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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.

3C INCORPORATED

APPLICANT.

OPPOSITION NO. \_\_\_\_\_

[ U.S. Appl. Serial No. 78/148,698 ]

08-11-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 78/148,698 covering the mark "CAREONE" filed on July 31, 2002 in accordance with Section 1(b), (Int. Classes 36 and 41) by 3C Incorporated, a corporation organized under the laws of the state of Maryland, having a principal place of business at 8930 Stanford Boulevard, Columbia, Maryland 21045, published in the Trademark Official Gazette on April 1, 2003, 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. 78/148,698, and hereby opposes the registration of the mark "CAREONE."

The grounds for opposition against U.S. Trademark Application Serial No. 78/148,698 under Sections 2(d) and 2(a) are as follows:

1. Prior to July 30, 2002, Applicant's constructive use date, Opposer, through its predecessors, has continuously used in commerce the "CAREFIRST" mark and name and the "CAREFIRST OF MARYLAND" mark and name. Opposer is 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 as described and stated in the registrations pleaded herein. Such products, services, and membership indicia 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, third party insurance claims administration, newsletters, educational services and services for and on behalf of its members. Said marks and names also are 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 July 30, 2002, Applicant's constructive use date, Opposer, through its predecessor, used the "CAREFIRST" mark and name and has continuously used the "CAREFIRST" mark and name in connection with the services, products and membership indicia 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 OF MARYLAND" as a trade and corporate 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 submitted at a later date.

4. On information and belief, the services of Applicant, namely, financial services, namely, fiscal assessment; consultation services in the field of consumer credit and debt; debt and credit counseling; negotiating debt repayment on behalf of debtors; and debt repayment and collection agency services and educational services, namely, providing courses and seminars in the field of consumer credit and debt management are closely related if not identical to the various services, products, and membership activities offered by Opposer and as described

in paragraph 1 herein.

5. On information and belief, each month Applicant sends more than 1.2 million client payments, worth more than \$75 million, to creditors.
6. On information and belief, many of the individuals who utilize Applicant's debt consolidation and counseling services do so in order to consolidate their extraordinary medical bills. As part of Applicant's services Applicant contacts its client's creditors and negotiates debt repayment with medical providers on behalf of the individuals who enroll in Applicant's debt consolidation plan. Many of these medical providers are the same medical providers that are associated with Opposer either as preferred providers or as part of Opposer's health maintenance organizations.
7. On information and belief, under Applicant's debt consolidation plan, Applicant deals directly with medical providers that have provided services to Applicant's enrollees and actually pays off the individual's debts directly to those medical providers. Opposer as part of its claims administration services for its members also deals directly with medical providers and also pays off claims directly to the same medical providers.
8. On information and belief, under Applicant's debt consolidation plan, these medical providers often deal solely with Applicant rather than the debtor to obtain repayment for medical services. Likewise, under Opposer's claims administration program, these medical providers often deal solely with Opposer rather than the patient to obtain repayment for medical services. As a result, both parties contact the same accounts receivable personnel within the medical services industry to negotiate and pay debts for their respective members.
9. On information and belief, many of the services and products of Opposer and Applicant are marketed through the same and related channels of trade.
10. On information and belief, many of the services, products and membership indicia which are offered, sold and provided by Opposer under its "CAREFIRST" mark and name and its "CAREFIRST OF MARYLAND" 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 and products.

11. Applicant's mark "CAREONE" is so confusingly similar in appearance, sound, meaning, and commercial impression to Opposer's "CAREFIRST" and "CAREFIRST OF MARYLAND" marks and names, which the public, the trade, and the medical services industry have associated and recognize with Opposer, as to be likely, when applied to the services of Applicant, to cause confusion or to deceive purchasers and the industry 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.
12. On information and belief, Applicant has made no use of its alleged mark "CAREONE" in the United States for any product or service prior to July 30, 2002, its earliest constructive use date, which is a date subsequent to the date of first use for Opposer's "CAREFIRST" mark and name and its "CAREFIRST OF MARYLAND" mark and name.
13. In view of the similarity between Applicant's mark "CAREONE" and Opposer's "CAREFIRST" and "CAREFIRST OF MARYLAND" marks and names, 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.
14. The "CAREONE" mark is a close approximation of the "CAREFIRST" and "CAREFIRST OF MARYLAND" marks, names, and identity previously used by Opposer and Opposer's marks and name would be recognized as such by the public, the trade, and the industry.
15. The "CAREFIRST" mark, name and identity points uniquely and unmistakably to Opposer.
16. Opposer is not connected with the activities performed by Applicant under the "CAREONE" mark.
17. The "CAREFIRST" mark, name and identity is of sufficient fame or reputation that a connection with Opposer would be presumed when Applicant's mark is used on Applicant's goods or services.

18. Opposer has expended considerable time, effort and money in advertising and in otherwise promoting its products, services and membership activities, and in encouraging the public and trade to recognize its "CAREFIRST" and "CAREFIRST OF MARYLAND" marks and names, that unless refused, the registration obtained by Applicant will enable Applicant to reap the benefits of such goodwill attached to Opposer's marks and identity, 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 and identity and/or create a false suggestion or connection with Opposer.
19. Furthermore, any defect, objection, or fault found with Applicant's goods and services provided under Applicant's "CAREONE" mark would necessarily reflect on and seriously injure the reputation that Opposer has established and currently enjoys under the "CAREFIRST" and "CAREFIRST OF MARYLAND" marks and names and would disparage Opposer's identity.
20. If the Applicant is able to register its mark "CAREONE" for the services set forth in the application, confusion of the public, trade and medical services industry is likely to result, and such confusion will result in damage and injury to Opposer and to Opposer's identity.
21. 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.
22. Applicant's subsequent, willful, and deliberate adoption, use, and registration of the "CAREONE" mark and name in the same industry and region, and in connection with the services described in its application, may disparage and falsely suggest a trade connection between Opposer and Applicant 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, products and membership indicia being offered by Applicant in connection with its confusingly similar mark.

23. Applicant's registration of the mark "CAREONE" 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 related services, including claims administration and reimbursement, all to Opposer's injury and detriment, and to the injury and detriment of the "CAREFIRST" mark and name.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant in U.S. Appln. Serial Nos. 78/148,698 be refused and this opposition be sustained. The government filing fees of \$600.00 for two classes are attached.

Please recognize Barth X. deRosa, James E. Ledbetter, Thomas P. Pavelko, Anthony P. Venturino and Peter N. Lalos, 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



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