UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BUO

Mailed: July 25, 2013

Opposition No. 91209777
("Parent")
Opposition No. 91209778
Opposition No. 91209779
Opposition No. 91209780

Shipcom Wireless, Inc.

v.

Catamaran Inc.

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board is Catamaran Inc.'s ("applicant") motion, filed April 24, 2013, to dismiss the notice of opposition under Fed. R. Civ. P. 12(b)(6), alleging that Shipcom Wireless, Inc.'s ("opposer") claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. 1052(d) "is barred under the *Morehouse* defense;" and applicant's motion, filed March 26, 2013, to divide its application nos. 85654663, 85654690, 85654697, and 85654706 into four distinct single-class applications.[1] Opposer,

[1] At publication all of the listed applications included goods and services in International Classes 009, 035, 036, and 044. The Board previously decided the motion to divide in proceeding

contests both motions, claiming that applicant's reliance on the *Morehouse* defense is inappropriate given the facts of this case; and asserts that only the two unopposed classes should be divided out into separate applications because "Opposer's oppositions to Classes 9 and 35 of the application[s] involve potentially overlapping issues…" The motions are fully briefed.

Motion to Dismiss

A motion to dismiss for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of a complaint. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). Opposer is not under a burden to prove its case in its notice of opposition. *Enbridge, Inc. v. Excelerate Energy Ltd. P'ship*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009). Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. *Advanced Cardiovascular Sys. Inc. v.*

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no. 91209778; and the '697 application has been divided, leaving only International Classes 009 and 035.

SciMed Life Sys. Inc., 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Applicant, however, has not attacked the sufficiency of opposer's pleading, but has instead based its motion to dismiss on an affirmative defense. Applicant contends that its now registered application Serial No. 85978290[2] for "essentially the same mark identifying the same services as the Subject Application," raises a prior registration defense to opposer's claim as it relates to the class 035 services, and seeks to have the likelihood of confusion claim dismissed as to class 035. App. Br., p. 3. Opposer contests the applicability of *Morehouse* in this case, stating that "[b]ecause Applicant cannot claim to own a 'prior registration' while Application No. 85/978,290 is still pending, the TTAB must reject Applicant's *Morehouse* defense." Opp. Response Br., p. 3.

Both parties miss the actual issue presented by applicant's submission. The Board notes that neither the '290 application or resulting Registration No. 4344276 were pleaded in any of the opposition proceedings cited in the

[2] The '290 application is the "child" application to application Serial No. 85625926, created as a result of applicant's divisional request filed with the USPTO on December 6, 2012. The child application subsequently matured into Registration No. 4344276 on May 28, 2013, for the mark CATAMARAN, in standard characters, for use with services in International Classes 035, 036, and 044.

caption of this order. Thus, a motion to dismiss based upon that application or registration would require the Board to consider matter outside of the pleadings, i.e. the Board would be required to consider Registration No. 4344276. The Board construes a motion to dismiss involving matters outside the pleadings as a motion for summary judgment. *See* Fed. R. Civ. P. 12(d); *Stephen Slesinger Inc. v. Disney Enter. Inc.*, 98 USPQ2d 1890, 1894 (TTAB 2011).

However, in Board proceedings commenced after November 1, 2007, a party may not file a motion for summary judgment until it has made its initial disclosures, unless the motion is based on issue or claim preclusion or lack of Board jurisdiction. Trademark Rule 2.127(e)(1). *See Zoba Int'l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011). Accordingly, inasmuch as applicant has not served its initial disclosures on opposer, this motion is prematurely filed, and will be given no further consideration.

Motion to Divide

An application which is the subject of an *inter partes* proceeding before the Board may be divided into two or more distinct applications upon motion granted by the Board, and

payment of the required fee.[3] Where a multiple-class application is the subject of an *inter partes* proceeding, but not all of the classes in the application are at issue, it is appropriate to divide out the uncontested classes. *See* TBMP § 516 (3d ed. rev. 2013).

Accordingly, applicant's motion, filed March 26, 2013, to divide the subject application is **GRANTED** in part, to the extent that unopposed International Classes 036 and 044 are divided into two separate "child" applications. The "child" applications will be processed and notices of allowance will issue in due course.

However, applicant concedes in its April 24, 2013, reply brief, that if its motion to dismiss is denied, International Classes 009 and 035 should remain together in the "parent" application, subject to this opposition proceeding. Accordingly, applicant's motion to dismiss having been denied, its motion to divide is **DENIED** in part, to the extent that International Classes 009 and 035 will remain in the subject applications.

Consolidation

When cases involving common questions of law or fact are pending before the Board, the Board may order the

[3] Applicant has authorized the debit of its deposit account to cover the necessary fees for division of its applications.

consolidation of the cases. Such consolidation may be ordered on the Board's own initiative. *See* Fed. R. Civ. P. 42(a); and TBMP § 511. Inasmuch as the parties to Opposition Nos. 91209777, 91209778, 91209779, and 91209780 are the same and the proceedings involve common questions of law or fact, the Board finds that consolidation of the above-referenced proceedings is appropriate. Consolidation will avoid duplication of effort concerning the factual issues and will avoid unnecessary costs and delays.

Accordingly, Opposition Nos. 91209777, 91209778, 91209779, and 91209780 are consolidated and may be presented on the same record and briefs. The record will be maintained in Opposition No. 91209777 as the "parent" case.

The Board notes initially that because these proceedings are being consolidated before the filing of answers in any of the opposition proceedings, applicant must file its answers in each proceeding, following which subsequent filings should be filed only in the parent case.

Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as the parent case by following it with: "(parent)," as in the case caption set forth above.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd., 94 USPQ2d 1889, 1893 (TTAB 2010).* The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42.

Schedule

Answers in all of the opposition proceedings are due August 8, 2013. The conferencing, disclosure, discovery and trial dates are reset as follows:

Time to Answer	**8/8/2013**
Deadline for Discovery Conference	**9/7/2013**
Discovery Opens	**9/7/2013**
Initial Disclosures Due	**10/7/2013**
Expert Disclosures Due	**2/4/2014**
Discovery Closes	**3/6/2014**
Plaintiff's Pretrial Disclosures	**4/20/2014**
Plaintiff's 30-day Trial Period Ends	**6/4/2014**
Defendant's Pretrial Disclosures	**6/19/2014**
Defendant's 30-day Trial Period Ends	**8/3/2014**
Plaintiff's Rebuttal Disclosures	**8/18/2014**
Plaintiff's 15-day Rebuttal Period Ends	**9/17/2014**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits,

must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.