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

Proceeding	91205010
Party	Defendant E-Insure Services, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ESURANCE INSURANCE SERVICES, INC.)))	Opposition No. 91205010
Opposer,)	
v.)	Appl'n Serial No. 77/982,409
)	Mark: EINSURANCE.COM
E-INSURE SERVICES, INC.,)	Published: January 3, 2012
Applicant.)))	

ANSWER TO AMENDED NOTICE OF OPPOSITION

Applicant, E-Insure Services, Inc. (“Applicant”), by and through its undersigned counsel, hereby answers the Amended Notice of Opposition filed by Esurance Insurance Services, Inc. (“Opposer”) in the above-identified proceeding, as set forth below. The paragraph numbers herein correspondence to the paragraph numbers of the Amended Notice of Opposition.

The first paragraph of the Amended Notice of Opposition is an introductory paragraph to which no responsive pleading is required. To the extent that a response is deemed necessary, Applicant denies that Opposer will be damaged by registration of the trademark EINSURANCE.COM as set forth in Application Serial No. 77/982,409 (“the ‘409 application”).

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 of the Amended Notice of Opposition and, therefore, denies the same.

2. Applicant admits that, pursuant to the records of the United States Patent and Trademark Office, Esurance Insurance Services, Inc. is the owner or assignee of trademark Registrations Nos. 2,673,515, 2,708,357, 2,854,154, 4,129,240, 4,129,241, and 4,129,242.

Applicant further admits that the aforementioned Registrations identify various services in the

field of insurance, as specifically set forth therein. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 2 of the Amended Notice of Opposition and, therefore, denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 3 of the Amended Notice of Opposition and, therefore, denies the same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 4 of the Amended Notice of Opposition and, therefore, denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 5 of the Amended Notice of Opposition and, therefore, denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 of the Amended Notice of Opposition and, therefore, denies the same.

7. Applicant denies that Opposer used the mark ESURANCE before Applicant's first use of the mark EINSURANCE.COM in commerce. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 7 of the Amended Notice of Opposition and, therefore, denies the same.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 8 of the Amended Notice of Opposition and, therefore, denies the same.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 9 of the Amended Notice of Opposition and, therefore, denies the same.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 10 of the Amended Notice of Opposition and, therefore, denies the same.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 11 of the Amended Notice of Opposition and, therefore, denies the same.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 12 of the Amended Notice of Opposition and, therefore, denies the same.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 13 of the Amended Notice of Opposition and, therefore, denies the same.

14. Applicant admits that it filed trademark Application No. 77/927,310 (“the ‘310 application”) on February 3, 2010, for the mark EINSURANCE.COM in connection with “Providing website and online insurance information and quotation services; online telephone directory information services; and commercial information and directory services” in International Class 035 and “Providing website and online information in the field of insurance, insurance products, and insurance product quotations” in International Class 036. Applicant further admits that the Examiner in the ‘310 application issued a final refusal of registration on July 7, 2011, asserting, in part, that “The applied-for mark [in Class 036] is generic because it

consists of the generic wording “EINSURANCE”, combined with the top-level domain (TLD) “.COM.” Applicant admits that it filed a request to divide the ‘310 application on July 18, 2011, which resulted in the ‘409 application for the services “Providing online telephone commercial information directory services via the internet; and commercial information and directory agency services” in International Class 035. Applicant admits that the ‘409 application was published for opposition on January 3, 2012. Applicant also admits that it filed a request for express abandonment in the ‘310 application on January 11, 2012. Applicant denies the remaining allegations contained in Paragraph 14 of the Amended Notice of Opposition.

15. Applicant admits that it is the owner of Registration No. 2,179,208 for the mark E-INSURE. Applicant denies the remaining allegations contained in Paragraph 15 of the Amended Notice of Opposition.

16. Applicant admits that its mark EINSURANCE.COM differs in appearance from Opposer’s mark ESURANCE, and includes the additional terms “i”, “n” and “.com”. Applicant denies the remaining allegations contained in Paragraph 16 of the Amended Notice of Opposition.

17. Applicant admits that it and Opposer do not share a corporate relationship. Applicant denies that Applicant and Opposer are not connected to the extent that, on information and belief, Applicant and Opposer have done business and Opposer’s insurance products have been offered through Applicant’s insurance services. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 17 of the Amended Notice of Opposition and, therefore, denies the same.

18. Applicant denies that Opposer used the mark ESURANCE before Applicant’s first use of the mark EINSURANCE.COM in commerce. Applicant further denies that a

connection between Applicant's mark EINSURANCE.COM and Opposer's mark ESURANCE would be presumed. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 18 of the Amended Notice of Opposition and, therefore, denies the same.

19. Applicant denies the allegations contained in Paragraph 19 of the Amended Notice of Opposition.

20. Applicant denies the allegations contained in Paragraph 20 of the Amended Notice of Opposition.

21. Applicant denies the allegations contained in Paragraph 21 of the Amended Notice of Opposition.

22. Applicant denies the allegations contained in Paragraph 22 of the Amended Notice of Opposition.

23. Applicant denies the allegations contained in Paragraph 23 of the Amended Notice of Opposition.

24. Applicant admits that it provides information services and directory agency services relating to the insurance industry, and that such services are provided via the Internet. Applicant denies that its services are limited solely to the insurance industry, and denies that its services are provided only via the Internet. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 24 of the Amended Notice of Opposition and, therefore, denies the same.

25. Applicant denies the allegations contained in Paragraph 25 of the Amended Notice of Opposition.

26. Applicant denies the allegations contained in Paragraph 26 of the Amended Notice of Opposition.

WHEREFORE, Applicant, E-Insure Services, Inc., respectfully requests that the Trademark Trial and Appeal Board dismiss the Amended Notice of Opposition with prejudice, and that its application proceed to allowance.

AFFIRMATIVE DEFENSES

1. Applicant or its predecessor in interest commenced use of the mark or tradename EINSURANCE.COM, and the similar marks or tradenames E-INSURANCE.COM, EINSURE.COM and E-INSURE.COM, in commerce long before Opposer's purported first use of its asserted registrations. Since at least as early as August 1996, Applicant has used the marks EINSURANCE.COM, E-INSURANCE.COM, EINSURE.COM and E-INSURE.COM in connection with its insurance services, including as domain names for Applicant's commercial Internet website offering online insurance services. Opposer's asserted registrations were filed and claim dates of first use as early as 1998 -- long after Applicant's use of the marks EINSURANCE.COM, E-INSURANCE.COM, EINSURE.COM and E-INSURE.COM. Therefore, Opposer's asserted mark ESURANCE could not have become famous before Applicant's use of its marks EINSURANCE.COM, E-INSURANCE.COM, EINSURE.COM and E-INSURE.COM, such that Opposer's claims for dilution are barred under 15 U.S.C. § 1125(c).

2. Applicant's rights in its trademark EINSURANCE.COM are superior to Opposer's rights in its alleged marks as set forth in Registration Nos. 2,673,515, 2,708,357, 2,854,154, 4,129,240, 4,129,241, and 4,129,242.

3. Opposer adopted and used its various alleged ESURANCE marks with knowledge of Applicant's prior use of and rights in the trademark EINSURANCE.COM.

4. Opposer is barred from any relief under the doctrine of estoppel by engaging in conduct that, expressly or by clear implication, assented to, encouraged, and/or furthered Applicant's use of the marks EINSURANCE and EINSURANCE.COM that Opposer now objects to. Since at least as early as 2005, Opposer has done business with Applicant and has used Applicant's insurance services to market Opposer's insurance products, including Applicant's services in connection with the mark and Internet domain name EINSURANCE.COM. Opposer did nothing to discourage Applicant or indicate a possible conflict with Opposer's mark. Opposer's conduct in doing business with Applicant clearly implied Opposer's assent to Applicant's use of the mark EINSURANCE.COM, and encouraged and assisted applicant to establish a good will and commercial value in the mark EINSURANCE.COM. In addition, in 2009, Opposer specifically asserted its Registration Nos. 2,673,515, 2,708,357 and 2,854,154 against Applicant's purported use of the term "esurance" as an Internet search engine keyword. Applicant responded by giving notice of Applicant's use of the mark EINSURANCE and corresponding domain name. As before, Opposer did nothing to discourage Applicant or indicate a possible conflict with Opposer's mark. Opposer's inaction by selectively choosing to assert its registrations regarding the term "esurance", but not against Applicant's use of the mark EINSURANCE and corresponding Internet domain name registration establishes Opposer's implied assent to Applicant's use of the mark EINSURANCE.COM. The only reasonable explanation for Opposer's inaction with regard to Applicant's use of the marks EINSURANCE and EINSURANCE.COM was that Opposer did not believe that the marks EINSURANCE and EINSURANCE.COM were confusingly similar to its asserted mark ESURANCE. In view of Opposer's conduct in knowingly assenting to and encouraging Applicant's use of the marks EINSURANCE and EINSURANCE.COM, and

Applicant's reliance on such conduct in continuing to develop and establish goodwill and commercial value in the marks EINSURANCE and EINSURANCE.COM, Opposer is barred from alleging that it would be damaged by and from opposing registration of Applicant's mark under the doctrine of estoppel.

5. Opposer is barred from any relief under the doctrine of acquiescence. Since at least as early as 2005, Opposer has done business with Applicant and has used Applicant's insurance services to market Opposer's insurance products, including Applicant's services in connection with the mark and Internet domain name EINSURANCE.COM. Opposer did nothing to discourage Applicant or indicate a possible conflict with Opposer's mark. In addition, in 2009, Opposer specifically asserted its Registration Nos. 2,673,515, 2,708,357 and 2,854,154 against Applicant's purported use of the term "esurance" as an Internet search engine keyword. Applicant responded by giving notice of Applicant's use of the mark EINSURANCE and corresponding domain name. As before, Opposer did nothing to discourage Applicant or indicate a possible conflict with Opposer's mark. Opposer's conduct in using Applicant's services in connection with the mark and Internet domain name EINSURANCE.COM, and inaction by selectively choosing to assert its registrations regarding the term "esurance", but not against Applicant's use of the mark EINSURANCE and corresponding Internet domain name registration, amounted to an express or implied assurance by Opposer to Applicant that Opposer would not assert its alleged rights in the mark ESURANCE against Applicant's use of the marks EINSURANCE and EINSURANCE.COM, such that Opposer is barred from alleging that it would be damaged by and opposing registration of Applicant's mark under the doctrine of acquiescence.

6. Opposer is barred from any relief under the doctrine of unclean hands.

Opposer's aforementioned conduct of doing business with Applicant and use of Applicant's insurance services to market Opposer's insurance products, including Applicant's services in connection with the mark and Internet domain name EINSURANCE.COM encouraged and assisted applicant to establish a good will and commercial value in the mark EINSURANCE.COM, thereby assisting in the purported likelihood of confusion that Opposer complains of. Such conduct bars Opposer from now opposing registration of Applicant's mark under the doctrine of unclean hands.

Respectfully submitted,

Dated: May 13, 2013

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Attorneys for Applicant
E-INSURE SERVICES, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO AMENDED NOTICE OF OPPOSITION was served on counsel for Opposer by mailing said copy on May 13, 2013, via First-Class mail, postage prepaid, and electronic mail to:

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