

ESTTA Tracking number: **ESTTA778503**

Filing date: **10/24/2016**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|---|-------------|----------|
| Name | Esurance Insurance Services, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 650 Davis Street San Francisco, CA 94111-1981 UNITED STATES | | |

| | | | |
|----------------------|---|--|--|
| Attorney information | Sara Suleiman Foley & Lardner LLP 321 North Clark Street Suite 2800 Chicago, IL 60654-5313 UNITED STATES ssuleiman@foley.com, jrodriguez@foley.com, ipdocketing@foley.com, klocher@esurance.com, jkurzman@esurance.com, paralegals@esurance.com Phone:312 832-4500 | | |
|----------------------|---|--|--|

Registration Subject to Cancellation

| | | | |
|-----------------|---|-------------------|------------|
| Registration No | 4385224 | Registration date | 08/13/2013 |
| Registrant | Safe Auto Insurance Company 4 Easton Oval Columbus, OH 43219 UNITED STATES | | |

Goods/Services Subject to Cancellation

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|--|
| Class 036. First Use: 2012/07/02 First Use In Commerce: 2012/07/02 All goods and services in the class are cancelled, namely: Insurance brokerage services, namely, providing land vehicle insurance; insurance underwriting and administration services in the field of land vehicle insurance |
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Grounds for Cancellation

| | |
|--------------------------------|---|
| The mark is merely descriptive | Trademark Act Sections 14(1) and 2(e)(1) |
| Abandonment | Trademark Act Section 14(3) |
| Failure to function as a mark | Trademark Act Sections 14(1) and 1,2 and 45 |

| | |
|-------------|---------------------------------------|
| Attachments | Petition to Cancel.pdf(558731 bytes) |
|-------------|---------------------------------------|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-----------------|
| Signature | /Sara Suleiman/ |
| Name | Sara Suleiman |
| Date | 10/24/2016 |

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

In the Matter of Trademark Reg. No.: 4,385,224
Trademark: DRIVE SAFE. SPEND LESS.
Registered: August 13, 2013

| | | |
|-----------------------------------|---|------------------------|
| ESURANCE INSURANCE SERVICES, INC. |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| v. |) | Cancellation No. _____ |
| |) | |
| SAFE AUTO INSURANCE COMPANY |) | |
| |) | |
| Respondent. |) | |
| |) | |

PETITION TO CANCEL

Petitioner, Esurance Insurance Services, Inc. (“**Esurance**”), a Delaware corporation having a business address at 650 Davis St. San Francisco, California, 94111, believes that it is and will be damaged by the continued registration of the mark DRIVE SAFE. SPEND LESS., as shown in Registration No. 4,385,224 (“**Registration**”), which was registered on August 13, 2013, to Safe Auto Insurance Company (“**Respondent**”), an Ohio corporation having a business address at 4 Easton Oval, Columbus, Ohio, 43219.

Esurance hereby petitions this Board for cancellation of the Registration, and as grounds for the Petition to Cancel, Esurance alleges the following:

1. On October 2, 2013, Esurance filed App. Ser. No. 86/081,262 (“**the ‘262 Application**”), covering the standard character mark DRIVESAFE, for use in connection with “Telematics apparatus, namely, wireless devices comprised of receivers, transmitters and computer hardware and firmware that provide telematic monitoring services, recording and

reporting data pertaining to the location and operation of motor vehicles” in International Class 9; “Collecting data about the driving behavior of motorists to determine insured motorists’ eligibility for underwriting programs, tier placement or premium discounts or surcharges” in International Class 35; and “Insurance services, namely, underwriting and loss control management services in the fields of property and casualty, utilizing telematics technology and monitoring services” in International Class 36 (these Class 9, 35 and 36 services, collectively, the “**Esurance Drivesafe Goods and Services**”). Attached as **Exhibit A** is a true and correct printout from the Trademark Electronic Search System (“**TESS**”) of the U.S. Patent and Trademark Office (“**USPTO**”).

2. The ‘262 Application was filed on an intent-to-use basis, based on Esurance’s *bona fide* intent to use the DRIVESAFE mark in U.S. Commerce, as an alternative brand name for its popular “Esurance Drivesafe” teen driver safety program. Esurance has been using the registered mark ESURANCE DRIVESAFE mark in connection with the Esurance Drivesafe Goods and Services in the United States since at least as early as December 13, 2013. The Esurance Drivesafe program provides a telematics device to install into the onboard diagnostics port of a teen driver’s car, and works together with a smartphone app to track teen driving habits and limit cell phone use when the car is in motion. The program will continue to operate in the same manner under the DRIVESAFE mark, to help protect teen drivers and give their parents peace of mind.

3. The ‘262 Application has been finally refused based upon the USPTO’s determination that Esurance’s registration of DRIVESAFE is likely to cause confusion with Respondent’s registered mark DRIVE SAFE. SPEND LESS. A final Office Action issued on November 15, 2015, and reconsideration of the likelihood of confusion refusal was denied on

August 15, 2016. The ‘262 Application is currently subject of an *ex parte* appeal to this Board. The only issue on appeal is whether there exists a likelihood of confusion between the DRIVESAFE mark as identified by the ‘262 Application, and Respondent’s DRIVE SAFE. SPEND LESS. mark as identified by the Registration.

4. On May 15, 2012, Respondent filed intent-to-use App. Ser. No. 85/625,204, for the standard character mark DRIVE SAFE. SPEND LESS., covering “Insurance brokerage services, namely, providing land vehicle insurance; insurance underwriting and administration services in the field of land vehicle insurance” in International Class 36. The application was published for opposition on October 16, 2012 and allowed December 11, 2012. Respondent filed a Statement of Use on April 26, 2013, alleging a first use date of July 2, 2012. (Attached hereto as **Exhibit B** is a true and correct copy of the specimen of use submitted by Respondent.)

5. DRIVE SAFE. SPEND LESS. registered on August 13, 2013. (Attached as **Exhibit C** is a true and correct printout from TESS.)

6. Esurance is harmed and damaged by Respondent’s Registration as it constitutes a bar to registration of Esurance’s own ‘262 Application for DRIVESAFE, as well as a potential bar to any future DRIVESAFE-formative applications to be filed by Esurance.

7. Although the Registration issued on the Principal Register and without a disclaimer, it is, in fact, purely functional, merely descriptive of the Class 36 services covered by the Registration, and does not function as a trademark.

8. Specifically, the phrase “Drive Safe. Spend Less.,” which is comprised of common, English-language words given their ordinary meaning, merely functions as a (grammatically incorrect) offer to consumers that if they “drive safe(ly),” they will be able to “spend less” on auto insurance from Respondent. The phrase is subordinate to Respondent’s

SAFEAUTO house mark, and serves as nothing more than a purely functional, informational phrase which gives consumers an immediate idea about the specific nature of Respondent's services.

9. Moreover, there is nothing novel or unexpected about this offer, and there is no imagination required for consumers to understand exactly what is being offered, or the nature of Respondent's services. The registered DRIVE SAFE. SPEND LESS. merely describes a feature or characteristic of the registered services. Thus, even if it theoretically, could be viewed by consumers as a designation of source, it was not entitled to registration unless secondary meaning could be established.

10. At the time of registration, Respondent could not show acquired distinctiveness in the merely descriptive DRIVE SAFE. SPEND LESS. mark, which had only been in limited use for less than a year.

11. Further, upon information and belief, shortly after the Registration issued, Respondent ceased use of the registered mark as depicted on its specimen, and has not otherwise used its registered DRIVE SAFE. SPEND LESS. mark for at least three years. On information and belief, Respondent has no intent to resume use of the DRIVE SAFE. SPEND LESS. mark.

**FIRST GROUND FOR CANCELLATION –
FAILURE TO FUNCTION AS A TRADEMARK**

12. The registered DRIVE SAFE. SPEND LESS. mark has never functioned as a trademark and would not be perceived by consumers as a service mark; it has been used merely as an informational phrase to make an offer regarding Respondent's insurance services, and is purely functional.

13. For at least the reasons stated above, Respondent's Registration should be cancelled, pursuant to 15 U.S.C. §§ 1052(e)(5), 1064(1) and (3), 1127.

SECOND GROUND FOR CANCELLATION – DESCRIPTIVENESS

14. In the unlikely event that DRIVE SAFE. SPEND LESS. would be perceived by consumers as something more than merely an informational phrase about Respondent's insurance services, it is nonetheless still subject to cancellation. Marks that are merely descriptive cannot be registered on the Principal Register without a showing of acquired distinctiveness.

15. For the reasons stated above, DRIVE SAFE. SPEND LESS. is merely descriptive of Respondent's services. Respondent was unable to show acquired distinctiveness in DRIVE SAFE. SPEND LESS. mark in 2013, and it cannot show acquired distinctiveness today.

16. For at least the reasons stated above, Respondent's Registration should be cancelled on the grounds that it is merely descriptive, pursuant to 15 U.S.C. § 1052(e)(1).

THIRD GROUND FOR CANCELLATION – ABANDONMENT

17. Non-use of a mark for three consecutive years is prima facie evidence of abandonment. 15 U.S.C. § 1127. Here, Respondent has not used the registered DRIVE SAFE. SPEND LESS. mark for the last three years, and has given no indication that it intends to resume use of the mark.

18. For at least the reasons stated above, Respondent's Registration should be cancelled on the grounds that it has been legally abandoned, pursuant to 15 U.S.C. §§ 1064 (3), 1127.

WHEREFORE ESURANCE PRAYS, by and through its attorneys, that this Petition is sustained and that Registration No. 4,385,224 for the mark DRIVE SAFE. SPEND LESS. be cancelled.

FOLEY & LARDNER LLP

Date: October 24, 2016

 /Sara Suleiman /
Jami A. Gekas (jgekas@foley.com)
Sara Suleiman (ssuleiman@foley.com)
321 North Clark Street, Suite 2800
Chicago, Illinois 60654-5313
Telephone: 312.832.4500
Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned, counsel for Petitioner, Esurance Insurance Services, Inc., hereby certifies that on this 24th day of October, 2016, a copy of the foregoing Petition to Cancel was served via first class mail, postage prepaid, upon counsel for Respondent, Safe Auto Insurance Company, as follows:

Theodore R. Remaklus
Wood, Herron & Evans, LLP
441 Vine Street, Suite 2700
Cincinnati, Ohio 45202-2814
(513) 241-2324

 /Sara Suleiman/



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DRIVESAFE

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| Word Mark | DRIVESAFE |
| Goods and Services | IC 009. US 021 023 026 036 038. G & S: Telematics apparatus, namely, wireless devices comprised of receivers, transmitters and computer hardware and firmware that provide telematic monitoring services, recording and reporting data pertaining to the location and operation of motor vehicles IC 035. US 100 101 102. G & S: Collecting data about the driving behavior of motorists to determine insured motorists' eligibility for underwriting programs, tier placement or premium discounts or surcharges IC 036. US 100 101 102. G & S: Insurance services, namely, underwriting and loss control management services in the fields of property and casualty, utilizing telematics technology and monitoring services |
| Standard Characters Claimed | |
| Mark Drawing Code | (4) STANDARD CHARACTER MARK |
| Serial Number | 86081262 |
| Filing Date | October 2, 2013 |
| Current Basis | 1B |
| Original Filing Basis | 1B |
| Owner | (APPLICANT) Esurance Insurance Services, Inc. CORPORATION DELAWARE 650 Davis St. San Francisco CALIFORNIA 94111 |

Attorney of Record Charles Lee
Prior Registrations 4512663
Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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DRIVE SAFE. SPEND LESS.

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| Word Mark | DRIVE SAFE. SPEND LESS. |
| Goods and Services | IC 036. US 100 101 102. G & S: Insurance brokerage services, namely, providing land vehicle insurance; insurance underwriting and administration services in the field of land vehicle insurance. FIRST USE: 20120702. FIRST USE IN COMMERCE: 20120702 |
| Standard Characters Claimed | |
| Mark Drawing Code | (4) STANDARD CHARACTER MARK |
| Serial Number | 85625204 |
| Filing Date | May 15, 2012 |
| Current Basis | 1A |
| Original Filing Basis | 1B |
| Published for Opposition | October 16, 2012 |
| Registration Number | 4385224 |
| Registration Date | August 13, 2013 |
| Owner | (REGISTRANT) Safe Auto Insurance Company CORPORATION OHIO 4 Easton Oval Columbus OHIO 43219 |
| Attorney of Record | Theodore R. Remaklus |
| Type of Mark | SERVICE MARK |

Register PRINCIPAL
Live/Dead Indicator LIVE

EXHIBIT C

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