ESTTA Tracking number: **ESTTA626442**
Filing date: **09/10/2014**

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

Proceeding	91218154
Party	Plaintiff ASCENSION HEALTH ALLIANCE
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Date	09/10/2014
Attachments	Stipulated Motion to Consolidate.pdf(171884 bytes)

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

ASCENSION HEALTH ALLIANCE , Petitioner, – against – ASCENSION INSURANCE, INC., Registrant.	Cancellation No. 92058897 U.S. Reg. Nos. 3,595,725 and 3,608,718
ASCENSION HEALTH ALLIANCE , Opposer, – against – ASCENSION INSURANCE, INC., Applicant.	Opposition No. 91218154 U.S. Application No. 85/702,989

STIPULATED MOTION TO CONSOLIDATE

Pursuant to Fed. R. Civ. P. 42(a), Trademark Rule 2.1116 and § 511 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner Ascension Health Alliance ("Ascension Health) and Registrant Ascension Insurance, Inc. ("Ascension Insurance") hereby submit this stipulated motion to consolidate this cancellation proceeding with Opposition No. 91218154.

Ascension Insurance is the owner of U.S. Trademark Registration Nos. 3,595,725 and 3,608,718 for the marks ASCENSION and ASCENSION INSURANCE, INC. for a range of insurance brokerage related services in International Classes 35 and 36. Ascension Insurance also owns U.S. Trademark Application Serial No. 85/702,989 for the mark ASCENSION

BENEFITS & INSURANCE SOLUTIONS for various insurance brokerage and advisory services in International Classes 35 and 36.

On March 21, 2014, Ascension Health initiated the present cancellation proceeding by filing a Petition to Cancel Registration Nos. 3,595,725 and 3,608,718 for the marks ASCENSION and ASCENSION INSURANCE, INC. On March 24, 2014, the Board instituted the proceeding as Cancellation No. 92058897 and on July 2, 2014 Ascension Insurance filed its answer.

On September 3, 2014, Ascension Health filed a Notice of Opposition against Ascension Insurance's Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS and the Board instituted proceedings in that matter as Opposition No. 91218154.

The Federal Rules of Civil Procedure, as made applicable by Trademark Rule 2.116(a), provide: "If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay." Fed. R. Civ. P. 42(a); 37 C.F.R. § 2.116(a). "In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby." TBMP § 511. In this regard, identity of the parties, although one factor to be considered, is not required. *Id.*

In this instance, Cancellation No. 92058897 and Opposition No. 91218154 involve the same parties, similar marks and some common issues of law and fact. The marks relied upon by Ascension Health are the same in both proceedings and are as follows: ASCENSION HEALTH & Design (Reg. No. 2,478,534, issued August 14, 2001 and already incontestable); ASCENSION HEALTH (Reg. No. 4,069,046, issued December 13, 2011);

ASCENSION HEALTH SMARTHEALTH (Reg. No. 4,422,262, issued October 22, 2013); and CERTITUDE BY ASCENSION HEALTH (Reg. No. 4,234,598, issued October 30, 2012). Ascension Insurance's marks at issue, that are subject to the respective cancellation and opposition proceedings, are similar in that they all incorporate the term ASCENSION as their dominant portion and are used/intended to be used by Ascension Insurance in connection with insurance brokerage services. Both the cancellation and opposition proceedings address issues relating to Petitioner's alleged priority of use of the term ASCENSION and Petitioner's allegations of similarities between the parties' marks and services offered under the respective marks. Finally, both Cancellation No. 92058897 and Opposition No. 91218154 are in a similar procedural posture as the discovery periods have not closed in each and testimony periods for either party have not yet begun.

Consolidation is in interest of both the parties and the TTAB. It will allow the parties to proceed on a unified record, will eliminate duplicative filings and motions with the Board, and will streamline the resolution of the parties' dispute. A consolidation of both proceedings will save both the TTAB and the parties time, effort and expense and conserve the TTAB's judicial resources.

Furthermore, neither party will be prejudiced or inconvenienced by consolidation. *See Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 & n. 1 (TTAB 1993) (granting parties' stipulation to consolidate opposition and cancellation proceedings); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (consolidation of opposition and cancellation proceedings ordered by Board on stipulation of the parties); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975) (consolidation ordered on the Board's own motion where issues were substantially the same and consolidation would be advantageous to both parties). As the parties have just commenced

discovery with the service of initial requests, and have been engaged in some settlement discussions concerning all of these proceedings, both parties are in a similar position as neither party has yet engaged in significant discovery efforts.

The parties do not intend that anything stated in this motion will be used as evidence in any proceeding, and agree not to so use such statements.

Therefore, the parties respectfully request that the Board grant this motion and consolidate the above-captioned Cancellation No. 92058897 with pending Opposition No. 91218154.

Dated: September 10, 2014

Respectfully submitted,

FOLEY & LARDNER LLP

By: /s/ *Jonathan E. Moskin*

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Dated: September 10, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 10, 2014 a true and complete copy of the foregoing **STIPULATED MOTION TO CONSOLIDATE** was served by first-class mail to the counsel of ASCENSION INSURANCE, INC. as follows:

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Sky G. Schoepfer