

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

Mailed: December 9, 2013

Opposition No. 91202450

David Escamilla and M2  
Software, Inc.

v.

Modernizing Medicine, Inc.

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

On December 3, 2013 the Board held a telephone conference involving David Byrne, Atty., counsel for Modernizing Medicine, Inc.,<sup>1</sup> and David Escamilla, appearing pro se for himself and as President of M2 Software, Inc. During the teleconference, it was brought to the Board's attention that opposers' June 7, 2013 motion contained the required verification of review for renewal of pending motions, albeit in a box on the signature page, rather than as a separate paper or declaration.<sup>2</sup> Also during the teleconference, the Board discussed with the parties scheduling for Board participation in a meet and confer conference related to outstanding discovery issues. The Board

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<sup>1</sup> Also participating in the teleconference was Hayden P. O'Byrne, Atty., for Modernizing Medicine.

<sup>2</sup> It is also noted that opposers filed a petition to the Director on November 29, 2013.

took matters under advisement, and reconvened the teleconference on December 6, 2013.

Although the Board has not repeated the parties' complete arguments, it has carefully reviewed the parties' respective arguments in support of and against the pending motions, and gave the parties an opportunity to be heard during the two teleconferences.

The Board's order of November 4, 2013 is vacated in part as to opposers' motion for renewal, and the scheduling order is revised as follows. The remainder of the Board's order remains as written.

***Motion for Renewal Granted***

Upon further consideration, opposers' motion for renewal of their October 15, 2013 motion for leave to amend its consolidated notice of opposition and motion for judgment as sanction or in the alternative for summary judgment ("Omnibus motion") is granted. Proceedings are otherwise suspended for consideration of those motions.

During the teleconference applicant renewed their motion for Rule 56(d) discovery, and opposers' waived any objections to renewal of the motion. Accordingly, applicant's motion for Rule 56(d) discovery is now before the Board.

***Opposers' Oral Motion to Suspend***

During the teleconference, opposers made an oral motion to suspend pending disposition of its petition to the director.

The filing of a petition to the Director will not act as a stay in an inter partes proceeding pending before the Board.

Trademark Rule 2.146(g); *see also In re Docrate Inc.*, 40 USPQ2d 1636, 1637 n.1 (Comm'r 1996) (citing Trademark Rule 2.146(g) and stating that filing petition to review denial of request to extend time to oppose does not stay time to file opposition or further extensions of time to oppose). The motion is **denied**.

***Applicant's Motion for Rule 56(d) Discovery***

Opposers' Notice of Opposition filed November 7, 2013 alleges priority and likelihood of confusion based on Opposers' Registration No. 1931182. Opposers' Omnibus motion seeks to amend the Notice of Opposition to add:

1. A claim of ownership for opposer David Escamilla's Registration No. 4128151 ("151 Registration") for the mark M2 in standard character form for, "Development, updating and maintenance of software and data bases; Technical support services, namely, troubleshooting of computer software problems" in Class 42, claiming dates of first use of Oct. 23, 1991 and first use in commerce of Jan. 10, 1992.
2. A claim that applicant's applications are void ab initio because, inter alia, applicant submitted false information on its applications and misrepresented it had a bona fide intent to use the marks on the identified goods and services, and in its declaration that no other corporation has the right to use the mark in commerce.
3. Opposers also filed on October 15, 2012, a motion to join David Escamilla as party plaintiff because claimed Registration No. 1931182 ("182 Registration") had been assigned from M2 Software to David Escamilla as recorded with the Trademark Assignments Branch.<sup>3</sup>

In response to opposers' Omnibus motion, applicant filed a motion for discovery under Fed. R. Civ. P. 56(d), supported

by declarations.<sup>4</sup> Applicant seeks Rule 56(d) discovery on the following issues:

- 1.) All of the *DuPont* factors as they relate to the '182 Registration and common law use;
- 2.) Any services described in the '151 Registration;
- 3.) The assignment by M2 Software to David Escamilla of the '182 and '151 Registrations;
- 4.) Licensing agreements between M2 Software and David Escamilla; and
- 5.) Continuing use or non-use of the M2 mark for services in the '182 Registration and common law rights

Applicant also seeks to compel discovery responses from applicant based on discovery that was served on January 27, 2012, and this motion to compel seems to be related to the information sought as to the '182 registration. This discovery dispute was also to be a subject of the meet and confer conference between the parties ordered by the Board in its November 4, 2013 order.<sup>5</sup> Applicant served additional interrogatories and document requests on opposers on November 18 and 26, 2013, in line with the Board's order of November 4, 2013, the subjects of which were limited to the addition of David Escamilla as a party plaintiff and assignee, and the proposed claim adding the '151 Registration. Applicant also

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<sup>3</sup> The assignment may be viewed at Reel/Frame Nos. 4870/0638. The Board granted opposers' motion to join by its order of October 19, 2012.

<sup>4</sup> As part of that motion, applicant raises the issue that joined opposer David Escamilla had not served initial disclosures prior to filing the Omnibus motion, which includes a motion for summary judgment. Applicant should note, "in Board cases, subsections (C) and (D) of Federal Rule 26(a)(1) are not relevant and will not apply." *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242, 42246 (Aug. 1, 2007). In view thereof, the Board has not considered this argument.

<sup>5</sup> The requirement for a meet and confer conference is **deferred** pending disposition of opposers' Omnibus motion.

noticed depositions as allowed by that order, and may seek further depositions based on discovery responses that have not yet been received.

A party which believes that it cannot effectively oppose a motion for summary judgment without first taking discovery, may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit or declaration showing that the nonmoving party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See Fed. R. Civ. P. 56; *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989). As a general rule, motions under Rule 56(d) will be liberally treated. If a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion for summary judgment, discovery will be permitted. See *Opryland*, 970 F.2d 847, 23 USPQ2d at 1475 (Fed. Cir. 1992); and TBMP § 528.06 (3d ed. rev. 2 2013). In addition, it would be highly inappropriate to allow the timing of opposers' summary judgment motion to deprive applicant of relevant information that may be essential to its opposition of the summary judgment motion. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 326 (1986) (Rule 56([d]) provides nonmovants with protection from being "railroaded" by premature summary judgment motions); *Dunkin'*

*Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 6 USPQ2d 1026, 1028 (Fed. Cir. 1988).

Applicant has identified discovery directed to "facts essential to justify [its] opposition" to the motion for summary judgment, and the Board has considered the motion in light of the amendments sought by opposers at the time of filing the motion for summary judgment. Accordingly, applicant's motion for Rule 56(d) discovery as to topics 1-5, and for discovery depositions is **granted**.

Applicant's discovery as to the first topic seems to be related to applicant's motion to compel. The Board will take up applicant's motion to compel, and Exhibit T to the Rule 56(d) motion, in the context of applicant's motion for Rule 56(d) discovery and an order will issue in due course. A teleconference is scheduled for Friday, December 13, 2013 at 2:30 p.m. EDT.<sup>6</sup>

### ***Depositions***

Applicant seeks to take the depositions of opposers David Escamilla and "M2 Software's Representative," as well as third party witness Dr. David Kalainov. Discovery depositions already noticed by applicant may proceed, **except** for the deposition of Dr. Kalainov.

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<sup>6</sup> The Interlocutory Attorney has sent a separate email to the parties with details for dialing in to that teleconference. If there are any questions regarding dial up instructions, the parties should telephone the Interlocutory Attorney at 571-272-9274.

The potential deposition of Dr. Kalainov was discussed during the December 6, 2013 teleconference, and applicant proposed that if opposers would stipulate to a restriction of certain evidence, applicant would forego the deposition. The parties were to further discuss the proposed stipulation and submit it to the Board prior to the December 13, 2013 teleconference, if they are able to reach an agreed stipulation. In any case, the potential deposition or stipulation will be a subject of that teleconference.

A telephone conference must be convened with the Board to determine if depositions will be allowed of any additional third party witnesses, or to file any further motions to compel.

***Applicant's Motion to Record Teleconference***

Applicant made an oral motion to record the December 13, 2013 teleconference, or to have a court reporter attend the teleconference, because of the number of issues to be addressed in the teleconference, and "because it is important to have any of opposers' 'admissions' on the record."

The Board will not normally allow a court reporter, videotaping or other electronic recording of an oral hearing.<sup>7</sup> See TBMP § 542. Accordingly, applicant's motion is **denied**.

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<sup>7</sup> Even when such recordings are permitted, they may not be used as "evidence." See TBMP § 542.

***Accelerated Case Resolution (ACR)***

The parties may wish to consider using the Board's Accelerated Case Resolution (ACR) procedure. This procedure is similar to the use of cross-motions for summary judgment, but the parties must stipulate that, in lieu of trial, the Board may resolve any genuine issues of material fact. The Board's ACR procedure is detailed under the heading "ACR & ADR" at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The parties are encouraged to consider agreeing to set this case as one for Accelerated Case Resolution (ACR).

***Proceedings Suspended***

Proceedings are otherwise suspended.

During the teleconference, the Board clarified that applicant's time for a combined response to the Omnibus motion, including the motion to amend the notice of opposition, the motion for judgment and the motion for summary judgment will be set at a later date. Applicant raised the issue of expanding its page limit for its combined brief in response to the Omnibus motion. The Board clarified that a motion for leave to exceed the page limit for briefing a motion should be filed on or before the date the brief is due. See TBMP § 537.



Applicant is granted permission to file such a motion, but the motion should not be filed and served until the Board sets the due date for applicant's brief in response to the Omnibus motion.

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