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

Mailed: November 4, 2013

Opposition No. 91202450

David Escamilla and M2 Software, Inc.

v.

Modernizing Medicine, Inc.

M. Catherine Faint,
Interlocutory Attorney:

Applicant, Modernizing Medicine, Inc., has filed two applications in which it seeks to register the following mark for goods and services:[1]

[1] Application Serial No. 85102289 based on Trademark Act § 1(b) for, "computer software for patient records and billing, scheduling, medical decision making, creating patient treatment schedules, data portal and ordering and managing prescriptions and tests, for use by healthcare and medical organizations and providers" in Class 9; and Application Serial No. 85102294 for, "Information technology services, namely, information technology consulting services; data services, namely, acting as an application service provider in the field of electronic medical records/electronic health records to host computer application software for the collection, editing, organizing, modifying, transmission, storage and sharing of data; providing computer software solutions, namely, design and development of computer software and on-line computer software systems for healthcare and medical organizations and providers" in Class 42. Each of the applications contains the following description of the mark, "The mark consists of a circle containing the letter "M" and the number "2" and a stylized form of the words "MODERNIZING MEDICINE"." Color is not claimed as a feature of the marks. The word "MEDICINE" is disclaimed in each application.

In its notice of opposition filed June 8, 2011, M2 Software, Inc. opposes registration of the marks on the ground of priority and likelihood of confusion and claims ownership of for the mark M2 in typed form.[2] Assignment of opposer's mark to David Escamilla, an officer of M2 Software, Inc., was recorded with the Assignments Branch and David Escamilla was joined as a party plaintiff by the Board's order of October 19, 2012. (Party plaintiffs are hereinafter referred to as "opposer").

Background

On October 2, 2012, the Board denied opposer's motion 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 admissions, based on the lack of opposer's good faith effort to resolve the dispute prior to seeking Board intervention. As part of that order, the parties were ordered to conduct a meet and confer conference on Friday, October 12, 2012 to attempt to resolve their discovery disputes.

On Monday, October 15, 2012, the first business day after the ordered conference to resolve discovery issues, opposer

[2] Registration No. 1931182, registered October 31, 1995, for, "computer software featuring business management applications for the film and music industries; and interactive multimedia applications for entertainment, education and information, in the nature of artists' performances and biographical information from the film and music industries; and instructions and information for playing musical instruments," in Class 9. Affidavits of

filed a combined motion to amend the notice of opposition, for judgment as a sanction, or in the alternative for summary judgment, and to renew the motion to determine the sufficiency of applicant's responses to admissions. Notwithstanding the Board's fourteen-page October 2012 order denying opposer's prior motion to compel and test the sufficiency of admission responses, and advising opposer in detail as to its discovery obligations, the good faith effort to resolve the discovery dispute is addressed in a footnote (Opposer's October 15, 2012 motion at 17 n.17).[3]

Proceedings were suspended by the Board on October 19, 2012. Applicant filed on November 7, 2012 a motion to suspend for a civil action involving opposer and a third party, Higher Logic, LLC, and applicant filed on November 14, 2012 a motion pursuant to Fed. R. Civ. P. 56(d) seeking discovery before responding to opposer's motion for summary judgment.

On June 7, 2013, the Board suspended this proceeding pending disposition of the civil action. In that order, the Board denied any pending motions without prejudice, and gave instructions as to how to renew any pending motions upon resumption.

---

continued use and incontestability under §§ 8 and 9 were accepted October 31, 2005.

[3] Opposer also described the conference in an attached declaration, at paragraph 12, in two sentences.

This case now comes up on opposer's motion for reconsideration of the Board's order suspending for civil action, or in the alternative for renewal of opposer's pending dispositive motions. In its response contesting opposer's motion, applicant cross-moved for entry of a scheduling order permitting applicant to conduct and compel discovery before opposer is allowed to file any further motions. Opposer did not file a reply brief, or otherwise respond to the cross-motion.

Proceedings Resumed

On June 5, 2013, the United States District Court dismissed the civil action between opposer and Higher Logic, LLC with prejudice. The dismissal, however, was not a "final disposition" until the time for appeal expired, *see* Fed. R. App. 4(a)(1), which was sixty days after entry of the District Court's judgment. 28 U.S.C. § 2107. As that time has since expired, proceedings herein are **resumed**.

Opposer's Filing of Future Motions

Opposer appears to base its October 15, 2012 combined motion on unresolved discovery issues, and also attempts to renew its motion to test the sufficiency of interrogatory responses in that same motion. In view thereof, the Board bars any subsequent filing of burdensome scattershot motions by opposer. More specifically, opposer is barred from filing any combined motions. Each motion must address a single topic.

Opposer must obtain the Board's permission by phone call to the assigned Interlocutory Attorney before filing any motion. If permission is sought on the last day a filing is due, it may not be obtained. Opposer should plan for responsive phone calls from the Board attorney within one business day of the call.

Motion for Reconsideration Denied

A motion for reconsideration of a decision on a prior motion under Trademark Rule 2.127(b) is limited to a demonstration that based on the facts before it and applicable law, the Board's ruling was in error and requires appropriate change. *See Vignette Corp. v. Marino*, 77 USPQ2d 1408, 1411 (TTAB 2005)(reconsideration denied because Board did not err in considering disputed evidence). It is not to be a reargument of the points presented in the original motion. TBMP § 518 (3d ed. rev. 2 2013). An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding, may be acted upon by a single Board judge, or by a Board attorney to whom authority so to act has been delegated. *See* Trademark Rule 2.127(c); *see also* TBMP § 502.04.

Opposer first argues the June 7, 2013 order should be reconsidered, and the affected motions "restored," because the underlying civil action in the Eastern District of Virginia was dismissed with prejudice on June 5, 2013. Applicant argues opposer failed to timely notify the Board of the June 5

dismissal, and while it does not dispute the civil action was dismissed, "given the procedural history of this case" applicant seeks entry of a scheduling order for discovery.

Obviously dismissal of the civil action just prior to issuance of the Board's order is not an error on the Board's part. The Board's order requires the parties to notify the Board "twenty days after" final determination in the civil action. Thus, opposer's notification on June 7, 2013 was not untimely.

Opposer next argues the Interlocutory Attorney was without jurisdiction to deny the pending motions without prejudice, which included both a motion for judgment and a motion for summary judgment, because only a three-judge panel may decide potentially dispositive motions.

We find no error in the Board's June 7, 2013 order. The order did not decide the merits of the case, or a complex or contested motion that was potentially dispositive of the case, but merely acted in an interlocutory fashion to suspend the case for a civil action. The order serves to control matters pending on the Board's docket by denying opposer's motions without prejudice, and provides that opposer could renew its motions. In view thereof, opposer's motion for reconsideration is **denied**.

Motion for Renewal Denied

The Board's June 7, 2013 order also provided a procedure by which opposer could renew any pending motions, which includes that:

> Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

Opposer failed to comply with the Board's order requiring a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed. Board attorneys regularly refuse consideration of motions which are procedurally deficient, whether untimely, or failing to otherwise comply with the Board's rules or, as in this case, Board orders. Opposer is reminded that, effective with this order, opposer may not file a motion without Board permission, and no permission to file other motions will be granted until the parties have completed the meet and confer process outlined below.

Accordingly, opposer's motion for renewal of its pending dispositive motions is **denied**.[4]

Scheduling Order for Discovery

Applicant's cross motion for a scheduling order regarding discovery is **granted** to the extent outlined herein.

[4] As opposer's motions have not been renewed, applicant's motion for Rule 56(d) discovery is denied without prejudice as moot.

In an effort to move this proceeding forward, the Board orders the parties within **FORTY-FIVE (45)DAYS** of the mailing date of this order to meet and confer to discuss any outstanding discovery issues and attempt to resolve them. If the parties are unable to reach a resolution, they are ordered to submit within **SIXTY DAYS** of the mailing date of this order a joint statement to the Board outlining any outstanding issues. If a joint statement is filed, the Board will then schedule a teleconference with the parties to determine whether any further motion to compel may be filed.

Applicant may during this period serve discovery on opposer from and regarding the party added to this action, David Escamilla, and opposer's Registration No. 4128151.

Applicant may during this period notice and schedule discovery depositions.

Applicant may not file any motions to compel discovery unless permission is granted by the Interlocutory Attorney. Such permission may be a subject of the joint statement and any subsequent Board teleconference, if appropriate.

Opposer has also sought to amend its pleadings as part of the October 15, 2012 combined motion. If opposer seeks to refile its motion to amend the pleadings, such request for permission may be a subject of the joint statement and any subsequent Board teleconference, if appropriate.

Summary

Proceedings are resumed and dates are reset as set out below.

The Board bars any subsequent filing of motions by opposer. More specifically, opposer is barred from filing any combined motions. Each motion must address a single topic. Opposer must obtain the Board's permission by phone call to the assigned Interlocutory Attorney before filing any motion.

Opposer's motion for reconsideration is **denied**.

Opposer's motion for renewal of its October 15, 2013 combined motion is **denied**.

Applicant's cross motion for a scheduling order regarding discovery is **granted** to the extent outlined herein.

Dates Reset

Dates are reset as set out below.

Expert Disclosures Due	1/7/2014
Discovery Closes	2/6/2014
Plaintiff's Pretrial Disclosures Due	3/23/2014
Plaintiff's 30-day Trial Period Ends	5/7/2014
Defendant's Pretrial Disclosures Due	5/22/2014
Defendant's 30-day Trial Period Ends	7/6/2014
Plaintiff's Rebuttal Disclosures Due	7/21/2014
Plaintiff's 15-day Rebuttal Period Ends	8/20/2014

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

***