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Filing date: **09/14/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91256082
Party	Plaintiff Softtek Illuminate, Inc.
Correspondence Address	ROBERT REYNOLDS CONROY BARAN LLC 1316 ST LOUIS AVE KANSAS CITY, MO 64101 UNITED STATES Primary Email: rreynolds@conroybaran.com Secondary Email(s): rbaran@conroybaran.com No phone number provided.
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Robert Reynolds
Filer's email	rreynolds@conroybaran.com
Signature	/Robert Reynolds/
Date	09/14/2020
Attachments	Rule 15 petition - Illuminate.pdf(2622995 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application
Serial No. 88/732,936
Published on April 28, 2020

Softek Illuminate, Inc.)	
)	
Opposer)	Opposition No. <u>91256082</u>
)	
v.)	
)	
Merck Sharp & Dohme Corp.)	
)	
Applicant)	

MOTION FOR LEAVE TO FILE FIRST AMENDED OPPOSITION PLEADING

Pursuant to Rule 15 of the Federal Rules of Civil Procedure, Softek Illuminate, Inc. (“**Opposer**”) respectfully requests that the Board grant Opposer leave to file a First Amended Pleading. A copy of the proposed First Amended Pleading is attached hereto, as required by Fed. R. Civ. P. 15(a).

Under Rule 15(a)(2) of the Federal Rules of Civil Procedure, a party may amend its pleading only with the opposing party’s consent to the amendment in writing or on the Board’s leave. Fed. R. Civ. P. 15(a)(2); *see also Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016) (“Trademark Rule 2.115, 37 C.F.R. § 2.115, and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings, stating that ‘leave shall be freely given when justice so requires.’”).

The only difference between the First Amended Pleading and the initial opposition pleading is correctly identifying Opposer’s predecessor in interest, Softek Solutions, Inc., and to

correct a scrivener's error in the year of first use, changing from 2009 to 2008. This amendment does not change the status of this matter. Therefore, Opposer respectfully requests that the Board grant Opposer leave to file the First Amended Opposition Pleading. A redline and clean copy of the First Amended Pleading are attached hereto.

Respectfully submitted

Softek Illuminate, Inc.

By: /s/ Robert C. Reynolds
Robert C. Reynolds
Attorney for Opposer
Conroy Baran, LLC
1316 St. Louis Ave.
Second Floor
rreynolds@conroybaran.com

CERTIFICATE OF SERVICE

I hereby certify that on September 14, 2020, I caused a copy of the foregoing Motion for Leave to File A First Amended Opposition Motion, along with the First Amended Motion attached thereto, to be served by the ESTTA system on all counsel who have appeared in this matter and by electronic mail.

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Applicant)	

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
PO Box. 1451
Alexandria, Virginia 22312-1451

FIRST AMENDED NOTICE OF OPPOSITION

Opposer Softek Illuminate, Inc., (“**Opposer**”) with an address of 7299 W. 98th Terrace, #130, Overland Park, KS 66212, a Kansas corporation, believes that it will be damaged by the registration of the stylized mark ILLUMINATE, Serial No. 88/732,936 (“**Applicant’s Mark**”) which is owned by Merck Sharp & Dohme Corp., with an address of One Merck Drive, Whitehouse Station, New Jersey, 08889, a New Jersey corporation (“**Applicant**”) and hereby opposes the same.

1. Opposer ~~began using its ILLUMINATE brand in February of 2009~~ is the assignee and current holder of Registration No. 3,608,560, which began use in 2008 by Softek Solutions, Inc., Opposer’s predecessor in interest. Applicant filed U.S. Application Serial No. 88/732,936 for Applicant’s Mark on December 19, 2019, claiming a *bona fide* intent to use Applicant’s Mark in connection with “Providing medical information, namely, clinical study results to doctors and patients” in

Class 044. Upon information and belief, Applicant has not yet begun use of Applicant's Mark and thus Opposer has priority over Applicant's Mark.

2. Opposer is the owner and user of the following U.S. registrations ("**Opposer's Marks**"):
 - a. Registration No. 3,608,560 registered on April 21, 2009, and renewed April 20, 2019, for the standard character mark "ILLUMINATE" covering "computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data" in Class 009. This mark's registration is attached as Exhibit A and incorporated herein by reference and made of record pursuant to Trademark Rule 2.122(d).
 - b. Registration No. 6,023,126 registered on March 31, 2020, for the standard character mark "ILLUMINATE" covering "downloadable and recorded computer software for managing patient medical information, specifically software for generating automatic follow-up notices for primary care physicians regarding radiological findings; computer software for tracking pre-screened patient data and patient diagnoses" in Class 009 and "business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services" in Class 035. This mark's registration is attached as Exhibit B and incorporated herein by reference and made of record pursuant to Trademark Rule 2.122(d).
3. Each of the above-mentioned registrations is valid. Registration No. 3,608,560 is incontestable.
4. Opposer has made significant investments to advertise and promote Opposer's Services in interstate commerce in connection with the Marks and has established extensive goodwill in the Marks.
5. Applicant's mark is similar in sight and overall commercial appearance to Opposer's Marks. The literal element and pronunciation of Applicant's Mark is identical to Opposer's Marks. Applicant's

Mark will travel in the same channels of commerce as Opposer's Marks and covers very similar services.

6. Applicant's Mark so closely resembles Opposer's previously used and registered ILLUMINATE marks that its use, in connection with the services previously mentioned, is likely to cause confusion, or to cause mistake or deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).
7. Opposer will be damaged by the registration of Applicant's Mark for the services listed in Application Serial No. 88/732,936 as a result of the confusion, mistake, and deception listed in Paragraph 6 above.

WHEREFORE, Opposer Softek Illuminate, Inc. prays that this opposition be sustained and registration on Application Serial No. 88/732,936 be refused.

Respectfully submitted

Softek Illuminate, Inc.

By: /s/ Robert C. Reynolds
Robert C. Reynolds

Attorney for Opposer
Conroy Baran, LLC
1316 St. Louis Ave.
Second Floor
Kansas City, MO 64112

Date: ~~May 29~~ August 4, 2020

Exhibit A

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ILLUMINATE

Word Mark	ILLUMINATE
Goods and Services	IC 009. US 021 023 026 036 038. G & S: Computer software for managing patient medical information; computer software for indexing, searching, displaying, and managing electronic health records and electronic medical records; computer software for indexing, searching, displaying, and managing radiology images, radiology examinations, radiology reports, radiology data, and patient data. FIRST USE: 20080401. FIRST USE IN COMMERCE: 20080401
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77562892
Filing Date	September 4, 2008
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	February 3, 2009
Registration Number	3608560
Registration Date	April 21, 2009
Owner	(REGISTRANT) Softek Solutions, Inc. CORPORATION KANSAS Suite 100 Prairie Village KANSAS 66207 (LAST LISTED OWNER) SOFTEK ILLUMINATE, INC. CORPORATION KANSAS SUITE 130 7299 W. 98TH TERRACE OVERLAND PARK KANSAS 66212
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Robert Reynolds
Type of Mark	TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20190420.
Renewal 1ST RENEWAL 20190420
Live/Dead Indicator LIVE

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M:

Word Mark ILLUMINATE

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IC 035. US 100 101 102. G & S: Business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services. FIRST USE: 20110101. FIRST USE IN COMMERCE: 20110101

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 88598373

Filing Date August 29, 2019

Current Basis 1A

Original Filing Basis 1A

Published for Opposition January 14, 2020

Registration Number 6023126

Registration Date March 31, 2020

Owner (REGISTRANT) Softek Illuminate, Inc. CORPORATION KANSAS 10012 W. 50th Terr. Merriam KANSAS 66203

Attorney of Record Robert Reynolds

Prior Registrations 3608560

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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IC 035. US 100 101 102. G & S: Business consulting services provided to the healthcare industry, namely, the collection, reporting, and analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services. FIRST USE: 20110101. FIRST USE IN COMMERCE: 20110101

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