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THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: June 26, 2018

Cancellation No. 92064262

Tribal-care Insurance LLC

v.

*Alliant Specialty Insurance
Services, Inc.*

Before Kuhlke, Lykos and Larkin,
Administrative Trademark Judges,

By the Board:

Alliant Specialty Insurance Services, Inc. (“Respondent”) owns a registration on the Principal Register for the mark TribalCARE in standard characters for “medical claims management services, namely, re-pricing of physician, hospital, and ancillary medical care provider transactions; business services, namely, independent medical management services for self-funded major medical health plans; medical claims management services, namely, receiving, data entering, and repricing of transactions that are originated by physicians, hospitals, and ancillary health care providers; medical cost management; providing consumer information regarding health care plan options, products and programs in the field of state and federal medical care programs related to American Indian and Alaska Native Tribal health plans” in International Class 35 and for “consulting and administrative services in the health care industry, namely, insurance claim adjudication, insurance

claims processing, administration of employee benefit plans concerning insurance for others, medical insurance case and utilization review and insurance claim adjustment services for healthcare purchasers and payors and providers and Medicare beneficiaries; insurance administration and consulting services in the field of state and federal medical insurance programs related to American Indian and Alaska Native Tribal health plans; insurance consulting, namely, assessing individual health insurance plan needs of patients to ensure adequate insurance coverage; medical case management services, namely, assessing health insurance claims based on the medical services provided to patients” in International Class 36 (“Respondent’s Registration”).¹

Tribal-care Insurance LLC (“Petitioner”) filed a petition to cancel Respondent’s Registration² on various grounds, including that the mark is merely descriptive, generic, deceptively misdescriptive, has not acquired distinctiveness, falsely suggests a connection, and is deceptive as to both international classes of services. *See* 1 TTABVUE. Respondent denied the salient allegations of the petition to cancel and enumerated six affirmative defenses. *See* 6 TTABVUE.

¹ Registration No. 4062744 issued November 29, 2011, claiming a date of first use anywhere of May 6, 2010 and in commerce of May 24, 2010 for both classes.

² Petitioner also sought cancellation of Registration No. 4054829. Following institution of this proceeding, on October 3, 2016, Respondent filed a voluntary surrender of this registration without Petitioner’s consent. In accordance with Trademark Rule 2.134(a), the Board entered judgment against Respondent (9 TTABVUE) and the registration was cancelled on March 29, 2018. *See Commissioner’s Order* at 24 TTABVUE.

This case now comes up for consideration of Petitioner's (1) motion for partial summary judgment on the ground of mere descriptiveness; (2) motion to strike its own exhibits 6 and 7; and (3) motion to strike Respondent's declarations submitted with its responsive brief to the motion for summary judgment. The motion for summary judgment is fully briefed.³

Motion to Strike Exhibits 6 and 7

The Board first addresses Petitioner's motion to strike its own exhibits 6 and 7 because they are confidential. The motion to strike is unopposed.

Discovery responses, exhibits, discovery and testimony deposition transcript pages, testimony declarations or affidavits or those portions of a brief, pleading, or motion that disclose confidential information should be electronically designated as "confidential" when filed through ESTTA or, where permitted, filed by paper under seal pursuant to the Board's standard protective order or a modification of it. *See* Trademark Rules 2.126(c), 37 C.F.R. § 2.126(c); 2.127(e), 37 C.F.R. § 2.127(e); Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 120.02; 412.04; 703.01(p) (June 2017). If a party submits any such material, the party must also submit for the public record a redacted version of each submission. Trademark Rule 2.126(c). A rule of reasonableness dictates what information should be redacted, and only in very rare instances should an entire submission be deemed confidential. *See*,

³ The Board has considered the parties' submissions and arguments, except as otherwise noted, and presumes the parties' familiarity with the factual bases for the motions, and does not recount them here except as necessary to explain the Board's order.

e.g., Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC, 110 USPQ2d 1458, 1460-61 (TTAB 2014); *Swiss Watch Int'l Inc. v. Fed. of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1736 (TTAB 2012). In addition, “[t]he Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.” Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g).

Because Petitioner asserts that portions of its exhibits in support of its motion for summary judgment are confidential,⁴ the submission has been re-designated as confidential and has been removed from public view. Petitioner is ordered to submit copies, for public view, of its motion to strike at 17 TTABVUE and motion for summary judgment and exhibits at 16 TTABVUE, in which only truly confidential material is redacted, within **twenty (20) days** of the mailing date of this order, failing which the motions will be returned to public viewing status. *See Swiss Watch Int'l Inc.*, 101 USPQ2d at 1736; *Morgan Creek Prod. Inc. v. Foria Int'l Inc.*, 91 USPQ2d 1134, 1136 n.9 (TTAB 2009); TBMP § 120.02. If Petitioner fails to designate future filings or to over designate them as confidential, the materials will be treated as part of the public record, consistent with the Board’s general policy that all submissions in a proceeding be public. *See Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, 118 USPQ2d 1392, 1398 n.39 (TTAB 2016).

⁴ Additionally, the Board notes that the brief in support of Petitioner’s motion for summary judgment relies upon and quotes directly from the confidential exhibits. *See* 16 TTABVUE 10. The confidential designation of these portions is therefore deemed waived.

In view thereof, the motion is **granted** to the extent discussed above.

Motion to Strike Respondent's Declarations

The Board now turns to Petitioner's motion to strike Respondent's declarations submitted with its responsive brief. Although Respondent has not responded to the merits of Opposer's motion to strike, the Board exercises its discretion to consider the motion on its merits. *See* Trademark Rule 2.127(a); *see also, e.g., Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1760 n.1 (TTAB 2009); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017, 2018 (TTAB 2003); *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1599 (TTAB 2002).

Pursuant to Fed. R. Civ. P. 56(c)(4), made applicable to Board proceedings under Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), affidavits and declarations may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits or declarations are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant or declarant. *See* Fed. R. Civ. P. 56(c)(4); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *Ava Ruha Corp. v. Mother's Nutritional Center, Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015); *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 n.8 (TTAB 2007).

Petitioner argues that the declarations submitted by Respondent should be stricken because they “include only scant and conclusory statements” and that as to the issue of acquired distinctiveness, the declarations “fail to show duration, extent or advertising expenditures.” 21 TTABVue 3-4.

Petitioner’s objections are related to the probative value of and weight to be given to the declarations, not that the declarations fail to comply with Board rules. Indeed, upon review of the declarations, each declaration indicates that it is made on personal knowledge, sets forth facts that are admissible in evidence and indicates that the declarant is competent to testify on the matters stated in the declaration.

In view thereof, Petitioner’s motion to strike is **denied**.

Motion for Summary Judgment

We now turn to Petitioner’s motion for partial summary judgment. Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant’s favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd’s Food Prods. Inc. v. Eli’s Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music*

Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

“Whether a mark is descriptive is a question of fact.”⁵ *Towers v. Advent Software Inc.*, 16 USPQ2d 1039, 1040 (Fed. Cir. 1990). A term is considered descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012); see *In re Bayer Aktiengesellschaft*, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re MBNA Am. Bank N.A.*, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). Descriptiveness must be evaluated “in relation to the particular [services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the [services] because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831; see *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the question is whether someone who knows what the services are will immediately understand the mark as directly conveying information about them. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990).

⁵ Likewise, the issue of acquired distinctiveness is a question of fact. *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

Petitioner argues that Respondent's Registration should be cancelled because "the mark is used by [Respondent] to designate its 'services in the health care industry ... for healthcare purchasers'"; and because Respondent "has always intended to provide customized administration services to 'Tribal Government, Tribal Enterprise, and associated industry contacts' for their healthcare insurance plans." 16 TTABVUE 10.

Respondent argues that its mark is not merely descriptive, submitting declarations from various insurance brokers and agents which declare that "I do not believe that 'TribalCare' describes a particular service or product in the Native American health insurance industry." 19 TTABVUE 9-12, 15-19; *see* 19 TTABVUE 6-7. Alternatively, Respondent argues that even if the Board were to find that the mark is merely descriptive, its mark has acquired distinctiveness thereby raising a genuine dispute of material fact. In support thereof, Respondent points to eight of the declarations stating that Respondent owns the "TribalCare brand or trademark" and that the TribalCARE mark is not used by "multiple different companies"; as well as the declaration of Robert Shearer stating that a portion of "the relevant market knows that TribalCare is a trademark owned and used by [Respondent]." 19 TTABVUE 9-19.

The evidence of record, and any reasonable inferences that may be drawn from the underlying undisputed facts, viewed in the light most favorable to Respondent as the non-movant, fail to demonstrate an absence of a genuine dispute of material fact on the ground of descriptiveness. In particular, there

is a genuine dispute as to whether someone who knows what the services provided by Respondent are will immediately understand TribalCARE as directly conveying information about them, and whether, to the extent necessary, secondary meaning has been established.⁶ In view thereof, the motion for summary judgment on the ground of descriptiveness and lack of acquired distinctiveness is **denied**.⁷

Proceedings herein are resumed. Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	July 5, 2018
Plaintiff's 30-day Trial Period Ends	August 19, 2018
Defendant's Pretrial Disclosures Due	September 3, 2018
Defendant's 30-day Trial Period Ends	October 18, 2018
Plaintiff's Rebuttal Disclosures Due	November 2, 2018
Plaintiff's 15-day Rebuttal Period Ends	December 2, 2018
BRIEFS SHALL BE DUE AS FOLLOWS:	
Plaintiff's Main Brief Due	January 31, 2019
Defendant's Main Brief Due	March 2, 2019
Plaintiff's Reply Brief Due	March 17, 2019

General Information

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the

⁶ Acquired distinctiveness requires proof that the mark acquired secondary meaning as of the time of registration. *See Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1747 (TTAB 1989).

⁷ Evidence submitted in connection with the motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); TBMP § 528.05(a). Furthermore, the fact that we have identified certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).