

ESTTA Tracking number: **ESTTA434792**

Filing date: **10/10/2011**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Blue Cross and Blue Shield Association
Granted to Date of previous extension	10/09/2011
Address	225 North Michigan Avenue Chicago, IL 60601 UNITED STATES

Attorney information	Susan G. O'Neill Hanson Bridgett LLP 425 Market Street San Francisco, CA 94105 UNITED STATES ttabfilings@hansonbridgett.com, soneill@hansonbridgett.com, gweng@hansonbridgett.com
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Applicant Information

Application No	85002922	Publication date	04/12/2011
Opposition Filing Date	10/10/2011	Opposition Period Ends	10/09/2011
Applicant	Dallas Neurosurgical & Spine Associates, P.A. Suite 220 8230 Walnut Hill Lane Dallas, TX 75231 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. All goods and services in the class are opposed, namely: Medical services in the field of neurosurgery
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	554488	Application Date	09/30/1947
Registration Date	02/05/1952	Foreign Priority Date	NONE
Word Mark	BLUE-CROSS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 DISTRIBUTION OF HOSPITAL CARE ON A PRE-PAYMENT FINANCING BASIS

U.S. Registration No.	554817	Application Date	08/19/1947
Registration Date	02/12/1952	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class U102 (International Class 036). First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 DISTRIBUTION OF HOSPITAL CARE ON A PRE-PAYMENT FINANCING BASIS
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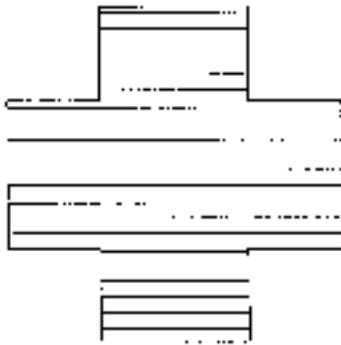
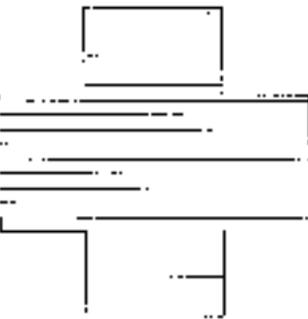
U.S. Registration No.	1632320	Application Date	02/26/1990
Registration Date	01/22/1991	Foreign Priority Date	NONE

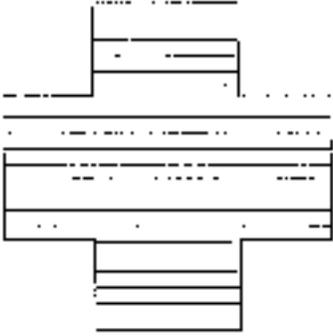
Word Mark	NONE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 016. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 EDUCATIONAL BOOKS, BINDERS, PRINTED FORMS, BUSINESS FORMS, HEALTHCARE TRADE JOURNALS, NOTEBOOKS, WRITING PAPER,
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	ENVELOPES, PEN AND PENCILS		
U.S. Registration No.	1639079	Application Date	05/04/1990
Registration Date	03/26/1991	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 healthcare newsletter		
U.S. Registration No.	1699627	Application Date	07/22/1991
Registration Date	07/07/1992	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1988/06/28 First Use In Commerce: 1988/06/28 health care services rendered through a health maintenance organization; namely, physician services, dental services, hospital services, home health care services, preventative health care services, health care services, medical lab services, counselling services in the field of family planning, mental health services and pharmacy services		
U.S. Registration No.	1826582	Application Date	04/16/1990
Registration Date	03/15/1994	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 prepaid financing, and administration thereof, of dental, hospital and related health care services

U.S. Registration No.	3092706	Application Date	03/31/2005
Registration Date	05/16/2006	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2005/02/01 First Use In Commerce: 2005/02/01 Offering consumer-driven health care plan, namely, underwriting, administration, financing, and maintenance of consumer-driven health care plans and defined contribution health care plans; debit card services, check cashing and check issuance, electronic debit transactions and electronic check processing transactions and providing financial information by electronic means via a global computer network, all of which are provided in connection with health care coverage plans

U.S. Registration No.	3172396	Application Date	03/31/2005
Registration Date	11/14/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1997/04/01 First Use In Commerce: 1997/04/01 Administration, financial management and maintenance of health savings accounts, medical savings accounts, and flexible spending accounts; insurance claims administration		

U.S. Registration No.	1055560	Application Date	04/05/1976
Registration Date	01/04/1977	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1972/11/09 First Use In Commerce: 1972/11/09 BOOKLETS DEALING WITH HEALTH CARE BENEFITS		

U.S. Registration No.	1293243	Application Date	07/25/1983
Registration Date	09/04/1984	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1968/12/31 First Use In Commerce: 1968/12/31 Prepaid Financing and Administration of Dental and Related Health Care Services		

U.S. Registration No.	969385	Application Date	12/05/1972
Registration Date	09/25/1973	Foreign Priority Date	NONE

Word Mark	NONE		
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Design Mark			
Description of Mark	NONE		
Goods/Services	Class U102 (International Class 036). First use: First Use: 1972/11/09 First Use In Commerce: 1972/11/09 PREPAID FINANCING OF HOSPITAL AND HEALTH CARE SERVICES		

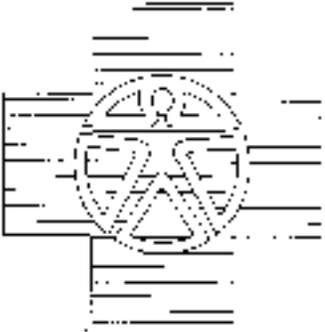
U.S. Registration No.	990414	Application Date	03/01/1973
Registration Date	08/06/1974	Foreign Priority Date	NONE

Word Mark	NONE		
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Design Mark	
Description of Mark	NONE
Goods/Services	Class U102 (International Class 036). First use: First Use: 1972/11/09 First Use In Commerce: 1972/11/09 PRE-PAID FINANCING OF HOSPITAL AND HEALTH CARE SERVICES

U.S. Registration No.	1425238	Application Date	08/29/1985
Registration Date	01/13/1987	Foreign Priority Date	NONE

Word Mark	NONE
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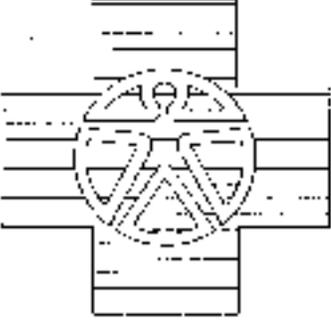
Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 042. First use: First Use: 1973/12/00 First Use In Commerce: 1973/12/00 HOME HEALTHCARE SERVICES, PREVENTIVE HEALTHCARE SERVICES, HEALTH CARE SERVICES RENDERED THROUGH A HEALTH MAINTENANCE ORGANIZATION NAMELY PHYSICIAN SERVICES, DENTAL SERVICES, HOSPITAL SERVICES, HEALTH TREATMENT AND THERAPY SERVICES, DIAGNOSTIC TESTING AND EXAMINATION SERVICES, FAMILLY PLANNING SERVICES, MENTAL HEALTH SERVICES, NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES
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U.S. Registration No.	1997328	Application Date	01/21/1994
Registration Date	08/27/1996	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 underwriting, financing, administration, and brokerage of life insurance

U.S. Registration No.	1426942	Application Date	08/29/1985
Registration Date	01/27/1987	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1973/12/00 First Use In Commerce: 1973/12/00 HOME HEALTHCARE SERVICES, PREVENTIVE HEALTHCARE SERVICES, HEALTH CARE SERVICES RENDERED THROUGH A HEALTH MAINTENANCE ORGANIZATION, NAMELY PHYSICIAN SERVICES, DENTAL SERVICES, HOSPITAL SERVICES, HEALTH TREATMENT AND THERAPY SERVICES, DIAGNOSTIC TESTING AND EXAMINATION SERVICES, FAMILY PLANNING SERVICES, MENTAL HEALTH SERVICES, NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES		

U.S. Registration No.	1632573	Application Date	04/16/1990
Registration Date	01/22/1991	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 prepaid financing and administration of medical, hospital and related health services		

U.S. Registration No.	1691498	Application Date	05/24/1991
Registration Date	06/09/1992	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 educational books, binders, trade journals, and newsletters in the field of health and insurance; printed forms, notebooks, pens and pencils

U.S. Registration No.	2027402	Application Date	01/21/1994
Registration Date	12/31/1996	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 underwriting, financing, administration, and brokerage of life insurance		

U.S. Registration No.	3085016	Application Date	03/31/2005
Registration Date	04/25/2006	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2005/02/01 First Use In Commerce: 2005/02/01 Offering consumer-driven health care plan, namely, underwriting, administration, and financing of consumer-driven health care plans and defined contribution health care plans; debit card services, check cashing and check issuance, electronic debit transactions and electronic check processing transactions and providing financial information by electronic means via a global computer network, all of which are provided in connection with health care coverage plans		

U.S. Registration No.	2150555	Application Date	02/07/1997
Registration Date	04/14/1998	Foreign Priority Date	NONE
Word Mark	BLUE CROSS AND BLUE SHIELD ASSOCIATION		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 036. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 prepaid financing and administration of medical, hospital and related health care services</p> <p>Class 042. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 comprehensive health care benefit programs, rendered through a health maintenance organization, namely, physician, dental, hospital, home health care, prevent health treatment, therapy, pharmacy and ambulatory services</p>
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U.S. Registration No.	3288738	Application Date	03/31/2005
Registration Date	09/04/2007	Foreign Priority Date	NONE

Word Mark	BLUE CROSS
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 036. First use: First Use: 2006/11/30 First Use In Commerce: 2006/11/30 Banking and financial services, namely, checking and savings account services, electronic funds transfer, cash management and disbursement services, lending services, acceptance of deposits and loan payments, check cashing and check issuance, electronic payment services, providing financial information by electronic means, providing secure financial transactions in the nature of electronic cash transactions, electronic check processing transactions, trustee services, investment security services, certificates of deposits, asset management services, stored-value card services, smart card services, credit card services, all of which are provided in connection with health care coverage plans</p>
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U.S. Registration No.	3288740	Application Date	03/31/2005
Registration Date	09/04/2007	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2006/11/30 First Use In Commerce: 2006/11/30 Banking and financial services, namely, checking and savings account services, electronic funds transfer, cash management and disbursement services, lending services, acceptance of deposits and loan payments, check cashing and check issuance, electronic payment services, providing financial information by electronic means, providing secure financial transactions in the nature of electronic cash transactions, electronic check processing transactions, trustee services, investment security services, certificates of deposits, asset management services, stored-value card services, smart card services, credit card services, all of which are provided in connection with health care coverage plans

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	A family of BLUE CROSS word and design marks (registered and common-law) as further described in the Notice of Opposition.		
Goods/Services	A range of goods and services relating to insurance, health care plans, and health care as further described in the Notice of Opposition.		

Attachments	71531753#TMSN.gif (1 page)(bytes) 74032415#TMSN.gif (1 page)(bytes) 74055846#TMSN.gif (1 page)(bytes) 74187033#TMSN.gif (1 page)(bytes) 74049148#TMSN.gif (1 page)(bytes) 78598842#TMSN.jpeg (1 page)(bytes) 78598844#TMSN.jpeg (1 page)(bytes) 73082826#TMSN.gif (1 page)(bytes) 73436072#TMSN.gif (1 page)(bytes) 72442919#TMSN.gif (1 page)(bytes) 72450146#TMSN.gif (1 page)(bytes) 73555889#TMSN.gif (1 page)(bytes) 74480773#TMSN.gif (1 page)(bytes) 78598832#TMSN.jpeg (1 page)(bytes) 78598836#TMSN.jpeg (1 page)(bytes) 78598854#TMSN.jpeg (1 page)(bytes) Ntc of Opp - Dallas Scoliosis Center.pdf (7 pages)(22074 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/susanoneill/
Name	Susan G. O'Neill
Date	10/10/2011

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

IN RE: APPLICATION SERIAL NO. 85/002,922

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

DALLAS NEUROSURGICAL & SPINE
ASSOCIATES, P.A.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer Blue Cross and Blue Shield Association, a not-for-profit membership-based corporation organized and existing under the laws of the State of Illinois, doing business at 225 North Michigan Avenue, Chicago, IL 60601-7680, brings this Opposition against Application Serial No. 85/002,922, filed by Applicant Dallas Neurosurgical & Spine Associates, P.A., having an address of 8230 Walnut Hill Lane, Suite 220, Dallas, TX 75231.

1. On information and belief, on March 31, 2010, Dallas Neurosurgical & Spine Associates, P.A. ("Applicant") filed Application Serial No. 85/002,922 (the "Application") under Section 1(b) of the Lanham Act. On information and belief, the Application was published in the U.S. Patent & Trademark Office's *Official Gazette* on April 12, 2011. The Application on its face seeks to cover: "Medical services in the field of neurosurgery," in International Class 44. The Application describes its subject mark ("Applicant's Mark") by stating: "The mark consists of a stylized cross within a square, with the term 'Dallas Scoliosis Center' to the right in stylized font and above the term 'at Dallas Neurosurgical & Spine'." The design codes assigned to Applicant's Mark note that Applicant's Mark is a "Greek cross (equal sized lines)." Additionally,

the Application states that "[c]olor is not claimed as a feature of the mark," meaning it claims the mark in all colors and the mark is presumed to be used in all colors. In sum, Applicant's Mark specifically encompasses a blue cross as a central element.

2. Opposer Blue Cross and Blue Shield Association (the "Association") is a national association of 39 independent, community-based, and locally operated BLUE CROSS® and BLUE SHIELD® companies ("Member Plans"). The Association represents the nation's oldest and largest family of health benefits companies. For over 75 years, the Association (including through its predecessors in interest and its Member Plans and licensees) has provided millions of families with top-quality affordable health care plans. The Association's Member Plans currently provide health care plans for nearly 100 million people in the United States—or about 1 in 3 Americans—and offer health care plans in all 50 states, the District of Columbia, and in Puerto Rico. More than 90% of hospitals and 80% of physicians in the United States contract with the Association's Member Plans—more than any other insurer. The Association's Member Plans currently provide health care plans to more than half of the Fortune 500 companies and more than three-quarters of the Fortune 100 companies.

3. The BLUE CROSS and BLUE SHIELD brands are the most recognized in the health insurance industry in the United States—and among the most recognized in any industry. The Association is the owner of the BLUE CROSS design marks—as well as the BLUE CROSS word mark, the BLUE SHIELD word and design marks, and other marks consisting of the image of a blue cross or the image of a blue shield (or both)—and licenses the use of various such marks to its Member Plans and other licensees for the provision of health and life insurance, health-care delivery services, financing access to health care, and other related goods and services. The Association (including through its predecessors in interest and its Member Plans and licensees) has been using these trademarks and service marks since at least as early as 1934 (BLUE CROSS) and 1939 (BLUE SHIELD).

4. Currently, in the United States alone, the Association owns more than 230 valid and subsisting U.S. federal trademark and service mark registrations. Many of its U.S. federal registrations have become incontestable under Section 15 of the Lanham Act. Additionally, the Association owns similar trademark and service mark registrations in more than 170 countries throughout the world. All these (along with numerous trade names and common-law marks) form a “family” of BLUE trade names, trademarks, and service marks (“Blue Marks”). Under the Lanham Act, the Association’s incontestable U.S. federal registrations are conclusive evidence of the Association’s exclusive right to use or authorize the use of the Blue Marks in commerce.

5. The Association (including through its Member Plans and licensees) has extensively used, advertised, and promoted the Blue Marks throughout the United States. For instance, in 2010 alone, total system-wide gross revenue was over approximately \$360 billion. The Association (including through its Member Plans and licensees) spends millions of dollars in advertising and promoting its marks, services, products, and image, thereby creating substantial goodwill in the marketplace. As a result, the general public recognizes the Blue Marks separately and collectively as identifying the Association and its Member Plans and licensees—and the quality services they render. The Blue Marks are an asset of incalculable value to the Association; and it has vigorously and successfully protected its marks. Moreover, at least as far back as 1977, federal district courts and other legal panels such as the World Intellectual Property Organization Uniform Dispute Resolution Policy Panel have expressly recognized the fame of the Blue Marks in designating the services of the Association (and its Member Plans and licensees) in the context of trademark disputes or litigation.

6. Among the Blue Marks are a wide range of marks consisting entirely or substantially of either the words BLUE CROSS or an image of a blue cross (or both) (the “Blue Cross Marks”). Historically, and through the present, these Blue Cross Marks span a variety of differently configured crosses; and historically and through the present, the Association (including through its predecessors in interest and its Member Plans and licensees) has used

and does use the Blue Cross Marks in a wide range of blue colors, from light to dark and through a variety of hues and tones. Historically, before Applicant's adoption or use of Applicant's Mark, and through the present, the Association (including through its predecessors in interest and its Member Plans and licensees) has used and does use the Blue Cross Marks in connection with health care delivery services (including without limitation in the context of medical services), health care plans and health care plan administration, health insurance and financing access to health care, and other related goods and services. Several of the Association's U.S. federal trademark registrations for its Blue Cross Marks are identified as "Marks Cited by Opposer as Basis for Opposition" in Opposer's electronic submission of this Opposition, including without limitation Registration Nos. 554,488; 554,817; 1,425,238; 1,426,942; 1,632,573; 1,699,627; 2,150,555; 3,085,016; 3,092,706; 3,288,738; and 3,288,740.

7. Applicant's Mark is confusingly similar to one or more of the Association's Blue Cross Marks. Among other things, Applicant's Mark features a Greek cross as a central element; Applicant's Mark is presumed to be used in all colors, including blue; and the services listed in the Application are similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those services designated by the Association's Blue Cross Marks. Additionally, on information and belief, Applicant intends to use and in fact uses Applicant's Mark in various shades and tones of the color blue. In sum, Applicant's Mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant is sponsored by, endorsed by, or in some manner related to the Association (or its Member Plans or licensees).

8. On information and belief, Applicant selected its mark in the Application, began using this mark in various shades and tones of the color blue, and continues to use this mark with full knowledge of the Association's Blue Cross Marks and with the intent to confuse, cause mistake among, and deceive the public into believing that Applicant's services are of the same

high quality as or are in some way associated with the services of the Association (or its Member Plans or licensees).

9. The above-described use of Applicant's Mark is likely to impair and has impaired the distinctiveness of the Blue Marks, and in particular the Blue Cross Marks, and their ability to identify and distinguish the goods and services of the Association—and has also harmed the reputation of the Association and these marks by associating them with Applicant.

10. Likewise, registration of Applicant's Mark, as described in the Application, will injure the Association by causing the relevant public to be confused, mistaken, or deceived to the detriment of the Association, by diluting the distinctive quality of the Association's famous Blue Cross Marks, and by harming the reputation of the Association and its marks by associating them with Applicant.

11. For the reasons set forth in this Notice of Opposition, the Association believes that it will be damaged by the registration of Applicant's Mark in the Application. Accordingly, the Association requests and prays that the Application (and all parts of it) be denied registration.

12. In the alternative, should the Board find that the Application is entitled to registration in some form, under Section 18 of the Lanham Act, the Association requests that the Application be allowed registration only with the Application restricted as to color, by the addition of the following statement: "The mark is not and will not be used in the color blue (or any colorable imitation thereof)." In the second alternative, should the Board find that the Application is entitled to registration in some form, under Section 18 of the Lanham Act, the Association requests that the Application be allowed registration only with the Application restricted as to color regarding the cross portion of the mark, by the addition of the following statement: "The cross portion of the mark is not and will not be used in the color blue (or any colorable imitation thereof)."

