

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Baxley

Mailed: June 13, 2016

Opposition No. 91217516

*Iodine Software, LLC*

*v.*

*Iodine, Inc.*

Before Wellington, Ritchie and Heasley,  
Administrative Trademark Judges.

By the Board:

On August 6, 2013, Iodine, Inc. (“Applicant”) filed four intent-to-use applications to register the mark IODINE in standard character form for goods and services in International Classes 9, 35, 42 and 44. Iodine Software, LLC (“Opposer”) opposes registration of Applicant’s marks on the ground of likelihood of confusion with its previously used mark IODINE in connection with “development, marketing, promotion, and licensing of its healthcare management solutions in connection with the IODINE mark and [application Serial No. 86130079] since at least as early as January 1, 2010.”<sup>1</sup> Notice of Opposition, paragraph 4, 1 TTABVUE 6. Applicant, in its answer, denied the salient allegations of the notice of opposition.

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<sup>1</sup> As exhibits to its notice of opposition, Opposer included (1) copies downloaded from the USPTO’s TSDR database of (a) its pleaded application Serial No. 86130079, filed November 26, 2013, for the mark IODINE in standard characters for “Downloadable mobile applications for use by medical professional to receive information about, and administer, patient care” in International Class 9 and “Software as a service (SAAS) services featuring software for gathering, analyzing, and real-time monitoring of patient-related data to alert medical

Pursuant to the Board's July 23, 2015 order, Opposer's testimony period closed on January 24, 2016 with Opposer having filed no evidence and taken no testimony. On February 1, 2016, Applicant filed a motion to dismiss for failure to prosecute under Trademark Rule 2.132(a).

On March 8, 2016, Opposer filed an untimely response to that motion,<sup>2</sup> asserting in pertinent part: "As of February 15, 2016, Opposer agreed with Applicant's final settlement proposal in full and communicated same to Applicant's counsel. As of March 2, 2016, Applicant's counsel confirmed that they are awaiting further instructions from Applicant." 15 TTABVUE 2.

Based on that assertion, Opposer asked that the Board deny Applicant's motion and suspend proceedings to allow the parties time in which to complete their settlement agreement.

In a March 17, 2016 order, the Board considered that late response and allowed Opposer until March 27, 2016 "to supplement its response with documentation of the settlement." 16 TTABVUE 1. In response, Opposer asserted, without documentation, that, on March 21, 2016, its attorney sent the latest draft of a proposed settlement

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directors, Chief Medical Officers, case managers, physicians, documentation specialists, and other medical professionals and caregivers of events or patterns of behavior to help improve length of hospital stay, re-admissions, documentation, and other patient care metrics" in International Class 42; (b) Applicant's involved application Serial Nos. 86029638, 86029641, 86029644, and 86029647; and (2) a November 8, 2013 cease and desist letter that Opposer's attorney sent to Applicant. However, none of these exhibits constitutes evidence on Opposer's behalf. *See* Trademark Rule 2.122(c).

<sup>2</sup> Applicant served the motion to dismiss by mail on February 1, 2016. Accordingly, Opposer response to that motion was due by February 21, 2016. *See* Trademark Rules 2.119(c) and 2.127(a). In that response, Opposer did not explain why it failed to timely respond to the motion to dismiss.

agreement to Applicant's attorney; that, on March 28, 2016, the parties' attorneys discussed "new settlement terms proposed by Applicant;" that Opposer's attorney "must seek" Opposer's approval of the proposed new settlement terms; and that Applicant "must propose" a new draft of the parties' settlement agreement. 17 TTABVUE 2.

In reply, Applicant stated that Opposer had not provided the documentation required by the Board, that the parties had not reached a settlement, and that the parties' negotiations did not constitute good and sufficient cause why judgment should not be entered against Opposer.

Because Opposer's testimony period has closed and Applicant has filed a motion for judgment under Trademark Rule 2.132(a), Opposer must show good and sufficient cause why judgment should not be rendered against it, failing which the opposition will be dismissed with prejudice. The "good and sufficient cause" standard, in the context of Trademark Rule 2.132(a), is equivalent to the "excusable neglect" standard which Opposer would be required to meet under Fed. R. Civ. P. 6(b)(1)(B) to reopen its testimony period. *See PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1860-61 (TTAB 2002).

There are four factors to be considered, in the context of all the relevant circumstances, to determine whether a party's neglect of a matter is excusable. They are: (1) the danger of prejudice to the non-moving party; (2) the length of the delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether

the moving party has acted in good faith. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993). These factors do not carry equal weight. See *FirstHealth of the Carolinas Inc. v. CareFirst of Maryland Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921-22 (Fed. Cir. 2007) (Court affirmed finding of no excusable neglect based on second and third factors, with third weighed heavily in the analysis). The Board has noted on numerous occasions that, as several courts have stated, the third factor may be considered the most important factor in any particular case. See, e.g., *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 n.7 (TTAB 1997).

Turning initially to the third *Pioneer* factor, while attempts at settlement are generally favored, they do not excuse Opposer's failure to act within the prescribed time. See *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011); *Atlanta-Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (the belief in settlement and/or the existence of settlement negotiations do not justify a party's inaction or delay, or excuse it from complying with the deadlines set by the Board or imposed by the rules). Opposer could have sought an extension or suspension of proceedings prior to the close of its testimony period.<sup>3</sup> However, Opposer without explanation allowed its testimony period to lapse without filing any such motion. "Opposer brought this case and, in so doing, took responsibility for moving forward on the established schedule." *Atlanta-Fulton County Zoo*, 45 USPQ2d

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<sup>3</sup> The case was suspended several times pending settlement negotiations. However, Opposer did not seek additional extensions of its deadlines. Settlement negotiations generally constitute good cause for granting an extension or suspension.

at 1860. The Board finds therefore that Opposer's failure to take appropriate action prior to the close of its testimony period was within Opposer's reasonable control.

In addition, regarding the second *Pioneer* factor, we find that, from a docket management standpoint, that the delay has a significant potential impact on this case. Because Opposer allowed its testimony period to close without presenting any case-in-chief, this case is over, unless we reopen Opposer's testimony period. Such a reopening would delay resolution of this case by several months and runs counter to the Board's interest in an expeditious adjudication of its cases.

With regard to the remaining *Pioneer* factors, there is no evidence of bad faith attempt by Opposer, nor of specific prejudice to Applicant beyond mere delay. However, on balance, we find that Opposer has not demonstrated excusable neglect to warrant proceeding any further with this case.

In view of Opposer's failure to submit evidence or take testimony during its testimony period, Applicant's motion to dismiss under Trademark Rule 2.132(a) is granted. The opposition is dismissed with prejudice.