

ESTTA Tracking number: **ESTTA566134**

Filing date: **10/21/2013**

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	10/20/2013
Address	225 North Michigan Avenue Chicago, IL 60601 UNITED STATES

Attorney information	Garner K. Weng Hanson Bridgett LLP 425 Market Street, 26th Floor San Francisco, CA 94105 UNITED STATES ttabfilings@hansonbridgett.com, soneill@hansonbridgett.com, gweng@hansonbridgett.com, cwalters@hansonbridgett.com, jthompson@hansonbridgett.com Phone:415-995-5081
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Applicant Information

Application No	85778843	Publication date	04/23/2013
Opposition Filing Date	10/21/2013	Opposition Period Ends	10/20/2013
Applicant	Alkemi Management Company, Inc. 477 South Rosemary, Suite 202 West Palm Beach, FL 33401 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 2011/08/15 First Use In Commerce: 2011/08/15 All goods and services in the class are opposed, namely: Medical Services, namely outpatient ambulatory-care services

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		
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.	969385	Application Date	12/05/1972
Registration Date	09/25/1973	Foreign Priority Date	NONE
Word Mark	NONE		
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		
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.	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.	1425238	Application Date	08/29/1985
Registration Date	01/13/1987	Foreign Priority Date	NONE
Word Mark	NONE		
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, FAMMILY PLANNING SERVICES, MENTAL HEALTH SERVICES, NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES		

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.	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	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		

	<p>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.	3709586	Application Date	03/28/2008
Registration Date	11/10/2009	Foreign Priority Date	NONE
Word Mark	<p>BLUECROSS BLUESHIELD ASSOCIATION AN ASSOCIATION OF INDEPENDENT BLUE CROSS AND BLUE SHIELD PLANS LEADING THE FUTURE OF HEALTHCARE</p>		
Design Mark			
Description of Mark	<p>The mark consists of a cross design encasing a stylized design of the vitruvian man and a shield design containing the staff of Asclepius with the words to the right "BlueCross BlueShield Association" and below the words "An Association of Independent Blue Cross and Blue Shield Plans" and below and under all the words "Leading the future of healthcare".</p>		
Goods/Services	<p>Class 036. First use: First Use: 2008/04/01 First Use In Commerce: 2008/04/01 prepaid financing and administration of hospital, medical and health care services</p> <p>Class 044. First use: First Use: 2008/04/01 First Use In Commerce: 2008/04/01 healthcare services, provided through preferred provider programs and health maintenance organizations</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	<p>A family of BLUE and BLUE-formative marks, including BLUE CROSS marks, and marks consisting of or including an image of a cross design (registered and at common law), as further described in the Notice of Opposition.</p>		
Goods/Services	<p>A range of goods and services relating to health care, health care plans, and insurance, as further described in the Notice of Opposition.</p>		

Attachments	Alkemi -- Notice of Opposition 85778843.pdf(30457 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	/Garner K. Weng/
Name	Garner K. Weng
Date	10/21/2013

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

IN RE: APPLICATION SERIAL NO. 85/778,843

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

ALKEMI MANAGEMENT COMPANY, INC.,

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. 85/778,843, filed by Applicant Alkemi Management Company, Inc., having an address of 477 South Rosemary, Suite 202, West Palm Beach, FL 33401.

1. On November 14, 2012, Alkemi Management Company, Inc. ("Applicant") filed Application Serial No. 85/778,843 ("Application") under Section 1(a) of the Lanham Act. The Application was published in the U.S. Patent & Trademark Office's *Official Gazette* on April 23, 2013. The Application on its face seeks to cover the following services: "Medical Services, namely outpatient ambulatory-care services," in International Class 44. The Application describes the subject mark ("Applicant's Mark") as a "cross," and the design codes assigned to Applicant's Mark include the codes for "Cross." The Application states that "Color is not claimed as a feature of the mark," meaning the Application claims Applicant's Mark in all colors and the mark is presumed to be used in all colors. Applicant's Mark therefore specifically encompasses a blue-colored cross design and, in fact, Applicant uses Applicant's Mark in the color blue.

2. Opposer Blue Cross and Blue Shield Association (“Association”) is a national association of 37 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 80 years, the Association (including through its predecessors in interest and its Member Plans and licensees) has provided tens of millions of families with top-quality affordable health care plans. The Association’s Member Plans currently provide health care plans for over 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 75% of the Fortune 500 companies and more than 80% of the Fortune 100 companies.

3. The BLUE CROSS and BLUE SHIELD brands are among the most recognized in the health and health-related industries in the United States—and, indeed, 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). It licenses the use of various such marks to its Member Plans and other licensees for the provision of a wide variety of goods and services, including but not limited to health insurance, life insurance, dental insurance, vision insurance, disability insurance, long-term care insurance, workers' compensation insurance, health care delivery services, financial services, wellness services, health education, 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. In the United States alone, the Association currently owns approximately 240 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 of 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 past years, annual gross revenue under the Blue Marks has been on the order of \$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 the context of trademark disputes or litigation. In sum, the Blue Marks have long been famous; and the Blue Marks were famous long before Applicant’s adoption of, use of, or application to register Applicant’s Mark.

6. Among the Association’s 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. 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. As with the Blue Marks, the Blue Cross Marks have long been famous; and the Blue Cross Marks were famous long before Applicant's adoption of, alleged use of, or application to register Applicant's Mark.

7. Several of the Association's U.S. federal trademark registrations for its Blue Marks and Blue Cross Marks are listed in Exhibit A hereto or identified as "Marks Cited by Opposer as Basis for Opposition" in Opposer's electronic submission of this Opposition, and are asserted as the basis for this opposition.

8. As further basis for this opposition, the Association asserts its rights in the marks consisting of or including an image of a cross design as shown in any of Opposer's registrations referenced above or consisting of or including the words BLUE CROSS in connection with the following goods and services for which use has been or is at common law: a broad range of health, insurance, medical, and related services, including without limitation health insurance services; health plan services; health care plan administration; health care management and consulting services; claims administration; dental insurance services; workers' compensation services; disability insurance services; life insurance services; long term care insurance services; health care services; medical services; health care delivery through medical clinics, physicians, biometric and wellness screening services, wellness programs, and nurse advice hotlines; assessing health care service provider performance; providing specialty care centers; providing centers-for-excellence programs in the field of health care; providing services for locating and connecting with health care providers and physicians; and conducting classes and seminars in the fields of health, fitness, diet/nutrition and lifestyle choices, and related educational services.

9. Applicant's Mark is confusingly similar to the Association's Blue Cross Marks. Among other things, Applicant's Mark has substantially the same shape and proportional dimensions of a Greek cross and is used in or containing the color blue. In addition, Applicant uses similar shades of blue in the cross design as the Blue Cross Marks. Overall, Applicant's

Mark creates a confusingly similar commercial impression to the Association's Blue Cross Marks. Furthermore, the services listed in the Application are identical to, similar to, overlap with, or are otherwise the type to be seen as emanating from the same source under a single mark as those goods or services designated by the Association's Blue Cross Marks. In sum, Applicant's Mark is therefore likely to confuse, cause mistake among, or deceive the relevant public into believing that Applicant and Applicant's goods and services offered in connection with Applicant's Mark are sponsored by, endorsed by, or in some manner related to the Association (or its Member Plans or licensees).

10. On information and belief, Applicant selected, adopted, began using and continues to use Applicant's Mark with full knowledge of the Association's Blue Cross Marks and Blue 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).

11. Registration and 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. Such registration and use would and does weaken the ability of such marks to identify and distinguish the goods and services of the Association from Applicant and others.

12. 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 Blue Marks, and by harming the reputation of the Association and its marks by associating them with Applicant.

13. 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.

EXHIBIT A

EXHIBIT A

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
BLUE-CROSS	554,488	IC 46
Blue Cross Design	554,817	IC 36
Blue Cross Design	969,385	IC 36
Blue Cross Design	990,414	IC 36
Blue Cross Design	1,055,560	IC 16
Blue Cross Design	1,293,243	IC 36
Blue Cross Design	1,422,665	IC 9
Blue Cross Design	1,425,238	IC 42
BLUE CROSS	1,426,942	IC 42
Blue Cross Design	1,632,320	IC 16
BLUE CROSS	1,632,573	IC 36
Blue Cross Design	1,639,079	IC 16
BLUE CROSS	1,691,498	IC 16
Blue Cross Design	1,699,627	IC 42
Blue Cross Design	1,763,481	IC 42
Blue Cross Design	1,826,582	IC 36
Blue Cross Design	1,997,328	IC 36
BLUE CROSS	2,027,402	IC 36
BLUE CROSS AND BLUE SHIELD ASSOCIATION	2,150,555	IC 36 IC 42
BLUE CROSS BLUE SHIELD ASSOCIATION	2,161,616	IC 16
Blue Cross Design	2,194,956	IC 36
THE BLUECROSS BOWL	2,681,673	IC 35
Blue Cross Design	3,132,422	IC 25
Blue Cross Design	3,132,424	IC 18
Blue Cross Design	3,132,572	IC 21
Blue Cross Design	3,132,578	IC 16
Blue Cross Design	3,172,396	IC 36

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
Blue Cross Design	3,219,839	IC 28
THE VALUE OF BLUE	3,148,694	IC 36 IC 44
BLUE SOLUTIONS	3,219,611	IC 44
Blue Cross Design	3,219,839	IC 28
WALKING WORKS & Design	3,255,615	IC 41
BLUE CROSS	3,288,738	IC 36
Blue Cross Design	3,288,740	IC 36
BLUE DISTINCTION	3,313,851	IC 35 IC 36 IC 44
BLUE CARE CONNECTION	3,315,528	IC 44
NATIONAL WALK @ LUNCH DAY & Design	3,436,871	IC 35
BLUE DISTINCTION CENTERS FOR TRANSPLANTS	3,478,216	IC 35 IC 44
BLUE DISTINCTION CENTERS FOR BARIATRIC SURGERY	3,478,217	IC 35 IC 44
BLUE DISTINCTION CENTERS FOR CARDIAC CARE	3,478,218	IC 35 IC 44
BLUE DISTINCTION HOSPITAL MEASUREMENT AND IMPROVEMENT PROGRAM	3,478,219	IC 35 IC 44
BLUE DISTINCTION CENTERS FOR SPECIALTY CARE	3,506,602	IC 35 IC 36 IC 44
BLUE DISTINCTION CENTERS	3,506,603	IC 35 IC 36 IC 44
BLUE DISTINCTION PROVIDER MEASUREMENT AND IMPROVEMENT PROGRAM	3,506,616	IC 35
BLUE DISTINCTION PROVIDER MEASUREMENT AND IMPROVEMENT	3,506,617	IC 44

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
PROGRAM		
BLUE 365 YOUR RESOURCE FOR LIVING HEALTHIER & BLUE CROSS DESIGN & Design	3,588,168	IC 35
BLUE DISTINCTION CENTERS FOR COMPLEX AND RARE CANCERS	3,677,329	IC 35 IC 44
BLUECROSS BLUESHIELD ASSOCIATION AN ASSOCIATION OF INDEPENDENT BLUE CROSS AND BLUE SHIELD PLANS LEADING THE FUTURE OF HEALTHCARE & Design	3,709,586	IC 36 IC 44
BLUECROSS BLUESHIELD VENTURE PARTNERS, L.P. AN INDEPENDENT LICENSEE OF THE BLUE CROSS AND BLUE SHIELD ASSOCIATION & Design	3,709,962	IC 36
BLUE DISTINCTION CENTER FOR SPINE SURGERY	3,794,451	IC 35 IC 44
BLUE DISTINCTION CENTERS FOR KNEE AND HIP REPLACEMENT	3,849,858	IC 35 IC 44
BLUE	4,074,287	IC 44
GOOD HEALTH CLUB & Design	4,007,542	IC 44
MY BLUE	4,085,124	IC 44

CERTIFICATE OF SERVICE

I, Dena Hong-Yee, hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 85/778,843 was served on the parties listed below by mailing said copies on October 21, 2013 via U.S. First Class Mail, postage pre-paid to:

Applicant's Attorney/Correspondent of Record:

Carl J. Spagnuolo
McHale Slavin, P.A.
2855 PGA Blvd.
Palm Beach Gardens, FL 33410

Dated: October 21, 2013

/s/ Dena Hong-Yee

Dena Hong-Yee