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

Proceeding	94002768
Party	Registrant Alacare Home Health Services, Inc.
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Attachments	Alacares Answer to Concurrent Use Proceeding.pdf(221046 bytes)

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

HERITAGE SENIOR CARE, INC.,)
)
 Applicant,)
)
v.)
)
ALACARE HOME HEALTH)
SERVICES, INC., and WILD)
KARMA, INC.,)
)
 Registrants.)

Concurrent Use No.: 94002768

**ALACARE HOME HEALTH SERVICES, INC.’S ANSWER TO HERITAGE SENIOR
CARE, INC.’S CONCURRENT USE PROCEEDING**

Registrant Alacare Home Health Services, Inc., based on its present knowledge and belief, files its Answer to this Concurrent Use Proceeding, initiated at the request of Applicant Heritage Senior Care, Inc., as follows:

THE PARTIES AND THEIR MARKS

1. Alacare Home Health Services, Inc. is the exclusive owner of the mark YOUR HOME. YOUR CARE. YOUR WAY. (the “Alacare Mark”) for use in connection with the following goods and services in International Class 44:

Home health care services, namely, hospice services, palliative care, diabetic care, rehabilitation services, wound care, dietary and nutritional guidance, clinical social work services, psychiatric services, cardiac care services, infusion therapy, chronic obstructive pulmonary disease (COPD) therapy, coumadin therapy monitoring; remote patient telemonitoring services, namely, remote monitoring of patient information, namely, heart rate, blood pressure, oxygen saturation, temperature and weight; rental and provision of home medical equipment and non-medical home assistance services.

Alacare first used its Alacare Mark at least as early as September 30, 2002.

2. Alacare applied to federally register the Alacare Mark on March 20, 2006. The Alacare Mark was federally registered as Reg. No. 3255474 on June 26, 2007.

3. The '474 Registration is incontestable.

4. Wild Karma, Inc. purports to be the owner of the mark YOUR LIFE. YOUR WAY. YOUR HOME. (the "Wild Karma Mark") for use in connection with the following goods and services in International Class 45:

In-home support services to senior persons, namely, geriatric care management services in the nature of coordination of necessary services and personal care for older individuals.

Wild Karma's application for registration identified a date of first use of December 2, 2011.

5. The Wild Karma Mark was federally registered as Reg. No. 4210179 on September 18, 2012, based on an application filed on April 19, 2012.

6. The '179 Registration is not yet incontestable.

7. Heritage Senior Care, Inc. has applied to federally register the mark YOUR HOME, YOUR WAY. SINCE 1983 (the "Heritage Mark") for use in connection with the following goods and services in International Class 45:

Non-medical in-home personal care services for assisting with daily living activities of the elderly, including light housekeeping and meal preparation; In-home social service, namely, companionship services for the elderly.

8. Heritage's application, Serial No. 86/795334, was filed on October 21, 2015, and alleges a date of first use of May 1, 1983.

JURISDICTION

9. Alacare denies that the Trademark Trial and Appeal Board has jurisdiction to maintain this concurrent use proceeding.

10. The United States Patent and Trademark Office may institute a concurrent use proceeding only if the applicant "alleges use in commerce 'prior to (1) the earliest of the filing

dates of the applications pending or of any registration issued under [the Trademark Act of 1946].” T.B.M.P. § 1103.01(b) (quoting 15 U.S.C. § 1052(d)). “This requirement is jurisdictional in nature.” *Id.*

11. Alacare denies that Heritage has sufficiently alleged use in commerce of the applied-for mark (YOUR HOME, YOUR WAY. SINCE 1983) before the ‘474 Registration’s filing date of March 20, 2006. In its August 18, 2016, Response to Office Action, Heritage submitted the photograph reproduced below of two brochures. Heritage stated that “the white brochure was in use by Applicant from 1980 through 2005.” (emphasis added). The white brochure, however, uses a different mark—YOUR HOME, YOUR WAY...—which is at most a component of the applied-for mark. Furthermore, as to the red brochure, Heritage alleges only that it is “currently in use” and “replaced the white brochure.” But Heritage fails to specify any date—whether before or after March 20, 2006—when it began using the red brochure.



12. In light of this inconsistency, Heritage's alleged date of first use of May 1, 1983 is implausible. Heritage's allegations therefore fail to satisfy the jurisdictional threshold—it fails to sufficiently allege use of the Heritage Mark before Alacare filed its application resulting in the '474 Registration.

TERRITORY OF USE

13. Except as specifically admitted below, Alacare denies Heritage's allegations relating to territory of use.

14. Alacare's '474 Registration was published for opposition on April 10, 2007, and issued on June 26, 2007. The '474 Registration has been incontestable since October 2012.

15. As a result, Alacare is entitled to a registration covering the entire United States except for any specific areas in which a prior user has established prior rights *before* actual or constructive notice of its '474 Registration. *Thriftmart, Inc. v. Scot Lad Foods, Inc.*, 207 U.S.P.Q. 330, at *4-5 (T.T.A.B. 1980).

16. All parties have had constructive knowledge of the '474 Registration since at least June 26, 2007.

17. Alacare denies that Heritage first began using its Heritage Mark on May 1, 1983. On information and belief, Heritage first used the Heritage Mark around September 2008. *See* https://web.archive.org/web/*/http://heritageseniorcare.com/.

18. Heritage's specimen of use fails to establish use of the applied-for mark (YOUR HOME, YOUR WAY. SINCE 1983) at any time before September 2008. As explained above, Heritage's August 18, 2016, Response to Office Action, offers a specimen that proves only that Heritage was using a component of the applied for mark—YOUR HOME, YOUR WAY...—

until at least 2005. The remaining allegations and evidence fails to corroborate *any* date of first use.

19. Heritage has thus failed to establish any prior use of its mark before at least June 26, 2007. As a result, Heritage is not entitled to any territory of use for its Heritage Mark.

20. Alacare further denies that Wild Karma is entitled to any concurrent use of its Wild Karma Mark.

21. Wild Karma's first use of its Wild Karma mark was in December 2, 2011, which is many years after it received constructive notice of the Alacare's 474 Registration.

22. Accordingly, Alacare is entitled to exclusive, nationwide use of its Alacare Mark, which is not subject to concurrent use by either Heritage or Wild Karma.

23. In the alternative, if the Board were to find that Heritage or Wild Karm is entitled to concurrent use rights, Alacare is entitled to the area comprising the entire United States, excluding only certain counties located in the State of California.

24. On information and belief, Heritage currently uses its Heritage Mark in the following counties in the State of California: San Diego County, Riverside County, and San Bernardino County. On information and belief, around June 26, 2007, Heritage used its Heritage Mark—to the extent it used the mark at all—in only those three counties.

25. Furthermore, on information and belief, Heritage's geographic use of its Heritage Mark has been static and non-expanding since its date of first use. Heritage has therefore forfeited any rights to a larger geographic area by failing to register its Heritage Mark. *Boi Na Braza, LLC v. Terra Sul Corp.*, 110 U.S.P.Q. 2d 1386, at *7–8 (T.T.A.B. 2014).

26. Thus, if Heritage has any rights to concurrent use of its Heritage Mark, those rights are limited to the areas consisting of San Diego County, Riverside County, and San Bernardino County in the State of California.

27. Further in the alternative, to the extent that Wild Karma has any rights to concurrent use of its Wild Karma Mark, Wild Karma's rights are limited to the areas consisting of Alameda County, Contra Costa County, and San Mateo County in the State of California.

GENERAL DENIAL OF ALLEGATIONS

28. To the extent not admitted above, Alacare denies Heritage's remaining allegations with respect to this concurrent use proceeding.

AFFIRMATIVE AND OTHER DEFENSES

29. Without assuming any burden not otherwise applicable to it, Alacare identifies the following affirmative defenses and other defenses and reservations based on its present knowledge and belief:

FIRST DEFENSE

The Board is without jurisdiction to maintain this concurrent use proceeding. 15 U.S.C § 1052(d); T.B.M.P. § 1103.01(b).

SECOND DEFENSE

Heritage has failed to state a claim upon which relief may be granted.

THIRD DEFENSE

There is no issue as to priority. Alacare has used its Alacare Mark since at least September 30, 2002, which is before both Heritage's and Wild Karma's first use of their respective marks.

FOURTH DEFENSE

Heritage's action is barred, in whole or in part, by the doctrine of estoppel.

FIFTH DEFENSE

Heritage does not own valid trademark rights in the Heritage Mark.

SIXTH DEFENSE

The '474 Registration is incontestable under 15 U.S.C. § 1065.

SEVENTH DEFENSE

Heritage or its predecessors had, has, or have a defective chain of title in the rights asserted, did not have proper use of the mark as asserted, or asserts rights that are defective. Without limiting the foregoing, on information and belief, Heritage has existed since only February 27, 2001. To the extent any rights existed in the Heritage mark before that date, Heritage did not possess those rights.

EIGHTH DEFENSE

Heritage has forfeited any rights to a presumption of rights extending beyond its area of actual use due to its failure to register its mark.

RESERVATION OF RIGHTS

Alacare expressly reserves the right to amend, supplement, or assert additional affirmative defenses based on information learned during or through discovery in this proceeding.

RELIEF REQUESTED

WHEREFORE, based on its Answer and Affirmative Defenses, Alacare Home Health Services, Inc. requests:

- (a) that judgment be entered in its favor;

- (b) that the Trademark Trial and Appeal Board dismiss with prejudice this concurrent use proceeding;
- (c) that registration of Heritage Senior Care, Inc.'s application Serial No. 86/795334 be refused;
- (d) that the Board confirm that Alacare is entitled to exclusive, nationwide use of its mark registered at Registration No. 3255474; and
- (e) that the Board award all other further and appropriate relief to which Alacare is entitled.

Dated: October 20, 2017

Respectfully submitted

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CERTIFICATE OF SERVICE

I hereby certify that on October 20, 2017, I caused the foregoing to be served by electronic mail to:

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By: /Jake Gipson/
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