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

Proceeding	85979129
Applicant	Epiq Systems, Inc.
Applied for Mark	DMX MOBILE
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Submission	Motion to Consolidate with Serial No. 85978692 and Reset Consolidated Briefing Date
Attachments	Motion to Consolidate and Reset Consolidated Briefing Date.pdf(75326 bytes)
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Date	07/24/2014

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

Applicant: Epiq Systems, Inc.)
)
Marks: DOCUMATRIX MOBILE)
 DMX MOBILE)
)
Applications: SN 85/978,692, 85/979,129)
)
Classes: 42, 45)

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO CONSOLIDATE AND RESET BRIEFING SCHEDULE

Dear Sir:

Applicant respectfully requests that Board consolidate the above captioned applications, and that in accordance with the Board's practice, the Board reset the Applicant's first briefing date for the consolidated cases to September 5, 2014.

Applicant submits that good cause supports Applicant's request. This good cause is as follows:

- 1) The applicant in each case is identical, as is the Examiner;
- 2) The marks are similar (Applicant and its customers use the marks involved interchangeably. DMX MOBILE is a shorthand version of DOCUMATRIX MOBILE, as reflected in the applications);
- 3) The appealed issues in each cases are identical; that is whether the specimens of use are acceptable;
- 4) The specimens in each case are, in part, identical; and

5) The records are similar.

FACTS

In application Serial Number 85/978,692 for the mark DOCUMATRIX MOBILE, on March 1, 2013 Applicant submitted its Statement of Use and an eight-page excerpt from a brochure (with the entire brochure being submitted on September 4, 2013) in support of its Statement of Use for services in Classes 42 and 45, specifically:

Class 42:

Consulting in the field of technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; leasing of computer software that stores and manages documents, digital media, text, sound and images in the fields of electronic discovery, internal corporate matters, compliance, second requests, litigation, investigations and document management

Class 45:

Litigation support services, namely, conducting electronic discovery and document review of electronically stored information that could be relevant in legal proceedings; legal consultation services

On March 19, 2013, The Examining Attorney issued an office action finding the specimen unacceptable.

On September 4, 2013, without waiving its position that the first specimen was acceptable, Applicant submitted the entire brochure, together with a second additional

specimen. This additional specimen consisted of a separate and independent two-page brochure for both DOCUMATRIX MOBILE and DMX MOBILE.

On October 1, 2013, the Examining Attorney issued an office action finding the new specimens submitted on September 4, 2013 unacceptable, stating, in part, that Applicant's DOCUMATRIX MOBILE is a "software platform" and that the specimens did not show the applied for mark to be in use in relation to any of the services in Classes 42 and 45 as identified in the application.

Applicant filed a Request for Reconsideration and Affidavit of Jayne Rothman, General Counsel of Applicant, on April 1, 2014. This Request was refused three days later, on April 4, 2014. Applicant timely appealed.

A similar pattern of events and consequences occurred in relation to Applicant's companion application, SN 85/979,129, for the mark DMX MOBILE.

Specifically, on April 15, 2013, Applicant submitted a Statement of Use for DMX MOBILE for the exact same services identified for DOCUMATRIX MOBILE, namely:

Class 42:

Consulting in the field of technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; leasing of computer software that stores and manages documents, digital media, text, sound and images in the fields of electronic discovery, internal corporate matters, compliance, second requests, litigation, investigations and document management

Class 45:

Litigation support services, namely, conducting electronic discovery and document review of electronically stored information that could be relevant in legal proceedings; legal consultation services

On April 15, 2013, Applicant submitted its Statement of Use. Applicant submitted the exact same two page brochure as had been submitted as an additional specimen in SN 85/978692.

On May 6, 2013, the Examining Attorney found the specimen similarly unacceptable and on the same grounds, i.e. that the specimens at best indicate that the mark is being used to identify a “software platform”, a service distinct from any identified in the Statement of Use.

When the Examiner issued a final refusal, Applicant filed, on November 8, 2014, a Request for Reconsideration and the Affidavit of Jayne Rothman. This response was similarly rejected.

In both cases, Applicant timely filed a Notice of Appeal. The brief for DOCUMATRIX MOBILE SN 85/978,692 is currently due on August 6, 2014. The brief for DMX MOBILE SN 85/979,129 is currently due September 5, 2014.

ARGUMENT

The Board consolidates cases where doing so would promote judicial economy and consistency. Applicant respectfully submits that granting Applicant’s motion would be in the interests of the parties and the Board. Granting Applicant’s motion will permit

the Applicant and the Examiner to write – and the Board to review- one set of briefs, comprising one record and arguments. It will also permit the Board to issue one decision.

Thus, as it would promote the interests of judicial economy, efficiency and consistency, Applicant respectfully submits that the Board should grant Applicant's motion to consolidate.

In accordance therewith, if consolidation is granted, Applicant respectfully requests that the Board reset the due date for Applicant's brief on the consolidated case such that it shall become due on September 5, 2014, (the date currently set for the least advanced case.)

Date July 24, 2014

Respectfully submitted,

EPIQ SYSTEMS, INC.

By ___/Carla C Calcagno/____
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