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

Proceeding	91212922
Party	Defendant InnoPath Software, Inc.
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Attachments	InnoPath Answer to Opposition.pdf(33587 bytes)

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

Siemens Medical Solutions USA, Inc.,)	
)	
Opposer,)	
)	OPPOSITION
v.)	NO. 91212922
)	
InnoPath Software, Inc.,)	
)	
Applicant.)	
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**APPLICANT INNOPATH SOFTWARE, INC.’S
ANSWER TO NOTICE OF OPPOSITION**

Applicant INNOPATH SOFTWARE, INC. (hereinafter “INNOPATH” or “Applicant”), by and through its undersigned counsel, and in accordance with Rules 8 and 12 of the Federal Rules of Civil Procedure and the corresponding Trademark Rules of Practice, files its Answer to the Notice of Opposition filed by Opposer SIEMENS MEDICAL SOLUTIONS USA, INC. (hereinafter “Siemens” or “Opposer”), and in support thereof, respectfully shows as follows:

INNOPATH responds to the separately numbered paragraphs of SIEMENS Notice of Opposition, repeated below for ease of reference, as follows:

Opp. Para. 1. Opposer, or its predecessor in interest commenced use in commerce, at least as early as February 5, 1999, and is presently using and has registered the trademark MobileMD (“Opposer’s Mark”), in connection with the following goods and services:

Class 9: Computer programs and software used to provide Health Information Services, namely, providing transmission, storage and management of health information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

Class 38: Communication services relating to health information, namely, providing electronic transmission of health information accessed via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

Class 42: Providing online non-downloadable software for the storage and management of health care information via the Internet and between computer systems, handheld devices and telecommunication devices of health care providers including health systems, hospitals, physician practices, practices, testing and laboratory companies, medical billing companies and others and other health care providers and/or their respective business partners and/or contractors

Answer to Opp. Para. 1. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 1 and therefore denies the same, leaving Opposer to its proof.

Opp. Para. 2. Opposer's Mark is the subject of the following United States trademark registration: Reg. No. 4,005,257 issued August 2, 2011, based on US SN 85/150,428 filed October 12, 2010

Answer to Opp. Para. 2. Applicant admits that the United States Patent and Trademark Office ("USPTO") database indicates that the referenced registration is owned by Opposer, and issued on August 2, 2011, based on Application SN 85/150,428 filed October 12, 2010, but Applicant is without knowledge or information sufficient to form a belief as to Opposer's actual use of the mark or entitlement to the registration and therefore denies the same, leaving Opposer to its proof.

Opp. Para. 3. By virtue of the Opposer's continuous use of Opposer's Mark, and Opposer's promotional activities, and by virtue of the quality of the goods and services offered under Opposer's Mark, Opposer's Mark has developed goodwill and consumer recognition.

Answer to Opp. Para. 3. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 3 and therefore denies the same, leaving Opposer to its proof.

Opp. Para. 4. Applicant filed an application for the mark MOBILEMD on March 25, 2013 ("Applicant's Mark") for "Mobile device software for use by mobile device users to receive product support and updates for mobile device operating systems and features; mobile device software for monitoring, diagnosing, and fixing mobile device problems and providing helpful advice when using the mobile device; mobile device software for use by mobile device users to facilitate real-time connection and communication with customer support representatives for the diagnosis and repair of mobile devices" in Class 9 and "Software as a Service (SaaS) for use by mobile device operators, manufacturers, and independent service providers to deliver product support and updates for mobile device operating systems and features; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent operators to remotely monitor, diagnose, and correct mobile device problems; Software as a Service (SaaS) for use by mobile device operators, device manufacturers, and independent service providers to connection and communicate in real-time with mobile device users to remotely monitor, diagnose and fix mobile devices" in Class 42 ("Applicant's Good and Services").

Answer to Opp. Para. 4. Admitted.

Opp. Para. 5. There is no issue as to priority. Opposer commenced use of Opposer's Mark in commerce, well prior to Applicant's March 25, 2013 filing date of its intent-to-use Application for MOBILEMD.

Answer to Opp. Para. 5. Applicant admits that Applicant's Application was filed, based on an intent-to-use the mark, on March 25, 2013 but notes that Applicant's mark was in use prior to the filing date of the Application. Applicant also is without knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 5 and therefore denies the same, leaving Opposer to its proof.

Opp. Para. 6. Applicant's Mark is confusingly similar to Opposer's Mark, so as to cause confusion and deceive the public as to origin of Applicant's goods and services to be offered under Applicant's Mark. Consumers and persons will assume, contrary to fact, that Applicant's goods and services are associated with, endorsed by or in some other way related to Opposer and/or Opposer's goods and services.

Answer to Opp. Para. 6. Denied.

Opp. Para. 7. Applicant's Mark is deceptively similar to Opposer's Mark so as to cause confusion and deceive the public as to the origin of Applicant's goods and services to be offered under Applicant's Mark. Consumers and persons in the trade will assume, contrary to the fact, that Applicant's goods and services are associated with, endorsed by or in some other way related to Opposer's goods and services.

Answer to Opp. Para. 7. Denied.

Opp. Para. 8. Opposer alleges and believes for the reasons set forth above, that if Applicant is permitted to use and/or register Applicant's mark in connection with Applicant's goods and services, as specified in the Application, confusion would occur, resulting in damage and injury to Opposer.

Answer to Opp. Para. 8. Applicant denies that confusion, damage or injury will occur due to use or registration of Applicant's mark in connection with Applicant's goods and services; Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 8 regarding Opposer's beliefs and therefore denies the same, leaving Opposer to its proofs.

Opp. Para. 9. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

Answer to Opp. Para. 9. Applicant denies that registration of Applicant's Mark to Applicant would be a source of damage or injury to Opposer.

DEFENSES

Without admitting any of the allegations of the Opposition, Applicant alleges as follows:

FIRST DEFENSE

Applicant's mark MOBILEMD, as used in connection with Applicant's services, is not likely to cause confusion with any of Opposer's marks.

SECOND DEFENSE

In the event that the Board deems such amendments necessary to find that confusion between the parties' marks is not likely and to dismiss the Opposition on that ground, Applicant amends its application under Section 18 of the Lanham Act to cover the following services or such other services as the Board may deem appropriate:

Int'l Class 9

Mobile device software for use by companies providing mobile device wireless carrier services to provide product support and updates for mobile device operating systems and features; mobile device software for use by companies providing mobile device wireless carrier services for monitoring, diagnosing, and fixing mobile device problems; mobile device software for use by companies providing mobile device wireless carrier services to facilitate real-time connection and communication with customer support representatives for the diagnosis and repair of mobile devices

Int'l Class 42

Software as a service (saas) for use by mobile device operators, manufacturers, and independent services providers to deliver product support and updates for mobile device operating systems and features; software as a service (saas) for use by mobile device operators, device manufacturers, and independent operators to remotely monitor, diagnose, and correct mobile device problems; software as a service (saas) for use by mobile device operators, device manufacturers, and independent service providers to remotely monitor, diagnose and fix mobile devices

* * *

Applicant denies each and every allegation of the Opposition not specifically admitted or otherwise specifically responded to herein. Applicant denies that its mark is likely to cause confusion with or otherwise violates or infringes any rights of Opposer. Applicant denies that it

has engaged in any acts that have damaged Opposer. Applicant denies that Opposer is entitled to any relief against Applicant.

* * *

PRAYER FOR RELIEF

WHEREFORE, having fully answered the Opposition, InnoPath respectfully prays that:

- a) the subject Opposition be dismissed and/or denied in its entirety;
- b) judgment be entered in favor of Applicant on the Opposition and each and every claim and count thereof;
- c) the mark MOBILEMD, as applied for in application Serial No. 85/886,016, be allowed to proceed to the Notice of Allowance phase and to eventual registration, either with or without the proposed restriction noted above; and
- d) the Board issue such other and further relief as may be appropriate under the circumstances.

This 20th day of November, 2013.

Respectfully submitted,

KING & SPALDING LLP

By /Kathleen E. McCarthy/

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Attorneys for Applicant
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CERTIFICATE OF SERVICE

This is to certify that I have this day served the foregoing Answer to Notice of Opposition upon Opposer, by causing a true and correct copy thereof to be emailed to Opposer's counsel of record in the subject opposition as follows:

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This 20th day of November, 2013.

/Kathleen E. McCarthy/
Kathleen E. McCarthy