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

Proceeding	92059301
Party	Plaintiff Grange Insurance Association
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IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE BEFORE THE TRADEMARK
TRIAL AND APPEAL BOARD

In re Registration Nos. 3,821,201 and 3,723,315

For the mark: GRANGE INSURANCE and GRANGE INSURANCE and Design

Grange Insurance Association,

Petitioner,

vs.

Grange Mutual Casualty Company,

Respondent.

PETITION FOR CANCELLATION

Cancellation No. 92059301

RESPONSE TO MOTION TO AMEND THE ANSWER

Petitioner Grange Insurance Association (“GIA”) does not oppose Respondent Grange Mutual Casualty Company’s (“GMCC”) Motion to Amend the Answer. GMCC’s motion, however, also submits argument on collateral issues of standing, res judicata, and estoppel based on GMCC’s interpretations of the allegations in GIA’s petition. GIA therefore offers this response to rebut those interpretations and remove all doubt as to GIA’s allegations. Further, to the extent the Board deems that GMCC’s interpretations of the allegations have any merit, GIA respectfully requests pursuant to the Trademark Trial and Appeal Board Manual of Procedure 315 and Federal Rules of Civil Procedure 15(a)(1)(2) that the Board grant leave to amend the Petition to Cancel.

ARGUMENTS

Each of GMCC’s affirmative defenses is predicated on the conclusion that the refusal to register “THE DAWNING OF A NEW GRANGE GRANGE INSURANCE GROUP” (Serial Number 76/272,754) in 2003 precludes GIA from petitioning to cancel GMCC’s “GRANGE

INSURANCE” marks (Reg. Nos. 3,821,201 and 3,723,315). GMCC Motion at 2-3 (citing *In re Grange Ins. Ass'n*, 2003 TTAB LEXIS 555 (Trademark Trial & App. Bd. Nov. 25, 2003) (the “2003 Decision”). As explained further below, that premise misreads both the law and the facts alleged in GIA’s Petition. The 2003 Decision considered different marks (most now dead) for a different purpose and in the context of different facts. And to the extent GMCC seeks to amend its answer based on the newly discovered fact of the 2003 Decision, GIA does so as well, based on recently discovered evidence (already provided to GMCC) that supports GIA’s common law rights in the term GRANGE as early as 1895, nearly four decades before GMCC’s alleged first use of the term in connection with insurance services.

I. STANDING

GMCC questions whether GIA has standing to petition to cancel GMCC’s “GRANGE INSURANCE” marks because the Board affirmed the Examiner’s refusal to register “THE DAWNING OF A NEW GRANGE GRANGE INSURANCE GROUP.” GMCC Motion at 5. The apparent reasoning is that if GIA could not register the “DAWNING OF A NEW GRANGE” mark in 2003, there is no harm to GIA in denying registration of “GRANGE INSURANCE ASSOCIATION” today. But neither the factual basis for GIA’s standing nor the statute support that conclusion.

GIA alleged the Examiner’s refusal to register GRANGE INSURANCE ASSOCIATION as one of the bases for its Petition. *See* Petition at ¶ 6. But GMCC contends that GIA cannot be injured by the registration of GMCC’s GRANGE INSURANCE marks because GIA’s “DAWNING OF A NEW GRANGE” mark was already refused (though three of the four marks cited in that refusal are now dead).¹ GMCC Motion at 5. GMCC is welcome to argue that the

¹ U.S. Reg. Nos. 1604932; 1663622; 1636326 (cancelled 25 November 2013).

remaining live GRANGE INSURANCE mark will bar GIA's new registration, but that does not eliminate GIA's standing; to the contrary, it confirms GIA's standing—this a different controversy addressing different marks for a different purpose. The Board has now before it a petition to cancel GMCC's marks, not an application to register GIA's mark (as in the 2003 Decision). And even if those two controversies were identical, which they are not, the Board has yet to decide, as GMCC has presumed, that "GRANGE INSURANCE ASSOCIATION" and the "THE DAWNING OF A NEW GRANGE GRANGE INSURANCE GROUP" are "the same mark." To the extent GMCC wants to argue that point, that establishes a distinct basis for harm that gives GIA standing.

But the Examiner's refusal to register GRANGE INSURANCE ASSOCIATION is not the only basis for GIA's standing. The statute does not limit standing to harms resulting strictly from of a party's inability to register a trademark; a party need only believe it is harmed by another party's registration: "A petition to cancel a registration of a mark ... may ... be filed by any person who believes that he [or she] is or will be damaged by registration of a mark ..." 15 U.S.C. Sec. 1064. Thus, standing lies simply where the petitioner can establish a real interest in the proceeding. *See Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA, 1982). Standing certainly lies to petition to cancel a mark cited against a party's application, but that is not the only way to establish standing.

GIA has already alleged facts entirely distinct from the registration of its GRANGE INSURANCE ASSOCIATION mark that give GIA standing. GIA has common law rights in the name GRANGE itself against which GMCC seeks to enforce rights afforded by the federal registrations GIA seeks to cancel. In an attempt to circumvent this alternative grounds for standing, GMCC contends that GIA "has not...alleged priority in the mark GRANGE standing alone." GMCC Motion at 2. To the contrary, Petitioner has alleged precisely that:

- “Since at least as early as 1936, Petitioner has adopted and used the mark **GRANGE** (with variations in additional wording or designs) in connection with insurance services in the US, and since at least as early as 1943, Petitioner has adopted and used the mark GRANGE INSURANCE ASSOCIATION in connection with insurance services in the US. Petitioner has US common law rights in the **GRANGE** and GRANGE INSURANCE ASSOCIATION marks based on such use.” *See Petition to Cancel* (“Petition”) ¶ 3 (emphasis added).
- “...Petitioner has priority of rights in the GRANGE INSURANCE ASSOCIATION mark based upon long-standing common law use of the **GRANGE** and GRANGE INSURANCE ASSOCIATION marks (and variations) in connection with insurance services in the US.” *Petition* ¶ 8 (emphasis added).
- “Petitioner has expended considerable time, effort, and expense in promoting, advertising, and offering the insurance services under its **GRANGE** and GRANGE INSURANCE ASSOCIATION marks...” *Petition* ¶ 9 (emphasis added).

Accordingly, GIA petitioned to cancel GMCC’s federal registrations because they injure GIA’s common law rights:

“The clear visual and phonetic similarities between the marks in question, as well as the close similarities between the services and customers offered and targeted by the respective marks has resulted in the relevant public mistakenly believing that Respondent’s services under the GRANGE INSURANCE marks are sponsored, endorsed, or approved by Petitioner, or are in some way affiliated, connected, or associated with Petitioner all to the detriment of Petitioner.” *Petition* ¶ 14.

This allegation reflects the harm presented by GMCC’s recent efforts to enforce its federal registrations in territories where GIA has long operated under its GRANGE marks. *See* Letter from Cory M. Amron, representative of Grange Mutual Casualty Company and its affiliates, to Arrow Head Insurance Company, (Feb. 4, 2014) (“cease and desist letter”) attached hereto as **Exhibit A**. And more to the point, that harm is entirely independent of whether GIA is able to register GRANGE INSURANCE ASSOCIATION, establishing a real interest in cancellation and thus standing. *See Boi Na Braza, LLC., v. Terra Sul Corporation a/k/a Churrascaria Boi Na Brasa*, Concurrent Use No. 94002525 (TTAB, 2014) (finding petitioner’s common law rights were

sufficient to establish a real interest in cancelling respondent's registration in the underlying cancellation proceeding).

II. Res Judicata (Claim Preclusion)

GMCC's argument that *res judicata* bars GIA's cancellation is similarly flawed. *Polaroid*, on which GMCC relies, rejected the *res judicata* defense and supports rejecting it again here. *Polaroid Corp. v. C&E Vision Services, Inc., C&E Vision Services, Inc.*, 52 U.S.P.Q.2d 1954 *3 (1999) [not precedential]. Like GMCC here, *Polaroid* argued that the prior refusal to register POLAREX barred the applicant's subsequent registration for POLAREX TUFF, POLAREX LITE, POLAREX PRO, and POLAREX itself under the doctrines of *res judicata* and collateral estoppel. *Id.* at *1. The Board, however, found that the prior POLAREX mark and the subsequent POLAREX marks were too different for the doctrines of *res judicata* and collateral estoppel to apply. *Id.* Looking at the marks in the broader context of their design elements and overall commercial impression, the Board found that the claims in the prior proceeding were simply not the same as those asserted in the subsequent proceeding. *Id.* at 4.

Likewise, GIA's previously refused tagline THE DAWNING OF A NEW GRANGE GRANGE INSURANCE GROUP (Serial No. 76/272,754) is fundamentally different from the present GRANGE INSURANCE ASSOCIATION (**and design**) mark. As in *Polaroid*, the new mark includes a distinct design element giving a fundamentally different commercial impression that the prior tagline word mark. Accordingly, *Polaroid* mandates rejecting the *res judicata* and collateral estoppel defenses.

III. Collateral Estoppel (Issue Preclusion)

The basis for applying collateral estoppel to GIA's petition is even more remote than that for *res judicata*. In addition to the reasons given above why *res judicata* does not apply, the

procedural posture of this proceeding bars the application of collateral estoppel. Collateral estoppel requires, among other things, that the identical issue was actually litigated in the prior proceeding. See *In re Kent G. Anderson*, 2012 WL 680264 (2012) (as cited by GMCC); *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ____ (2015). The issue in the 2003 Decision was whether GIA’s “THE DAWNING OF A NEW GRANGE GRANGE INSURANCE GROUP” tagline was registrable given GMCC’s then existing marks. In contrast, the issue now before the Board is whether two of GMCC’s marks should be canceled based on GIA’s prior common law rights. That issue is distinct because it can be decided irrespective of whether GIA’s GRANGE INSURANCE ASSOCIATION mark (a different mark than GIA’s tagline) is ultimately registrable.²

The Supreme Court’s recent decision in *B&B Hardware* similarly precludes application of collateral estoppel. *B&B Hardware, Inc.*, 575 U.S. ____ (2015). Justice Ginsburg’s concurrence flagged precisely the flaw in GMCC’s argument, namely, that the 2003 Decision made its determination regarding potential confusion in the abstract. Issue preclusion does not apply where the previous TTAB ruling was “decided upon ‘a comparison of the marks in the abstract and apart from their marketplace usage.’” *Id.* at 1 (Ginsburg, J., concurring). Accordingly, collateral estoppel does not apply.

IV. CONCLUSION

As explained above, GIA submits the above argument in response to those made by GMCC but does not otherwise oppose GMCC’s motion to amend per se. If, however, the Board grants

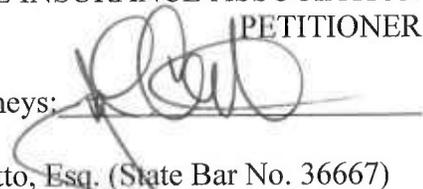
² Because the issue for the Board to decide is new, GMCC’s discussion of collateral estoppel between *inter partes* and *ex parte* proceedings is moot. Still, GIA notes that in *Gruen Industries v. Ray Curran & Co.*, 152 U.S.P.Q., 778 (T.T.A.B. 1967), the Board, considering a petition to cancel, responded to the argument that the examiner considered the same set of facts as those before the Board, by stating “[i]rrespective of whether or not there is any new or additional evidence that was before the examiner, any *ex parte* ruling has no binding effect in an *inter partes* proceeding since Section 17 of the Act directs the Board to determine the respective rights of the parties.”

GMCC's motion on the basis that the allegations in GIA's Petition are insufficient or unclear, GIA requests that the Board enter an order allowing GIA to amend its Petition to Cancel accordingly.

Respectfully Submitted,

GRANGE INSURANCE ASSOCIATION
PETITIONER

By its attorneys:



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EXHIBIT A

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September 3, 2014

VIA FEDERAL EXPRESS

Arrow Head Insurance Agency
3508 Dale Road
Modesto, CA 95356-0504

Re: Unauthorized use of GRANGE trademark
Our Ref. No.: 06307-000019

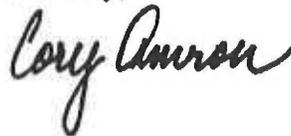
Dear Sir or Madam:

As you are aware, this firm represents Grange Mutual Casualty Company and its affiliates (collectively, "Grange") in intellectual property matters. This is to follow up our correspondence of February 4, 2014. A copy of which is enclosed for your convenience.

As you are also aware, Yahoo has removed the offending ad/listing containing our client's mark which was mentioned in our letter. We have monitored this page and determined that it remains down.

We trust that you will not use the Grange mark in the future. However, this letter is without prejudice to our client's right to take whatever further steps it deems necessary in order to protect its rights.

Sincerely,



Cory M. Amron

CMA/pak

Enclosure



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February 4, 2014

VIA FEDERAL EXPRESS

Arrow Head Insurance Agency
3508 Dale Road
Modesto, CA 95356-0504

Re: Unauthorized use of GRANGE trademark
Our Ref. No.: 06307-000019

Dear Sir or Madam:

This firm represents Grange Mutual Casualty Company and its affiliates (collectively, "Grange") in intellectual property matters. Grange is the owner of federal registrations for various GRANGE and GRANGE INSURANCE marks, including U.S. Reg. Nos. 1,535,724; 3,821,201; 3,821,202; 3,723,315; 3,723,316; and others (collectively, the "Grange Mark").

Grange is a billion-dollar plus insurance provider headquartered in Columbus, Ohio. Grange provides auto, home, business, and life insurance through its network of independent insurance agents. Our client has invested substantial time and resources in building the goodwill embodied in the Grange Mark, which has been in use since 1935. As a result of our client's prior and continuous use of the Grange Mark for more than 75 years, our client has exclusive rights in the Grange Mark in connection with insurance services.

It has recently come to our attention that Arrow Head Insurance Agency ("Arrowhead") is using the name GRANGE in connection with its location at 3508 Dale Road, Modesto, CA (see attached advertisement). The telephone number of this location is the same as what we assume was your prior location around the corner at 2937 Veneman Avenue, Modesto, CA.

Our client objects to your company's use of the Grange Mark as the name of your agency and in advertising and promotional material. This use is misleading, likely to cause confusion, trades on our client's goodwill and violates its legal rights. This unauthorized use of the Grange Mark constitutes, inter alia, trademark infringement under 15 U.S.C. § 1114 et seq.; unfair competition under 15 U.S.C. § 1125(a); and trademark dilution under 15 U.S.C. § 1125(c).

VORYS

Legal Counsel

Arrow Head Insurance Agency

February 4, 2014

Page 2

Our client must protect and enforce its intellectual property rights to prevent the unauthorized use of its marks and ensure that others do not use marks likely to cause confusion with or infringe its marks. Accordingly, we demand that you *immediately* cease and desist from any further use of the Grange Mark or any confusingly similar marks and notify Yahoo to remove the offending ad/listing. We have already reported this violation to Yahoo.

We request a written response by **February 18, 2014** regarding your company's intentions in this matter. This letter, however, is without prejudice to our client's right to take whatever further steps it deems necessary in order to protect its rights.

Sincerely,



Cory M. Amron

CMA/TMC/pak

Enclosure

Arrow Head Insurance Agency
February 4, 2014
Page 3

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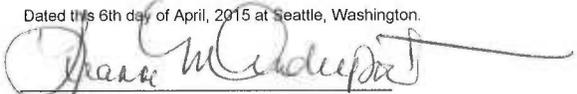
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STATE OF WASHINGTON) CERTIFICATE
COUNTY OF KING) ss OF SERVICE

The undersigned, under penalty of perjury, states that on April 6, 2015, I caused to be delivered via Facsimile to the attorneys of record of all parties, a copy of the document to which this certificate is attached.

Dated this 6th day of April, 2015 at Seattle, Washington.



Leanne M. Andrepont