UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

CBG

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB 1/13/00

Opposition No. 93,163

Health Net

v.

Mid-America Health
Network, Inc.

Before Simms, Cissel and Quinn, Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's motion for summary judgment on applicant's counterclaim for cancellation, filed September 30, 1999, with certificates of mailing and service dated September 27, 1999.[1] Applicant's opposition thereto was due by November 1, 1999, but was not filed until November 22, 1999.

[1] We granted opposer's prior motion for summary judgment in regard to the opposition on June 29, 1999, and entered judgment in opposer's favor on the claim of priority of use and likelihood of confusion. Although we did not then dismiss the counterclaim, which alleges that opposer had fraudulently obtained its pleaded registration, we had hoped that our observations regarding the probable outcome of the counterclaim would have persuaded the parties to settle this matter. Applicant's continuing insistence that it should be allowed to pursue the counterclaim has resulted in the needless expenditure of time and money by the parties and the Board.

Although applicant did not file a motion to extend the time to respond to the summary judgment motion in this proceeding, applicant filed such a motion in the related proceeding, Opposition No. 94,072, in which a summary judgment motion also is pending. Opposer filed an opposition to applicant's extension request. We note that both parties parenthetically listed the instant opposition number in the caption for their filings in the related proceeding, as though the two proceedings had been consolidated. In fact, they remain unconsolidated.[2] We do not view the extension request as applicable to this proceeding. However, we have reviewed the request and the opposition thereto in connection with the related proceeding, and have determined that if applicant had filed the same request in this proceeding, it would have been denied for applicant's failure to show good cause. Further, to the extent that the request to extend can be construed as a request for reconsideration of our June 29, 1999 order, it is denied as untimely.

In view of the foregoing, applicant's response to the summary judgment motion was due on November 1, 1999. *See* 37 C.F.R. §§2.127(e)(1) and 2.119(c). While we recognize that we may treat opposer's motion as conceded pursuant to 37

[2] The order granting opposer's motion for summary judgment in regard to the instant opposition referenced the other case, but did not order consolidation.

C.F.R. §2.127(a) because applicant did not file a timely response, we have considered the motion on its merits due to its potentially dispositive nature.

In the counterclaim, applicant contends that opposer fraudulently obtained its registration for the mark HEALTH NET by attesting to erroneous dates of use in the underlying application. In the June 29, 1999 order, we advised applicant that even if a party set forth an incorrect date of first use in its application, the party has not committed fraud unless it did not make valid use of the mark until after the application was filed. *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery,* 17 USPQ2d 1137, 1141 (TTAB 1990); and *Hecon Corp. v. Magnetic Video Corp.,* 199 USPQ 502 (TTAB 1978). We further advised applicant that given the discovery responses and the uncontroverted statements of opposer's former vice president, Ms. Fittipaldo, pertaining to opposer's dates of use, applicant's claim of fraud "appears to be unfounded." To date, applicant has presented no evidence to the contrary. Further, in the September 30, 1999 declaration in support of opposer's summary judgment motion, opposer's counsel affirmatively states that applicant engaged in no new discovery since the June 29, 1999 order, and that the Fittipaldo declaration remains uncontroverted. Finally,

though applicant had an opportunity to depose Ms. Fittipaldo, it declined to do so.[3]

Summary judgment is appropriate when the record shows that there is no genuine issue of material fact and that the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). A dispute as to a material fact issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.,* 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

The party seeking summary judgment bears the initial burden of informing the Board of the basis for its motion and identifying those portions of the record which it believes demonstrate the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S. Ct. 2548 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts

[3] Counsel's claim that he has been "bamboozled by opposer" into the position where he can present no further arguments on applicant's behalf is simply ludicrous.

to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record, or produce additional affidavit evidence showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate, shall be entered in the moving party's favor. Fed. R. Civ. P. 56(e).

In this case, we believe that opposer has carried its burden of showing *prima facie* the absence of any genuine issue of material fact, and its entitlement to judgment as a matter of law. Ms. Fittipaldo's uncontroverted sworn statements establish that opposer continuously has provided its health maintenance organization services and related services under its HEALTH NET mark since 1978. That is, opposer began using its mark long before it filed the involved underlying application. Thus, as a matter of law, opposer has not committed fraud. *Western Worldwide Enterprises Group Inc., supra,* 17 USPQ2d at 1141; and *Hecon Corp., supra*, 199 USPQ 502 (TTAB 1978).

Because applicant has not presented any affidavit or other evidence showing the existence of a genuinely disputed fact issue for trial and because the undisputed facts of

record establish, as a matter of law, that opposer is entitled to judgment in its favor on the counterclaim, we grant opposer's motion for summary judgment. See Fed. R. Civ. P. 56(c).

Judgment is hereby entered in favor of opposer and the counterclaim is dismissed.

R. L. Simms

R. F. Cissel

T. J. Quinn
Administrative Trademark
Judges Trademark Trial and
Appeal Board