

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

Mailed: March 13, 2014

Opposition No. 91202450

David Escamilla and M2
Software, Inc.

v.

Modernizing Medicine, Inc.

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

On December 13, 2013 the Board held a telephone conference involving David Escamilla, appearing pro se for himself and M2 Software, Inc., and David J. Byer, counsel for Modernizing Medicine, Inc.¹ By way of background, the Board held a teleconference with the parties on December 6, 2013 wherein the Board granted applicant's motion for Rule 56(d) discovery, but deferred decision on applicant's motion to compel discovery filed as part of that motion.² This December 13, 2013 teleconference embodies the Board's decision on the motion to compel, and other matters that arose during the teleconference.

The Board carefully considered the arguments raised by both parties, as well as the supporting papers and the record of this case, in coming to a determination regarding the

¹ Also participating in the teleconference was Hayden P. O'Byrne, Atty. for Modernizing Medicine, Inc.

relevance of the requested information and the sufficiency of the provided information. As discussed during the teleconference, the Board makes the following findings and determinations.

Opposers' Oral Objection to Teleconference

Opposers' raised an oral objection to the December 13, 2013 teleconference, arguing the Board did not have jurisdiction to decide the Rule 56(d) motion, or any related motions, because "it was mentioned" in opposers' December 2, 2013 petition to the Director.³ As the Board had stated in its December 9, 2013 order and during the teleconference, the filing of a petition to the Director does not act as a stay in an inter partes proceeding pending before the Board.⁴ The Board is an administrative tribunal and has jurisdiction to decide inter partes opposition cases before it regarding the right to register. *See FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007); *see also* TBMP § 102.01. Pursuant to Trademark Rule 2.127(c), "Interlocutory motions, requests, and other matters not actually or potentially dispositive of a

² During the December 6, 2013 teleconference, opposers waived any objection to renewal of applicant's motion for Rule 56(d) discovery. Board's Order of December 9, 2013 at p. 2.

³ Opposers' also stated it was "advised by counsel" not to participate in this teleconference, as the Board did not have "jurisdiction." The Board notes that no counsel for opposers has entered an appearance in this proceeding, nor have opposers stated they expected such an appearance to be entered.

⁴ Board's Order of December 9, 2013 at p. 3.

proceeding may be acted upon by a single Administrative Trademark Judge of the Trademark Trial and Appeal Board or by an Interlocutory Attorney of the Board to whom authority so to act has been delegated." *Accord Consultants & Designers, Inc. v. Control Data Corporation*, 221 USPQ 635, 637 (TTAB 1984). As the Rule 56(d) motion, and the related discovery issues, is not dispositive of the case, the Interlocutory Attorney has the authority to decide the motions.

Deposition of Dr. Kalainov

During the prior teleconference, the parties had agreed to discuss a possible stipulation regarding the proposed discovery deposition of the witness Dr. David Kalainov.⁵ Applicant reported that it had sent the proposed stipulation to opposers, but opposers did not respond. Opposers confirmed they would not stipulate to the evidence restriction applicant sought in lieu of the deposition of Dr. Kalainov.

Applicant seeks to depose Dr. Kalainov, whose name was provided in opposers' supplemental response to Interrogatory No. 5 as a "representative client" in the healthcare field. In its declaration in support of Rule 56(d) discovery, applicant states, "Dr. Kalainov is uniquely qualified to testify and provide documents relating to [opposers'] use of the M2 mark..." and points out that Dr. Kalainov sent an unsolicited letter to

⁵ Opposers have variously referred to Dr. Kalainov as a "non-party surgeon," "collaborator" or a "client."

applicant's counsel regarding uses of the opposers M2 mark and stating he would be "confused" by applicant's mark.

As part of its motion for summary judgment, opposers argue that its database solutions and services are identical to those of applicant in the "healthcare sub-segment of the IT industry," while opposers' registration of record limits opposers' goods to the "film and music industries." Thus at issue is whether opposers have expanded their uses of the goods and/or services shown in opposers pending application for the same mark.⁶ Opposers have identified Dr. Kalainov as a "representative client" of products or services in the healthcare field. In these circumstances it would be unjust to deprive applicant of the opportunity of obtaining discovery, and specifically of confronting and examining the witness by oral examination. *See Orion Group, Inc. v. the Orion Insurance Co., P.L.C.*, 12 USPQ2d 1923, 1925 (TTAB 1989).

In view thereof, applicant's motion pursuant to Rule 56(d) to take the discovery deposition of Dr. David Kalainov is **granted**. As Dr. Kalainov is a non-party witness, if he is unwilling to appear voluntarily, applicant must secure his attendance by subpoena. Fed. R. Civ. P. 30.

⁶ The application has since registered, and the registration is the subject of opposers' motion to amend the pleadings.

Motion to Compel

As noted in the Board's prior order, applicant's motion to compel raises issues pertinent to the grant of Rule 56(d) discovery, and the Board reviews those issues here.

Privilege Log

Opposers have made boilerplate objections to every discovery request. Objections to discovery requests must be specific to the requests for which the objections are being interposed. That is, in addition to posing the objection, the objecting party must explain why the objection applies to the discovery request at issue. See 8B Wright, Miller, Kane and Marcus, *Fed. Prac. & Proc. Civ.* 3d §§ 2173 and 2213 (Westlaw update 2013) (hereinafter "Wright & Miller"). As a consequence, very little, if any, consideration will be given by the Board to general objections or to a rote listing of objections. This is so because the Board cannot guess why a particular objection or set of objections may apply. Despite opposers arguments to the contrary, the objections as worded appear to be rote objections that do not explain why the objection pertains to the particular discovery request at issue. Thus no further consideration is given to opposers' general objections.

Opposers have raised objections based on privilege, confidentiality and that information is "trade secret" or commercially sensitive. The Board's standard protective order for the exchange of confidential information and material is in

place, and deals with these issues. See Trademark Rule 2.116(g); TBMP § 412.01. Thus, any objections made by opposers on the grounds of confidentiality, trade secret, or that information is commercially sensitive, or the need for a protective order are resolved by the protective order already in place. To the extent opposers continue to assert any discovery responses are confidential and/or trade secret/commercially sensitive, opposers may appropriately mark its responses as provided in the Board's standard protective order, but may not withhold responsive information.

As opposers are appearing pro se, it is hard to see how any claim of attorney-client privilege would apply. But if opposers have some basis for such a claim, they must provide details about the claim.

Fed. R. Civ. P. 26 (b) (5) (A) provides that:

When a party withholds information otherwise discoverable by claiming that the information is privileged or subject to protection as trial-preparation material, the party must:

- (i) expressly make the claim; and
- (ii) describe the nature of the documents, communications, or tangible things not produced or disclosed—and do so in a manner that, without revealing information itself privileged or protected, will enable other parties to assess the claim.

By this procedure, the party who has withheld requested information on the basis of privilege must make the claim in such a way that the party seeking the information can decide whether to contest the claim and ultimately seek resolution by

the court, or in this case the Board, as to whether the claim of privilege applies. Thus, it is up to the responding party to provide the support for its assertion of privilege. In the present case, neither the requesting party nor the Board has any information with which to determine if the claims of privilege are properly asserted.

While Fed. R. Civ. P. 26(b)(5)(A) does not specify how the party asserting a claim of privilege must provide the information to support its claim of privilege, the most common way is through a privilege log. See 8 *Wright & Miller* § 2016.1. Such a log will normally contain a brief description or summary of the contents of the withheld document, date the document was prepared, the person or persons who prepared the document, the person to whom the document was directed or for whom the document was prepared, the purpose in preparing the document, the privilege or privileges asserted with respect to the document, and how each element of the privilege is met.

In the present case, opposers have not provided sufficient information to support its claims of privilege. In view thereof, opposers are ordered within **THIRTY DAYS** of the mailing date of this order to state that no items are being withheld based on claims of privilege, or to provide a privilege log as described herein for any items which are being withheld based on a claim of privilege.

The Board now turns to specific discovery requests.

Interrogatory Responses

Interrogatory No. 2: Seeks information about opposers' goods or services offered in connection with its M2 mark. Objections overruled the information is discoverable. See *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). To the extent opposer is asserting the requested information is trade secret, commercially sensitive information, it is covered by the protective order.

Interrogatory Nos. 5, 16 & 17: Opposers provide general information regarding a representative sampling of customers in the healthcare field and identified the names of two "representative" customers in their supplemental response to Interrogatory No. 5, but did not provide contact information and have not specified their "first customer" in the healthcare field. A party is required to furnish the name and address of its first customer in order to verify its claimed date of first use, and a party may be required to furnish, under protective order, the names of one or two of its customers for each year of a specified period of years, if there is a question of possible non-use or abandonment involved. See *Johnston Pump*, 10 USPQ2d at 1675. Objections overruled. Opposers must provide pursuant to the protective order, the names of, and contact information for, its first customer and those customers which it has designated as being a "representative sample" in the healthcare field.

Interrogatory Nos. 6, 10 & 14: Opposers responded that they "expended millions over 20 years" but did not provide any specific information. Objections overruled, the information is discoverable. See TBMP § 414(18). Opposers must provide, subject to the protective order, annual advertising and/or marketing figures in round numbers for 1992 to the present.

Interrogatory Nos. 7, 8 & 9: The interrogatories seek information about opposers' channels of trade, marketing and advertising. Objections overruled, the information is discoverable as it relates to the likelihood of confusion analysis. Opposers' answers are vague and must be answered with more specificity.

Interrogatory No. 11: The interrogatory seeks information about each person with knowledge of actual confusion. Objections overruled, the information is discoverable. See *Volkswagenwerk Akg. v. MTD Products Inc.*, 181 USPQ 471, 473 (TTAB 1974). While instances of actual confusion may not be dispositive, they may have a bearing on likelihood of confusion analysis.

Interrogatory No. 19: The interrogatory asks opposers to, "identify all services or products offered or provided under the M2 Mark in the healthcare field." Opposers answer is vague and gives a "representative sampling" but makes no showing that

the information is so vast or the number so great that a representative sampling is required. Objections overruled. As opposers seek to allege likelihood of confusion with services in the healthcare field, the information is relevant. Opposers must supplement the answer, or state it has no other responsive information.

Interrogatory Nos. 20 & 21: The interrogatories seek information about sales cycles and buyers, and media outlets for advertising. Objections overruled, the information is discoverable. See, e.g., *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, (TTAB 2010) (noting length of sales cycles in sales of computer systems used in analysis of sophistication of purchasers). Opposers answers are vague and must be answered with more specificity, or opposers must state it has no other responsive information.

Interrogatory Nos. 22 & 23: The interrogatories seek information about geographic territories. Objections overruled, the information is discoverable. Locations where a party conducts business or areas of distribution are discoverable. See TBMP § 414(15 & 16). Opposers responded that they would provide a representative sampling of non-privileged documents, "if any," responsive to the requests. Opposers are ordered to provide more complete answers to the interrogatory, or state no more responsive information exists.

Interrogatory No. 24: The interrogatory seeks information about trade shows and exhibitions where opposers have promoted their services. The information is discoverable. Opposers answer is vague and purports to provide a "representative sampling," without showing that the number is voluminous. Opposers are ordered to provide a more complete answer to the interrogatory, or state no more responsive information exists.

Interrogatory No. 25: The interrogatory seeks officers, directors, managing personnel and the number of employees by year since adoption of the M2 mark for services, which opposers have answered is 1991. The information is discoverable. TBMP § 414(12). Opposers have represented that it is a small business and provided the name of only one person as being "in charge of provision" of its services. Objections are overruled to the extent there are any other officers, directors or managers from the years 1991 to the present, opposers must answer the interrogatory or state there are none.

Interrogatory Nos. 27 and 31: Interrogatory No. 27 seeks "every agreement...between [opposers] and any third party that concerns or relates to the M2 mark;" and Interrogatory No. 31 seeks "all past and present non-disclosure agreements." Opposers' response to Interrogatory No. 27 appears to duplicate their answer to Interrogatory No. 26, and is not responsive, while their answer to Interrogatory No. 31 is non-responsive. Licenses and agreements are discoverable. See *Johnston Pump*,

10 USPQ2d at 1675; see also TBMP § 414(10). Opposers must answer the interrogatories, or state there are no agreements.

Interrogatory Nos. 29 and 32: Interrogatory No. 29 asks opposers to "Identify all distributors or resellers who incorporated M2 Services in their own products or services and offer or sell their goods or services." Opposers respond with general and boilerplate objections and refer to "a representative sampling of services" provided in response to Interrogatory No. 2. The answer does not appear to respond to the interrogatory as the "representative sampling" is vague and does not identify any particular persons or entities.

Interrogatory No. 32 seeks the first use of opposers M2 mark in the health care field. Opposers respond in part with a reference to their "representative sampling" of service projects to "a client" in the healthcare subsector provided in response to Interrogatory No. 5. The answer similarly does not appear to respond to the interrogatory as the "representative sampling" is also vague.

While it is well established that the names of customers, including resellers, constitute confidential information and generally are not discoverable, even under protective order, there are two exceptions. Where priority is at issue, the name of the first customer for a party's involved goods or services, and when there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. See *Fisons Ltd. v. Capability Brown Ltd.*, 209 USPQ 167, 169 (TTAB 1980) (possible harm outweighed where issue is abandonment); *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 583 (TTAB 1975) (name and address of first customer may be revealed to verify date of first use); see also, TBMP § 414(3 and 5).

In their motion for summary judgment, opposers claim priority based in part on common law rights and on the registration of their mark that issued after the filing of the notice of opposition, and claiming dates of use that stretch back twenty-one years. In view thereof, opposers must supplement their response to Interrogatory No. 29 to provide the name and address of the first customer for its goods, the first customer for services in the healthcare field, and the names and addresses of the "representative sampling" of customers referred to in its response to Interrogatory No. 2.

Interrogatory No. 30: The interrogatory asks opposers to identify "all public displays" of opposers' marks by opposers, or their distributors, resellers or authorized agents. Opposers respond they have promoted and marketed their marks and trade names at trade shows in the U.S. and Europe, through publications and directories, and in other ways, and allege

opposer maintains a website. The interrogatory is relevant as it goes to the use and fame of opposers' marks. Opposers' boilerplate objections, including that the information sought is trade secret and confidential, are overruled. Public displays are by their nature, public and not confidential. Opposers must respond to the interrogatory. If the only display is the website, then opposers must so state.

Interrogatory No. 33: The interrogatory asks opposers to "[i]dentify all lawsuits, oppositions or cancellation actions in which [y]ou have been deposed or have testified at trial. Opposers respond with boilerplate objections and that a "summary of prevailing formal proceedings" in which opposers have "successfully received a sustained opposition, a permanent injunction, or affirmative domain ruling" in its history to date, and refers to "Chart of Prevailing Enforcement Proceedings" that has been or will be provided.

The information sought is relevant to show, inter alia, admissions against interest or limitations on rights in the mark. See *American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons*, 201 USPQ 531, 533 (TTAB 1979). Opposers' objections are overruled. Information concerning litigation and controversies, including settlement agreements and other contractual agreements between responding party and third parties is discoverable. See *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577, 580-81 (TTAB 1975) (identity of all civil and USPTO proceedings involving mark is not objectionable); see also TBMP § 414(10). Opposers must provide the names of the parties to any legal proceedings, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision, if published. *Id.*

Interrogatory No. 34: The interrogatory asks opposers to identify all public recognition received by opposers including, but not limited to media articles, awards, publications, blog postings and appearances in social media. Opposers' response discusses its promotion and marketing efforts, but does not appear responsive. Further, as noted above, "public recognition" is by its nature not confidential information, and the information goes to the uses and promotion efforts of opposers for the involved marks. Opposers state in the response that they have promoted their marks "for over 20 years." While the Board is not persuaded that provision of the requested information is necessarily burdensome, in the interest of proportionality and moving this proceeding along in a timely manner, opposers must respond to the interrogatory, but the response is limited to providing relevant information for the years beginning in 2008 until the present.

Request for Production of Documents

Opposers have responded with boilerplate objections and indicated in response to every one of applicant's Requests for Production of Documents that responsive documents in the form of a "representative sampling" will be provided. The identification of discovery documents, as opposed to their substance, is not privileged or confidential. See *Goodyear Tire & Rubber Co. v. Tyrco Industries*, 186 USPQ 207, 208 (TTAB 1975) (fact that client received legal opinions and identity of documents related thereto, not privileged).

Opposers appear to have redacted the substantive details from many of the documents it has produced, which applicant argues "renders them indecipherable." Opposers must provide to applicant unredacted copies of the documents 1.) filed in support of the Omnibus Motion, which includes the motion for summary judgment, 2.) filed in support of the Motion to Quash, and 3.) any other documents produced by opposers.

With regard to a representative sampling of responsive documents, opposers have not indicated why it might be burdensome to produce responsive documents, nor have they indicated that a large number of documents are at issue. See *Bison Corp. v. Perfecta Chemie, B.V.*, 4 USPQ2d 1718, 1720-21 (TTAB 1987). For any production requests where opposers believe the document production would be voluminous, opposers must indicate something about the number of documents involved. If they are voluminous, opposers must provide a representative sampling for each year from 1991 to the present, for each of the goods and

services it is claiming, particularly in the healthcare field. Also, opposers have produced some documents without indicating to which requests they are responsive, nor indicating whether they have produced all documents in their possession custody or control. Opposers are ordered to produce an index to its documents with sufficient information for applicant to determine 1.) what the document is, and 2.) indicating to which requests the documents are responsive. Opposers must state unequivocally whether they have no documents in their custody, possession or control that are responsive to a request, or produce the documents and indicate to which request the documents are responsive.

Opposers are ordered to produce documents responsive to Request for Production Nos. 2-9, 11-14, 16-20, 23-26, 29-32, 34 and 36-51, or indicate that they have no responsive documents.

With regard to Document Request No. 7 which requests sales records, to the extent that opposers have records to show sales by channels of trade, in particular in the healthcare field, those records must be produced for each year opposers claim priority in every class for which opposers are claiming use, as they are relevant to issues of priority and likelihood of confusion.

For Document Request Nos. 7, 17-18 and 37-38, if the number of responsive documents is voluminous, opposers must indicate the number of documents involved to support the claim they are voluminous and provide documents sufficient

to identify a representative sampling of the requested information.

For Document Request No. 10, opposers must provide responsive documents sufficient for each year since opposers began use of the mark, or indicate that no documents exist for any particular year where opposers cannot provide documents.

To the extent that responsive documents have not yet been provided, opposers are allowed until **THIRTY DAYS** from the mailing date to do so. Opposers are also ordered to produce an index listing the documents provided, and indicating to which requests the document is responsive.

Summary

Where opposers have been ordered to provide or supplement discovery, the time set in the body of this order is **THIRTY DAYS** from the mailing date of this order. Applicant may take depositions of opposers' representative David Escamilla, and may seek to depose Dr. Kalainov after opposers serve their responses, supplemental responses, and produce documents and prior to the due date for applicant's substantive response to opposers' Omnibus motion/motion for summary judgment.

Applicant is allowed until **ninety days** from the mailing date of this order in which to file its response to opposers Omnibus motion/motion for summary judgment. Opposers' reply brief, if any, is due in accordance with Trademark Rule 2.127(a). Proceedings otherwise remain suspended in

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accordance with Trademark Rule 2.127(d), pending disposition of Opposers Omnibus motion/motion for summary judgment.
