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

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|---|---|
| Proceeding | 92067714 |
| Party | Defendant<br>Prepared Health, Inc. |
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| Signature | /maurineknutsson/ |
| Date | 06/21/2018 |
| Attachments | 008923.00003 Answer to Amended Petition to Cancel.pdf(145460 bytes ) |

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

| | |
|---|---|
| **INTOUCH TECHNOLOGIES, INC.,** | |
| **Petitioner,** | |
| **v.** | **Cancellation No. 92067714** |
| **PREPARED HEALTH, INC.,** | **Registration No. 5271618** |
| **Registrant.** | **Mark: ENTOUCH** |

**ANSWER TO AMENDED PETITION FOR CANCELLATION**

Registrant Prepared Health, Inc. ("Registrant") responds to the Petition for Cancellation, filed by Petitioner Intouch Technologies, Inc. ("Petitioner"), as follows.

The numbered paragraphs are answered as follows:

**I. The Parties.**

1. Petitioner, InTouch Technologies, Inc. dba InTouch Health, is a corporation organized and existing under the laws of the State of Delaware with an address at 7402 Hollister Avenue, Goleta, California 93117 (hereinafter, "Petitioner"). Petitioner provides products and services that support medical provider's delivery of high-quality clinical care to patients at any time, while reducing overall costs of healthcare. Petitioner's products and services include, among others, computer software and equipment for physicians, patients, patients' family and patients' friends to remotely monitor, communicate and share information regarding the patient's health and treatment, and for physicians to otherwise provide remote healthcare services.

**ANSWER:** Registrant does not have sufficient information to admit or deny the allegations in numbered paragraph 1 and therefore they are denied.

2. Prepared Health, Inc. is, on information and belief, a corporation organized and existing under the laws of the State of Delaware with an address at 1 North State Street, Suite 1500, Chicago, Illinois 60602 (hereinafter, "Registrant").

**ANSWER:** Admitted.

## II. Standing.

3. Registrant is listed in the United States Patent and Trademark Office ("USPTO") records as the owner of record of U.S. Trademark Registration No. 5,271,618 ("Registrant's Registration") for use of the ENTOUCH mark ("Registrant's Mark") with the following goods and services ("Registrant's Goods and Services"): "Computer software for patients to access, research, review, record, organize, manage, and share health, medical, and wellness information with their healthcare professionals, family, friends, and others; computer software for patients to personalize their healthcare, medical, wellness, and self-care programs and to share and communicate such programs with their healthcare professionals, family, friends, and others; computer software for use in maintaining health, medical, wellness, and other records of patients and for communicating such information among patients, healthcare professionals, family, friends, and others relating to the care of such patients; computer software used to access, collect, edit, organize, store, manage, transmit, share, and communicate information in the field of healthcare, namely, patient health and medical records and images, laboratory results, treatment plans, care information, and health insurance and provider information; computer software that permits patients and their healthcare professionals, family, friends, and others to access patient records and other information, healthcare and wellness educational information, treatment plans, care information, and healthcare insurance and provider information; computer software for healthcare professionals to prescribe, track, monitor, share, encourage, educate, communicate, and instruct their patients and patients' family and friends on treatment plans and care information. computer software for patients to track, monitor, receive instruction, learn, ask questions, communicate, and receive motivation on treatment plans and care information provided and prescribed by their healthcare professionals and share such information with their family, friends, and others; computer software that allows users to record, post, share, and comment on messages, text, files, data, photos, images, graphics, audio, video, and audio-visual content with others; computer software that allows subscribers to communicate and share messages, text, files, data, photos, images, graphics, audio, video, and audio-visual content among themselves over global communication networks, the Internet, and wireless networks" in Class 9; and "Providing temporary use of non-downloadable software that allows subscribers to communicate and share messages, text, files, data, photos, images, graphics, audio, video, and audio-visual content among themselves over global communication networks, the Internet, and wireless networks; providing temporary use of non- downloadable software that allows healthcare professionals, patients, family, friends, and others to communicate and share messages, text, files, data, photos, images, graphics, audio, video, and audio-visual content among themselves relating to the care of such patients over global communication networks, the Internet, and wireless networks; software as a service (SAAS) services featuring non-downloadable software for providing health and medical information to healthcare professionals, patients, patients' family and friends, and others; providing an Internet website portal for patients to access, research, review, record, organize, manage, and share health, medical, and wellness information with their healthcare professionals, family, friends, and others, and to personalize their healthcare, medical, wellness, and self-care programs and to share and communicate such programs with their healthcare professionals, family, friends, and others; providing an Internet website portal for patients and their care providers to access, collect, edit, organize, store, manage, transmit, share, and communicate information in the field of healthcare, namely, patient status, patient health and

medical records and images, laboratory results, treatment plans, care information, and health insurance and provider information" in Class 42.

**ANSWER:** Admitted.

4. Petitioner is the owner of record of the trademark applications ("Petitioner's Applications") for use of the INTOUCH and other INTOUCH-formative marks ("Petitioner's Marks") with the goods and services set forth in Schedule A ("Petitioner's Goods and Services"), which is incorporated herein by this reference.

**ANSWER:** Registrant does not have sufficient information to admit or deny the allegations in numbered paragraph 4 and therefore they are denied.

5. Petitioner is also the owner of the registrations ("Petitioners' Registrations") for use of Petitioner's Marks with the Petitioner's Goods and Services, as set forth in Schedule B, which is incorporated herein by this reference.

**ANSWER:** Registrant does not have sufficient information to admit or deny the allegations in numbered paragraph 5 and therefore they are denied.

6. On March 14, 2016 and July 13, 2017, the USPTO issued Office Actions provisionally refusing registration of Petitioner's Applications under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the mark in the trademark application that issued as Registrant's Registration. A true and correct copy of the Office Actions attached hereto as Schedule C, which is incorporated herein by this reference.

**ANSWER:** Registrant does not have sufficient information to admit or deny the allegations in numbered paragraph 6 and therefore they are denied.

7. Petitioner believes it has been and will continue to be damaged by Registrant's Registration, and hereby petitions for cancellation of the same pursuant to 15 U.S.C. §§ 1064(1) and 1064(3).

**ANSWER:** Denied.

## III. First Ground for Cancellation: Cancellation for Prior Rights Pursuant to 15 U.S.C. § 1052(d) and 15 U.S.C. § 1064(1).

8. Petitioner incorporates by reference paragraphs 1-7 as set forth above.

**ANSWER:** Registrant repeats and incorporates by reference its answers to paragraphs 1-7.

9. Petitioner has continuously used Petitioner's Marks with certain of Petitioner's Goods and Services since at least as early as 2003 and, without limiting the foregoing, Petitioner has used Petitioner's Marks with telehealth goods and services (including, without limitation, computer software and equipment for physicians, patients, patients' family and patients' friends to remotely monitor, communicate and share information regarding the patient's health and treatment and for physicians to otherwise provide remote healthcare services) since at least as early as 2003.

**ANSWER:** Registrant does not have sufficient information to admit or deny the allegations in numbered paragraph 9 and therefore they are denied.

10. As set forth in Registrant's Registration, Registrant's earliest date of first use of Registrant's Mark with Registrant's Goods and Services is March 31, 2015 and the earliest constructive priority date Registrant can claim is March 11, 2015, the filing date of Registrant's Registration.

**ANSWER:** Denied.

11. The only difference between Petitioner's INTOUCH mark and Registrant's Mark is Registrant's use of the letter "e" in place of the letter "i".

**ANSWER:** Denied.

12. Registrant's Goods and Services also overlap with Petitioner's Goods and Services. For example, Registrant's Goods and Services and Petitioner's Goods and Services both include software used by caregivers, patients and others to remotely share healthcare information: **Registrant's Registration** Computer software for patients to access, research, review, record, organize, manage, and share health, medical, and wellness information with their healthcare professionals, family, friends, and others. . . **Petitioner's Reg. No. 2,843,750** . . . computer operating software . . .used by caregivers, medical experts and patients' family and friends to . . . exchange information concerning the care of the patient/resident. . . See Schedule B.

**ANSWER:** Denied

13. If, as the USPTO contends, Petitioner's Marks are similar to Registrant's Mark in sight, sound, and commercial impression, such that they are likely to cause confusion as to source, sponsorship or association, when used in connection with Petitioner's Goods and Services and Registrant's Goods and Services, respectively, then Petitioner is the senior user with priority over Registrant and entitled to cancellation of Registrant's Registration under Trademark Act § 2(d),

15 U.S.C. § 1052(d), because, among other things, Petitioner's first use of Petitioner's Marks is prior to any priority date Registrant can rely upon.

**ANSWER:** Denied.

## IV. Second Ground for Cancellation: Cancellation for Fraud Pursuant to 15 U.S.C. § 1064(3).

14. Petitioner incorporates by reference paragraphs 1-13 as set forth above.

**ANSWER:** Registrant repeats and incorporates by reference its answers to paragraphs 1-13. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

15. On or about December 15, 2016, Petitioner informed Registrant of Petitioner's prior use of Petitioner's Marks and the likelihood of confusion from Registrant's use of Registrant's Mark: "As you may know, InTouch has been operating since 2003 and provides a variety of remote care products and services to healthcare providers, including products and services to connect providers and patients. We also own several trademark registrations for INTOUCH, INTOUCH HEALTH and INTOUCH TECHNOLOGIES. We noticed that your company recently decided to offer a mobile app with the name ENTOUCH to connect healthcare providers and patients. Since ENTOUCH is virtually identical to our mark, and given that you are using it on very similar goods and services, we are concerned that your ongoing use will cause problems for us, as well as for patients and providers." Registrant confirmed receipt of Petitioner's letter in a subsequent response thereto. Copies of Petitioner's and Registrant's letters are attached hereto as Schedules D and E, respectively, and incorporated herein by this reference.

**ANSWER:** Registrant admits that it received and responded to Petitioner's letter dated December 15, 2016. Registrant denies the remaining allegations in paragraph 15. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

16. Prior to Registrant filing the Statement of Use for Registrant's Mark, Registrant and Petitioner engaged in communications regarding Registrant's use of a confusingly similar mark, Petitioner's prior rights in Petitioner's Marks, and Petitioner's demand that Registrant discontinue use of Registrant's Mark. During a telephone conference between Registrant and Petitioner regarding the likelihood of confusion between Registrant's Mark and Petitioner's Marks, the parties discussed the similarities between Petitioner's Mark and Registrant's Mark, and the associated goods and services set forth above in this Petition, and Registrant admitted that it would not be comfortable if the parties used their respective marks on the same goods and services. This admission regarding Registrant's concern about the parties using their respective marks on the same goods and services, together with the facts regarding similarities between Registrants' Mark and Petitioner's Marks and overlap of the associated goods and services, confirm

Registrant's belief that there was a likelihood of confusion between Petitioner's use of Petitioner's Marks and Registrant's use of Registrant's Mark.

**ANSWER:** Denied. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

17. Notwithstanding Registrant's belief that there was a likelihood of confusion between Registrant's Mark and Petitioner's Marks, Registrant did not want to invest time and resources in rebranding at this point in time. Thus, it proposed, during the same telephone conference, delaying any action with regard to Registrant's use of Registrant's Mark until there was actual evidence of confusion in the marketplace. Registrant's counsel subsequently confirmed Registrant's desire to continue using Registrant's Mark until there was actual confusion: "I was under the belief that there was a tacit understanding between the parties that, until there is confusion in the marketplace, they would continue with their marks and businesses as is." A true and correct copy of an email, dated January 10, 2018, from Hoang-chi Truong to Catherine Lake is attached hereto as Schedule F, which is incorporated herein by this reference. Notwithstanding Registrant's counsel's contention to the contrary, Petitioner did not agree that the parties should use their respective marks until there is confusion in the marketplace.

**ANSWER:** Registrant admits that Hoang-chi Truong sent an email to Catherine Lake on January 10, 2018. Registrant denies the remaining allegations in paragraph 17. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

18. In furtherance of Registrant's proposal to register and use Registrant's Mark until there was confusion in the marketplace, and notwithstanding Registrant's knowledge of Petitioner's prior rights in and registrations for Petitioner's Marks and Registrant's belief that Registrant's use of Registrant's Mark was likely to cause confusion with Petitioner's use of Petitioner's Marks, on June 5, 2017, Registrant intentionally and falsely represented to the USPTO that no other person has the right to use a similar mark to Registrant's Mark in commerce. Specifically, David M. Coyle, on behalf of Registrant, declared as follows in the Trademark/Service Mark Statement of Use filed with the USPTO for Registrant's Registration: "To the best of the signatory's knowledge and belief, no other persons . . . have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive. To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contents made above have evidentiary support. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed

to be true." A true and correct copy of the Trademark/Service Mark Statement of Use is attached hereto as Schedule G, which is incorporated herein by this reference.

**ANSWER:** Registrant admits that on June 5, 2017 it executed and filed its Trademark/Service Mark Statement of Use at the USPTO. Registrant denies the remaining allegations in paragraph 18. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

19. Registrant, in failing to disclose these facts to the USPTO in connection with the Statement of Use, intended to procure a registration to which it is not entitled and the USPTO relied thereon when issuing Registrant's Registration. Accordingly, Registrant committed fraud and Registrant's Registration should be canceled for fraud.

**ANSWER:** Denied. Registrant has also filed a motion to dismiss Petitioner's fraud claim.

Registrant denies that Petitioner has been and will continue to be damaged by the continued registration of Registrant's ENTOUCH trademark shown in U.S. Registration No. 5271618. Registrant denies that Petitioner is entitled to the relief sought.

## AFFIRMATIVE DEFENSES

Without assuming any burden of proof it would not otherwise bear, Registrant asserts the following affirmative or other defenses. Registrant reserves the right to assert further defenses as discovery proceeds.

### First Affirmative Defense

1. One or more of Petitioner's claims fails to state a claim upon which relief can be granted. Registrant has filed a Motion to Dismiss under Rule 12(b)(6) concurrently with its Answer and Affirmative Defenses.

**Second Affirmative Defense**

2. Petitioner was put on constructive notice of Registrant's intent to use and use of its ENTOUCH mark at least as early as Registrant's March 11, 2015 filing date and Petitioner did not oppose or take other action against Registrant's mark until its letter dated December 15, 2016.

3. Petitioner unreasonably delayed in taking action, and Petitioner's delay materially prejudiced Registrant.

4. Petitioner failed to take any action against Registrant's prior use or registration for the ENTOUCH mark and thus Petitioner's claims are barred by the doctrines of waiver, laches, acquiescence, and estoppel.

**WHEREFORE**, Registrant prays that this cancellation be dismissed.

Respectfully submitted,

Date: June 21, 2018

By: /Maurine L. Knutsson/
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Attorneys for Prepared Health, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that on June 21, 2018, a copy of the foregoing ANSWER TO AMENDED PETITION FOR CANCELLATION was served on the following counsel of record for Petitioner, via email, addressed as follows:

tm-slc@stoel.com

_/mark houston /