

TTAB



03-14-2003

U.S. Patent & TMOs/TM Mail Rpt Dt. #01

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

In the matter of Applications:

Serial Nos.: 78/126,968 and 78/126,971

Filed: May 7, 2002

Applicant: ForeScout Technologies, Inc.

Marks: ACTIVESCOUT and FORESCOUT

Published in the Official Gazette of November 12, 2002

NetScout Systems, Inc.,)
)
Opposer,)
)
v.)
)
ForeScout Technologies, Inc.,)
)
Applicant.)

Opposition No.

03/28/2003 EPINA1 00000056 78126968

01 FC:6402

600.00 OP

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
Box TTAB - Fee

CONSOLIDATED NOTICE OF OPPOSITION

NetScout Systems, Inc., a Delaware corporation doing business at 310 Littleton Road, Westford, Massachusetts 01886 (hereinafter "Opposer"), believes that it will be damaged by registration of the marks shown in Application Serial No. 78/126,968 and 78/126,971, both filed on May 7, 2002, in the United States Patent and Trademark Office, by ForeScout Technologies, Inc. (hereinafter "Applicant"), and hereby opposes same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063. A duplicate copy of this Consolidated Notice of Opposition and a check in the amount of \$600 for the opposition are enclosed. Please charge any additional fees to Attorney

Deposit Account 20-0531.

03/27/2003 EPINA1 00000039 78126968

01 FC:6402

300.00 OP

03/27/2003 EPINA1 00000040 78126971

01 FC:6402

300.00 OP

Adjustment date: 03/28/2003 EPINA1

03/27/2003 EPINA1 00000039 78126968

01 FC:6402

-300.00 OP

Adjustment date: 03/28/2003 EPINA1

03/27/2003 EPINA1 00000040 78126971

01 FC:6402

-300.00 OP

The grounds of opposition are as follows:

1. Opposer is a Delaware corporation, doing business at 310 Littleton Road, Westford, Massachusetts 01886.
2. Upon information and belief, Applicant is a Delaware corporation, doing business at 2755 Campus Drive, Suite 115, San Mateo, California 94403.
3. Opposer is the owner of U.S. Registration No. 1,764,154 for the trademark NETSCOUT for and in connection with "software for use on local area networks and wide area networks to analyze network information traffic for the purpose of measuring network performance and isolating and diagnosing errors, delays and faults in International Class 9." Such registration issued on April 13, 1993 and has become incontestible under Section 15 of the Lanham Act, 15 U.S.C. § 1056. Such registration is based on use of NETSCOUT since at least as early as October 7, 1991.
4. Opposer also is the owner of U.S. Registration No. 2,287,610 for the trademark NETSCOUT and Design for and in connection with "computer programs for monitoring and managing computer network traffic and computer network diagnostic software." Such registration issued on October 19, 1999 and is based on use of NETSCOUT and Design since at least as early as March 31, 1997.
5. In addition to its NETSCOUT and NETSCOUT and Design marks, Applicant has used the designation APPSCOUT. Such "scout" formatives, including the registrations and applications described above, form a family of "SCOUT" marks ("NetScout Family of Marks").
6. Applicant's Application Serial No. 78/126,968 seeks registration of the term ACTIVESCOUT as a trademark for "computer software designed to provide computer network perimeter security; computer hardware in International Class 9." Applicant's application was filed on May 7, 2002 and claims a date of first use of April 2000.

7. Applicant's Application Serial No. 78/126,971 seeks registration of the term FORESCOUT as a trademark for "computer software designed to provide computer network perimeter security; computer hardware in International Class 9." Applicant's application was filed on May 7, 2002 and claims a date of first use of April 2000.
8. The ACTIVESCOUT and FORESCOUT trademarks in Application Serial Nos. 78/126,968 and 78/126,971, respectively, are confusingly similar to Opposer's trademarks, including NETSCOUT, NETSCOUT and Design, APPSCOUT, and the NetScout Family of Marks ("NetScout Marks"), all in which Opposer has prior rights.
9. The goods identified in Applicant's Application Serial Nos. 78/126,968 and 78/126,971 are confusingly similar to the goods described in Opposer's Registration Nos. 1,764,154 and 2,287,610, and used in connection with the NetScout Family of Marks.
10. The goods identified in Applicant's Application Serial Nos. 78/126,968 and 78/126,971 are within the normal fields of expansion of Opposer's NetScout Marks and NetScout Family of Marks.

FIRST CLAIM FOR RELIEF: LIKELIHOOD OF CONFUSION

11. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 10 as if fully set forth herein.
12. Opposer's actual and constructive dates of first use for the NetScout Marks and NetScout Family of Marks precedes Applicant's filing dates and actual use dates, and any date on which Applicant can rely.
13. Applicant's ACTIVESCOUT and FORESCOUT designations are virtually identical to Opposer's NetScout Marks and NetScout Family of Marks.
14. The goods on which Applicant uses its ACTIVESCOUT and FORESCOUT designations are confusingly similar to Opposer's goods identified under the

NetScout Marks and NetScout Family of Marks, and the corresponding trademark registrations.

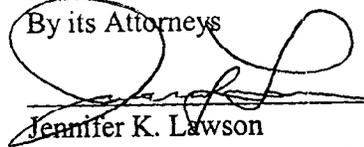
15. Under the expansion of trade doctrine, Opposer is entitled to protection against the registration of a similar mark on goods that might reasonably be expected to be produced by it in the normal expansion of its business. The goods covered by Applicant's applications are within the normal fields of expansion of Opposer's NetScout Marks and NetScout Family of Marks, and, therefore, cannot be allowed under Lanham Act § 1207.01(a)(v).
16. Applicant is not entitled to the registrations that it seeks, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because the alleged trademarks are likely to cause consumer confusion, to cause mistake, or to deceive consumers.
17. Opposer would be damaged by registration of the alleged trademarks because Applicant would obtain at least a prima facie exclusive right to use trademarks that are likely to cause confusion, to cause mistake, or to deceive.

WHEREFORE, Opposer requests that the present consolidated opposition be sustained and the registrations of ACTIVESCOUT and FORESCOUT sought by Applicant be refused.

Respectfully submitted,

NETSCOUT SYSTEMS, INC.

By its Attorneys



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Date: March 12, 2003

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CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence, including all documents referred to below as submitted herewith, are being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Box Responses – TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on this 12th day of March, 2003:


Gayle Buonopane

Submitted herewith are:

- (1) Consolidated Notice of Opposition (with duplicate copy);
- (2) Check in the amount of \$600.00
- (3) Postcard

All under this Certificate of First Class Mailing dated March 12, 2003.

DOCKETED:
FSD-601 0/4 US
TRADEMARK ADMINISTRATION