

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

Mailed: October 2, 2012

Opposition No. 91202450

M2 Software, Inc.

v.

Modernizing Medicine, Inc.

**M. Catherine Faint,  
Interlocutory Attorney:**

On September 27, 2012, the Board held a telephone conference involving David Escamilla, appearing pro se for M2 Software, Inc., and David J. Byer, counsel for Modernizing Medicine, Inc. Before the Board are opposer's motions, filed April 25, 2012 to compel applicant to produce supplemental responses to opposer's interrogatories and document requests, and to test the sufficiency of applicant's responses to opposer's requests for admission. The motion is fully briefed.

The Board carefully considered the arguments raised by counsel for both parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations.

**A. Background**

On January 16, 2012, opposer served on applicant 24 interrogatories, 12 requests for production of documents and things, and 17 requests for admission. Applicant served its discovery responses on opposer on March 15, 2012, based on a consented extension of time to answer the discovery requests. On March 20, 2012, opposer sent a letter via email,<sup>1</sup> outlining its dispute as to all of applicant's responses to opposer's Interrogatory Nos. 1-24, Document Request Nos. 1-12 and Admission Request Nos. 1-11, and demanding that applicant respond immediately. Applicant responded on March 28, 2012 outlining why it believed its responses and objections were sound, and asking opposer to contact applicant's counsel to amicably resolve the issues. On April 25, 2012, opposer filed its motion to compel supplemental responses as to Interrogatory Nos. 1-16, and 21-22, and all 12 document requests.<sup>2</sup> Opposer also seeks to test the sufficiency of applicant's responses to all 17 admission requests, and asks the Board to conduct an in camera inspection of all documents for which applicant has claimed attorney-client privilege or designated as trade

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<sup>1</sup> The parties agreed to service via email during their discovery conference. See Board's Order of Jan. 12, 2012 at 4.

<sup>2</sup> It was difficult for the Board to understand exactly which interrogatories opposer sought further answers to, as opposer asked the Board to "issue the discovery relief set forth" in an attached proposed order. A review of the proposed order shows that it seeks the Board to compel full and complete responses to Interrogatory Nos. 1-12, 14-24 and 72-79. Obviously there were no interrogatories numbered 72-79, and the order appears to seek even broader relief than requested by the motion to compel.

secret/commercially sensitive. In its declaration regarding the motion, opposer asserts, "[t]he parties have set forth their respective positions, and are at an impasse requiring a Board ruling." [Decl. of Officer at ¶ 21].

In response, applicant notes that "[w]ithout the courtesy of a single phone call, [opposer] has filed its Motion to Compel demanding that [a]pplicant answer its irrelevant and incomprehensible discovery requests." Applicant argues that the motion to compel fails to demonstrate that a good faith effort was made to resolve the discovery dispute and thus the motion to compel is improper and should be denied. Further, applicant asserts that upon receipt of opposer's March letter, applicant arranged for the delivery of responsive documents to opposer's offices along with all requested discovery logs, and has supplemented its discovery as additional information became available, or it was better able to understand opposer's requests.<sup>3</sup>

In reply, opposer, citing the *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*,<sup>4</sup> argues that applicant's supplementation of its discovery responses during suspension of this proceeding for the motion to compel, "violates the Board's Order of May 4, 2012," because a party

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<sup>3</sup> Respondent cites to the Board's order in an unrelated case involving petitioner, and used this order as a template for further supplementing its discovery responses.

<sup>4</sup> 72 Fed. Reg. 42242 (Aug. 1, 2007).

may not serve new discovery after filing and service of a motion to compel until suspension by the Board is lifted.

**B. Good Faith Effort**

Trademark Rule 2.120(e)(1) requires that a motion to compel discovery,

must be supported by a written statement from the moving party that such party... has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therfor the issues presented in the motion but the parties were unable to resolve their differences.

While opposer has submitted the required statement, together with a declaration, after reviewing the parties' arguments and submissions made with respect to the motion, the Board finds that opposer has not satisfied its obligation to make a good faith effort to resolve discovery disputes prior to seeking the Board's intervention.

Opposer misunderstands the requirements for attempting to resolve discovery disputes prior to their submission to the Board, and, if issues have been resolved during the pendency of the motion to compel, opposer must so inform the Board. Opposer has ignored the second paragraph of the Board's suspension order, which specifically does NOT toll the time for a party to, "respond to discovery requests which had been duly served prior to the filing and service of the motion to compel, or to appear for a discovery deposition which had been duly noticed prior to the filing and service of the motion to compel. (Board's Order of May 4, 2012).

It is clear from the total number of discovery matters in dispute that opposer has failed to make a substantive effort to resolve by agreement the issues raised in its motion to compel. Further, in many instances it appears as though opposer has not even read the discovery responses already provided prior to seeking to compel further discovery.

For instance, the Board notes that opposer, "concedes and is satisfied that [] information is not relevant to this proceeding," (Mot. Compel at 12) regarding Interrogatory Nos. 16-17 and Document Request Nos. 4-5, yet opposer continues to request that the Board compel applicant to provide "full and complete" responses to Interrogatory No. 16 and all Document Requests. Opposer served 24 interrogatories and 12 requests for production upon applicant, and now seeks an order compelling responses to, or further responses to, nearly all interrogatories and *all* document requests.

While opposer argues that "additional letters" between the parties regarding the discovery dispute would only serve as "legal debate," the Board finds that at least some of the problems opposer identifies are resolvable by a good faith effort made without Board intervention.<sup>5</sup> The parties are obligated to make a good faith effort to narrow the issues to

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<sup>5</sup> Opposer is directed to carefully review TBMP § 414 for the discoverability of a variety of matters. For instance, applicant's "business structure" which opposer seeks through its Interrogatory No. 2, is irrelevant to a determination of which party has priority.

be presented to the Board. *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (prior to seeking Board intervention, parties must narrow amount of disputed requests to reasonable number). This requires more than a demand for supplementation, and the parties must confer in good faith regarding their discovery disputes. *Id.*

Accordingly, opposer's motion to compel is **denied**.

**C. Sufficiency of Responses to Requests for Admission**

With regard to the motion to test the sufficiency of applicant's responses to opposer's admission requests, the Board finds that, per the above discussion, opposer has not made a good faith effort to resolve discovery disputes prior to seeking the Board's intervention. Specifically, opposer has introduced a copy of a single correspondence to applicant, and applicant's response thereto, as evidence that it attempted to resolve the discovery dispute and was unable to reach agreement. Yet, opposer seeks to test the sufficiency of applicant's responses to all 17 of opposer's requests for admission.

In view thereof, and again based on the substantial number of admission requests at issue, it is evident to the Board that the parties have failed to make a genuine, good faith effort to resolve by agreement the issues raised herein.

Accordingly, opposer's motion to test the sufficiency of applicant's admission responses is **denied**.

However, in the interest of avoiding the need for further discovery motions, the Board provides the following comments regarding certain of the discovery requests and objections.

**D. Documents Submitted Under Seal to the Board/Standard Protective Order**

Both opposer and applicant have submitted documents related to the motion to compel under seal, which the Board notes are obviously not confidential. For instance, opposer submitted copies of articles from the Internet under seal, and applicant submitted a copy of a Board order in an unrelated case. Only the particular discovery responses, exhibits, deposition transcript pages, or those portions of a brief, pleading or motion that disclose confidential information should be filed under seal pursuant to a protective order. See Trademark Rule 2.126(c); *Duke University v. Haggard Clothing Co.*, 54 USPQ2d 1443, 1445 (TTAB 2000). If a party submits any brief, pleading, motion or other such filing containing confidential information under seal, the party must also submit for the public record a redacted version of said papers. See Trademark Rule 2.126(c); TBMP § 120.02.

The parties will be expected to comply with this rule in all future filings in this case.

As the parties are aware, the Board's standard protective order is in place for this proceeding, and applies to discovery in this case. Trademark Rule 2.116(g). The parties may view that order here:

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

**E. Request for In Camera Review**

Opposer, who is appearing pro se, requests the Board make an *in camera* review of *all* information or documents where applicant has asserted attorney-client privilege or made a trade secret/commercially sensitive designation. Opposer was informed during the discovery conference, which was conducted with Board assistance in this case, that as a party, he would not be allowed access to information designated as trade secret/commercially sensitive. As the terms of the Board's standard protective order make clear, where the parties disagree as to whether certain information is protected, they are obligated to negotiate in good faith regarding the designation by the disclosing party. (Prot. Order at ¶ 20).

**1. Attorney-Client Privilege**

Information protected by the attorney-client privilege is not discoverable unless the privilege has been waived. Fed. R. Civ. P. 26(b)(5). *See e.g., In re Seagate Technology LLC*, 497 F.3d 1360, 83 USPQ2d 1865, 1873 (Fed. Cir. 2007) (attorney-client privilege provides absolute protection from disclosure unless waived). Where a claim of privilege has been invoked, the party claiming the privilege must make the claim expressly and provide a description or privilege log, unless the parties otherwise agree. *See* Fed. R. Civ. P. 26(b)(5)(A)(ii);



Trademark Rule 2.116(a). *See also Red Wing Co. v. J. M. Smucker Co.*, 59 USPQ2d 1861, 1864 (TTAB 2001) (party making claim of privilege must do so expressly and otherwise describe nature of withheld information as provided in Fed. R. Civ. P. 26(b)(5)).

Here, applicant has provided the particularized explanation of the privilege relied on, and a log describing the documents sufficiently to allow opposer to assess the applicability of the privilege. There is not even the barest assertion by opposer that it has reviewed the privilege log and assessed the applicability of the privilege asserted, or any assertion that the privilege has been waived.

## **2. Trade Secret/Commercially Sensitive Information**

A claim of trade secret privilege must be made timely, before the trade secret has been disclosed, and be specific enough to clearly identify the matter claimed to be privileged. Fed. R. Civ. P. 26(b)(5)(A)(ii) & (ii). *See also Great West Life Assure. Co. v. Leviathan*, 152 F.R.D. 494, 498 (D.C. Pa. 1994) (blanket assertion of privilege insufficient). The "federal law" of trade secret has been described as a three-part balancing test where:

- 1) the claimant asserting that a matter is a "trade secret" must also show that its disclosure would cause harm to the owner of the secret;
- 2) the burden then shifts to the party seeking discovery to show that the information is relevant and necessary to bring the matter to trial; and

3) if both parties satisfy their burden, the court must then weigh the potential harm of disclosures against the need for the information in reaching a decision.

*Bridgestone Americas Holding, Inc. v. Mayberry*, 878 N.E.2d 189, 193 (Ind. 2007). See also 26 Wright & Graham, et al., *Federal Practice and Procedure Evidence* § 5652 (1st ed. Westlaw update 2012). Thus, as the parties work to resolve their discovery dispute, applicant must be mindful as to whether the information it seeks to designate as a "trade secret" would meet a definition of that term,<sup>6</sup> and whether its disclosure would cause any harm. If applicant meets that burden, opposer would need to show that the information sought is relevant and necessary to bring the matter to trial. For instance, lists of customers have been found to be protected, while the names of stockholders are irrelevant to a Board proceeding. See, *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580 (TTAB 1975) (must identify class of customers who purchase products under mark, but not names of customers); *Volkswagenwerk Aktiengesellschaft v. MTD Products Inc.*, 181 USPQ 471, 472 (TTAB 1974) (identity of stockholders has no bearing on right to register).

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<sup>6</sup> Such as the definition in the *Uniform Trade Secrets Act* where it is defined as a, "formula, pattern, compilation, program, device, method, technique or process that : i) derives independent economic value... and ii) is subject to reasonable efforts to maintain its security. *Uniform Trade Secrets Act*, 1979 § 1(4), 14 *Uniform Laws Annot.* 542.

**F. Requests for Production**

Contrary to opposer's assertion in its documents accompanying the motion to compel,<sup>7</sup> the responding party is not required to copy responsive documents and forward them to its adversary in response to document requests, unless ordered to do so by the Board. *Electronic Industries, Assn. v. Potega*, 50 USPQ2d 1775, 1777 (TTAB 1999). A party is only obliged to make documents and materials available for inspection and copying, where the documents are stored, and as they are kept in the ordinary course of business. See Trademark Rule 2.120(d)(2). See also *No Fear*, 54 USPQ2d at 1551. However, in Board cases, parties often extend each other the courtesy of producing requested documents by copying the documents and forwarding them to the requesting party at the requesting party's expense, and applicant has produced its documents to opposer in electronic form as requested. See TBMP § 406.04(b). The Board expects that such cooperation between the parties will continue.

**G. Duty to Cooperate**

The Board expects parties, and their attorneys, to cooperate with one another in the discovery process, and looks with extreme disfavor on those who do not. *Amazon Technologies Inc. v. Wax*, 93 USPQ2d 1702, 1705 (TTAB 2009), (for meet and

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<sup>7</sup> In its March 20, 2012 letter opposer asserted, "it is unreasonable to require M2 Software to send an agent to your Miami, Florida office."

confer process to be meaningful and serve its intended purpose, parties must present to each other merits of their respective positions with same candor, specificity, and support during informal negotiations as during briefing of discovery motions.) Each party, and its attorney, has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. *Sentrol*, 231 USPQ at 667. Moreover, where the parties disagree as to the propriety of certain discovery requests, they are under an obligation to attempt to resolve those differences, and to present to the Board only a reasonable number of issues, which despite their best efforts they have been unable to resolve. *Id.* (parties are under obligation to make good faith effort to resolve their differences prior to seeking Board intervention).

The parties are reminded that discovery in proceedings before the Board is not governed by any concept of priority. *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067 (TTAB 1990) (*citing* Fed. R. Civ. P. 26(d)). Parties are under an obligation to respond to an adversary's request for discovery during the time allowed therefore under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending

request for discovery. See Fed. R. Civ. P. 26(d), and TBMP § 408.01.

The parties are also reminded that should information and documents responsive to the already propounded interrogatories and document requests subsequently come to light, the parties are under a duty to seasonably supplement discovery responses pursuant to Fed. R. Civ. P. 26(e). The parties are reminded in addition that as to information refused during discovery, the parties may be precluded from relying on such information and from adducing this testimony as evidence at trial. See *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1792-93 (TTAB 2009) (documents not produced until after start of trial stricken); see also TBMP § 527.01(e), and the authorities cited therein.

**H. Date for the Parties to Meet and Confer**

During the teleconference, the parties agreed that they would meet and confer regarding both the discovery propounded by opposer, and that subsequently propounded by applicant, via a telephone call between them. That call is scheduled for October 12, 2012 at 3:00 p.m. EDT. If the parties are unable to resolve their discovery disputes during that conference, they may telephone the Interlocutory Attorney, at 571-272-9274 to seek assistance.

**I. Summary**

Opposer's motions to compel and to test the sufficiency of applicant's admission responses are **denied**.

**Proceedings Resumed/Dates Reset**

Proceedings are resumed. Dates are reset as set out below.

Expert Disclosures Due	11/16/2012
Discovery Closes	12/16/2012
Plaintiff's Pretrial Disclosures Due	1/30/2013
Plaintiff's 30-day Trial Period Ends	3/16/2013
Defendant's Pretrial Disclosures Due	3/31/2013
Defendant's 30-day Trial Period Ends	5/15/2013
Plaintiff's Rebuttal Disclosures Due	5/30/2013
Plaintiff's 15-day Rebuttal Period Ends	6/29/2013

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 Rules 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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