

ESTTA Tracking number: **ESTTA593913**

Filing date: **03/21/2014**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Ascension Health Alliance		
Entity	nonprofit corporation	Citizenship	Missouri
Address	101 S. Hanley Road, Suite 450 St. Louis, MO 63105 UNITED STATES		

Attorney information	Jonathan E. Moskin Foley & Lardner LLP 90 Park Avenue New York, NY 10016 UNITED STATES IPdocketing@foley.com, jmoskin@foley.com, ygorbach@foley.com, sschoepfer@foley.com, wwalker@foley.com Phone:2123383572		
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Registrations Subject to Cancellation

Registration No	3595725	Registration date	03/24/2009
Registrant	Ascension Insurance, Inc. 2345 Grand Blvd., Suite 610 Kansas City, MO 64108 USA		

Goods/Services Subject to Cancellation

<p>Class 035. First Use: 2008/11/13 First Use In Commerce: 2008/11/13 All goods and services in the class are cancelled, namely: 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</p>
<p>Class 036. First Use: 2008/11/13 First Use In Commerce: 2008/11/13 All goods and services in the class are cancelled, namely: 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</p>

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)		
Priority and likelihood of confusion	Trademark Act section 2(d)		
Dilution	Trademark Act section 43(c)		
Registration No	3608718	Registration date	04/21/2009
Registrant	Ascension Insurance, Inc.		

	Suite 610 Kansas City, MO 64108 GERMANY
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Goods/Services Subject to Cancellation

<p>Class 035. First Use: 2007/09/17 First Use In Commerce: 2007/09/17 All goods and services in the class are cancelled, namely: 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</p>
<p>Class 036. First Use: 2007/09/17 First Use In Commerce: 2007/09/17 All goods and services in the class are cancelled, namely: 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</p>

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2478534	Application Date	09/23/1999
Registration Date	08/14/2001	Foreign Priority Date	NONE
Word Mark	ASCENSION HEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 1999/09/29 First Use In Commerce: 1999/09/29 [FITNESS CENTERS]</p> <p>Class 042. First use: First Use: 1999/09/29 First Use In Commerce: 1999/09/29 HEALTHCARE SERVICES, NAMELY, PROVIDING HEALTHCARE FACILITIES IN THE NATURE OF HOSPITALS, LONG-TERM CARE FACILITIES, CLINICS, WELLNESS CENTERS, CONGREGATE AND ASSISTED LIVING FACILITIES AND OTHER HEALTHCARE FACILITIES, PROVIDING SERVICES IN THE NATURE OF HOME HEALTH CARE AGENCIES, HOSPICE AGENCIES,</p>		

	MANAGED CARE ORGANIZATIONS, PHYSICIAN AND HOSPITAL ORGANIZATIONS, MANAGED SERVICES ORGANIZATIONS, HEALTH NETWORKS, HEALTH MAINTENANCE ORGANIZATION, AND PREFERRED PROVIDER ORGANIZATIONS, AND PROVIDING OCCUPATIONAL AND PHYSICAL THERAPY AND REHABILITATION SERVICES, PHARMACY SERVICES, DRUG SCREENING, PHYSICAL EXAMINATIONS, NURSING SERVICES, LABORATORY SERVICES, OUTPATIENT SERVICES, FITNESS CENTERS FOR THERAPEUTIC USE, WOMEN'S SERVICES CENTERS, SURGERY SERVICES, SENIOR'S SERVICES, DIABETES DIAGNOSTIC AND TREATMENT SERVICES, ONCOLOGY DIAGNOSTIC AND TREATMENT SERVICES, WOUND CARE, AND EMERGENCY MEDICAL SERVICES
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U.S. Registration No.	4069046	Application Date	03/04/2010
Registration Date	12/13/2011	Foreign Priority Date	NONE

Word Mark	ASCENSION HEALTH
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Management and operation of a health system comprised of hospitals, medical clinics, nursing homes, acute care facilities, long-term care facilities, wellness centers, congregate and assisted living facilities, outpatient surgery centers, urgent care centers, imaging centers, cancer centers, rehabilitation centers, pharmacies, health and physical therapy centers, convalescent centers, heart centers, home healthcare, and hospice care centers; association services, namely, promoting the interests of medical patients and access to and growth of the healthcare industry; promoting public awareness of the transformation of healthcare, access to healthcare coverage for all, healthcare reform, health, disease prevention, health care cost containment, chronic disease management, health care, health care policy, and health care management</p> <p>Class 036. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Providing grants for health awareness projects; providing recognition and incentives by way of grants and other financial support in the field of healthcare; providing recognition and incentives by way of grants and other financial support to promote and encourage the provision of high quality health care to the indigent, the furtherance of patient safety programs, and the furtherance of medical research</p> <p>Class 042. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Providing temporary use of web-based software applications for use in monitoring medical patient safety and patient and medical event recording, tracking and reporting, namely, monitoring patient heart rates, patient falls, facilities, and clinician response times; providing temporary use of web-based software application for use in monitoring medical patient safety, medical</p>
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	<p>personnel, and medical facilities Class 044. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Healthcare services, namely, providing information in the field of healthcare ethics</p>
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U.S. Registration No.	4422262	Application Date	12/23/2010
Registration Date	10/22/2013	Foreign Priority Date	NONE
Word Mark	ASCENSION HEALTH SMARTHEALTH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2011/01/11 First Use In Commerce: 2011/01/11 Services in the field of group healthcare and medical insurance benefits for employees, namely, providing insurance coverage services, namely, insurance underwriting in the field of health and insurance administration		

U.S. Registration No.	4234598	Application Date	01/13/2011
Registration Date	10/30/2012	Foreign Priority Date	NONE
Word Mark	CERTITUDE BY ASCENSION HEALTH		
Design Mark			
Description of Mark	The mark consists of a stylized plus sign in fuchsia to the left of the wording "CERTITUDE by ASCENSION HEALTH" in darkpurple/blue.		
Goods/Services	Class 036. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 Professional liability insurance services, namely, insurance underwriting in the field of professional liability, administration, carrier selection, claims adjustment, claims management, namely, insurance claims administration, claims processing, consultation services, rating services, and collection; insurance underwriting in the field of professional liability; insurance administration;		

	insurance placement, namely, providing insurance for physicians and related medical professionals, namely, providing insurance brokerage services; insurance claims administration services; insurance risk/loss prevention services, namely, insurancerisk management services and insurance loss control management services
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Attachments	75806856#TMSN.gif(bytes) 77950779#TMSN.jpeg(bytes) 85204970#TMSN.jpeg(bytes) 85217123#TMSN.jpeg(bytes) Petition for Cancellation_Reg. No. 3595725.pdf(16601 bytes) Petition for Cancellation_Reg. No. 3608718.pdf(16481 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jonathan E. Moskin/
Name	Jonathan E. Moskin
Date	03/21/2014

4. Ascension operates 113 wholly-owned and 18 additional jointly owned hospitals in 24 states and the District of Columbia. It employs more than 150,000 associates serving in more than 1,900 locations.

5. Ascension's core services include managed care organizations, health maintenance organizations, preferred provider organizations, insurance services and numerous other financial services.

6. Ascension, directly and through its wholly owned subsidiaries, also provides general liability and professional liability insurance services to its members and affiliates and health insurance services to the general market under the trademark and trade name ASCENSION.

7. Ascension is the sole owner of several trademark registrations and applications covering the mark ASCENSION, alone, in composite form and in stylized form ("ASCENSION Marks") for use with a wide range of health care services, as well as related financial and insurance services.

8. Ascension's ASCENSION Marks include valid, unrevoked and uncanceled registrations for 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).

9. Since 1999, long before the November 13, 2008 claimed date of first use of the subject mark or the August 20, 2007 date of constructive first use of the subject mark, Ascension has continuously used its ASCENSION name and marks in connection with health care and related financial services including PPO and HMO insurance services.

10. In addition, since at least 2000 and about seven years prior to the claimed date of first use of the subject mark, Ascension, directly and through its wholly subsidiaries, has provided general liability and professional liability insurance services under the trademark and trade name ASCENSION.

11. As a result of Ascension's long and successful use of the name ASCENSION and the ASCENSION Marks, consumers have come to recognize the name ASCENSION and Ascension's health care and related financial and insurance services offered under the name ASCENSION and the ASCENSION Marks as identifying Ascension as the sole source of the name ASCENSION and the ASCENSION Marks, and as distinguishing them from the health care and related financial and insurance services offered by other providers.

12. As a result of Ascension's great success in marketing health care and insurance services under the name ASCENSION, Ascension's name and mark has become sufficiently well-recognized to be deemed a famous mark.

13. On or about March 24, 2009, Respondent obtained Registration No. 3,595,725 for the mark ASCENSION INSURANCE, INC. for a range of insurance brokerage related services in International Classes 35 and 36.

14. Among these services, Respondent offers health care, student health care and malpractice coverage for health care professionals, which compete with Petitioners' services.

15. Ascension has been, and will continue to be, damaged by Registration No. 3,595,725 because such Registration provides Registrant with at least prima facie evidence of its exclusive right to use the subject mark. Such evidence will support and assist Registrant in the confusing and misleading use of the subject mark, and will give color of exclusive statutory rights to Registrant in violation and derogation of the prior and superior rights of Ascension.

16. Registration No. 3,595,725 should be cancelled pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Registrant's use of the subject mark falsely suggests a connection between Registrant and Ascension, to the damage of Ascension.

17. Registration No. 3,595,725 should be cancelled pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Registrant's subject mark so resembles the dominant portion of the ASCENSION Marks and the ASCENSION name used consistently by Ascension in the United States, as to be likely, when used in connection with the registered services, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Ascension and to the public.

18. Registration No. 3,595,725 should be canceled under Sections 2 and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052 and 1125(c), on the grounds that Registrant's use of the subject mark will dilute the distinctive and famous quality of Ascension's ASCENSION Marks.

WHEREFORE, Ascension respectfully requests that the Registration No. 3,595,725 be canceled in its entirety.

The required fee of \$300 per Class is being submitted herewith. Please charge any additional costs to our Deposit Account No. 19-0741. All communication should be addressed to Petitioner's counsel, Foley & Lardner LLP, at the below stated address.

Dated: New York, New York
March 21, 2014

Respectfully submitted,
FOLEY & LARDNER LLP

By: /Jonathan E. Moskin/
Jonathan E. Moskin, Esq.
Janina Gorbach, Esq.
90 Park Avenue
New York, NY 10016-1314
Tel.: (212) 338-3572
Fax: (212) 687-2329

Attorneys for Petitioner
Ascension Health Alliance

CERTIFICATE OF SERVICE

I hereby certify that on the 21st day of March, 2014 a true and complete copy of the foregoing **PETITION FOR CANCELLATION** was served by first-class mail to the Registrant as follows:

Anita Larson, Esq.
Senior Counsel
Ascension Insurance, Inc.
2345 Grand Blvd., Suite 610
Kansas City, MO 64108

/s/ Jonathan E. Moskin
Jonathan E. Moskin, Esq.

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

In the Matter of Registration No. 3,608,718
Registered April 21, 2009
Mark: ASCENSION

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ASCENSION HEALTH ALLIANCE,	:	
	:	
Petitioner,	:	
	:	
-against-	:	Cancellation No. _____
	:	
ASCENSION INSURANCE, INC.,	:	PETITION FOR CANCELLATION
	:	
Respondent.	:	
-----	X	

TO THE COMMISSION FOR TRADEMARKS:

Petitioner, Ascension Health Alliance, believes it is being and will continue to be, damaged by the existence of Registration No. 3,608,718 for the Mark ASCENSION and hereby petitions for cancellation of the same pursuant to Section 14 of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1064.

As grounds for cancellation, Petitioner alleges that:

1. Petitioner Ascension Health Alliance ("Ascension") is a nonprofit corporation duly organized and existing under the laws of the State of Missouri, with its executive offices at 101 S. Hanley Road, Suite 450, St. Louis, Missouri 63105.
2. Registrant Ascension Insurance, Inc. ("Registrant") is, upon information and belief, a company duly organized and existing under the laws of the State of Delaware, with its principal place of business at 2345 Grand Blvd., Suite 610, Kansas City, Missouri 64108.
3. Ascension is the country's largest Catholic and non-profit health system and is the third-largest system overall in the United States, based on revenues.

4. Ascension operates 113 wholly-owned and 18 additional jointly owned hospitals in 24 states and the District of Columbia. It employs more than 150,000 associates serving in more than 1,900 locations.

5. Ascension's core services include managed care organizations, health maintenance organizations, preferred provider organizations, insurance services and numerous other financial services.

6. Ascension, directly and through its wholly owned subsidiaries, also provides general liability and professional liability insurance services to its members and affiliates and health insurance services to the general market under the trademark and trade name ASCENSION.

7. Ascension is the sole owner of several trademark registrations and applications covering the mark ASCENSION, alone, in composite form and in stylized form ("ASCENSION Marks") for use with a wide range of health care services, as well as related financial and insurance services.

8. Ascension's ASCENSION Marks include valid, unrevoked and uncanceled registrations for 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).

9. Since 1999, long before the September 17, 2007 claimed date of first use of the subject mark, Ascension has continuously used its ASCENSION name and marks in connection with health care and related financial services including PPO and HMO insurance services.

10. In addition, since at least 2000 and about seven years prior to the claimed date of first use of the subject mark, Ascension, directly and through its wholly subsidiaries, has provided general liability and professional liability insurance services under the trademark and trade name ASCENSION.

11. As a result of Ascension's long and successful use of the name ASCENSION and the ASCENSION Marks, consumers have come to recognize the name ASCENSION and Ascension's health care and related financial and insurance services offered under the name ASCENSION and the ASCENSION Marks as identifying Ascension as the sole source of the name ASCENSION and the ASCENSION Marks, and as distinguishing them from the health care and related financial and insurance services offered by other providers.

12. As a result of Ascension's great success in marketing health care and insurance services under the name ASCENSION, Ascension's name and mark has become sufficiently well-recognized to be deemed a famous mark.

13. On or about April 21, 2009, Respondent obtained Registration No. 3,608,718 for the mark ASCENSION for a range of insurance brokerage related services in International Classes 35 and 36.

14. Among these services, Respondent offers health care, student health care and malpractice coverage for health care professionals, which compete with Petitioners' services.

15. Ascension has been, and will continue to be, damaged by Registration No. 3,608,718 because such Registration provides Registrant with at least prima facie evidence of its exclusive right to use the subject mark. Such evidence will support and assist Registrant in the confusing and misleading use of the subject mark, and will give color of exclusive statutory rights to Registrant in violation and derogation of the prior and superior rights of Ascension.

16. Registration No. 3,608,718 should be cancelled pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Registrant's use of the subject mark falsely suggests a connection between Registrant and Ascension, to the damage of Ascension.

17. Registration No. 3,608,718 should be cancelled pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Registrant's subject mark so resembles the dominant portion of the ASCENSION Marks and the ASCENSION name used consistently by Ascension in the United States, as to be likely, when used in connection with the registered services, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Ascension and to the public.

18. Registration No. 3,608,718 should be canceled under Sections 2 and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052 and 1125(c), on the grounds that Registrant's use of the subject mark will dilute the distinctive and famous quality of Ascension's ASCENSION Marks.

WHEREFORE, Ascension respectfully requests that the Registration No. 3,608,718 be canceled in its entirety.

The required fee of \$300 per Class is being submitted herewith. Please charge any additional costs to our Deposit Account No. 19-0741. All communication should be addressed to Petitioner's counsel, Foley & Lardner LLP, at the below stated address.

Dated: New York, New York
March 21, 2014

Respectfully submitted,
FOLEY & LARDNER LLP

By: /Jonathan E. Moskin/
Jonathan E. Moskin, Esq.
Janina Gorbach, Esq.
90 Park Avenue
New York, NY 10016-1314
Tel.: (212) 338-3572
Fax: (212) 687-2329

Attorneys for Petitioner
Ascension Health Alliance

CERTIFICATE OF SERVICE

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Anita Larson, Esq.
Senior Counsel
Ascension Insurance, Inc.
2345 Grand Blvd., Suite 610
Kansas City, MO 64108

/s/ Jonathan E. Moskin
Jonathan E. Moskin, Esq.