



06-24-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

308/00296-1

TAB

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

TRADEMARK TRIAL AND
APPEAL BOARD
02 JUL -2 PM 8:27



CAREFIRST OF MARYLAND, INC.,)
d/b/a CAREFIRST BLUE CROSS)
BLUE SHIELD,)
)
OPPOSER,)
)
v.)
)
MONUMENTAL LIFE INSURANCE)
COMPANY)
)
APPLICANT.)

OPPOSITION NO. _____

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 76/118,363 covering the mark "TRIPLECARE" as filed on August 28, 2000 in accordance with Section 1(b), (Int. Class 36) by Monumental Life Insurance Company, a corporation organized under the laws of the state of Maryland having a principal place of business at 2705 Brown Trail, Suite 508, Bedford, Texas 76021-4104 published in the Trademark Official Gazette April 2, 2002, time being extended until July 1, 2002, Opposer Carefirst of Maryland, Inc. d/b/a Carefirst Blue Cross Blue Shield, a corporation organized under the laws of the state of Maryland, having a principal place of business at 10455 Mill Run Circle, Owings Mills, Maryland 21117, believes that it would be damaged by registration of Application Serial No. 76/118,363, and hereby opposes the registration of the mark "TRIPLECARE." The grounds for opposition, on information and belief, are as follows:

1. Prior to August 28, 2000, Applicant's constructive use date, Opposer through its predecessor has continuously used in commerce the "CAREFIRST" mark and name and Opposer is presently

07/01/2002 JHARLEY
01 FC:377

00000195 76118363

300.00 DP

mas

using in commerce the "CAREFIRST" mark and name in connection with a variety of different products and services all related to the delivery of managed medical care to its members. Such products and services include but are not limited to insurance administration and health insurance underwriting services, healthcare services in the nature of health maintenance organizations and/or preferred provider organizations, newsletters, educational services and services for and on behalf of its members. Said mark and name also is used by members of Opposer's plans to indicate membership in an organization or organizations interested in health maintenance, prepaid medical plans and the like.

2. Since prior to August 28, 2000, Applicant's constructive use date, Opposer through its predecessor has continuously used the "CAREFIRST" mark and name in connection with the services and products described in paragraph 1, did offer such services and products to its members that reside throughout the states of Maryland, Delaware, Pennsylvania, West Virginia, Virginia and the District of Columbia, and is presently using "CAREFIRST" as a service mark in connection with the rendering of said services, as a trademark in connection with the dissemination of said products, as a collective membership mark in connection with services rendered for and on behalf of its members, and as a trade name.

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

- (a) Registration No. 1,543,100
"CAREFIRST"
Dated: June 6, 1989

(b) Registration No. 1,546,326
"CAREFIRST"
Dated: July 4, 1989

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

4. The services of Applicant, namely, insurance underwriting and insurance administration in the field of chronic health care in International Class 36, are closely related, if not identical, to the various services, products and membership activities offered by Opposer and as described in paragraph 1 herein. Many of the services and products offered and sold by Opposer under its "CAREFIRST" mark and name are likely to be purchased and used by the same class of purchasers who are likely to use Applicant's services, and are marketed through the same and related channels of trade.

5. Applicant's mark "TRIPLECARE" is so confusingly similar at least in meaning and commercial impression to Opposer's "CAREFIRST" mark and name which the public and trade have associated and recognize with Opposer, as to be likely, when applied to the services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the services and products of Applicant emanate from, or are disseminated under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

6. On information and belief, Applicant has made no use of its alleged mark "TRIPLECARE" in the United States for any product or service prior to August 28, 2000, its constructive use date, which is a date subsequent to the date of first use for Opposer's "CAREFIRST" mark and name.

7. In view of the similarity between Applicant's mark "TRIPLECARE" and Opposer's "CAREFIRST" mark and name, and in view of the related or identical nature of the services and products offered and disseminated by both Applicant and Opposer and the activities of Opposer's members, it is alleged that Applicant's mark consists of and comprises matter which may disparage and falsely suggest a trade connection between Opposer and Applicant.

8. Opposer has expended considerable time, effort and money in advertising and otherwise promoting its products, services and membership activities and in encouraging the public and trade to recognize its "CAREFIRST" mark and name, that unless refused, the registration obtained by Applicant will enable Applicant to reap the benefits of such goodwill attached to Opposer's mark and name, and Opposer will suffer irreparable damage and injury as a result of the confusion that is likely to arise from its inability to control its reputation.

9. Furthermore, any defect, objection or fault found with Applicant's goods and services provided under Applicant's "TRIPLE CARE" mark would necessarily reflect on and seriously injure the reputation that Opposer has established and enjoys under the "CAREFIRST" mark and name.

10. If the Applicant is able to register its mark "TRIPLE CARE" for the services set forth in the application, confusion of the trade and public is likely to result, and such confusion will result in damage and injury to Opposer.

11. If Applicant is granted a registration for the mark herein, it will obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer and its members.

12. Since long before the constructive use of "TRIPLECARE" by Applicant, Opposer has used the "CAREFIRST" mark and name, and has, through its predecessors continuously and in good faith used the "CAREFIRST" mark and name as described in paragraphs 1 and 2. As a consequence of the widespread use of the "CAREFIRST" mark and name, Opposer's "CAREFIRST" mark and trade name have become distinctive in the minds of the trade and the business community of the quality of goods, services, and membership rights offered by Opposer. Accordingly, Opposer's "CAREFIRST" mark and name have achieved niche market fame in the health insurance industry. Opposer's niche market fame is evidenced, in part, by the Consumer's Union's (publisher of Consumer Reports) independent study which recognized Opposer in their October 2001 report as the best overall rated health insurer in the United States in terms of its health maintenance and preferred provider related services.

13. As a consequence of the widespread use of the "CAREFIRST" mark and name, Opposer's "CAREFIRST" mark and name have also become distinctive in the minds of the public of the quality of goods, services, and membership rights offered by Opposer. Accordingly, Opposer's "CAREFIRST" mark and name have achieved fame to the public in general.

14. Opposer's "CAREFIRST" mark and name has achieved general fame and niche market fame at some time prior to the constructive use and the actual use if any, of the "TRIPLECARE" mark and name by Applicant.

15. Applicant's subsequent, willful, and deliberate adoption, intention to use, and attempted registration of the "TRIPLECARE" mark and name in connection with the services described in its application would dilute the distinctive quality of the "CAREFIRST" mark and name both to the general public and in its niche market causing the diminution in the value of the goodwill associated with the "CAREFIRST" mark and name.

16. Applicant's subsequent, willful, and deliberate adoption, intention to use, and attempted registration of the "TRIPLECARE" mark and name in connection with the services described in its application is likely to cause injury to the business reputation of Opposer since Opposer has no control over the nature and quality of the services being offered by Applicant in connection with its confusingly similar mark.

17. Registration of the mark "TRIPLECARE" would also injure the business reputation of Opposer since both the public and individual members of Opposer's organizations may erroneously believe that Applicant is in some way associated with Opposer and believe that Applicant is in some way obligated to that member for medical care, all to Opposer's injury and detriment.

WHEREFORE, Opposer, by and through its counsel, respectfully prays that the mark sought to be registered by Applicant be refused and this opposition be sustained. The \$300.00 government fee (one class) is attached hereto.

//
//
//
//
//

Please recognize Barth X. deRosa, James E. Ledbetter, Thomas P. Pavelko, Anthony P. Venturino, all members of a Bar, and the firm of Stevens, Davis, Miller & Mosher, LLP, 1615 L Street, NW, Suite 850, Washington, DC 20036, as attorneys for Opposer.

Respectfully submitted,

CAREFIRST OF MARYLAND, INC. d/b/a
CAREFIRST BLUE CROSS BLUE SHIELD

BY: 

Barth X. deRosa
Ruth Mae Finch
Christopher M. Collins
Karen A. Sekowski
STEVENS, DAVIS, MILLER & MOSHER, LLP
Counsel for Opposer
1615 L Street, NW, Suite 850
Washington, DC 20036
(202) 785-0100