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Filing date: **06/29/2018**

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 has filed a petition to cancel the registration indicated below.

**Petitioner Information**

Name	Epic Systems Corporation		
Entity	Corporation	Citizenship	Wisconsin
Address	1979 Milky Way Verona, WI 53593 UNITED STATES		

Attorney information	Anthony A. Tomaselli Quarles & Brady LLP 33 East Main Street, Suite 900 Madison, WI 53703 UNITED STATES Email: aat@quarles.com, martha.snyder@quarles.com, lori.meddings@quarles.com, meme.hilley@quarles.com, hailey.carvalho@quarles.com Phone: 608-251-5000		
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**Registration Subject to Cancellation**

Registration No.	4361839	Registration date	07/02/2013
Registrant	Educational Commission for Foreign Medical Graduates 3624 Market Street Philadelphia, PA 19104 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 039. First Use: 2013/04/02 First Use In Commerce: 2013/04/02 All goods and services in the class are subject to cancellation, namely: Electronic storage services for physicians, other health care providers, and students/trainees in medicine and other health professions worldwide, namely, providing an electronic repository for their credentials and other professional documents
Class 045. First Use: 2013/04/02 First Use In Commerce: 2013/04/02 All goods and services in the class are subject to cancellation, namely: Verifying the authenticity of the credentials of physicians, other health care providers, and students/trainees in medicine and other health professions, and reporting on their credentials and other professional documents to medical regulatory authorities, other organizations, and individuals worldwide for public safety reasons

**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)
Dilution by tarnishment	Trademark Act Sections 14(1) and 43(c)

## Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1791373	Application Date	07/28/1992
Registration Date	09/07/1993	Foreign Priority Date	NONE
Word Mark	EPIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1979/03/00 First Use In Commerce: 1980/02/00 computer programs and accompanying users' manuals sold as a unit for the healthcare and public health fields		

U.S. Registration No.	1925126	Application Date	02/14/1994
Registration Date	10/10/1995	Foreign Priority Date	NONE
Word Mark	EPICCARE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1993/11/25 First Use In Commerce: 1993/11/25 computer programs and accompanying manuals sold as a unit for use by health-careproviders to access and maintain medical records		

U.S. Registration No.	2246406	Application Date	09/10/1996
Registration Date	05/18/1999	Foreign Priority Date	NONE
Word Mark	EPICENTER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/04/00 First Use In Commerce: 1998/04/00 computer programs and accompanying usermanuals sold as a unit for use in the health care industry for master patient indexing, and for coordinating, linking, indexing, accessing or integrating clinical, health care or related data among, across, from or to similar or disparate computer systems		

U.S. Registration No.	2406751	Application Date	04/01/1998
Registration Date	11/21/2000	Foreign Priority Date	NONE
Word Mark	EPICWEB		

Design Mark	<b>EPICWEB</b>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/10/15 First Use In Commerce: 1998/10/15 COMPUTER SOFTWARE AND ACCOMPANYING MANUALS SOLD AS A UNIT FOR USE IN THE HEALTHCARE FIELD, NAMELY, PROVIDING REMOTE ACCESS TO HEALTHCARE SYSTEMS, INCLUDING, MEDICAL RECORDS, PATIENT ACCOUNTING, SCHEDULING, MANAGED CARE, ADMISSIONS, DISCHARGE, AND TRANSFER, LABORATORY, AND MEDICAL DATA REPOSITORY		

U.S. Registration No.	2567678	Application Date	08/19/1997
Registration Date	05/07/2002	Foreign Priority Date	NONE

Word Mark	EPICLINK		
Design Mark	<b>EPICLINK</b>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/11/17 First Use In Commerce: 2000/11/17 computer software and accompanying manuals sold as a unit for use in the healthcare field, namely, providing remote access to health care systems, including, medical records, patient accounting, scheduling, managed care, admissions, discharge, and transfer, laboratory, and medical data repository		

U.S. Registration No.	4206061	Application Date	03/01/2012
Registration Date	09/11/2012	Foreign Priority Date	NONE
Word Mark	EPIC		

Design Mark	<h1>EPIC</h1>
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1979/02/01 First Use In Commerce: 1979/06/01 Design and development of computer software for use in the healthcare field; implementation and maintenance of computersoftware for use in the healthcare field; technical support, namely, troubleshooting of computer software problems relative to software used by healthcare organizations; consulting services on the subject of design, implementation, operation, maintenance and troubleshooting of computer software used by healthcare organizations

Attachments	75460684#TMSN.png( bytes ) 75343425#TMSN.png( bytes ) 85558050#TMSN.png( bytes ) Petition for Cancellation.pdf(346296 bytes )
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Signature	/Anthony A. Tomaselli/
Name	Anthony A. Tomaselli
Date	06/29/2018

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

In the Matter of Registration No. 4,361,839

Mark:



Date of Registration: July 2, 2013

Epic Systems Corporation )

)

Petitioner, )

)

v. )

)

Cancellation No. \_\_\_\_\_

Educational Commission for )  
Foreign Medical Graduates )

)

Respondent. )


**PETITION FOR CANCELLATION**

Petitioner, Epic Systems Corporation (“Epic”), a Wisconsin corporation located and doing business at 1979 Milky Way, Verona, Wisconsin 53593-9179, believes that it is, and will continue to be, damaged by Registration No. 4,361,839, and hereby petitions to cancel the same.

As grounds for cancellation, it is alleged that:

1. Since at least as early as 1980, Epic has developed and sold computer software for use in medical and healthcare fields under the EPIC trademark. Over the past four decades, Epic has expended considerable costs, time, and effort in becoming a recognized leader in the healthcare software industry with thousands of healthcare providers and patients using its software solutions. As such, Epic has developed and owns valuable goodwill in many marks associated with the development and sale of software for use in the medical and healthcare fields.

2. Epic registered the trademark EPIC (Registration No. 1,791,373) for use in connection with “computer programs and accompanying users’ manuals sold as a unit for the

health care and public health fields” in International Class 9, on September 7, 1993. Epic also owns registrations for other EPIC marks, including EPICCARE (Registration No. 1,925,126), EPICENTER (Registration No. 2,246,406), EPICWEB (Registration No. 2,406,751), EPICLINK (Registration No. 2,567,678), EPIC (Registration No. 4,206,061),  (Registration No. 5,098,055), and EPIC EARTH (Registration No. 4,460,048) for use in connection with a range of computer programs for use in a variety of healthcare-related processes. Epic’s software has been used by hospitals, academic medical centers, community hospitals, children’s healthcare organizations, retail clinics, specialty groups, integrated delivery networks, safety net providers, rehab centers, skilled nursing, hospice, and independent health practices.

3. Upon information and belief, Educational Commission for Foreign Medical Graduates is an Illinois non-profit corporation located and doing business at 3624 Market Street, Philadelphia, Pennsylvania 19104 (“ECFMG”).

4. On July 2, 2013, ECFMG registered the design mark consisting of the word EPIC with the letter “E” represented within a circle (“EPIC Design Mark” or “ECFMG’s Mark”)—Registration No. 4,361,839—for use in connection with “electronic storage services for physicians, other health care providers, and students/trainees in medicine and other health professions worldwide, namely, providing an electronic repository for their credentials and other professional documents” in International Class 39 and “verifying the authenticity of the credentials of physicians, other health care providers, and students/trainees in medicine and other health professions, and reporting on their credentials and other professional documents to medical regulatory authorities, other organizations, and individuals worldwide for public safety reasons” in International Class 45.

5. On June 14, 2011, ECFMG filed an application for registration of the EPIC Design Mark pursuant to Section 1(b) (intent-to-use).

6. Upon information and belief, ECFMG did not make use of the EPIC Design Mark until at least April 2, 2013.

7. ECFMG is not affiliated with, connected with, or endorsed or sponsored by Epic. Epic has not approved or authorized ECFMG to register or use the EPIC Design Mark in U.S. commerce with regard to the services identified in the registration.

8. Epic has established strong common law rights in and to the EPIC Marks in connection with software and software-related services in the healthcare field. Epic shall rely on such common law rights in seeking to cancel ECFMG's registration of the EPIC Design Mark.

9. In addition to its common law rights, Epic is the owner of, and will rely upon herein, the United States trademark registrations identified in paragraph 2.

10. Epic's rights in its EPIC trademarks are superior to any rights ECFMG may have in the EPIC Design Mark.

11. Epic has continuously used its EPIC Marks since long prior to the registration date of ECFMG's EPIC Design Mark, and since long prior to ECFMG's alleged date of first use of the EPIC Design Mark.

12. The following registrations of Epic's EPIC Marks have achieved incontestable status under 15 U.S.C. § 1065: 4,206,061; 1,791,373; 1,925,126; 2,246,406; 2,567,678; and 2,406,751.

13. ECFMG's mark is identical in sound and almost identical in appearance and commercial impression to Epic's mark. The design feature of ECFMG's mark does not impact

sound in any way, and does not convey any meaning so as to alter the commercial impression of the mark.

14. ECFMG's services identified in the EPIC Design Mark registration are similar to those of Epic. Electronic storage services utilize software, and such software is searchable and accessible by ECFMG's customers. (*See Exhibit A* (screenshot from ECFMG's website for "Applicant Portal")). Epic's software includes storage of information, including log-in credentials and profile information for medical professionals, and other staff in the healthcare industry. As explained above, Epic provides a variety of software products to customers in the medical and healthcare fields.

15. Moreover, ECFMG's target audience is medical school students and graduates. These are the same users who interface with Epic's software, and who in some cases are involved in purchasing Epic's software.

16. Thus, when applied to the services of ECFMG, the EPIC Design Mark is likely to cause confusion or mistake, or to deceive the purchasing public. Because the services provided under Epic's trademark and ECFMG's Design Mark overlap (both being computer software and services involving the use of software for use in medical and healthcare fields), purchasers will be led to the mistaken belief that Epic's goods and services and ECFMG's services originate from the same source, or that ECFMG's use of EPIC has been sponsored, authorized, or warranted by Epic, all to Epic's detriment.

17. ECFMG's use of an identical mark for overlapping services will cause confusion and deception, and could impair Epic's ability to conduct its business in certain channels of trade.

18. The contemporaneous use by ECFMG of the EPIC Design Mark will dilute and impair Epic's trademarks and trademark rights. ECFMG's registration will cause Epic's mark to



lose its distinctiveness and exclusivity and will result in the inability of Epic's mark to function as a source or indication of origin.

19. Based upon the foregoing, Registration No. 4,361,839 is causing injury and damage to Epic.

WHEREFORE, Epic requests cancellation of Registration No. 4,361,839 for use in connection with "electronic storage services for physicians, other health care providers, and students/trainees in medicine and other health professions worldwide, namely, providing an electronic repository for their credentials and other professional documents" in International Class 39 and "verifying the authenticity of the credentials of physicians, other health care providers, and students/trainees in medicine and other health professions, and reporting on their credentials and other professional documents to medical regulatory authorities, other organizations, and individuals worldwide for public safety reasons" in International Class 45.

Please direct all correspondence in this matter to the undersigned.

Dated: June 29, 2018

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

In the Matter of Registration No. 4,361,839

Mark:



Date of Registration: July 2, 2013

Epic Systems Corporation )

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Cancellation No. \_\_\_\_\_

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**EXHIBIT A  
TO  
PETITION FOR CANCELLATION**

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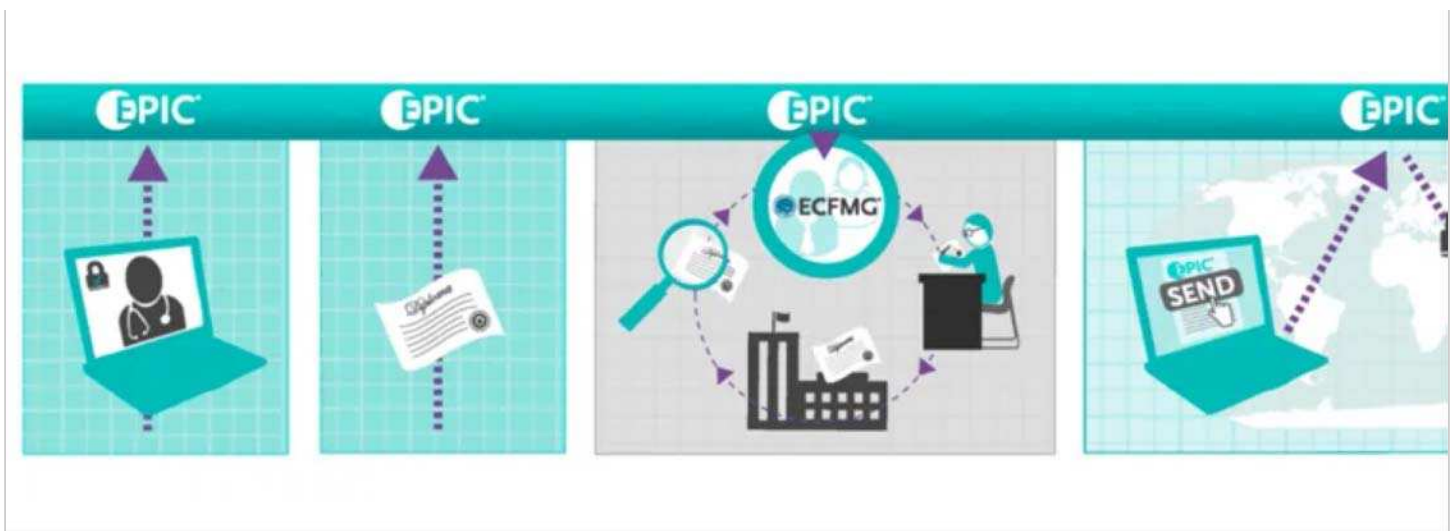
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## How EPIC Works

EPIC makes it possible for the world's physicians, as well as for the organizations responsible for evaluating the credentials of those physicians, to access the highest professional standard in the verification of physician credentials. EPIC is convenient, efficient, and secure.

The logo features the text "HOW EPIC WORKS:" in a bold, teal, sans-serif font. The word "EPIC" is significantly larger and more prominent than the other words. The letter "E" in "EPIC" is stylized, with a circular shape behind it that partially overlaps the letter.



## Physician Establishes an EPIC Account and Verifies Identity

The physician submits a request to establish an EPIC Account, which includes basic biographic information, details about his/her medical education and licensure history (if applicable), a recent photo, and a scanned image of the photograph page of his/her passport. The photo and passport will appear on the *EPIC Identification Form (EIF)*, which the physician must have certified by an acceptable official and then mailed to ECFMG. The physician must have a valid *EIF* on file with ECFMG in order to use EPIC.

## Physician Uploads a Credential to EPIC

With a valid *EIF* on file, the physician is able to upload electronic copies (PDF, JPG, or TIF) of his/her medical credentials to EPIC. Currently, the types of credentials a physician can upload to EPIC are:

- Final Medical Diploma
- Alternate Graduation Document
- Final Medical School Transcript
- Student Medical School Transcript
- Pregraduate Internship Credential
- Postgraduate Medical Education Credential
- Specialist Qualification
- Certificate of Medical Registration
- License to Practice Medicine
- Advanced Degree in the Medical Sciences

If a physician uploads a credential that is not in English, he/she also must provide an English translation that meets ECFMG's translation requirements.

## ECFMG Primary-source Verifies the Credential

For every credential uploaded to EPIC, ECFMG uses its established process to primary-source verify the credential directly with the issuing institution. Primary-source verification is a rigorous, multi-step process that ECFMG employs to ensure the integrity and authenticity of a physician's credentials. The process is not complete until ECFMG receives and accepts verification of these credentials directly from the issuing institution. Once a credential has been verified, it will become part of the physician's secure EPIC Portfolio.

## Physician Requests to Have an EPIC Report Sent

Using EPIC, the physician can request verification reports demonstrating the authenticity of the primary-source verified credentials for organizations worldwide. EPIC Reports include the physician's name, photo, date of birth, EPIC ID, the physician's name as it appears on the credential, and information on the institution that issued the credential. Verification reports are accompanied by a copy of the credential and, if the credential is not in English, an English translation of the credential.

## Organization Receives EPIC Report

EPIC offers organizations the flexibility to choose between two options for secure, electronic access to reports.

If the organization establishes an EPIC Report Portal Account, reports will be delivered through the secure EPIC Report Portal. Through the portal, the organization's authorized users can view all reports sent to the organization; sort these reports; and access copies of the reports, credentials, and the verification forms completed by the institutions that verified the credentials.

If the organization does not establish an EPIC Account, reports will be delivered through a secure, one-time-use version of the portal. Instructions for obtaining the report will be sent to the e-mail address provided by the physician at the time the report is requested.

For information on establishing an EPIC Report Portal Account, please contact EPIC Support Services at ECFMG by e-mail at [info@ecfmgepic.org](mailto:info@ecfmgepic.org) or by telephone at (215) 966-3900, Monday through Friday, 9:00 a.m. to 5:00 p.m., Eastern Time in the United States.

Last updated January 19, 2018

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