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

Proceeding	91200167
Party	Defendant Higher Logic, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

M2 SOFTWARE, INC.

Opposer,

v.

HIGHER LOGIC, LLC,

Applicant.

OPPOSITION NO. 91200167

SERIAL NO. 85/017,071; 85/017,090

MARK: M2 MOBILE MEMBERSHIP

APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO COMPEL DISCOVERY

Applicant, HIGHER LOGIC, LLC (“Higher Logic” or “Applicant”), by and through its attorneys of record, the law firm of Greenberg Traurig, LLP, hereby files this Opposition to Opposer, M2 Software, Inc.’s (“M2” or “Opposer”), Motion to Compel. This Opposition is based upon the points and authorities as identified below.

I. INTRODUCTION

The Crux of Opposer’s Motion is its deliberate misinterpretation of the discovery rules to demand that Applicant hand over confidential, sensitive business information directly to M2. M2 is not represented by counsel. Without attorney gatekeepers in place to ensure M2 does not obtain Applicant’s trade secret and other commercially sensitive information, and without a Protective Order specifically drafted to prevent M2’s direct review of this information, Applicant has not, and cannot provide this information.¹ To do so would cause unmitigated harm to Applicant because M2 could use that information both for its own commercial benefit, and to the detriment of its claimed

¹ The TTAB recognizes this dilemma. Its rules expressly state that, “[w]hile the Board’s standard protective order sets forth guidelines for the disclosure of confidential information to pro se litigants and in-house counsel, in some cases, a modification of the Board’s standard protective order upon motion or stipulation of the parties, approved by the Board, may be desirable.” TBMP § 412.02(b). Under the terms of the standard protective order, pro se litigants “do not have access to trade secret/commercially sensitive information.” *Id.*

competitor, Higher Logic.²

If Opposer were correct in that it was entitled to this commercially sensitive information, then any business could obtain its alleged competitor's trade secrets, confidential customer lists, sensitive financial information and the like, simply by filing a TTAB proceeding without being represented by counsel. Logically, this is not the purpose of these proceedings, nor the intent of the discovery rules.

The other main argument Opposer makes is its objection to the manner in which Applicant has responded to the discovery requests. Applicant is not a magician and cannot miraculously interpret many of the convoluted, senseless discovery requests propounded by Opposer. Applicant's objections are not only proper under the rules, they are intended to offer an explanation to M2 as to why Applicant has difficulty in responding to the requests. If Opposer truly wanted the information it seeks, rather than wasting time on filing motions, that time could be better spent re-drafting the requests in clearer, unambiguous language - in a manner that Applicant cannot object to. Had M2 immediately done so in mid-November 2011 when it first received Higher Logic's objections, M2 would have already received Applicant's revised responses. The fact that M2 fails to acknowledge the faults in its requests, ignored the clear need for it to re-draft its requests, but instead rushed to file this motion and without allowing Higher Logic time to supplement its responses, as it expressly stated it would time and time again throughout its responses, strongly suggests Applicant is simply playing the "bully" as it has done before in many prior proceedings.³

Also, M2's discovery requests seeks irrelevant information without any valid basis as to why Applicant should exert the time, effort and expense to go beyond what is required under the rules to provide this unnecessary information: Information that

² The fact that M2 alleges that Higher Logic uses the same mark for similar goods and services which equates to being a competitor, weakens any argument that it is entitled to Higher Logic's commercially sensitive business information. Higher Logic does not acknowledge it is a competitor. However, with Higher Logic's confidential information, M2 could potentially take that information and expand its services into Higher Logic's market.

³ A party may not seek immediate entry of sanctions for no response unless the responding party has expressly informed the inquiring party that no response will be made to the discovery requests. TBMP §411.02. Here, Applicant has not refused to respond to discovery. Applicant has, and will continue to respond to discovery. Its objections simply point out those requests which it cannot respond to at this time.

does not concern any of the issues in this proceeding and would not be used as evidence. These requests are overburdensome and were properly identified as so. If, however, M2 could provide a reasonable and legal basis for seeking such information, for example, the request for insurance information in a proceeding where damages are not awarded and where the only issues are priority of use and likelihood of confusion, Applicant might reconsider the request.

The bottom line is that M2 is being unreasonable. If Applicant loses this proceeding the result is that it cannot obtain a federal registration but it can continue its common law use of the mark to the extent it believes it has the right to do so. As articulated to the Interlocutory Attorney during the Initial Case Conference, Applicant has offered to abandon its applications, in effect, giving M2 the same result as a victory in this proceeding, provided M2 did not challenge its common law use. Incongruously, M2 refused the settlement offer further supporting Higher Logic's belief that M2's actions in this proceeding, including its discovery bullying, are not in good faith.

II. LEGAL ARGUMENT

M2 makes several arguments in support of its Motion all of which Applicant deems inappropriate for the following reasons:

A. Applicant's Initial Disclosures Were Appropriate

M2 complains about the inadequacy of Applicant's Initial Disclosures. (Motion p. 1). Based upon the information available to it at that time, Applicant properly provided both witness information and documents in its Initial Disclosures. (See Exhibit 2 attached to Motion). In fact, Applicant identified both Rob Wenger and a person most knowledgeable as witnesses for Higher Logic with contact information appropriately through Higher Logic's counsel, Greenberg Traurig. Also, Mr. Escamilla and a person most knowledgeable for M2 were identified as likely witnesses. At this time Applicant does not know of other witnesses, nor does it intend to depose other witnesses, such that its witness disclosures were complete and proper.⁴

⁴ Pursuant to Fed. R. Civ. P. 26(a)(1), a party is not obligated to disclose the name of every witness, document or thing that may have or contain discoverable information about its claim or defense, but merely the witnesses, LV 419,645,711v1 1-17-12

M2's objection that Higher Logic only identified Rob Wenger is unjustified because if that is the only person Applicant believes at this time would be a suitable witness then that is the only person required to be identified. Further, under the federal discovery rules, a person most knowledgeable is simply a person the company makes knowledgeable and prepares to testify on its behalf at the time of deposition. Fed. R. Civ. P. 30(b)(6). Applicant need not have a specific person in mind until the time of the deposition. *Id.*

Additionally, Applicant produced 138 pages of documents attached to its Initial Disclosures as compared to a lesser 132 pages by M2. Incongruously, M2 complains that it did not like Applicant's production of the file history for Applicant's M2 mark and demands Applicant re-produce those documents even though M2 produced that very same file history attached to its own disclosures. Clearly, M2's complaints are baseless and amount to no more than self-indulgent whining.

B. Incomprehensible Discovery Requests:

M2's discovery is rife with incomprehensible requests often made more convoluted by their compound nature and ambiguous terminology. A prime example includes the following:

INTERROGATORY REQUEST NO. 7:

With respect to the first use(s) of the M2 MARK in connection with the sale or distribution of each item of goods or services identified in Interrogatory No. 3, please list each item separately and state:

- (a) The manner in which the M2 MARK was used, e.g., by affixation to containers or labels, use on signs, use on web pages, use on printed promotional materials, as a trade name, etc.;
- (b) If the M2 MARK was printed on containers, labels, printed promotional materials, or web pages for the product or service, the name and address of the PERSON(s) or organization which printed the term;
- (c) Whether the product or service was sold;
- (d) Whether the product or service was distributed or provided free of charge.
- (e) The name and address of the PERSONS to whom the product or service was sold, distributed, or provided;
- (f) Whether APPLICANT itself manufactured or provided each of the

- goods or services identified;
- (g) Whether the sale, distribution, or provision of each item of goods or services under the M2 MARK has been continuous from the date specified in Interrogatory No. 6 to the present;
- (h) If the answer to Interrogatory 7g. is in the affirmative, whether the circumstances described in answer to Interrogatories 7a., 7b., 7c., 7d., 7f. prevailed throughout the period identified in Interrogatory 7g.;
- (i) If the circumstances described in answer to Interrogatories 7a., 7b., 7c., 7d., and 7f. did not prevail throughout the period identified in Interrogatory 7g., state how they changed, providing specific dates and names wherever requested; and
- (j) If the answer to Interrogatory 7g. is in the negative, state the periods of time during which the M2 MARK was not used by the Applicant in connection with the sale, distribution, provision, or operation of any of the items of goods, services or trade entity.

This interrogatory is, in a word, indecipherable. Applicant believes this Interrogatory on its own might well exceed the 75 interrogatory limit, including subparts, under the rules. TBMP §405.03(a). It is difficult to know for sure without a team of mathematicians to calculate the requests. Further, buried deep in this Interrogatory are improper requests for information, such as manufacture information, which is irrelevant to the issues involved in this trademark proceeding. Surely, after the twenty plus Board proceedings filed by M2, it knows that certain information is not relevant, not discoverable and need not be produced yet it still “sneaks” requests for that information into its discovery, and then acts with outrage when that information is not produced.

Regardless, Applicant did its best to wade through the quagmire and find some identifiable parts of the request and reasonably responded as follows:

Notwithstanding said objection, and without waiver of same, see applications Serial Nos. 85017090, and 85017090 for the goods and services on which the mark is used, and the dates of first use. The marks have been in continuous use since the dates of first use and have been used on Applicant’s website found at <www.higherlogic.com>, in print in Higher Logic’s product brochure, in print in a dedicated handout, on banners displayed at tradeshow and on the mobile application downloadable onto mobile phones. Applicant reserves the right to supplement this response should additional information become available at a later date.

INTERROGATORY REQUEST NO. 8:

Identify the PERSON or PERSONS most knowledgeable CONCERNING the design, ordering, purchase, import, distribution, display or sale of products and the performance of services bearing the M2 MARK, and

state the **circumstances** of such design, ordering, purchase, import, distribution, display, or sale. (Emphasis added).

Applicant properly objected that this request is overbroad and burdensome and more specifically compound. Applicant continues that objection because:

1. The Interrogatory seeks both a Person Most Knowledgeable concerning a list of activities **and** information on the circumstances relating to a list of activities;
2. The request does not define or explain what is meant, or the information being sought, in relation to the terms “concerning” and/or “circumstances.” For example, does “concerning” the sale of products, mean to what customers are the products being sold to? What products have been sold? Does “circumstances” of sale mean how it is sold, the process for selling the product? How it is advertised letting customers know it is for sale?
3. M2’s use of the term “or” means the request can be read as seeking a person most knowledgeable concerning the design, **or** ordering, **or** purchase, **or** import, **or** distribution, **or** display **or** sale of products and the performance of services **and** certain information of the design, **or** ordering, **or** purchase, **or** import, **or** distribution, display **or** sale of products and the performance of services.
4. Applicant believes M2 might have intended that the request be read as seeking a person most knowledgeable concerning the design, **and** ordering, **and** purchase, **and** import, **and** distribution, **and** display **and** sale of products and the performance of services **and** certain information of the design, **and** ordering, **and** purchase, **and** import, **and** distribution, display **and** sale of products and the performance of services.

Based upon the large number of potential interpretations of this one request, Applicant’s objection was proper. Regardless, Applicant did its best to respond by identifying the witnesses named in its Initial Disclosures as persons most knowledgeable, which they are. Further, and even though Applicant does not believe that the how, why, where, of a product’s design is relevant to the use of a trademark associated with that product, M2 has the ability to depose the persons most knowledgeable already identified to determine if that information might be relevant or lead to the discovery of admissible evidence. The bottom line is that the discovery is still in its early days and M2 will obtain additional information and documents from Applicant as they become available such that the Motion to Compel is not yet ripe.⁵

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⁵ Applicant supplemented its discovery requests on January 17, 2012 and continues reviewing and identifying relevant documents and information which might either be produced or identified on a Privilege Log.
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C. Higher Logic's Objections Are Permitted And Appropriate

M2 argues that Applicant's objections are not applicable in Federal Proceedings (Motion at p. 6), ignoring, or perhaps unaware of TBMP § 410 acknowledging that, ". . . rules governing discovery in proceedings before the Board provide for both the assertions of objections to discovery requests believed to be improper and a means . . . for testing the sufficiency of those objections" Moreover, if Applicant failed to exercise its right to object, that right would be deemed waived. (See *for example*, Fed. R. Civ. P. 33 (b)(4) (Any ground not stated in a timely objection is waived); TBMP § 405.04(b). Based upon the above-referenced examples of the convoluted and at times indecipherable nature of M2's discovery requests, Applicant believed its objections were proper. More significantly, Applicant did not simply refuse to respond to the requests. It did what it could to interpret the request, offer a reasonable objection with explanation where appropriate, respond with information and documents (more than M2 produced), known to it at the time of the response, and expressly stated it would supplement its responses.

D. Higher Logic's Objections Identify The Basis For Why Applicant Cannot Fully Respond.

Objections are permitted to challenge a discovery request. TBMP § 410. They allow a responder to identify the nature of the objection putting the party propounding the request on notice of what it is about the request that is objectionable - why it is difficult to give a complete response. The party propounding the request then has the ability to re-serve a better articulated request. Permissible objections going to the merits of a discovery request include: **overly broad, unduly vague and ambiguous, burdensome and oppressive** TBMP § 410. Applicant used these and other similarly permissible objections in its responses to M2's discovery.

Before filing a Motion to Compel, M2 should have given serious review and evaluation to the merits of Applicant's objections and then re-drafted and re-served its requests. That it did not do so, and in fact quickly filed its Motion, strongly suggests to Higher Logic that this proceeding is simply a vehicle for M2 to act like the trademark

bully it is and to harass Applicant, even after Applicant has offered to settle this matter.

E. Opposer Seeks Irrelevant Information

Many of M2's requests seek information that is not relevant to this trademark proceeding. Some examples are as follows:

INTERROGATORY NO. 2:

Describe in detail APPLICANT'S business structure, identifying: a) APPLICANT and any parents, subsidiaries, partners and/or affiliates and b) the identity of any principals, owners, directors, shareholders, officers, and/or general or limited partners of each entity identified in (a), and the percentage of the respective entity that each of the foregoing owns or controls.

Applicant properly objected that this request for information on corporate entities seeks irrelevant information but appropriately did respond that the information regarding ownership of the mark, which is relevant to the issues in this proceeding, could be identified by looking at the record of the trademark application.

INTERROGATORY NO. 4:

For each product or service identified in Interrogatory No. 3, please identify in detail:

- (a) any software tools utilized to develop the product or service;
- (b) the name, manufacturer, and version number of any software or database application used to develop the product or service;
- (c) all programming languages utilized in developing the product or service.

This request is more suited to a patent infringement proceeding and not a trademark case as the development of Higher Logic's product and software is irrelevant to use of a trademark in commerce.

INTERROGATORY NO. 23:

Has APPLICANT ever entered into any AGREEMENT or policy providing insurance or other reimbursement for trademark infringement or for any other legal costs in connection with trademark use or registration? If so, please identify:

- (a) the PERSON or entity providing such coverage;
- (b) the date on which each AGREEMENT or policy was entered into;
- (c) the policy number, terms and coverage of such AGREEMENT or policy;
- (d) the identity of any documents evidencing or relating hereto.

As stated above, the Board has found insurance information irrelevant to a Board proceeding because no damages are awarded.⁶ Significantly, Applicant identified that this information is not applicable in its Initial Disclosures. M2 clearly ignored that designation in Higher Logic's Initial Disclosures, inappropriately requested this information through discovery, and now loudly complains because that information is not forthcoming.

M2 also improperly sought documents not relevant to this proceeding which involves use of a M2 mark in relation to a computer application for mobile devices. M2's requests sought documents on goods and services that were not related to mobile applications, or where not used with an M2 mark, and so were not at relevant in this proceeding or likely to lead to admissible evidence. If M2 believes there is some connection between these other goods and services and the goods and services at issue in this proceeding, it has the ability through deposition to question the person most knowledgeable for Applicant, identify the chain of relevancy, and then propound follow-up discovery. At this time the relevance of the information is not apparent from M2's discovery requests and Applicant is not required to "guess" that somehow it is. Regardless, Applicant continues to look for and identify documents to be produced to M2 and will continue to supplement its document production through the end of the discovery period.

Significantly absent from Opposer's Motion, is any valid basis for seeking this irrelevant information. Based upon M2's apparent ignorance, or deliberate disregard, of the discovery rules, and blinkered assessment of Higher Logic's discovery responses, Applicant believes M2 failed to properly evaluate the appropriateness of Higher Logic's discovery responses, including objections, and would have filed this motion to compel regardless, simply to harass Higher Logic.

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⁶ The TTAB does not require disclosure of damage computations or insurance agreements because those are going to be irrelevant to opposition or cancellation proceedings. 72 Fed. Reg. 42242 (Aug. 1, 2007).
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F. Requests for Admissions

Opposer's arguments regarding the insufficiency of Applicant's responses to the requests for admissions are similarly baseless and ignores the fact that Applicant gave appropriate one word "admit" or "deny" responses where it could. There were multiple compound requests which were improper under the rules and Applicant's objections were proper. Significantly, there is no limit to the number of requests for admissions a party may propound and M2 had, and still has, the ability to re-draft the requests to separate the admission sought into individual requests.

G. Opposer Is Not Entitled To Higher Logic's Confidential, Sensitive Business Information

Applicant believes there is not an appropriate Protective Order in place that would permissibly allow it to provide confidential and business sensitive information directly to M2. The matter of the Protective Order, and M2's lack of legal counsel, was raised by the Interlocutory Attorney during the Early Case Conference in this matter. This issue was summarily dismissed by Mr. Escamilla.

Though Mr. Escamilla is correct that the Standard TTAB Protective Order is automatically in place, it is not workable in this proceeding if M2 seeks sensitive business information but does not have counsel to act as a filter for Higher Logic's production of commercially sensitive materials. M2 cannot have it both ways. If it wants to argue that the Standard Protective Order is sufficient, with its designations of sensitive documents to be marked "Attorneys Eyes Only" and it does not have attorneys, then it simply must accept that it cannot have access to Higher Logics sensitive information. TBMP § 412.02(b). Alternatively, if M2 believes access to that information is relevant to its case, then it either needs to retain counsel, or be creative in explaining to Higher Logic how some other form of Protective Order could be drafted that would preclude M2's access to Applicant's confidential information. M2 does neither. It simply complains about Applicant's failure to provide information and documents without recognizing the situation created by its own lack of counsel, and

without offering any valid solution to the issue it has chosen to create.⁷

For the Board's information, Applicant is diligently complying with its discovery obligations and although it will not provide M2 with its confidential information, it is in the process of creating a Privilege Log to be served on M2 when the process is complete.

III. CONCLUSION

M2 chose not to be represented by counsel knowingly precluding its ability to obtain sensitive business information from Higher Logic. The difficulty of proceeding without counsel was pointed out to Mr. Escamilla by the Interlocutory Attorney during the Early Case Conference. Moreover, the lack of legal counseling is apparent in the oft times convoluted language of the discovery requests. Mr. Escamilla cannot now complain of Applicant's alleged discovery failures when they are of his own creation. Applicant has done its best to respond to the discovery requests and has provided both information and documents, it offered proper objections to point out the problems with the requests, and Applicant will continue to supplement its discovery responses throughout the remainder of the discovery period which closes on April 9, 2012, almost three months from now.

If M2 was seriously concerned about obtaining documents and information from Higher Logic, it would have given sound consideration to Applicant's objections received on or about November 11, 2011, realized there are issues with the way the discovery requests are drafted, **re-drafted and re-served the requests** and, even assuming the requests were re-served by the end of November, M2 would have had Applicant's responses by the end of December 2011.

Regardless, Applicant is aware of its obligation under the discovery rules and continues to review documents and information to supplement its discovery responses. Again, on January 17, 2012, Applicant supplemented its Answers to Interrogatories. M2's Motion to Compel is unripe, fails to allow time for any supplementation of

⁷ Applicant is diligently complying with its discovery obligations and although it will not provide M2 with its confidential information, it is in the process of creating a Privilege Log to be served on M2 (with appropriate supplements) when this lengthy process is complete.

discovery, ignores its own failings in propounding discovery, ignores the fact it is not entitled to Higher Logic's sensitive business information, and is believed solely intended to harass Applicant.

As Applicant continues to supplement its discovery, M2's Motion should be denied as moot. Further, the Board should find that M2 has the ability to re-draft and re-serve its discovery requests and should do so.

Respectfully Submitted,

Dated: January 17, 2012

/s/ Lauri S. Thompson

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CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a true copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO COMPEL DISCOVERY** should be accepted as timely-filed is being filed electronically with the united states patent and trademark office trademark trial and appeals board and being served by first class mail, postage prepaid, on January 17, 2012, on the following:

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An employee of Greenberg Traurig, LLP