

19

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No.

EWH/TAF

8/10/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Blue Cross and Blue Shield of South Carolina
v.
Mountain View Software Corporation

Opposition No. 107,521
to application Serial No. 75/182,070
filed on October 16, 1996

Craig Killough of Barnwell, Whaley, Patterson & Helms for
Blue Cross and Blue Shield of South Carolina.

Evan A. Schmutz of Hill, Harrison, Johnson & Schmutz for
Mountain View Software Corporation.

Before Hanak, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Mountain View Software Corporation (applicant) seeks
to register WORKERS COMPANION in typed drawing form for
"computer programs and software for use in analyzing and

Opposition No. 107,521

generating documents for workers' compensation." The intent-to-use application was filed on October 16, 1996.

Blue Cross and Blue Shield of South Carolina (opposer) filed a notice of opposition alleging that long prior to October 1996, it both used and registered the mark COMPANION for various types of insurance services. In addition, opposer alleged that through its wholly owned subsidiary Companion Property and Casualty, it used the mark COMPANION specifically for workers' compensation insurance, and that through its other wholly owned subsidiary Companion Technologies, Inc., it used the mark COMPANION in connection with computer software for use in the insurance industry.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition.

Opposer made of record evidence and filed a brief. Applicant did neither. An oral hearing was not requested. The record in this case is fully summarized at pages 4-5 of opposer's brief.

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarity of the goods and services and the similarity of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, (192 USPQ 24, 29 (CCPA 1976) ("The

Opposition No. 107,521

fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.").

Considering first the goods and services, we note that opposer has properly made of record a certified status and title copy of its Registration No. 1,566,320 for the mark COMPANION depicted in the typed drawing form. The services of this registration include insurance administration and underwriting including accident, health, property, casualty, death and life insurance (Class 36) and the custom design of computer hardware and software systems for professional offices (Class 42). While this registration does not include the specific words "workers' compensation insurance," the record demonstrates that this insurance is a form of casualty insurance.

In addition, the record demonstrates that since 1984, opposer through its wholly owned subsidiary Companion Property and Casualty Insurance Company has offered workers' compensation insurance under the mark and trade name Companion Property and Casualty. Finally, since 1986 opposer through its wholly owned subsidiary Companion Technologies Corporation has offered computer

Opposition No. 107,521

software to process various insurance claims including specifically workers' compensation claims under the mark and trade name Companion Technologies.

In view of the foregoing, we find that the goods and services for which opposer has established prior rights in its COMPANION marks are essentially identical to or extremely similar to the goods for which applicant seeks to register its mark WORKERS COMPANION (computer programs and software for use in analyzing and generating documents for workers' compensation)." To be more specific, opposer's Registration No. 1,566,320 for the mark COMPANION - which registration issued on November 14, 1989 long prior to applicant's filing date of October 16, 1996 - specifically includes the "custom design of computer hardware and software systems for professional offices." Obviously, insurance offices are professional offices, and thus opposer's registration is broad enough to include the custom design of computer software for analyzing insurance documents, specifically including workers' compensation documents. Moreover, as previously noted, the record reflects that since 1986 opposer has actually used the trade name and mark Companion Technologies specifically in connection with software for

Opposition No. 107,521

use in processing insurance claims, including specifically workers' compensation claims.

Moreover, opposer's Registration No. 1,566,320 also includes insurance administration and underwriting for, among other types of insurance, casualty insurance. One type of casualty insurance is workers' compensation insurance. Indeed, in actual practice, opposer has continuously sold since 1984 worker's compensation insurance under the trade name and mark Companion Property and Casualty. While workers' compensation insurance and computer software for use in analyzing and generating documents for workers' compensation insurance are not identical services and goods, they are very closely related services and goods.

In sum, as indicated previously, we find that opposer has established prior rights in its COMPANION marks and names for goods which are essentially identical to applicant's goods and for services which are extremely similar to applicant's goods.

Turning to a consideration of the marks, we note at the outset that when the goods of the parties are in part identical as is the case here, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp.

Opposition No. 107,521

v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

We find that opposer's registered mark COMPANION and opposer's trade name and unregistered mark Companion Technologies are both very similar to applicant's mark WORKERS COMPANION when all three are used in connection with computer software for use in analyzing and generating documents for workers' compensation insurance. Applicant has adopted opposer's registered mark COMPANION in its entirety and added thereto the highly suggestive word WORKERS. In this regard, we have little doubt that as applied to software for use in analyzing workers' compensation insurance, the word WORKERS is indeed highly suggestive. Likewise, we find that applicant's mark WORKERS COMPANION is extremely similar to opposer's previously used trade name and unregistered mark Companion Technologies in that when used in conjunction with computer software for analyzing workers' compensation insurance, the word "technologies" is likewise highly suggestive of computer software.

It has long been held that one may not appropriate the entire mark of another (COMPANION) and escape liability by the addition thereto of a highly suggestive term such as WORKERS. Bellbrook Dairies v. Hawthorn-

Mellody Dairy, 253 F.2d 431, 117 USPQ 213, 214 (CCPA 1958) and cases cited therein.

Moreover, to the extent that there are any slight doubts on the issue of likelihood of confusion, said doubts are removed when one recognizes that applicant is seeking to register its mark WORKERS COMPANION in typed drawing form. Because applicant seeks to register its mark in typed drawing form, we are obligated to consider all reasonable manners in which applicant could depict its mark. Phillips Petroleum v. C. J. Webb, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); INB National Bank v. Metrohost, 22 USPQ2d 1585, 1588 (TTAB 1992). One reasonable manner of presentation of applicant's mark would be to depict the word WORKERS on one line in somewhat smaller lettering and the word COMPANION on a second line in somewhat larger lettering. When so depicted, applicant's mark would be extremely similar to opposer's registered COMPANION mark.

Finally, while we have no doubts that there exists a likelihood of confusion, it need hardly be said that to the extent that there are any doubts whatsoever on this issue, said doubts must be resolved in favor of opposer as both the long prior registrant and user of the aforementioned COMPANION marks and trade names. In re

Opposition No. 107,521

Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223
USPQ 1289, 1290 (Fed. Cir. 1984).

Decision: The opposition is sustained.

E. W. Hanak

C. E. Walters

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial
and Appeal Board