

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

JULY 28, 97

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Blue Cross & Blue Shield of Rhode Island**

Serial No. 74/**612,608**

Michael K. Barron of **Peabody & Brown** for applicant.

David M. Mermelstein, Trademark Examining Attorney, Law
Office 103 (**Michael A. Szoke**, Managing Attorney)

Before **Simms**, **Hanak** and **Hairston**, Administrative Trademark
Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

On December 19, 1994, Blue Cross and Blue Shield of Rhode Island (applicant) filed an intent-to-use application seeking to register OPUS 123 in typed capital letters for "computer software program that will allow doctor's offices to communicate electronically with the insurance provider, retrieving and submitting information and allowing doctors to make referrals to other doctors."

The Examining Attorney refused registration pursuant to Section 2(d) of the Lanham Trademark Act on the basis that applicant's mark, as applied to applicant's services, is

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likely to cause confusion with three marks previously registered by Lotus Development Corporation. Registration No. 1,641,139 depicts 1-2-3/G in typed capital letters for "computer programs for spreadsheet applications containing a graphical user interface and instruction manuals sold as a unit." Registration No. 1,352,553 depicts the mark 1-2-3 in typed capital letters for "pre-recorded computer programs recorded on magnetic disks and instruction manuals sold as a unit." Finally, Registration No. 1,315,501 depicts 123 in the stylized form shown below for "pre-recorded computer programs recorded on magnetic disks and instruction manuals sold as a unit."



When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Before discussing the merits of this case, one procedural matter deserves comment. In response to the first Office Action, the applicant's attorney made the following comments at page 3 of applicant's response:

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"Applicant's mark when viewed as a whole is sufficiently distinctive from the cited registered Lotus Marks so that there is no likelihood of confusion. The common element of the applicant's mark and the Lotus Marks is the '123' element. The element '123' has been incorporated in numerous registered trademarks for a very wide variety of goods since the initial registration of the Lotus Marks in 1985. See Exhibit 2 attached." In his second and final Office Action, the Examining Attorney never commented upon Exhibit 2. However, at page 5 of his appeal brief, the Examining Attorney stated that there was a "problem" with Exhibit 2 because it was "not in the Trademark Office file, and to the best of the Examining Attorney's knowledge, was not there during examination." In its reply brief, applicant noted that during the examination process, the Examining Attorney never even commented upon Exhibit 2, much less raised an objection to Exhibit 2. Moreover, the applicant attached to its reply brief a copy of its entire response to Office Action number 1, including Exhibit 2. Exhibit 2 is a print out from a private trademark search report showing over 80 marks registered with the United States Patent and Trademark Office which contain the numerals 123.

When the file reached this Board, there was no Exhibit 2 attached to applicant's response to Office Action number 1, although there were other exhibits attached which were mentioned in the response. We are at a loss to understand

why the Examining Attorney did not contact the applicant's attorney and explain that Exhibit 2 was missing.

Applicant's attorney could then have simply submitted a copy of Exhibit 2 (which it did in any event with its reply brief) and the Examining Attorney could then have had a chance to make substantive comments with regard to Exhibit 2.

However, because we believe that Exhibit 2 is not necessary to our decision, we are deciding this case without reference to this Exhibit, instead of remanding the case to the Examining Attorney.

While both registrant's goods and applicant's goods are computer programs, applicant's computer programs are highly specialized computer programs which are directed to doctors. There is no dispute that doctors are sophisticated when it comes to purchasing equipment for their offices. Stated somewhat differently, we are not dealing with a situation where registrant's computer programs and applicant's computer programs are sold through retail outlets to the general public.

In comparing the marks, we note that applicant's mark begins with the distinctive and arbitrary term OPUS. The only element common to both marks is the equivalent of the common phrase "one, two, three." See Dictionary of American English, Volume III (1996). The numerals 123 suggest ease of use, as in the expression "simple as 123."

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Given the highly specialized nature of applicant's computer programs; the fact that said computer programs are sold to sophisticated purchasers; the appearance in applicant's mark of the quite distinctive and arbitrary term OPUS; and the fact that the only element common to applicant's mark and registrant's marks is the highly suggestive expression "123," we find that the contemporaneous use of applicant's mark and registrant's marks is not likely to result in confusion.

Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston
Administrative Trademark Judges
Trademark Trial and Appeal Board