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Filing date: **07/02/2014**

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

Proceeding	92058897
Party	Defendant Ascension Insurance, Inc.
Correspondence Address	ASCENSION INSURANCE INC 2345 GRAND BLVD SUITE 610 KANSAS CITY, MO 64108 UNITED STATES uspt@polsinelli.com, jkass@polsinelli.com, lswain@polsinelli.com
Submission	Answer
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Signature	/Karin E. Sullivan/
Date	07/02/2014
Attachments	Answers to Petition for Cancellation.pdf(2491180 bytes)

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

Registration Number: 3,595,725
Mark: ASCENSION INSURANCE, INC.
Registration Date: March 24, 2009

ASCENSION HEALTH ALLIANCE,)	
)	
Petitioner,)	
)	
vs.)	Cancellation No. 92058897
)	
ASCENSION INSURANCE, INC.)	
)	
Registrant.)	

ANSWER TO PETITION FOR CANCELLATION

Ascension Insurance, Inc. (“Registrant”), by and through its attorneys, answers Ascension Health Alliance’s (“Petitioner”) Petition for Cancellation of Trademark Registration No. 3,595,725, as follows:

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

truth of the allegations contained in paragraph 4 of the Petition for Cancellation, except admits that Petitioner operates hospitals.

5. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Petition for Cancellation, and therefore denies the same.

6. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Petition for Cancellation, and therefore denies the same.

7. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7 of the Petition for Cancellation, and therefore denies the same.

8. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 8 of the Petition for Cancellation, and therefore denies the same, except admits that Petitioner 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. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 9 of the Petition for Cancellation, and therefore denies the same.

10. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 10 of the Petition for Cancellation, and therefore denies the same.

11. Registrant denies the allegations contained in paragraph 11 of the Petition for

Cancellation.

12. Registrant denies the allegations contained in paragraph 12 of the Petition for Cancellation.

13. Registrant admits that on March 24, 2009 Registrant was issued Registration No. 3,595,725 for the mark ASCENSION INSURANCE, INC. 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.

14. Registrant 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. Registrant denies the remaining allegations in paragraph 14 of the Petition for Cancellation.

15. Registrant admits that Registration No. 3,595,725 provides Registrant with prima facie evidence of Registrant’s exclusive right to use the ASCENSION INSURANCE, INC. mark in connection with the services identified in the trademark registration. Registrant

denies the remaining allegations in paragraph 15 of the Petition for Cancellation.

16. Registrant denies the allegations contained in paragraph 16 of the Petition for Cancellation.

17. Registrant denies the allegations contained in paragraph 17 of the Petition for Cancellation.

18. Registrant denies the allegations contained in paragraph 18 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

LACHES, WAIVER & ESTOPPEL

1. Registrant's U.S. Trademark Application Serial No. 77/259,694 for registration of the mark ASCENSION INSURANCE, INC. was published for opposition in the Official Gazette on February 19, 2008.

2. Petitioner did not file a Notice of Opposition against registration of the mark ASCENSION INSURANCE, INC. as applied for in U.S. Trademark Application Serial No. 77/259,694.

3. Registrant's U.S. Trademark Application Serial No. 77/259,694 matured to U.S. Trademark Registration No. 3,595,725 on March 24, 2009.

4. Registrant's U.S. Trademark Registration No. 3,595,725 for ASCENSION INSURANCE, INC. was cited by a U.S.P.T.O. Examining Attorney as a potential bar to Petitioner's registration of the marks ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH on March 29, 2011.

5. Petitioner filed its Petition for Cancellation of U.S. Trademark Registration No.

3,595,725 on March 21, 2014 which was only three days before the deadline to file a Petition for Cancellation against U.S. Trademark Registration No. 3,595,725.

6. Registrant has invested significant time, money and company assets into the services it offers and sells under the ASCENSION INSURANCE, INC. mark and has developed valuable goodwill in the ASCENSION INSURANCE, INC. mark during the period of Petitioner's silence for over five years from February 19, 2008 until October 31, 2013.

7. Petitioner unreasonably delayed its assertion of rights against Registrant and such delay has caused material prejudice to Registrant.

8. Petitioner's claim for cancellation of U.S. Trademark Registration No. 3,595,725 is barred by the doctrines of laches, waiver and estoppel.

ABANDONMENT

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

10. Petitioner 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

11. On information and belief, Petitioner committed bad acts directed at Registrant with respect to its claims that U.S. Trademark Registration No. 3,595,725 for the trademark ASCENSION INSURANCE, INC. for "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 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.

12. On information and belief, Petitioner committed bad acts directed at Registrant with respect to its claims that U.S. Trademark Registration No. 3,595,725 for the trademark ASCENSION INSURANCE, INC. 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 Registrant’s priority date of August 20, 2007.

13. On information and belief Petitioner is not a licensed insurer or insurance broker in any U.S. state.

14. Registrant’s U.S. Trademark Registration No. 3,595,725 for the trademark

ASCENSION INSURANCE, INC. was cited by the Examining Attorney for Petitioner'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.

15. On September 27, 2011, Petitioner, 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."

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

17. Petitioner did not oppose or seek to cancel Registrant's trademark registration for ASCENSION INSURANCE, INC. 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 five years after the ASCENSION INSURANCE, INC. mark was published for opposition.

18. Petitioner's claim for cancellation of U.S. Trademark Registration No. 3,595,725 is barred by the doctrine of unclean hands.

RELIEF REQUESTED

WHEREFORE, Registrant requests that the Petition for Cancellation be dismissed.

Respectfully submitted,

Ascension Insurance, Inc.,
Registrant

Dated: July 2, 2014

By: POLSINELLI, P.C.

By: *Karin E Sullivan*

Jeffrey Kass

Larry Swain

Karin E. Sullivan

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ATTORNEYS FOR REGISTRANT

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 2nd day of July, 2014.



Karin E. Sullivan
Karin E. Sullivan

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 July 2, 2014 in an envelope addressed to:

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



Karin E. Sullivan
Karin E. Sullivan

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

Registration Number: 3,608,718
Mark: ASCENSION
Registration Date: April 21, 2009

ASCENSION HEALTH ALLIANCE,)	
)	
Petitioner,)	
)	
vs.)	Cancellation No. 92058897
)	
ASCENSION INSURANCE, INC.)	
)	
Registrant.)	

ANSWER TO PETITION FOR CANCELLATION

Ascension Insurance, Inc. (“Registrant”), by and through its attorneys, answers Ascension Health Alliance’s (“Petitioner”) Petition for Cancellation of Trademark Registration No. 3,608,718, as follows:

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

truth of the allegations contained in paragraph 4 of the Petition for Cancellation, except admits that Petitioner operates hospitals.

5. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Petition for Cancellation, and therefore denies the same.

6. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Petition for Cancellation, and therefore denies the same.

7. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 7 of the Petition for Cancellation, and therefore denies the same.

8. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 8 of the Petition for Cancellation, and therefore denies the same, except admits that Petitioner 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. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 9 of the Petition for Cancellation, and therefore denies the same.

10. Registrant denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 10 of the Petition for Cancellation, and therefore denies the same.

11. Registrant denies the allegations contained in paragraph 11 of the Petition for

Cancellation.

12. Registrant denies the allegations contained in paragraph 12 of the Petition for Cancellation.

13. Registrant admits that on April 21, 2009 Registrant was issued 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.

14. Registrant 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. Registrant denies the remaining allegations in paragraph 14 of the Petition for Cancellation.

15. Registrant admits that Registration No. 3,608,718 provides Registrant with *prima facie* evidence of Registrant’s exclusive right to use the ASCENSION mark in connection with the services identified in the trademark registration. Registrant denies the remaining allegations in paragraph 15 of the Petition for Cancellation.

16. Registrant denies the allegations contained in paragraph 16 of the Petition for Cancellation.

17. Registrant denies the allegations contained in paragraph 17 of the Petition for Cancellation.

18. Registrant denies the allegations contained in paragraph 18 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

LACHES, WAIVER & ESTOPPEL

1. Registrant's U.S. Trademark Application Serial No. 77/569,627 for registration of the mark ASCENSION was published for opposition in the Official Gazette on February 3, 2009.

2. Petitioner 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.

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

4. Registrant'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 Petitioner's registration of the marks ASCENSION HEALTH SMARTHEALTH and CERTITUDE BY ASCENSION HEALTH on March 29, 2011.

5. Petitioner filed its Petition for Cancellation of U.S. Trademark Registration No. 3,608,718 on March 21, 2014 which was only one month before the deadline to file a Petition for Cancellation against U.S. Trademark Registration No. 3,608,718.

6. Registrant 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 Petitioner's silence for over four years from February 3, 2009 until October 31, 2013.

7. Petitioner unreasonably delayed its assertion of rights against Registrant and such delay has caused material prejudice to Registrant.

8. Petitioner's claim for cancellation of U.S. Trademark Registration No. 3,608,718 is barred by the doctrines of laches, waiver and estoppel.

ABANDONMENT

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

10. Petitioner 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

11. On information and belief, Petitioner committed bad acts directed at Registrant with respect to its claims that U.S. Trademark Registration No. 3,608,718 for the trademark ASCENSION for "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 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.

12. On information and belief, Petitioner committed bad acts directed at Registrant 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 Registrant’s priority date of September 15, 2008.

13. On information and belief Petitioner is not a licensed insurer or insurance broker in any U.S. state.

14. Registrant’s U.S. Trademark Registration No. 3,608,718 for the trademark ASCENSION was cited by the Examining Attorney for Petitioner’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.

15. On September 27, 2011, Petitioner, 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."

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

17. Petitioner did not oppose or seek to cancel Registrant'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.

18. Petitioner's claim for cancellation of U.S. Trademark Registration No. 3,608,718 is barred by the doctrine of unclean hands.

RELIEF REQUESTED

WHEREFORE, Registrant requests that the Petition for Cancellation be dismissed.

Respectfully submitted,

Ascension Insurance, Inc.,
Registrant

By: POLSINELLI, P.C.

Dated: July 2, 2014

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ATTORNEYS FOR REGISTRANT

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 2nd day of July, 2014.



Karin E. Sullivan

CERTIFICATE OF MAIL SERVICE

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



Karin E. Sullivan