

ESTTA Tracking number: **ESTTA586510**

Filing date: **02/10/2014**

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	02/09/2014
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, sgill@hansonbridgett.com Phone:(415) 995-5081
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### Applicant Information

Application No	85818129	Publication date	08/13/2013
Opposition Filing Date	02/10/2014	Opposition Period Ends	02/09/2014
Applicant	VITTAL INTERNATIONAL CORP. 20900 N.E. 30th Avenue, Suite 200 Aventura, FL 33180 FL		

### Goods/Services Affected by Opposition

Class 044. First Use: 2012/09/01 First Use In Commerce: 2012/10/01  
All goods and services in the class are opposed, namely: home health care services, namely, in home physician house calls

### 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 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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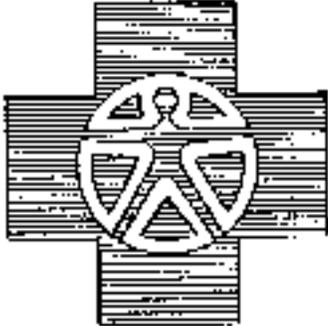
Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 036. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 DISTRIBUTION OF HOSPITAL CARE ON A PRE-PAYMENT FINANCING BASIS
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U.S. Registration No.	969385	Application Date	12/05/1972
Registration Date	09/25/1973	Foreign Priority Date	NONE

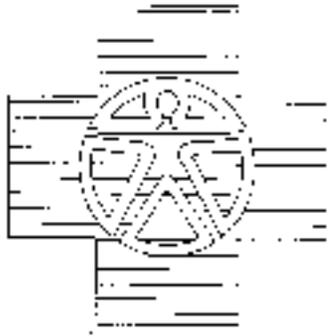
Word Mark	NONE
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Design Mark	
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Description of Mark	NONE
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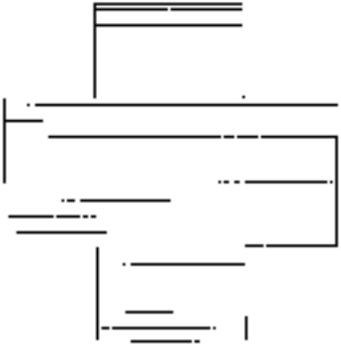
Goods/Services	Class 036. First use: First Use: 1972/11/09 First Use In Commerce: 1972/11/09 PREPAID FINANCING OF HOSPITAL AND HEALTH CARE SERVICES
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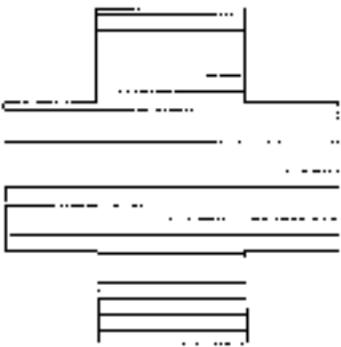
U.S. Registration	1425238	Application Date	08/29/1985
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No.			
Registration Date	01/13/1987	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1973/12/00 First Use In 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, FAMILY PLANNING SERVICES, MENTAL HEALTH SERVICES, NURSING SERVICES AND PRESCRIPTION DRUG SERVICES, AND ARRANGING FOR AMBULANCE SERVICES		

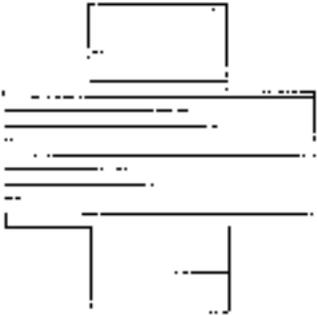
U.S. Registration No.	1426942	Application Date	08/29/1985
Registration Date	01/27/1987	Foreign Priority Date	NONE
Word Mark	BLUE CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1973/12/00 First Use In Commerce: 1973/12/00 HOME HEALTHCARE SERVICES, PREVENTIVE 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.	1632320	Application Date	02/26/1990
Registration Date	01/22/1991	Foreign Priority Date	NONE
Word Mark	NONE		

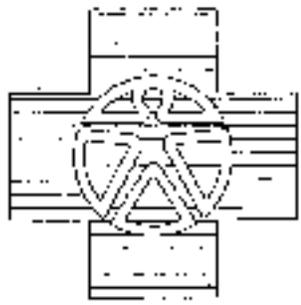
Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1934/12/00 First Use In Commerce: 1934/12/00 EDUCATIONAL BOOKS, BINDERS, PRINTED FORMS, BUSINESS FORMS, HEALTHCARE TRADE JOURNALS, NOTEBOOKS, WRITING PAPER, ENVELOPES, PEN AND PENCILS

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 ahealth 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 offamily planning, mental health servicesand 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 ofmedical, hospital and related health care services 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		

U.S. Registration No.	2194956	Application Date	04/01/1997
Registration Date	10/13/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1996/10/00 First Use In Commerce: 1996/10/00 insurance, namely, underwriting in the field of workers compensation with or without a managed care component

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	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.		
Goods/Services	A range of goods and services relating to health care, health care plans, and insurance, as further described in the Notice of Opposition.		

Attachments	71531753#TMSN.gif( bytes ) 72442919#TMSN.gif( bytes ) 73555889#TMSN.gif( bytes ) 74032415#TMSN.gif( bytes ) 74055846#TMSN.gif( bytes ) 74187033#TMSN.gif( bytes ) 75267697#TMSN.gif( bytes ) Vittal2U- Ntc of Opp.pdf(30316 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	/gkw/
Name	Garner K. Weng
Date	02/10/2014

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

IN RE: APPLICATION SERIAL NO. 85/818,129

BLUE CROSS AND BLUE SHIELD  
ASSOCIATION,

Opposer,

v.

VITTAL INTERNATIONAL CORP.,

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. 85/818,129, filed by Applicant Vittal International Corp., having an address of 20900 N.E. 30<sup>th</sup> Avenue, Suite 200, Aventura, FL 33180.

1. On January 8, 2013, Vittal International Corp. ("Applicant") filed Application Serial No. 85/818,129 ("Application") under Section 1(a) of the Lanham Act. The Application was published in the U.S. Patent & Trademark Office's *Official Gazette* on August 13, 2013. The Application on its face seeks to cover the following services: "home health care services, namely, in home physician house calls," in International Class 44. The Application's subject mark ("Applicant's Mark") includes design elements consisting of two Greek crosses and the design codes assigned to Applicant's Mark include the code for "Greek 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 blue-colored Greek cross designs and, in fact, Applicant uses both of the cross designs in 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<sup>®</sup> and BLUE SHIELD<sup>®</sup> 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. 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 care services; medical services; health care delivery through medical clinics, physicians, biometric and wellness screening services, wellness programs, and nurse advice hotlines; 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; 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, the visually dominant design elements of Applicant's Mark are two blue-colored Greek crosses, which Applicant uses in similar shades of blue and in similar ways of

presenting, 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.

14. 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 amended so that it claims color as a feature of the mark, with an amended drawing showing the mark in color, and with the colors shown in the drawing and stated or otherwise described in the application not being or including the cross elements in the color blue (or any color with the commercial impression of blue).

The Association (through its counsel) hereby authorizes the requisite filing fee in the amount of \$300 to be charged to Hanson Bridgett LLP's U.S. Patent & Trademark Office Deposit Account No. 08-0630; and the Commissioner is further authorized to charge any deficiencies or other amounts due in connection with this filing to Deposit Account No. 08-0630.

Respectfully submitted,

BLUE CROSS AND BLUE SHIELD ASSOCIATION

By           /s/ Garner K. Weng          

Susan G. O'Neill, Esq.  
Garner K. Weng, Esq.  
Simron K. Gill, Esq.  
Attorneys for Opposer  
Blue Cross and Blue Shield Association

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Date: February 10, 2014

# EXHIBIT A

## EXHIBIT A

<b>BCBSA FEDERAL REGISTRATIONS</b>		
<b>Mark</b>	<b>Reg. No.</b>	<b>International Classes of Goods or Services</b>
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
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
Blue Cross Design	3,219,839	IC 28

<b>BCBSA FEDERAL REGISTRATIONS</b>		
<b>Mark</b>	<b>Reg. No.</b>	<b>International Classes of Goods or Services</b>
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
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
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 PROGRAM	3,506,617	IC 44
BLUE 365 YOUR RESOURCE FOR LIVING HEALTHIER & BLUE CROSS DESIGN & Design	3,588,168	IC 35

<b>BCBSA FEDERAL REGISTRATIONS</b>		
<b>Mark</b>	<b>Reg. No.</b>	<b>International Classes of Goods or Services</b>
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
MY BLUE	4,085,124	IC 44

**CERTIFICATE OF SERVICE**

I, Laura Prongos, hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 85/818,129 was served on the parties listed below by mailing said copies on February 10, 2014 via U.S. First Class Mail, postage pre-paid to:

Applicant's Attorney/Correspondent of Record:

Peter A. Matos  
Malloy & Malloy, P.L.  
2800 SW 3<sup>rd</sup> Avenue  
Miami, FL 33129

Dated: February 10, 2014

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*/s/ Laura Prongos*

Laura Prongos