

ESTTA Tracking number: **ESTTA425709**

Filing date: **08/17/2011**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	SolarWinds Worldwide, LLC
Granted to Date of previous extension	08/17/2011
Address	3711 South MoPac Expressway Building Two Austin, TX 78746 UNITED STATES
Attorney information	Susan E. Billheimer, Esq. Squire, Sanders & Dempsey (US) LLP 8000 Towers Crescent Drive 14th Floor Vienna, VA 22182 UNITED STATES ipgeneraltyc@ssd.com, celianna.sienkiewicz@ssd.com, susan.billheimer@ssd.com, douglas.goldhush@ssd.com Phone:703-720-7800

**Applicant Information**

Application No	77743820	Publication date	04/19/2011
Opposition Filing Date	08/17/2011	Opposition Period Ends	08/17/2011
Applicant	DeKing Gregg T 61 Codorus Road Montgomery, IL 605382520 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Apparatus for converting electronic radiation to electrical energy, namely, photovoltaic solar modules
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2917050	Application Date	11/24/2003
Registration Date	01/11/2005	Foreign Priority Date	NONE
Word Mark	SOLARWINDS		

Design Mark	<b>SOLARWINDS</b>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/03/00 First Use In Commerce: 1998/03/00 Computer software for use in monitoring and managing computer networking equipment		

U.S. Registration No.	3328422	Application Date	12/07/2006
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	SOLARWINDS		
Design Mark			
Description of Mark	The mark consists of a orange narrow square with a white circling rotating propeller shape image on the left side and the words solarwinds in white uppercase letters on the right side, with the image and words separated by a thin white line.		
Goods/Services	Class 009. First use: First Use: 2006/10/19 First Use In Commerce: 2006/10/19 Computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies		

U.S. Registration No.	3964126	Application Date	11/12/2009
Registration Date	05/24/2011	Foreign Priority Date	NONE
Word Mark	SOLARWINDS SOFTWARE		
Design Mark	<b>SOLARWINDS SOFTWARE</b>		
Description of Mark	NONE		

Goods/Services	Class 009. First use: First Use: 1998/03/00 First Use In Commerce: 1998/03/00 Computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies
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U.S. Registration No.	3805776	Application Date	06/19/2009
Registration Date	06/22/2010	Foreign Priority Date	NONE
Word Mark	SOLARWINDS CERTIFIED PROFESSIONAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 2009/06/23 First Use In Commerce: 2009/06/23 Indicating membership in an organization of network management professionals/engineers that have developed the required expertise in managing computer networks and the use of software applications to do so		

U.S. Registration No.	3805774	Application Date	06/19/2009
Registration Date	06/22/2010	Foreign Priority Date	NONE
Word Mark	SOLARWINDS CERTIFIED PROFESSIONAL		
Design Mark			
Description of Mark	The mark consists of the words "SOLARWINDS CERTIFIED PROFESSIONAL" in white on an orange oval styled background, of which the top half is of a lighter orange color than the bottom half; to the right of the word "SOLARWINDS" is a white solar flare.		
Goods/Services	Class 200. First use: First Use: 2009/06/23 First Use In Commerce: 2009/06/23 Indicating membership in an organization of network management professionals/engineers that have developed the required expertise in managing computer networks and the use of software applications to do so		

U.S. Registration No.	3690114	Application Date	03/04/2008
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	SOLARWINDS		
Design Mark			
Description of Mark	The mark consists of the word "SOLARWINDS" in dark gray with orange solar flares to the right of the wording.		
Goods/Services	Class 009. First use: First Use: 2008/04/27 First Use In Commerce: 2008/04/27 computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies		

Attachments	76563597#TMSN.gif ( 1 page )( bytes ) 77058905#TMSN.jpeg ( 1 page )( bytes ) 77871571#TMSN.jpeg ( 1 page )( bytes ) 77764162#TMSN.jpeg ( 1 page )( bytes ) 77764057#TMSN.jpeg ( 1 page )( bytes ) 77412471#TMSN.jpeg ( 1 page )( bytes ) SOLARWINDS_NOTICE OF OPPOSITION_SOLARWINDSUSA_Ser No 77743820.pdf ( 28 pages )(433550 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Susan E. Billheimer/
Name	Susan E. Billheimer, Esq.
Date	08/17/2011

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/743820: SOLARWINDSUSA, filed May 24, 2009  
Published in the Official Gazette of April 19, 2011, in International Class 009

SolarWinds Worldwide, LLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition. No. _____
	)	Serial. No. 77/743820
Gregg T. DeKing, d/b/a Solar Winds USA,	)	Mark: SOLARWINDSUSA
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

SolarWinds Worldwide, LLC, (“Opposer” or SolarWinds”), a corporation located and doing business at 3711 South Mopac Expressway, Building 2, Austin Texas, 78746, believes it will be damaged by registration of the proposed registration of the trademark SOLARWINDSUSA shown in Application Serial No. 77/743820, and it opposes the same. In particular, SolarWinds believes that the registration would give rise a likelihood of confusion with its existing domestic and international SOLARWINDS registered trademarks in violation of 15 U.S.C. §§ 1052(d).

The grounds for the opposition are as follows:

1. SolarWinds offers a variety of computer software and related goods and services under the distinctive SOLARWINDS trademark as well as a number of registered marks incorporating the SOLARWINDS component.

2. Since prior to the filing date of the application opposed herein, SolarWinds exclusively has distributed, advertised and sold in the United States a number of computer

software products and related goods and services under the SOLARWINDS trademark. As a result, SolarWinds has common law rights to the SOLARWINDS trademark for the goods and services that it provides.

3. SolarWinds also owns a number of SOLARWINDS trademark registrations that are registered with the United States Patent and Trademark Office, including without limitation U.S. Registration Nos. 2917050, 3328422, 3964126, 3805776, 3805774, 3690114. See Ex. A (providing TARR records of relevant SolarWinds' registrations). For example, U.S. Registrations 2917050, 3328422, and 3964126 cover:

- a. U.S. Reg. No. 2917050 for SOLARWINDS in standard characters for “computer software for use in monitoring and managing computer networking equipment” in International Class 009;
- b. U.S. Reg. No. 3328422 for SOLARWINDS and Design for “computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies” in International Class 009;
- c. U.S. Reg. No. 3964126 for SOLARWINDS SOFTWARE as a standard character form mark for “computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies” in International Class 009.

These registrations are valid and subsisting and are owned by Opposer.

4. Opposer has sold significant amounts of its SOLARWINDS computer software product in United States commerce and extensively has advertised and promoted its SOLARWINDS trademark in the United States.

5. By virtue of this extensive domestic and internal sales, advertising and promotion, the SOLARWINDS mark represents an extremely valuable goodwill to SolarWinds.

6. On May 24, 2009, Applicant filed an application to register the mark SOLARWINDSUSA for “apparatus for converting electronic radiation to electrical energy, namely, photovoltaic solar modules” in Class 009.

7. That application was filed on the basis of use claimed in United States commerce since January 1, 2009, pursuant to 15. U.S.C. 1152(a), and was assigned Application Serial No. 77/743820. Applicant later amended the filing basis to a *bona fide* intent to use the mark in United States commerce, in response to the USPTO’s request to provide a valid specimen of use.

8. Applicant’s proposed use of the mark SOLARWINDSUSA is likely to (a) cause confusion, mistake or deception with its existing SOLARWINDS mark, and (b) result in the mistaken belief that Applicant or its SOLARWINDSUSA photovoltaic solar modules are in some way legitimately connected with, licensed or approved by Opposer; causing harm and damage to Opposer. The applied-for mark is nearly identical in sound, appearance, meaning, connotation and commercial impression to Opposer’s existing trade name and trademarks.

9. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made commercial use of the mark SOLARWINDSUSA January 1, 2009, the priority date originally claimed in the opposed application. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made commercial use of the mark SOLARWINDSUSA prior to the application filing date of May 24, 2009.

10. Applicant’s proposed use of and application to register the mark SOLARWINDSUSA is without Opposer’s consent or permission.

11. This Opposition is timely, as Opposer has received extensions of time up to and including August 17, 2011, within which to file this Opposition.

12. This Opposition is being filed electronically through ESTTA, pursuant to the Board's rules. The filing fees are being paid through ESTTA.

WHEREFORE, Opposer SolarWinds Worldwide, LLC believes that it would be damaged by the registration by Applicant of the proposed mark SOLARWINDSUSA for the goods identified in Application Serial No. 77/743820, and prays that this Opposition be sustained and that said Application be refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §§ 1052(d).

Dated August 17, 2011

Respectfully submitted,

SQUIRE, SANDERS & DEMPSEY L.L.P.

By 

Susan E. Billheimer  
8000 Tysons Corner Center,  
Suite 1400  
Vienna, VA 22181  
sbillheimer@ssd.com

Attorneys for Opposer

**EXHIBIT A**

**USPTO ELECTRONIC (TARR) RECORDS EVINCING  
SOLARWINDS USPTO TRADEMARK REGISTRATIONS**

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-08-17 09:37:06 ET

Serial Number: 76563597 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2917050

Mark

# SOLARWINDS

(words only): SOLARWINDS

Standard Character claim: Yes

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2011-01-28

Filing Date: 2003-11-24

Transformed into a National Application: No

Registration Date: 2005-01-11

Register: Principal

Law Office Assigned: LAW OFFICE 116

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: M70 -TMO Law Office 116

Date In Location: 2011-01-28

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. [SOLARWINDS WORLDWIDE, LLC](#)

Address:

[SOLARWINDS WORLDWIDE, LLC](#)  
[3711 SOUTH MOPAC EXPRESSWAY BUILDING TWO](#)

AUSTIN, TX 78746

United States

**Legal Entity Type:** Limited Liability Company

**State or Country Where Organized:** Delaware

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### GOODS AND/OR SERVICES

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**International Class:** 009

**Class Status:** Active

Computer software for use in monitoring and managing computer networking equipment

**Basis:** 1(a)

**First Use Date:** 1998-03-00

**First Use in Commerce Date:** 1998-03-00

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### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-01-28 - Section 8 (6-year) accepted & Section 15 acknowledged

2011-01-28 - Case Assigned To Post Registration Paralegal

2011-01-10 - TEAS Section 8 & 15 Received

2010-02-18 - Assignment Of Ownership Not Updated Automatically

2008-12-17 - Automatic Update Of Assignment Of Ownership

2008-09-17 - Assignment Of Ownership Not Updated Automatically

2008-08-13 - Assignment Of Ownership Not Updated Automatically

2008-08-13 - Assignment Of Ownership Not Updated Automatically

2008-08-13 - Assignment Of Ownership Not Updated Automatically

2008-08-06 - Automatic Update Of Assignment Of Ownership

2007-09-28 - Attorney Revoked And/Or Appointed

2007-09-28 - TEAS Revoke/Appoint Attorney Received  
2007-02-05 - Applicant/Correspondence Changes (Non-Responsive) Entered  
2007-02-05 - TEAS Change Of Owner Address Received  
2007-01-16 - Attorney Revoked And/Or Appointed  
2007-01-16 - TEAS Revoke/Appoint Attorney Received  
2006-12-06 - Assignment Of Ownership Not Updated Automatically  
2006-11-30 - Applicant/Correspondence Changes (Non-Responsive) Entered  
2006-11-30 - TEAS Change Of Owner Address Received  
2006-11-30 - TEAS Change Of Correspondence Received  
2006-04-19 - Automatic Update Of Assignment Of Ownership  
2005-01-11 - Registered - Principal Register  
2004-10-19 - Published for opposition  
2004-09-29 - Notice of publication  
2004-08-23 - Law Office Publication Review Completed  
2004-08-16 - Assigned To LIE  
2004-08-07 - Amendment From Applicant Entered  
2004-07-30 - Unresponsive/Duplicate Paper Received  
2004-08-06 - Approved for Pub - Principal Register (Initial exam)  
2004-08-05 - Examiner's amendment mailed  
2004-08-04 - Amendment From Applicant Entered  
2004-07-30 - Unresponsive/Duplicate Paper Received  
2004-07-30 - PAPER RECEIVED  
2004-06-07 - Non-final action mailed  
2004-06-05 - Assigned To Examiner  
2003-12-22 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Douglas H. Goldhush, Esq.

**Correspondent**

Douglas H. Goldhush, Esq.  
SQUIRE, SANDERS & DEMPSEY, L.L.P.  
8000 TOWERS CRESCENT DRIVE  
14TH FLOOR  
TYSONS CORNER VA 22182  
Phone Number: 703-720-7800  
Fax Number: 703-720-7801

**Domestic Representative**

Alisa C. Key, Esq.  
Phone Number: 703-720-7800  
Fax Number: 703-720-7801

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Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-08-17 09:36:11 ET

Serial Number: 77058905 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3328422

**Mark**



(words only): [SOLARWINDS](#)

Standard Character claim: [No](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2007-11-06](#)

Filing Date: [2006-12-07](#)

Transformed into a National Application: [No](#)

Registration Date: [2007-11-06](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 112](#)

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Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-11-06](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. [SOLARWINDS WORLDWIDE, LLC](#)

**Address:**

[SOLARWINDS WORLDWIDE, LLC](#)

3711 SOUTH MOPAC EXPRESSWAY BUILDING TWO  
AUSTIN, TX 78746  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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### GOODS AND/OR SERVICES

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**International Class:** 009

**Class Status:** Active

Computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies

**Basis:** 1(a)

**First Use Date:** 2006-10-19

**First Use in Commerce Date:** 2006-10-19

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### ADDITIONAL INFORMATION

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**Color(s) Claimed:** The color(s) orange and white is/are claimed as a feature of the mark.

**Description of Mark:** The mark consists of a orange narrow square with a white circling rotating propeller shape image on the left side and the words solarwinds in white uppercase letters on the right side, with the image and words separated by a thin white line.

**Design Search Code(s):**

**26.01.02** - Circles, plain single line; Plain single line circles

**26.01.17** - Circles, two concentric; Concentric circles, two; Two concentric circles

**26.01.26** - Coils; Spirals; Swirls

**26.01.28** - Circles with irregular circumferences; Miscellaneous circular designs with an irregular circumference

**26.11.10** - Rectangles divided once into two sections

**26.11.21** - Rectangles that are completely or partially shaded

**Prior Registration Number(s):**

2917050

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-02-18 - Assignment Of Ownership Not Updated Automatically

2008-12-17 - Automatic Update Of Assignment Of Ownership

2008-08-06 - Automatic Update Of Assignment Of Ownership  
2007-11-06 - Registered - Principal Register  
2007-09-28 - Attorney Revoked And/Or Appointed  
2007-09-28 - TEAS Revoke/Appoint Attorney Received  
2007-08-21 - Published for opposition  
2007-08-01 - Notice of publication  
2007-07-17 - Law Office Publication Review Completed  
2007-07-17 - Assigned To LIE  
2007-06-12 - Approved for Pub - Principal Register (Initial exam)  
2007-05-29 - NON-FINAL ACTION E-MAILED  
2007-05-29 - Non-Final Action Written  
2007-05-05 - Teas/Email Correspondence Entered  
2007-05-04 - Communication received from applicant  
2007-05-04 - TEAS Response to Office Action Received  
2007-03-31 - Non-final action e-mailed  
2007-03-31 - Non-Final Action Written  
2007-03-31 - Assigned To Examiner  
2007-02-05 - Applicant/Correspondence Changes (Non-Responsive) Entered  
2007-02-05 - TEAS Change Of Owner Address Received  
2006-12-13 - Notice Of Design Search Code And Pseudo Mark Mailed  
2006-12-12 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Alisa C. Key, Esq.

**Correspondent**

Alisa C. Key, Esq.

Squire, Sanders & Dempsey, L.L.P.  
14th Floor  
8000 Towers Crescent Drive  
Tysons Corner VA 22182  
Phone Number: 703-720-7800  
Fax Number: 703-720-7801

**Domestic Representative**

Alisa C. Key, Esq.  
Phone Number: 703-720-7800  
Fax Number: 703-720-7801

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This page was generated by the TARR system on 2011-08-17 09:35:09 ET

Serial Number: [77412471 Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: [3690114](#)

Mark



(words only): [SOLARWINDS](#)

Standard Character claim: [No](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2009-09-29](#)

Filing Date: [2008-03-04](#)

Transformed into a National Application: [No](#)

Registration Date: [2009-09-29](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 116](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2009-08-25](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. [SOLARWINDS WORLDWIDE, LLC](#)

**Address:**

[SOLARWINDS WORLDWIDE, LLC](#)  
[3711 SOUTH MOPAC EXPRESSWAY BUILDING TWO](#)  
[AUSTIN, TX 78746](#)  
[United States](#)

**Legal Entity Type:** [Limited Liability Company](#)  
**State or Country Where Organized:** [Delaware](#)

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### GOODS AND/OR SERVICES

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**International Class:** [009](#)

**Class Status:** [Active](#)

[computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies](#)

**Basis:** [1\(a\)](#)

**First Use Date:** [2008-04-27](#)

**First Use in Commerce Date:** [2008-04-27](#)

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### ADDITIONAL INFORMATION

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**Color(s) Claimed:** [The color\(s\) orange and dark gray is/are claimed as a feature of the mark.](#)

**Description of Mark:** [The mark consists of the word "SOLARWINDS" in dark gray with orange solar flares to the right of the wording.](#)

**Design Search Code(s):**

[01.05.25](#) - Sun, other representations of the sun

[01.15.03](#) - Fire (flames), other than emanating from objects, words, numbers, fireplaces or candles;  
Flames, other than flames emanating from objects, words, numbers, fireplaces or candles

[01.15.15](#) - Fire (flames), emanating from objects, words or numbers

**Prior Registration Number(s):**

[2917050](#)

[3328422](#)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

[2010-02-18 - Assignment Of Ownership Not Updated Automatically](#)

[2009-09-29 - Registered - Principal Register](#)

[2009-08-25 - Law Office Registration Review Completed](#)

[2009-08-20 - Allowed for Registration - Principal Register \(SOU accepted\)](#)

[2009-08-07 - Statement Of Use Processing Complete](#)

2009-07-13 - Use Amendment Filed  
2009-08-06 - Case Assigned To Intent To Use Paralegal  
2009-07-13 - TEAS Statement of Use Received  
2009-01-13 - NOA Mailed - SOU Required From Applicant  
2008-12-17 - Assignment Of Ownership Not Updated Automatically  
2008-10-21 - Published for opposition  
2008-10-01 - Notice of publication  
2008-09-13 - Law Office Publication Review Completed  
2008-09-13 - Assigned To LIE  
2008-09-05 - Approved For Pub - Principal Register  
2008-09-03 - Teas/Email Correspondence Entered  
2008-09-02 - Communication received from applicant  
2008-09-02 - TEAS Response to Office Action Received  
2008-08-06 - Automatic Update Of Assignment Of Ownership  
2008-06-12 - Notification Of Non-Final Action E-Mailed  
2008-06-12 - Non-final action e-mailed  
2008-06-12 - Non-Final Action Written  
2008-06-12 - Assigned To Examiner  
2008-03-08 - Notice Of Design Search Code And Pseudo Mark Mailed  
2008-03-07 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Alisa C. Key

**Correspondent**

ALISA C. KEY  
SQUIRE, SANDERS & DEMPSEY  
8000 TOWERS CRESCENT DR FL 14

VIENNA, VA 22182  
Phone Number: 703.720.7800  
Fax Number: 703.720.7801

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Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-08-17 09:33:54 ET

Serial Number: [77764057 Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: [3805774](#)

**Mark**



**(words only):** [SOLARWINDS CERTIFIED PROFESSIONAL](#)

**Standard Character claim:** [No](#)

**Current Status:** [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

**Date of Status:** [2010-06-22](#)

**Filing Date:** [2009-06-19](#)

**Transformed into a National Application:** [No](#)

**Registration Date:** [2010-06-22](#)

**Register:** [Principal](#)

**Law Office Assigned:** [LAW OFFICE 109](#)

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** [650 -Publication And Issue Section](#)

**Date In Location:** [2010-06-22](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. [SolarWinds Worldwide, LLC](#)

**Address:**

[SolarWinds Worldwide, LLC](#)

Building Two, 3711 S. MoPac Expressway  
Austin, TX 78746  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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### GOODS AND/OR SERVICES

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**International Class:** 200

**Class Status:** Active

Indicating membership in an organization of network management professionals/engineers that have developed the required expertise in managing computer networks and the use of software applications to do so

**Basis:** 1(a)

**First Use Date:** 2009-06-23

**First Use in Commerce Date:** 2009-06-23

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### ADDITIONAL INFORMATION

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**Color(s) Claimed:** The color(s) orange and white is/are claimed as a feature of the mark.

**Disclaimer:** "CERTIFIED PROFESSIONAL"

**Description of Mark:** The mark consists of the words "SOLARWINDS CERTIFIED PROFESSIONAL" in white on an orange oval styled background, of which the top half is of a lighter orange color than the bottom half; to the right of the word "SOLARWINDS" is a white solar flare.

**Design Search Code(s):**

**01.15.03** - Fire (flames), other than emanating from objects, words, numbers, fireplaces or candles;  
Flames, other than flames emanating from objects, words, numbers, fireplaces or candles

**26.11.20** - Rectangles inside one another

**26.11.25** - Rectangles with one or more curved sides

**Prior Registration Number(s):**

2917050

3328422

3640732

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-06-22 - Registered - Principal Register

2010-04-06 - Notice Of Publication E-Mailed  
2010-04-06 - Published for opposition  
2010-03-03 - Law Office Publication Review Completed  
2010-03-03 - Assigned To LIE  
2010-02-18 - Assignment Of Ownership Not Updated Automatically  
2010-02-05 - Approved for Pub - Principal Register (Initial exam)  
2010-02-05 - Amendment to Use approved  
2010-01-27 - Amendment To Use Processing Complete  
2010-01-27 - Use Amendment Filed  
2010-01-26 - TEAS Amendment of Use Received  
2010-01-26 - Teas/Email Correspondence Entered  
2010-01-26 - Communication received from applicant  
2010-01-26 - TEAS Response to Office Action Received  
2009-09-21 - Notification Of Non-Final Action E-Mailed  
2009-09-21 - Non-final action e-mailed  
2009-09-21 - Non-Final Action Written  
2009-09-18 - Assigned To Examiner  
2009-06-24 - Notice Of Design Search Code And Pseudo Mark Mailed  
2009-06-23 - New Application Office Supplied Data Entered In Tram  
2009-06-23 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Alisa C. Key

**Correspondent**

ALISA C. KEY  
SQUIRE, SANDERS & DEMPSEY LLP  
8000 TOWERS CRESCENT DR FL 14

[VIENNA, VA 22182-6207](#)

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Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-08-17 09:33:07 ET

Serial Number: [77764162 Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: [3805776](#)

Mark

**SOLARWINDS CERTIFIED  
PROFESSIONAL**

(words only): [SOLARWINDS CERTIFIED PROFESSIONAL](#)

Standard Character claim: [Yes](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2010-06-22](#)

Filing Date: [2009-06-19](#)

Transformed into a National Application: [No](#)

Registration Date: [2010-06-22](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 109](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2010-06-22](#)

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. [SolarWinds Worldwide, LLC](#)

Address:

[SolarWinds Worldwide, LLC](#)

Building Two 3711 S. MoPac Expressway  
Austin, TX 78746  
United States  
**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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### GOODS AND/OR SERVICES

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**International Class:** 200

**Class Status:** Active

Indicating membership in an organization of network management professionals/engineers that have developed the required expertise in managing computer networks and the use of software applications to do so

**Basis:** 1(a)

**First Use Date:** 2009-06-23

**First Use in Commerce Date:** 2009-06-23

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### ADDITIONAL INFORMATION

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**Disclaimer:** "CERTIFIED PROFESSIONAL"

**Prior Registration Number(s):**

2917050

3328422

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-06-22 - Registered - Principal Register

2010-04-06 - Notice Of Publication E-Mailed

2010-04-06 - Published for opposition

2010-03-03 - Law Office Publication Review Completed

2010-03-03 - Assigned To LIE

2010-02-18 - Assignment Of Ownership Not Updated Automatically

2010-02-05 - Approved for Pub - Principal Register (Initial exam)

2010-02-05 - Amendment to Use approved  
2010-01-27 - Amendment To Use Processing Complete  
2010-01-27 - Use Amendment Filed  
2010-01-26 - TEAS Amendment of Use Received  
2010-01-26 - Teas/Email Correspondence Entered  
2010-01-26 - Communication received from applicant  
2010-01-26 - TEAS Response to Office Action Received  
2009-09-21 - Notification Of Non-Final Action E-Mailed  
2009-09-21 - Non-final action e-mailed  
2009-09-21 - Non-Final Action Written  
2009-09-18 - Assigned To Examiner  
2009-06-24 - Notice Of Pseudo Mark Mailed  
2009-06-23 - New Application Office Supplied Data Entered In Tram  
2009-06-23 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Alisa C. Key, Esq.

**Correspondent**

ALISA C. KEY, ESQ.  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
8000 TOWERS CRESCENT DR FL 14  
VIENNA, VA 22182-6207  
Phone Number: 703.720.7800  
Fax Number: 703.720.7801

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Serial Number: 77871571 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3964126

Mark

**SOLARWINDS SOFTWARE**

(words only): [SOLARWINDS SOFTWARE](#)

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2011-05-24

Filing Date: 2009-11-12

Transformed into a National Application: No

Registration Date: 2011-05-24

Register: Principal

Law Office Assigned: [LAW OFFICE 113](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 650 -Publication And Issue Section

Date In Location: 2011-05-24

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. [SOLARWINDS WORLDWIDE, LLC](#)

Address:

[SOLARWINDS WORLDWIDE, LLC](#)

BUILDING 2 3711 SOUTH MOPAC EXPRESSWAY  
AUSTIN, TX 78746  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** Delaware

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### GOODS AND/OR SERVICES

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**International Class:** 009

**Class Status:** Active

Computer software in the field of computer network management for use in monitoring the computer network and infrastructure of businesses and government agencies

**Basis:** 1(a)

**First Use Date:** 1998-03-00

**First Use in Commerce Date:** 1998-03-00

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### ADDITIONAL INFORMATION

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**Disclaimer:** "SOFTWARE"

**Prior Registration Number(s):**

2917050

3328422

3690114

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2011-05-24 - Registered - Principal Register

2011-03-08 - Notice Of Publication E-Mailed

2011-03-08 - Published for opposition

2011-02-02 - Law Office Publication Review Completed

2011-02-01 - Assigned To LIE

2011-01-03 - Approved for Pub - Principal Register (Initial exam)

2010-12-29 - Teas/Email Correspondence Entered

2010-12-28 - Communication received from applicant  
2010-12-28 - TEAS Request For Reconsideration Received  
2010-08-30 - Notification Of Final Refusal Emailed  
2010-08-30 - Final refusal e-mailed  
2010-08-30 - Final Refusal Written  
2010-08-25 - Teas/Email Correspondence Entered  
2010-08-24 - Communication received from applicant  
2010-08-24 - TEAS Response to Office Action Received  
2010-02-24 - Notification Of Non-Final Action E-Mailed  
2010-02-24 - Non-final action e-mailed  
2010-02-24 - Non-Final Action Written  
2010-02-18 - Assignment Of Ownership Not Updated Automatically  
2010-02-18 - Assigned To Examiner  
2009-11-19 - Notice Of Pseudo Mark Mailed  
2009-11-18 - New Application Office Supplied Data Entered In Tram  
2009-11-16 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Alisa C. Key

**Correspondent**

ALISA C. KEY  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
8000 TOWERS CRESCENT DR FL 14  
VIENNA, VA 22182-6207  
Phone Number: (703) 720 7800  
Fax Number: (703) 720 7801

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### CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 CFR § 2.119, I served a true copy of the foregoing NOTICE OF OPPOSITION and exhibits thereto on Applicant by sending said copy by U. S. First Class Mail to Applicant's attorney of record, addressed as follows:

Adam E. Schwartz  
Schwartz Intellectual Property Law, PLLC  
Suite 2157  
244 5th Avenue  
New York NY 10001

on this day, August 17, 2011.

By   
Susan E. Billheimer  
8000 Tysons Corner Center,  
Suite 1400  
Vienna, VA 22181  
sbillheimer@ssd.com