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

Proceeding	91198315
Party	Defendant Data Security, Inc.
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497-99133

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

Proton Data Security, LLC )

Opposer, )

v. )

Data Security, Inc. )

Applicant. )

Opposition No. 91198315

Serial No.: 77/840,286 )

Filed: October 2, 2009 )

Mark: DATA SECURITY, INC. )

Published: September 28, 2010 )

ANSWER TO NOTICE OF OPPOSITION

Data Security, Inc., Applicant in the above-identified Opposition, hereby responds to the Notice of Opposition filed by Proton Data Security, LLC ("Opposer") opposing registration of the mark DATA SECURITY, INC., Application Serial No. 77/840,286. Any and all allegations in the Notice of Opposition not specifically admitted herein are denied. Applicant responds to the numbered allegations as follows:

1. Registration of the mark in the Challenged Application should be refused because Applicant's mark consists of matter that is generic and not registrable. In addition, registration of the mark in the Challenged Application should be refused because Applicant has committed fraud on the PTO in connection with the prosecution of the Challenged Application.

ANSWER: Denied.

2. Opposer is a corporation organized and existing under the laws of the State of Florida and has a principal address of 9703 S. Dixie Highway, Suite 207, Miami, FL 33156.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2 of the Notice of Opposition, and, therefore, denies the same.

3. Upon information and belief, Applicant is a corporation organized and existing under the laws of the State of Nebraska and has a mailing address of 729 Q Street, Lincoln, NE 68508.

ANSWER: Admitted.

4. Since at least as early as 2007, Opposer has offered risk assessment, regulatory compliance, and consulting services in the field of data security and destruction. Opposer also sells data destruction devices such as degaussers (which destroy data on magnetic storage media, such as floppy disks and hard drives), declassifiers (which destroy data on optical storage media, such as CD-ROMS and DVDs) and destroyers (which physically destroy hard drives), all of which serve to secure data from falling into unauthorized hands.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Notice of Opposition, and, therefore, denies the same.

5. Like many companies in this field, Opposer uses the generic term "data security" as part of its name, in Opposer's case combining it with the distinctive term "Proton" to form the name "Proton Data Security." See lists of companies employing the term "data security" in their name, attached hereto as Exhibit A. Indeed, the law firm prosecuting the Challenged Application describes "data security" as one of its primary practice areas. See printout of <http://fitcheven.com/?t=5&LPA=988&format=xml&p=3128>, attached hereto as Exhibit B.

ANSWER: Applicant admits that its attorneys' website includes a practice area entitled "Privacy and Data Security" which references compliance with privacy laws not devices for erasing digital media. Furthermore, Applicant denies that the term is generic and lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 5 of the Notice of Opposition, and, therefore, denies the same.

6. On October 2, 2009, Applicant filed the Challenged Application to register the standard character mark DATA SECURITY, INC. ("Applicant's Mark"), which is also Applicant's corporate name, in connection with "Magnetic device for erasing digital(sic) and magnetic storage media" in Class 7 and "Electronic device for erasing digital(sic) and magnetic storage media" in Class 9.

ANSWER: Admitted.

7. The Challenged Application contains, as is required by 15 U.S.C. § 1051, a sworn declaration by the Applicant that Applicant believed it was the owner of Applicant's Mark and that no others have a right to use the mark in commerce, either in identical form, or in such near resemblance as to cause confusion.

ANSWER: Applicant admits that its Application for the DATA SECURITY, INC. mark

contained a sworn declaration that read in its entirety:

“The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051 (b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”

As to the remaining allegations, Applicant lacks the knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 9 of the Notice of Opposition, and, therefore, denies the same.

8. On December 31, 2009 the Examining Attorney issued an Office Action refusing registration on the grounds that the term “data security” is merely descriptive of Applicant’s goods.

ANSWER: Admitted.

9. On June 30, 2010, Applicant responded to the refusal by asserting a claim of acquired distinctiveness, pursuant to Section 2(f) of the Lanham Act, “through the applicant’s substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement.” Included with this response was a supporting declaration from the Applicant, also attesting to the “substantially exclusive and continuous use” of Applicant’s Mark, “for more than five years preceding the date of this Declaration.” The declaration, executed by Applicant’s president, also acknowledges that “willful false statements may jeopardize the validity of this Application or any resulting registration.” In reliance on these assertions, the Examining Attorney accepted the claim of acquired distinctiveness, and ultimately approved the Challenged Application for publication.

ANSWER: Applicant admits that on June 30, 2010, it responded to the Office Action by asserting a claim of acquired distinctiveness pursuant to Section 2(f) of the Lanham Act, and Applicant admits that it included with its response a declaration executed by Applicant's President which stated, *inter alia*, " the mark DATA SECURITY INC has become distinctive as applied to Applicant's goods due to the substantially exclusive and continuous use thereof by Data Security in commerce, which may be lawfully regulated by Congress, for more than five years preceding the date of this Declaration." Applicant also admits that the declaration included the statement that "such willful false statements may jeopardize the validity of this Application or any resulting registration..." Applicant also admits that the subject application was approved for publication by the PTO. As to the remaining allegations, Applicant lacks the knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 9 of the Notice of Opposition, and, therefore, denies the same.

10. Opposer would be damaged by the registration of the mark shown in the Challenged Application and has standing to bring this proceeding because registration would provide Applicant with presumptive exclusive rights to the generic wording in Opposer's name. Indeed, Applicant has already written to Opposer in November 2009 and January 2010, accusing Opposer of infringement and threatening to take legal action.

ANSWER: Applicant admits that it sent letters to Opposer in November 2009 and January 2010 to object to Opposer's newly adopted, confusingly similar trade name as well as Opposer's deceptive advertising. Further Applicant admits that registration of the Applicant's mark would provide it with a presumptive exclusive right to Applicant's mark. However, Applicant lacks the knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 10 of the Notice of Opposition, and, therefore, denies the same.

11. Because the wording in the Challenged Mark is generic as applied to the subject goods, the Challenged Application should be refused registration pursuant to Section 14 of the Lanham Act.

ANSWER: Applicant denies the allegations contained in paragraph 11 of the Notice of Opposition.

12. Even if not generic, the Challenged Mark is merely descriptive as applied to the subject goods, and the Challenged Application should be refused registration pursuant to Section 2(e) of the Lanham Act. The Challenged Mark has not acquired distinctiveness because its use by Applicant has not been substantially exclusive over the five years preceding Applicant's claim of acquired distinctiveness, as evidenced by the numerous third-party users of the term "data security". The term has not acquired secondary meaning as an identifier of Applicant's goods. Accordingly, Applicant's claim of acquired distinctiveness must fail under Section 2(f) of the Lanham Act and the Challenged Application must be rejected according to Section 2(e).

ANSWER: Applicant denies the allegations contained in paragraph 12 of the Notice of Opposition.

13. Applicant's two instances of fraud on the PTO each provide a separate ground for refusal of the Challenged Application.

ANSWER: Applicant denies the allegations contained in paragraph 13 of the Notice of Opposition.

14. In the sworn declaration initially submitted with the Challenged Application, Applicant falsely stated that it was the owner of Applicant's Mark and that no others have a right to use the mark in commerce, either in identical form, or in such near resemblance as to cause confusion. This was false, because in view of the widespread third-party use of "data security" as a generic term, Applicant is not the owner of Applicant's Mark and numerous others have a right to use the term "data security" in commerce. Given that widespread third-party use in its own industry, Applicant must have been aware that this statement was false and have made the statement with the intent to deceive the PTO into approving the Challenged Application. In reliance on this material misrepresentation, the PTO approved the Challenged Application for publication. Accordingly, registration should be refused for fraud on the PTO.

ANSWER: Applicant admits that the PTO approved the subject application for publication and that in its sworn declaration it stated *inter alia* that Applicant,

"believes the applicant to be the owner of the trademark/service mark sought to be registered, ...he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.."

Applicant denies Opposer's allegation that Applicant is not the owner of Applicant's mark. Applicant also denies having intent to deceive the PTO. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 14 of the Notice of Opposition, and, therefore, denies the same.

15. In the sworn declaration submitted with the claim of acquired distinctiveness in Challenged Application, Applicant falsely stated that it had made "substantially exclusive and continuous use" of Applicant's Mark, "for more than five years preceding the date of this Declaration." This was false, because in view of the widespread third-party use of "data security" as a generic term, Applicant's use in the relevant time period was far from substantially exclusive. Given that widespread use, Applicant must have been aware that this statement was false and have made the statement with the intent to deceive the PTO into approving the Challenged Application. Certainly, Applicant was at least aware of Opposer's use when it made this declaration because it had already contacted Opposer about its use months earlier. In reliance on this material misrepresentation, the PTO approved the Challenged Application for publication. Accordingly, registration should be refused for fraud on the PTO.

ANSWER: Applicant admits that its declaration stated that Applicant had made "substantially exclusive and continuous use" of Applicant's Mark, "for more than five years preceding the date of this Declaration." Applicant denies that statements made in Applicant's declaration are false. Applicant denies having intent to deceive the PTO. Applicant admits to contacting Opposer in November 2009 and January 2010 to object to Opposer's newly adopted, confusingly similar trade name as well as Opposer's deceptive advertising. As to the remaining allegations, Applicant lacks knowledge or information sufficient to form a belief as to the truth of said allegations contained in paragraph 15 of the Notice of Opposition, and, therefore, denies the same.

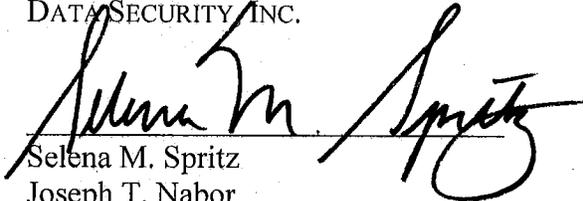
AFFIRMATIVE DEFENSES

For its affirmative defenses to the Notice of Opposition, Applicant states as follows:

1. The Notice of Opposition fails to state a claim upon which relief may be granted.
2. On information and belief, Opposer lacks standing to bring the Notice of Opposition.
3. On information and belief, Opposer has bad faith in that it adopted its trade name in part to trade upon the goodwill built up by the Applicant in the subject mark for the relevant goods.
4. On information and belief, any use of the mark DATA SECURITY by the Opposer began years after it was used by Applicant.

THEREFORE, Applicant respectfully prays that opposition to registration of its DATA SECURITY, INC. mark, Application Serial No. 77/840,286, be dismissed; that registration for Application Serial No. 77/840,286 be issued, and that Applicant be granted such other and further relief as the Board deems just and proper.

Respectfully submitted,  
DATA SECURITY INC.



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March 7, 2011

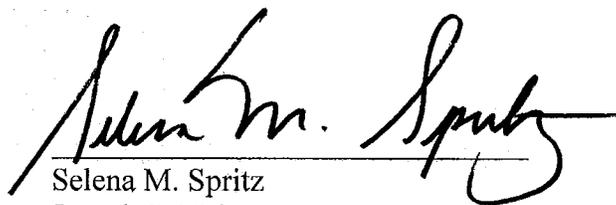
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

Michael Tschupp  
ESPINOSA TRUEBA PL  
3001 SW 3<sup>rd</sup> Avenue  
Miami, Florida 33129

*Attorney for Opposer*

on this 7<sup>th</sup> day of March, 2011.



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