

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF WISCONSIN**

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MY HEALTH, INC., a Delaware corporation,

Plaintiff,

v.

Case No. 15-CV-80

GENERAL ELECTRIC COMPANY, a New  
York corporation,

Defendant.

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**DEFENDANT’S BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

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Plaintiff My Health, Inc. (“MHI”) has sold neither goods nor services under its claimed MY HEALTH trademark. Instead, discovery in this case has confirmed that MHI’s revenue-generating activity apparently is litigation and, specifically, collecting settlements for claims of infringement of its business method patent. In this case, MHI has failed to produce in discovery a single shred of evidence of any bona fide sale of goods or services using the purported mark. MHI has not used its trademark in a manner that would support the claims in this lawsuit, and the Seventh Circuit rejects trademark claims under circumstances such as these.

MHI’s failure to use the trademark on which this lawsuit is based in any sort of legitimate commerce is grounds to dismiss this action. MHI’s claims also fail for an independent reason, which is that Defendant General Electric Company (“GE”)’s use that MHI alleges is an infringement commenced years before MHI’s earliest claimed priority date—indeed, more than two years before MHI came into existence—and continued without material change until that use was phased out by GE in the ordinary course of business. Because GE’s use was senior, MHI has no remedy against GE, even if MHI has valid trademark rights of some kind.

## **STATEMENT OF PROPOSED UNDISPUTED FACTS**

### **I. GE'S LAUNCH OF ITS "myHealth" WEB SITE IN 2005**

GE is a New York corporation, with employees around the world. (Defendant's Proposed Findings of Fact ("PFF") ¶ 2.) For many years, GE has maintained an informational health and benefits website that is designed to assist GE employees, retirees, and their dependents, including GE health benefit plan participants, in leading a healthy lifestyle. (PFF ¶ 3.) Although the site was designed to be of interest only to GE benefit plan participants, it was made accessible on the public internet so that retirees and dependents without GE employee credentials could access it. (PFF ¶ 4.)

Prior to 2005, this informational health and benefits website was located at the uniform resource locator ("URL") [www.ge.com/healthcare](http://www.ge.com/healthcare). (PFF ¶ 5.) In 2005, GE rebranded its business unit that provides medical equipment and technology to healthcare providers as "GE Healthcare," and decided to change the name and URL of the internal benefits website so as to avoid possible confusion with the external offerings of that business unit. (PFF ¶¶ 6-7.) On August 3, 2005, GE's Operations Leader for Group Health Programs asked a few employees for suggestions for a new name and URL for the website, and among the suggestions was [ge.com/myhealth](http://ge.com/myhealth). (PFF ¶¶ 8-9.) GE surveyed a larger group of employees about the suggested names, and the GE employees selected the name "myHealth" for the new website. (PFF ¶ 10.)

GE's redesigned employee health and benefits website, which was located at [www.ge.com/myhealth](http://www.ge.com/myhealth), went live in November 2005. (PFF ¶ 11.) The website header displayed the famous GE Monogram design and immediately next to it the term "myHealth" as follows:



(PFF ¶ 12.) The term “myHealth” was also used to refer to the site in phrases such as “Welcome to the new myHealth website” and “Welcome to myHealth.” (PFF ¶ 13.)

Between 2005 and 2011, the GE “myHealth” website provided GE employees, retirees, and dependents with information regarding health, wellness, and benefits. (PFF ¶ 14.) The site also provided information about third-party services that GE made available to its employee benefit plan participants at no cost, such as a “Health Coach” service to assist GE benefit plan participants in selecting doctors and treatment options, and a page titled “MyHealthIQ health and wellness portal,” which displayed a secure hyperlink by which GE benefit plan participants could access a third-party website to complete a health risk questionnaire and receive health and wellness information based on their responses. (PFF ¶¶ 15-17.)

GE regularly updated the content of the “myHealth” website between 2005 and 2011 to include different articles and topics, such as preventing heart disease, portion sizes, exercise, and healthy recipes, among others. (PFF ¶ 18.) The overall character of the website and the display of the term “myHealth” did not change in any material way and was continuous for the six year time period. (PFF ¶ 19.)

In 2011, as part of a company-wide focus on improving employee health that used the name “HealthAhead,” GE changed the name of the employee health and wellness website to “HealthAhead.” (PFF ¶ 20.) For a period of time after the transition, the web address [www.ge.com/myhealth](http://www.ge.com/myhealth) directed users to the “GE HealthAhead” employee health and benefits website. (PFF ¶ 21.) The site no longer displays the term “myHealth.” (PFF ¶ 22.)

## II. CREATION OF MHI IN 2008 AND ITS SUBSEQUENT TRADEMARK REGISTRATION

MHI was incorporated on April 16, 2008, in the State of Delaware. (PFF ¶ 23.) GE’s “myHealth” employee health and benefits website had by then been active for more than two years. (PFF ¶¶ 11, 23.) On May 7, 2008, MHI filed a federal trademark application to register the mark MY HEALTH on an intent-to-use basis. (PFF ¶ 24.) [REDACTED]

[REDACTED] United States Patent No. 6,612,985 (“the ’985 Patent”) entitled “Method and system for monitoring and treating a patient.” (PFF ¶ 25.)

On May 11, 2009, MHI filed a Statement of Use with the U.S. Patent and Trademark Office (“USPTO”), declaring—under penalty of perjury—that the mark MY HEALTH had been in use in commerce since April 17, 2008, the day after MHI was incorporated. (PFF ¶¶ 23, 26.)

MHI claimed use as of that date for the following services:

Computer software consultancy; Computer software design; Consultancy in the field of software design; Developing computer software, in International Class 42; and

Providing an internet web site for medical professionals and medical patients that allows for the exchange of information from remote locations using devices that feed information to the web site that is then processed and can be accessed in real-time by users; Providing an internet web site for medical professionals and medical patients that allows for the exchange of information from remote locations using electronic patient monitoring devices that feed information to the web site that can be accessed in real-time by medical professionals for purposes of monitoring and diagnosing medical conditions; Providing medical information, consultancy and advisory services, in International Class 44

(PFF ¶ 27.) Based on MHI’s representations of actual use, on November 10, 2009, the USPTO issued to MHI U.S. Trademark Registration No. 3,709,669 for use of the mark MY HEALTH on the above services. (PFF ¶ 28.)

**III. MHI HAS NEVER USED ITS PURPORTED MARK IN COMMERCE.**

On October 23, 2015, GE served discovery on MHI that requested, among other things, that MHI produce the following documents:

**REQUEST NO. 9.** For each good or service referenced in Interrogatory No. 1 [which asked for identification of goods or services sold under the MY HEALTH mark], documents sufficient to show total sales, in dollars and units, by year, of such goods and services....

**REQUEST NO. 10.** For each good or service referenced in Interrogatory No. 1, documents sufficient to show total profits, in dollars and units, by year, derived from such goods and services.

**REQUEST NO. 12.** Documents sufficient to identify all goods and services promoted, advertised, marketed, or sold under the Mark by You or through any licensing or other agreement issued by You.

**REQUEST NO. 18.** All strategic plans, management plans, marketing plans, or other formal or informal planning documents concerning goods or services offered under or proposed to be offered under the Mark.

**REQUEST NO. 26.** All documents evidencing that You have continuously used the Mark in commerce since at least April 17, 2008, as alleged in Paragraph 18 of the Complaint.

**REQUEST NO. 30.** All documents evidencing that You use the Mark “in conjunction with remote monitoring of a patient’s condition through the Internet, wireless servers, and web applications” as alleged in Paragraph 25 of the Complaint.

**REQUEST NO. 39.** All documents supporting Your claim of damages.

(PFF ¶ 30.)

MHI served unsworn discovery responses on December 9, 2015. (PFF ¶ 31.) In response to each of the above document requests, MHI said that it would “produce non-privileged responsive documents.” (PFF ¶ 32.) MHI simultaneously produced 762 pages of documents. (PFF ¶ 33.) Of these, over 700 pages related exclusively to the ‘985 Patent: the patent itself, its file history in the USPTO, and various license, assignment, and other contractual documents concerning that patent. (PFF ¶ 34.) The remaining pages produced by MHI consisted of MHI’s

correspondence with GE about this dispute; screen shots of various web pages purportedly showing GE's infringing uses; screen shots of web pages from MHI's web site; and a "License and Settlement Agreement" with [REDACTED], after the filing of this action. (PFF ¶ 35; Compl., Dkt. 1.)

On December 15, 2015, GE asked MHI to either confirm that its discovery responses and document production were complete, or to supplement its responses by December 30, 2015. (PFF ¶ 36.) In response, on December 30, MHI produced 66 agreements relating exclusively to the '985 Patent, and a duplicate copy of the [REDACTED] agreement. (PFF ¶ 37.) MHI made no other attempts to update its written discovery responses or supplement its document production. (PFF ¶ 38.)

MHI did not produce any documentation showing an actual sale of any goods or services under its purported MY HEALTH mark. (PFF ¶ 50.) Indeed, in 2010, when MHI wrote to GE and claimed infringement, GE questioned whether MHI had made any actual use of its purported mark in commerce. (PFF ¶¶ 53-54.) MHI did not identify any such use and simply stated that if it decided to take any action, "you will be advised." (PFF ¶ 55.) MHI waited more than four years, until its declaration of incontestability was accepted by the USPTO, and then commenced this lawsuit. (PFF ¶ 56.)

### **STANDARD OF REVIEW**

Summary judgment is warranted when "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). The Seventh Circuit has described summary judgment as the "'put up or shut up' moment in a lawsuit, when a party must show what evidence it has that would convince a trier of fact to accept its version of events." *Steen v. Myers*, 486 F.3d 1017, 1022 (7<sup>th</sup> Cir. 2007) (quoting *Hammel v. Eau Galle*

*Cheese Factory*, 407 F.3d 852, 859 (7th Cir. 2005)). To defeat summary judgment, the non-moving party must submit admissible evidence sufficient to allow a trier of fact to find in its favor. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505 (1986). Otherwise, “Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party’s case, and on which that party will bear the burden of proof at trial.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548 (1986).

## ARGUMENT

### **I. MHI CANNOT SUCCEED ON ITS LANHAM ACT CLAIMS BECAUSE IT HAS NOT USED THE PURPORTED MARK IN COMMERCE.**

The “most fundamental aspect of United States trademark law [is] that trademark ownership and attendant rights are acquired in the marketplace by use...” *In re ECCS, Inc.*, 94 F.3d 1578, 1579 (Fed. Cir. 1996). Federal registration confers benefits, but it “does not create a mark or confer ownership; only use in the marketplace can establish a mark.” *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 979 (9th Cir. 2006). This core premise is embodied in the language of the Lanham Act itself: before any registration may issue, the applicant must file a “verified statement that the mark is in use in commerce.” 15 USC § 1051(d)(1).

“The registration of a mark that does not meet the use requirement is void ab initio.” *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009). The Seventh Circuit has explained the reasons for this rule:

Bare registration is not enough. Trademarks cannot be “banked” or “warehoused” – that is, you cannot register thousands of names, unrelated to any product or service that you sell, in the hope of extracting a license fee from sellers of products or services for which one of your names might be apt... For such a practice, by creating a trademark thicket, would make it difficult for new producers to find suitable names for their products that had not already been appropriated to no worthier end than providing the premise for an infringement suit.

*Custom Vehicles Inc. v. Forest River, Inc.*, 476 F.3d 481, 485 (7th Cir. 2007). See also, e.g., *Central Mfg., Inc. v. Brett*, 492 F.3d 876, 881 (7th Cir. 2007) (“Ultimately, it is not the fact of registration that matters so much as the use of the mark in commerce; [b]y insisting that firms use marks to obtain rights in them, the law prevents entrepreneurs from reserving brand names in order to make their rivals’ marketing more costly.”) (quoting *Zazu Designs v. L’Oreal, S.A.*, 979 F.2d 499, 503 (7th Cir. 1992)).

**A. MHI Has Not Used Its Purported Mark In Commerce.**

With respect to services such as those claimed by MHI here, “a mark shall be deemed to be used in commerce...when it is used or displayed in the sale or advertising of services *and the services are rendered in commerce.*” 15 U.S.C. § 1127 (emphasis added). The conjunctive nature of this definition is crucial; the statute “requires not only the display of the mark in the sale or advertising of services *but also the rendition of those services* in order to constitute use of the service mark in commerce.” *Aycock Engineering, Inc.*, 560 F.3d at 1359 (emphasis added) (quoting *Intermed Comm., Inc. v. Chaney*, 197 USPQ 501, 507-08 (TTAB 1977)).

MHI’s document production establishes that it cannot meet the statutory use requirement, because it has not rendered any services in commerce under the claimed MY HEALTH mark. Copies of pages from MHI’s website are at most advertising or promotion, which are insufficient without evidence that services were actually performed. See *Specht v. Google Inc.*, 747 F.3d 929, 934-35 (7th Cir. 2014) (“use must pertain to the sale of goods or provision of services;” evidence of traffic to plaintiff’s website “goes nowhere because [plaintiff] furnished no evidence of any commercial interest associated with the visits”); *Buti v. Perosa, S.R.L.*, 139 F.3d 98, 105 (2d Cir. 1998) (“the mere advertising or promotion of a mark in the United States is insufficient to constitute ‘use’ of the mark ‘in commerce,’ within the meaning of the Lanham Act, where that



advertising or promotion is unaccompanied by any actual rendering in the United States or in ‘commerce which may lawfully be regulated by Congress,’ 15 U.S.C. § 1127, of the services ‘in connection with which the mark is employed’...” (emphasis omitted); *Sensient Techs. Corp. v. SensoryEffects Flavor Co.*, 613 F.3d 754, 762 (8th Cir. 2010) (“mere advertising is not enough to constitute ‘use in commerce’ because ‘a mark is used in commerce only if it accompanies services rendered in commerce’”) (quoting *Int’l Bancorp, LLC v. Societe des Bains de Mer et du Cercle des Etrangers a Monaco*, 329 F.3d 359, 364 (4th Cir. 2003)).

The only other documentation MHI produced consists of various license and settlement agreements; however, even bona fide licensing agreements cannot by themselves establish use in commerce. *See Gameologist Group, LLC v. Sci. Games Int’l, Inc.*, 508 F. App’x 31, 33 (2d Cir. 2013) (unpublished) (“In the absence of sales, a licensing agreement generally cannot qualify as use in commerce.”). Moreover, only one of these agreements, the “License and Settlement Agreement” with [REDACTED], [REDACTED], and that agreement cannot evidence any trademark use relevant to this case because it was entered into [REDACTED] more than six years after MHI filed the statement of use that resulted in issuance of its registration. (PFF ¶¶ 26, 39, 46-47.)

The language of the [REDACTED] also does not establish bona fide use of MHI’s claimed mark at any time. [REDACTED] [REDACTED]. (PFF ¶ 40 [REDACTED] [REDACTED] [REDACTED]); ¶ 41 [REDACTED].) In other words, [REDACTED] [REDACTED]

Threatening and bringing trademark infringement suits does not constitute using a mark in commerce. *Silverman v. CBS Inc.*, 870 F.2d 40, 47-48 (2d Cir. 1989) (“[C]hallenging infringing uses is not use...”); *Baig v. Coca-Cola Co.*, 69 F. Supp.3d 766, 780 (N.D. Ill. 2014) (pursuing infringement claims not a use in commerce).

Moreover, the [REDACTED] lacks essential characteristics of a genuine trademark license. It purported to authorize the use of MHI’s mark [REDACTED]

[REDACTED]

[REDACTED]

(PFF ¶¶ 42-43, 45.) [REDACTED]

[REDACTED]

[REDACTED] (PFF ¶¶ 41, 44.) [REDACTED]

[REDACTED]

[REDACTED] (PFF ¶ 45.) Where a purported licensor retains “no authority over the appearance and operations of defendants’ business, or even over what inventory to carry or avoid,” that “is the paradigm of a naked license,” and any rights in the mark are deemed abandoned. *Eva’s Bridal Ltd. v. Halanick Enter., Inc.*, 639 F.3d 788, 790 (7th Cir. 2011) (emphasis in original).

The remaining license and settlement agreements produced by MHI are even further removed from any possible claim that they evidence trademark use: [REDACTED]

[REDACTED]. (PFF ¶¶ 46-47.) [REDACTED]

[REDACTED]. (PFF ¶ 48.) The earliest of these agreements was entered into in [REDACTED], long after MHI has claimed that it commenced use of the MY HEALTH mark. (PFF ¶¶ 26, 49.)

Despite unambiguous requests, MHI's production did not include a single document showing the actual sale of any goods or services under the purported MY HEALTH mark. (PFF ¶ 50.) There is no documentation of the first dollar of revenue generated by any such sales. (PFF ¶ 51.) MHI has produced no internal strategic plans, management plans, marketing plans, or other operational documents showing delivery of, preparations to deliver, or implementation of the capacity to deliver any goods or services under that mark. (PFF ¶ 52.) The discovery record is unambiguous: MHI simply obtained a patent, obtained a trademark registration, and proceeded to extract settlements based on threats of infringement litigation. It did not engage in any bona fide commerce under the mark that it now attempts to enforce.

**B. MHI's Claim Of Incontestability Cannot Forestall Summary Judgment.**

A registered mark can gain incontestable status if the registrant continuously uses the mark in commerce for five years and files an affidavit or declaration to that effect with the USPTO. 15 U.S.C. § 1065. MHI filed such a declaration in connection with Registration No. 3709669 on November 12, 2014. (PFF ¶ 29.) However, even when the USPTO accepts the declaration as it did MHI's, a court hearing a subsequent infringement claim must decide based on the evidence whether the registrant in fact engaged in five consecutive years of continuous use, and, if it did not, the registration is not incontestable. *Brittingham v. Jenkins*, 914 F.2d 447, 454 (4th Cir. 1990).

In *Brittingham*, the plaintiff filed an affidavit with the USPTO attesting to five years of continuous and unchallenged use of a service mark. *Id.* at 452. The defendant challenged the plaintiff's mark by saying it was procured by fraud, but the Fourth Circuit held that it did not have to consider the fraud defense because, "contrary to the claims made in his affidavit of use filed with the Patent and Trademark Office, [plaintiff] did not use the [registered] mark continuously in connection with the sale of goods for the required five-year period following

registration.” *Id.* at 454. The registration therefore “never acquired incontestable status,” and the plaintiff was only entitled to the rebuttable presumptions associated with registered marks, not the stronger protections conferred by incontestability. *Id.* at 454-55. *See also, e.g., NetJets Inc. v. IntelliJet Grp., LLC*, No. 2:12-cv-00059, -- F. Supp.3d --, 2015 WL 5935826 at \*8-9 (S.D. Ohio Oct. 13, 2015), *appeal docketed*, No. 15-4230 (6<sup>th</sup> Cir. Nov. 9, 2015) (“It goes without saying, however, that the Court must first examine whether the [registered] mark satisfies the requirements of § 1065 before it can consider” whether any defenses are barred by claimed incontestability; court “therefore must consider whether the mark was in continuous use in commerce for the five years subsequent to its registration...”).

Similarly here, MHI did not use its claimed mark in commerce continuously (or at all) between 2009 and 2014 on the services for which it was registered. (PFF ¶¶ 30-52.) As a result, MHI’s registration is not incontestable, and MHI is at most entitled to the rebuttable presumption of validity that accompanies trademark registration. 15 U.S.C. §§ 1057(b), 1065, 1115; *Brittingham*, 914 F.3d at 454-55.

### **C. The Presumption Of Validity Cannot Save MHI’s Registration.**

While federal registration creates a presumption that a mark is valid, that presumption “is easily rebuttable, since it merely shifts the burden of production to the alleged infringer,” *Custom Vehicles*, 476 F.3d at 486, and “evaporates as soon as evidence of invalidity is presented.” *Georgia-Pacific Consumer Prods. LP v. Kimberly-Clark Corp.*, 647 F.3d 723, 727 (7th Cir. 2011) (*quoting Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 172 (7th Cir. 1996)). Here, MHI’s purported registration is invalid because there is no evidence that MHI used its claimed mark in commerce, and the presumption afforded by registration is of no effect.

The Seventh Circuit reached just such a result in *Central Manufacturing, Inc. v. Brett*, 492 F.3d 876 (7th Cir. 2007). There, plaintiff Central registered the word “Stealth” as a trademark for various sporting goods including baseballs in 1985, and thereafter defendant began selling a “Stealth” baseball bat. *Id.* at 879-880. Central sued for trademark infringement and unfair competition, as part of what the Seventh Circuit noted as a business strategy:

Acting as a sort of intellectual property entrepreneur, [plaintiff] has federally registered scores of trademarks with the U.S. PTO..., many containing everyday words that regularly pop up in commercial enterprise. When other companies or individuals inevitably make use of these words, [plaintiff] issues cease-and-desist letters in the hopes that the user will blanch at the prospect of litigation and either agree to pay him a “licensing fee” or yield to his claims of ownership and stop using the alleged mark altogether.

*Id.* at 880. This strategy foundered on the absence of any use of the claimed mark in commerce. Central did not produce any records of actual sales of baseballs bearing the “Stealth” mark, instead relying on price lists and conclusory spreadsheets showing alleged sales by year without any specifics about customers or products sold. *Id.* at 882. The Seventh Circuit noted that it was not even a close question: “It is unfathomable that a company claiming to have engaged in thousands of dollars of sales of a product for more than a decade would be unable to produce even a single purchase order or invoice as proof.” *Id.* at 883. It therefore concluded, “By exposing Central’s failure to make bona fide use of the ‘Stealth’ mark for baseballs, [defendant] met its burden to overcome the presumption afforded by the 1985 registration, and summary judgment in its favor was the appropriate course.” *Id.* That is precisely the situation here and the same result—summary judgment—is as appropriate. *See also Custom Vehicles, Inc.*, 476 F.3d at 485-86 (affirming summary judgment on infringement claim when the plaintiff only sold one good not using the mark, because it was not a bona fide use of a mark in the ordinary course of trade).

Like the unsuccessful plaintiff in *Central Manufacturing*, MHI registered a trademark in the commonly used words “My Health” for use in healthcare-related fields and has relied on that registration in pursuing a claim against GE, despite never having actually sold any goods or services using the mark. MHI’s failure to produce any documentation showing bona fide sales of any goods or services using the purported mark is more than sufficient to overcome the presumption of validity afforded by MHI’s registration.

**D. MHI’s Failure To Use The Mark Warrants Summary Judgment On All Of Its Lanham Act Claims.**

Because MHI’s failure to use renders its registration “void ab initio,” *Aycock Engineering, Inc.*, 560 F.3d at 1357, it cannot maintain a claim under § 32 of the Lanham Act, 15 U.S.C. § 1114, for infringement of a registered mark. The same absence of use in commerce is equally fatal to MHI’s claim under Lanham Act § 43(a), 15 U.S.C. § 1125(a).

The provisions of § 43(a) create a remedy for infringement of unregistered trademarks, but “general confusion ‘in the air’ is not actionable. Rather, only confusion about ‘origin, sponsorship, or approval of ... goods’ supports” such a claim. *Fortres Grand Corp. v. Warner Bros. Entertainment, Inc.*, 763 F.3d 696, 701 (7th Cir. 2014). Here, all of MHI’s allegations rest on GE’s use of the term “myHealth” and the claim that such use “confuse[d] consumers into thinking that [MHI] is the source of the goods.” (Compl. ¶ 37, Dkt. 1.)

On such a claim, “the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). In particular, the plaintiff must establish “that it has a protectible trademark,” *Int’l Kennel Club, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1084 (7th Cir. 1988), and protectible trademark rights can be obtained under the common law only by use of the mark in commerce:

At common law, “use” meant sales to the public of a product with the mark attached.... “Use” is neither a glitch in the Lanham Act nor a historical relic.... Under the common law, one must win the race to the marketplace to establish the exclusive right to a mark.

*Zazu Designs*, 979 F.2d at 503 (citations omitted). Thus, a § 43(a) plaintiff must demonstrate that, “through its use in commerce, the plaintiff had won the race to the marketplace such that it owns the exclusive right to use a particular mark.” *Keane v. Fox TV Stations, Inc.*, 297 F. Supp. 2d 921, 935 (S.D. Tex. 2004) (citing numerous cases). *See also Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir. 1998) (“[W]hether alleging infringement of a registered trademark, pursuant to 15 U.S.C. § 1114(1), or infringement of an unregistered trademark, pursuant to 15 U.S.C. § 1125(a)(1), it is clear that a plaintiff must show that it has actually used the designation at issue *as a trademark*”) (emphasis in original). Because it cannot prove use of the MY HEALTH mark in commerce, MHI’s claim for trademark infringement is no more viable under § 43(a) than it is under § 32.

**E. MHI’s Failure To Use The Mark Warrants Cancellation Of Its Registration.**

Section 37 of the Lanham Act, 15 U.S.C. § 1119, provides that in “any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action.” This statute “arms the court with the power to update the federal trademark register to account for a mark’s actual legal status (or lack thereof) after it has been adjudicated.” *Central Mfg.*, 492 F.3d at 883. This power is concurrent with that of the USPTO. *See* 5 J.T. McCarthy, *Trademarks and Unfair Competition* § 30:109 (4th ed. rel. 76 12/2015) (citing cases) (hereafter “McCarthy”).

GE has counterclaimed for cancellation of MHI’s registration, including on the grounds that MHI has not in fact used the registered mark in commerce. (Dkt. 41 at 20-21, ¶¶ 13-16.)

Because nonuse renders MHI's registration "void ab initio," cancellation is appropriate. *Aycock Engineering*, 560 F.3d at 1357 (affirming cancellation of registration issued 35 years earlier based on failure to use in commerce). As the Seventh Circuit instructed in *Central Manufacturing*, "Where, as here, a registrant's asserted rights to a mark are shown to be invalid, cancellation is not merely appropriate, it is the best course." 492 F.3d at 883.

## **II. MHI'S LANHAM ACT CLAIMS ALSO FAIL BECAUSE GE'S USE WAS PRIOR.**

Even if MHI had any valid and enforceable trademark rights, and even if GE's myHealth employee website could be considered an infringing use in commerce,<sup>1</sup> MHI's claims still fail as a matter of law because GE's purportedly infringing use predates the earliest possible priority of any of MHI's claimed rights.

The "basic rule of trademark ownership in the United States is priority of use." 2 McCarthy § 16:1. *See Johnny Blastoff, Inc. v. Los Angeles Rams Football Co.*, 188 F.3d 427, 434 (7th Cir. 1999) ("The party who first appropriates the mark through use, and for whom the mark serves as a designation of source, acquires superior rights to it."). As this Court has already recognized in this case (Dkt. 40 at 6), priority of use governs regardless of whether the second comer may have been the first to obtain a federal registration, because registration does not confer a right against a person whose use of the mark commenced "prior to such filing." Lanham Act § 7(c), 15 U.S.C. § 1057(c). Incontestable status, even if MHI's registration were entitled to it, likewise has no effect on a right "acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration..." Lanham Act § 15, 15 U.S.C. § 1065.

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<sup>1</sup> GE concedes neither of these propositions, but assumes them solely for purposes of this alternative argument.



As the Seventh Circuit has made clear, “a trademark application is always subject to previously established common law trademark rights of another party.” *Johnny Blastoff*, 188 F.3d at 435. *See also Wrist-Rocket Mfg. Co., Inc. v. Saunders Archery Co.*, 578 F.2d 727, 731 (8th Cir. 1978) (“The plain meaning of this language [of § 15] is that if a party has acquired common-law trademark rights continuing since before the publication of the federal registration, then to that extent the registration will not be incontestable.”); *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 979 (9th Cir. 2006) (“Neither the registration nor the incontestable status of the [plaintiff’s] mark” affects defendant’s rights in a mark “acquired through use in the marketplace” prior to the registration); 5 McCarthy § 26:53 at pp. 26-96 and 26-97 (§ 15 “preserves the common law rights of the senior user,” citing numerous cases). If the “senior common law user has already established trademark rights throughout the United States, then the owner of the federal incontestable registration has no rights and the registration is ineffectual.” *Id.* at p. 26-98, *citing Watec Co., Ltd. v. Liu*, 403 F.3d 645 (9th Cir. 2005).

GE launched its “myHealth” website in November 2005, two and a half years before MHI applied for the registration upon which it now relies to claim that GE’s use is infringing. (PFF ¶¶ 11, 24.) Continuously from the 2005 launch to at least March 2011, the GE site displayed the term “myHealth” in conjunction with information relevant to maintaining and improving the health of GE employees, retirees, and their dependents. (PFF ¶¶ 12-18.) Although the specific content of the site changed during that time period, the type of information provided and the manner in which the term “myHealth” was displayed and used did not change in any material way. (PFF ¶¶ 18-19.)

This is clear not only from the declaration of an employee at GE who had responsibility for the site for that entire time period (Declaration of Kelly Conroy ¶¶ 15-17), but also from the

authenticated screen shots throughout that time period captured independently by the Internet Archive. (Affidavit of Christopher Butler Ex. A.) Those images demonstrate that the display of the “myHealth” term, including in the specific statements that are called out in the Complaint as allegedly infringing and likely to confuse or mislead (Compl. ¶¶ 23, 37, Dkt. 1), was consistent and continuous until well after the issuance of MHI’s registration in 2009. (Affidavit of Christopher Butler Ex. A.)

To whatever extent MHI might otherwise be able to demonstrate that it had valid trademark rights and that GE’s use was in the nature of an infringing use, GE’s use was nonetheless prior and continuous, precluding any possible liability as a matter of law.

### **III. MHI’S STATE LAW CLAIMS FAIL AS A MATTER OF LAW.**

MHI also brought state law claims for violation of Wisconsin’s trademark infringement statute (Claim III), for common law trademark infringement (Claim IV), and for common law unfair competition (Claim V). Each is fatally defective.

Claim III cannot succeed because Wisconsin’s trademark infringement statute only applies to trademarks that are registered with the Wisconsin Department of Financial Institutions (“WDFI”) under Wis. Stat. § 132.01. *See* Wis. Stat. §§ 132.001(2) (defining “Mark” to include only trademarks registered with the WDFI pursuant to § 132.01); 132.033(1) (prohibiting infringement of a “Mark”). MHI has not provided any proof of registration, and the WDFI’s records do not show any registered mark for the words “My Health.” (PFF ¶¶ 57-59.)

The Count IV claim for common law trademark infringement requires the same elements of use in commerce and priority of use as are discussed above with respect to the Lanham Act claims. *See supra* at pp. 14, 16; *First Wis. Nat’l Bank v. Wichman*, 85 Wis. 2d 54, 60, 270 N.W.2d 168 (1978) (“Common law rights in a trademark or tradename are created and preserved by use and not by registration.”); *Third Educ. Grp., Inc. v. Phelps*, No. 07-C-1094, 2009

WL2150686 at \*4, \*7 (E.D. Wis. May 15, 2009) (holding federal registration invalid for “failure to use the mark prior to the registration,” and concluding that, “[f]or the same reasons,” registrant’s “common law trademark and unfair competition claims must fail”).

Finally, the attempt in Count V to invoke Wisconsin unfair competition law provides no different basis for recovery; rather, “[c]ommon law trademark infringement is a branch of the law of unfair competition, and the principles used in both actions are substantially similar.” *First Wis. Nat’l Bank*, 85 Wis. 2d at 60; *see also Mid-West Mgmt, Inc. v. Capstar Radio Oper. Co.*, 2004 WL 2535404 at \*3 (W.D. Wis. Oct. 21, 2004) (“The same standards that govern plaintiff’s Lanham Act claims govern plaintiff’s state trademark and unfair competition claims”).

### **CONCLUSION**

MHI apparently has chosen to substitute litigation for engaging in actual business, and it is time for that effort to be brought to a complete and swift end. GE respectfully requests that this Court grant its motion for summary judgment, dismiss each of MHI’s claims with prejudice, and cancel MHI’s federal trademark registration.

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von BRIESEN & ROPER, S.C.

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