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OF THE TRADEMARK TRIAL  
AND APPEAL BOARD

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

Baxley

Mailed: October 18, 2005

Cancellation No. 92042159

Borland Software Corporation

v.

EMSoftware Solutions, Inc.

Before Seeherman, Quinn and Walters,  
Administrative Trademark Judges

By the Board:

EMSoftware Solutions, Inc. ("respondent") is the record owner of a registration for the mark SNAP in standard character form for "computer software used in the design of other computer software programs" in International Class 9.<sup>1</sup>

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<sup>1</sup> Registration No. 1769816, issued May 11, 1993; renewed. Under the circumstances, a description of the chain of title of the involved registration is appropriate:

Software Architecture and Engineering, Inc., a Maryland corporation ("Software"), filed underlying application Serial No. 74256895 on March 19, 1992, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), alleging May 22, 1989 as the date of first use and date of first use in commerce.

A document reflecting Software's name change to Template Software, Inc. ("Template Maryland") was executed on March 12, 1992 and was recorded with the USPTO's Assignment Branch at Reel 0878, Frame 0479 on June 30, 1992. The involved registration was issued to Template Maryland.

A document reflecting Template Maryland's merger into Template Software, Inc., a Virginia corporation ("Template Virginia"), was executed on October 28, 1996 and recorded with the Assignment Branch at Reel 2053, Frame 0177 on March 20, 2000.

A document reflecting Template Virginia's merger into TSAC, Inc. ("TSAC") was executed on December 27, 1999 and recorded with the Assignment Branch at Reel 2640, Frame 0556 on April 28, 2003.

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Borland Software Corporation ("petitioner") filed a petition to cancel the involved registration on the ground of abandonment based on respondent's having "ceased ... use [of the involved mark] at least three (3) years prior to the date hereof with no intent to resume." In its answer, respondent denied the salient allegations of the petition to cancel.

This case now comes up for consideration of respondent's renewed motion (filed January 25, 2005) for summary judgment in its favor on petitioner's abandonment claim. Petitioner has filed a brief in opposition thereto.

As an initial matter, we note that respondent has filed all of its exhibits in support of its renewed motion for summary judgment under seal. Respondent is advised, however, that only that information which is truly confidential in nature, such as sales and advertising figures and customer names, should be marked "confidential" and filed under seal. When parts of a paper or document are marked "confidential" and filed under seal, the submitting

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A document reflecting TSAC's merger into Level 8 Technologies, Inc. ("Level 8") was executed on December 31, 2000 and was recorded at Reel 2640, Frame 0565 on April 28, 2003.

A document reflecting the assignment of Registration No. 1769816 from Level 8 to EMSSoftware Solutions, Inc. was executed on December 13, 2002 and was recorded at Reel 2540, Frame 0573 on April 28, 2003.

Petitioner named "Template Software, Inc." as the party defendant in the petition to cancel. However, the Board instituted this proceeding with EMSSoftware Solutions, Inc. identified as the party defendant.

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party should also file in the normal manner a copy of the paper or document in question, with the confidential matter redacted therefrom, for the file record. Board proceedings are open to the public, and with the exception of information which is truly confidential in nature, a party's filings may not be shielded from public view by filing them under seal. See Trademark Rules 2.27(d) and (e). See also, TBMP Section 412.04 (2d ed. rev. 2004), regarding filing of confidential materials with the Board. Respondent is hereby ordered to file, for the public record, within thirty days of the mailing date of this order a copy of its renewed motion for summary judgment with redacted copies of exhibits in support thereof that were previously filed under seal, failing which copies marked "confidential" will be placed in the public record.

Turning to the renewed motion for summary judgment, we note that respondent, on February 17, 2004, filed an earlier motion for summary judgment in its favor on petitioner's abandonment claim and that the Board, in an October 28, 2004 decision, denied that motion. In that decision, the Board noted that respondent relied primarily upon its president's "vague" declaration and "heavily redacted" copies of an asset purchase agreement and two licensing and maintenance agreements asserted by respondent to show continuous use of the subject mark. The Board ruled that "respondent has not

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proven the absence of a genuine issue of fact as to abandonment such that respondent is entitled to summary judgment as a matter of law."

As part of that decision, the Board imposed its standard form protective order on the parties. The parties subsequently filed acknowledgments of the protective order. We note that the protective order was imposed on the parties roughly eighteen months after the commencement of this proceeding and after the close of the discovery period herein. Respondent filed its renewed motion for summary judgment less than three months after the Board's denial of its first motion for summary judgment.

A review of respondent's two motions for summary judgment indicates that both seek entry of summary judgment in respondent's favor on petitioner's abandonment claim. It is also apparent that the renewed motion is based on evidence that was available to respondent or was within respondent's control at the time the first motion for summary judgment was filed. Respondent contends that its renewed motion is based on more complete information concerning use of the mark during the years in question and includes confidential business information. This information, according to respondent, discloses customer identities and, thus, could only be disclosed under a protective order.

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The underlying purpose of motions for summary judgment is judicial economy. See TBMP Section 528.01 (2d ed. rev. 2004). To allow a party to file repeated motions for summary judgment on the same ground based on evidence that was available to it when it filed its first motion for summary judgment is in contravention of that purpose and unhelpful to the judicial process. Respondent contends that the more complete selection of documents in support of its second motion for summary judgment divulges confidential business information, such as customer names, that could only be disclosed during discovery to petitioner under a protective order. However, respondent could have produced copies of those documents with customer names redacted in discovery prior to the entry of the protective order and relied upon those redacted copies in support of its earlier motion for summary judgment.<sup>2</sup> As such, we are unwilling to allow respondent to use the parties' failure to reach agreement with regard to the filing and handling of confidential materials prior to the filing of its first motion for summary judgment as a means of filing a renewed motion for summary judgment on the same ground.<sup>3</sup>

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<sup>2</sup> In such a situation, if petitioner had felt it necessary to obtain the actual customer names in order to respond to the motion, the parties could have entered into a protective order at that point.

<sup>3</sup> Even if we had considered respondent's renewed motion for summary judgment on its merits, it is insufficient to show that

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Accordingly, respondent's renewed motion for summary judgment is hereby denied. In view of the fact that this is respondent's second motion for summary judgment on the same ground, with both motions having been denied by the Board, respondent is hereby ordered not to file any additional summary judgment motions in this case.

Proceedings herein are resumed. Trial dates are reset as follows.

Plaintiff's 30-day testimony period to close: **12/16/05**

Defendant's 30-day testimony period to close: **02/14/06**

15-day rebuttal testimony period to close: **03/31/06**

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 the 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.

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there are no genuine issues of material fact regarding the claim of abandonment.