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

| | |
|------------------------|---|
| Proceeding | 91209778 |
| Party | Defendant Catamaran Inc. |
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| Submission | Motion to Dismiss - Rule 12(b) |
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| Date | 04/24/2013 |
| Attachments | Motion to Dismiss 91209778.pdf (5 pages)(316694 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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|--------------------------------|---|---|
| SHIPCOM WIRELESS, INC., |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition Nos. 91209778 |
| |) | |
| CATAMARAN, INC., |) | Serial No. 85/654,697 |
| Applicant. |) | |
| |) | Mark: |
| |) |  |
| |) | catamaran |

MOTION TO DISMISS

Pursuant to 37 C.F.R. §2.127 and all other applicable rules, Applicant, Catamaran Inc. hereby moves the Board for an order dismissing the above-captioned Opposition Proceeding in this matter filed by Opposer, Shipcom Wireless, Inc. (“Shipcom”), against Serial No. 85/654,697 in connection with Class 35 for the above-identified CATAMARAN design mark (“Subject Application”).

Facts

Applicant filed an application for the CATAMARAN word mark (Serial No. 85/625,926) on May 15, 2012, which was published on August 7, 2012 (the “CATAMARAN Word Mark Application”). The CATAMARAN Word Mark Application covered four classes: 9, 35, 36 and 44.

Nearly four (4) months after the CATAMARAN Word Mark Application was published (and after receiving two extensions of time), on December 4, 2012, Shipcom filed an opposition to the CATAMARAN Word Mark Application (Opposition No. 91208297) challenging only Class 9. There was no opposition in Classes 35, 36, or 44.

A day after Shipcom filed Opposition No. 91208297 against the CATAMARAN Word Mark Application, on December 5, 2012, Applicant filed a motion requesting the division of the CATAMARAN Word Mark Application into two separate applications: one application for the CATAMARAN word mark in Class 9 and another for the CATAMARAN word mark in Classes 35, 36 and 44. Applicant's motion to divide the CATAMARAN Word Mark Application into two separate applications was not contested by Shipcom.

On January 11, 2013, the TTAB granted the motion and divided the CATAMARAN Word Mark Application into a "parent" application (Serial No. 85/625,926) to include the goods identified in Class 9 and a new "child" application (Serial No. 85/978,290) to include the services identified in Classes 35, 36 and 42 that were unopposed. The child application, Serial No. 85/978,290, shall be referred to hereinafter as "the Morehouse Application".

The TTAB directed that the Morehouse Application be forwarded to the Publication and Issue section of the Trademark Office for issuance and allowed the opposition against the parent application in Class 9 (Serial No. 85/625,926) to continue. The Morehouse Application is expected to imminently mature into a registration.

After consenting to the registration of the CATAMARAN word mark in Class 35, Shipcom filed this Opposition against essentially the same mark in Classes 9 **and 35**. Strangely, despite its prior actions allowing the CATAMARAN mark to register in Class 35, Shipcom now alleges that it will be harmed by the registration of the CATAMARAN mark in Class 35.

Argument

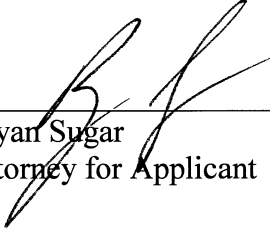
Shipcom's claim of likelihood of confusion against Class 35 of the Subject Application is barred under the *Morehouse* defense. The *Morehouse* defense is an equitable doctrine that applies where an applicant in an opposition proceeding owns a prior registration for essentially the same mark identifying essentially the same services as the subject mark and goods at issue in the opposition. *Morehouse Mfg. Corp.*, 160 USPQ 715 (CCPA 1969). In such a case, the opposition cannot be sustained because there is no added damage from the 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 *Morehouse* defense applies here because Applicant will shortly own a registration (i.e. the Morehouse Application that will soon mature into a registration) for essentially the same mark identifying the same services as the Subject Application. On its face, it is evident that the Subject Application contains the same goods and services as the Morehouse Application. Moreover, Shipcom admits the Morehouse Application is essentially the same mark as the Subject Application in its Notice of Opposition. *See* Notice of Opp. ¶ 9 (“The primary distinctive element of Applicant’s proposed [Subject Application Mark] is identical to [Shipcom’s] registered CATAMARAN mark—the term CATAMARAN is the dominant element of both marks, making Applicant’s and [Shipcom’s] respective marks confusingly similar in appearance, sound, meaning, and commercial impression.”). Thus, whatever the injury Shipcom may have sustained or may sustain from the CATAMARAN mark in Class 35 by virtue of the registration of the Morehouse Application, it cannot be increased by the registration of the Subject Application.

Shipcom 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 Original Application and failed to contest the division of the Original Application, which allowed the Morehouse Application to proceed to registration. Accordingly, Shipcom has failed to state a claim in connection with its opposition of Class 35 of the Subject Application and the Opposition with respect to Class 35 should be dismissed with prejudice.

Respectfully submitted,
UNGARETTI & HARRIS

Dated: April 24, 2013

By: 
Bryan Sugar
Attorney for Applicant

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing 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 24th day of April, 2013.


Maureen R. Smith