ESTTA Tracking number: **ESTTA433274**
Filing date: **09/30/2011**

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

Proceeding	91201297
Party	Defendant Serenic Software, Inc
Correspondence Address	JEFFRY F. CRAFT LAW OFFICE OF JEFFREY CRAFT 2069 COLD CANYON RD CALABASAS, CA 91302-2369 UNITED STATES jcraft@jeffreycraftlaw.com
Submission	Answer
Filer's Name	David G. Bayles
Filer's e-mail	bayles.david@arentfox.com, henrye@arentfox.com, tmdocket@arentfox.com
Signature	/David G. Bayles/
Date	09/30/2011
Attachments	Serenic Software ans.pdf (8 pages)(425664 bytes)

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

CLARK CAPITAL MANAGEMENT GROUP, INC.	)	
Opposer,	)	
vs.	)	Opposition No. 91201297
SERENIC SOFTWARE, INC.	)	Ser. No. 85/193,740
Applicant.	)	

ANSWER TO NOTICE OF OPPOSITION

Applicant SERENIC SOFTWARE, INC. ("Applicant") hereby answers the Notice of Opposition as follows:

1. Responding to paragraph 1 of the Notice of Opposition, Applicant admits that Applicant is a Delaware Corporation with a principal address in Lakewood, CO. Applicant denies that it has a principal address of 7175 West Jefferson Avenue, Suite 2500.

2. Applicant admits the allegations of paragraph 2 of the Notice of Opposition.

3. Applicant admits the allegations of paragraph 3 of the Notice of Opposition.

4. Responding to paragraph 4 of the Notice of Opposition, Applicant admits that on September 21, 1990, Opposer filed an application for registration of the mark NAVIGATOR in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq; that this application was assigned Serial No. 74/099,288 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and

issued as Registration No. 1,662,756 on October 29, 1991. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 4 of the Notice of Opposition and, therefore, denies the same.

5. Responding to paragraph 5 of the Notice of Opposition, Applicant admits that on January 31, 2001, Opposer filed an application for registration of the mark NAVIGATORLINK in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq; that this application was assigned Serial No. 76/202,022 and covers the use of this mark in conjunction with "computer software and programs for use in database management" and "financial and investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 2,789,230 on December 2, 2003. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 5 of the Notice of Opposition and, therefore, denies the same.

6. Responding to paragraph 6 of the Notice of Opposition, Applicant admits that on January 18, 2001, Opposer filed an application for registration of the mark NAVIGATOR ASSET MANAGEMENT in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq; that this application was assigned Serial No. 76/195,532 and covers the use of this mark in conjunction with "financial and investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 2,750,916 on August 12, 2003. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 6 of the Notice of Opposition and, therefore, denies the same.

7. Responding to paragraph 7 of the Notice of Opposition, Applicant admits that on January 10, 2001, Opposer filed an application for registration of the mark NAVIGATOR PREMIER in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq.; that this application was assigned Serial No. 76/192,050 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 2,638,519 on October 22, 2002. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 7 of the Notice of Opposition and, therefore, denies the same.

8. Responding to paragraph 8 of the Notice of Opposition, Applicant admits that on September 11, 2007, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,292,265 for NAVIGATOR SENTRY for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; and stock brokerage services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 8 of the Notice of Opposition and, therefore, denies the same.

9. Responding to paragraph 9 of the Notice of Opposition, Applicant admits that on March 12, 1999, Opposer filed an application for registration of the mark NAVIGATOR STRATEGIC WORLD in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq; that this application was assigned Serial No. 75/659,523 and covers the use of this mark in conjunction with "investment management services for optimal asset allocation in the field of stocks, bonds and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as

Registration No. 2,324,236 on February 29, 2000. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 9 of the Notice of Opposition and, therefore, denies the same.

10. Responding to paragraph 10 of the Notice of Opposition, Applicant admits that on August 28, 1998, Opposer filed an application for registration of the mark NAVIGATOR CLASSIC in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq.; that this application was assigned Serial No. 75546330 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 2,318,330 on February 15, 2000. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 10 of the Notice of Opposition and, therefore, denies the same.

11. Responding to paragraph 11 of the Notice of Opposition, Applicant admits that on June 10, 1998, Opposer filed an application for registration of the mark NAVIGATOR FUND in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq.; that this application was assigned Serial No. 75/499,466 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 2,639,961 on October 22, 2002. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 11 of the Notice of Opposition and, therefore, denies the same.

12. Responding to paragraph 12 of the Notice of Opposition, Applicant admits that on May 31, 1994 Opposer filed an application for registration of the mark NAVIGATOR

S.T.A.R. in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq; that this application was assigned Serial No. 74/531,302 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 1,904,627 on July 11, 1995. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 12 of the Notice of Opposition and, therefore, denies the same.

13. Responding to paragraph 13 of the Notice of Opposition, Applicant admits that on March 2, 1993 Opposer filed an application for registration of the mark NAVIGATOR MASTER in the United States Patent and Trademark Office on the Principal Register under the Lanham Act, 15 U.S.C. § 1051 et seq.; that this application was assigned Serial No. 74/364,257302 and covers the use of this mark in conjunction with "investment advisory services in the field of stocks and mutual funds;" and that this application was allowed by the Patent and Trademark Office and issued as Registration No. 1,849,587 on August 9, 1994. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 13 of the Notice of Opposition and, therefore, denies the same.

14. Responding to paragraph 14 of the Notice of Opposition, Applicant admits that on May 13, 2008, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,426,152 for NAVIGATOR 401K for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 14 of the Notice of Opposition and, therefore, denies the same.

15. Responding to paragraph 15 of the Notice of Opposition, Applicant admits that on April 21, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,608,683 for NAVIGATOR & Design for printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services; investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 15 of the Notice of Opposition and, therefore, denies the same.

16. Responding to paragraph 16 of the Notice of Opposition, Applicant admits that on October 20, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,698,185 for NAVIGATOR for printed publication, namely, a newsletter in the field of investment advisory services in the field of stocks, bonds, annuities and mutual funds, investment consultation, asset allocation services and stock brokerage services; investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 16 of the Notice of Opposition and, therefore, denies the same.

17. Responding to paragraph 17 of the Notice of Opposition, Applicant admits that on December 8, 2009, Opposer registered on the Principal Register of the U.S. Patent and Trademark Office Registration No. 3,721,660 for NAVIGATOR 401(K)

"KEEPING YOU ON COURSE FOR RETIREMENT" & Design for investment advisory services in the field of stocks, bonds, annuities and mutual funds; investment consultation; asset allocation services; stock brokerage services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 17 of the Notice of Opposition and, therefore, denies the same.

18. Applicant admits that in 2011 Opposer filed the lawsuit that is alleged in paragraph 18 of the Notice of Opposition. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 18 of the Notice of Opposition and, therefore, denies the same.

19. Applicant admits that Opposer has filed a request to suspend these proceedings as alleged in paragraph 19 of the Notice of Opposition. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other allegations of paragraph 19 of the Notice of Opposition and, therefore, denies the same.

20. Responding to paragraph 20 of the Notice of Opposition, Applicant admits that the word NAVIGATOR as used by Opposer is identical in sound and appearance to the word NAVIGATOR in Applicant's mark. Applicant denies the remaining allegations of paragraph 20 of the Notice of Opposition.

21. Applicant denies the allegations of the second numbered paragraph 19 in the Notice of Opposition.

22. Applicant denies the allegations of the second numbered paragraph 20 in the Notice of Opposition.

23. Applicant denies the allegations of paragraph 22 of the Notice of Opposition.

24. Applicant denies the allegations of paragraph 23 of the Notice of Opposition.

25. No response required to the allegations of paragraph 24 of the Notice of Opposition.

WHEREFORE, Applicant submits that the Opposition should be rejected and Applicant's mark should proceed to registration.

Respectfully submitted,

SERENIC SOFTWARE, INC.

Dated: September 30, 2011

By: /David G. Bayles/

Craig A. Gelfound
Jeffrey F. Craft
David G. Bayles
Arent Fox LLP
555 West Fifth Street, 48th Floor
Los Angeles, CA 90013
Telephone: (213) 629-7400
Facsimile: (213) 629-7401

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that the original Answer to Opposition is filed electronically via ESTTA and a copy mailed by first class mail, postage prepaid, on September 30, 2011, addressed as follows:

Camille M. Miller
Cozen O'Connor, PC
1900 Market Street
Philadelphia, PA 19103
UNITED STATES

By: /David G. Bayles/