

ESTTA Tracking number: **ESTTA527123**

Filing date: **03/15/2013**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Shipcom Wireless, Inc.
Granted to Date of previous extension	03/20/2013
Address	11200 Richmond Ave., Suite 552 Houston, TX 77082 UNITED STATES

Attorney information	Jennifer Lee Taylor Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105 UNITED STATES jtaylor@mofo.com, jliou@mofo.com, lsimpson@mofo.com
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**Applicant Information**

Application No	85654697	Publication date	11/20/2012
Opposition Filing Date	03/15/2013	Opposition Period Ends	03/20/2013
Applicant	CATAMARAN INC. 2441 WARRENVILLE ROAD LISLE, IL 60532 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Computer software for database integration in the area of drug information and pharmaceutical formulary management
Class 035. All goods and services in the class are opposed, namely: Pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; specialty mail order pharmacy services; distributorship services in the field of special purpose pharmaceuticals; retail pharmacy services

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2576219	Application Date	10/18/2001
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Registration Date	06/04/2002	Foreign Priority Date	NONE
Word Mark	CATAMARAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/04/17 First Use In Commerce: 2001/04/17 Software i) enabling interface between enterprise applications and wireless access by mobile devices and ii) integrating enterprise applications		

Attachments	76327429#TMSN.gif ( 1 page )( bytes ) Notice of Opposition - C CATAMARAN (vertical).pdf ( 6 pages )(163409 bytes ) Exhibit A - CATAMARAN registration.pdf ( 3 pages )(52114 bytes ) POS.pdf ( 1 page )(39074 bytes )
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### 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	/JLT/
Name	Jennifer Lee Taylor
Date	03/15/2013

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

SHIPCOM WIRELESS, INC.,

Opposer,

vs.

CATAMARAN INC.,

Applicant.

Opposition No.: TO BE ASSIGNED

Application No.: 85/654,697

Mark: C CATAMARAN and design

Filed: June 18, 2012

Published for Opposition: November 20, 2012

**NOTICE OF OPPOSITION**

Box TTAB FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

Shipcom Wireless, Inc. (“Opposer”), a Delaware corporation having its principal place of business at 11200 Richmond Ave., Suite 552, Houston, Texas 77082, believes that it will be damaged by registration of the C CATAMARAN and design mark in Application Serial No. 85/654,697, filed by Catamaran Inc. (“Applicant”), for certain goods and services in International Classes 9 and 35.

As grounds for the opposition, it is alleged as follows:

1. Opposer is a leading developer of supply-chain execution software designed for use in enterprise mobility markets. It provides server-based software solutions that integrate enterprise systems and capture, aggregate, filter, and route data from mobile devices to enterprise applications. Opposer’s software solutions are used by numerous businesses across multiple industry sectors, including but not limited to oil, gas, energy, utilities, life sciences, pharma, medical instruments, manufacturing, defense, and transportation sectors. As a result of the

versatility of Opposer's integrated software solutions, Opposer has developed a strong, diverse consumer base. Opposer currently services large and small businesses throughout the United States, Middle East, Asia, Africa, Australia, and other regions. Many of Opposer's customers are Fortune 500 companies in the United States.

2. Opposer has developed specialized identification and tracking software solutions for healthcare providers. Opposer's software enables multiple technologies to integrate real time data gathered across disparate hospital infrastructures with enterprise systems, allowing mobility and efficiency within hospitals' operational and clinical settings. A member of the Healthcare Information and Management Systems Society (HIMSS), Opposer devotes considerable resources to optimizing its software solutions within the healthcare industry. Opposer participates in the annual HIMSS conference, where professionals from all healthcare sectors, e.g. governmental, hospital, and non-profit organizations, meet to discuss and share effective practices in information technology and management systems. Opposer is also partnered with key system integrators and service providers in the healthcare industry, such as SAIC, Inc., VetFed Resources, Inc., and ICS-Nett, Inc.

3. Since at least as early as April 17, 2001, and substantially prior to Applicant's filing date for U.S. Application Serial No. 85/654,697, Opposer has continuously offered and promoted the CATAMARAN mark in connection with Opposer's integrated software solutions. The CATAMARAN product is a server-based software platform that integrates information collected from mobile devices, such as RFID readers and barcode scanners, directly with enterprise systems. The CATAMARAN platform features a suite of over 100 developmental tools and applications, which enable entities easily and quickly to configure the CATAMARAN software to their specific needs. Through continuous use and promotion of its CATAMARAN software, Opposer has acquired common law rights in the CATAMARAN mark.

4. Opposer owns U.S. Registration No. 2,576,219 for CATAMARAN for "software i) enabling interface between enterprise applications and wireless access by mobile devices and ii) integrating enterprise applications" in International Class 9. The application to register the

CATAMARAN mark as shown in Registration No. 2,576,219 was filed on October 18, 2001, prior to Applicant's filing date for U.S. Application Serial No. 85/654,697. Attached hereto as Exhibit A is a true and correct copy of a printout from the TESS electronic database of the U.S. Patent and Trademark Office ("USPTO"), showing the current status and title of Registration No. 2,576,219. The Section 15 Affidavit was acknowledged on June 23, 2008, rendering Registration No. 2,576,219 incontestable.

5. Opposer owns the goodwill and reputation of the goods connected with and symbolized by the CATAMARAN mark. Opposer regularly exhibits its CATAMARAN software at trade shows and conventions. In 2003, Opposer partnered with Hewlett Packard Co. to present Opposer's CATAMARAN software at the EPC Technology Exposition in Springdale, Arkansas. In 2004, Opposer's CATAMARAN software was used by Bell Canada Enterprises, a sponsor of the Olympic Games, to integrate components of a user-interactive, RFID-controlled demonstration on display in a 1,000-square-foot pavilion. As a result of extensive advertising, promotion and sales of Opposer's CATAMARAN software, Opposer has built up highly valuable goodwill in Opposer's CATAMARAN mark and said goodwill has become closely and uniquely identified and associated with Opposer and Opposer's goods.

6. Opposer's CATAMARAN products are particularly well known in the healthcare field. Opposer provides its CATAMARAN software directly to hospitals and pharmaceutical companies. In 2008, Opposer was selected by the U.S. Air Force Surgeon General's Office to implement Opposer's integrated software solutions at Keesler Medical Center, one of the largest medical centers in the Air Force. Opposer has continued to provide IT guidelines for the management of mobile medical equipment throughout the Air Force Medical Services.

7. On June 18, 2012, Applicant, a Texas corporation located at 2441 Warrenville Road, Lisle, Illinois 60532, filed U.S. Application Serial No. 85/654,697 in International Classes 9, 35, 36, and 44 for the design mark C CATAMARAN on an intent-to-use basis. The application was published in the *Official Gazette* on November 20, 2012.

8. By the application herein opposed, Applicant seeks to register the design mark C CATAMARAN for, *inter alia*, “computer software for database integration in the area of drug information and pharmaceutical formulary management” in International Class 9 and “pharmaceutical services, namely, processing online and telephone prescription orders in retail and central fill pharmacies; specialty mail order pharmacy services; distributorship services in the field of special purpose pharmaceuticals; retail pharmacy services” in International Class 35.

#### LIKELIHOOD OF CONFUSION

9. The primary distinctive element of Applicant’s proposed C CATAMARAN and design mark is identical to Opposer’s registered CATAMARAN mark—the term CATAMARAN is the dominant element of both marks, making Applicant’s and Opposer’s respective marks confusingly similar in appearance, sound, meaning, and commercial impression.

10. The Class 9 goods covered by Application Serial No. 85/654,697 are competitive, complementary, and/or closely related to the integrated software solutions offered under Opposer’s CATAMARAN mark and covered by Opposer’s prior registration. Applicant intends to offer “computer software for database integration,” which overlaps with software integrating enterprise applications already offered by Opposer under the CATAMARAN mark. Applicant’s proposed software may also be used in conjunction with Opposer’s CATAMARAN software to integrate wirelessly enterprise applications with mobile devices.

11. The Class 35 services covered by Application Serial No. 85/654,697 are competitive, complementary, and/or closely related to the integrated software solutions offered under Opposer’s CATAMARAN mark and covered by Opposer’s prior registration. Applicant’s services may rely on or be offered in conjunction with Applicant’s computer software in Class 9, which overlaps with software integrating enterprise applications already offered by Opposer under the CATAMARAN mark. Therefore, Applicant’s proposed services may be used together with Opposer’s CATAMARAN software to integrate wirelessly enterprise applications with mobile devices.

12. Opposer is informed, believes and on that basis alleges that consumers of the Class 9 goods and Class 35 services identified in Application Serial No. 85/654,697 are likely to consist of many of the same consumers within the healthcare industry who are familiar with Opposer's CATAMARAN software. Applicant's proposed software integrates drug and pharmaceutical formulary information. Opposer's CATAMARAN software integrates data collected from mobile equipment, which may include drug and pharmaceutical information, with enterprise applications operated by hospitals and pharmaceutical companies. The software provided by both Applicant and Opposer is likely to be used by professionals within the same industry.

13. Opposer is informed, believes and on that basis alleges that Applicant will offer and distribute its goods and services through channels of trade that will overlap with those used by Opposer to offer and distribute Opposer's CATAMARAN software. Opposer promotes the CATAMARAN mark in various professional settings as a member of the HIMSS. Opposer is informed and believes that Applicant is also a member of HIMSS, and on that basis alleges that consumers of Applicant's and Opposer's software are likely to encounter Applicant's and Opposer's respective marks through similar channels.

14. In view of the fact that the primary distinctive element of Applicant's C CATAMARAN and design mark is identical to Opposer's CATAMARAN mark; that Applicant's and Opposer's goods and/or services are competitive, complementary, and/or closely related; and that the customers and trade channels for Applicant's and Opposer's goods and/or services will be the same or overlapping, Applicant's C CATAMARAN and design mark is likely to cause confusion with Opposer's CATAMARAN mark, or to cause mistake, or to deceive as to the origin, source, or sponsor of Applicant's goods and services. Opposer would thereby be injured by Applicant's intended use and registration of mark in Application Serial No. 85/654,697 in International Classes 9 and 35.

Filing Fee: The USPTO is authorized to charge \$600.00 for the Notice of Opposition to International Classes 9 and 35 to Morrison & Foerster LLP's Deposit Account 031952 (Reference No. 57683-6001503).

WHEREFORE, Opposer prays that Application Serial No. 85/654,697 be rejected in International Classes 9 and 35, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,



Dated: March 15, 2013

By:

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Jennifer Lee Taylor  
Attorney for Opposer  
Shipcom Wireless, Inc.

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San Francisco, California 94105-2482  
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# **EXHIBIT A**



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**Typed Drawing**

<b>Word Mark</b>	<b>CATAMARAN</b>
<b>Goods and Services</b>	IC 009. US 021 023 026 036 038. G & S: Software i) enabling interface between enterprise applications and wireless access by mobile devices and ii) integrating enterprise applications. FIRST USE: 20010417. FIRST USE IN COMMERCE: 20010417
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76327429
<b>Filing Date</b>	October 18, 2001
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	March 12, 2002
<b>Registration Number</b>	2576219
<b>Registration Date</b>	June 4, 2002
<b>Owner</b>	(REGISTRANT) Shipco Wireless, Inc. CORPORATION TEXAS 11200 Richmond Avenue, Suite 552 Houston TEXAS 77082  (LAST LISTED OWNER) SHIPCOM WIRELESS, INC. CORPORATION DELAWARE 11200 RICHMOND AVENUE, SUITE 552 HOUSTON TEXAS 77082
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Bart G. Thompson
<b>Type of Mark Register</b>	TRADEMARK PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120615.
<b>Renewal</b>	1ST RENEWAL 20120615
<b>Live/Dead</b>	LIVE

**Indicator**

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**PROOF OF SERVICE BY MAIL**

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

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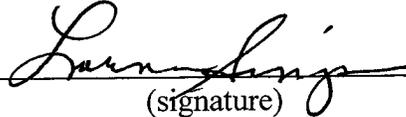
on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Bryan P. Sugar  
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70 W Madison St., Suite 3500  
Chicago, IL 60602-4283

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 15<sup>h</sup> day of March, 2013.

\_\_\_\_\_  
Lorna Simpson  
(typed)

  
\_\_\_\_\_  
(signature)