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

Proceeding	92064680
Party	Plaintiff Esurance Insurance Services, Inc.
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Date	01/30/2017
Attachments	107244-0902 Answer to Counterclaims re Cancellation of ESURANCE DRIVESAFE.pdf(22447 bytes)

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. 92064680
)	Reg. No. 4385224
SAFE AUTO INSURANCE COMPANY)	DRIVE SAFE. SPEND LESS.
)	Registered Aug. 13, 2013
Respondent.)	

SAFE AUTO INSURANCE COMPANY,)	
)	
Counterclaim Petitioner,)	
)	
v.)	Reg. No. 4512663
)	ESURANCE DRIVESAFE
ESURANCE INSURANCE SERVICES, INC.)	Registered April 8, 2014
)	
Counterclaim Respondent.)	

**ANSWER TO COUNTERCLAIM TO CANCEL
U.S. REGISTRATION NO. 4512663 IN CLASSES 9, 35 AND 36**

Petitioner/Counterclaim Respondent, Esurance Insurance Services, Inc., (“**Esurance**”), by and through its attorneys, Foley & Lardner LLP, hereby responds to the numbered paragraphs of the Counterclaim to Cancel U.S. Registration No. 4512663 in Classes 9, 35 and 36 filed by Respondent/Counterclaim Petitioner Safe Auto Insurance Company (“**Safe Auto**”) on November 30, 2016, as follows:

19. Esurance lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 19 and therefore denies them.

20. Esurance admits the allegations in Paragraph 20.

21. The '224 Registration speaks for itself. Esurance lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 21 and therefore denies them.

22. Esurance lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 22 and therefore denies them.

23. Esurance admits it is the owner of U.S. Reg. No. 4512663, which speaks for itself.

24. Esurance lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 24 and therefore denies them.

25. Esurance denies the allegations in Paragraph 25.

26. Esurance denies the allegations in Paragraph 26.

27. Esurance lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 27 and therefore denies them.

28. Esurance denies the allegations in Paragraph 28.

29. Esurance denies the allegations in Paragraph 29.

30. Esurance denies the allegations in Paragraph 30.

31. Esurance denies the allegations in Paragraph 31.

AFFIRMATIVE DEFENSES

Esurance alleges and asserts the following defenses in response to the allegations contained in Safe Auto's Counterclaim, and Esurance specifically reserves the right to assert additional defenses that become known through the course of discovery.

FIRST DEFENSE

Safe Auto's Counterclaim fails to state a claim upon which relief can be granted. In particular, there is no likelihood of confusion between the ESURANCE DRIVESAFE mark identified by the '663 Registration and Safe Auto's DRIVE SAFE. SPEND LESS. mark. Not only are the two marks wholly different on their faces (the Esurance mark incorporating the incontestably registered ESURANCE house mark, which has been in use for years prior to Safe Auto's adoption of its own mark), but Esurance's mark is used for a teen driver safety program, while Safe Auto's claimed mark is used in connection with the offering of a safe driver discount.

SECOND DEFENSE

Safe Auto's claims are barred by the equitable defenses of laches, waiver, acquiescence and/or estoppel. Safe Auto has been aware of Esurance's '663 Registration since at least the date when the mark was published for opposition (November 5, 2013), but did not oppose the application. Safe Auto allowed the time to oppose Esurance's application to expire without opposition. Safe Auto has never objected to the '663 Registration or Esurance's use of the ESURANCE DRIVESAFE mark identified therein prior to filing its cancellation counterclaims in this matter.

THIRD DEFENSE

Any alleged rights that Safe Auto may have are limited by third party usage of identical or similar marks.

FOURTH DEFENSE

Safe Auto's claims are barred by unclean hands and/or trademark misuse.

WHEREFORE ESURANCE PRAYS, by and through its attorneys, that Safe Auto's Counterclaim to Cancel U.S. Registration No. 4512663 be denied. Esurance further prays for an award of fees and costs in this action, and for such other and further relief as may be warranted.

Respectfully submitted,

FOLEY & LARDNER LLP

Date: January 30, 2017

s/ Jami A. Gekas
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CERTIFICATE OF SERVICE

The undersigned, counsel for Petitioner/Counterclaim Respondent, Esurance Insurance Services, Inc., hereby certifies that on this 30th day of January, 2017, a copy of the foregoing Answer to Counterclaim to Cancel U.S. Registration No. 4512663 in Classes 9, 35 and 36, was served via email upon the following counsel of record for Respondent/Counterclaim Petitioner:

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s/Jami A. Gekas_____