

ESTTA Tracking number: **ESTTA1153994**

Filing date: **08/18/2021**

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

Proceeding	91268673
Party	Defendant Trimble Inc.
Correspondence Address	ANDREA ANDERSON HOLLAND & HART LLP P.O. BOX 8749 ATTN: TRADEMARK DOCKETING DENVER, CO 80201-8749 UNITED STATES Primary Email: docket@hollandhart.com Secondary Email(s): aanderson@hollandhart.com, ljheld@hollandhart.com, ml-lapidus@hollandhart.com 303.473.2861
Submission	Motion to Join/Substitute Party
Filer's Name	Kathryn Starshak
Filer's email	kate.starshak@klgates.com, ttablitigationdocket@klgates.com
Signature	/Kathryn Starshak/
Date	08/18/2021
Attachments	Motion to Join MANHATTANONE Opposition.pdf(76320 bytes) Exhibit A - ManhattanOne Motion.pdf(323738 bytes)

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

In the Matter of U.S., Trademark Application Serial No. 88/839,081
For the Mark: MANHATTANONE
Filing Date: March 18, 2020
Publication Date: October 13, 2020

MANHATTAN ASSOCIATES, INC.,)	
)	
)	
)	
v.)	Opposition No. 91268673
)	
TRIMBLE INC.,)	
)	
Applicant.)	
)	

CONSENTED MOTION TO SUBSTITUTE APPLICANT

MRI Occupier LLC (“MRI Occupier”) with the consent of counsel for Opposer, Manhattan Associates, Inc., hereby moves to be formally substituted as the Applicant in this proceeding. In the alternative, MRI Occupier requests that it be formally joined as an Applicant for the purposes of this action. In support of its motion, MRI Occupier states as follows:

1. On March 18, 2020, Trimble Inc. (“Trimble”) filed Application Serial No. 88/839,081 for MANHATTANONE (the “Application”).
2. On April 12, 2021, Opposer filed a Notice of Opposition against the Application.
3. Effective as of April 12, 2021, in connection with an Asset Purchase Agreement, Trimble assigned the entire interest in the Application and its subject mark to MRI Occupier. The assignment was submitted for recordation with the PTO on August 18, 2021. Copies of the assignment and the request for recordation are attached as Exhibit A.

4. MRI Occupier has standing to take action in this matter as assignee of the Application.

5. Kathryn Starshak of K&L Gates LLP, 70 W. Madison Street, Suite 3300, Chicago, IL 60602, hereby appears as counsel of record for MRI Occupier in this Opposition Proceeding. All pleadings and papers should be sent the following address:

Kathryn Starshak
K&L Gates LLP
70 W. Madison Street, Suite 3300
Chicago, IL 60602
TTABLitigationDocket@klgates.com, kate.starshak@klgates.com,
Phone: 312-781-6013

6. Counsel for Opposer has consented to this motion and the substitution of MRI Occupier as the Applicant in the Opposition.

Respectfully submitted,

Date: August 18, 2021

By: /Kathryn Starshak/
Kathryn Starshak
Attorney for MRI Occupier LLC

CERTIFICATE OF SERVICE

I, Kathryn Starshak, hereby certify that a true and correct copy of the foregoing CONSENTED MOTION TO SUBSTITUTE APPLICANT was served upon counsel of record for Opposer Manhattan Associates, Inc. via electronic mail on August 18, 2021, by sending to the email address shown below:

Nancy Lapidus
The Law Office of Nancy Lapidus, PLLC
5335 Wisconsin Avenue, N.W.
Suite 440
Washington, D.C. 20015
nancy.lapidus@lapiduslawoffice.com

/Kathryn Starshak/
Kathryn Starshak

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
 Stylesheet Version v1.2

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Trimble, Inc.		04/12/2021	Corporation: DELAWARE
RECEIVING PARTY DATA			
Name:	MRI Occupier LLC		
Street Address:	28925 Fountain Parkway		
City:	Solon		
State/Country:	OHIO		
Postal Code:	44139		
Entity Type:	Limited Liability Company: DELAWARE		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Serial Number:	88839081	MANHATTANONE	
CORRESPONDENCE DATA			
Fax Number:	3128278185		
Phone:	312-781-6013		
Email:	citrademarks@klgates.com, valerie.swanson@klgates.com, kate.starshak@klgates.com		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Correspondent Name:	Kathryn Starshak c/o K&L Gates LLP		
Address Line 1:	P.O. Box 1135		
Address Line 4:	Chicago, ILLINOIS 60690-1135		
ATTORNEY DOCKET NUMBER:	0817770.00117		
NAME OF SUBMITTER:	Kathryn Starshak		
Signature:	/Kathryn Starshak/		
Date:	08/18/2021		

Total Attachments: 2

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RECEIPT INFORMATION

ETAS ID: TM668476
Receipt Date: 08/18/2021
Fee Amount: \$40

TRADEMARK ASSIGNMENT

THIS TRADEMARK ASSIGNMENT (this "Assignment") is made and entered into as of April 12, 2021 ("Effective Date") by and between Trimble, Inc., a Delaware corporation, 935 Stewart Drive, Sunnyvale, California, USA 94085 ("Assignor"), and MRI Occupier LLC, a Delaware limited liability company, 28925 Fountain Parkway, Solon, Ohio 44139 ("Assignee").

WHEREAS, Assignor wishes to assign to Assignee, and Assignee wishes to acquire from Assignor, the trademark and trademark application set forth on Schedule A attached hereto, together with the goodwill of the business associated therewith (the "Mark");

NOW, THEREFORE, in consideration of the sum of US\$10.00 and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor hereby sells, assigns, transfers and sets over to Assignee the entire right, title and interest in and to the Mark, for the United States and for all foreign countries, including, without limitation, any registrations and applications therefor, any renewals and extensions of the registrations, and all other corresponding rights that are or may be secured under the laws of the United States or any foreign country, now or hereafter in effect, for Assignee's own use and enjoyment, and for the use and enjoyment of Assignee's successors, assigns or other legal representatives, as fully and entirely as the same would have been held and enjoyed by Assignor if this Assignment had not been made, together with all income, royalties or payments due or payable as of the Effective Date or thereafter, including, without limitation, all claims for damages by reason of past, present or future infringement or other unauthorized use of the Mark, with the right to sue for, and collect the same for Assignee's own use and enjoyment and for the use and enjoyment of its successors, assigns or other legal representatives.

Assignor hereby requests the Commissioner of Patents and Trademarks, and the corresponding entities or agencies in any applicable foreign countries, to record Assignee as the assignee and owner of the Mark.

TRIMBLE, INC.



Name: James A. Kirkland

Title: Senior VP, General Counsel and Secretary

MRI OCCUPIER, LLC



Name: Roman Telerman

Title: Chief Financial Officer

**Schedule A
Trademarks**

<u>Trademark</u>	<u>Jurisdiction</u>	<u>App. Number</u>	<u>App. Date</u>
ManhattanONE	United States of America	88839081	March 18, 2020



REAL ESTATE SOFTWARE

Certificate of Completion

Document Number: dde65494-1981-417b-b73c-45b1d2c3f2cf

Document Name: MANHATTANONE Trademark Assignment (part 1) - signed

Date Created: 8/17/2021 12:24:42 PM EDT

Date Modified: 8/17/2021 12:26:00 PM EDT

Document Owner: Katey Burgwald

Signatures: 1

Roman Teberman

Signed: 8/17/2021 12:26:00 PM EDT

IP Address: 38.68.81.4

MRI Secure Sign Signature by:

Roman Teberman

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