

ESTTA Tracking number: **ESTTA656328**

Filing date: **02/17/2015**

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	02/15/2015
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, gweng@hansonbridgett.com, cwal- ters@hansonbridgett.com, soneill@hansonbridgett.com, jthompson@hansonbridgett.com Phone:415/995-5081
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Applicant Information

Application No	86233170	Publication date	08/19/2014
Opposition Filing Date	02/17/2015	Opposition Period Ends	02/15/2015
Applicant	SISTERS OF CHARITY OF LEAVENWORTH HEALTH SYSTEM, INC. 2420 West 26th Avenue, Suite 100-D Denver, CO 80211 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2014/03/01 First Use In Commerce: 2014/03/01 All goods and services in the class are opposed, namely: Hospital administration services; Hospital management
Class 044. First Use: 2014/03/01 First Use In Commerce: 2014/03/01 All goods and services in the class are opposed, namely: Health care; Hospitals

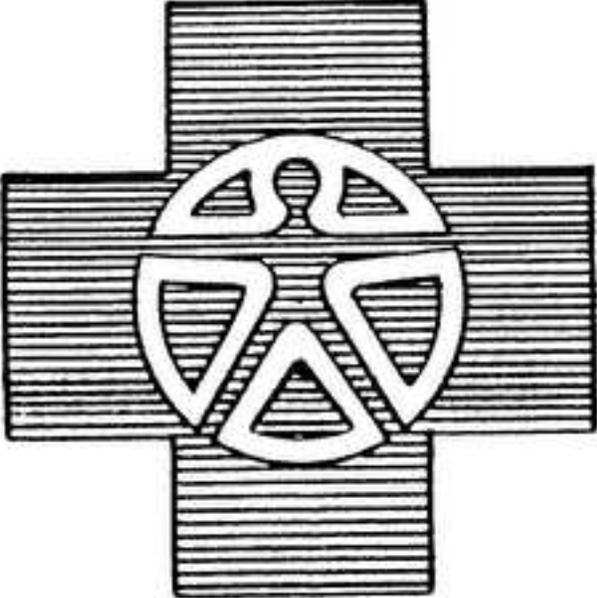
Grounds for Opposition

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

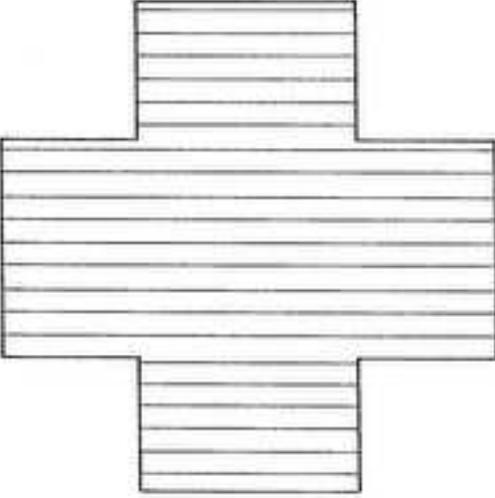
Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	554817	Application Date	08/19/1947
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Registration Date	02/12/1952	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 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 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 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.	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.	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 flexiblespending accounts; insurance claims administration

U.S. Registration No.	3313851	Application Date	08/26/2005
Registration Date	10/16/2007	Foreign Priority Date	NONE
Word Mark	BLUE DISTINCTION		
Design Mark	<p style="text-align: center; font-size: 2em; font-weight: bold;">BLUE DISTINCTION</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2006/06/05 First Use In Commerce: 2006/06/05 Assessing healthcare service provider performance, providing centers for excellence programs, providing specialty care centers, namely, conducting a quality measurement, improvement and assurance surveys in hospitals to determine service quality</p> <p>Class 036. First use: First Use: 2006/06/05 First Use In Commerce: 2006/06/05 Organization and administration of pre-paid, preferred provider organization,</p>		

	<p>health maintenance organization, exclusive provider organization, and point of service healthcare plans</p> <p>Class 044. First use: First Use: 2006/06/05 First Use In Commerce: 2006/06/05</p> <p>Healthcare services and comprehensive healthcare benefits programs, including those rendered through a health maintenance organization and preferred provider organization, namely physician, dental, hospital, home health care, preventative healthcare treatment, physical therapy and dispensing of pharmaceuticals services; Healthcare consulting services</p>
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U.S. Registration No.	3709586	Application Date	03/28/2008
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Registration Date	11/10/2009	Foreign Priority Date	NONE
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Word Mark	<p>BLUECROSS BLUESHIELD ASSOCIATION AN ASSOCIATION OF INDEPENDENT BLUE CROSS AND BLUE SHIELD PLANS LEADING THE FUTURE OF HEALTHCARE</p>
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Design Mark	 <p>BlueCross BlueShield Association</p> <p>An Association of Independent Blue Cross and Blue Shield Plans</p> <p>Leading the future of healthcare</p>
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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 theright "BlueCross BlueShield Association" and below the words "An Association ofIndependent Blue Cross and Blue Shield Plans" and below and under all the words"Leading the future of healthcare".</p>
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Goods/Services	<p>Class 036. First use: First Use: 2008/04/01 First Use In Commerce: 2008/04/01</p> <p>prepaid financing and administration ofhospital, medical and health care services</p> <p>Class 044. First use: First Use: 2008/04/01 First Use In Commerce: 2008/04/01</p> <p>healthcare services, provided through preferred provider programs and health maintenance organizations</p>
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U.S. Registration No.	4074287	Application Date	06/15/2011
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Registration Date	12/20/2011	Foreign Priority Date	NONE
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Word Mark	BLUE
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Design Mark	<h1>BLUE</h1>
Description of Mark	NONE
Goods/Services	Class 044. First use: First Use: 2003/06/03 First Use In Commerce: 2003/06/03 Providing on-line information, news and commentary in the field of health and wellness relating to health plans, health support, fitness, nutrition and self care

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	A family of BLUE marks, BLUE CROSS marks, and marks consisting of or including an image of a cross design (registered and 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.png(bytes) 72442919#TMSN.png(bytes) 72450146#TMSN.png(bytes) 74187033#TMSN.png(bytes) 78598844#TMSN.png(bytes) 78701074#TMSN.png(bytes) 77434198#TMSN.png(bytes) 85346475#TMSN.png(bytes) Sisters of Charity - Ntc of Opp.pdf(31126 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	02/17/2015

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

IN RE: APPLICATION SERIAL NO. 86/233,170

BLUE CROSS AND BLUE SHIELD
ASSOCIATION,

Opposer,

v.

SISTERS OF CHARITY OF LEAVENWORTH
HEALTH SYSTEM, 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. 86/233,170, filed by Applicant Sisters of Charity of Leavenworth Health System, Inc., having an address of 2420 West 26th Avenue, Suite 100-D, Denver, CO 80211.

1. On March 26, 2014, Sisters of Charity of Leavenworth Health System, Inc. ("Applicant") filed Application Serial No. 86/233,170 ("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 19, 2014. The Application on its face seek to cover the following services: "Hospital administration services; Hospital management," in International Class 35 and "Health care; Hospitals," in International Class 44. The Application describes the subject mark ("Applicant's Mark") as including a Greek cross in the color blue. Likewise, the design codes assigned to Applicant's Mark include codes for "Greek cross." In sum, Applicant's Mark specifically encompasses a Greek cross design containing 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 nearly 105 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 96% of hospitals and 92% of physicians in the United States contract with the Association’s Member Plans—more than any other insurer. The Association’s Member Plans currently have local and national presence in 75% of all Fortune 500 companies and 86% of all 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 221 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 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 is a Greek cross containing the color blue, and Applicant uses similar shades of blue in, and similar ways of presenting, the cross element of Applicant's Mark 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 the colors

EXHIBIT A

EXHIBIT A

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
BLUE-CROSS	554,488	IC 36
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

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
THE VALUE OF BLUE	3,148,694	IC 36 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 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
BLUE DISTINCTION CENTERS FOR	3,677,329	IC 35

BCBSA FEDERAL REGISTRATIONS		
Mark	Reg. No.	International Classes of Goods or Services
COMPLEX AND RARE CANCERS		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	4,111,938	IC 36

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. 86/233,170 was served on the parties listed below by mailing said copies on February 17, 2015 via U.S. First Class Mail, postage pre-paid to:

Applicant's Attorney/Correspondent of Record:

Carl Baranowski
1601 Glen Ayr Drive
Lakewood, CO 80215

Dated: February 17, 2015

/s/ Laura Prongos

Laura Prongos