

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

MBA

Mailed: October 12, 2011

Opposition No. 91200167

M2 Software, Inc, .

v.

Higher Logic, LLC

Michael B. Adlin, Interlocutory Attorney:

On October 7, 2011, at applicant's request, the Board participated in the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2). Opposer appeared pro se through David Escamilla, its President and Chief Executive Officer, Lauri S. Thompson and Laraine Burrell appeared on applicant's behalf and the interlocutory attorney responsible for this proceeding participated on the Board's behalf.

Discovery Conference Summary

Opposer indicated that it does not intend to obtain an attorney to represent it. The Board advised opposer that it is generally recommended that parties retain experienced trademark practitioners to represent them in Board

proceedings.¹ The Board also indicated that opposer would be expected and required to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in 37 C.F.R. § 2.119, regardless of whether or when opposer retains counsel. The parties were directed to the following sources of information which may be useful, among others:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp

<http://ttabvue.uspto.gov/ttabvue/>

<http://www.uspto.gov/trademarks/process/appeal/tmlaw2.pdf>

http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf

During the teleconference, the parties agreed to accept service of papers by e-mail, pursuant to Trademark Rule 2.119(b)(6).

The parties have only had cursory discussions thus far. During the teleconference, applicant proposed a resolution to this dispute, but opposer was not willing to agree to it. Opposer is encouraged to consult with an attorney regarding applicant's proposal, and its impact, or lack thereof, on opposer. More generally, the parties are strongly encouraged to work together to resolve this proceeding, including by exchanging information and/or documents

¹ Information for parties representing themselves pro se is included at the end of this order.

informally, so as to better evaluate this proceeding prior to it advancing to discovery or trial.

The parties discussed the pleadings, including opposer's sole claim of priority and likelihood of confusion. While opposer pleads ownership of a registration, which applicant has not counterclaimed to cancel, opposer has not yet introduced its pleaded registration into evidence, and applicant was not prepared to stipulate that priority is not an issue in this proceeding. Nevertheless, it may become clear in the future that priority is not at issue, and formally acknowledging this could significantly streamline this proceeding. Unrelated to the issue of priority, applicant indicated that it may seek leave to amend its answer. Opposer may wish to consider stipulating to the filing of an amended answer, so as to avoid motion practice or any delay.

In any event, whether priority is at issue or not, it is clear that this case is quite straightforward, and the relevant facts appear relatively limited. Therefore, the Board reminded the parties of their option to stipulate to limits on discovery, abbreviated procedures for submission of evidence and other ways to expedite resolution of this case. See, Target Brands Inc. v. Hughes, 85 USPQ2d 1676 (TTAB 2007). The Board also discussed the possibility of the parties making greater reciprocal disclosures than

required by Fed. R. Civ. P. 26(a)(1), in lieu of formal discovery. See, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 71 Fed. Reg. 2498 (January 17, 2006). Applicant proposed specific limits to discovery, to which opposer was unwilling to agree during the teleconference, and opposer proposed a method of introducing "business records" into evidence, to which applicant was unwilling to agree during the teleconference. Nevertheless, the parties agreed to consider these and other possibilities in the future.

On a related note, the Board indicated that this case appears particularly appropriate for Accelerated Case Resolution ("ACR"). The parties agreed to consider this possibility, and are directed to:

<http://www.uspto.gov/trademarks/process/appeal/acrognoticerule.pdf>

[http://www.uspto.gov/trademarks/process/appeal/accelerated case resolution acr faq.doc](http://www.uspto.gov/trademarks/process/appeal/accelerated%20case%20resolution%20acr%20faq.doc)

[http://www.uspto.gov/trademarks/process/appeal/acrcase list.doc](http://www.uspto.gov/trademarks/process/appeal/acrcase%20list.doc)

Although applicant is "very open" to ACR, opposer was unwilling to agree to it during the teleconference, though it is encouraged to consider this possibility further.

The Board's standard protective order is applicable herein by operation of Trademark Rule 2.116(g) and available here:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

The parties are encouraged to acknowledge their obligations under the protective order in writing, and may utilize the following form:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/ackagrmnt.htm>

Finally, the parties were reminded that although discovery will soon open pursuant to the schedule set forth in the Board's order of September 14, 2011, neither discovery requests nor motions for summary judgment may be served until after initial disclosures are made.

Disclosure, conferencing, discovery, trial and other dates remain as set in the Board's September 14, 2011 order.

Pro Se Information

Opposer is reminded that it will be expected to comply with all applicable rules and Board practices during the remainder of this case. The Trademark Rules of Practice, other federal regulations governing practice before the Patent and Trademark Office, and many of the Federal Rules of Civil Procedure govern the conduct of this opposition proceeding. The parties should note that Patent and Trademark Rule 10.14 permits any person or legal entity to represent itself in a Board proceeding, though it is generally advisable for those unfamiliar with the applicable rules to secure the services of an attorney familiar with such matters.

If opposer does not retain counsel, then it will have to familiarize itself with the rules governing this proceeding. The Trademark Rules are codified in part two of Title 37 of the Code of Federal Regulations (also referred to as the CFR). The CFR and the Federal Rules of Civil Procedure are likely to be found at most law libraries, and may be available at some public libraries. Finally, the Board's manual of procedure will be helpful.

On the World Wide Web, opposer may access most of these materials by logging onto <http://www.uspto.gov/> and making the connection to trademark materials.

The parties must pay particular attention to Trademark Rule 2.119. That rule requires a party filing any paper with the Board during the course of a proceeding to serve a copy on its adversary, unless the adversary is represented by counsel, in which case, the copy must be served on the adversary's counsel. The party filing the paper must include "proof of service" of the copy. "Proof of service" usually consists of a signed, dated statement attesting to the following matters: (1) the nature of the paper being served; (2) the method of service (e.g., e-mail, first class mail); (3) the person being served and the address used to effect service; and (4) the date of service. Also, the parties should note that any paper they are required to file herein must be received by the Patent and Trademark Office

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by the due date, unless one of the filing procedures set forth in Trademark Rules 2.197 or 2.198 is utilized. These rules are in part two of Title 37 of the previously discussed Code of Federal Regulations.

Files of TTAB proceedings can now be examined using TTABVue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format.

The third edition (2011) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at

http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp
