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

Proceeding	91228034
Party	Defendant INFORMATION SYSTEMS AUDIT AND CONTROL ASSOCIATION, INC.SOCIATION, INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CSXT Intellectual Properties Corporation)
)
 Opposer,)
)
 v.)
)
 Information Systems Audit and Control)
 Association, Inc.)
)
 Applicant.)

Opposition No. 91228034
Application No. 86203846



ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION

Applicant, by its attorneys Ladas & Parry LLP, for its Answer and Affirmative Defenses to the Notice of Opposition filed by CSXT Intellectual Properties Corporation, hereby states as follows:

1. Applicant, Information Systems Audit and Control Association, Inc. (“ISACA”), seeks to register the stylized mark “CSX CYBERSECURITY NEXUS” (the “CSX CYBERSECURITY NEXUS Mark”) for pre-recorded media, computer software, and other materials for business management, consultation, and auditing of information systems in International Class 9; newsletters and journals relating to auditing and data processing in International Class 16; association services in the field of internal auditing in International Class 35; and educational services relating to telecommunication, database performance evaluation, and auditing in International Class 41. See U.S. Application Serial No. 86/203,846.

ANSWER:

Applicant admits that it filed its application for CSX CYBERSECURITY NEXUS and Design on February 25, 2014, as evidenced by Application No. 86203846, and that the application speaks for itself.

2. Opposer, CSXT Intellectual Properties Corp. (“CSXT”), a Delaware corporation with its principal place of business at 500 Water Street, Jacksonville, FL 32202, would be damaged by

registration of the CSX CYBERSECURITY NEXUS Mark and therefore opposes registration under 15 U.S.C. § 1063.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the factual allegations of Paragraph 2 of the Notice. Applicant denies the legal conclusions of Paragraph 2 of the Notice.

3. Pursuant to Trademark Rule 2.102, CSXT obtained an extension of time for filing a Notice of Opposition against registration of the CSX CYBERSECURITY NEXUS Mark up to and including May 23, 2016.

ANSWER:

Applicant admits that the Opposer was granted an extension of time up to May 21, 2016, a Saturday, and the Notice of Opposition was filed on May 23, 2016, the following Monday.

4. CSX Corporation is one of the largest providers of rail-based freight transportation services in North America. The transportation network owned and operated by CSX Corporation and its subsidiaries, such as CSX Intermodal Terminals, Inc. and CSX Transportation, Inc., encompasses approximately 21,000 route miles of track in 23 states, the District of Columbia, and Canada. Nearly two-thirds of Americans live within the service territory of CSX Corporation and its subsidiaries.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Notice.

5. For the past 20 years, CSX Corporation also has done substantial business in the field of information technology. Indeed, CSX Corporation began offering information technology and computer services, such as website design and creation and computer software maintenance and development, through its subsidiary CSX Technology, Inc. in 1987. For more than 15 years, CSX Technology, Inc. provided information technology and computer services under marks such as CSX TECHNOLOGY and ADVANCED INFORMATION TECHNOLOGY CENTER.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 5 of the Notice.

6. Today, CSX Corporation, through its subsidiary, CSX Technology, Inc., continues to provide information technology colocation and managed services, such as troubleshooting computer hardware systems, providing secure co-hosting services and infrastructure, and monitoring software and hardware systems for security purposes, in the United States under the mark ColoCSX.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 6 of the Notice.

7. CSX Corporation, directly and through its subsidiaries, uses a large portfolio of trademarks in connection with its rail-based freight transportation and related services. CSXT, a wholly-owned subsidiary of CSX, owns and licenses the various trademarks used by CSX Corporation and its subsidiaries. CSX Corporation and its subsidiaries, including CSXT, are collectively referred to herein as “CSX.”

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 7 of the Notice.

8. CSX’s trademarks are invaluable to CSX’s business, as they distinguish CSX’s services from those of other rail-based freight transportation service and information technology service providers in the minds of the consuming public.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 8 of the Notice.

9. To protect its substantial investment in, and the goodwill associated with, its large portfolio of trademarks, CSXT has obtained federal registrations from the United States Patent and Trademark Office for many of its trademarks, including, but not limited to, the following (collectively, the “CSX Marks”):

Mark	Registration No.	Registration Date	Services
CSX	2,543,728	March 5, 2002	Consulting services in the fields of transportation and freight distribution and storage, namely consulting in the selection of freight transportation, storage, manufacturing and distribution sites in Class 42
CSX	2,475,447	August 7, 2001	Transportation of freight by train and truck and warehouse storage of freight in Class 39
	2,364,124	July 4, 2000	Transportation of freight by train, truck, barge, and warehouse storage of freight in Class 39.
	2,544,010	March 5, 2002	Transportation of freight by train and truck, and warehouse storage of freight in Class 39
	3,712,055	November 17, 2009	Business management consulting services in the field of freight transportation; Consulting services in the fields of transportation and freight distribution and storage, namely, consultation regarding the impact of selection of freight transportation, storage, manufacturing and distribution sites on the efficiency of freight logistics in Class 35
COLOCSX	4,483,720	February 18, 2014	Maintenance of computer hardware systems; technical support services, namely, troubleshooting in the nature of the repair of computer hardware, in Class 37; Computer equipment co-location services, namely, providing facilities for the location of computer servers with the equipment of others and network co-hosting services, namely, server hosting, website hosting services; leasing of computer facilities and server space; technical support, namely, providing backup computer programs and facilities; computer systems analysis, maintenance of software for computer systems, and technical support services namely, troubleshooting in the nature of diagnosing computer hardware and software problems; monitoring technological functions of computer network systems; consulting services in the field of design, selection and implementation and use of computer hardware and software systems for others, in Class 42; and Monitoring of computer software and hardware systems for security purposes in Class 45.
	4,509,105	April 8, 2014	Maintenance of computer hardware systems; technical support services, namely, troubleshooting in the nature of the repair of computer hardware in Class 37; Computer equipment co-location services, namely, providing facilities for the location of computer servers with the equipment of others and network co-hosting services, namely, server hosting, and website hosting services; leasing of computer facilities and server space; technical support, namely, providing backup computer programs and facilities; computer systems analysis, maintenance of software for computer systems, and technical support services namely, troubleshooting in the nature of diagnosing computer hardware and software problems;

monitoring technological functions of computer network systems; consulting services in the field of design, selection and implementation and use of computer hardware and software systems for others in Class 42; and Monitoring of computer software and hardware systems for security purposes in Class 45.

ANSWER:

Applicant admits that registrations matching those registration numbers are listed in the records of the United States Patent and Trademark Office, but is without knowledge of the remaining allegations of Paragraph 9.

10. Copies of the registration certificates for the aforementioned marks are attached as Exhibit A.

ANSWER:

Applicant admits that photocopies of registration certificates are attached as Exhibit A, but notes that the exhibits are not certified copies and Applicant is without knowledge as to their current status or title.

11. CSX also enjoys substantial common law rights in the CSX Marks. For example and without limitation, CSX has used in commerce the CSX CORPORATION Mark claimed in U.S. Registration No. 2,364,124 since at least 1997.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 11 of the Notice.

12. Given the global reach of CSX's well-known goods and services, CSX also has obtained foreign trademark registrations covering both the rail and information technology services. For example and without limitation, CSX's famous "CSX" mark is registered internationally for use in business management, advisory services, and other consulting services in Class 35.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 12 of the Notice.

13. CSX has expended considerable time, money, and effort in the development, preparation, advertising, and promotion of goods and services under the CSX Marks throughout the United States. The CSX Marks are integral parts of CSX's business and brand identity.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 13 of the Notice.

14. CSX's trademark registrations for several of the CSX Marks are incontestable, having been registered for well over five years. See, e.g., Ex. A, at U.S. Registration Nos. 2,543,728; 2,475,447; 2,544,010; and 3,712,055.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 14 of the Notice.

15. By virtue of CSX's long, exclusive, and continuous use of the distinctive CSX Marks, CSX's services have become well-known to the general consuming public in both the rail and information technology sectors. Indeed, the information technology publication ComputerWorld in 2013 ranked CSX within the top 20 "Best Places to Work in IT." See Ex. B.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 15 of the Notice.

16. Thus, the CSX Marks have come to represent valuable symbols of CSX's goodwill.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 16 of the Notice.

17. ISACA filed an intent to use application on February 2, 2014, seeking to register the CSX CYBERSECURITY NEXUS Mark in Classes 9, 16, 35, and 41. See U.S. Application Serial No. 86/203,846 (the “Application”).

ANSWER:

Applicant admits that it filed its application for CSX CYBERSECURITY NEXUS and Design on February 25, 2014, as evidenced by Application No. 86203846, and that the application speaks for itself.

18. The Board issued a non-final rejection on June 5, 2014, finding, among other things, that the CSX CYBERSECURITY NEXUS Mark presented a likelihood of confusion with the mark claimed in U.S. Application No. 79/145,331, which was filed by Sony Corp. before ISACA submitted the instant application.

ANSWER:

Applicant admits that the Board issued an Office Action dated June 5, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Office Action speaks for itself.

19. The Board further advised that ISACA would need to disclaim “CYBERSECURITY” apart from the mark as shown, and also would need to clarify the description of goods and services claimed in Class 9.

ANSWER:

Applicant admits that the Board issued an Office Action dated June 5, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Office Action speaks for itself.

20. By response dated October 31, 2014, ISACA disclaimed “CYBERSECURITY” apart from the mark as shown, clarified the meaning of “downloadable documents” as used in the Class 9 goods and services description, and requested that the Examiner reconsider its potential refusal under Second 2(d) based on a likelihood of confusion with Sony’s CSX Mark.

ANSWER:

Applicant admits that it filed a Response to Office Action dated October 31, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Response to Office Action speaks for itself.

21. ISACA specifically argued that ISACA’s and Sony’s services were in different fields, with Sony offering entertainment-related services, and ISACA intending to offer services in the fields of “telecommunication, data base performance evaluation, internal auditing and electronic data processing audit techniques.” (Resp. Office Action, at 3.)

ANSWER:

Applicant admits that it filed a Response to Office Action dated October 31, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Response to Office Action speaks for itself.

22. The Board was not persuaded by ISACA’s arguments, and accordingly suspended the Application on November 29, 2014. (Suspension Notice, at 1.)

ANSWER:

Applicant admits that the Board issued a Suspension Letter on November 29, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Suspension Letter speaks for itself.

23. The Board withdrew its citation to Sony’s application on February 9, 2016, and the Application was published for opposition on March 2, 2016.

ANSWER:

Applicant admits that the Board issued a “Note To The File” on February 9, 2016 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the “Note To The File” speaks for itself. Applicant further admits that a Notice of Publication was issued on March 2, 2016 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Notice of Publication speaks for itself. Applicant further admits that its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, was actually published for opposition on March 22, 2016.

24. The goods and services identified in ISACA’s application, as published, are as follows:

Class 9: Pre-recorded media, namely, compact discs containing instructional, educational and teaching materials in the area of information technology for business management, consultation and auditing of information systems; computer software containing instructional, educational and teaching materials in the area of information technology for business management, consultation and auditing of information systems; downloadable computer software and downloadable cloud computer software for use in the fields of education, information technology, business management and information technology; downloadable documents, namely, white papers, training course materials, journal articles and publications, in the fields of education, information technology, business management and information technology;

Class 16: Newsletters and journals relating to auditing and data processing;

Class 35: Association services, namely, promoting the interest of auditors and data processors in the field of internal auditing; and

Class 41: Educational services, namely, conducting conferences, seminars and workshops in the fields of telecommunication, data base performance evaluation, internal auditing and electronic data processing auditing techniques.

ANSWER:

Applicant admits that the goods as listed match those in its application for CSX

CYBERSECURITY NEXUS and Design as published on March 22, 2016, as evidenced by

Application No. 86203846, and that the application speaks for itself.

25. ISACA currently promotes its goods and services through the website <https://cybersecurity.isaca.org> (the “ISACA Website”). Upon information and belief, based on information available through the ISACA Website, the goods and services in connection with which ISACA uses and/or intends to use the CSX CYBERSECURITY NEXUS Mark relate to the field of cybersecurity.

ANSWER:

Applicant admits the allegations of Paragraph 25 of the Notice.

26. As ISACA further explained in its October 31, 2014 Response to Office Action, ISACA’s CSX CYBERSECURITY NEXUS program “focuses on cybersecurity research, education, guidance, and certifications.”

ANSWER:

Applicant admits that it filed a Response to Office Action dated October 31, 2014 in its application for CSX CYBERSECURITY NEXUS and Design, as evidenced by Application No. 86203846, and that the Response to Office Action speaks for itself.

27. Although the ISACA Website pictures the CSX CYBERSECURITY NEXUS Mark in small banners, a substantial majority of the website refers simply to “CSX.” For example and without limitation, the ISACA Website invites visitors to “Discovery CSX” and obtain a “CSX Practitioner certification,” offers a “CSX Career Tool” and link to “CSX News,” and makes claims about the benefits and programs offered by “CSX.” See Ex. C.

ANSWER:

Applicant admits that the screenshots of its website presented as Exhibit C has a “Discover CSX” button, not “Discovery.” Otherwise, the website screenshots speak for themselves.

28. As noted above, CSX’s COLOCSX Mark and logo is registered for computer equipment and co-location services, including, but not limited to, monitoring computer software and hardware systems for security purposes in Class 45.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 28 of the Notice.

29. In addition, CSX itself has common law rights for the CSX Marks as to the goods and services claimed in CSX's registrations for the COLOCSX Mark and logo. Indeed, the COLOCSX Mark emphasizes "CSX" over all other portions of the mark.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 29 of the Notice.

30. Consumers encountering the CSX CYBERSECURITY NEXUS Mark, as it appears at the ISACA Website, are likely to believe that ISACA's cybersecurity services are offered, sponsored, or endorsed by, or otherwise affiliated with, CSX.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 29 of the Notice.

31. There is no issue as to priority, as CSX has used in commerce and owned registrations for the CSX Marks for several years, and in some cases decades, whereas ISACA merely intended to use the CSX CYBERSECURITY NEXUS Mark as of February 25, 2014.

ANSWER:

Applicant admits that it filed its application for CSX CYBERSECURITY NEXUS and Design on February 25, 2014, as evidenced by Application No. 86203846, and that the application speaks for itself. Applicant is without knowledge sufficient to form a belief as to the truth of the allegations or legal conclusions of the remainder of Paragraph 31 of the Notice.

FIRST GROUND FOR OPPOSITION

(Likelihood of Confusion)

32. Paragraphs 1 through 31 are incorporated by reference as if fully set forth herein.

ANSWER:

Applicant reasserts and realleges its answers to Paragraphs 1 through 31 of the Notice by reference as if fully set forth herein.

33. The CSX CYBERSECURITY NEXUS Mark and the CSX Marks, including at least the CSX and COLOCSX word marks, are substantially similar. The CSX CYBERSECURITY NEXUS Mark and the CSX Marks prominently feature “CSX” over all other components, with the CSX CYBERSECURITY NEXUS Mark merely adding in small typeface the descriptive phrase “Cybersecurity Nexus.”

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 33 of the Notice.

34. Phonetically, consumers are likely to believe that the CSX CYBERSECURITY NEXUS Mark is not in fact a mark; instead, consumers are likely to believe that the brand is “CSX,” and “CYBERSECURITY NEXUS” is merely descriptive of services being offered, sponsored, or endorsed by, or otherwise affiliated with, CSX.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 34 of the Notice.

35. The services for which ISACA seeks to register the CSX CYBERSECURITY NEXUS Mark are substantially related to services provided under CSX’s CSX Marks.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 35 of the Notice.

36. Because of the similarity between the parties’ marks and services, consumers and the general public are likely to be confused, mistaken, or deceived as to the origin and sponsorship of ISACA’s services, and are likely to be misled into believing that ISACA’s services offered under the CSX CYBERSECURITY NEXUS Mark are provided by, or are in some other way

directly or indirectly associated with, CSX and its affiliates and licensees, to the damage of CSX and its reputation.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 36 of the Notice.

37. CSX has no control over the nature or quality of ISACA's services. In the event of false association, any defects, objections, or faults found with Applicant's services could inflict serious injury upon CSX and its reputation.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 37 of the Notice.

SECOND GROUND FOR OPPOSITION

(Dilution)

38. Paragraphs 1 through 37 are incorporated by reference as if fully set forth herein.

ANSWER:

Applicant reasserts and realleges its answers to Paragraphs 1 through 37 of the Notice by reference as if fully set forth herein.

39. Numerous of the CSX Marks, including at least the marks claimed in U.S. Registration Nos. 2,543,728; 2,475,447; 2,544,010; and 3,712,055, are distinctive and famous within the meaning of 15 U.S.C. § 1125(c), and became famous before ISACA applied to register the CSX CYBERSECURITY NEXUS Mark.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 39 of the Notice.

40. The CSX Marks, including at least the marks claimed in U.S. Registration Nos. 2,543,728; 2,475,447; 2,544,010; and 3,712,055, are used extensively throughout the United States, and are instantly recognizable by the consuming public.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 40 of the Notice.

41. CSX actively polices use of the CSX Marks by third parties.

ANSWER:

Applicant is without knowledge sufficient to form a belief as to the truth of the allegations of Paragraph 41 of the Notice.

42. Registration of the CSX CYBERSECURITY NEXUS Mark is likely to cause dilution by blurring of the CSX Marks, including at least the marks claimed in U.S. Registration Nos. 2,543,728; 2,475,447; 2,544,010; and 3,712,055.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 42 of the Notice.

43. Indeed, registration of the CSX CYBERSECURITY NEXUS Mark is likely to impair the distinctiveness of the CSX Marks, including at least the marks claimed in U.S. Registration Nos. 2,543,728; 2,475,447; 2,544,010; and 3,712,055.

ANSWER:

Applicant denies the allegations and legal conclusions of Paragraph 43 of the Notice.

WHEREFORE, Applicant prays that this Opposition be rejected, and that its application be allowed to proceed to the issuance of a Notice of Allowance.

AFFIRMATIVE DEFENSES

Applicant, by its attorneys Ladas & Parry LLP, for its Affirmative Defenses to the Notice of Opposition filed by CSXT Intellectual Properties Corporation, hereby states as follows:

1. Applicant alleges that the Notice of Opposition fails to state a claim upon which relief may be granted.
2. Applicant alleges on information and belief that Opposer has failed to police its marks against third parties, and as such is estopped from asserting rights against Applicant.
3. Applicant alleges that Opposer cannot establish that Applicant's alleged use creates a likelihood of impairment of the distinctiveness of any allegedly famous mark owned by Opposer and Opposer cannot establish the requisite causation necessary to establish harm to any allegedly famous mark under the Lanham Act or other applicable state and federal laws.

Respectfully submitted,
/Kevin A. Thompson/
One of the Attorneys for Applicant

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper is being electronically filed with the United States Patent and Trademark Office on this 1st day of July, 2016.

/Kevin A. Thompson/
Kevin A. Thompson

CERTIFICATE OF SERVICE

The undersigned, one of Applicant's attorneys, hereby certifies that on July 1, 2016, he caused true and correct copies of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION to be served upon Opposer's counsel by First Class mail, postage pre-paid at the following address:

Andriana S. Daly
McGuireWoods LLP
Gateway Plaza
800 East Canal Street
Richmond, VA 23219

/Kevin A. Thompson/
Kevin A. Thompson