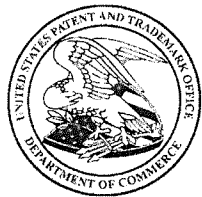
OWNER OF U.S. REG. NO. 1,970,126.

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

SEC. 2(F).

SER. NO. 77-937,834, FILED 2-17-2010.

DAVID COLLIER, EXAMINING ATTORNEY



*David J. Kyffas*

Director of the United States Patent and Trademark Office

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Mark: THE LIBERTY CLINIC

THE LIBERTY CLINIC

US Serial Number: 77937834      Application Filing Date: Feb. 17, 2010  
US Registration Number: 3853189      Registration Date: Sep. 28, 2010  
Register: Principal  
Mark Type: Service Mark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Sep. 28, 2010  
Publication Date: Jul. 13, 2010

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## Mark Information

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Mark Literal Elements: THE LIBERTY CLINIC  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK  
Disclaimer: "THE" AND "CLINIC"  
Acquired Distinctiveness Claim: In whole

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## Related Properties Information

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Claimed Ownership of US Registrations: 1970126

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [..] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: Physician services, medical services and obstetric and gynecology services

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 11, 1994

Use in Commerce: Jan. 11, 1994

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## Basis Information (Case Level)

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Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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## Current Owner(s) Information

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Owner Name: New Liberty Hospital District  
Owner Address: 2525 Glenn Hendren Drive  
Liberty, MISSOURI 64068  
UNITED STATES  
Legal Entity Type: missouri hospital district under chapter 206 of the revised statutes of missouri      State or Country Where Organized: MISSOURI

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## Attorney/Correspondence Information

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**Attorney of Record**

Attorney Name: Michael Elbein

Docket Number: 41412

**Correspondent**

Correspondent Name/Address: MICHAEL ELBEIN  
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10801 MASTIN ST STE 1000  
OVERLAND PARK, KANSAS 66210-1697  
UNITED STATES

Phone: 913-647-9050

Fax: 913-647-9057

Domestic Representative - Not Found

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**Prosecution History**

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Date	Description	Proceeding Number
Jul. 31, 2012	SEC 7 REQUEST FILED	75184
Aug. 02, 2012	CERTIFICATE OF CORRECTION ISSUED	75184
Aug. 01, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Jul. 31, 2012	TEAS SECTION 7 REQUEST RECEIVED	
Sep. 28, 2010	REGISTERED-PRINCIPAL REGISTER	
Jul. 13, 2010	PUBLISHED FOR OPPOSITION	
Jun. 23, 2010	NOTICE OF PUBLICATION	
Jun. 04, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	76532
Jun. 04, 2010	ASSIGNED TO LIE	76532
May 20, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 20, 2010	ASSIGNED TO EXAMINER	81852
Feb. 23, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Feb. 20, 2010	NEW APPLICATION ENTERED IN TRAM	

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**Maintenance Filings or Post Registration Information**

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Change in Registration: Yes

Correction made to Registration: In the statement, column 1, line 1, New Liberty Hospital District of Clay County should be deleted and New Liberty Hospital District should be inserted.

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**TM Staff and Location Information**

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TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Sep. 07, 2012