

ESTTA Tracking number: **ESTTA1135**

Filing date: **06/11/2013**

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

Proceeding	92057136
Party	Defendant Catalist Homes, Inc.
Correspondence Address	CATALIST HOMES INC 2601 PACIFIC COAST HIGHWAY, SUITE 302 HERMOSA BEACH, CA 90254 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Michael W Reagor
Filer's e-mail	mreagor@drc-law.com
Signature	/Michael W. Reagor/
Date	06/11/2013
Attachments	2013 06 11 catalyst lending mot for substitution of parties and extension of time to file answer.pdf(387529 bytes)

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

In re Trademark Registration No. 2,956,688
Mark: CATALIST HOMES INC.
Date of Issue: May 31, 2005

CATALYST MORTGAGE, INC.)	CANCELLATION NO. 92057136
)	
Petitioner,)	
)	
vs.)	
)	
CATALIST HOMES, INC.,)	
)	
Registrant.)	

COMBINED (1) MOTION FOR SUBSTITUTION OF PARTIES AND
(2) MOTION FOR EXTENSION OF TIME TO FILE RESPONSE TO PETITION FOR
CANCELLATION

Comes now CATALYST LENDING, INC., Assignee of Registration 2956688, mark CATALIST HOMES, by and through undersigned counsel, and respectfully submits this combined (1) motion for substitution of parties and (2) motion for extension of time to file response to petition for cancellation and as grounds therefore states as follows:

Certificate of Conferral

1. Assignee's attorney has conferred with Petitioner's attorney Susan Hollander via email regarding the relief requested herein and has requested Petitioner's consent to such relief, but as of the filing of this motion has not yet heard back as to whether Petitioner opposes the relief requested herein.

Material Facts.

2. Petitioner has filed a Petition for Cancellation of Trademark Registration 2956688, CATALIST HOMES, on the basis of nonuse ("the Petition"). The Petition was filed on May 1, 2013 and served on the prior attorney of record for Respondent Catalist Homes, Inc. ("Respondent"). On May 13, 2013 Petitioner filed an amended certificate of service confirming corrected service on Respondent. According to the Notice and Trial Dates set by the TTAB, an answer to the Petition is due June 11, 2013.

3. Assignee and Petitioner presently have a dispute regarding the effect of the Respondent's Mark CATALIST HOMES ("the Mark"). In 2008, Assignee's trademark application no. 77359588 for registration of CATALYST LENDING was denied on the basis that Trademark Act Section 2(d) barred the registration of such mark because of likelihood of confusion with the Mark. Subsequently, Petitioner's applications for two registrations of mark CATALYST MORTGAGE were granted without consideration of Registrant's Mark, whereupon Petitioner's Mark CATALYST MORTGAGE was registered in two separate marks, Registrations No. 4175817 and 4133466. On October 16, 2012, Assignee filed trademark application no. 85755734, for mark CATALYST LENDING. On March 15, 2013 the PTO issued an office action in application No. 85755734, denying registration under Section 2(d) on the basis of likelihood of confusion with Petitioner's two marks, Registrations No. 4175817 and 4133466. Petitioner then filed a letter of protest with the PTO, prior to publication, in application 85755734. On May 1, 2013, Petitioner filed this cancellation proceeding. On June 10, 2013 Registrant's Mark was assigned to Assignee and such assignment was filed for recordation with the USPTO. Assignee is thus the legal owner of the Registrant's mark CATALIST HOMES.

Motion for Substitution of Parties

4. At the time the Petition was filed, Respondent Catalist Homes, Inc. was the owner of the mark shown in Registration No. 2956688. Accordingly, Catalist Homes, Inc. was the named Respondent.

5. On June 10, 2013 Respondent assigned all its rights, title, good will, and interest in the Mark to Catalist Lending, Inc. See Exhibit A. On June 10, 2013, Assignee electronically filed the Assignment with the USPTO. See Exhibit B.

6. When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative. TBMP § 512.01.

7. Further, the assignee of a trademark application or registration may prosecute a trademark application, submit documents to maintain a trademark registration, or file papers against a third party in reliance on the assignee's trademark application or registration, to the exclusion of the original applicant or previous assignee. 37 C.F.R. § 3.71.

8. When a mark that is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded with the USPTO or that proof of the assignment has been submitted in the Board proceeding record. TBMP § 512.01. In this case, the assignment has been recorded with the USPTO.

9. Therefore, Assignee Catalyst Lending, Inc. is authorized to seek both a substitution of parties and an extension of time to file a responsive pleading to the Petition.

10. The assignment of the Mark to Catalyst Lending, Inc. terminates all right, title and interest of Catalist Homes, Inc. in the Mark. Therefore, Assignee Catalyst Lending, Inc. has agreed with Catalist Homes, Inc. that, based on the assignment of the Mark to Assignee, defense of Petitioner's Petition for Cancellation should be made by Assignee. Further, Assignee may defend the Petition to the exclusion of named Respondent Catalist Homes, Inc.. 37 C.F.R. § 3.71. Therefore, Assignee requests that the Board substitute Catalyst Lending, Inc. as the named Respondent in the Petition, in place of Catalist Homes, Inc..

Motion for Extension of Time to File Response to Petition for Cancellation.

11. Counsel for Assignee was retained relating to this Petition for Cancellation within only the last several days. Assignee and its relevant employees and agents need additional time to confer with their attorneys regarding the allegations in and defenses to the Petition, which cannot be adequately accomplished before June 11. Because of the unique circumstances herein, additional time is also needed to consider the necessity of filing a counterclaim for cancellation of Petitioner's mark. Further, press of undersigned's other business necessitates additional time to file an answer. Such other business includes but is not limited to a multi-day multi-party settlement conference in a complex commercial litigation case, Arapahoe County, Colorado State District Court Case No. 2008 CV 2323, wherein undersigned is lead plaintiff's counsel, which is scheduled to begin June 17, 2012 in San Diego, CA. This and other immediate obligations prevent immediate attention to preparation of a response prior to close of business June 11. For these reasons, Assignee needs an extension of time of up to 30 days, through and including July 11, to file an answer and assert any counterclaims to the Petition. This is the first

requested extension in this matter on any matter and the short delay should not prejudice any party or the PTO.

12 Under TBMP 310.03(c) and 509.01, the time for filing an answer may be extended by order of the Board, upon a showing of good cause established with particularity of facts.

Assignee was not made aware of the Petition at the time of the Petition's filing or the filing of the amended Certificate of Service but instead was notified of the Petition only within the last few days. Assignee also just retained undersigned firm in representation of Assignee in this proceeding. Assignee's counsel needs additional time to prepare an answer and possibly a counterclaim, in order to adequately consider the Petition and because of other pre-existing obligations which prevent immediate consideration of the Petition. These specific facts demonstrate that the need for a short extension was not necessitated by Assignee's lack of diligence or unreasonable delay in taking required action. Therefore, good cause exists to grant Assignee an extension of time to file an answer and counterclaim. See TBMP 509.01(a), note 1 (cases discussing good cause under similar circumstances); see, e.g., Societa Per Azioni Chianti Ruffino Esportazione Vinicola Toscana v. Colli Spolentini Spoletoducali SCRL, 59 USPQ2d 1383 (TTAB 2001);

13. Therefore, Assignee requests up to a thirty (30) day extension, through and including July 11, 2013, within which to file a response to the Petition as well as any counterclaim.

WHEREFORE, Assignee Catalyst Lending, Inc. requests that the Board grant the following relief:

(a) substitute Calatyst Lending, Inc. as named Respondent for Catalyst Homes, Inc.; and

(b) grant Catalyst Lending, Inc. an extension of time, through and including July 11, 2013 within which to file an answer to the Petition for Cancellation and to file any counterclaim.

Respectfully submitted,

DYMOND • REAGOR • COLVILLE, LLP

By: 

Michael W. Reagor, Esq.
Anna E. Lineberger, Esq.
8400 E. Prentice Avenue, Suite 1040
Greenwood Village, CO 80111
(303) 793-3400

ATTORNEYS FOR CATALYST LENDING, INC.

CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of June, 2013, a true and correct copy of the foregoing COMBINED (1) MOTION FOR SUBSTITUTION OF PARTIES, AND (2) MOTION FOR EXTENSION OF TIME TO FILE RESPONSE TO PETITION FOR CANCELLATION was mailed postage prepaid through the U.S. Mail and served electronically via email, return receipt requested, to the following:

Susan E. Hollander, Esq.
Susan.Hollander@klgates.com
Jocelyn M. Belloni, Esq.
Jocelyn.Belloni@klgates.com
K&L Gates LLP
4 Embarcadero, Suite 1200
San Francisco, CA 94111

/s Lisa K. Evans



TRADEMARK ASSIGNMENT

WHEREAS, Catalist Homes, Inc. organized under the laws of the State of Delaware, with its principal place of business at 2601 Pacific Coast Highway, Suite 302, Hermosa Beach, California, 90254 ("Assignor"), has adopted, owns, has used, and is using the Trademarks set forth on the attached Schedule of Trademarks without any intent to abandon such Trademarks; and

WHEREAS, Catalyst Lending, Inc., organized and existing under the laws of the State of Colorado, with its principal place of business at 6530 South Yosemite Street, Suite 310, Greenwood Village, Colorado 80111 ("Assignee"), is desirous of acquiring any and all rights that Assignor may have throughout the world in and to the Trademarks and the applications and registrations therefore, together with the goodwill of the business in connection with which the Trademarks are used and which is symbolized by the Trademarks, throughout the world, along with the right to recover for damages and profits for any past, present, or future infringements thereof; and

NOW, THEREFORE, for ten dollars (\$10.00) and other good and valuable consideration, receipt of which is hereby acknowledged, Assignor does hereby assign unto Assignee all of Assignor's rights, title, and interest in and to the Trademarks and the registrations therefor, together with the goodwill of the business in connection with which the Trademarks are used and which is symbolized by the Trademarks, throughout the world, along with the right to recover for damages and profits for past, present, or future infringements thereof.

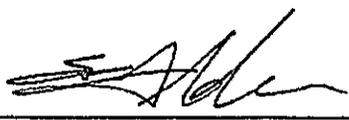
Assignor agrees to execute and deliver at the request of the Assignee, all papers, instruments, and assignments, and to perform any other reasonable acts the Assignee may require in order to vest all Assignor's rights, title, and interest in and to the Trademarks to the Assignee and/or provide evidence to support any of the foregoing in the event such evidence is necessary to effectuate the assignment, to the extent such evidence is in the possession or control of the Assignor.

Assignee hereby releases Assignor from all claims that may be made against Assignor, Erik Anderson or WestRiver Management, LLC ("Released Assignors") for infringement of the Trademarks and warrants that no such claims shall be made by Assignee against any of the Released Assignors.

Agreed and accepted as dated this 10th day of June, 2013.

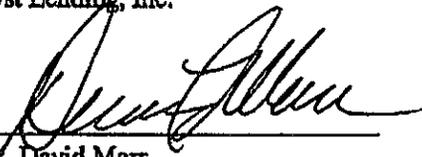
ASSIGNOR

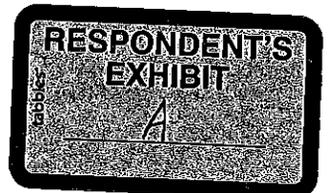
Catalist Homes, Inc.

By: 
Name: Erik Anderson
Title: *Managing Member*

ASSIGNEE

Catalyst Lending, Inc.

By: 
Name: David Marr
Title: Chief Executive Officer



STATE OF Washington)

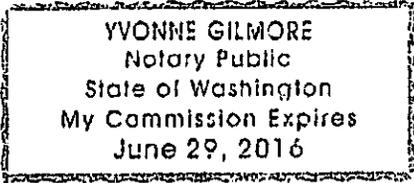
) ss.

COUNTY OF King)

SUBSCRIBED and sworn before me by Erik Anderson, Managing Member (title) for Catalist Homes, Inc., the Assignor, as the voluntary act and deed of the Assignor, this 10th day of June, 2013.

Witness my hand and official seal.

[SEAL]



Notary Public Yvonne Gilmore
My commission expires: 6.29.2016

STATE OF COLORADO)

) ss.

COUNTY OF Arapahoe)

SUBSCRIBED and sworn before me by David Marr, Chief Executive Officer for Catalyst Lending, Inc., the Assignee, as the voluntary act and deed of the Assignee, this 10th day of June, 2013.

Witness my hand and official seal.

[SEAL]

CATRINA L. GEATHERS
NOTARY PUBLIC
STATE OF COLORADO
NOTARY ID 20084040135
MY COMMISSION EXPIRES NOVEMBER, 28 2016

Notary Public *Catrina L. Geathers*
My commission expires: 11/28/2016

SCHEDULE OF TRADEMARKS

Registered Trademarks

<i>Trademark</i>	<i>U.S. Registration No.</i>	<i>Goods and Services</i>
Catalist Homes, Inc.	2956688	Real estate brokerage and real estate listing services

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,956,688

Registered May 31, 2005

**SERVICE MARK
PRINCIPAL REGISTER**



**CATALIST
HOMES INC.**

CATALIST HOMES, INC. (DELAWARE COR-
PORATION)
2601 PACIFIC COAST HIGHWAY, SUITE 302
HERMOSA BEACH, CA 90234

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE HOMES INC., APART FROM THE
MARK AS SHOWN.

FOR: REAL ESTATE BROKERAGE AND REAL
ESTATE LISTING SERVICES, IN CLASS 36 (U.S. CLS.
100, 101 AND 102).

SER. NO. 76-574,261, FILED 2-6-2004.

FIRST USE 3-20-2001; IN COMMERCE 3-20-2001.

KELLY CHOE, EXAMINING ATTORNEY



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Thu Jun 6 02:20:23 EDT 2013

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CATALIST HOMES INC.

Word Mark CATALIST HOMES INC.

Goods and Services IC 036, US 100 101 102. G & S: Real estate brokerage and real estate listing services. FIRST USE: 20010320. FIRST USE IN COMMERCE: 20010320

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 01.15.06 - Advertising, skywriting; Clouds; Fog
 07.01.04 - Detached house
 07.11.11 - Highways without lines or dividers; Intersections (roads) without lines or dividers; Roads without lines or dividers; Streets without lines or dividers
 07.13.03 - Advertising, signs, mounted or with posts or standards; Street signs (mounted on posts)
 26.11.09 - Rectangles made of geometric figures, objects, humans, plants or animals
 26.11.20 - Rectangles inside one another
 26.11.21 - Rectangles that are completely or partially shaded
 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters

Serial Number 76574261

Filing Date February 6, 2004

Current Basis 1A

Original Filing Basis 1A

Published for Opposition March 8, 2005

Registration Number 2956688
Registration Date May 31, 2005
Owner (REGISTRANT) Catalist Homes, Inc. CORPORATION DELAWARE 2601 Pacific Coast Highway, Suite 302 Hermosa Beach CALIFORNIA 90254
Attorney of Record Julla Anne Matheson, Esq.
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE HOMES INC. APART FROM THE MARK AS SHOWN
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

TESS Home	NEW USER	STRUCTURED	FREE FORM	BROWSE DOC	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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Electronic Version v1.1
Stylesheet Version v1.1

Form containing submission details: SUBMISSION TYPE (NEW ASSIGNMENT), NATURE OF CONVEYANCE (ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL), CONVEYING PARTY DATA (Catalist Homes, Inc.), RECEIVING PARTY DATA (Catalyst Lending, Inc.), and PROPERTY NUMBERS (Total: 1).



CORRESPONDENCE DATA**Fax Number:** 8668617066**Phone:** 3037933400**Email:** mreagor@drc-law.com*Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent via US Mail.***Correspondent Name:** Michael W Reagor**Address Line 1:** 8400 East Prentice Avenue #1040**Address Line 4:** Greenwood Village, COLORADO 80111**NAME OF SUBMITTER:**

Michael W. Reagor

Signature:

/michael w. reagor/

Date:

06/10/2013

Total Attachments: 7

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