ESTTA Tracking number: **ESTTA540193**
Filing date: **05/28/2013**

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

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|---|---|
| Proceeding | 91209778 |
| Party | Defendant<br>Catamaran Inc. |
| Correspondence Address | BRYAN P SUGAR<br>UNGARETTI & HARRIS LLP<br>THREE FIRST NATIONAL PLAZA, 70 WEST MADISON SUITE 3500<br>CHICAGO, IL 60602-4224<br>UNITED STATES<br>ipdocket@uhlaw.com, mrsmith@uhlaw.com |
| Submission | Reply in Support of Motion |
| Filer's Name | Bryan P. Sugar |
| Filer's e-mail | bpsugar@uhlaw.com, ipdocket@uhlaw.com, mrsmith@uhlaw.com |
| Signature | /Bryan P. Sugar/ |
| Date | 05/28/2013 |
| Attachments | 91209778 --Catamaran's Reply to Shipcom's Opposition.pdf(180280 bytes ) |

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

| | | |
|---|---|---|
| **SHIPCOM WIRELESS, INC.,** | ) | |
| **Opposer,** | ) | |
| | ) | |
| **v.** | ) | **Opposition Nos. 91209778** |
| | ) | |
| **CATAMARAN, INC.,** | ) | **Serial No. 85/654,697** |
| **Applicant.** | ) | |
| | ) | **Mark:** |
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| | ) | |
| | ) | |
| | ) | |
| | ) | catamaran |

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**CATAMARAN, INC.'S REPLY**
**TO SHIPCOM WIRELESS, INC.'S OPPOSITION TO**
**MOTION TO DISMISS**

Applicant, Catamaran, Inc. replies to Shipcom Wireless, Inc.'s Opposition to Motion to Dismiss Opposition in Class 35, as follows.

Shipcom's response does not deny, and therefore admits, the central issue before for the Board, namely, Shipcom will not sustain any additional injury by allowing this application to mature to registration because Shipcom already made the deliberate decision not to oppose the CATAMARAN mark in Class 35 in the Morehouse Application.

Shipcom, cites a single case, *Hornblower & Weeks Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d 1733, 1737 (TTAB 2001) for the proposition that the *Morehouse* defense is "inapplicable when the prior marks relied upon by the applicant were not registered marks." However, the *Hornblower* case is inapposite to the facts in this case and does not apply.

In the *Hornblower* case, the Applicant was relying on an amalgamation of alleged common law rights in an undefined "family" of designations, none of which, the Board noted, was "the legal equivalent of the mark [at issue in that case]." In this case, the Morehouse

Application has now matured to Registration No. 4,344,276. A copy of the Registration Certificate is attached as **Exhibit A**. Moreover, this registration is essentially identical to the Subject Mark.

Shipcom's argument merely tries to divert the Board from the purpose of the *Morehouse* defense: to deny oppositions when there is no added damage from a second registration. *See Joseph & Feiss Co. v. Sportempos, Inc.*, 59 C.C.P.A. 742, 451 F.2d 1402, 172 U.S.P.Q. 235 (1971); *see also* 3 J. THOMAS MCCARTHY, *McCarthy on Trademarks and Unfair Competition* § 20:38 (4th ed. 2007); and TBMP §311.02(b)(3d ed. rev. 2012). The Board in the *Hornblower* case did not contemplate the unique set circumstances presented in the case; it merely ruled on the facts before it, which are distinctly different from those presented in this case. Moreover, as Shipcom acknowledges, it will not suffer any damage because it can simply file a cancellation proceeding against the Subject Mark once it issues.

As Shipcom will not suffer any added damage by the Board allowing this second application to mature to registration, the Board should dismiss this Opposition in connection with Class 35 with prejudice.

Respectfully submitted,
**UNGARETTI & HARRIS**

Dated: May 28, 2013

By: _____
Bryan Sugar
Attorney for Applicant

## CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing CATAMARAN, INC.'S REPLY TO SHIPCOM WIRELESS, INC.'S OPPOSITION TO MOTION TO DISMISS was served upon Opposer by sending true and correct copies thereof, by first class mail, postage prepaid, in an envelope addressed to the following:

Jennifer Lee Taylor, Esq.
Joyce Liou, Esq.
Morrison & Foerster LLP
425 Market Street
San Francisco, CA 94105

on this, the 28th day of May, 2013.

Kathleen Churay

Kathleen Churay