

TTAB

308/00266-1

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



CAREFIRST OF MARYLAND, INC.,)
d/b/a CAREFIRST BLUE CROSS)
BLUE SHIELD,)
OPPOSER,)
v.)
CARE ONE MEDICAL CLINIC, P.C.,)
APPLICANT.)



12-05-2001

U.S. Patent & TMO/TM Mail Rpt Dt. #67

OPPOSITION NO. _____

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NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 78/035,171 covering the mark "CARE ONE MEDICAL CLINIC, P.C." as filed on November 14, 2000 in accordance with Section 1(a), (Int. Class 42) by Care One Medical Clinic, P.C., a corporation organized under the laws of the state of North Carolina, having a principal place of business at 470 Jake Alexander Boulevard West, Salisbury, North Carolina 28147-1365, published in the Trademark Official Gazette on September 18, 2001, time being extended, Opposer, Carefirst of Maryland, Inc. d/b/a Carefirst Blue Cross Blue Shield, a corporation organized under the laws of the state of Maryland, having a principal place of business at 10455 Mill Run Circle, Owings Mills, Maryland 21117, believes that it would be damaged by the registration of Application Serial No. 78/035,171, and hereby opposes the registration of the mark "CARE ONE MEDICAL CLINIC, P.C." The grounds for opposition, on information and belief, are as follows:
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1. Prior to October 24, 2000, Applicant's alleged date of first use, Opposer through its predecessors has continuously used in interstate commerce the "CAREFIRST" mark and name. Opposer is

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presently using in interstate commerce the "CAREFIRST" mark and name and the "CAREFIRST OF MARYLAND" mark and name in connection with a variety of different products and services, all related to the delivery of managed medical care to its members. Such products and services include, but are not limited to, insurance administration and health insurance underwriting services, healthcare services in the nature of health maintenance organizations and/or preferred provider organizations, newsletters, educational services and services for and on behalf of its members. Said mark also is used by members of Opposer's various plans to indicate membership in an organization or organizations interested in health maintenance, prepaid medical plans, and the like.

2. Since prior to October 24, 2000, Applicant's alleged date of first use, Opposer through its predecessor used the "CAREFIRST" mark and name and, has continuously used the "CAREFIRST" mark and name in connection with the services and products described in paragraph 1, has offered such services and products to its members, is presently using "CAREFIRST" as a service mark in connection with the rendering of said services, as a trademark in connection with the dissemination of said products, as a collective membership mark in connection with services rendered for and on behalf of its members, and is using "CAREFIRST" as a trade name.

3. Opposer relies upon and is the owner of the following registrations which are valid, subsisting, unrevoked, and incontestable:

- (a) Registration No. 1,543,100
"CAREFIRST"
Dated: June 6, 1989

(b) Registration No. 1,546,326
"CAREFIRST"
Dated: July 4, 1989

Certified status and title copies of the registrations will be presented at a later date.

4. The services of Applicant, namely, health care services, especially rehabilitation, diagnostic testing, and primary care health care in International Class 42, are closely related, if not identical, to the various services, products, and membership activities offered by Opposer and as described in paragraph 1 herein. Many of the services and products offered and sold by Opposer under its "CAREFIRST" mark and name are likely to be purchased and used by the same class of purchasers who are likely to purchase and use Applicant's services. In addition, many of the services and products of Opposer and Applicant are marketed through the same and related channels of trade.

5. Applicant's mark "CARE ONE MEDICAL CLINIC, P.C." is so confusingly similar in meaning and commercial impression to Opposer's "CAREFIRST" mark and name, which the public and trade have associated and recognize with Opposer, as to be likely, when applied to the services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the services and products of Applicant emanate from, or are disseminated under Opposer's approval, sponsorship, or control, all to the great damage of Opposer.

6. On information and belief, Applicant has made no use of its alleged mark "CARE ONE MEDICAL CLINIC, P.C." in the United States for health care services prior to October 24, 2000, its

alleged date of first use, which is a date subsequent to the date of first use for Opposer's "CAREFIRST" and mark and name.

7. On information and belief, Applicant has made no use of its alleged mark "CARE ONE MEDICAL CLINIC, P.C." in the United States for any product or service prior to October 24, 2000, its date of first use, which is a date subsequent to the date of first use for Opposer's "CAREFIRST" mark and name.

8. In view of the similarity between Applicant's mark "CARE ONE MEDICAL CLINIC, P.C." and Opposer's "CAREFIRST" mark and name, and in view of the related or identical nature of the services and products offered and disseminated by both Applicant and Opposer and the activities of Opposer's members, it is alleged that Applicant's mark consists of and comprises matter which may disparage and falsely suggest a trade connection between Opposer and Applicant.

9. Opposer has expended considerable time, effort and money in advertising and otherwise promoting its products, services and membership activities, and in encouraging the public and trade to recognize its "CAREFIRST" mark and name, that unless refused, the registration obtained by Applicant will enable Applicant to reap the benefits of such goodwill attached to Opposer's marks, and Opposer will suffer irreparable damage and injury as a result of the confusion that is likely to arise from its inability to control its reputation.

10. Furthermore, any defect, objection, or fault found with Applicant's services provided under Applicant's "CARE ONE MEDICAL CLINIC, P.C." mark would necessarily reflect on and seriously injure the reputation that Opposer has established and currently enjoys under the "CAREFIRST" mark and name.

11. If the Applicant is able to register the mark "CARE ONE MEDICAL CLINIC, P.C." for the services set forth in the application, confusion of the trade and public is likely to result, and such confusion will result in damage and injury to Opposer.

12. If Applicant is granted a registration for the mark herein, it will obtain at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and its members.

13. Since long before the use of "CARE ONE MEDICAL CLINIC, P.C." by Applicant, Opposer, through its predecessors has continuously and in good faith used the "CAREFIRST" mark and name as described in paragraphs 1 and 2. As a consequence of the use of the "CAREFIRST" mark and name, Opposer's "CAREFIRST" mark and name has become distinctive in the minds of the trade, business community, and the public of the quality of goods, services, and membership rights offered by Opposer. Accordingly, Opposer's "CAREFIRST" mark and name have become famous.

14. Opposer's "CAREFIRST" mark and name became famous at some time prior to the use of the "CARE ONE MEDICAL CLINIC, P.C." mark and name by Applicant. Such fame is evidenced, in part, by the Consumer's Union's, publisher of Consumer Reports, independent study which recognized Opposer in their October 2001 report as the best overall rated health insurer in the United States in terms of its health maintenance and preferred provider related services.

15. Applicant's subsequent, willful, and deliberate adoption, use, and registration of the "CARE ONE MEDICAL CLINIC, P.C." mark and name in connection with the services described in its application would dilute the distinctive quality of the "CAREFIRST" mark and name, and is likely to cause injury to the business

reputation of Opposer since Opposer has no control over the nature and quality of the services being offered by Applicant in connection with its confusingly similar mark.

16. Registration of the mark "CARE ONE MEDICAL CLINIC, P.C." would dilute the distinctive quality of the "CAREFIRST" mark and name, as well as the "CAREFIRST OF MARYLAND" mark and name, and is likely to cause injury to the business reputation of Opposer since individual members of Opposer's organizations may erroneously believe that Applicant is in some way associated with Opposer and believe that Applicant is in some way obligated to that member for medical care, all to Opposer's injury and detriment.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant be refused and this opposition be sustained. The \$300.00 government fee (one class) is simultaneously being submitted herewith.

Please recognize Barth X. deRosa, James E. Ledbetter, Thomas P. Pavelko, Anthony P. Venturino, all members of a Bar, and the firm of Stevens, Davis, Miller & Mosher, LLP, 1615 L Street, NW, Suite 850, Washington, DC 20036, as attorneys for Opposer.

Respectfully submitted,

CAREFIRST OF MARYLAND, INC. d/b/a
CAREFIRST BLUE CROSS BLUE SHIELD

BY: _____

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