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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.

PRINCETON BIOMEDITECH CORPORATION,

APPLICANT.

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

[U.S. Appl. Serial No. 78/301,591]

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 78/301,591 covering the mark "FIRSTCARE" filed on September 17, 2003, under Section 1(b), by Princeton Biomeditech Corporation, a corporation organized under the laws of New Jersey, having a principal place of business at 4242 U.S. Route 1, Monmouth Junction, New Jersey 08852, published in the Trademark Official Gazette on March 29, 2005, 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. 78/301,591, and hereby opposes the registration of the mark "FIRSTCARE."

The grounds for opposition against the application and under Sections 2(d), 2(a), and 43(c), on information and belief, are as follows:

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1. Prior to September 17, 2003, Applicant's constructive use date, Opposer, through its predecessors, has continuously used in commerce the "CAREFIRST" mark and name. Opposer is presently using in interstate commerce the "CAREFIRST" 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 that include a variety of riders for vision, mental health, prescription drugs, dental care and the like, as well as 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 mark and name 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 September 17, 2003, 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" as a trade and corporate name.

3. In addition to its longstanding use of the "CAREFIRST" mark and name, Opposer has also used and licensed others to use the "FIRSTCARE" mark and name long prior to Applicant's constructive use date of September 17, 2003. Said mark and name has been used in connection with emergency medical centers and clinics by a licensee, has been used in connection with the offering of insurance services and a HMO and/or PPO related services by a wholly owned subsidiary, and during the next year, Opposer plans to resume use of the "FIRSTCARE" name in connection with the administration of pharmaceutical care, related healthcare services and in connection with organizational services.

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

- (a) Registration No. 1,543,100  
"CAREFIRST"  
Dated: June 6, 1989  
INCONTESTABLE
- (b) Registration No. 1,546,326  
"CAREFIRST"  
Dated: July 4, 1989  
INCONTESTABLE
- (c) Registration No. 2,360,421  
"FIRSTCARE"  
Dated: June 20, 2000

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

5. On information and belief, the products of Applicant, namely, Medical Diagnostic tests comprised primarily of cardiac markers and diagnostic reagents for use in connection with rapid immunoassay testing in the fields of abused drugs, cancer diagnosis, cardiac disorders,

chemical disorders, coagulation, endocrinological disorders, fertility, infectious disease, hematology, immunological disorders, and physiological and neurological disorders are closely related to the various services, products, and membership activities offered by Opposer and as described in paragraphs 1-3 herein. Many of the services and products offered and sold by Opposer under its "CAREFIRST" mark and name, and those services planned for resumption of its "FIRSTCARE" name, are likely to be purchased and used by the same class of purchasers who are likely to purchase Applicant's products and services. In addition, many of the services and products of Opposer and Applicant are apt to be marketed through the same and related channels of trade.

6. Applicant's mark "FIRSTCARE" is so confusingly similar in appearance, sound, meaning, and commercial impression to Opposer's "CAREFIRST" mark and name, which the public and trade have long associated and recognize with Opposer, as to be likely, when applied to the products and services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the products and services of Applicant emanate from, or are disseminated under Opposer's approval, sponsorship, or control, all to the great damage of Opposer.
7. Similarly, Applicant's mark "FIRSTCARE" is otherwise identical to Opposer's past use and planned use for "FIRSTCARE," which the public and trade have associated and recognized with Opposer, as to be likely, when applied to the products of Applicant, to cause confusion and to deceive purchasers in the mistaken belief that the products of Applicant emanate from or are disseminated under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

8. On information and belief, Applicant has made no use of its alleged mark "FIRSTCARE" in the United States for any product or service prior to its constructive use date of September 17, 2003, and/or prior to the filing date of this notice of opposition, which dates are subsequent to the date of first use for Opposer's "CAREFIRST" mark and name and its "FIRSTCARE" mark and name, and the date Opposer's federal registrations issued.
9. In view of the similarity between Applicant's mark "FIRSTCARE" and Opposer's "CAREFIRST" and "FIRSTCARE" marks and names, and in view of the related 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.
10. The "FIRSTCARE" mark is a close approximation of the "CAREFIRST" mark, name, and identity previously used by Opposer.
11. The CAREFIRST mark, name, and identity points uniquely and unmistakably to Opposer.
12. Opposer is not nor will be connected with the activities performed by Applicant under the "FIRSTCARE" mark.
13. 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 in connection with its products and, if applicable, services.
14. 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 mark, 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.

15. Furthermore, any defect, objection, or fault found with Applicant's products and services provided under Applicant's "FIRSTCARE" mark would necessarily reflect on and seriously injure the reputation that Opposer has established and currently enjoys under the "CAREFIRST" mark and name.
16. If the Applicant is able to register its mark "FIRSTCARE" for the products 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.
17. 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.
18. Since long before the Applicant's constructive used date for "FIRSTCARE," Opposer has, through its predecessors, 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 and famous in the minds of the trade, business community, and the public of the quality of goods, services, and membership benefits offered by Opposer. Accordingly, Opposer's "CAREFIRST" mark and name has achieved general fame, if not at least niche market fame in the health care industry. Such general and niche market fame is evidenced, in part, by the continuous use of the "CAREFIRST" mark and name for 28 years, 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 preferred provider related services, by over one thousand six hundred unsolicited news articles about Opposer, by millions of dollars expended in the promotion and advertisement of the "CAREFIRST" mark and name since 1996, by over 3.3 million persons who have joined Carefirst as members, by numerous awards and honors granted Carefirst within the industry, and by such other factors indicative of fame and distinctiveness.

19. Opposer's "CAREFIRST" mark and name achieved general fame, if not niche market fame, at some time prior to the constructive use date claimed by Applicant and, if applicable, any use in commerce for the "FIRSTCARE" mark and name by Applicant.
20. Applicant's use and/or *bona fide* intent to use the "FIRSTCARE" mark is commercial, in commerce, and within the same industry.
21. Applicant's subsequent, willful, and deliberate adoption, *bona fide* intent to use, and registration of the "FIRSTCARE" mark and name in the same general industry and in connection with the products and services described in its application, would dilute the distinctive quality of the "CAREFIRST" mark and name by blurring, and is likely to cause injury to the business reputation of Opposer since Opposer has no control over the nature and quality of the products being offered by Applicant in connection with its confusingly similar and dilutive mark.
22. Registration of the mark "FIRSTCARE" would dilute the distinctive quality of the "CAREFIRST" mark and name, and is likely to cause injury to the business reputation of Opposer since potential purchasers may erroneously believe that Applicant is in some way

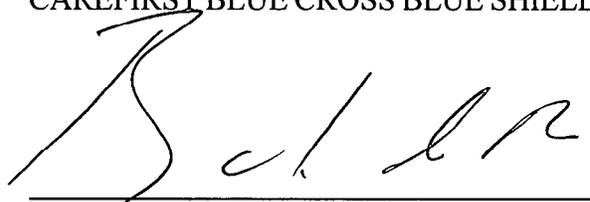
associated with, affiliated with or sponsored by Opposer, all to Opposer's injury and detriment, and to the injury and detriment of the "CAREFIRST" mark and name.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant in U.S. Appln. Serial No. 78/301,591 be refused and this opposition be sustained. The government filing in the amount of \$300.00, for one class, is attached hereto.

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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