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

Proceeding	91187614
Party	Plaintiff Virgin Health, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VIRGIN HEALTH CORPORATION,
a Florida corporation,

Opposer,

v.

VIRGIN ENTERPRISES LIMITED,
an English corporation,

Applicant.

OPPOSITION NOS.: 91187612
91187614

**OPPOSER’S MEMORANDUM IN OPPOSITION TO APPLICANT’S MOTION FOR
JUDGMENT ON THE PLEADINGS**

AND

**OPPOSER’S MOTION TO SUSPEND THE OPPOSITIONS DURING THE PENDENCY
OF A FEDERAL COURT SUIT BETWEEN THE PARTIES**

I. INTRODUCTION

Applicant’s, Virgin Enterprises Limited (“VEL”), Motion for Judgment on the Pleadings (the “Motion”) argues that Virgin Health Corporation (“Virgin Health”) failed to state a claim. VEL is wrong as a matter of law. VEL primarily erred by ignoring the 1988 Amendment to Section 18 of the Lanham Act, 15 U.S.C. § 1068, which specifically authorizes the cause of action for partial restriction or modification pled by Virgin Health in the subject oppositions. Consequently, as explained below, the Board, over fourteen years ago, based on Section 18 of the Lanham Act, expressly rejected the central arguments proffered here and now by VEL in its Motion. Since Virgin Health pled the allegations that this Board stated were necessary to state a

claim for partial restriction or modification under Section 18, the Board should deny VEL's Motion.

Virgin Health also respectfully requests that the Board suspend the instant oppositions pending the resolution of S.D. Fla. Case No. 08-22557-civ-Ungaro/Simonton which is between the same parties and over the same marks at issue here. As set forth below, the federal court case will adjudicate whether the parties' simultaneous use of their marks for their respective goods and services is likely to cause confusion. Under TBMP Rules, this Board should ordinarily suspend an opposition if the federal court case will have a bearing on it. Here, the federal court's adjudication of whether confusion is likely will be highly relevant to the issue of whether Virgin Health's proposed restriction will avoid confusion. Accordingly, Virgin Health respectfully suggests that suspending the opposition proceedings is the appropriate and proper course of action, and moves the Board for the entry of an order doing so.

II. FACTS & PROCEDURAL POSTURE

A. Virgin Health is in the Intensive Home Health Care Services Business

Since at least as early as November 2005, Virgin Health has been in the business of providing home health care services to patients that: (a) require regular, periodic or highly skilled health care services; and (b) are afflicted with substantial preexisting illnesses or conditions that are not immediately remediable, including: (1) nursing aid services, (2) nursing services, (3) physical therapist services, (4) occupational therapist services, (5) speech and hearing therapist services, and (6) social services critical for mental health such as companionship services for the elderly. See Companioni Dec. ¶ 1, attached as Ex "A."

B. VEL is the Trademark Holding Company for the Virgin Group's Global Business

VEL is the trademark holding company for the Virgin Group. The Virgin Group is comprised of “200 [VIRGIN] branded companies, employing approximately 50,000 people, in 29 countries [with] revenues . . . exceed[ing] US \$20 billion.” See Ex. “B.”

C. The Virgin Group Decides to Dip Its Toe Into the 2.2 Trillion Dollar U.S. Healthcare Industry

“The United States of America has one of the largest medical and healthcare industries in the world. . . . [t]he total health care expenditures across the world were \$4.5 trillion last year. Of which, US solely accounts for 2.2 trillion.” See Ex. “C.” Four years ago, VEL decided to dip its toe into the 2.2 trillion dollar U.S. health care industry by filing two intent-to-use federal trademark applications, numbers 78/570,287 and 78/570,290, covering, among other things, “medical evaluation services, namely, providing health assessments; advisory services relating to health; consultation relating to health care.” In the four years since filing these applications, VEL’s sole entre into the U.S. health care industry has been in association with its Virgin Health Bank, which is providing an infant stem cell collection and repository service, and its Virgin Healthmiles business. According to VEL’s website, the Virgin Healthmiles business “is a first-of-its-kind health, rewards program that motivates and incentivizes consumers to engage in the process of getting and staying healthier, by being more active. The program is offered by insurers, employers and other network partners, such as health clubs, in an effort to motivate Americans to live more active lives – and ultimately lower health care costs for everyone.” See Ex. “D.”

D. VEL is Improperly Seeking to Have Its Identification of Goods or Services Interpreted In Such a Way That It Covers the Entire 2.2 Trillion Dollar Health Care Industry

On December 6, 2007, VEL sent a letter to Virgin Health stating “VIRGIN is a registered trademarkVEL’s licensee, Virgin Healthmiles, Inc. (“VHI”), currently offers VIRGIN-branded services designed to reward individuals for engaging in activity to improve their health. . . .” and demanding that Virgin Health “confirm to us that you will refrain from any use of VIRGIN as all or part of any business name, trademark, or service mark used in association with health care services.” See Ex “E.” On January 14, 2008, VEL filed suit against Virgin Health in the Southern District of New York alleging that Virgin Health was infringing its trademark rights. See Ex. “F.” VEL dismissed the suit only after Virgin Health’s counsel advised VEL’s counsel that New York did not have personal jurisdiction over Virgin Health.

E. There is a Presently Pending Federal Court Suit Involving the Issue of Infringement

After VEL voluntarily dismissed its suit in the Southern District of New York, Virgin Health filed suit against VEL in the Southern District of Florida, Case No. 08-22557-civ-Ungaro/Simonton, seeking, among other things, a declaration that Virgin Health is not infringing VEL’s trademark rights. See Count I of the Complaint, attached as Exhibit “G.” In the parties’ 26(f) Scheduling Report, VEL again asserted that it “expects that it will serve an Answer that likely will deny that the Plaintiff is entitled to any relief, and likely will include one or more counterclaims against the Plaintiff and its controlling person(s).” See Ex “H.”

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