

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

Mailed: January 12, 2012

Opposition No. 91202450

M2 Software, Inc.

v.

Modernizing Medicine, Inc.

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

On January 9, 2012, at applicant's request, the Board participated in the parties' discovery conference, conducted by telephone. The participants were David Escamilla, President and CEO of opposer, appearing pro se, David Byer, counsel for applicant, and Catherine Faint, Interlocutory Attorney for the Board.

Legal Representation Strongly Recommended

As discussed, while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the

Board may not provide legal advice, though it may provide information as to procedure.

Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006). If opposer decides to continue without counsel, it is urged to frequently consult the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (3d ed. 2011) and the Trademark rules of practice, which are available from the Office website at www.uspto.gov.

Prior Communications/Settlement/Related Proceedings

The parties have exchanged information regarding their claims and defenses, but are presently not interested in the suspension of proceedings to pursue settlement. The parties agreed to continue discussing potential settlement options at the end of the discovery conference, after the Interlocutory Attorney ended the call.

The parties are aware of no related proceedings before the Board or in any court. The parties did inform the Board that applicant had filed an extension of time to oppose opposer's pending Application Serial No. 85341646. As set forth in the institution order, the parties must notify the Board promptly if that proceeding is instituted, and they become parties to another Board proceeding, or a civil action,

which involve related marks or issues of law or fact which overlap with this case, as the Board may consider consolidation or suspension, as appropriate, in such cases.

Requirement for Service of Papers

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

The parties are reminded, however, that copies of all papers which either party may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer [or applicant] by forwarding said copy, via email to: [insert name and address].

The certificate of service must be signed and dated. See also TBMP § 113 (2d ed. rev. 2004).

Email Service

The parties stipulated to accept service of papers by email, and that opposer may be served at the following email address: info@m2software.com, and that applicant may be served at the following email address: David.Byer@klgates.com. The Board noted that since the parties have agreed to service by email, the parties may no longer avail themselves of the additional five days for service provided under Trademark Rule 2.119(c) that is afforded to parties when service is made by first-class or express mail.

TBMP

The Board directed the parties to TTAB Manual of Procedure, the TBMP, available in an electronic version on the Board's website at http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp. The parties may want to pay particular attention to Chapters 400-800 which describe the conduct of Board proceedings. Chapter 400 describes written discovery tools and discovery depositions. The parties should also look to the Trademark Rules for specific guidance. TBMP § 414 (3d ed. 2011) provides

an extensive, but not exhaustive, guideline of typical discovery topics in Board proceedings.

Board's Standard Protective Order

The Board then advised the parties of the automatic imposition of the Board's standard protective order in this case and further indicated that the parties would control which tier of confidentiality applies. Additionally, the Board stated that if the parties wished to modify the Board's standard protective order, they could do so by filing a motion for Board approval. The Board noted that inasmuch as opposer is representing itself *pro se* in this case, it would be unable to view documents produced by opposer that have been designated "Highly Confidential - For Attorneys Eyes Only." The Board advised, however, that opposer could contest the appropriateness of the "Highly Confidential - For Attorneys Eyes Only" designation by seeking an *in camera* inspection by the Board of such documents designated "FOR ATTORNEYS EYES ONLY" by applicant.

Initial Disclosures

The Board also provided the parties instruction as to what the required initial disclosures entail under Fed. R. Civ. P. 26(a). Furthermore, the Board noted that the service of discovery requests could not occur until a party made its initial disclosures as required by Fed. R. Civ. P. 26(f). The

Board also noted that a motion for summary judgment may not be filed until initial disclosures were made by the parties.

During the teleconference applicant's attorney noted that he would expect to see initial disclosures from opposer regarding M2 Software's alleged use of its pleaded marks for goods and services in relation to healthcare companies and/or third parties in the healthcare field.

Review of the Pleadings

Upon review of the notice of opposition, the Board noted opposer pleads based on Trademark Act § 2(d) or priority and likelihood of confusion, between applicant's M2 MODERNIZING MEDICINE and design marks for computer goods and services in Classes 9 and 42 (Application Serial Nos. 85102289 and 85102294) and opposer's common law rights and registered mark M2 (Registration No. 1931182) for computer goods and services. Applicant has denied the salient allegations of the complaint.

Discovery Topics

Based on the pleadings, the Board identified that discovery topics could be focused on the likelihood of confusion factors, *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563 (CCPA 1973).

The Board suggested to the parties that they could adopt various measures to limit the scope of discovery, including agreeing to limit the number of depositions, interrogatories, document production requests, and admission requests. The

parties declined to limit the scope of discovery at this time, but were willing to consider and discuss further the use of phone depositions or the submission of testimony by affidavit or declaration.

The parties also discussed producing responsive discovery documents in electronic form, rather than in hard copy paper form, although applicant was not willing to so stipulate at this time. The parties will discuss this further, and will seek to cooperate in providing electronic discovery where possible. The parties will also consider other stipulations that they may be able to agree on, such as stipulations as to facts.

Availability of ACR

The Board encourages settlement of matters between the parties. While the Board does not conduct settlement conferences, there is an Accelerated Case Resolution ("ACR") procedure available. The Board explained that the ACR procedure is an expedited procedure for obtaining a final decision from the Board. In order to pursue ACR, the parties must stipulate that the Board can make findings of fact. The parties may review more detailed information about ACR at the Board's website.¹ Should the parties agree to use the ACR procedure, the parties are reminded that they may stipulate to

¹ Information about the Board's ACR procedure may be viewed at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

facts after the close of the initial disclosure period and to a shortening of the discovery period. See Trademark Rule 2.120(a)(2). There are also possible stipulations that may streamline this case without agreeing to the full ACR procedure, as described on the Board's website.

Schedule

Dates remain as set in the Board's order of November 7, 2011.
