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

Proceeding	91256082
Party	Plaintiff Softtek Illuminate, Inc.
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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

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

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

ANSWER TO CANCELLATION COUNTERCLAIM

This answer is made pursuant to the timeline published by the Board on July 30, 2020, after it granted Opposer’s first consent motion to extend time to pursue settlement agreements. Opposer’s First Amended Opposition Pleading and motion granting Opposer leave for the same is currently pending before the Board, which (if granted) could modify the due dates in the current proceeding. In an abundance of caution Opposer has filed its answer to Applicant’s counterclaim in accordance with the dates currently in effect.

Softtek Illuminate, Inc. (“**Illuminate**”) hereby answers the counterclaims filed by Merck Sharp & Dohme Corp. (“**MSD**”) in MSD’s Answer to Notice of Opposition filed with the Board July 8, 2020.

In response to the first unnumbered paragraph in MSD’s counterclaim, Illuminate is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph

regarding MSD's belief as to damage from the continued registration of Registration Numbers 3,608,560 and 6,023,126 in connection with the goods and services identified therein, currently owned by Illuminate, and accordingly denies them.

1. Illuminate lacks information and knowledge necessary to form a belief as to the truth or falsity of the allegations of Paragraph 1 of the counterclaims and on that basis denies those allegations.

2. Illuminate admits that the contact information in Paragraph 2 is the publicly listed address of MSD.

3. Illuminate admits that MSD is the owner of record of application serial number 88/732,936 but lacks information and knowledge necessary to form a belief regarding MSD's *bona fide* intent to use the 88/732,936 mark, and on that basis denies those allegations.

4. Paragraph 4 makes no factual allegations, and as such does not require a response.

5. Illuminate admits the factual allegations in Paragraph 5.

6. Illuminate admits the factual allegations in Paragraph 6.

7. The USPTO's records speak for themselves regarding the history of Application Serial No. 77/562,892, and no further response is required.

8. The USPTO's records speak for themselves regarding the history of Application Serial No. 77/562,892, and no further response is required.

9. The allegations in Paragraph 9 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest, and to the extent that Illuminate has information and knowledge regarding the actions of Softek Solutions, Illuminate denies the factual allegations in Paragraph 9.

10. Illuminate made a small scrivener's error in its initial pleading and has since submitted a First Amended Pleading to the Board correcting this mistake. Illuminate denies the factual allegations in Paragraph 10.¹

11. The allegations in Paragraph 11 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest.

12. Illuminate denies the factual allegations in Paragraph 12.

13. A portion of the allegations in Paragraph 13 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent the allegation apply to Illuminate, Illuminate denies the factual allegations in Paragraph 13.

14. Illuminate admits that portions of its website, <https://goilluminate.com/> contain the words "Putting EMR Data to Work for the Radiology Practice" and "Welcome to the Patient-Centered Radiology Practice." The remaining allegations in Paragraph 14 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest.

15. Paragraph 15 states a legal conclusion which requires no response. To the extent a response is required, Illuminate denies the allegations in Paragraph 15.

16. Illuminate denies the factual allegations in Paragraph 16.

17. A portion of the allegations in Paragraph 17 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent the allegations apply to Illuminate, Illuminate denies the factual allegations in Paragraph 17.

¹ MSD's claim in Paragraph 10 is affected by Illuminate's First Amended and Restated Pleading.

18. The allegations in Paragraph 18 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent the allegations apply to Illuminate, Illuminate denies the factual allegations in Paragraph 18.

19. Illuminate admits that the USPTO granted Reg. No. 3,608,560, but denies the remainder of the allegations in Paragraph 19.

20. The USPTO's records for Registration No. 3,608,560 speak for themselves, and no response is required.

21. The USPTO's records for Registration No. 3,608,560 speak for themselves, and no response is required.

22. The allegations in Paragraph 22 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 22.

23. The allegations in Paragraph 23 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 23.

24. Paragraph 24 states a legal conclusion which requires no response. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 24.

25. A portion of the allegations in Paragraph 25 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. Illuminate denies the remaining factual allegations in Paragraph 25.

26. Paragraph 26 states a legal conclusion which requires no response. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 26.

27. Paragraph 27 states a legal conclusion which requires no response. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 27.

28. Paragraph 28 states a legal conclusion which requires no response. To the extent a response is required Illuminate denies the factual allegations in Paragraph 28.

29. A portion of the allegations in Paragraph 29 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. Illuminate denies the remaining factual allegations in Paragraph 29.

30. A portion of the allegations in Paragraph 30 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. Illuminate denies the remaining factual allegations in Paragraph 30.

31. Illuminate admits that the USPTO maintained Reg. No. 3,608,560, but denies the remainder of the allegations in Paragraph 31.

32. Illuminate denies the factual allegations in Paragraph 32.

33. Illuminate admits that it filed Application Serial No. 88/598,373, which matured into Reg. No. 6,023,126 in connection with “[d]ownloadable 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 09 and “[s]ervices related to the analysis, both real-time and post-completion, of productivity, efficiency, and completeness in the provision of healthcare services” in Class 35.

34. The USPTO's records for Application No. 88/598,373 speak for themselves, and no response is required.

35. The USPTO's records for Application No. 88/598,373 speak for themselves, and no response is required.

36. Illuminate denies the factual allegations in Paragraph 36.

37. Illuminate denies the factual allegations in Paragraph 37.
38. Illuminate admits that portions of its website, <https://goilluminate.com/> contain the words “Putting EMR Data to Work for the Radiology Practice”, “Welcome to the Patient-Centered Radiology Practice” and “instant access to the patient and business documentation your radiology practice needs.”
39. Paragraph 39 states a legal conclusion for which no response is required. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 39.
40. Paragraph 40 states a legal conclusion for which no response is required. To the extent a response is required, Illuminate denies the factual allegations in Paragraph 40.
41. Illuminate denies the factual allegations in Paragraph 41.
42. Illuminate denies the factual allegations in Paragraph 42.
43. Illuminate admits that the USPTO granted Reg. No. 6,023,126, but denies the remainder of the factual allegations in Paragraph 43.
44. Paragraph 44 sets forth legal conclusions for which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 44.
45. Paragraph 45 does not require a response.
46. The allegations in Paragraph 46 relate to the actions of a third party, Softek Solutions, Inc., Illuminate’s predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. The records of the USPTO speak for themselves regarding the basis of Application Serial No. 77/562,892 and no further response is required.
47. The allegations in Paragraph 47 relate to the actions of a third party, Softek Solutions, Inc., Illuminate’s predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. The records of the USPTO speak for themselves regarding what statements were made to the USPTO by which parties at which times, and no further response is required.
48. The allegations in Paragraph 48 relate to the actions of a third party, Softek Solutions, Inc., Illuminate’s predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief

on the allegations related to its predecessor in interest. The records of the USPTO speak for themselves and no further response is required.

49. The allegations in Paragraph 49 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. The records of the USPTO speak for themselves and no further response is required.

50. The USPTO's records for Application Serial No. 88/598,373 speak for themselves and no response is required.

51. The USPTO's records for Application Serial No. 88/598,373 speak for themselves and no response is required.

52. The USPTO's records for Application Serial No. 88/598,373 speak for themselves and no response is required.

53. A portion of the allegations in Paragraph 53 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations related to its predecessor in interest. To the extent that the allegations in Paragraph 53 relate to Illuminate, Illuminate denies the same.

54. A portion of the allegations in Paragraph 54 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations relating to its predecessor in interest. To the extent that the allegations in Paragraph 54 relate to Illuminate, Illuminate denies the same.

55. Illuminate admits that the USPTO granted Reg. No. 6,023,126, but denies the remainder of the factual allegations in Paragraph 55.

56. Paragraph 56 incorporates legal conclusions to which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 56.

57. Paragraph 57 requires no response. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 57.

58. Paragraph 58 sets forth legal conclusions to which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 58.

59. Paragraph 59 makes no factual allegations and as such requires no response.

60. A portion of the allegations in Paragraph 60 relate to the actions of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations relating to its predecessor in interest. To the extent that the allegations in Paragraph 60 relate to Illuminate, Illuminate denies the same.

61. A portion of the allegations in Paragraph 61 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 61 relate to Illuminate, Illuminate denies the same.

62. Paragraph 62 sets forth legal conclusions to which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 62.

63. Paragraph 63 requires no response. To the extent a response is required, Illuminate denies all allegations in Paragraph 64.

64. Paragraph 64 requires no response. To the extent a response is required, Illuminate denies all allegations in Paragraph 64.

65. Paragraph 65 sets forth legal conclusions to which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 65.

66. Paragraph 66 makes no factual allegations and as such requires no response.

67. A portion of the allegations in Paragraph 67 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 67 relate to Illuminate, Illuminate denies the same

68. A portion of the allegations in Paragraph 68 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information

and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 68 relate to Illuminate, Illuminate denies the same. The remainder of Paragraph 68 are legal conclusions which require no further response.

69. The allegations in Paragraph 69 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 69 relate to Illuminate, Illuminate denies the same.

70. A portion of the allegations in Paragraph 70 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 70 relate to Illuminate, Illuminate denies the same.

71. A portion of the allegations in Paragraph 71 relate to the actions, beliefs, and information of a third party, Softek Solutions, Inc., Illuminate's predecessor in interest. Illuminate lacks information and knowledge necessary to form a belief on the allegations as they related to its predecessor in interest. To the extent that the allegations in Paragraph 68 relate to Illuminate, Illuminate denies the same. Illuminate admits that the USPTO granted registration to Reg. Nos. 6,023,126 and 3,608,560 and maintained Reg. No. 3,608,560.

72. Illuminate denies that either Reg. Nos. 3,608,560 and 6,023,126 were premised on fraud. The remainder of Paragraph 72 requires no response.

73. Portions of Paragraph 73 state legal conclusions for which no response is required, and the remainder of Paragraph 73 requires no response.

74. Paragraph 74 sets forth legal conclusions to which no response is required. To the extent a response is required, Illuminate denies the allegations contained in Paragraph 74.

WHEREFORE, Opposer respectfully requests that the Trademark Trial and Appeals Board deny applicant Merck Sharpe & Dohme Corp's petition in all respects and dismiss their counterclaims.

Respectfully submitted

Softtek Illuminate, Inc.

By: /s/ Robert C. Reynolds
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