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

Proceeding	91205010
Party	Plaintiff Esurance Insurance Services, Inc.
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Date	11/20/2013
Attachments	Esurance Opp to Motion for Reconsideration.pdf(21959 bytes)

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

ESURANCE INSURANCE SERVICES, INC.	)	
	)	Opposition No. 91205010
Opposer,	)	
	)	Application No. 77/982409
E-INSURE SERVICES, INC.,	)	Mark: EINSURANCE.COM
	)	Published: January 3, 2012
Applicant.	)	

ESURANCE'S OPPOSITION TO APPLICANT'S MOTION
FOR RECONSIDERATION OF THE BOARD'S 10/16/13 ORDER

In a *third* attempt to salvage its Affirmative Defenses of estoppel, acquiescence and unclean hands, Nos. 4, 5, and 6,[1] Applicant E-INSURE SERVICES, INC. ("Applicant") has moved for reconsideration of the Board's 10/16/13 Order. As set forth in detail below, Applicant's Motion does not set forth any authority to support this request and accordingly, the Motion should be denied.

Applicant's Motion Violates TBMP § 518 Because
It is a Reargument of the Points Already Briefed

On March 13, 2013, this Board struck Applicant's equitable Affirmative Defenses, but granted Applicant leave to re-plead.[2] On October 16, 2013, this Board entered an Order striking —for the second time—Applicant's amended Affirmative Defenses, Nos. 4-6, and denied Applicant's request for leave to amend. Applicant now seeks to revisit these affirmative defenses for a ***third*** time and has moved for reconsideration of the Board's October 16 Order.

[1] These affirmative defenses were originally numbered 4, 5, and 7 in Applicant's original Answer and Counterclaim, and subsequently properly re-numbered in Applicant's Answer to the Amended Notice of Opposition.

[2] *See* Board's Order of March 13, 2013.

A request for reconsideration, however, "should [not] be devoted simply to a reargument of the points presented in a brief on the original motion . . . [T]he motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change." TBMP § 518. The TBMP in this sense comports with the generally accepted notion that motions to reconsider are disfavored, and appropriate only in an extremely narrow set of circumstances, none of which apply here. *See, e.g., Anderson v. Duncan*, 907 F. Supp. 2d 90, 92 (D.D.C. 2012), (a court's discretion to reconsider a prior interlocutory order is limited by the law of the case doctrine and subject to the caveat that, where litigants have once battled for the court's decision, they should neither be required, nor without good reason permitted, to battle for it again, citing FED. R. CIV. P. 54(b)); *Harris v. District of Columbia*, 756 F. Supp. 2d 25, 28 (D.D.C. 2010) (a motion for reconsideration is not a vehicle for presenting arguments or theories that could have been advanced earlier; the moving party must show new facts or clear errors of law which compel the court to change its prior position); *Spencer v. Roche*, 755 F. Supp. 2d 250, 258-59 (D. Mass. 2010) (reconsideration is an "extraordinary remedy which should be used sparingly'; in the absence of a change in law or newly discovered evidence, a party seeking reconsideration must demonstrate that original decision was based on manifest error of law or was clearly unjust) (internal citations omitted); *Arnold v. Farmers Ins. Co. of Arizona*, 827 F. Supp. 2d 1289, 1293 (D.N.M. 2011) (grounds warranting a motion to reconsider include (1) an intervening change in the controlling law, (2) new evidence previously unavailable, and (3) the need to correct clear error or prevent manifest injustice; thus, a motion for reconsideration is only appropriate if the court has misapprehended the facts, a party's position, or the controlling law); *U.S. v. Jasin*, 292 F. Supp. 2d 670, 676 (E.D. Pa. 2003) (to show clear error or manifest injustice on motion for reconsideration, the movant

must base its motion on arguments that were previously raised but were overlooked by court; parties are not free to relitigate issues that court has already decided); *Brown v. DFS Services, LLC*, 719 F. Supp. 2d 785, 788 (S.D. Tex. 2010) (a motion for reconsideration must clearly establish either a manifest error of law or fact or must present newly discovered evidence; such motions cannot be used to raise arguments which could, and should, have been made previously, citing FED. R. CIV. P. 59(e)).

Applicant cites no new case law or newly-discovered evidence in support of its Motion. Instead, Applicant asserts that the Board has "misunderstood" the basis for its affirmative defenses, resulting in a "misapplication of the law." (Motion at p. 1). But this assertion of misunderstanding rings hollow in light of the fact that Applicant has twice had the opportunity – in response to Esurance's two Motions to Strike – to make the case for these defenses and explain them. Applicant's Motion is devoted to a mere reargument of the same case law presented in its briefs in response to Opposer's prior two Motions to Strike, in direct violation of Section 518 of the TBMP. Applicant has not, however, offered any support or arguments to demonstrate that, based on the facts before it and the applicable law, the Board's October 16, 2013 Order was in clear error or manifestly unjust. Thus there is no basis for the Board to change its Order. *C.f. Bassani Mfg. v. Campbell, Monty Allen,* Opp. No. 91166939, 2009 WL 4073523, *1-2 (T.T.A.B. May 27, 2009) (denying motion for reconsideration because applicant was merely "rearguing points previously made, or advancing new issues or arguments… that could have been offered at the time the [original motion] was briefed").

Applicant's Reargument Does Not Salvage the Affirmative Defenses

Even if the Board were to consider Applicant's re-argument, Applicant's motion should still fail, for the simple reason that Applicant's new arguments are incorrect. Applicant argues

that the Board has made an error because the equitable defenses of estoppel and acquiescence can be a defense to likelihood of confusion, even if not available as a defense to registration, and that the defense of unclean hands can be established by bad faith (here, allegedly Opposer's decision to bring the instant opposition). But Applicant's positions are simply not supported by the law.

It is clear that "in an opposition proceeding, the equitable estoppel defense must be tied to registration of applicant's marks." *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1797 (TTAB 2009) *citing Lincoln Logs Ltd. V. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992) (denying applicant's equitable defenses and sustaining opposition, finding that opposer acted at its first opportunity to object to registration of applicant's mark). Simply because estoppel and acquiescence may also be considered in the context of a likelihood of confusion analysis does not create two separate affirmative defenses in an opposition proceeding—one relating generally to registration of an applicant's mark and one relating only to whether there is a claimed likelihood of confusion—that Applicant can choose between at its convenience. The Board has already found twice before that Applicant's estoppel and acquiescence defenses must fail. Applicant's citation to the exact same cases (*e.g.*, *Iodent*, *Man's Day* and *DAK Indus.*) it previously relied on to oppose Esurance's Motions to Strike provide no legal basis for Applicant's new assertion that the Board's prior findings were in error.

Similarly, Applicant's third attempt to salvage its unclean hands defense fails. Applicant attempts to refute the Board's holding that an allegation of "misconduct or wrongful conduct" is required to assert an affirmative defense of unclean hands by relying upon *Warnaco Inc. v. Adventure Knits, Inc.*, 210 U.S.P.Q. 307 (TTAB 1981) to suggest that unclean hands may be

based only on "bad faith." But Applicant has already cited *Warnaco* to the Board, and the Board evidently found Applicant's reading of that case unpersuasive in light of the greater weight of evidence holding that "misconduct or wrongful conduct" is required.

Nothing Applicant has set forth demonstrates any error in the Board's ruling. Applicant has not set forth any change in law or circumstances to support its Motion. Applicant was free to advance any and all arguments in the two prior briefs submitted with respect to these Affirmative Defenses and there is no reason Applicant should be permitted to reargue its position a third time. Applicant's Motion should be denied.

Conclusion

Applicant's Motion for Reconsideration should be denied and the Amended Affirmative Defenses Nos. 4-6 should remain stricken with prejudice.

Respectfully submitted,

_/Tanya H. Miari/_____
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CERTIFICATE OF SERVICE

The undersigned, one of the attorneys for Opposer, hereby certifies that on this 20th day of November, 2013, a copy of the foregoing ESURANCE'S OPPOSITION TO APPLICANT'S MOTION FOR RECONSIDERATION OF THE BOARD'S 10/16/13 ORDER was served via first class mail upon counsel for Applicant, as follows:

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/ Tanya H. Miari/