

ESTTA Tracking number: **ESTTA786050**

Filing date: **11/30/2016**

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

Proceeding	92064680
Party	Defendant Safe Auto Insurance Company
Correspondence Address	SAFE AUTO INSURANCE COMPANY 4 EASTON OVAL COLUMBUS, OH 43219 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Theodore R. Remaklus
Filer's e-mail	tremaklus@whe-law.com
Signature	/theodore r remaklus/
Date	11/30/2016
Attachments	Answer and Counterclaim.pdf(59159 bytes )

Registration Subject to the filing

Registration No	4512663	Registration date	04/08/2014
Registrant	Esurance Insurance Services, Inc. 650 Davis Street San Francisco, CA 94111 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 009. First Use: 2013/12/13 First Use In Commerce: 2013/12/13 All goods and services in the class are requested, namely: 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</p>
<p>Class 035. First Use: 2013/12/13 First Use In Commerce: 2013/12/13 All goods and services in the class are requested, namely: Collecting data about the driving behavior of motorists to determine insured motorists' eligibility for underwriting programs, tier placement or premium discounts or surcharges</p>
<p>Class 036. First Use: 2013/12/13 First Use In Commerce: 2013/12/13 All goods and services in the class are requested, namely: Insurance services, namely, underwriting and loss control management services in the fields of property and casualty, utilizing telematics technology and monitoring services</p>

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

Esurance Insurance Services, Inc.,	)	
	)	
Petitioner,	)	Cancellation No. 92064680
v.	)	Reg. No. 4385224
	)	Mark: DRIVE SAFE. SPEND LESS.
Safe Auto Insurance Company,	)	
	)	
Respondent.	)	
	)	

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

**Answer to Petition for Cancellation**

Respondent Safe Auto Insurance Company ("Safe Auto"), for its response to the numbered paragraphs of the Petition for Cancellation filed by Petitioner Esurance Insurance Services, Inc., answers as follows

1. Safe Auto admits on information and belief the allegations of Paragraph 1 of the Petition for Cancellation.

2. In response to Paragraph 2 of the Petition for Cancellation, Safe Auto admits that Application Serial No. 86081262 ("the '262 Application") was filed on the basis of intent-to-use. Safe Auto is without knowledge sufficient to form a belief as to the truth of the remaining allegations of Paragraph 2 of the Petition for Cancellation and, therefore, denies the same.

3. Safe Auto admits on information and belief the allegations of Paragraph 3 of the Petition for Cancellation, including that the USPTO correctly determined that registration of the DRIVESAFE mark would be likely to cause confusion with Safe Auto's DRIVE SAFE. SPEND

LESS. mark, but notes that the appeal filed by Petitioner has been suspended pending the completion of the present proceeding at the request of Petitioner.

4. Safe Auto admits on information and belief the allegations of Paragraph 4 of the Petition for Cancellation.

5. Safe Auto admits on information and belief the allegations of Paragraph 5 of the Petition for Cancellation.

6. In response to Paragraph 6 to the Petition for Cancellation, Safe Auto admits that Safe Auto's Reg. No. 4385224 for the DRIVE SAFE. SPEND LESS. mark ("the '224 Registration) bars registration to Petitioner's confusingly similar DRIVESAFE mark of the '226 Application, but denies that Petitioner is being harmed as Petitioner has no right to use or register the DRIVESAFE mark for the applied-for goods and services.

7. Safe Auto denies the allegations of Paragraph 7 of the Petition for Cancellation.

8. Safe Auto denies the allegations of Paragraph 8 of the Petition for Cancellation.

9. Safe Auto denies the allegations of Paragraph 9 of the Petition for Cancellation.

10. In response to Paragraph 10 of the Petition for Cancellation, Safe Auto denies that Safe Auto was required to show acquired distinctiveness as the DRIVE SAFE. SPEND LESS. mark of the '224 Registration is not merely descriptive.

11. Safe Auto denies the allegations of Paragraph 11 of the Petition for Cancellation.

12. Safe Auto denies the allegations of Paragraph 12 of the Petition for Cancellation.

13. Safe Auto denies the allegations of Paragraph 13 of the Petition for Cancellation.

14. Safe Auto denies the allegations of Paragraph 14 of the Petition for Cancellation.

15. Safe Auto denies the allegations of Paragraph 15 of the Petition for Cancellation.

16. Safe Auto denies the allegations of Paragraph 16 of the Petition for Cancellation.

17. In response to Paragraph 17 of the Petition for Cancellation, Safe Auto admits that non-use of a mark for a period of three years is prima facie evidence of abandonment. Safe Auto denies the remaining allegations of Paragraph 17 of the Petition for Cancellation.

18. Safe Auto denies the allegations of Paragraph 18 of the Petition for Cancellation.

**Counterclaim to Cancel U.S. Registration No. 4512663 in Classes 9, 35 and 36**

Respondent Safe Auto Insurance Company ("Safe Auto"), through its attorney, hereby alleges and asserts as follows:

19. Safe Auto is an Ohio corporation having a place of business at 4 Easton Oval, Columbus, Ohio 43219.

20. On information and belief, Esurance Insurance Services, Inc. ("Esurance") is a Delaware corporation having a place of business at 650 Davis St., San Francisco, California 94111.

21. Safe Auto is the owner of US Registration No. 4385224 ("the '224 Registration") for the mark DRIVE SAFE. SPEND LESS. for the following services:

Class 36 - Insurance brokerage services, namely, providing land vehicle insurance; insurance underwriting and administration services in the field of land vehicle insurance

The application for the '224 Registration was filed on the basis of intent-to-use on May 12, 2012, a statement of use was filed on April 26, 2013 claiming a first use date of July 2, 2012, and registered on August 13, 2013. A printout from the TESS database for the '224 Registration is attached as Exhibit 1.

22. Safe Auto has used the DRIVE SAFE. SPEND LESS. mark since it was first used on or about July 2, 2012 in connection with the services recited in the '224 Registration. The DRIVE SAFE. SPEND LESS. mark has been the subject of considerable marketing, and the mark is associated with Safe Auto.

23. On information and belief, Esurance is the owner of US Registration No. 4512663 ("the '663 Registration") for the mark ESURANCE DRIVESAFE for the following services in Classes 9, 35 and 36:

Class 9 - 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

Class 35 - Collecting data about the driving behavior of motorists to determine insured motorists' eligibility for underwriting programs, tier placement or premium discounts or surcharges

Class 36 - Insurance services, namely, underwriting and loss control management services in the fields of property and casualty, utilizing telematics technology and monitoring services

The application for the '663 Registration was filed on the basis of intent-to-use on June 13, 2013, a statement of use was filed on January 21, 2014 claiming a first use date of December 13, 2013, and registered on April 8, 2014. A printout from the TESS database for the '663 Registration is attached as Exhibit 2.

24. Safe Auto's filing date and first use date for its DRIVE SAFE. SPEND LESS. mark are earlier than the filing date and first use date of Esurance for the ESURANCE DRIVESAFE mark. The Safe Auto DRIVE SAFE. SPEND LESS. mark is senior to the ESURANCE DRIVESAFE mark.

25. The ESURANCE DRIVESAFE mark is confusingly similar in sound appearance and connotation to Safe Auto's DRIVE SAFE. SPEND LESS. mark as they share the identical

wording "DRIVE SAFE". The addition of the house mark "Esurance" to the Esurance mark does not lessen the likelihood of confusion.

26. The use by Esurance of the ESURANCE DRIVESAFE mark with the goods and services in Classes 9, 35 and 36 is likely to cause confusion among consumers as the services that are the subject of Safe Auto's '224 Registration and the goods and services that are the subject of Esurance's '663 Registration are identical or highly related as they both involve insurance services and software related to such services.

27. The relevant consumers of goods and services under Safe Auto's DRIVE SAFE. SPEND LESS. mark are the same as those under the Esurance ESURANCE DRIVESAFE mark.

28. A consumer, upon encountering the ESURANCE DRIVESAFE mark for the goods and services of the '663 Registration in Classes 9, 35 and 36, is likely to be confused and mistakenly believe that the goods and services promoted and sold under that mark are those of Safe Auto.

29. Use of the ESURANCE DRIVESAFE mark is also likely to cause confusion or to cause mistake or to deceive consumers by creating the false impression that the goods and services of Esurance originate with or come from the same source as those of Safe Auto, or are endorsed by, sponsored by, or otherwise connected or affiliated in some way with Safe Auto and the DRIVE SAFE. SPEND LESS. mark.

30. .If Esurance is permitted to retain the '663 Registration for the ESURANCE DRIVESAFE mark, and thereby the *prima facie* exclusive nationwide right to use the mark in commerce, confusion among consumers is likely to result thereby damaging Safe Auto.

31. If Esurance is permitted to continue to maintain the '663 Registration, that registration may be deemed inconstestable after five (5) years from the date of registration, and

Esurance would thereby obtain an incontestable right to use the ESURANCE DRIVESAFE mark in commerce, which would cast a cloud over Safe Auto's right to continue to use, register and expand its valuable DRIVE SAFE. SPEND LESS. mark of the '224 Registration, thereby damaging Petitioner.

WHEREFORE, Safe Auto Insurance Company prays that the Petition for Cancellation of Registration No. 4385224 be dismissed with prejudice, and that its counterclaim for cancellation of Registration No. 4512663 in Classes 9, 35 and 36 be granted.

Respectfully submitted,

SAFE AUTO INSURANCE COMPANY

Date: November 30, 2016

By: /Theodore R. Remaklus/  
Theodore R. Remaklus  
Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
441 Vine Street  
Cincinnati, Ohio 45202  
(513) 241-2324  
tremaklus@whe-.law.com

Attorneys for Safe Auto Insurance Company

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **Answer to Petition for Cancellation and Counterclaim to Cancel U.S. Registration No. 4512663 in Classes 9, 35 and 36** was served upon the following counsel for Petitioner by first class mail, postage prepaid, this 30th day of November, 2016:

Jami A. Gekas  
Sara Suleiman  
Foley & Lardner LLP  
321 North Clark Street, Suite 2800  
Chicago, Illinois 60654-5313

/Theodore R. Remaklus/  
Theodore R. Remaklus  
Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324

# **EXHIBIT 1**

**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Nov 30 03:22:30 EST 2016

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)[Logout](#)

Please logout when you are done to release system resources allocated for you.

**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*( Use the "Back" button of the Internet Browser to return to TESS)***DRIVE SAFE. SPEND LESS.****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

---

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)

---

| [HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

# **EXHIBIT 2**

**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Nov 30 03:22:30 EST 2016

[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [BOTTOM](#) | [HELP](#)[Logout](#)

Please logout when you are done to release system resources allocated for you.

**Record 1 out of 1**[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) ( Use the "Back" button of the Internet Browser to return to TESS)**ESURANCE DRIVESAFE****Word Mark ESURANCE 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. FIRST USE: 20131213. FIRST USE IN COMMERCE: 20131213

IC 035. US 100 101 102. G &amp; S: Collecting data about the driving behavior of motorists to determine insured motorists' eligibility for underwriting programs, tier placement or premium discounts or surcharges. FIRST USE: 20131213. FIRST USE IN COMMERCE: 20131213

IC 036. US 100 101 102. G &amp; S: Insurance services, namely, underwriting and loss control management services in the fields of property and casualty, utilizing telematics technology and monitoring services. FIRST USE: 20131213. FIRST USE IN COMMERCE: 20131213

IC 045. US 100 101. G &amp; S: Telematic monitoring services providing information concerning safety risks relative to the driving behavior of individuals for the protection of said individuals and others; risk management in the field of driver behavior. FIRST USE: 20131213. FIRST USE IN COMMERCE: 20131213

**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85959145**Filing Date** June 13, 2013**Current Basis** 1A**Original Filing Basis** 1B**Published**

**for** November 5, 2013  
**Opposition**

**Registration**  
**Number** 4512663

**Registration**  
**Date** April 8, 2014

**Owner** (REGISTRANT) Esurance Insurance Services, Inc. CORPORATION DELAWARE 650 Davis Street San Francisco CALIFORNIA 94111

**Attorney of**  
**Record** Charles Lee

**Type of**  
**Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead**  
**Indicator** LIVE

---

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

---

[| HOME](#) [| SITE INDEX](#) [| SEARCH](#) [| eBUSINESS](#) [| HELP](#) [| PRIVACY POLICY](#)