



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

January 14, 2014

Mr. David Escamilla
500 N Michigan Ave, Suite 600
Chicago, IL 60611

Re: Petition to Director
Opposition No. 91202450
Mark: M2 MODERNIZING MEDICINE

Dear Mr. Escamilla:

This acknowledges receipt of David Escamilla and M2 Software, Inc.'s (petitioner's) November 29, 2013 petition to the Director of the United States Patent and Trademark Office (Director) relating to the November 4, 2013 interlocutory Order issued in conjunction with the above referenced opposition, the December 13, 2013 response to the petition filed by Modernizing Medicine, Inc., and petitioner's December 20, 2013 reply brief in support of the petition to the Director.

The petition is hereby DISMISSED.

The above referenced opposition was commenced on November 7, 2011.¹ There have been several motions filed in conjunction with the above referenced opposition. One such motion was petitioner's motion for leave to amend its consolidated notice of opposition and motion for judgment as sanction or in the alternative for summary judgment (referred to as the "Omnibus motion") filed on October 15, 2012. On November 7, 2012, Modernizing Medicine, Inc. filed a motion to suspend the above opposition on the grounds that there was a civil litigation involving petitioner and a third party that might have a bearing on the above opposition. On June 7, 2013, the Trademark Trial and Appeal Board (TTAB) suspended the above opposition, denied any pending motions without prejudice and instructed the parties how to renew any pending motions when the proceedings were resumed. That same day, petitioner filed a motion for reconsideration of the June 7 order on the ground that the civil litigation was dismissed.

On November 4, 2013, the TTAB issued an Order resuming the opposition but denying, among other motions, petitioner's request to renew consideration of its Omnibus motion. Specifically, the TTAB noted that the procedures outlined in the June 7 Order for renewing motions had not been followed.

This petition was filed on November 29, 2013. Petitioner declares that the TTAB committed a clear error in denying its request to renew its Omnibus motion and, in so doing, has deprived petitioner of its right to receive a decision on its "dispositive motion" from at least three Board judges.

¹ This decision recites only the facts relevant to the issue on petition.

On December 9, 2013, after a telephone conference with the parties to the above opposition, the TTAB issued an Order, vacating in part the November 4 Order as to petitioner's motion for renewal of its Omnibus motion, granting in part Modernizing Medicine's motion for Rule 56(d) discovery in order to respond to the Omnibus motion and dealing with various other motions.

On December 13, 2013, Modernizing Medicine filed a response to the petition alleging that the petition should be denied as moot in light of the December 9 Order of the TTAB, but argued supporting the TTAB's action, in the December 9 Order, granting in part its motion for Rule 56(d) discovery. Petitioner filed a reply to Modernizing Medicine, Inc.'s response.²

Modernizing Medicine Inc.'s motion for Rule 56(d) discovery was not the subject of the November 4 Order or the petition filed on November 29 and therefore will not be addressed. As the new issues raised by Modernizing Medicine Inc.'s response supporting the motion for Rule 56(d) discovery are not being considered, neither have the arguments raised by petitioner in its reply brief been considered.³ If either party had an issue with the December 9 Order of the TTAB, the proper procedures for filing a petition, as outlined in the Trademark Rules, should have been followed.

In view of the fact that the TTAB vacated the November 4, 2013 Order as to the request raised in the petition, the November 29 petition is dismissed as moot. Since the petition is being dismissed, any fees paid in conjunction with the petitioner will be refunded in due course.

If you have any questions, please do not hesitate to contact me.

/Dawnmarie D. Sanok/
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² The Trademark Rules do not provide for the filing of a reply brief in support of a petition. *See* 37 C.F.R. §2.146(e)(2). It appears the reply brief may have been submitted to respond to issues raised by Modernizing Medicine Inc. in its response to the petition. Petitioner states in its reply brief: "it should be noted that most, if not all, Respondent's Response does not concern the issues and November 4, 2013 Order subject of the Petition. Thus, the issues raised in the Petition should be treated as conceded. However, should the Director elect to exercise supervisory authority to review the areas raised in the Response, this Reply is submitted thereto." Reply 1.

³ To the extent petitioner is requesting that the Director review any Order that predated the November 4, 2013 Order, such a request is untimely. *See* 37 C.F.R. §2.146(e)(2).

cc: Attorney for Opposer

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