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

BUO

Mailed: December 30, 2013

**Opposition No. 91208297
("Parent")**

Opposition No. 91209777

Opposition No. 91209778

Opposition No. 91209779

Opposition No. 91209780

Shipcom Wireless, Inc.

v.

Catamaran Inc.

**Before Cataldo, Shaw, and Greenbaum, Administrative
Trademark Judges.**

By the Board:

Catamaran Inc. ("applicant") seeks to register the
following four marks:¹



¹ Applicant is also seeking to register the mark CATAMARAN, in standard character format, in Application Serial No. 85625926, which is subject to Opposition No. 91208297, and is consolidated into this proceeding by this order, as discussed further below.



All of the referenced marks were filed for use in connection with "computer software for database integration in the area of drug information and pharmaceutical formulary management," in International Class 9; "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; [and] retail pharmacy services" in International Class 35; "administration of prescription drug healthcare plans; insurance claims processing; [and] pharmacy benefit management services," in International

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

Class 36; and "dispensing special purpose pharmaceuticals" in International Class 44.²

On March 15, 2013, Shipcom Wireless, Inc. ("opposer") filed separate notices of opposition to the registration of applicant's marks in International Classes 9 and 35, alleging a likelihood of confusion between the applied-for marks and opposer's previously used and registered mark CATAMARAN in standard character format.³ In its July 25, 2013 order, the Board consolidated Opposition Nos. 91209777, 91209778, 91209779, and 91209780, denied applicant's motions to dismiss, and granted its motions to divide out International Classes 36 and 44.⁴ Subsequently, applicant filed its answer to each notice of opposition on August 7, 2013, admitting that opposer is the owner of Registration No. 2576219 and that the filing date of the

² Application Serial Nos. 85654663, 85654697, 85654690, and 85654706, filed on June 18, 2012, based upon applicant's assertion of a bona fide intention to use the marks in commerce under Section 1(b) of the Trademark Act.

³ Opposer alleges common law rights with use since at least as early as April 17, 2001. Opposer has also pleaded ownership of U.S. Registration No. 2576219, for use in connection with "software i) enabling interface between enterprise applications and wireless access by mobile devices and ii) integrating enterprise applications," in International Class 9.

⁴ By the July 25, 2013 order, the goods and services in International Classes 9 and 35 remained in the subject applications as the "parent" applications, while the unopposed services in International Classes 36 and 44 were divided out into separate "child" applications, which are still pending.

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

application that matured into that registration predates the filing date of the subject applications, Answer, ¶ 4; and admitting that its proposed software integrates drug and pharmaceutical formulary information, Answer, ¶ 12; but denying the remainder of the salient allegations asserted therein. In each answer, applicant also asserted two "affirmative defenses" alleging that opposer's notices of opposition fail to state a claim upon which relief can be granted, and also that opposer's claim of likelihood of confusion is barred by the *Morehouse* doctrine.⁵

This case now comes before the Board for consideration of applicant's fully-briefed motion, filed August 21, 2013, for partial summary judgment in the four consolidated oppositions.⁶

Partial Summary Judgment

Applicant asserts that as a matter of law the oppositions cannot be sustained as to International Class 35 because applicant was recently issued a registration for the mark CATAMARAN, in standard characters, for, among other services, "pharmaceutical services, namely,

⁵ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

⁶ The Board construes applicant's motion as one for partial summary judgment, as applicant's arguments only address International Class 35, and do not address the allegations with respect to International Class 9.

processing online and telephone prescription orders in retail and central fill pharmacies; specialty mail order pharmacy services; pharmacy benefit management services; distributorship services in the field of special purpose pharmaceuticals; retail pharmacy services.”⁷ Applicant argues that “whatever injury [opposer] may sustain from the CATAMARAN mark in Class 35 by virtue of the registration of the [‘276 registration], it cannot be increased by the registration of the Subject Application.” Motion for Summary Judgment, p.3. Applicant goes on to state that opposer “forfeited its opportunity to challenge Applicant’s registration of the CATAMARAN mark in Class 35 when it expressly failed to oppose Class 35 in its opposition” to the application that matured into the ‘276 registration. For its part, opposer argues that to the extent the registration applicant seeks to base its *Morehouse* defense upon registered after the commencement of this proceeding, the *Morehouse* defense is inapplicable in this matter. As discussed below, we agree with opposer.

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ.

⁷ Registration No. 4344276, issued on May 28, 2013, from child application Serial No. 85978290, filed May 15, 2012.

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

P. 56(a). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Under Rule 56(a), the movant has the initial burden of demonstrating that there is no genuine dispute of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

Where a defendant's prior registration was not procured until after the commencement of a proceeding, *Morehouse* does not apply:

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

The proposition for which the *Morehouse* case stands is that, as a matter of law, an opposer cannot be damaged, within the meaning of Section 13 of the Trademark Act, by the issuance to an applicant of a second registration when applicant already has an *existing, unchallenged* registration of the same mark for the same goods. See *O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); and TBMP § 311.02(b) (2d ed. rev. 2004). The prior registration or *Morehouse* defense is an equitable defense, "to the effect that if the opposer can not be further injured because there *already exists* an injurious registration, the opposer can not object to an additional registration that does not add to the injury." *O-M Bread*, 36 USPQ2d at 1045 (emphasis added). Because the injury contemplated under the *Morehouse* doctrine is injury not from a party's prior use of a mark but rather from the party's ownership of a registration for the mark, it necessarily follows that *the registration must be in existence* in order to form the basis ... of a valid *Morehouse* defense.

Land O' Lakes v. Hugunin, 88 USPQ2d 1957, 1958-59 (TTAB 2008) (emphasis added).

As the Board held in *S. Gumpert Co., Inc. v. ITT Cont'l Baking Co.*, 191 USPQ 409, 411 (TTAB 1976), an exception to the applicability of the *Morehouse* defense arises where "the registration which bottoms the defense issued subsequently to the institution of the opposition." See also, *Tex. Instruments Inc. v. Peerless Telerad, Inc.*,

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

171 USPQ 376 (TTAB 1971) (prior registration defense found inapplicable where applicant's registration did not issue until "long" after the institution of the instant proceeding). The Board explained that:

The exception exists because it would be unfair to require an opposer to anticipate an event – the issuance of a second registration to applicant – that had not yet occurred when the opposition was instituted or to impose upon opposer an obligation to commence a second proceeding (a cancellation) when the first proceeding might settle all issues. By hypothesis, the registration used as a basis for the defense (ownership of a subsisting registration) would be for substantially the same mark and goods as are depicted and identified in applicant's opposed application. If opposer prevails in the opposition, applicant's registration might well be voluntarily cancelled or a cancellation proceeding might be determinable by a summary judgment motion predicated upon the principle of collateral estoppel.

S. Gumpert, 191 USPQ at 411.

After consideration of the parties' respective arguments, the evidence submitted, and relevant case law, we find that entry of summary judgment is inappropriate in this case on the basis raised by applicant. Indeed, the *Morehouse* defense is inapplicable under the circumstances of this case because it is based on a registration that issued after this proceeding commenced. Therefore,

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

applicant's motion for summary judgment is **DENIED**,⁸ and its second affirmative defense alleging that opposer's claim is barred by applicant's ownership of a prior registration is **STRICKEN**.⁹

Failure to State a Claim

As noted above, applicant also asserted an "affirmative defense" alleging that the notices of opposition failed to state a claim upon which relief may be granted. The Board notes that this asserted defense is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claims rather than a statement of a defense to a properly

⁸ The parties should note that the evidence submitted in connection with the present motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

⁹ Further, the Board notes that this outcome would not have differed had the Board considered applicant's *Morehouse* defense, as the subject marks cannot be said, as a matter of law, to be "essentially the same" as the mark in Registration No. 4344276. See *O-M Bread*, 36 USPQ2d at 1045 ("Morehouse defense ... require[s] that the prior and proposed marks be essentially the same."); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) ("The prior registration defense will apply where the mark and goods in the pre-existing registration are substantially identical to the mark and goods which are the subject of the involved application."). Not only do the subject marks contain an additional design element, but the marks applied for in the '690 and '706 applications also contain additional literal elements.

We do not reach, however, on the present motion for summary judgment, the question of whether the marks are similar for purposes of a likelihood of confusion analysis.

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

pleaded claim. In view thereof, and in the absence of a formal motion to dismiss for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6), this asserted defense will not be considered. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

Following a careful review of opposer's notices of opposition, however, the Board finds that opposer's pleadings are legally sufficient to the extent that they clearly contain allegations which, if proven, would establish opposer's standing, as well as its asserted grounds for opposition. In view thereof, applicant's defense that opposer's pleadings fail to state a claim upon which relief may be granted is also **STRICKEN** from its answers.

Consolidation

As a final matter, the Board's September 11, 2013 order in Opposition No. 91208297 suspended that proceeding pending a determination on the instant summary judgment motion. In view of the denial of applicant's motion for summary judgment, Opposition No. 91208297 is hereby added to the previously consolidated oppositions, and may be presented on the same record and briefs.

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

The parties should note that Opposition No. 91208297 will now function as the "parent" case, and therefore, the record will be maintained in that case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear the case caption as set forth above.

Finally, 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.

Discovery, disclosure, and trial dates are reset as indicated below:

Opposer's Initial Disclosures Due (if not already served)	1/10/2014
Expert Disclosures Due	5/10/2014
Discovery Closes	6/9/2014
Plaintiff's Pretrial Disclosures	7/24/2014
Plaintiff's 30-day Trial Period Ends	9/7/2014
Defendant's Pretrial Disclosures	9/22/2014
Defendant's 30-day Trial Period Ends	11/6/2014
Plaintiff's Rebuttal Disclosures	11/21/2014
Plaintiff's 15-day Rebuttal Period Ends	12/21/2014

Opposition Nos. 91208297, 91209777, 91209778, 91209779, and 91209780

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 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.