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

Proceeding	91218154
Party	Defendant Ascension Insurance, Inc.
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Date	10/13/2014
Attachments	ASCENSION Answer.pdf(412854 bytes)

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

ASCENSION HEALTH ALLIANCE,)	
)	
Opposer/Petitioner,)	Opposition No. 91218154
)	Cancellation No. 92058897
vs.)	
)	
ASCENSION INSURANCE, INC.)	
)	
Applicant/Registrant.)	

ANSWER TO NOTICE OF OPPOSITION

Ascension Insurance, Inc. (“Applicant”), by and through its attorneys, answers Ascension Health Alliance’s (“Opposer”) Notice of Opposition of U.S. Trademark Serial No. 85/702,989, as follows:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Notice of Opposition and therefore denies the same.
2. Applicant admits the allegations in paragraph 2 of the Notice of Opposition, except that Applicant is a corporation and Applicant’s executive offices are located at 1277 Treat Boulevard, Suite 650, Walnut Creek, California 94597.
3. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Notice of Opposition, and therefore denies the same.
4. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Notice of Opposition, except admits that Opposer operates hospitals.

5. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Notice of Opposition, and therefore denies the same.

6. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Notice of Opposition, and therefore denies the same.

7. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7 of the Notice of Opposition, and therefore denies the same.

8. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 8 of the Notice of Opposition, and therefore denies the same, except admits that Opposer is the last listed owner in the U.S.P.T.O. records for the trademarks identified by Registration Nos. 2,478,534, 4,069,046, 4,422,262, and 4,234,598.

9. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 9 of the Notice of Opposition, and therefore denies the same.

10. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 10 of the Notice of Opposition, and therefore denies the same.

11. Applicant denies the allegations contained in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations contained in paragraph 12 of the Notice of

Opposition.

13. Applicant admits that on August 14, 2012 Applicant filed U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS, and that on May 6, 2014 such application was published based on an intent to use the mark in connection with “Insurance claims auditing services; insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; promotion of financial and insurance services, on behalf of third parties; providing insurance agent referrals” in International Class 35 and “Advisory services in the field of employee benefits for group healthcare and business insurance offered to employees in addition to standard benefits such as medical, dental, life insurance including short-term disability, long-term disability and accidental death and dismemberment; agricultural insurance agency services; brokerage in the field of insurance; claims administration in the field of workers compensation; claims administration in the field of health insurance; financial evaluation for insurance purposes; insurance administration; insurance agencies; insurance agency and brokerage; insurance brokerage; insurance claims administration; insurance consultation; insurance services, namely, writing property and casualty insurance; providing information in insurance matters; processing, administering and managing employee benefit plans concerning insurance and finance” in International Class 36.

14. Applicant admits that it offers brokerage, consulting, and administrative services with respect to employee benefits and insurance coverages, including health insurance plans for employers, that it is a broker of student health insurance plans and that it is a broker of malpractice insurance plans for health care professionals, though Applicant’s

U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS is based on its intent to use such mark in connection with the services identified in such application. Applicant denies the remaining allegations in paragraph 14 of the Notice of Opposition.

15. Applicant admits that the registration of U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS will provide Applicant with *prima facie* evidence of Applicant's exclusive right to use such mark in connection with the services identified in such application. Applicant denies the remaining allegations in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations contained in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations contained in paragraph 18 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

LACHES, WAIVER, ESTOPPEL, and ACQUIESCENCE

1. Opposer's Notice of Opposition to U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS is barred by the doctrines of laches, waiver, estoppel and acquiescence.

2. By way of one example, Applicant is the owner of U.S. Trademark Registration No. 3,608,718 for the mark ASCENSION for use in connection with "Insurance claims auditing services; Insurance lead collection and matching services, namely, matching consumer requests

for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; Managing the operations of insurance agencies and brokers on an outsourcing basis; Promotion of financial and insurance services, on behalf of third parties; Providing insurance agent referrals” in International Class 35 and “Brokerage in the field of insurance; Financial evaluation for insurance purposes; Insurance administration; Insurance agencies; Insurance agency and brokerage; Insurance brokerage; Insurance consultation; Insurance services, namely, writing property and casualty insurance; Providing information in insurance matters” in International Class 36. Applicant’s underlying application for such mark, U.S. Trademark Application Serial No. 77/569,627, was published for opposition in the Official Gazette on February 3, 2009.

3. Opposer did not file a Notice of Opposition against registration of the mark ASCENSION as applied for in U.S. Trademark Application Serial No. 77/569,627.

4. Applicant’s U.S. Trademark Application Serial No. 77/569,627 matured to U.S. Trademark Registration No. 3,608,718 on April 21, 2009.

5. Applicant’s U.S. Trademark Registration No. 3,608,718 for ASCENSION was cited by a U.S.P.T.O. Examining Attorney as a potential bar to Opposer’s registration of the marks ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH on March 29, 2011.

6. Opposer did not file its Petition for Cancellation of U.S. Trademark Registration No. 3,608,718 until March 21, 2014.

7. Applicant has invested significant time, money and company assets into the services it offers and sells under the ASCENSION mark and has developed valuable goodwill in the ASCENSION mark during the period of Opposer’s long period of silence.

8. Opposer unreasonably delayed its assertion of rights against Applicant and such delay has caused material prejudice to Applicant, including when Applicant filed U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS.

9. For a variety of reasons, including but not limited to those set forth herein, Opposer's Notice of Opposition to U.S. Trademark Serial No. 85/702,989 is barred by the doctrines of laches, waiver, estoppel and acquiescence.

ABANDONMENT

10. On information and belief Opposer has failed to police the use of the mark ASCENSION or confusingly similar marks by third parties. Such failure to police its trademark by Opposer has caused Opposer to abandon and/or waive its rights to enforce any rights Opposer claims in the mark ASCENSION.

11. Opposer cannot prove prior rights due to its abandonment and waiver of the mark ASCENSION for failure to police the use of the mark by others.

UNCLEAN HANDS

12. Opposer's Notice of Opposition to U.S. Trademark Serial No. 85/702,989 for the mark ASCENSION BENEFITS & INSURANCE SOLUTIONS is barred by the doctrine of unclean hands.

13. On information and belief, Opposer committed bad acts directed at Applicant with respect to its claims that U.S. Trademark Serial No. 85/702,989 for the trademark ASCENSION BENEFITS & INSURANCE SOLUTIONS is likely to cause consumer confusion with U.S. Trademark Registration No. 2,478,534 for the stylized design trademark ASCENSION

HEALTH for services in International Class 042, and U.S. Trademark Registration No.4,069,046 for the trademark ASCENSION HEALTH for services in International Classes 35, 36, 42 and 44, respectively, where neither registration covers any insurance related services.

14. By way of another example, as noted herein, Applicant is the owner of U.S. Trademark Registration No. 3,608,718 for the mark ASCENSION for use in connection with “Insurance claims auditing services; Insurance lead collection and matching services, namely, matching consumer requests for insurance policy quotes collected over the internet to pre-qualified insurance brokers, agents and agencies interested in those requests; Managing the operations of insurance agencies and brokers on an outsourcing basis; Promotion of financial and insurance services, on behalf of third parties; Providing insurance agent referrals” in International Class 35 and “Brokerage in the field of insurance; Financial evaluation for insurance purposes; Insurance administration; Insurance agencies; Insurance agency and brokerage; Insurance brokerage; Insurance consultation; Insurance services, namely, writing property and casualty insurance; Providing information in insurance matters” in International Class 36.

15. On information and belief, Opposer committed bad acts directed at Applicant with respect to its claims that U.S. Trademark Registration No. 3,608,718 for the trademark ASCENSION is likely to cause confusion with Trademark Registration Nos. 4,234,598 and 4,422,262 for the stylized design trademark CERTITUDE BY ASCENSION HEALTH and ASCENSION HEALTH SMARTHEALTH, respectively, where such marks do cover certain insurance related services but were filed after and claim a date of first use well after Applicant’s priority date of September 15, 2008.

16. On information and belief Petitioner is not a licensed insurer or insurance broker

in any U.S. state.

17. To that end, Applicant's U.S. Trademark Registration No. 3,608,718 for the trademark ASCENSION was cited by the Examining Attorney for Opposer's applications to register ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH as a bar to the registration of both ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH on the basis of a likelihood of confusion.

18. On September 27, 2011, Opposer, through its legal counsel, submitted statements to the Examining Attorney in response to the Examining Attorney's refusal of registration for both ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH that "In addition to the distinct differences in the parties' respective services, the subject marks are visually and conceptually different such that there is no potential for consumer confusion.", "Clearly, the parties' marks are not identical.", "Applicant also wishes to bring to the Examining Attorney's attention the fact that the parties' respective marks have coexisted in the marketplace and on the Federal Register for at least the past four (4) years without any known instances of actual confusion or any citations by the Office of each other's marks.", and "...the fact that the parties' marks have not been cited against each other and the parties have not contested to each other's filings provides persuasive evidence that the Trademark Office and the parties themselves have already taken the position that the respective marks can coexist."

19. Opposer used such statements and others to obtain registration of its applied for marks, ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH.

20. Opposer did not oppose or seek to cancel Applicant's trademark registration for ASCENSION in 2011 and delayed making any allegations that such mark was likely to cause

confusion with U.S. Trademark Registration Nos. 2,478,534, 4,069,046, 4,422,262, and 4,234,598 for more than four years after the ASCENSION mark was published for opposition.

21. For a variety of reasons, including but not limited to those set forth herein, Opposer's Notice of Opposition to U.S. Trademark Serial No. 85/702,989 is barred by the doctrine of unclean hands.

RELIEF REQUESTED

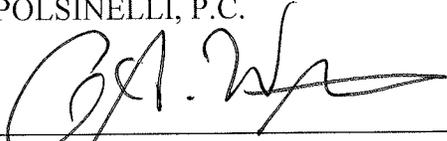
WHEREFORE, Applicant requests that the Notice of Opposition be dismissed.

Respectfully submitted,

Ascension Insurance, Inc.,
Applicant

By: POLSINELLI, P.C.

Dated: October 13, 2014

By: 

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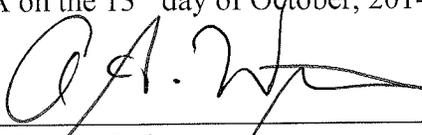
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ATTORNEYS FOR APPLICANT

CERTIFICATE OF ESTTA FILING

I hereby certify that a copy of the foregoing paper was filed electronically with the Trademark Trial and Appeal Board via the ESTTA on the 13th day of October, 2014.

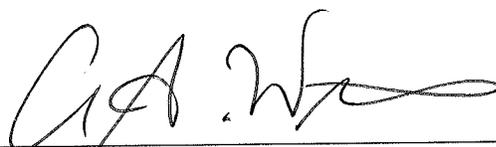


Adam S. Weiss

CERTIFICATE OF MAIL SERVICE

I hereby certify that the foregoing pleading is being deposited with the U.S. Postal Service by First Class Mail on October 13, 2014 in an envelope addressed to:

Jonathan E. Moskin
Foley & Lardner LLP
90 Park Avenue
New York, NY 10016



Adam S. Weiss